A

TREATISE ON THE LAW

RELATING TO

Patent Privileges

FOR

THE SOLE USE OF INVENTIONS;

AND

THE PRACTICE OF OBTAINING

Letters Patents for Inventions;

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WITH AN

APPENDIX OF STATUTES, RULES, FORMS,

&c. &c.

BY

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PREFACE.

THE improved state of the law relating to Patent privileges, and the great and increasing importance of the subject to the profession and the public, seem to demand a treatise exhibiting the law and practice in all its details.

It was with the view of supplying the acknowledged want of such a treatise (*a*), that I commenced this work; but it is not without apprehension as to the success of my performance, that it is now submitted to the public.

The difficulty attending the performance of such an undertaking, however, will be readily acknowledged by all, who have given any attention to this branch of the law; and if I have succeeded in producing a work which throws any additional light upon the subject, or facilitates the labours of the practitioner, I shall be amply repaid for my exertions.

In preparing those parts of the work which relate to the practice in *Scire Facias*, and in the Privy Council, and the practice of obtaining patents, entering disclaimers, &c., I have been favoured with the assistance of the officers by whom

(*a*) This is not intended as any disparagement of the many useful works on Patent Law which have been published.

the various proceedings are conducted or prepared. To each of those gentlemen I have submitted so much of the following sheets, as relates to his particular office or department; and I have not stated any thing on the subject of practice, which has not been approved of by the authorities I have mentioned.

The Forms which I have given in the Appendix, have been prepared with the greatest care, and with very few exceptions, have been actually used in practice. In order to make the use of these forms in practice more readily understood, the blanks have been filled up, and printed in italic letters, so as to represent more accurately the forms of real proceedings.

In conclusion, I beg to tender my best thanks to all my professional friends; and also to all the gentlemen in the public offices, for the valuable information which they have so liberally afforded me respecting the various matters treated of in this work.

7, KING'S BENCH WALK,
February, 1846.

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Wilson *v.* Tindal . . .	1 Webs. R. 730	348, 355
Winter *v.* Foworacres . .	2 Rol. R. 39	240
Wood *v.* Ledbitter . . .	9 Jur. 187	240
——— *v.* Zimmer . . .	1 Holt. N. P. C. 158 . . .	113, 114, 115, 129, 167, 464, 484
Woodcroft's patent, *in re* .	1 Webs. R. 740; 3 Mo. P. C. C. 172 .	565, 569
Wright's patent, *Ex parte* Shuttleworth, *in re* . . .	1 Webs. R. 561	149, 565, 566, 569, 575
Wright's patent, *Ex parte* Wright, *in re* . . .	1 Webs. R. 575	572, 575
Wroth's, Sir T., case . .	Dyer, 167	591
Wynne *v.* Thomas . . .	Willes, 563	212
Wynne, *dem.*, Thomas, *ten.*, Apperly, *vouch.* . . .	Willes, 563	225
Yovatt *v.* Winyard . . .	1 Ja. & W. 394	232
Zouch, Lord, and More's case .	Godb. 413	74

ERRATA.

Page 20, line 16 from the top, after "realm" add inverted commas.
,, 37, line 5 from the bottom, after "letters" insert the word "patent."
,, 39, note (*c*), bottom line, for Earl of Devon's" read "Earl of Devonshire's."
,, 46, note (*m*), after "Neilson v. Harford" add "1 Webs. R. 331."
,, 72, line 9 from the bottom, after "patent" insert "began."
,, 73, note (*i*), for "Bozun's case, Co. R." read "Bozoun's case, 4 Co. R."
,, 86, note (*k*), for "4 B. & G." read "4 M & G."
,, 104, side note, near the top, for "of invention" read "If invention."
,, 114, five lines from the bottom, after "Morgan v. Seaward," for "(*f*)" read "(*b*)."
——— at the bottom of the page, note (*e*), after "530" insert "and;" and *dele* "(*f*)."
,, 139, side note, near the bottom, for "awards" read "avolds."
,, 150, line 9 from the top, after "granted them" add "to inventors."
,, 196, note (*i*), for "182" read "163."
,, 207, line 21 from the top, for "always" read "frequently."
,, 234, note (*p*), for "8 M. & W." read "12 M. & W."
,, 245, note (*m*), for "Hart" read "Hare."
,, 295, note (*q*), for "Beckford" read "Bickford."
,, 311, line 15 from the top, for "King v. Marshall" read "Kay v. Marshall."
,, 366, line 20 from the top, after "hearing," insert "or."
,, 385, line 2 from the top, for "Acres" read "Aires."
,, 408, note (*s*), for "3 Fast" read "2 East."
,, 452, note (*q*), for "488" read "502."
,, 476, line 10 from the top, *dele* "and also enrolled."
——— marginal note, *dele* "and enrolled."
,, 490, line 5 from the top, after "do" insert "not."
——— note (*i*), for "Hill" read "Hall."
,, 503, line 14 from the top, for "Alterations" read "Alteration."
,, 616, top line, for "office" read "offices."
——— line 5 from the top, for "10" read "4."

A

TREATISE

ON

THE LAW OF PATENTS.

CHAPTER I.

INTRODUCTION.

The right of property in moveable chattels was recognized in the earliest periods, and is founded on the law of nature (*a*). But it was very different with respect to the sole right to use an invention, which had its origin in an advanced state of society, and not until after improvements in the arts had made considerable progress.

It has often been asserted, that according to the principles of universal equity, an inventor has an exclusive property in his invention. But it is clear, that independent of positive law, he has no such exclusive property, any longer than he keeps it secret; for no one who first makes any discovery can thereby acquire the right to prevent others from *making* and using the same discovery. He may, if he pleases, conceal his discovery from the world, but the moment he publishes it, he abandons his *exclusive* property in it, and others acquire a right to use the invention in any manner they please. The exclusive right to use an invention after it is published, can only have existence therefore by virtue of some positive law, which is made with the actual or implied consent of the whole community.

Every member of the community receives many benefits from the society in which he lives, and he is therefore bound,

(*a*) See Wollaston's Religion of Nature, s. vi.; Locke on Government, b. 2, c. 5; 2 Bl. Com. cc. 1, 24, 25, 26, and the authorities there referred to.

by every means in his power, to advance its interests. And it seems to be but reasonable that he should be expected to promote the public weal by putting the community in possession of any discovery he makes which may be for the public good. But invention is generally the result of much study and labour, accompanied with a considerable expenditure of time and money, and few persons have the requisite ability and inclination, without the hope of reward, to search for improvements in the arts for the benefit of the public.

Inventions beneficial to the public.

The whole community is benefited by the promotion of the useful arts, and, therefore, it is for the public good to hold out the promise of rewards to the inventors of new and useful arts and manufactures, who may first put the public in possession of them.

Public rewards.

In some cases, where meritorious inventors could not be otherwise adequately rewarded, sums of money have been granted to them out of the public purse (*b*); but such a mode of recompense, it is clear, could not be generally adopted.

Rewards by patent privileges.

The mode of rewarding inventors, which has been adopted in this country, seems to be the best that could be devised:—it is by granting the inventor a monopoly in his invention for a limited time. It is true that by such a grant every other person is restrained during the continuance of the monopoly from using the patent invention, even if he makes a similar discovery himself. But at the time the grant is made, it is by no means certain that the invention will be given to the public, or even made by any other person, and by the temporary suspension of their right, the people acquire the certainty of being able to use the invention at the expiration of the monopoly. The reward which an inventor thus obtains, will, in general, be in proportion to the benefit which he confers upon the public, for the greater the utility of the invention, the more profitable will it be to the grantee of the monopoly.

Reason why privilege good.

Speaking of such a grant, *Sir Edward Coke* says (*c*), "The reason wherefore such a privilege is good in law is because the inventor bringeth to and for the commonwealth a new manu-

(*b*) See a list of cases in Parl. Rep. on Patents, 1829, App. p. 181.

(*c*) 3 Inst. 184.

facture by his invention, costs, and charges, and therefore it is reason that he should have a privilege for his reward (and the encouragement of others in the like), for a convenient time."

Utility the consideration for the grant.

Utility to the public is, in fact, the consideration for every grant of the sole use of an invention, and letters patent, containing such grants, always state the public good to be the motive of the Crown in making the grants (*d*). It is not every thing invented, therefore, to the sole use of which the inventor can become entitled, for the thing itself (although perfectly new) may be of no value whatsoever to the public. And an exclusive right vested in any one to use a thing, which at the time it is given or offered to the public, is of itself of no value, might prevent others from bringing forward useful and profitable inventions, by reason of such otherwise useless thing forming part of their inventions. If an invention is useful to the inventor, and useless to the public, the inventor does not suffer any injury by having no legal right to the exclusive use of it; for no one would infringe the right if he had it, and the legal right could not be any source of profit to him; and if he should fear that he himself would be deprived of the right to use his invention by reason of its being included in a grant to some other person, he might most effectually prevent that by publishing it to the world. Still less will the inventor be injured for want of such an exclusive right if the invention is of no utility either to himself or the public, and he cannot have any right by means of his useless invention to anticipate and appropriate to himself any part of the profit to arise from the subsequent invention of any other person who may be able by his ingenuity to confer an actual benefit upon the public.

Total absence of utility.

The total absence of utility to the public in any invention will at all times, therefore, vitiate a grant of the sole use of it; but it will not be void on that ground, if the invention was of any utility to the public, although such utility may be very small (*e*).

Frivolous inventions.

But an invention may happen to be of some use to the public, and yet it may be so trifling or frivolous that the inconvenience to the public, arising from the grant of the sole

(*d*) See c. iv. and c. v. s. 3, *post*, and the Index, tit. Utility.

(*e*) Vide *post*, c. v. s. 3.

use of it, would not be adequately compensated by the benefit which the public would receive from it. The law has deemed it right, therefore, that mere discovery of any new manufacture shall not vest the sole right to use it in the inventor; but that in order to become entitled to such a sole privilege, he must obtain a grant of it from the Crown, in whom the law has vested the power (which it exercises through its ministers) of judging, not only whether the invention is likely to be of so much utility to the public as to render the making of the grant *a matter of public expediency*, but also what duration of privilege (not exceeding fourteen years) the invention merits.

Inventors not entitled to a patent as of right.

Accordingly inventors are *never entitled as of right* to letters patent, granting them the sole use of their inventions, but they must obtain them from the Crown by petition, and *as a matter of grace and favour*, and letters patent always express that the grant is so made.

Prerogative ancient.

It is impossible to ascertain with certainty when such grants of the sole use of inventions were first made in this country, but there is reason to believe that this prerogative of the Crown is very ancient.

Thus in a case decided in the reign of Edward the Third (*f*), it is said that arts and sciences which are for the public good are greatly favoured in law, and the King, as chief guardian of the common weal, has power and authority by his prerogative to grant many privileges *for the sake of the public good*, although *primâ facie* they appear to be clearly against common right.

Patent for philosopher's stone.

And it is stated at the end of the report of the case of *Darcy* v. *Allen* in Sir Francis Moore's Reports (*g*), that in the time of Edward III., some alchymists persuaded the King that a philosopher's stone might be made, that the King granted a commission to two fryers and two aldermen to enquire if it was feasible, who certified that it was, and that the King granted to the two aldermen a patent of privilege, that they and their assigns should have the sole making of the philosopher's stone.

There is reason to believe that the practice of making grants

(*f*) Year Book, part iv. 40 Edw. III. fol. 17, 18.

(*g*) P. 675.

of the sole use of inventions originated in England, and that the English system of rewarding inventors has since been copied more or less closely by almost every European power. Patents originated in England.

It is quite certain that in England the Crown derives its power to grant such letters patent from the Common Law itself, but restrained by the Statute of Monopolies, which was little more than a declaration of the Common Law on the subject.

Although it seems that the law has at all times permitted the grant of such limited monopolies as the exclusive right to use new inventions (*h*), yet almost all other grants of monopolies by the Crown were contrary to the Common Law, and the legislature in former times frequently interfered to repress them (*i*). All other monopolies illegal.

Notwithstanding the illegality of all monopolies (except those for the sole use of new inventions), they were very frequently granted in former times, but the continual encroachments of the prerogative upon the Common Law in this way, particularly during the reigns of Elizabeth and James I., led at last to the passing of the celebrated Statute of Monopolies in the 21st year of the reign of the latter monarch; by which the Crown was effectually restrained from making such extravagant and illegal grants. Statute of Monopolies.

It is by that statute declared, that all monopolies whatsoever are contrary to law, and void; with a saving however of letters patent and grants of the sole privilege of working or making of new manufactures to the first inventors thereof. The provisions of this statute, material to the subject, will be minutely considered in the subsequent chapters of this work. 21 Ja. I. c. 3.

The 5 & 6 Will. IV. c. 83, the 2 & 3 Vict. c. 67, and 7 & 8 Vict. c. 69, are the only other public general acts relating to patents which have been passed since the Statute of Monopolies. These statutes provide a remedy for many of the deficiencies of the old law, and they also will be considered in the following pages.

For many years after the passing of the Statute of Monopolies the arts and manufactures continued in a low state in this

(*h*) Vide *post*, c. ii.

(*i*) See Mag. ch. c. 30; 9 Edw. III. st. 1, c. 1; Stat. of Cloths, 25 Edw. III. c. 2; *Statutum de Stanulis*, 27 Edw. III. st. 2; 28 Edw. III. c. 13, s. 3; 31 Edw. III. c. 10; 2 Rich. II. st. 1, c. 1; 7 Hen. VII. c. 9, & 12 Hen. VII. c. 6.

country, few of the inventions for which letters patent were obtained were of any value, and the demand for novelties being very limited, no one was tempted to infringe the rights of patentees. Our law reports, from the time of the passing of that statute, therefore, until the reign of George III., are almost entirely silent respecting such patent privileges; and indeed the case of *Edgeberry* v. *Stephens*, reported in the second volume of Salkeld's Reports (*j*), is almost the only case to be found during that period.

The first case of importance respecting a patent was an action of *scire facias* brought against Mr. Arkwright, to repeal his patent for an invention of certain instruments or machines for preparing silk, cotton, flax, and wool for spinning, which was tried in June 1785 (*k*).

About ten years afterwards the important cases of *Boulton and Watt* v. *Bull* (*l*), and *Hornblower* v. *Boulton and Watt* (*m*) were tried, in which this branch of our law was much discussed, and many of its difficulties and obscurities cleared away.

Since that period the number of causes respecting letters patent has gone on steadily increasing, in consequence of which, and the magnitude of the interests concerned in it, the patent law of this country has become of the greatest importance to the community, more particularly those engaged in trade or manufactures.

There is now, perhaps, hardly any part of the law relating to patents which has not been made the subject of judicial investigation and determination; and this branch of our law may therefore now be said to have at last assumed the form of a regular system, and the relative rights of the public and of patentees, as well as the prerogative of the Crown, to have been determined with at least a very considerable degree of certainty.

There is yet, however, much wanting to render the law any thing like perfect; but the greater part of the deficiencies can only be supplied by the legislature. Unfortunately there is little chance of the required remedies being applied at present, or indeed at all, whilst party strife shall continue to occupy so much of the time and attention of parliament.

(*j*) P. 447.
(*k*) See a report of the case in Davies's Patent Cases, p. 61.
(*l*) 2 H. Bl. 463.
(*m*) 8 T. R. 95.

CHAPTER II.

OF THE GRANTOR OF A PATENT, AND THE POWER OF THE CROWN TO GRANT THE SOLE USE OF INVENTIONS.

Common law prerogative.

It is quite clear that the prerogative of the Crown to grant the sole use of inventions is derived from the Common Law itself, and not from any statute.

This prerogative is vested in the Crown, as the depositary of the supreme executive power of the state, to be exercised on the behalf of (*a*), and for the benefit of the public (*b*). It is inseparably annexed to the Crown, and cannot be granted to a subject (*c*), nor can any private person create a legal monopoly (*d*).

No statute prior to 21 Ja. I.

There is no statute to be found made prior to the Statute of Monopolies (*e*), which relates to grants of the sole use of inventions, although many acts have been passed for suppressing various illegal monopolies (*f*). There are authorities, however, in our ancient law books, which show that before the passing of the Statute of Monopolies, the Crown had power at the Common Law to make such grants.

Common law authorities.

Darcy v. Allin.

Thus in the case of monopolies, *Darcy* v. *Allin* (*g*), it is said that "Where any man, by his own charge and industry, or by his own wit or invention, doth bring any new trade into the realm, or any engine tending to the furtherance of a trade that never was used before: and that for the good of the realm: that in such cases the King may grant to him a monopoly patent for some reasonable time, until the subjects may learn the same, in consideration of the good that he doth bring by his invention to the commonwealth: otherwise not."

Hastings' case.

And in the same report (*g*) it is stated, that in the 9 Eliza-

(*a*) Per *Lord Eldon*, L. C., in *Harmer* v. *Playne*, 14 Ves. 132.

(*b*) Bac. Abr. tit. Prerog. and see Year Book, 40 Edw. III. fol. 18.

(*c*) 3 Shep. Abr. Prerog. p. 57, s. (7) and p. 54; Skin. 606; Jenkins, p. 304; Bro. Pat. 13, and *ibid.* Prerog. 18.

(*d*) Hawk. P. Cr. bk. I. c. 79.

(*e*) 21 Ja. I. c. 3.

(*f*) See those referred to, *ante*, p. 5, n. (*i*).

(*g*) Noy, R. 182.

beth, there was a patent granted to Mr. Hastings of the Court, that in consideration that he brought in the skill of making of frisadoes, as they were made in Harlem and Amsterdam beyond the seas, being not used in England; that, therefore, he should have the sole trade of the making and selling thereof for divers years; charging all other subjects not to make any frisadoes in England during that time, under a penalty of 100*l*. The patentee having filed a bill in the Exchequer against certain clothiers of Coxall, for making frisadoes contrary to the intent of the patent, it appeared, upon the examination of the cause, that the same clothiers did make baies very like to Mr. Hastings's frisadoes, and that they used them before Mr. Hastings's patent, for which cause they were neither punished nor restrained from making their baies like to his frisadoes.

Darcy *v.* Allen. So in the report of the case of monopolies contained in Moore's Reports (*h*), it is said that the Queen could not grant a patent to restrain the people in their usual trades and occupations; and that no occupation could be prohibited or put into a monopoly, but solely such thing as is newly invented by the skill of man, which may be granted by patent.

Clothworkers of Ipswich case. In the *Clothworkers of Ipswich* case (*i*), it is said, "If a man hath brought in a new invention, and a new trade within the kingdom in peril of his life, and consumption of his estate, or stock, &c., or if a man hath made a new discovery of any thing: in such cases the King, of his grace and favour, in recompense of his costs and travail, may grant by charter unto him, that he only shall use such a trade or trafique for a certain time, because at first the people of the kingdom are ignorant, and have not the knowledge or skill to use it: but when that patent is expired, the King cannot make a new grant thereof. For when the trade is become common, and others have been bound apprentices in the same trade, there is no reason that such should be forbidden to use it."

Mitchell *v.* Reynolds. In the case of *Mitchell* v. *Reynolds* (*k*), it is laid down by *Parker*, C. J., that "the grant of the sole use of a trade is void, but a grant of a trade newly invented and for a time is good; for the public has an advantage in the invention of a

(*h*) *Darcy* v. *Allen*, F. Moore, 672.
(*i*) Godb. 252, 254; *S.C.*, 1 Rol. R. 4.
(*k*) 1 P. Wms. 181; 10 Mod. 130, *S.C.*

useful trade, which, after a limited time, is to be public, and the inventor's industry is sufficiently encouraged by the sole use of it secured to him by charter for such a time."

In Sheppard's Abridgment (*l*), it is laid down that it is generally held by the Judges, that the King may, for a reasonable time, grant a monopoly patent of that which any man at his own charge, wit, and invention, shall bring in as a new trade or device into the realm; or any new engine tending to the furtherance of it, for the good of the realm. Shep. Abr.

And Serjeant *Hawkins* says (*m*), "It seemeth clear that the King may, for a reasonable time, make a grant to any one, of the sole use of an art invented, or first brought into the realm by the grantee." Hawk. P. Cr.

And *Sir Edward Coke* says, in his Chapter of Monopolies in the Third Institute (*n*), that such a monopoly is good, and gives the reasons for it (*o*). 3 Inst. 184.

The extent of the prerogative thus vested in the Crown having been grossly abused, a declaratory statute was passed in the 21st year of the reign of James I. (1623), by which the power of the Crown to make such grants was confined within certain limits; and all other grants of monopolies were declared to be void (*p*). This Act has been frequently, but erroneously, supposed to *create* the power exercised by the Queen, in making grants of the sole use of inventions; but it will be seen from the statute itself, that such grants are merely excepted out of its provisions, and are left to depend upon the Common Law for their legality. 21 Ja. I. c. 3.

The statute (*p*) is intituled "An Act concerning monopolies and dispensations with penal laws, and the forfeitures thereof;" but it is usually called the Statute of Monopolies. Title.

The preamble of the Act contains the following recitals:—

"Forasmuch as your most excellent Majesty, in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did in the year of our Lord God one thousand six hundred and ten; publish in print to the whole realm and to all posterity, that all grants of monopolies, and of the benefit of any penal laws, or of power to dispense with Preamble.

(*l*) Part III. tit. Prerog. p. 61.

(*m*) Hawk. P. Cr. bk. I. c. 79, s. 20.

(*n*) 3 Inst. 184.

(*o*) See the passage given at length, *ante*, p. 2.

(*p*) 21 Ja. I. c. 3.

the law, or to compound for the forfeiture, are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant and agreeable to the ancient and fundamental laws of this your realm.

"And whereas your Majesty was further graciously pleased expressly to command, that no suitor should presume to move your Majesty for matters of that nature. Yet, nevertheless, upon misinformations, and untrue pretences of public good many such grants have been unduly obtained, and unlawfully put in execution, to the great grievance and inconvenience of your Majesty's subjects, contrary to the laws of this your realm, and contrary to your Majesty's most royal and blessed intention so published as aforesaid. For avoiding whereof, and preventing the like in time to come, may it please your excellent Majesty, &c."

Coke's Commentary.

Sir Edward Coke says (*q*), "It appeareth by the preamble of this Act (as a judgment in parliament) that all grants of monopolies are against the ancient and fundamental laws of this kingdom, and therefore it is necessary to define what a monopoly is—

Definition of monopoly.

"A monopoly is an institution or allowance by the King, by his grant, commission, or otherwise, to any person or persons, bodies politic or corporate, of or for the sole buying, selling, making, working, or using of any thing, whereby any person or persons, bodies politic or corporate, are sought to be restrained of any freedom or liberty that they had before, or hindered in their lawful trade."

Case of monopolies.

In the case of monopolies (*r*), *Coke* says, "Our Lord the King that now is, in a book which he in zeal to the law and justice commanded to be printed, anno 1610, intituled 'A Declaration of his Majesty's pleasure,' &c., p. 13, has published that monopolies are things against the laws of this realm, and, therefore, expressly commands that no suitor presume to move him to grant any of them, &c."

And in the Third Institute (*s*) he says, "That the judgment in the case of monopolies (*t*) was the principal motive for publishing that book, and that the book was a great motive of obtaining the royal assent to the statute." The second

(*q*) 3 Inst. 181.
(*r*) 11 Co. R. 88, b.
(*s*) 3 Inst. 182.
(*t*) 11 Co. R. 88, b.

recital in the preamble shows that the misinformations or false suggestions, and the untrue pretences of public good upon which grants of monopolies had been obtained, made them contrary to law. And this part of the preamble also shows that the intent of the legislature was to pass an Act for avoiding and preventing "such grants; that is to say, grants obtained upon misinformations and untrue pretences of public good."

After thus reciting the grievances under which the people laboured, in consequence of the illegal grants of monopolies, the first section of the Act proceeds to say that "for avoiding whereof, and preventing of the like in time to come," it was declared and enacted, "That all monopolies, and all commissions, grants, licences, charters, and letters patents heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of any thing within this realm, or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty, to dispense with any others; or to give licence or toleration to do use or exercise any thing against the tenor or purport of any law or statute; or to give or make any warrant for any such dispensation, licence, or toleration, to be had or made, or to agree or compound with any others for any penalty or forfeitures limited by any statute, or of any grant or promise of the benefit, profit, or commodity of any forfeiture, penalty, or sum of money, that is or shall be due by any statute before judgment thereupon had, and all proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things whatsoever any way tending to the instituting, erecting, strengthening, furthering, or countenancing of the same or any of them, are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in no wise to be put in ure or execution."

Sec. 1, 21 Ja. I. c. 3.

By the grant of the sole privilege of using a new manufacture to an inventor, all other persons are restrained from using it during the continuance of the privilege, including every person, who, being ignorant of the prior invention, may himself make a discovery precisely similar. And as the effect

Patent privilege is a monopoly.

of such a grant is therefore to restrain persons of a freedom and liberty which they had before, that is to say, a freedom and liberty themselves to invent the art or manufacture, and use it in the way of trade for their own profit and benefit; it follows that such an exclusive privilege is a monopoly within the meaning of the word as defined by *Coke* (*u*).

In the case of *Boulton and Watt* v. *Bull* (*x*), Lord Chief Justice *Eyre* said, that by section one of this statute, a monopoly is defined to be, "the privilege of the sole buying, selling, making, working, or using any thing within the realm." And it is clear that this is so, for the Act, immediately after mentioning "all commissions, grants, licences, charters and letters patents of or for the sale, buying, selling, making, working, or using of anything within this realm," adds the words, "or any *other* monopolies," clearly indicating that all the commissions, grants, &c., previously mentioned are in law deemed to be monopolies.

But even if it were doubtful whether the sole privilege granted to an inventor is a monopoly according, to the Common Law, the words "all commissions, grants, licences, charters and letters patents, of or for the sole buying, selling, making, working or using of anything within this realm," but for the subsequent exception would have been sufficient to include letters patent for inventions.

The first section of the Act concludes by declaring, that the matters and things before mentioned "are altogether contrary to the laws of this realm; and so are, and shall be, utterly void and of none effect, and in nowise to be put in ure or execution." These words plainly show that it was the intention of the legislature to declare what the Common Law was on the subject, and not to introduce any new law.

Sec. 2, 21 Ja. I. c. 3. By section 2, it is declared and enacted, that all monopolies, and all such grants, letters patents, &c., ought to be and shall be tried by the Common Laws of the realm, and not otherwise.

Sec. 3. The 3rd section enacts, that all persons shall be disabled and incapable to have or exercise any monopoly, or any such grant, letters patent, &c., as aforesaid.

Sec. 4. Section 4 provides, that any person aggrieved by any mo-

(*u*) 3 Inst. 181; vide *ante*, p. 10. (*x*) 2 H. Bl. 463.

nopoly, or any such commission, grant, letters patent, &c., shall have a remedy by action to recover treble damages and double costs, and imposes the penalties of præmunire upon persons delaying such actions except by authority of the Court.

Statute suppressed illegal monopolies.

These four sections of the statute effectually suppressed all illegal monopolies, and deprived the Crown, not only of all claim to grant such monopolies in future, but also of all power to prevent persons aggrieved by them from pursuing their legal remedies; the statute being, as *Sir Edward Coke* observes (*y*), "forcibly and vehemently penned for the suppression of all monopolies:—for monopolies in times past were ever without law, but never without friends."

Intended to be declaratory of the common law.

This statute, however, as has been already observed, was only intended to be declaratory of the Common Law respecting monopolies, and as the generality of the terms used in the first and third sections would have extinguished the power of granting to inventors the sole use of their inventions, the authority of the Crown to make such grants is excepted and preserved within certain limits by the fifth and sixth sections of the Act.

Exception in Sect. 5, as to patents already made.

The first exception is in favour of letters patent made *prior* to the statute, and it is as follows: section 5. "Provided, nevertheless, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patent, and grants of privilege for the term of one and twenty years or under, *heretofore made*, of the sole working or making of any manner of new manufacture within this realm, to the first and true inventor or inventors of such manufactures, which others at the time of making of such letters patent and grants did not use, so they be not contrary to the law, nor mischievous to the state by raising of the prices of commodities at home, or hurt of trade, or generally inconvenient, but that the same shall be of such force as they were or should be, if this Act had not been made, and of none other: and if the same were made for more than one and twenty years, that then the same for the term of one and twenty years only, to be accompted from the date of the first letters patents, and grants thereof made, shall be of such force as

(*y*) 3 Inst. 182.

they were or should have been, if the same had been made but for term of one and twenty years only, and as if this Act had never been had or made, and of none other."

2nd exception.

The 2nd exception is in favour of letters patent to be made *after* the passing of the Act. It is as follows:

Sec. 6, as to patents to be made afterwards.

Section 6.—"Provided also, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patents, and grants of privilege, for the term of fourteen years or under, *hereafter to be made*, of the sole working, or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patents and grants shall not use, so as also they be not contrary to the law, nor mischievous to the state, by raising prices of commodities at home, or hurt of trade, or generally inconvenient; the said fourteen years to be accounted from the date of the first letters patents or grants of such privilege hereafter to be made, but that *the same shall be of such force as they should be if this act had never been made, and of none other.*"

Ch. Monop. 3rd Inst.

The Chapter of Monopolies in *Sir Edward Coke's* Third Institute of the Laws of England (*z*), contains the following commentary respecting the exceptions in this statute in favour of letters patent for new inventions; speaking of the proviso in section *five*, he says, "The first is, that this Act shall not extend to any letters patents or grants of privilege heretofore made of the sole working, or making of any manner of new manufacture, but that new manufacture must have seven properties."

"*First*, it must be for twenty-one years, or under."

"*Secondly*, it must be granted to the first and true inventor."

"*Thirdly*, it must be of such manufactures which any other at the making of such letters patent did not use, for albeit it were newly invented, yet if any other did use it at the making of the letters patents, or grant of the privilege, it is declared and enacted to be void by this Act."

"*Fourthly*, the privilege must not be contrary to law: such a privilege as is consonant to law must be substantially and essentially newly invented; but if the substance was *in esse* before, and a new addition thereunto, though that addition

(*z*) 3 Inst. c. 85, p. 181, 184.

make the former more profitable, yet is it not a new manufacture in law: and so was it resolved in the Exchequer Chamber, Pasch. 15 Eliz. in *Bircot's* case, for a privilege concerning the preparing and melting, &c. of lead ore: for there it was said, that that was to put but a new button to an old coat, and it is much easier to add than to invent. And there it was also resolved, that if the new manufacture be substantially invented according to law, yet no old manufacture in use before can be prohibited." Bircot's case.

"*Fifthly*, nor mischievous to the state by raising of prices of commodities at home. In every such new manufacture that deserves a privilege, there must be *urgens necessitas*, and *evidens utilitas*."

"*Sixthly*, nor to the hurt of trade. This is very material and evident."

"*Seventhly*, nor generally inconvenient."

"There was a new invention found out heretofore that bonnets and caps might be thickened in a fulling mill, by which means more might be thickened and fulled in one day, than by the labours of four-score men who got their living by it. It was ordained that bonnets and caps should be thickened and fulled by the strength of men and not in a fulling mill, for it was holden inconvenient to turn so many labouring men to idleness."

"If any of these seven qualities fail, the privilege is declared and enacted to be void by this Act: and yet this Act, if they have all these properties, set them in no better case than they were before this Act."

Speaking of section *six*, he says,

"The *second* proviso concerneth the privilege of new manufactures *hereafter* to be granted: and this also must have seven properties; first, it must be for the term of fourteen years, or under; the other six properties must be such as are aforesaid. *and yet this Act maketh them no better than they should have been if this Act had never been made, but only except and exempt them out of the purview and penalty of this law.*"

The cause wherefore the privileges of new manufactures, either before this Act granted, or which after this Act should be granted, having these seven properties, were not declared to be good was, for that the reason wherefore such a privilege

is good in law is, because the inventor bringeth to and for the commonwealth a new manufacture by his invention, cost and charges; and therefore it is reason that he should have a privilege for his reward (and the encouragement of others in the like) for a convenient time: but it was thought that the times limited by this Act were too long for the private before the commonwealth should be partaker thereof, and such as served such privileged persons by the space of seven years, in making or working of the new manufacture (which is the time limited by law of apprenticehood), must be apprentices or servants still during the residue of the privilege, by means whereof such numbers of men would not apply themselves thereunto as should be requisite for the commonwealth after the privilege ended. And this was the true cause wherefore, both for the time past, and for the time to come, they were left of such force as they were before the making of this Act."

In the case of *Boulton and Watt* v. *Bull* (*a*), Lord Chief Justice *Eyre* said, respecting this commentary of Coke's, "*Sir Edward Coke* discourses largely, and sometimes not quite intelligibly, upon monopolies, in his Chapter of Monopolies, Third Inst. 181; but he deals very much in generals, and says little or nothing of patent rights as opposed to (illegal) monopolies."

Bircot's case we shall see hereafter is not now law, having been again and again expressly overruled. Nor would a patent be deemed generally inconvenient within the meaning of the sixth section of the Act, because it turned many labouring men to idleness. Indeed, it seems to have escaped the notice of our great commentator, that ordaining "that bonnets and caps should be thickened and fulled by the strength of men," is to give labouring men a monopoly of thickening and fulling bonnets and caps.

Prerogative derived from the common law.

It appears most clearly, both from the words of the statute, and also the Commentary of *Sir Edward Coke*, that the power of the Crown to grant the sole use of an invention is derived from the Common Law, and not, as many persons have erroneously supposed, from the Statute of Monopolies. For the sixth section, respecting letters patent to be made after the passing of the Act, expressly declares (*b*), that the excepted

(*a*) 2 H. Bl. 463.

(*b*) Vide *ante*, p. 13-14.

grants shall be of such force as they should be if the Act had never been made, *and of none other*; and *Sir Edward Coke* says (*c*), that the Act makes them no better than they should have been if the Act had never been made, but only excepts and exempts them out of the purview and penalty of it. And all the cases decided in favour of patentees, whether before or since the passing of the Act, are so many authorities that the Crown has power *at the Common Law* to make such grants.

Prerogative limited by common law and statute.

The prerogative of the Crown to make such grants is, however, confined within definite limits, both by the Common Law and the Statute of Monopolies. At the Common Law such grants could only be made by the Crown, by charter, or letters patent under the Great Seal, to the first inventor; the invention must have been new in England, and useful; and the term of the privileges reasonable. The statute seems merely to have further provided that the term shall not exceed fourteen years.

The grant of a patent discretionary.

This, like every other prerogative, being vested in the Crown, for the benefit of the people, a discretion is to be exercised with respect to the making of such grants; and that discretion is exercised through the medium of certain officers and advisers appointed by law for that purpose. Thus, the petition for such a grant must be presented to her Majesty, through one of the Secretaries of State, who is always a privy councillor, and bound by his oath to advise her Majesty respecting the expediency of granting the prayer of the petition. The petition is also referred to the Attorney or Solicitor-general, to report upon the petitioner's title, and the propriety of granting him the privilege which he seeks to obtain. And even after it has been decided that the grant shall be made, the proceedings necessary for obtaining it must pass through several public offices before the Lord Chancellor is authorized by writ under the privy seal to make the patent (*d*); and the making of the patent may be stopped at any stage of the proceedings.

Command to Chancellor to make a patent is conditional.

And although the Queen has determined to make the grant

(*c*) Vide *ante*, p. 15.

(*d*) The various proceedings for obtaining a patent and the offices through which they pass, will be detailed, *post*, in Chapter XII., respecting the practice upon obtaining patents.

requested by an inventor, and in consequence commands a patent to be made; that command is to be understood as having an implied condition annexed to it; namely, that the making of the grant will not be contrary to law or inconsistent with justice to any others of her Majesty's subjects, and therefore it is that, as we shall see in a subsequent part of this work, the Lord Privy Seal, and the Lord Chancellor exercise judicial authority respecting the making of the writ of privy seal and letters patent (*e*).

Power to grant not suspended by minority.

The power of the Crown to grant patent privileges is not suspended by the minority, or any other personal incapacity, of the reigning Sovereign (*f*).

(*e*) See further on this subject in Chapter IV. respecting the patent, and the practice as stated in Chapter XII. respecting the writ of privy seal and letters patent.

(*f*) Co. Lit. 43, b; 5 Co. 27, a; 7 Co. 12, a; 1 Black. Com. 248.

CHAPTER III.

OF THE GRANTEE OF A PATENT PRIVILEGE, OR THE PERSON TO WHOM THE SOLE USE OF AN INVENTION MAY BE GRANTED.

SECT. I.—*Of the Grantee of a Patent Privilege*, p. 19.
II.—*Of the true and actual Inventor or Discoverer of a new Art or Manufacture*, p. 22.
III.—*Of the true and actual Importer of a new Art or Manufacture*, p. 26.
IV.—*Of the first Inventor, or first Importer of a new Art or Manufacture*, p. 31.
V.—*Of the Persons incapacitated from becoming Grantees of Patent Privileges*, p. 34.

SECTION I.

Of the Grantee of a Patent Privilege.

To whom a patent privilege may be granted.

THE next subject of enquiry is,—to whom may the sole use of an invention be granted? We shall see that a patent granting such a privilege is to be considered as containing a bargain between the public and the grantee (*a*), the Crown on behalf of the public making the grant in consideration of a benefit conferred upon the public *by the grantee*. And *Sir Edward Coke* says (*b*), that the reason why such a grant to an inventor is good, is "because the inventor bringeth to and for the commonwealth a new manufacture, *by his invention*, cost and charges, and therefore it is reason that he should have a privilege *for his reward, and the encouragement of others*."

Object of the law to procure inventions by rewards.

The object of the law is, therefore, to procure new inventions for the benefit of the public, and letters patent, are

(*a*) *Post*, Ch. IV. and vide *Williams* v. *Williams*, 3 Mer. 157; and *Harmar* v. *Playne*, 14 Ves. 131—6.
(*b*) 3 Inst. 184.

granted for new inventions for the purpose, not only of recompensing particular grantees, but also of stimulating and encouraging others by the hope of similar rewards to confer similar benefits upon the public.

Patents can be granted to inventors only.

The persons to be rewarded therefore, by such letters patent, are those who *invent, and give to the public the benefit of their inventions*; to such persons, and such alone, is the Crown authorized by law to grant the sole use of inventions; and we shall see that the prerogative of the Crown is limited in this manner, both by the Common Law and the Statute of Monopolies.

Darcy v. Allin.

In the case of monopolies, *Darcy* v. *Allin* (*c*), which was decided before the passing of the Statute of Monopolies, it was laid down that such a monopoly may be granted to any man, who, "by his own charge and industry, or by his own wit or invention, doth bring any new trade into the realm. And

Clothworkers of Ipswich case.

in the *Clothworkers of Ipswich* case (*d*), (also decided before the statute,) it is said that if a man hath brought in a new invention and a new trade within the kingdom, in peril of his life and consumption of his estate or stock, &c., or if a man hath made a new discovery of anything," the King may grant him the monopoly of his invention for a time.

Mitchell v. Reynolds.

In the case of *Mitchell* v. *Reynolds* (*e*), Lord Chief Justice *Parker* states the opinion of the Court of Queen's Bench at some length respecting monopolies, and he there says, that "a grant of the sole use of a new invented art is good, being indulged for the encouragement of ingenuity, but is tied up by the statute of 21 Jac. I. c. 3, s. 6, to the term of fourteen years." He also states, that "patents for the sole use of a new invented art" are not within any of the reasons against illegal monopolies, and that "as to a new invented art nobody can be said to have a right to that which was not in being before; and, therefore, it is but a reasonable reward to ingenuity and uncommon industry." And although this case occurred after the passing of the statute, it is evident from the language of the judgment, that the Court was laying down what was deemed to be the Common Law on the subject.

(*c*) Noy, 182.
(*d*) Godb. 252, 254.
(*e*) 1 P. Wms. 181; 10 Mod. 130, *S. C.*

In Sheppard's Abridgment (*f*) it is laid down that the King may grant a monopoly "of that which *any man at his own charge, wit, and invention*, shall bring in as a new trade or device *into the realm*." And the person who brings in the trade or device must of course be the grantee of the monopoly. Shep. Abr.

By the sixth section of the Statute of Monopolies, an exception is made out of the preceding condemnation of all monopolies in favour of future letters patents and grants of privilege for the term of fourteen years, "of the sole working or making of any manner of new manufactures within this realm to the true and first inventor and inventors of such manufactures." It seems that this enactment must be read, as if the grants were permitted to be made to the true and first inventors within the realm, for it will be seen that a valid patent may be granted to a person who imports an invention from abroad, if it be new in this country. Sec. 6, stat. 21 Jac. I. c. 3.

Letters patent for inventions are always framed in such a way as to impose conditions upon the grantee in affirmance of the provisions of the Common and Statute Law upon this subject (*g*). Therefore every patent granting the sole use of an invention to the actual inventor or discoverer, contains a proviso for avoiding the grant if the invention was "not invented or found out" by the grantee (*h*). And in a patent granted for an imported invention, there is a similar proviso for avoiding it if the invention was not first introduced into this kingdom by the patentee. *Condition in patent in accordance with the law.*

Letters patent always recite the patentee's petition for the grant (*i*), and the recital shows whether the petitioner stated himself to be an inventor or an importer. And if the statement made to the Crown was false, the grant is void by reason of the false suggestion (*k*). *Recital of patentee's title.*

It is evident from what has been stated, that no person can be the grantee of a privilege in an invention, except the *true* and *first* inventor of the invention. To be capable of supporting such a grant therefore, the patentee must be the person *None but true and first inventor can be a grantee.*

(*f*) Part. III. tit. Prerog, p. 61.
(*g*) 21 James I. c. 3. s. 6.
(*h*) See this clause, in the patent.
(*i*) See the form of patent, in the Appendix, Chapter II. s. 1.
(*k*) See Chapter IV. *post*, on this subject.

who has not only actually invented or imported the invention, but who has been the first to give the invention to the public.

Section II.

Of the true and actual Inventor of a new Art or Manufacture.

Inventor, who is.

An inventor is a person who discovers or finds out something new, a framer, contriver, or deviser of what was before unknown. A person who founds his claim to a patent privilege upon discovery, and not importation merely; must be the person who really and actually invented or discovered the invention, which is made the subject of the privilege.

Patentee must himself have invented.

To be an actual inventor or discoverer of a manufacture, a person must himself make the discovery or invention, the idea of it must originate in his own mind (*l*); and must not be suggested to him by another (*m*), or taken from a book (*n*), or from any thing else (*o*); but whether the discovery be the result of accident, of some happy thought, or of great study, labour and expense (*p*), is perfectly immaterial as respects the validity of the bargain made by the patent, between the patentee and the public. If the patentee was enabled by his own discovery to communicate to the public the knowledge of the invention, he is the person whom the law enables the Crown to reward by a patent for the benefit conferred upon the public.

Whether accidental or not immaterial.

Jones v. Pearce.

Thus in the case of *Jones* v. *Pearce* (*q*), *Patteson*, J., said, that the plaintiff's patent would be good if the patent "*was his own invention.*"

Tennant's case.

In *Tennant's* case (*r*), it appeared that the principal part of the process claimed by the patentee in his specification had been suggested to him by another person, and therefore it was held that he was not the true inventor, and that his patent was void.

(*l*) *Jones* v. *Pearce*, 1 Webs. 124.
(*m*) *Tennant's* case, 1 Webs. 125.
(*n*) *Arkwright's* case, Dav. P. C. 61; *Hill* v. *Thompson*, 8 Taunt. 375; 2 B. Mo. 424, *S. C.*; and vide *post*, Chapter V. s. 3, as to the novelty of an invention.
(*o*) *Carpenter* v. *Smith*, 1 Webs. R. 535.
(*p*) See *Crane* v. *Price*, 1 Webs. R. 411.
(*q*) Webs. R. 124.
(*r*) Webs. 125, Davies. P. C. 429.

In the case of *Barber* v. *Walduck* (*s*), it appeared that the invention was made by a workman whilst employed in the workshop of the patentee, and it was held that the patent could not be sustained. It must, however, be presumed, that in this case the patentee obtained a knowledge of the invention from his workman, and that the workman when he made the discovery was not employed in carrying out the ideas of his master. Barber v. Walduck.

In the case of *Minter* v. *Wells* (*t*), Mr. Baron *Alderson* said to the jury, "Minter and Sutton were together about the time the invention took place; which of the two suggested the invention, and which carried it into effect, is a question for you to decide. If Sutton suggested the principle to Mr. Minter, then he (Sutton) would be the inventor. If, on the other hand, Mr. Minter suggested the principle to Sutton, and Sutton was assisting him, then Mr. Minter would be the first and true inventor." Minter v. Wells.

In the case of *Lewis and another* v. *Marling* (*u*), Lord *Tenterden*, C. J., said, that if the plaintiffs had borrowed their invention from some one else, their patent would fail. And also that if they had seen a model of the invention, or a description of it contained in *an American specification*, that would be an answer to their claim of invention (*x*). And in the same case *Bayley*, J., said, "If it had been shown that the plaintiff had seen the model, *and had borrowed from it*, he would not have been the true inventor." Lewis v. Marling.

The reason why the grantee of an invention is required to be the true and actual inventor is, that the *consideration* for the grant made to him by or on the behalf of the public, must proceed from the grantee himself (*y*), and it is intended to reward him for his ingenuity, labour, and expense, and not another who may by any means obtain a knowledge of his invention. It is difficult to prove an actual inventing or discovering by the patentee in any case (*z*), and, indeed, the only evidence of it which an inventor is ever capable of giving in our Courts of Law is, that he was the first person to give a Consideration must move from the grantee.

Difficulty of proving an actual inventing.

(*s*) Cit. 1. C. & P. 567; *S. C. nom.* *Barber* v. *Shaw*, Holroyd. Pat. p. 60.
(*t*) 1 Webs. R. 132.
(*u*) 4 C. & P. 52; 10 B. & C. 22.
(*x*) 10 B. & C. 27.
(*y*) A similar rule of law prevails with respect to the consideration necessary to support a promise in an action of assumpsit.
(*z*) See Chap. XI. and Index, tit. Evidence.

knowledge of the invention to the world; for, according to the rules of evidence which obtain in those Courts, no one can be a witness in his own cause.

Prior invention may be proved.

But although a patentee may have been the first to put the public in possession of the invention, yet it is open to any one to show that *he* was *not* the *real* inventor, or that *he* had borrowed it from some other person, or had obtained a knowledge of it (in this country) from some other source than his own actual discovery (*a*).

Cornish v. Keene.

Thus, in *Cornish* v. *Keene*(*b*), the Lord Chief Justice (*Tindal*) said, "Sometimes it is a material question to determine whether the party who got the patent was the real and original inventor or not; because these patents are granted as a reward, not only for the benefit which is conferred upon the public by the discovery, but also to the ingenuity of the first inventor: and although it is proved that it is a new discovery so far as the world is concerned, yet if any body is able to show that although that was new,—that the party who got the patent was not the man whose ingenuity first discovered it; that he had borrowed it from *A.* or *B.*, or taken it from a book that was printed in England, and which was open to all the world,—then although the public had the benefit of it, it would become an important question whether he was the first and original inventor of it."

Patentee must have invented every part.

Losh v. Hague.

And not only must the patentee have been the actual inventor, but he must have invented every part of what he claims to have invented (*c*). Thus in the case of *Losh* v. *Hague* (*d*), Lord *Abinger*, C. B., said, "That if a man claims by his patent a number of things as being the inventor of them, whether they consist of improvements or original inventions, and it turns out that some of them are not original, his patent is void."

Not necessary to show great labour.

But although the invention must have been the patentee's own invention, it is not necessary to show that it has been the result of great labour, pains, or expense. For, indeed, a patentee would seldom be in a position to prove the extent of his labour or cost in bringing his invention to perfection;

(*a*) Vide *post*, Evidence, Chap. XI.
(*b*) 1 Webs. R. 507.
(*c*) See *Tennant's* case, 1 Webs. R. 125; *Arkwright's* case, Dav. P. C. 61.
(*d*) 1 Webs. R. 203.

and besides, if there are persons in the world who are capable, without much mental effort, and without the aid of experiment, to make inventions useful to the public, it is very desirable that they should be encouraged and rewarded, by the grant of temporary privileges, to bestow their time and talents in the production of new inventions, which may be of the greatest benefit to the public.

Crane v. Price.

Thus in the case of *Crane* v. *Price and others* (e), the Court of Common Pleas held that it was unnecessary to consider the labour, pains, or expense incurred by the patentee in bringing his discovery to perfection, and that in point of law the labour of thought or experiment, and the expenditure of money, are not the essential grounds of consideration on which the question whether an invention is or is not the subject-matter of a patent ought to depend. And there can be no doubt that the same law is applicable to the question whether a patentee was the true inventor of the invention, for it is sufficient if the patentee was really the inventor, and gave the invention to the public in consideration of the patent. And in the case last cited, the Court said, "If the invention be new and useful to the public, it is not material whether it be the result of long experiment and profound research, or whether by some sudden and lucky thought, or mere accidental discovery."

Inventor may avail himself of assistance.

The law does not prevent an inventor from availing himself of the assistance of workmen or servants in the prosecution of his search after a new manufacture. Many processes cannot be conducted by the unaided exertions of a single individual, and in order to discover any thing new in the arts and manufactures, it is almost always necessary to have recourse to actual experiment in order to discover how any particular object may be best obtained. And indeed the previous ignorance of the world respecting a process or mode of producing a new manufacture, points out the necessity for questioning nature, as it were, by experiments, and thus endeavouring to discover in what way her laws allow us to attain any object we may have in view. It would, therefore, be most impolitic to confine the rewards given to inventors to that class of them only who have entirely and without any assistance whatever brought their inventions to perfection; and indeed

(e) 1 M. & G. 580; 1 Webs. R. 410, 411.

it may be doubted whether, properly speaking, any such would be found.

Servants considered as inventor's tools.

Our law, therefore, permits an inventor in the prosecution of his discovery to avail himself of the labour of servants, they being in fact considered as mere tools or instruments working by his directions, and carrying out the views which he has formed in his own mind.

Minter v. Wells.

Thus, in the case of *Minter* v. *Wells* (e), *Alderson*, B., said, if Mr. Minter suggested the principle to Sutton, and Sutton was assisting him, then Mr. Minter would be the first and true inventor, and Sutton would be a machine, so to speak, which Minter used for the purpose of enabling him to carry his original conception into effect.

Bloxam v. Elsee.

And in the case of *Bloxam* v. *Elsee* (f), which was an action for the infringement of two patents granted to John Gamble, the first of which was for a new paper machine, and the second for improvements made upon the invention comprised in the first. One ground of defence at the trial was, that these improvements were the invention of Mr. Donkin, an engineer.

Mr. Donkin proved that the improvements were of his invention; but he stated that at the time he invented those improvements he was employed by Mr. Gamble, the patentee, and Mr. Foudrinier, his partner, as an engineer, for the purpose of bringing the machine to perfection, and was paid by them for so doing; and therefore he was acting as their servant for the purpose of suggesting improvements in the machine. For the plaintiff it was contended that the improvements were the patentee's inventions, and that Mr. Donkin was employed by them to carry their ideas into effect in the best manner. And the objection to the patent on this ground seems to have been disregarded.

Section III.

Of the true and actual Importer of a New Art or Manufacture.

Importer might at common law be a grantee.

Some of the old cases respecting monopolies already cited, show that the importer from abroad of an invention unknown in this kingdom was, at Common Law, entitled to maintain a patent for the sole use of the invention.

(e) 1 Webs. P. 132.

(f) 1 C. & P. 558; 6 B. & C. 169.

Thus, in the case of monopolies (*g*), it is laid down that a grant may be made to a man who "doth bring any new trade into the realm." In the same case it appears that a patent had been granted to Mr. Hastings, "in consideration that he brought in the skill of making of frisadoes as they were made in Harlem and Amsterdam." And no objection was made to the patent on the ground, that Mr. Hastings was not the actual inventor. So in the *Clothworkers of Ipswich* case (*h*), it is said that the King may make a grant to a man who "hath brought in a new invention, and a new trade, within the kingdom."

Case of Monopolies.

Hasting's case.

Clothworkers of Ipswich case.

In Sheppard's Abridgment (*i*), it is laid down that the King may grant a monopoly of any new trade or device which any man bring *bring into the realm*. And Serjeant *Hawkins* (*k*) says, that such grants may be made "of an art invented *or first brought into the realm* by the grantee."

Shep. Abr.

It is clear that the exception contained in the sixth section of the Statute of Monopolies (*l*), was intended by the legislature to be in affirmance of the Common Law upon the subject, with the exception perhaps of the length of the term for which a patent might be granted, and which, before the passing of the statute, was uncertain, and merely required to be reasonable.

Sect. 6, Stat. Monopolies.

And the language of the preamble of the Act plainly indicates that the grants intended to be rendered void, were such only as would be void at Common Law, independently of the statute (*m*). Our Courts have therefore construed this section of the statute as permitting grants of privilege in new arts or manufactures, to be made to the true and first inventors of such arts or manufactures *within the realm*, and therefore patents for foreign inventions, unknown in this country, have been held to be good ever since the passing of the statute, and very many of such patents are continually granted to the importers of such inventions.

Statute construed to permit grants for foreign inventions.

Thus, in the case of *Edgeberry* v. *Stephens* (*n*), it was held that if an invention be new in England, a patent may be granted though the thing was practised beyond the sea

Edgeberry v. Stephens.

(*g*) Noy. 182.
(*h*) Godbolt, 252, 254.
(*i*) Part 3, tit. Prerog. p. 61.
(*k*) Hawk. pl. Cr. bk. i. c. 79, s. 20.
(*l*) 21 Ja. I. c. 3.
(*m*) See *ante*, p. 10.
(*n*) 2 Salk. 447; Dav. P. C. 36; and 1 Webs. R. 35, *S. C.*

before; that the Act intended to encourage new devices useful to the kingdom, and whether learned by travel or study, it is the same thing.

This case has ever since been acted upon as law; and indeed there is no subsequent case reported in which the validity of a patent has been questioned on the ground of the invention comprized in it being a foreign invention, and merely imported into this country by the patentee.

Importer may support a patent for a foreign invention.

It is clear, therefore, that if an invention be unknown in this realm, a person who imports a knowledge of it from a foreign country, will be able to support a patent for it as the true inventor of it, within the meaning of the Statute of Monopolies.

Importer from any other part of the realm cannot support a patent.

But it seems that if an invention be publicly known in any part of the realm, as Ireland or Jamaica, for example; a person who afterwards imports the knowledge of it into England cannot be an inventor within the meaning of the law.

Brown v. Annandale.

The case of *Brown* v. *Annandale* (*o*) shows, that if an invention be known in any part of the realm, a subsequent patent for it in England or Scotland, would be void on the ground of a want of novelty in the invention, even if it were perfectly new at the date of the patent in that part of the realm for which the patent was granted.

There can be little doubt that whenever the question does arise, it will be held that a mere transportation of a knowledge of an invention from one part of the realm to another, will not make a person an inventor within the meaning of the patent law. And in the case of *Brown* v. *Annandale* (*p*), just cited, Lord *Lyndhurst*, L. C., said, "It would be a monstrous thing if an invention having full publicity in one part of the United Kingdom could be made the subject of a patent in another part of it." And in the same case Lord *Campbell* said, that "If the Crown were made aware of that fact the grant would be refused."

Tennant's Case.

In *Tennant's* case (*q*), one ground upon which the patent was held to be void was, that the plaintiff (the patentee) was not the inventor of an indispensable part of the process for which

(*o*) 1 Webs. R. 433; See also *Roebuck* v. *Stirling*, 1 Webs. R. 45 and 451.

(*p*) 1 Webs. R. 444.

(*q*) Dav. P. C. 429; 1 Webs. R. 125.

he had obtained his patent; it having been shown that it was suggested to him by a chemist at Glasgow. It does not appear from any report of that case *where* the communication was made to the patentee, although from the language of the note of the case in Davies' Patent Cases, it is to be inferred that the suggestion was made in Scotland; but no attempt was made to support the patent on the ground that the communication was made to the patentee by a person residing out of England. Tennant's patent was, however, obtained for an invention by the patentee, and without mentioning it to be an imported or communicated invention, and therefore it may have been thought that the form of the representation to the Crown in that case, excluded the patentee from all right to support his patent as for a communicated invention.

Whether patent good for communication from an Englishman abroad,

It is quite clear that no patentee can support a patent as inventor of a new manufacture, when it is shown that he obtained a knowledge of the invention from any Englishman residing in his own country (*r*). But it has never been decided whether a communication made from an Englishman residing abroad to a person residing here would be sufficient to support a patent. But the language of some of the old cases already cited, would seem to lay down the law in terms quite large enough to include such a case (*s*).

or from a foreigner residing here.

Nor has there been any decision as to whether the communication made by a foreigner to the patentee may be made in this country, or by a foreigner residing here. The representation which is always made to the Crown in the petition, to obtain a patent for an imported invention, is that the petitioner is in possession of the invention, in consequence of a communication made to him by a foreigner *residing abroad*. And it would seem from this that if the communication was made by a foreigner *permanently* domiciled here, that it would not be sufficient; but if the foreigner at the time of the communication was only temporarily residing here, the communication would most probably be held sufficient to support the patentee's claim to be an inventor within the meaning of the law. For a foreigner is under no obligation of duty to the people of this country to give them the invention,

(*r*) Vide *ante*, p. 22, 23.

(*s*) Vide *ante*. p. 7. and p. 20.

either for a reward or without, and a native of this country having by purchase or otherwise acquired from a foreigner temporarily here, the means of giving the public the benefit of a useful invention, would most probably be enabled as importer or introducer to support a patent for the invention. And it is to be observed, that our Courts do not put a patentee to very strict proof of the mode in which he became possessed of the invention. It is sufficient that he appears, *primâ facie*, to have been the inventor or (in the language of a patent for an imported invention) to have been the first to introduce the invention into this country (*t*). There must however be no false representation made to the Crown respecting the nature of the patentee's title, or the patent will be thereby rendered void.

First publisher cannot support a patent unless he be an inventor or importer.

It has been erroneously supposed that there is a class of persons who may become true and first inventors within the meaning of the law, besides actual inventors and importers of foreign inventions. And it has been said, that in addition to discoverers of new inventions and importers of foreign inventions, the first publishers or introducers of inventions may maintain letters patent for them. But it is clear that this supposition is founded in error, for any new invention which a person may possess the knowledge of must either have been discovered by the possessor himself, or by some other person. We have seen that an actual inventor can maintain a patent for his invention (*u*), but no one can support a patent for an invention communicated to him by a fellow-countryman in England (*x*), and therefore it seems that the only other class of inventors within the meaning of the law, besides discoverers, are those who become possessed of foreign inventions, and who we have termed importers.

(*t*) See *post*, Ch. XI. and Index, tit. Evidence.

(*u*) Vide *ante*, p. 22.

(*x*) Vide *ante*, p. 23.

Section IV.

Of the first Inventor, or first Importer of a new Art or Manufacture.

Object to procure inventions speedily.

It has already been shown that the object of the law is to procure for the public the benefit of new inventions. And it must now be added, that it is equally the object of the law to procure that benefit in every case as speedily as possible.

Patentee must be the first inventor.

The law, therefore, as declared by the Statute of Monopolies (*y*), requires not only that a patentee shall have been the true inventor, or person who actually invented or imported the invention into this country; but also that he shall have been "the *first* inventor thereof." And therefore, however clearly it might be shown in support of a patent, that the patentee had actually discovered or imported the invention, it would be of no avail, and the patent would be void if it should appear that, at the time when the grant was made, he was not also the *first* inventor.

Who is the first inventor.

But although the patentee is thus in terms required by the statute to be the first inventor, the words of the statute have been construed liberally for the benefit of the public, and so as to carry out the intent of the law; namely, to induce inventors to give the public the benefit of their discoveries and inventions as speedily as possible. And therefore it has been held, that *he* shall be deemed the first inventor of a new manufacture who shall *first* give, or contract by a patent to give, a knowledge of it to the public (*z*). And the circumstance of a patentee being the first to introduce an invention shows, *primâ facie*, that he was the first inventor (*z*).

Simultaneous applications for patents.

If two inventors were simultaneously to apply to the Crown for separate patents for the same invention, and both applications were to be referred to the same officer (*a*), the grant would be made to the person who could show that he had first made the invention. But few, if any, persons are in a position to prove by direct evidence that they have invented any thing,

(*y*) 21 James I. c. 21. s. 6.
(*z*) *Minter* v. *Wells*, 1 Webs. R. 131.
(*a*) See the Practice, *post*, Chapter XII.

much less the time when they made their inventions; and, indeed, if the evidence of the inventor himself be excluded, the only way in which it can be shown that any particular person made an invention, is by proof that he communicated a knowledge of it to some other person; and consequently the only proof which can be given that any person made an invention before any other person, is to show by legal evidence that he was the first to communicate a knowledge of it to some other person.

He who first obtains a grant is the first inventor.

But if the applications should happen to be referred by the Crown to different officers, the applicants might both obtain reports in favour of grants being made to them, and then the applicant who first obtains a grant will be entitled to the sole use of the invention. Thus, in the case of *ex parte Dyer* in Chancery, in 1812 (*b*), Lord *Eldon*, L. C., held, that in concurrent applications for a patent for the same object, that which obtains the Great Seal first will have the right at Law.

Prior invention immaterial.

And it has frequently been decided that it is no objection to a patent that some one made the same invention prior to the patentee, unless the world was also put in possession of it by its being made public before the date of the patent (*c*).

Dolland's Case.

In *Dolland's* case (*d*), it was objected that the patentee was not the (first) inventor of the new method of making object-glasses comprised in the patent, but that Dr. Hall had made the same discovery before him. But it was held that as Dr. Hall had confined the discovery to his closet, and the public were not acquainted with it, Dolland was to be considered as the (first) inventor.

Forsyth *v.* Riviere.

In the case of *Forsyth* v. *Riviere* (*e*), on the question of priority of invention, Lord Chief Justice *Abbott* held that, if several persons simultaneously discover the same thing, the party first communicating it to the public under the protection of letters patent becomes the legal inventor, and is entitled to the benefit of it.

Lewis *v.* Marling.

In the case of *Lewis* v. *Marling* (*f*), Mr. Justice *Bayley* said, "If I make a discovery and am enabled to produce an

(*b*) Holroyd, 59.

(*c*) See *Hill* v. *Thompson*, 1 Webs. R. 244; and per *Erskine*, J., in *Gibson* v. *Brand*, 4 M. & G. 198, 205.

(*d*) 2 H. Bl. 470, 487, and Davies' P. C. 172.

(*e*) Chit. Prerog. Cr. 182; 1 Webs. R. 97.

(*f*) 10 B. & C. 22; 1 Webs. R. 496.

effect from my own experiments, judgment and skill, it is no objection that some one else has made a similar discovery by his mind, unless it has become public. So, if I introduce a discovery *bonâ fide* made, I may have a patent for it, though a person might have privately a communication from abroad, which would have enabled him to have made the machine."

Carpenter v. Smith.

In the case of *Carpenter* v. *Smith* (*g*), Lord *Abinger*, C. B., said, that "A man is entitled to a patent for a new invention, and if his invention is new and useful, he shall not be prejudiced by any other man having invented that before, and not made use of it; because the mere speculations of ingenious men which may be fruitful of a great variety of inventions, if they are not brought into actual use ought not to stand in the way of other men equally ingenious, who may afterwards make the same inventions *and apply them*."

Patentee not first inventor, if invention known to the public.

But although a patentee's claim to be the first inventor of his invention will not be defeated by the prior discovery of the same invention by a person who kept it secret, it is otherwise if the invention was known or used by the public at any time before the date of the patent. For the public knowledge or use of an invention shows that some one must have given the invention to the public, and such a public knowledge or use of an invention comprized in a patent before the date of the patent, shows conclusively that the patentee was not at the time of the grant the first inventor of the invention.

Publication by an inventor is a dedication to the public.

If an inventor himself publishes a knowledge of his invention to the world, the law deems that he thereby dedicates it or gives it to the public; and when once the publication has been made, the act is irrevocable, and the Crown cannot afterwards grant the sole use of the invention either to the same or any other inventor. For the person who thus voluntarily gives the benefit of his invention to the public, becomes so far the true and first inventor of it, as to defeat the claim of any other person to be afterwards considered the true and first inventor of it.

Public cannot be deprived of the right to use an invention.

If the public once becomes possessed of an invention by any means whatever, no subsequent patent for it can be granted either to the true and first inventor himself, or any other person, for the public cannot be deprived of the right

(*g*) 1 Webs. R. 534.

to use the invention, and a patentee of the invention could not give any consideration to the public for the grant, the public already possessing every thing that he could give.

Stead v. Williams.

Thus in the case of *Stead* v. *Williams* (*h*), it was held that if an invention has already been made public by a description contained in a work, whether written or printed, which has been publicly circulated, in such case the patentee is not the first and true inventor within the meaning of the statute, whether he himself borrowed his invention from such publication or not, because the public cannot be precluded from the right of rising such information as they were already possessed of at the time the patent was granted (*i*).

Section V.

Of the Persons incapacitated from becoming Grantees of Patent Privileges.

What persons are incapable of being grantees.

It has now been shown that the grantee of a patent privilege, must be the person whom the law adjudges to be the true and first inventor of the art which is made the subject of the privilege, or the person from whom the consideration for the grant is obtained by the public. It only remains to be seen what persons are by law incapable of becoming grantees of such patent privileges.

Queen.

And first it seems that the Queen herself could not become the grantee of such a privilege, for she could not grant to herself.

Corporation aggregate.

Nor could a corporation aggregate become a grantee of a privilege for an actual invention, for invention is an act of the mind which clearly could not proceed from such a corporation. And even with respect to an imported invention, it seems difficult to conceive how such a corporation could become a grantee.

Corporation sole.

A corporation sole, *as such*, must also be incapable of becoming a grantee, for he must make the invention by his mind in his natural capacity; and in that capacity alone, therefore, could he become grantee.

(*h*) 8 Jur. 930.
(*i*) See also the cases cited in *Stead* v. *Williams*.

It may be doubtful whether the exercise of a patent privilege by a beneficed clergyman, would not be a trading within the meaning of the statute 57 Geo. III. c. 99 (*k*), and therefore prohibited by section three of that Act. And if that be so, it may be questionable whether the grant of a patent privilege to such a clergyman would not be void, because the Queen's intent, namely, that the patentee should derive a profit from the exercise of the privilege, cannot take effect.

Alien. There seems to be no reason why an alien may not hold such a privilege as grantee, and there are many instances of such privileges being granted to aliens. In one case (*l*), a question was raised at *nisi prius*, respecting the validity of a grant to a person in trust for an alien enemy; the question was reserved for the determination of the Court of Queen's Bench, but the patent was held to be bad upon a different ground, and the point was not determined.

Married woman. A married woman might, as an inventor, become the grantee of such a privilege; but the privilege, when acquired, would vest in her husband.

Infant. It is difficult to say what would be the effect of such a grant to an infant inventor, he could not exercise the privilege beneficially, for he could not buy or sell; or make any contract to bind himself. It is doubtful whether such a grant would be valid (*m*).

(*k*) See *Hall* v. *Franklin*, 3 M. & W. 259.

(*l*) *Bloxam* v. *Elsee*, 1 C. & P. 558; 6 B. & C. 169, *S. C.*

(*m*) For further information respecting persons who may and may not become grantees of any thing, see Co. Lit. 2, b; Shep. Touch. 234, 235.

CHAPTER IV.

OF THE GRANT OF A PRIVILEGE IN AN INVENTION BY LETTERS PATENT, AND THE CONSTRUCTION OF IT.

Queen's grants must be by record under the great seal.

By the Common Law the Queen can make a good gift of moveable chattels without writing (*a*), but no other grant by the Crown is available unless it be made by matter of record under the great seal (*b*); and this is required by reason of the person of the Queen, and the dignity of her office (*c*).

Charters or letters patent.

The grants of the Queen must be made by *charters* or *letters patent* under the great seal, and they are matters of *public* record (*d*).

Great seal.

The seal under which these grants of the Crown were formerly made was the great seal of England; after the union with Scotland the great seal of Great Britain; and now since the union with Ireland the great seal of the United Kingdom (*e*).

Great seal in custody of Lord Chancellor.

Sir Edward Coke calls the great seal *clavis regni*, or key of the kingdom (*f*); and it is always in the custody of the Lord Chancellor, or of commissioners appointed for the purpose.

Stat. 6 Ann. c. 7. s. 9.

By the statute of 6 Ann. c. 7, s. 9, it was enacted that the great seal and other public seals in being at the time of the demise of her Majesty, or any of her successors, should continue and be made use of as the respective seals of the successor until such successor should give order to the contrary.

All persons bound to take notice of the great seal.

In the case of the *East India Company* v. *Sandys* (*g*), it is laid down that "all the King's subjects are bound to take notice of the King's great seal." And, therefore, it is that the

(*a*) Vin. Abr. Prerog. (M. b. 7.)

(*b*) Com. Dig. Pat. (C. 2); *Lane's* case, 2 Co. R. 16, b; Moor, 476; 2 Rol. Ab. 182, l. 5; Bro. Ab. Prerog. 70; Noy, Dialog. Tenures, p. 33.

(*c*) *Owen* v. *Saunders*, 1 Ld. Ray. 163; Dr. & Stud. Dialog. i. c. 8. p. 34.

(*d*) Bro. Abr. Prerog. 70, 95; Com. Dig. Pat. (A.); 3 Lev. 223; 2 Bl. Com. c. 21, s. 2; Noy, Dialog. Tenures, p. 34.

(*e*) See the case of the *King* v. *Bullock*, 1 Taunt. 71; and the *King* v. *Yandell*, 4 T. R. 521.

(*f*) 2 Inst. 552.

(*g*) Skin. 225.

great seal shall always be credited (*h*), and can never be denied (*i*).

Saving in Stat. of Monopolies extends only to letters patent.

The saving of the prerogative of the Crown, contained in the 6th section of the Statute of Monopolies, is in accordance with the Common Law upon the subject, for it extends only to *letters patent* and grants of privilege of the description which form the subject matter of this work (*k*). And, therefore, the sole use of an invention can only be granted within the meaning of the statute (*k*) by letters patent; and as such letters patent must, according to the Common Law, be under the great seal, they must also be written on parchment (*l*).

Letters patent.

"Letters patents, that is, open letters, *literæ patentes*, are so called because they are not sealed up, but exposed to open view, with the great seal pendant at the bottom, and are usually directed or addressed by the Queen to all her subjects at large" (*m*). And letters patent, or in common parlance, a patent such as forms the subject of this work, may be correctly defined an open record under the great seal, containing a grant of privilege in an invention made by the Crown to an inventor.

Record.

A record in our law is defined to be a memorial of an act or proceeding of a Court of record proceeding according to the course of the Common Law, entered on parchment for the preservation of it (*n*).

Lord Chancellor sole judge of matters of law in Chancery.

The Lord Chancellor is the sole judge of the Common Law branch of the Court of Chancery, in which all the Queen's letters patent are made (*o*); and the making of letters patent by the Lord Chancellor, by affixing the great seal to them, is an act of the Court of Chancery, by which the Court makes a record of the Queen's grant, that is, makes her letters patent, containing her grant, in pursuance of her command.

Making a patent a judicial act.

Queen cannot herself make a patent.

The Queen cannot herself make her letters except by means of her ministers, who act according to her legal commands. The command given to the Lord Chancellor to make a patent for an invention is always made by means of a writ or bill, sealed with the privy seal; and, therefore, when the patent

(*h*) Ben. & Dal. 19.
(*i*) 4 Co. R. 71, b; Doct. plac. 352; Plow. 232.
(*k*) 21 Ja. 1. c. 3, s. 6.
(*l*) 3 Shep. Abr. Prerog. p. 93.
(*m*) 2 Bl. Com. c. 21, s. 2.
(*n*) Com. Dig. Record (A.); 3 Inst. 71.
(*o*) 4 Inst. 79, 80, 84; 1 Shep. Abr. 464.

has been written, the words, "By writ of Privy Seal," are subscribed, in order to show by what authority the Lord Chancellor seals the grant (*p*).

Queen's command only extends to what may be done lawfully.

But, notwithstanding the Queen's authority or command to make letters patent, the Lord Chancellor cannot knowingly affix the great seal to a grant which will be contrary to law; for the Queen cannot do, or intend to do, any thing wrong (*q*); and, therefore, the command must be construed to be made conditionally upon the Lord Chancellor deeming the grant to be lawful. And if the Chancellor is of opinion that the proposed grant would be illegal or unjust, or that for any reason it ought not to be made, he will not seal the patent (*r*).

Patent delivered to grantee.

The original letters patent are always delivered out of Chancery to the patentee, as his evidence of his title to the grant which they contain, and therefore they are enrolled; that is,

Enrolment.

the grants which they contain are entered upon rolls called the Patent Rolls, in order that the records of the Court of Chancery may at all times show what patents the Lord Chancellor has made in pursuance of the Queen's writs (*s*). These

Rolls are records to which all persons may have access.

rolls are themselves records to which all persons may have access (*t*), and every one is bound to take notice of the grants so enrolled (*u*).

Queen protected by law in making her grants.

The Queen in making her grants is under the especial protection of the law, the reason of which seems to be, that she being so much occupied with public affairs, cannot be supposed to give the same attention to her grants as private persons can give to theirs (*x*); and that the whole community has an interest in the Queen, and the grants which she makes, more particularly those which she makes in her public capacity.

Ordinary rules of construction inapplicable.

The ordinary rules which are to be observed in the construction of grants made by private persons do not necessarily apply to the construction of grants by the Crown.

Rules respecting the Queen's grants.

And accordingly we find it laid down in our law books, that,

(*p*) 2 Bl. Com. p. 347; 8 Co. R. 18, b; and see the Forms and Practice in a subsequent part of this work.

(*q*) Vide 3 Shep. Abr. 48; Jenk. Cent. 9, case 16; 1 Co. R. 44, b, 45, b.

(*r*) See 2 Inst. 566; and the Practice, *post*.

(*s*) Vide 3 Shep. Abr. 93 (7); Com. Dig. Pat. (E.)

(*t*) 1 Co. R. 45, a; 3 Inst. 71; and see the stat. 46 E. III. printed in the Preface to the 3rd part of Coke's Reports, p. vi.

(*u*) 1 Co. R. 45, a.

(*x*) Godb. 295; 1 Co. R. 52, a.

as the Queen's grants proceed chiefly from her own bounty, and her letters patent are records of a high nature, they ought to contain the utmost truth and certainty, and have in all times been construed most favourably for the Crown (*y*), and that contrary to the construction put upon the grants of common persons (*z*); and accordingly in a great variety of cases we find, that uncertainty, misrecitals, false suggestions, and all such matters as show that the King was deceived in his grants, held to be sufficient reasons to vitiate the grants (*a*). But it seems that where the Queen proceeds by and with the advice of parliament, she is not in that situation in respect of which she is under the special protection of the law, that she could be considered as deceived in her grant (*b*).

False suggestion avoids a patent.

If the grant of the Queen be founded upon a false suggestion, it will be void, because the Queen has been deceived (*c*). And if the Queen be misinformed (*d*), or be deceived in her grant, and grant more than she lawfully may, the whole grant will be void (*e*). So the grant of the Queen will be void for a misrecital (*f*), or for want of form (*g*), or for uncertainty (*h*), or if too general (*i*).

The material parts of a patent for granting a sole privilege in an invention will now be considered in the following order:—

1st. The address or direction.

2nd. The recitals.

3rd. The grant to the inventor.

4th. The prohibition to others.

5th. The conditions of the grant.

(*y*) Plow. 333; 1 Co. R. 45, a; 8 Co. 56, a; Bac. Abr. Prerog. (F. 2), p. 514; Com. Dig. Grant (G. 12).

(*z*) See Bac. Abr. Grant (I. 1); Shep. Touch. 83; 3 Atk. 136; *Swan* v. *Fonnereau*, 3 Ves. 41, 48.

(*a*) Vin. Abr. Prerog. (G. b. 2); Bac. Abr. Prerog. (F. 2); Com. Dig. Grant (G. 6, 7, 8 and 9).

(*b*) Per Lord C. J. *Eyre*, in *Boulton* v. *Bull*, 2 H. Bl. 500.

(*c*) Com. Dig. Grant (G. 8 and 9); *Earl of Devon's* case, 11 Co. 90, a; Vin. Abr. Prerog. (N. b. 1.)

(*d*) 1 Co. R. 52, a.

(*e*) Com. Dig. Grant (G. 8); case of *Allen Woods*, 1 Co. R. 49, a; Vin. Abr. Prerog. (G. b. 2.)

(*f*) Moore, 318; Hob. 224.

(*g*) Hob. 323; Vin. Abr. Prerog. (G. b. 2.)

(*h*) 2 Rol. Abr. 196, l. 30; Com. Dig. Grant (G. 6); Vin. Abr. Prereg. (G. b. 2); per *Heath*, J., in *Boulton and Watt* v. *Bull*, 2 H. Bl. 483.

(*i*) 2 Rol. Abr. 193, l. 41.

1st. *Of the Address or Direction.*

Commencement.

Letters patent always commence with the style (*k*) of the Queen, and a general direction or address in the following form:—

"Victoria, by the Grace of God of the United Kingdom of Great Britain and Ireland, Queen, Defender of the faith: to all to whom these presents shall come, greeting."

Must be in Queen's name.

Letters patent commence in the name of the Queen, because although they are made by the Court of Chancery, yet they cannot be made without the Queen's writ, and the grant is the Queen's grant, made by her as the head of the executive government, acting with the advice of her ministers, on behalf of the whole community; and the grant must be made in her name in order that the authority by which the privilege or monopoly is created and granted, may be thus announced to all those who reside within that part of the Kingdom to which the patent privilege extends.

Directed to all persons.

Letters patents are directed to all persons to whom they shall come, because they contain bargains made between the public and the patentees (*l*); they are public records, and all persons are bound to take notice of the grants which they contain (*m*), and no one can excuse himself from the consequences of infringing a patentee's privilege by alleging that he was ignorant of its existence.

Chancery always open.

The Court of Chancery is always open, and any one upon payment of a small fee may have free access to peruse the enrolment of any patent (*m*), and may also procure an office copy of it.

2nd. *Of the Recital.*

Petition recited.

The recital in a patent always contains a short statement of the substance of the inventor's petition, and the motive of the Queen in making the grant.

(*k*) See as to the styles formerly used by the Kings of England in letters patent, &c., Co. Lit. 7, a, 7, b; 2 Inst. 1.

(*l*) 14 Ves. 131, 136.

(*m*) 1 Co. R. 45, a; 1 Skin. R. 225; 4 Co. R. 71, b; 6 Co. R. 15, b.

It has already been shown that an inventor is not entitled to a patent as of right, but only by the grace and favour of the Crown, acting on behalf of the public (*n*). Inventor not entitled as of *right*.

And the Queen cannot have knowledge of an invention having been made until she is informed of the fact by the inventor; for until he applies for a patent, he keeps a knowledge of the invention from all the world. Queen cannot have knowledge.

Every person, therefore, who desires to secure to himself the sole use of any new manufacture which he has invented, must apply by petition to the Crown for a grant of privilege. The petition is the foundation of the proceedings by which an inventor is to acquire the exclusive privilege which he seeks to obtain, and as the Crown acts and proceeds upon the representations contained in the petition, the petition is always recited or stated in the patent. Inventors must petition.

The Queen ought always to be correctly informed respecting the subject-matter of her grants, so that she may not be deceived, and so fail in her intent (*o*).

Every petition to the Queen for a grant ought therefore to be strictly correct, and for this reason it has always been the practice to require a petition for a patent to be verified; and as none can know the facts stated but the petitioner himself, no other person can verify them. The verification was formerly by the petitioner's oath; but in pursuance of a recent statute (*p*), it is now by solemn declaration made before a Master in Chancery. Petition must be correct and be verified.

A petition to the Crown for such letters patent must state the name and addition of the petitioner, the title of the invention, and the grounds upon which the petitioner asks for the favour of the Crown, which is in substance that he has discovered or imported the invention for which he desires a privilege, that he believes it to be of public utility, and new in England (*q*). What a petition must state.

The effect of the petition is generally recited very shortly in the letters patent, as in the following example:—

"Whereas James Gowland, of Leathersellers Buildings, in the City of London, Chronometer Maker, hath by his petition humbly represented unto us that he hath invented certain Recital.

(*n*) Vide *ante*, Chapter I. p. 4.
(*o*) 1 Co. R. 52, a.
(*p*) 5 & 6 Will. IV. c. 62, s. 11.
(*q*) See the Practice and Forms, *post*.

improvements in the mechanism of timekeepers, that he is the first and true inventor thereof, and that the same has never been practised by any other person or persons whomsoever to his knowledge or belief: the petitioner, therefore, most humbly prayed that we would be graciously pleased to grant to him, his executors, administrators, and assigns, our royal letters patent under the Great Seal of the United Kingdom of Great Britain and Ireland, for the sole use, benefit, and advantage of the said invention within England, Wales, and Town of Berwick-upon-Tweed, for the term of fourteen years, pursuant to the statute in such case made and provided." And then, after mentioning the motive of the grant, it is stated that the Queen is "graciously pleased to condescend to the petitioner's request."

Misrecital avoids a patent.

As a misrecital avoids a patent; if the recital of the inventor's petition be untrue in any material particular, the whole patent will be void (*q*). The patentee being a party to the grant made by the patent, is bound by the recital, and estopped from denying any thing it alleges. And even if it did not appear in the recital itself that the matters recited had been represented to the Crown by the patentee, yet it would be deemed in law that the matters recited had been suggested to the Crown by the grantee (*r*). It is the duty of every petitioner to the Crown for a grant to take care that the Queen is correctly informed respecting the subject-matter of the grant (*s*), for it is a maxim that the Queen cannot deceive, and must not be deceived (*t*). The representations contained in a petition are made at the petitioner's own peril; and if the information or suggestion to the Crown be false, neither the Queen or any one suing in her name is prevented by the recital in the patent from showing that it is so, and the grant made upon such false information will be absolutely void (*u*). And that not only as against the Crown, but as against third persons (*x*).

Matters recited must be deemed to have been suggested by the patentee.

Representations are made by a patentee at his own peril.

It is not every mistake that will avoid a patent.

But it is not every false recital that will vitiate a grant by patent if the Queen's intent sufficiently appears. Thus where

(*q*) Vin. Abr. Prerog. (Q. b.); 1 Co. R. 43, a.
(*r*) 6 Co. R. 55, b.
(*s*) 1 Co. R. 52, a.
(*t*) Jenk. 18.
(*u*) 1 Co. R. 43, a; Com. Dig. Grant (G. 8, G. 9).
(*x*) *Morgan* v. *Seaward*, 2 M. & W. 544; *Alcock* v. *Cook*, 5 Bing. 340.

a grant was made to a person as a knight, who in truth was no knight; yet, as the identity of the person of the grantee sufficiently appeared, the grant was good. This was decided by the House of Lords in the case of the King and the Bishop of Chester, reversing the judgment of the Court of King's Bench (*y*).

Recital states the inventing or importing of invention.

The recital begins by stating that the patentee has alleged that he has invented the invention described in the title which follows. Or, if the invention has been imported from abroad, that the patentee is in possession of the invention in consequence of a communication from a foreigner, or words of a similar import.

And if either of these representations, being recited in a patent, is untrue in any particular, the patent will be held void in consequence of the Queen having been deceived (*z*).

Title is stated *in recital only.*

The title of the invention always appears in the recital, and in no other part of the patent; and the general vague description which the title gives is all the information which can be obtained from the patent respecting the nature of the invention granted.

Ancient patents described the invention.

In the patents which were granted before the time when a specification began to be required, the nature of the invention was fully recited (*a*), and a patent without such a recital would most probably be held void if it did not contain a proviso dispensing with it by reason of the grant being too general, and not sufficiently certain (*b*). And accordingly we shall see that in all modern patents there is a provision inserted that they shall be good, notwithstanding the want of a full description of the nature of the invention (*c*).

Title is the language of the patentee.

The language in which an invention is described in a patent is the language of the patentee himself (*d*).

Title must accurately describe *invention.*

The title of an invention ought accurately to describe the nature of it; it must not be too large so as to include any thing more than the patentee has actually invented, and it must not be too narrow, so as to exclude any part of the invention.

(*y*) See the case reported, 2 Salk. 560; 5 Mod. 297; Show. P. C. 212.

(*z*) See Chap. III. p. 21.

(*a*) See one of those patents in 1 Webs. R.

(*b*) See Vin. Abr. Prerog. (C.c.) (F.c.)

(*c*) Vide *post*, in this Chapter.

(*d*) *The King* v. *Wheeler*, 2 B. & Ald. 349.

Accuracy of description is required in order to prevent either the Crown or the public from being deceived. In the

Campion v. Benyon.

case of *Campion* v. *Benyon* (*e*), in the Court of Common Pleas, it was laid down that a patent being a limited monopoly, an infringement on the rights of the public, and operating as a prohibition to persons in future from adopting the precise mode used by the patentee, it should be in precise and unambiguous terms, and describe with accuracy what the inventor claims as his own, as well as the precise extent of the privileges conferred on him by such patent. And that if there be any ambiguity in the patent in any material point, that is of itself a ground for rendering the patent absolutely void. And

Hill v. Thompson.

the same law is laid down in the case of *Hill* v. *Thompson* (*f*), in which Mr. Justice *Dallas* said, in delivering the judgment of the Court of Common Pleas, "This, like every other patent, must stand on the ground of improvement or discovery. If of improvement, it must stand on the ground of improvement invented; if of discovery, it must stand on the ground of the discovery of something altogether new; and the patent must distinguish and adapt itself accordingly. If the patent be taken out for discovery, when the alleged discovery is merely an addition or improvement, it is scarcely necessary to observe, that it will be altogether void."

R. v. Metcalf. A misdescription is fatal.

In the case of the *King* v. *Metcalf* (*g*), which was a *scire facias*, brought to repeal a patent obtained by the defendant for the manufacture of hair brushes, which were described to be *tapering brushes*, it appeared, that according to the defendant's mode of manufacturing brushes the bristles would be of unequal lengths, whereas, according to the usual mode, the bristles are of the same length. Lord *Ellenborough*, C. J. held this misdescription in the title of the patent to be fatal, and directed the jury to find a verdict for the Crown, which the Court of Queen's Bench afterwards refused to disturb.

R. v. Wheeler.

A similar objection was fatal to a patent in the case of the *King* v. *Wheeler* (*h*), which was a *scire facias* to repeal a patent obtained by the defendant for "a new or improved method of drying and preparing malt." The specification described the invention to consist in so heating malt that it should

(*e*) 6 B. Mo. 81; 3 B. & B. 5, *S. C.*
(*f*) 8 Taunt. 394.
(*g*) 2 Stark. R. 249.
(*h*) 2 B. & Ald. 345.

become of a deep brown colour, and be readily soluble in hot or cold water. At the trial Lord C. J. *Abbott* thought that the title of the patent showed that it was obtained for a different thing than that stated in the specification, the patent being for a method of preparing malt, which must mean making it from barley, whereas the specification appeared to be for drying malt already made; and his Lordship directed the jury to find a verdict for the Crown. And the Court of Queen's Bench being of opinion that the invention mentioned in the specification was entirely different from that mentioned in the patent, refused to grant the defendant a new trial. It was contended on the part of the defendant in this case, that the process was in truth a preparation of malt to answer a particular purpose (the colouring of beer and porter), and that the purpose need not be noticed in the grant. But the Court said, that although it may be true in general that the purpose need not be mentioned in the grant, yet, if in any particular case the mention of the purpose be necessary to explain the words previously used, to show that they were not used in their ordinary and obvious sense, but in a sense limited and confined to that particular purpose; in such a case the purpose ought to be mentioned. If the patentee had represented himself to be the inventor of a method of preparing malt for the purpose of colouring beer and porter, every person who read his representation, would have understood that the malt prepared, according to his method, was not intended to answer the common and known purposes of that article, *viz.*, the brewing of beer, but was intended only for the special and particular purpose of colouring the liquor, and to be used in addition to common malt. And the Court was of opinion that no person could conjecture that to be the object of the invention mentioned in the patent.

Misdescription as an improvement.

So if the description contained in the title represent the invention to be an improvement in any particular manufacture or process, and it appears it is no improvement at all, or no improvement in the thing named, or in any of several things named, the patent will be void by reason of the Queen having been deceived (*i*).

Misrepresentation.

And if the title or description of the invention allege that

(*i*) *Morgan* v. *Seaward*, 2 M. & W. 544.

it is applicable to any particular purpose, and it turns out that it is not applicable in the way suggested, the patent would be void for the same reason.

Felton v. Greaves.

Thus in the case of *Felton* v. *Greaves* (*k*), the title of the plaintiff's patent described the invention to be a machine for giving a fine edge to knives, razors, scissars, and other cutting instruments; but it appeared that the invention, as described in the specification, was inapplicable for the sharpening of scissars; and Lord *Tenterden*, C. J., therefore held the patent to be void, and nonsuited the plaintiff.

But in the case of *Nickels* v. *Haslam* (*l*), in which the title of the invention was "improvements in the manufacture of plaited articles," and it appeared that the invention, as described in the specification, consisted of a single improvement only, it was held that the title was sufficient.

Generality of title no objection.

The generality of the terms in which a title describes an invention, appears to be no objection to the patent, if the description is not in any respect inaccurate (*m*). The description must, however, unquestionably give some idea, and so far as it goes, a true idea of the alleged invention (*n*).

Title so large as to be calculated to deceive is bad.

It has been held that if a title is so large and indefinite in its terms as to be calculated to deceive any person reading it, as to the extent or object of the grant, it will render the patent void. Thus in the case of *Cochrane* v. *Smethurst* (*o*), it appeared that the plaintiff's patent was for an improved method of lighting cities, towns, and villages; but his invention really was an improved street-lamp: and it was held by Mr. Justice *Le Blanc* that the title was too general in its terms, and the patent void.

Cochrane v. Smethurst.

Campion v. Benyon.

So in the case of *Campion* v. *Benyon* (*p*), it appeared that the plaintiff had obtained a patent for "a new and improved method of making canvas and sail-cloth with hemp and flax, or either of them, without any starch whatever." The invention really was a new mode of preparing and twisting the hemp or flax for making the canvas and sail-cloth, and the Court of Common Pleas held that the title was too extensive, and that the patent was therefore void.

(*k*) 3 C. & P. 611.
(*l*) 8 Scott, 97.
(*m*) *Cook* v. *Pearce*, 7 Jur. 499; see per Lord *Abinger*, C. B., in *Neilson* v. *Harford*.
(*n*) *Sturz* v. *De la Rue*, 5 Russ. 324.
(*o*) 1 Stark. R. 205.
(*p*) 6 B. Mo. 71.

The generality of the words in a title may be restrained and explained by the specification; and it is clear that for many purposes the specification must be considered as part of the patent itself.

Generality of title restrained by specification.

A specification cannot, however, extend the meaning of the title so as to make the grant include any thing not within the natural and ordinary meaning of the language made use of in the patent to describe the invention. And we shall see hereafter (*q*) that the claim in the specification of any thing not within the true extent and meaning of the grant will render the patent itself absolutely void.

Specification cannot extend the title.

After giving the title or description of the invention from the patentee's petition, it is generally farther recited that the patentee had represented that he was the true and first inventor; and that the invention was new, or had not been practised before to his knowledge or belief; and it is sometimes added that the petitioner believes the invention to be of public utility.

Recital that patentee the true and first inventor.

As the Crown in granting the sole use of an invention acts upon such representations, and confiding in the truth of them makes the grant; if either of those representations be untrue the patent will be void (*r*).

The recital then shows that the patentee humbly prayed for a grant of the patent, and that for the motive or consideration mentioned (and nextly to be considered) her Majesty was "graciously pleased to condescend to the petitioner's request."

Prayer for patent.

These words show most clearly that the grant is made (as indeed it necessarily must be) upon the petition and representation of the grantee. And these words diminish the force of the words "of our especial grace, certain knowledge, and mere motion (presently to be noticed) (*s*), for a patent shall not be taken to proceed from the grace of the Queen merely, and so to be taken more strongly against the Queen, and in favour of the patentee, unless it is merely of the motion of the Queen, and without suit of the party (*t*).

The concluding part of a recital in a patent for an invention is, that her Majesty "being willing to give encouragement to

Conclusion of recital.

(*q*) *Post*, Chap. VII.
(*r*) Vide *post*, Chap. V. s. 2 & 3.
(*s*) Vide *post*, in this Chapter.
(*t*) Plow. 337.

all arts and inventions which may be for the public good," is pleased to grant the petitioner's request for a patent.

Recital shows the motive and intended consideration.

These words show the motive or intent of the Queen in making the grant, and the whole of the recital taken together shows that the consideration which the Queen intended to have was a new and useful invention made by the patentee.

Patent to be construed according to intent.

It is a rule that the letters patent of the Queen are to be construed according to her intent, and that if they cannot take effect, according to her intent expressed in the letters patent themselves, they are void (*t*).

If Queen deceived in consideration, grant void.

And if the Queen be deceived in the consideration which she intends to have, the grant is void (*u*). For it is a maxim that if the consideration, which is for the benefit of the Queen (or of her subjects), be it executed or executory, or be it on record or not on record, be not true or not duly performed, or if any prejudice may accrue to the Queen (or her subjects), by reason of the non-performance of it, the letters patent are void (*x*).

Every part of consideration must be given.

Every part, therefore, of the consideration which the Queen appears by a patent to intend to have for her grant of the sole use of an invention, must be actually given and performed according to the intent of the Queen, as it appears in the patent.

If patentee not inventor patent void.

Thus, if the statement in the petition (as recited) that the patentee had invented the invention mentioned, or that he is true and first inventor thereof, be untrue, the Queen is deceived as to the consideration which she intended to have from the grantee, and the grant will be void (*y*).

So if the Queen be deceived in any of the particulars already mentioned, she does not receive the consideration she intends, and the grants upon such false considerations will be void.

If invention not new, patent void.

And if the allegation that the invention was new, or had not been used in this kingdom, be untrue, the patent cannot be sustained. And if the allegation be untrue in any respect, as if any part of the invention comprised in a patent was not new, although the remainder of it was so, yet the whole grant will be void.

(*t*) 1 Co. R. 46, a.
(*u*) Vin. Abr. Prerog. (M. c.)
(*x*) 5 Co. 94, a.
(*y*) Vide *ante*, Chap. III.

This was determined in the case of *Brunton* v. *Hawks* (*a*), in which the patent was for improvements in ships' anchors, windlasses, and chain cables; and it having been proved that the alleged improvements in anchors were not new, the Court of King's Bench held that the patent was void, although the other parts of the invention were new. In that case, Lord Chief Justice *Abbott* said (*b*), "It is quite clear that a patent granted by the Crown cannot extend beyond the consideration of the patent. The King could not, in consideration of a new invention in one article, grant a patent for that article and another." And, speaking of the patent in that case, his Lordship said, "The patent is granted upon the recital that he (the patentee) has made improvements in all the three (articles), and that they are new; and the consideration of the patent is the improvement in the three articles, and not in one; for an improvement in only one of them would render the patent bad. The consideration is the entirety of the improvement of the three, and if it turns out there is no novelty in one of the improvements, the consideration fails in the whole, and the patentee is not entitled to the benefit of that other part of his invention." And in the same case, Mr. Justice *Bayley* said (*c*), "If a patent is taken out for many different things, the entire discovery of all those things is the consideration upon which the King is induced to make the grant. That consideration is entire, and if it fails in any part it fails *in toto*." Brunton v. Hawks.

So it was held by the Court of Common Pleas, in the case of *Hill* v. *Thompson* (*d*), that if any part of an alleged discovery comprised in a patent, being a material part, fail, (the discovery in its entirety forming one entire consideration,) the patent is altogether void. Hill v. Thompson.

In the case of *Kay* v. *Marshall* (*e*), it was held that whether an invention comprised in a patent is to be considered as one entire invention, or divided into distinct parts, yet if part of what is claimed by the patentee is not properly the subject of a patent, or not new, the whole grant must be void. And the same law was laid down by the Court of Exchequer in the case of *Morgan* v. *Seaward* (*f*). Kay v. Marshall.

(*a*) 4 B. & Ald. 541.
(*b*) 4 B. & Ald. 551.
(*c*) 4 B. & Ald. 552.
(*d*) 8 Taunt. 401.
(*e*) 5 Bing. N. C. 492.
(*f*) 2 M. & W. 544.

3rd. *Of the Granting Part of the Patent.*

Grant.

After the recital in a patent for an invention follow the words, "know ye therefore that we of *our especial grace, certain knowledge, and mere motion*, have given and granted," &c.

Grants upon petition construed more strictly.

But with words of grace and bounty more favourably.

Grants made by the Crown merely upon the petition of the grantee, have always been construed with much greater strictness than those which proceed from the Crown voluntarily, and without suit from the grantee. For this reason the words "of an especial grace, certain knowledge, and mere motion," have long been inserted in patents in order that they may be construed more favourably for the grantees.

Meaning of words "especial grace."

The words "of our especial grace," import that the grant in a patent proceeds merely from the grace and bounty of the Crown, the grantee having no right or title to the grant except through the favour of the Crown.

"Certain knowledge."

The words "certain knowledge," in a patent, imply that the Queen has knowledge of the subject-matter of the grant, and if there was no recital, these words would show that the Queen was acting upon certain knowledge, which she possessed independent of the representation of the grantee (*g*).

"Mere motion."

And the words of our "mere motion," import that the grant proceeds from the bounty of the Queen of her own mere motion, and without any suit of the grantee (*h*).

Construction of patent with such words.

The words "of our certain knowledge and mere motion," cause the Queen's grants to be taken in the most liberal and beneficial sense, according to the Queen's intent and meaning expressed in the grant (*i*); and a grant with these words is taken more strongly against the Crown, and in favour of the grantee, than other grants are construed to operate (*k*).

Patent cannot be reduced to the same level of construction as a private grant.

But it seems that the words "of our especial grace, certain knowledge, and mere motion," will not reduce a royal grant to the same standard of construction as the grant of a subject, or bring it within the principle that it is to be taken most strongly against the grantor (*l*). For notwithstanding these

(*g*) See Vin. Abr. Prerog. (E. c. 3); 10 Co. 112, b.
(*h*) See 10 Co. 112, b.
(*i*) Bro. Abr. Pat. pl. 80; 6 Co. 56, a.
(*k*) Com. Dig. Grant (G. 12.); 1 Co. R. 45, b.
(*l*) *The King* v. *Capper*, 5 Price, 261; 1 Co. R. 46, a, 46, b.

words the Queen's grant must be construed according to her intent as it appears in the letters patent, and not in deceit of the Queen, or so that any thing shall pass by the grant against the intent or purpose expressed in the patent, or so as to make any thing pass which is not actually expressed in the grant (*m*). So it is laid down in the case of *Alton Woods* (*n*), that in many cases the King's grants "*of his certain knowledge and mere motion*," shall be construed beneficially for the patentee, yet such words shall never produce a violent or strained construction, or any construction which is against the intent or purpose of the grant.

Needler v. Bishop of Winchester.

It was laid down in the case of *Needler* v. *The Bishop of Winchester* (*o*), that when the King makes a grant expressed to be of his own mere motion, and yet expresses a consideration, not personal, moving him to make the grant, and the consideration is false,—since these are contrarieties and cannot stand together,—the law shall judge upon the consideration, and shall not regard the clause, "of his own mere motion," which is *clausula clericorum*, but shall reject that as the Court does the opinion of the Jury when they find the fact, and conclude upon it contrary to law.

Petition diminishes the force of the words of grace, &c.

The recital in every patent for an invention, shows that the grant was made upon the petition of the patentee, and this diminishes the force of the words "of our especial grace," &c., for the patent cannot be taken to proceed purely from the grace and favour of the Queen; and a grant by patent cannot be construed more strongly against the Que and favourably for the patentee, unless it is made merely of the Queen's own motion, and without the suit or petition of the patentee (*p*).

Untrue suggestion cannot be cured.

And if the matters recited in the patent are untrue, so that it appears that the Queen was deceived in any respect, either by the false suggestion of the party, or as to the consideration or motive of the grant, the patent will be wholly void. For the words "of our especial grace," &c., are of no effect or operation if the Queen has been deceived, or if the intent or purpose of her grant cannot by law take effect (*q*). These words are words of bounty and of great effect, if the Queen be not

(*m*) 1 Co. R. 46, a, 46, b; Plowd. 333.
(*n*) 1 Co. R. 49, a, 52, b, 53, a.
(*o*) Hob. 221-222.
(*p*) Plowd. 337.
(*q*) 1 Co. R. 51, b.

deceived in the intent or purpose of her grant, but they shall never be of force to maintain a grant in deceit of the Queen (*r*).

Words of grant.

The next material words in the patent for an invention are "have, given, and granted, and by these presents, for us, our heirs and successors, do give and grant unto the said James Gowland, his executors, administrators, and assigns," &c.

The object of inserting the words "for us, our heirs and successors," is to show that the grant is not intended to exist merely during the life of the reigning sovereign, but is to continue in force during the whole of the term granted, notwithstanding the demise of the Crown. The grant would, however, it seems, be binding upon the Queen's successor without those words (*s*).

Crown acts on *behalf of the* public.

In making a patent for an invention, the Crown, in pursuance of the prerogative vested in it by law for the general benefit of the community, makes the grant *on behalf of the public* for the consideration which has already been adverted to, and the benefit of which the public are to have (*t*).

The words "give and grant" are the proper operate words in a patent for an invention not only as respects the Queen, who is the grantor, but also the nature of the thing which is granted (*u*).

Grant must be made to inventor.

The grant must be made to the inventor of the invention, or to the importer of it, if it be a foreign invention, and to no other person can such a grant be legally made (*x*).

Subject of grant.

The subject of the grant, as expressed in a patent for an invention, is the Queen's "especial licence, full power, *sole* privilege and authority, that he the said *J. G.*, his executors, administrators and assigns, and every of them, by himself and themselves, or by his or their deputy or deputies, servants or agents, or such others as he the said *J. G.*, his executors, administrators, or assigns, shall at any time agree, and no others, from time to time, and at all times hereafter, during the term of years herein expressed, shall and lawfully may make, use, exercise, and vend his said invention within that part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and Town of Berwick-upon-

(*r*) 1 Co. 53, a.
(*s*) Com. Dig. Grant (G. 3).
(*t*) Per Lord *Eldon*, L. C., in *Harmer* v. *Plane*, 14 Ves. 132.
(*u*) Shep. Touch. 228.
(*x*) Vide *ante*, Chapter III. p. 21. 26

Tweed, and also in the Islands of Guernsey, Jersey, Alderney, Sark, and Man, and in all our colonies and plantations abroad, in such manner as to him the said *J. G.*, his executors, administrators and assigns, or any of them shall, in his or their discretions, seem meet; and that he the said *J. G.*, his executors, administrators and assigns shall, and lawfully may have and enjoy the whole profit, benefit, commodity, and advantage from time to time coming, growing, accruing, and arising by reason of the said invention, for, and during the term of years herein mentioned."

Subject of grant is a privilege.

The subject of the grant thus made by the patent is a sole and exclusive privilege (*y*) which extends to the using and exercising of the invention or art invented by the patentee; to the making of articles by means of the invention, or the exercise of it;—and to the vending of such articles to the public.

The patentee does not acquire the privilege of using his invention by means of the grant made to him by his patent, for an inventor would have a right to use his invention independent of the grant contained in the patent. But he could not exercise that right publicly without putting others in possession of his invention, and thus giving them a right to use it; for we have seen (*z*) that a public use of an invention, without previously obtaining a patent for it, amounts to a dedication of it to the public. The use of an invention under the protection of a patent is a dedication to the public only from the end of the term granted by the patent, and the privilege granted by the patent is a right to use the invention to the exclusion of all other persons, or, more correctly speaking, a right to exclude all others from the use or exercise of the invention during the patent term. By means of such a privilege an inventor is enabled to use his invention publicly, and thus acquire the profit intended to be given him as a reward, without giving the public any right to use the invention before the expiration of the term granted by the patent.

Construction of the word "make" in the patent.

According to the terms of the grant contained in the patent the inventor is to have the sole privilege of *making* his inven-

(*y*) As to the nature and disposition of this privilege, see Chapter IX.

(*z*) *Ante*, Chapter III. p. 33.

tion; but it seems clear that the word make must not here be understood in its ordinary sense.

One signification of the word "make," is to practise or to use, put in action (*a*), and the word seems to be used in that sense in the patent. The use of the word in any other sense in this place would indeed be repugnant; for *making* an invention in the other sense of the word *make*, would signify an inventing or discovering, which is clearly not what is intended.

The sole privilege of making the invention as expressed to be granted by the patent, is in truth the same in substance as the sole privilege of using and exercising it; but it is clear that such an exclusive right must necessarily extend to and include the sole privilege of making articles by the use or exercise of art invented by the patentee, and it is most probable that when the form of patent was first drawn, the sole privilege of making an invention was intended to signify the sole privilege of exercising the invention in the making of articles of manufacture.

Statute of Monopolies, sec. 1 and 6.

By the first section of the Statute of Monopolies (*b*), patents granting "the sole buying, selling, making, working, or using of any thing," are declared to be void, and the proviso in favour of inventions contained in the sixth section only extends to "grants of privilege of the sole working or making of any manner of new manufactures," leaving the sole buying or selling of any thing within the prohibition contained in the first section of the statute.

Privilege of vending seems at first sight to be contrary to the statute.

The sole privilege granted by a patent for an invention authorizes the inventor "to make, use, exercise, and *vend*" the *invention* mentioned in the recital; and the grant of the sole right of vending appears at first sight to be contrary to the first section of the statute, and not to be within the meaning of the proviso. But it will be observed, that by the sixth section the sole privilege permitted to be granted is to extend to the "working or making of any manner of new manufactures," and the word "manufactures" signifies things made by art, as well as the art or practice of making such things (*a*). The things produced by the exercise of a patent invention

(*a*) See Johnson's dictionary. (*b*) 21 Ja. I. c. 3.

must, in fact, be what are popularly termed manufactures, or vendible articles, capable of being made the subject of transactions in trade and commerce.

Vending must be deemed to be within the exception in sec. 6 of the stat.

It has already been shown that the object of the law in permitting these grants to be made, is to reward such inventors as shall give to the public the benefit of useful inventions; and that reward is, the profit to arise from the exercise of the invention during the patent term. That profit is to be produced by the sale of articles made by means of the art invented by the patentee, or in other words, according to the invention; the profit in fact being the sum charged by the patentee to the purchaser of an article beyond the cost of its production. Whether a patentee makes and sells these articles himself, or is merely paid by others for making such articles, it is quite clear that the patentee's reward must be derived from the same source; and as no one can use the invention except the patentee, none besides him can lawfully have such articles for sale. The sole right to vend articles made by means of a patent invention is therefore not only necessarily incident to the privilege granted by the patent, but is also absolutely necessary to enable the patentee to obtain the reward which the law intends for him; and although the exception contained in the sixth section of the Statute of Monopolies does not expressly save the right of the Crown to grant the sole privilege of vending such articles, there can be no doubt that it must be implied; and indeed all patents made since the passing of the statute, have invariably granted patentees the sole privilege of vending their patent articles, and this shows the construction put upon the statute, not only at the time it was made, but ever since.

Every part of the privilege granted by a patent for an invention when thus explained is, therefore, clearly within the meaning of the exception contained in the sixth section of the Statute of Monopolies; and the Common Law authorities already cited (*c*), as well as the constant practice of making such grants, incontestably prove that the Crown has the prerogative of granting such privileges to inventors.

How the privilege is to be exercised.

The privilege thus comprised in the grant, the patentee and those claiming under him (it is declared by the patent) shall

(*c*) *Ante*, Chapter II.

use in such manner as to them shall "in their discretions seem meet." And therefore a patentee is not bound to exercise his privilege in any particular manner, or perhaps at all during the continuance of his right.

A declaration in an action for infringing a patent, always indeed alleges that the patentee has "made, used, exercised, and vended the invention to his great advantage and profit;" but it has never been decided whether a patentee must have exercised his invention in order to enable him to prevent others from infringing his patent right (*d*).

To what parts of the United Kingdom patent privileges may extend.

Although the Lord Chancellor of Great Britain is Keeper of the Great Seal of the United Kingdom, a patent for an invention made under that seal, cannot be extended to Scotland or Ireland. The treaty for the Union of England and Scotland provides that such patents for Scotland shall be made under a seal which is by the treaty ordained to be used in the place of the Great Seal of Scotland. By the treaty for the Union of Ireland with Great Britain, the Great Seal of Ireland is retained, which is in the custody of the Lord Chancellor of Ireland, and under that seal patents for Ireland must be made.

A patent for an invention made under the Great Seal of the United Kingdom in the ordinary form, therefore, only extends to "England, Wales, and Berwick-upon-Tweed." But if a patent privilege is intended to apply to the Channel Islands, and our colonies, plantations and possessions abroad, the grant must be made under the Great Seal of the United Kingdom; and therefore it is usual to include such a grant in an English patent. The mode of doing this is merely by adding the words, "and also in our Islands of Guernsey, Jersey, Alderney, Sark, and Man, and in all our colonies and plantations abroad," or such of those words as may be necessary to extend the grant to the places intended to be comprised in the privilege.

Patent may be extended to colonies.

If a patent privilege is made to comprise England only, it may afterwards be extended to the colonies and other British possessions by a separate patent (*e*), which must be made under the Great Seal of the United Kingdom.

(*d*) Vide *post*, Chapter X. and the form of declaration in the Appendix, Chapter II. s. 4.

(*e*) Per Lord *Campbell* in *Brown* v. *Annandale*, 1 Webs. R. 433.

Effect of patent in the colonies.

So far as a patent relates to some of the colonies, the grant itself seems to be sufficient to entitle the patentee to the privilege comprised in the grant. But as to many of our colonies, it is necessary to have an act of the colonial legislature to make the grant available. For further information respecting these islands and colonies, the reader is referred to the first volume of Blackstone's Commentaries (*f*), the second volume of Peere Williams' Reports (*g*), and the cases of *the King* v. *Vaughan* (*h*), and *Campbell* v. *Hall* (*i*).

Privilege might be granted for part of England.

The privilege granted by a patent is usually extended over the whole of England, Wales, and Berwick-upon-Tweed; but there can be no doubt that the privilege might be restricted to any particular part or parts of England and Wales (*k*).

Who may exercise the privilege.

The patent, it will be seen, mentions all those who may exercise the sole privilege granted to the patentee. They are not only the executors, administrators and assigns of the patentee, but also his and their deputies, servants, agents, and such others as he or they shall agree with. This form of patent seems to have had its origin in ancient times, and indeed patents for inventions are now granted with very little variation, in the same form as they always have been ever since the passing of the Statute of Monopolies. And it seems that the persons authorized to exercise the privilege are mentioned lest any of them should be subject to punishment for monopolizing or creating a monopoly without sufficient authority (*l*).

Habendum.

The next clause in a patent is, what is technically called the *habendum*; it is usually in the following form:—

"To have, hold, exercise, and enjoy the said licence, powers, privileges, and advantages hereinbefore granted or mentioned, or to be granted unto the said *J. G.*, his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years from the date of these presents next and immediately ensuing, and fully to be complete and ended, according to the statute in such case made and provided."

It appears from this clause that the subject of the grant

(*f*) P. 105.
(*g*) P. 75.
(*h*) 4 Burr. 2500.
(*i*) 1 Cowp. 204.
(*k*) See the observations of Lord *Lyndhurst*, L. C., and Lord *Brougham*, in *Brown* v. *Annandale*, 1 Webs. R. 448, 449.
(*l*) See Bac. Abr. tit. Monop. (A).

which the patentee is to enjoy is the licences, powers, privileges, and advantages before mentioned (*m*).

Limitation of privilege to executors, &c.

The privileges granted are always limited to the inventor, his executors, administrators and assigns, and it is clear that they could not be limited to any other person (*n*). The limitation is made to the inventors, executors, administrators and assigns, because without these words the grant would be personal only, and the privilege would cease in case of the death of the patentee during the term. Nor would the privilege be assignable if these words of limitation did not expressly make it so (*o*). The 6th section of the Statute of Monopolies (*p*) excepts grants to inventors only, but the legality of the limitation to the executors, administrators and assigns has never been questioned, and there can be no doubt of its being good (*q*).

Of the term which may be granted.

The term usually granted by a patent is fourteen years, being the full extent of the time for which such a privilege is permitted to be granted by the sixth section of the Statute of Monopolies. The Crown has the power however of making the grant for any shorter term; but the full period allowed by law is rarely more than sufficient to enable an inventor to obtain a sufficient reward, and therefore the full term of fourteen years is never refused.

The words, "from the date of these presents," show that the time during which the patent is to run must be computed exclusive of the day of the date of the patent (*r*).

Prolongation of the term.

The term allowed by law for the duration of a patent being frequently insufficient to remunerate a patentee for his expense and trouble, the Crown was authorized, by a recent statute (*s*), upon the report and advice of the Judicial Committee of the Privy Council, to prolong the term for not exceeding seven years (*t*).

(*m*) Vide *ante*, p. 53.

(*n*) Vide 21 Ja. I. c. 3, sec. 6, and *ante*, Chap. III.

(*o*) Per *Littledale*, J., in *Duvergier* v. *Fellows*, 10 B. & C. 826.

(*p*) 21 Ja. I. c. 3.

(*q*) See further as to the nature and disposition of the privilege granted by a patent, *post*, Chap. IX.

(*r*) See Co. Lit. 46, b; *Watson* v. *Pears*, 2 Camp. 294; *Lester* v. *Garland*, 15 Ves. 248; *Webb* v. *Fairmaner*, 3 M. & W. 473.

(*s*) 5 & 6 Will. IV. c. 83, sec. 4.

(*t*) See further as to the term granted by a patent, and the prolongation thereof, *post*, Chap. VI.

4th. *Of the Prohibition to all others except the Patentee, his Executors, &c.*

The next clause is what is called the prohibitory part of a patent; it is in the following form:—"And to the end that he, the said *J. G.*, his executors, administrators and assigns, and every of them, may have and enjoy the full benefit, and the sole use and exercise of the said invention, according to our gracious intention hereinbefore declared: we do by these presents, for us, our heirs and successors, require and strictly command all and every person and persons, bodies politic and corporate, and all other our subjects whatsoever, of what estate, quality, degree, name, or condition soever they be within that part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and town of Berwick-upon-Tweed [and also in the Islands of Guernsey, Jersey, Alderney, Sark, and Man, and in all our colonies and plantations abroad] aforesaid, that neither they nor any of them, at any time during the continuance of the said term of fourteen years, hereby granted, either directly or indirectly do make, use, put in practice the said invention, or any part of the same so attained unto by the said *J. G.*, as aforesaid, nor in anywise counterfeit, imitate, or resemble the same, nor shall make, or cause to be made, any addition thereunto, or substraction from the same, whereby to pretend himself or themselves the inventor or inventors, devisor or devisors thereof, without the licence, consent, or agreement of the said *J. G.*, his executors, administrators, or assigns, in writing, under his or their hands and seals, first had and obtained in that behalf, upon such pains and penalties as can or may be justly inflicted on such offenders for their contempt of this our royal command; and further, to be answerable to the said *J. G.*, his executors, administrators and assigns, according to law, for his and their damages thereby occasioned." Prohibitory part of a patent.

The operation of a patent for an invention is not to grant the patentee a mere right to use the invention, but a sole and separate right to the exclusion of all other persons; the effect of the grant is therefore to prevent all persons except the Operation of a patent.

patentee, and those claiming under him, from using the invention during the term of the patent (*u*).

Object of a prohibition.

We have seen that all persons are bound to take notice of these grants of the Crown (*x*). And the object of the prohibition is to warn all persons of the effect of the grant, and what the law requires them to abstain from doing.

This clause commences with a declaration of the intention of the Crown that the patentee may have and enjoy the full benefit and sole use and exercise of the invention, which shows that the intention is to reward the patentee for the invention which he undertakes to put the public in possession of.

To whom it extends.

The prohibition extends to all persons living within those parts of the realm to which the privilege extends, and during the whole term granted by the patent.

To what it extends.

The persons prohibited are commanded not to "make, use, or *put in practice*" the invention, or any part of it. These words differ from the words of the privilege granted, which authorize the patentee to "make, use, *exercise and vend*" the invention. The words "put in practice" seem to be of essentially the same signification as the word "exercise;" and the declaration of intention at the commencement of the clause uses the word exercise, which shows that the subsequent words intended to have at least as extensive a meaning as the word exercise. It is not easy however to suggest a reason why the word "vend" should be inserted in the granting part of the patent, and not in the prohibitory. The prohibition is however only declaratory of the law, and cannot diminish the effect of the preceding grant.

The clause now under consideration then proceeds to command that the persons prohibited shall not in anywise counterfeit, imitate, or resemble the invention, or make any addition to it, or subtraction from it, whereby to pretend themselves to be the inventors or devisors thereof without the licence of the patentee.

This part of the prohibition, like the preceding part, is only a declaration of what the law commands; and is intended to give notice to all persons what will be an infringement of the patentee's rights, and subject them to punishment (*y*).

(*u*) Vide *ante*, p. 53.
(*x*) *Ante*, p. 38.
(*y*) See further as to what is an infringement of a patent, *post*, Chap. XI.

The licence, consent, or agreement which a person must have in order to take him out of the meaning of this clause, it is provided shall be under hand and seal. This provision seems to render it necessary that licences to use a patent invention should always be granted by deed (*z*). Licences.

The prohibition addressed to all the Queen's subjects is followed by a command to her justices and officers in the following form. "And moreover we do by these presents for us, our heirs and successors, will and command all and singular, the justices of the peace, mayors, sheriffs, bailiffs, constables, headboroughs, and all other officers and ministers whatsoever, of us our heirs and successors for the time being, that they or any of them do not, nor shall at any time hereafter during the said term hereby granted, in any wise molest, trouble or hinder the said *J. G.*, his executors, administrators or assigns, or any of them, or his or their deputies, servants or agents, in or about the due and lawful use or exercise of the aforesaid invention, or any thing relating thereto." Command to justices, &c.

All monopolies (except those preserved by the provisoes in the Statute of Monopolies) are contrary to law, and persons who put them in force may be punished by fine and imprisonment(*a*). The grant to a patentee of the sole use of his invention being a lawful grant, this clause seems to have been introduced into the patent as a protection to the patentee, so that if he were to be charged before any justices or officers of the Crown, with putting an illegal monopoly in force, he might produce his patent to them in proof of his right, and to show by the command contained in it that they had no power to proceed against him. Reason for the clause being inserted.

5th. *Of the Conditions of the Grant.*

We have already, in a former part of this work, discussed the power of the Crown to grant the sole use of inventions (*b*), and we have seen in what manner the prerogative is limited by the Statute of Monopolies. But there is nothing either in Conditions may be annexed to the grant.

(*z*) See further as to licences, *post*, Chap. IX.

(*a*) 2 Inst. 61; 3 Inst. 181; Hawk. P. C. bk. II. c. 79, sec. 2.

(*b*) Vide *ante*, Chap. II. p. 7.

our Common or Statute Law, to prevent the Crown from annexing any legal conditions to such grants as those now under consideration; and there can be no doubt that such conditions are valid and binding upon the patentee. Thus in a pardon granted by the Queen under the Great Seal, she may annex any condition to it she may think fit (*c*).

Proviso for avoiding the grant.

The first condition or proviso in a patent for an invention is in the following form:

"Provided always, and these our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted, it shall be made appear to us, our heirs or successors, or any six or more of our or their Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof in that part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and Town of Berwick-upon-Tweed [and also in the Islands of Guernsey, Jersey, Alderney, Sark, and Man, and in all our colonies and plantations abroad] aforesaid, or not invented and found out by the said *J. G.*, as aforesaid, then upon signification or declaration thereof to be made by us, our heirs or successors, under our or their signet or privy seal, or by the Lords and others of our or their Privy Council, or any six or more of them under their hands, these our letters patent shall forthwith cease, determine, and be utterly void to all intents and purposes, any thing hereinbefore contained to the contrary thereof in anywise notwithstanding."

If contrary to law.

The first cause for voiding the grant under this condition is in case the grant is contrary to law, or prejudicial or inconvenient to the people of the kingdom in general. This provision is merely in affirmance of the law, which says that the Queen cannot do any thing against the law (*d*), or against right or justice; hence the maxim that the Queen cannot do wrong.

And therefore all her letters patent which are contrary to law or common justice, or which are to the prejudice of the commonwealth, or to the general injury of the people, are null

(*c*) 2 Hawk, c. 37, sec. 45.

(*d*) Godbolt, 254.

and void (*e*). And every grant from the Queen has this condition either expressly or tacitly annexed to it, that it be not a grievance or prejudice to her Majesty's subjects; and if a grant be contrary to this condition it is void (*f*).

The Statute of Monopolies (*g*) also provides that patents for inventions shall not be "contrary to the law; nor mischievous to the state, by raising prices of commodities at home; or hurt of trade, or generally inconvenient" (*h*).

If invention not new.

Another cause for avoiding a patent under this proviso or condition, is, if the invention is not new as to the public use of it within that part of the kingdom to which the grant extends. This is in accordance with the law, which requires that every invention which is made the subject of a grant by patent must be new to the public; novelty in fact being a material and necessary part of the consideration for the grant which the Queen makes on behalf of the public (*i*).

The law requires more than the proviso.

The law, however requires much more than this condition in the patent; for the Statute of Monopolies provides that an invention must be new *in this realm*, which since the Union with Scotland and Ireland, includes the whole of the United Kingdom, together with all its colonies and possessions abroad (*j*).

Invention must be new throughout the realm.

There was indeed formerly a very general opinion amongst the profession, that it was only necessary that an invention should be new in England, Wales, and Berwick-upon-Tweed, but that opinion was exploded by the decision of the House of Lords in *Brown* v. *Annandale* (*k*).

Brown v. Annandale.

In that case it seems to have been erroneously supposed that the effect or intent of a patent is to grant a privilege on the terms merely of the conditions comprised in the patent, excluding all others. But that is clearly not so, for it is declared by the habendum (*l*) in the patent, that the inventor his executors, administrators and assigns, shall have and enjoy the privilege *according to the statute in such case made and provided*, and therefore it is manifest that the grant is intended to be made subject to all the conditions required by the Statute of Monopolies. If the patent had provided that novelty within a smaller district

(*e*) See Shep. Abr. Prerog. 48, sec. 5 & 7, and the authorities there cited.
(*f*) 11 Co. 86, b.
(*g*) 21 Ja. I. c. 3, s. 6.
(*h*) Vide *post*, Chap. V. sec. 3.
(*i*) See this subject fully discussed, *post*, C. V. sec. 3.
(*j*) Vide *post*, Ch. V. sec. 2.
(*k*) 1 Webs. R. 433.
(*l*) Vide *ante*, p. 57.

than required by law should *be sufficient*, the patent would have been void in that respect, if not *in toto*, for the Crown has no power to dispense with the provisions of an Act of Parliament. But the Crown is not restrained from making conditions which are not *contrary* to law; and a condition which is in accordance with the law, will not be bad or avoid the patent because it is not so extensive as the law itself. The fact is, that the form of this condition in a patent was adopted at a time when the realm only included England, Wales, and Berwick-upon-Tweed, and the alteration in the law produced by the Union with Scotland and Ireland, not being adverted to, the officers of the Crown have adhered to the old form which was in use prior to the alteration of the law. The condition ought now to require an invention to be new within the realm.

If patentee did not invent.

The last cause for avoiding a patent under this proviso is, in case the invention was not invented or found out by the patentee; or, if the invention was imported, in case it was not first introduced by the patentee. The law respecting the grantees of inventions has already been fully considered in a preceding chapter of this work(*m*), and this clause of the proviso is intended to be in accordance with the law on that subject.

Mode of recalling the grant.

The last clause of the proviso contains a provision, that upon signification made to the Queen of any such cause for avoiding the patent, as before mentioned, the patent shall cease and be void.

The only means which the law provides for the repealing of letters patent, is by action of *scire facias* at the suit of the Queen. This provision, which is contained in the patent itself, however, provides additional modes of determining the patent, and rendering it void. There is no instance in modern times of this provision in a patent having been put in force, although, if the clause were to be framed so as to vest the power of avoiding the patent in the Judicial Committee of the Privy Council, it might be of considerable service to the public.

The second proviso or condition which is always inserted in a patent for an invention is in the following form:—

Proviso that the patent shall not affect any former grant.

"Provided also, that these our letters patent, or anything herein contained, shall not extend or be construed to extend

(*m*) Chap. III.

to give privilege unto the said J. Gowland, his executors, administrators, or assigns, or any of them, to use or imitate any invention or work whatsoever, which hath heretofore been found out or invented by any other of our subjects whatsoever, and publicly used or exercised in that said part of our United Kingdom of Great Britain and Ireland called England, our dominion of Wales or town of Berwick-upon-Tweed, [in the islands of Guernsey, Jersey, Alderney, Sark, and Man, or in any of our colonies and plantations abroad,] aforesaid, unto whom like letters patent or privileges have been already granted for the sole use, exercise, and benefit thereof, it being our will and pleasure that the said J. Gowland, his executors, administrators, and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practise their several inventions, by them invented and found out, according to the true intent and meaning of the same respective letters patent, and of these presents."

Some patents determine prior patents.

In some cases, letters patent under the Great Seal operate so as to determine the powers or privileges granted by former letters patent. Thus a new commission of the peace, contained in letters patent under the Great Seal, at once determines all the powers and authorities of justices named in previous letters patent, who are not named in the new commission.

Proviso inserted by way of caution.

The proviso, now under consideration, seems to have been inserted by way of caution, and in order to prevent the rights and interests of different patentees from clashing with each other. And whatever might have been the construction of a patent without such a clause, it is quite clear that the lawful intent of the Crown, as declared in this proviso, is sufficient to control the effect of a grant in a patent, and to confine the effect of it within the true intent and meaning of the Queen, as here declared.

Ex parte Fox.

In the case of *ex parte Fox* (*n*), Lord *Eldon*, L. C., said that a patent might be granted for an improvement upon an invention which was the subject of a prior patent, but that the subsequent patentee would be unable to use the invention of the prior patentee during the continuance of the first pa-

(*n*) 1 V. & B. 67.

tent. The same law was laid down by the Court of Common Pleas in the case of *Crane* v. *Price* (*o*).

Third Proviso against assignment to more than twelve persons.

The next proviso in a patent for an invention is in the following form:

"Provided likewise nevertheless, and these our letters patent are upon this express condition, that if at any time hereafter these our letters patent, or the liberty and privileges hereby by us granted, become vested in more than the number of twelve persons or their representatives, at any one time, as partners, dividing or entitled to divide, the benefit or profit obtained by reason of these our letters patent, reckoning executors or administrators as and for the single person whom they represent as to such interest, as they are or shall be entitled to in right of such their testator or intestate, that these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine, and become void, any thing hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided that nothing herein contained shall prevent the granting of licences in such manner, and for such considerations as they may by Law be granted" (*p*).

We have seen (*q*) that the privilege granted by a patent cannot be assigned except by virtue of the express provisions of the patent itself. The third proviso in a patent is intended to restrain the previously unlimited power of alienation which is given to the patentee.

Object of restraining alienation.

The object in restraining the alienation of these patent privileges has always been, firstly, to prevent the public being imposed upon by specious projects, under the colour of letters patent, which too often terminate in the ruin of those who are induced to embark in them; and, secondly, to avoid the oppression which might be practised if large and powerful companies were to be permitted to become possessed of such privileges.

What is necessary to render a patent void under this clause.

In order to render a patent void under this proviso, two things are necessary, *firstly*, that the privilege granted by the patent shall become vested in more than twelve persons; se-

(*o*) 4 M. & G. 580; and see *Harmar* v. *Playne*, 14 Ves. 130; 11 East, 101; and *Lewis* v. *Davis*, 3 C. & P. 502.

(*p*) This clause was first introduced in the year 1832, in the place of a condition against assigning to more than *five* persons; see the form of the old clause in the Appendix; see also Carpmael Law of Patents, 2nd Edit. p. 78.

(*q*) *Ante*, p. 58.

condly, that more than twelve proprietors of the patent privilege shall, as partners, divide, or be entitled to divide, the benefit or profit obtained by reason of the patent.

As to the number of persons in whom a patent may become vested, the clause itself provides that executors and administrators shall only be reckoned as the single person whom they represent. And it was decided by the court of Queen's Bench in the case of *Bloxam* v. *Elsee* (*r*), that the vesting of a patent in the assignees of a bankrupt, in trust for the creditors of the bankrupt who were more than twenty in number, did not avoid the patent, on the ground that the assignees were merely "representatives" of the bankrupt; and that the object of the proviso applied to assignments by acts of parties, and not by operation of Law (*s*).

Creditors not entitled to use the invention.

It seems also that there is another reason why a bankrupt's patent will not be avoided in consequence of his creditors exceeding twelve in number, which is, that the creditors do not acquire any right to use or exercise the patent privilege, but are only entitled to the proceeds to arise from a sale of the patent.

It seems from the form of the proviso in question that however numerous the persons may be in whom a patent becomes vested, it will not be thereby rendered void, if there are not more than twelve proprietors *as partners* dividing, or entitled to divide, the profits obtained by reason of the patent.

If therefore the patent privilege should become vested in more than twelve persons, in any other way than as partners so entitled to divide profits, the patent would not be thereby avoided. Thus if the patent were to be vested in twenty persons, in such a way that each of them should be entitled to use the patent privilege for his own profit and benefit, separate and apart from his co-proprietors, such a disposition of the patent right would not render the patent void within the meaning of this clause.

Co-proprietors not partners.

Where several persons by assignment become entitled to the privileges granted by a patent, it is difficult to determine what is the precise nature or extent of their rights amongst themselves. It seems that without some agreement amongst

(*r*) 6 B. & C. 169.

(*s*) See further respecting the assignment or disposition of patents, *post*, Chapter IX.

them as partners to work the patent, or jointly to take the profits obtained by means of the patent, they could not be considered as partners dividing profit within the meaning of this proviso. For no proprietor of a share in a patent could be compelled to become a partner to work the invention, or to concur in granting licences to enable others to use it, nor could he be prevented from working the invention himself separate and apart from his co-proprietors (*t*).

Companies for working patents.

This clause in a patent renders it necessary to apply to Parliament, whenever it is desired to transfer a patent to a company of more than twelve persons. Many Acts of Parliament have been passed for this purpose, but few if any of the companies formed, solely for the working of inventions, have succeeded. It is clear indeed that public companies cannot conduct manufacturing or trading business so efficiently as private persons or ordinary copartnerships, and the machinery necessary for the management and regulation of such companies, swallows up all the profit made by their trade or manufactures.

Licence.

A licence may be considered either as vesting in the licensee some right or interest in the privilege granted by a patent, or as granting him a dispensation from the prohibition contained in the patent, and in order to guard against a licensee being held to be an assignee, in whom a portion of the patent privilege is vested within the meaning of this proviso, it is expressly declared that nothing in the patent shall prevent the granting of legal licences (*u*).

Proviso requiring a specification.

We now come to the most important proviso in a patent, by which the patentee is compelled to enrol in Chancery an instrument usually called a specification; this proviso is now usually in following form:—

"Provided also that if the said J. G. shall not particularly describe and ascertain the nature of his said invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and cause the same to be enrolled in our High Court of Chancery within [six] calendar months next, and immediately after the date of these our letters patent, that then these our letters patent, and all

(*t*) Vide *post*, Chapter IX.

(*u*) See further on the subject of licences in Chapter IX. s. 3, *post*.

liberties and advantages whatsoever hereby granted, shall utterly cease, determine and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding."

Patent does not describe invention.

We have seen that it is not now the practice in a patent to give any further explanation of the invention which is comprised in it, than is contained in the title as mentioned in the recital of the patentee's petition for the patent. But certainty is an essential requisite in every grant, and more particularly so in grants by the Crown (*x*), which are always construed strictly *against* the grantee (*y*). And if there was no provision in a patent for obtaining a description of the invention, the subject of the grant would not only be uncertain, but incapable of being reduced to a certainty, and therefore the patent would be void.

But certainty is requisite.

Without a specification a patent would not have certainty.

Without a specification the public would not know to what the patent extends.

We have already considered the effect of the grant, and of the prohibition contained in patents (*z*). And it is evident that without some better description of an invention than a title usually affords, the public would have no means of knowing what they are prohibited from doing, during the term of the patent, or what it is they are to have at the end of the term as a consideration for the grant. The Lord Chancellor would not knowingly seal a patent which does not contain some proper provision for the benefit of the public, or, as Lord *Hardwicke*, L. C., said in the case of *ex parte O'Reilly* (*a*), he would not seal a patent which did not put the parties under some control, even though there should be no caveat against it.

Patent would not be granted without a proviso for specification.

Origin of specification.

The practice of requiring a specification first commenced in the reign of Queen Anne, before which time it had been customary to introduce recitals into patents, containing descriptions of the inventions intended to be comprised in them.

Advantage of specification.

By adopting the expedient of requiring a specification, at the end of a few months the patentee is benefited by the time and opportunity of completing and perfecting his invention, and producing a proper description of it; and the public have the advantage of a better description than a patentee

(*x*) Per *Heath*, J., in *Boulton* v. *Bull*, 2 H. Bl. 483; and 1 Buls. 70.
(*y*) See *ante*, p. 39.
(*z*) *Ante*, p. 50, 59.
(*a*) 1 Ves. Jr. 112.

would be able to give if he were required to make it before or at the time he obtains his patent.

What the proviso requires.

The proviso requires the patentee *particularly* to describe and ascertain the *nature* of the invention, and *the manner in which it is to be performed.* The instrument by which this is required to be done, must be under the hand and seal of the patentee, and this instrument is what is popularly termed a specification.

Specification to be enrolled within a limited time.

The specification is also required to be enrolled within *four* months in ordinary cases, and in *six* months if the patentee declares that he intends to apply for a Scotch patent. This indulgence is granted on the ground that if the specification were to be enrolled before the date of the Scotch patent, the Scotch patent would be void (*b*).

Time, how computed.

The time within which the enrolment is to be made must be computed exclusive of the day of the date of the patent (*c*).

Enrolment to be in Chancery.

The enrolment is also required to be in the Court of Chancery, which is the Court in which all the most important public records of the country are kept, to which the public has a right to resort for information. There are three offices for enrolments in the Court of Chancery; they are the Enrolment Office, the Rolls Chapel, and the Petty Bag Office; and an enrolment in any of these offices is a sufficient compliance with the proviso. Since the passing of a recent Act of Parliament (*d*) there is some advantage in enrolling a specification in the office of the Rolls Chapel for copies obtained in that office, and stamped as the Act directs, are admissible in evidence without further proof.

The proviso amounts to a covenant by patentee.

It seems that this proviso contained in a patent under which the grantee claims, amounts to a covenant by him that he will perform the conditions required of him (*e*).

If condition not performed the patent will be void.

The clause in question concludes with a declaration, that if the condition it contains is not complied with, the patent shall become void. What is a sufficient compliance with this condition, and the essential requisite of a specification, will be fully discussed in a subsequent Chapter of this work (*f*).

(*b*) *Brown* v. *Annandale*, 1 Webs. R. 433.

(*c*) *Watson* v. *Pears*, 2 Camp. 294.

(*d*) 1 & 2 Vict. c. 94. See s. 12 & 13.

(*e*) See the case of *Lord Ewre* v. *Strickland*, Cro. Ja. 240; *Brett* v. *Cumberland*, Cro. Ja. 522; *Mayor, &c. of Lyme Regis* v. *Henley*, 3 B. & Ad. 77.

(*f*) Vide *post*, Chapter VII.

Whenever the officers of the Crown think that an invention may be useful in any department of the public service, a condition is inserted in the patent in the following form,—or to a similar effect:—

Proviso that patentee shall supply the patent article to the Crown at reasonable prices.

"Provided also, that if the said *J. G.*, his executors, administrators or assigns, shall not supply, or cause to be supplied, for our service all such articles of the said invention as he or they shall be required to supply, in such manner, at such times, and upon such reasonable prices and terms as shall be settled for that purpose by the Master General of our Ordnance, or the principal officers of the Ordnance (or by the Lords Commissioners of our Admiralty, &c.), for the time being, that then, &c.," the patent shall become void.

Performance of this proviso part of the consideration.

In such a case the performance of this proviso is one of the considerations which the patentee is to give to the public for the grant made to him by the Queen on behalf of the public.

Patentee cannot proceed by *mandamus* against the officers of the Crown.

This proviso does not however enable the patentee to compel the officers of the Crown to settle the prices or terms upon which he is to supply articles according to the proviso. Thus in the case of *ex parte Perring* (*g*), it appeared that Perring had obtained a patent for an invention of improvement in anchors, and the patent contained a proviso for making the patent void if the patentee should not supply for his late Majesty's service all such articles of the invention as he should be required to supply, in such manner, and at such prices as should be settled by the Lords Commissioners of the Admiralty for the time being. The patentee, upon an affidavit that the Admiralty had constructed anchors according to the invention, and had refused to give him adequate remuneration, moved the Court of King's Bench for a *mandamus* commanding the Lords of the Admiralty to settle the prices and terms according to the patent. But the Court held the application was not warranted by the terms of the patent, and refused the *mandamus*.

This clause also seems to amount to a covenant on the part of the patentee (*h*).

Clause dispensing with a particular description of invention in the patent.

The last clause in the body of a patent is usually the following:—

"And lastly, we do by these presents, for us our heirs and

(*g*) 4 A. & E. 949.

(*h*) See the cases cited, *ante*, p. 70. n. (*e*).

successors, grant unto the said *J. G.*, his executors, administrators, and assigns, that these our letters patent, or the enrolment or exemplification thereof, shall be in and by all things good, firm, valid, sufficient, and effectual in the law, according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favourable and beneficial sense, for the best advantage of the said *J. G.*, his executors, administrators, and assigns, as well in all our Courts of Record as elsewhere, and by all and singular the officers and ministers whatever of us, our heirs and successors, in that part of our said United Kingdom of Great Britain and Ireland called England, our dominion of Wales and town of Berwick-upon-Tweed, and in all our colonies and plantations abroad aforesaid, and amongst all and every the subjects of us, our heirs and successors whatsoever and wheresoever, notwithstanding the not full and certain describing the nature or quality of the said invention, or of the materials thereto conducing or belonging."

Reason for inserting the clause.

We have seen that the ordinary rules for construing grants of the Crown require them to be taken most strongly in favour of the Crown, and against the grantee. We have also seen that the words "of our especial grace, certain knowledge, and mere motion," are usually inserted in patents to cause them to be construed more favourably for the patentee. But notwithstanding these words, in consequence of the extremely general and vague terms in which a title usually describes an invention, it is very doubtful whether a patent would not be void for uncertainty, if it did not contain some particular provision such as that now under consideration. The provision follows almost immediately after the proviso requiring a specification of the invention, and the clause seems to have been adopted about the time when a full recital of the nature of an invention granted by patent to be dispensed with, and a condition for a specification substituted in its place.

Lawful intent of patent to prevail.

It is a rule that the intent of a grant, whether made by the crown or any private person, shall always be allowed to prevail as far as it is lawful; and it seems that there is nothing unlawful in making a grant of an invention named and to be afterwards described by the inventor, for the Queen cannot know anything respecting the invention, except from the representation of the inventor; and whether he gives the descrip-

tion of it to the public, before or after the making of the grant cannot be material, if the description is but correct. It is true that the patentee might insert a false description of the invention in his specification, but the consequence of that would be to avoid the patent, and put an end to the grant, and the public could not receive any substantial injury from such a void grant.

This clause, in effect, provides that the patent, or the enrolment or exemplification thereof, shall be valid and construed in the most favourable sense for the patentee, notwithstanding the patent does not contain a full and certain description of the invention. If a patent, in the form we have been considering, did contain a full description of the invention granted, it would be construed favourably for the patentee; and therefore the object of this clause is to declare the intention of the Queen that that rule of construction is to prevail, and that the grant is to be valid notwithstanding the title in the patent does not fully describe the invention; or, in other words, it is intended to be a dispensation from the rule that the subject of a grant by patent must be described in it with certainty and particularity. Effect of clause.

And as this dispensation does not produce any injury to the public, but coupled with the condition requiring a specification is rather beneficial to the public, it seems that the Queen may lawfully grant such a dispensation (*i*); and indeed there cannot now be any doubt that patents containing this proviso are valid and sufficient in Law. This dispensation seems to be *lawful*.

We now come to the formal conclusion of a patent, the first clause of which is— Formal conclusion.

"In witness whereof, we have caused these our letters to be made patent." The name "letters patent" is taken from the words of this clause (*k*), by which it is in effect declared that the Queen makes her grant patent, or known to all persons by the affixing of the Great Seal to it, and publishing it to the world. The publication being the enrolment of the patent in the Chancery Rolls, to which all persons have access (*l*), and the delivery of the patent to the patentee, to be

(*i*) See *Bozun's* case, Co. R. 35—36; *Attorney-General* v. *Hungate*, Hardres, 231; Vin. Abr. Prerog. (Y. a.) and (Y. a, 2); and 3 Shep. Abr. Prerog. p. 95.

(*k*) 2 Inst. 78.

(*l*) 1 Co. R. 45 a.

shown a[illegible]vidence of his title to the privilege granted by the pate[illegible]

The p[illegible]nt then concludes thus, "Witness ourself at Westminster, this day of in the year of our reign." Patents for inventions, like commissions, writs, and Common Law proceedings issuing out of Chancery, are always tested in the name of the Queen herself; but commissions, writs, &c. issuing out of other Courts, are tested in the name of the chief or sole judge of the Court; thus those which issue out of the Queen's Bench are tested, "Witness, Thomas Lord Denman, at Westminster, &c."

Date of patent.

In *Lord Zouch and More's* case (*m*), it is laid down that "the King's patent may be without date, for he may resort to the enrolment and privy seal, and so help it."

The deed of a subject has relation only to the time of the delivery, and not to the time of the date; but the Queen's patent has relation to the time of the date, and not to the time of the delivery; inasmuch as matters of record (which letters patent are) by presumption of Law import truth in them (*n*).

Statute 18, Hen. VI.

In order to prevent the mischievous effect of antedating patents, an Act was passed in the 18th year of the reign of Henry VI. (*o*), by which it is provided that the day of the delivery of every warrant to the Chancellor shall be entered of record, and letters patent are to be made thereupon, bearing date the day of such delivery, and not before, and that letters patent made to the contrary are void.

Every patent for an invention has subscribed to it the words, "By writ of Privy Seal." These words are intended to show that the patent has been made in pursuance of a command contained in the Queen's writ, or warrant under her privy seal (*p*).

Subscription.

And at the bottom is written the name of the clerk of the letters patent thus, "Edmunds," whose duty it is to prepare all patents which pass the Great Seal (*q*).

To the bottom of the patent is affixed an impression of the

(*m*) Godbolt, 416.
(*n*) Plowd. 491.
(*o*) 18 Hen. VI. c. 1; see the Act, Appendix, c. 1, s. 1.
(*p*) See 2 Inst. 555—556, and 8 Co. R. 18, b.
(*q*) The office is now regulated by the Act 3 & 4 Will. IV. c. 84.

Great Seal, as already mentioned (*r*). It is this seal which gives authority to the document, and all persons are bound to take notice that it is the Great Seal; so that when a patent under the Great Seal is produced, it is admissible in evidence without further proof.

Prolongation of a patent under statute 5 & 6 Will. IV. c. 83, s. 4.

By the statute 5 & 6 Will. IV. c. 83. s. 4. (*s*) the Queen in Council is enabled to grant an extension of the term comprised in a patent for an invention, and such extension is to be granted by new letters patent.

Effect of an extension only to extend the term.

It is evident from the words of the statute that the effect of a patent for an extension can only be to extend the term granted by the first patent for such an additional term (not exceeding seven years) (*t*) as may be granted by the second patent; and therefore the second patent must be construed in like manner as the first; and indeed the validity of the second patent must depend upon the validity of the first.

If first patent void, second patent void also.

If the first patent was void, the privilege which it purports to grant has no existence, and as a nullity cannot be extended, the second patent cannot have any effect, and will be void also.

Report of Privy Council in favour of a patent subject to all objections.

For this reason the Privy Council will not entertain any question respecting the validity of a patent which is sought to be prolonged, unless, indeed, it has been repealed; but if the invention is of sufficient merit, will report in favour of an extension, the petitioner taking it at his own peril, subject to all objections to its validity, and for so much as it may be worth.

Second patent contains same proviso as the first.

And it will be seen from the form of a patent for an extension (*u*) that it contains a proviso for avoiding it for want of novelty, &c., in precisely the same form as the proviso to that effect contained in an original patent.

Acts prolonging patents to have the same construction.

Before the Queen in Council was enabled to prolong patent privileges, special Acts of Parliament were sometimes passed for that purpose, but such Acts always contained provisions for making the extended privilege liable to all the obligations which were applicable to the original grant of it by patent.

(*r*) Vide *ante*, p. 37.

(*s*) Amended by 2 & 3 Vict. c. 67, and extended by 7 & 8 Vict. c. 79.

(*t*) Or fourteen years, under 7 & 8 Vict. c. 79.

(*u*) See the Form in the Appendix, Chapter II. s. 1.

Act enabling assignment does not vary construction.

An Act of Parliament which merely enables a patentee to assign his patent privilege to a greater number of persons, or in a different mode from that allowed by the conditions contained in the patent, does not in any other way alter or affect the construction or validity of the patent (*x*).

Confirmation does not vary the construction.

Nor will the confirmation of a patent under the 5 & 6 Will. IV. c. 83. s. 2, have any effect upon the construction of it, or alter it in any way except to give it validity, notwithstanding such a prior publication of the invention as mentioned in the statute, all other objections being left untouched.

(*x*) *Hesse* v. *Stevenson*, 3 B. & P. 565.

CHAPTER V.

OF THE NATURE AND QUALITIES OF AN ART OR INVENTION WHICH MAY BE MADE THE SUBJECT OF A PATENT PRIVILEGE.

SEC. I.—*Of the Nature of the Art or Invention.*
II.—*Of the Novelty of the Art or Invention.*
III.—*Of the Utility of the Art or Invention.*

SECTION I.

Of the nature of an Invention which may be the Subject of a Privilege granted by Patent.

Confusion produced by improper use of words.

MUCH confusion has been introduced into Patent Law by the use of words to indicate things not within their proper and ordinary signification. Thus the word "patent" is frequently used instead of the word "invention;" sometimes it is employed to denote the *grant* contained in a patent, and sometimes the *privilege* which is the subject of such a grant. So the word "invention" is occasionally used to signify the act of discovering or finding out something; frequently to signify an art newly invented, and occasionally the article produced by means of such an art. The word "principle" has also been used in several different senses in various cases, so as to make it difficult to understand what is meant by the word.

Necessity for guarding against improper use of words.

In considering what kind of inventions may, and what cannot be made the subject of patent privileges; it becomes of the utmost importance, in treating of a subject so full of difficulty and so imperfectly understood, to use every precaution in order to guard against the improper use of these words, so as to avoid the confusion and uncertainty which would ensue if they were to be used in any sense at all loose or indeterminate.

"Patent" an open record

The word "patent" in its proper sense merely signifies an

under the great seal.

open record made by the Queen in Chancery and under the Great Seal (*a*); and patents, or more correctly speaking, letters patent, are made for very many purposes besides granting sole rights to use inventions.

A patent contains a grant.

Patents (such as those which form the subject of this work) contain *grants* made by the Crown to meritorious inventors; and in some of the preceding Chapters of this work (*b*), the policy of the law respecting such grants has been pointed out, and the law considered both as it relates to the grantor and the grantee.

The grant confers a privilege.

A patent grant of this description confers upon the patentee a sole or exclusive *privilege*, the nature of which will be considered in a subsequent part of this work (*c*). And the question what may be made the subject of such a sole privilege is what is purposed to be discussed in the present Chapter.

Subject of a privilege.

"Invention" is the general and popular name given to any thing which may be made the subject of such a privilege; or which, in the language of some of our old law books, may be *put into a privilege.*

Meaning of "invention."

The word invention signifies (in its proper sense) something invented, discovered, or found out, a device or contrivance; and therefore it includes many things, such as designs, patterns, models, drawings, &c. (*d*), which are clearly not inventions within the meaning of the patent law.

Statute of Monopolies.

By the sixth section of the Statute of Monopolies (*e*), it is declared that the previous clauses condemning all monopolies shall not extend to "any letters patent and grants of *privilege* for the term of fourteen years, or under, of *the sole working, or making of any manner of new manufacture*, within this realm, to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patents and grants shall not use, so as also they be not contrary to the law, nor mischievous to the state, by raising prices

(*a*) Vide *ante*, Chap. IV. p. 36.
(*b*) Chapters I., II. and III.
(*c*) See Chap. IX. respecting the nature of a patent privilege and the disposition of it.
(*d*) The authors of such inventions derive their privileges from the express provisions of particular statutes by registration merely, and without the aid of any grant from the Crown.
(*e*) 21 Jas. I. c. 3.

of commodities at home or hurt of trade or generally inconvenient," and that such grants "shall be of such force as they should be if the Act had never been made, *and of none other.*"

The effect of the statute is to leave the excepted patents to the common law.

The effect of this section of the Act is in substance, that such letters patent, and grants of privilege as it describes, are not on the one hand to be taken to be within the meaning of the preceding sections, which in very general terms declare the illegality of all monopolies whatsoever: nor are they on the other hand to be rendered valid by virtue of the Act: but they are to be of precisely the same force as if the Act had not been passed, and no more. An invention which may legally be made the subject of a patent privilege must, therefore, not only be of such a nature as to come within the meaning of the exception contained in the statute, but it must also be such an invention as at Common Law the Crown possesses the prerogative of granting the sole use of.

Words of the statute, of the common law, and of the patent to be considered.

In order to discover what was intended by this enactment, it will be necessary to consider the words of the enactment itself;—the Common Law which it was intended to preserve;—and the effect which a valid patent must have, which it will be seen, in the sequel, is to make a grant of the sole privilege of using a new ART for making or manufacturing vendible articles, or articles of commerce.

Words of the statute.

The material words of the Act are, "letters patents, and grants of privilege, of the sole working or making of any manner of new manufactures, which others at the time of making such letters patents shall not use" (*f*). The words "letters patents and grants of privilege" show (what has already been stated) that the *subject of the grant* contained in a patent, must be a privilege, and the subsequent words point out what may be made the *subject of such a privilege.*

In order to discover what was intended by the legislature, we must have regard not only to the word "manufactures," upon which so much stress has always been laid; but also the prior words "working or making," and the subsequent words "which others at the time of making such letters patents shall not use," and give effect to the whole of them. The subject of such a privilege is to be the "working or

Subject can only be an art

(*f*) See the clause, *ante*, p. 78, and the Act in the Appendix, Chap. I. s. 1.

of working or making.

making of some manner of manufacture," and this indicates that the subject of the privilege must be the means by which some manufactures or articles of commerce are to be produced; and as novelty is required to be a quality in the subject of the privilege, it can only be *a new art* invented by the patentee, by means of which "working or making" is to be applied in the production of articles of commerce.

The words "which others shall not *use*," are plainly referable to the "working or making," which is to be the subject of the privilege, and not to the articles of manufacture which are produced by means of such a working or making.

Meaning of the word "manufactures."

The meaning of the word "manufactures" in this section of the Act has been much discussed, and almost all the cases decided respecting the subject of a patent privilege have turned upon the construction which is to be put *upon that word*. But in those cases, not only have the other words in this section of the Act, which it has been shown are so material to be considered for the purpose of ascertaining what is to be the subject of a patent privilege, been entirely neglected; but the word "manufactures" has until recently had a much more limited construction put upon it than is warranted either by the context or the signification of the word itself.

The word manufacture in our language as a noun has two significations; firstly, the art or practice of making or constructing any piece of workmanship; secondly, anything made by art (*g*).

It is extraordinary that notwithstanding this double signification of the word, the statute seems almost always to have been construed as if the word bore the latter only of these two significations.

Construction of the Act.

The words "working or making," which are used in connection with the word "manufactures," in the sixth section of the Act (*h*), seem to show that the word manufactures was intended to bear both of those significations. Thus, construed with the word "working" in this section, "manufactures" signifies the arts or processes of making, and the words "working of manufactures" evidently refer to the

(*g*) See Johnson's dictionary, Webster's dictionary, &c.

(*h*) 21 Jas. I. c. 3, s. 6, *ante*, p. 78.

exercise of arts of making or constructing; and it seems indeed that the use of the word working as applied to "manufactures" in any other sense of the word than that of arts or processes of making or manufacturing would be repugnant. Construed with the word "making," the word "manufactures" signifies articles or things made, and the words "making of manufactures" appear therefore to mean the art of making articles or things which, when made, may properly be denominated manufactures. It appears from the words "any manner of," immediately preceding the words "new manufactures," in the sixth section of the statute, that the legislature intended that the word manufactures should not be understood in any narrow or limited sense; but on the contrary, that the word should be taken in the most extensive signification it will bear consistently with the context. And the subsequent words in the sixth section of the statute show that the articles to be produced by an art of working, or making, must be articles of trade or commerce (*i*).

Common law authorities.

There were not many Common Law authorities in existence before the passing of the Statute of Monopolies, respecting the subject of such grants by patent; but those which are to be found in our books, are in perfect accordance with the construction which is here put upon the proviso in the Statute of Monopolies.

Case of monopolies.

In the case of monopolies (*k*), it it laid down that the Crown may grant a monopoly of "*a new trade*" or "*any engine tending to the furtherance of a trade that never was used before.*"

Clothworkers of Ipswich case.

In the *Clothworkers of Ipswich* case (*l*) it is said, that "if a man hath brought in *a new invention, and a new trade,*" or "*a new discovery of anything,*" the Crown may grant to him that he only shall use such a trade.

Edgeberry v. Stephens.

In the case of *Edgeberry* v. *Stephens* (*m*), it was held that the Act (the exception contained in the Statute of Monopolies) intended to encourage *new devices* useful to the kingdom.

Sheppard's Abridgment.

In Sheppard's Abridgment (*n*) it is said, that the King

(*i*) See per *Heath*, J., in *Boulton* v. *Bull*, 2 H. Bl. 463.
(*k*) Noy, 182.
(*l*) Godb. 252—254.
(*m*) 2 Salk. 447.
(*n*) Part 3, tit. Prerog. p. 61.

may grant a patent for a new *trade* or *device*, or any new *engine* tending to the furtherance of it.

Hawkins P. Cr. And Serjeant *Hawkins* says (*o*), that the King may grant the sole use of "AN ART invented or first brought into the realm by the grantee."

These authorities, and indeed all the other old authorities on the subject, show that the object of the law in giving validity to patent privileges for new inventions was to encourage the introduction of new *arts* for the employment of the people in manufacturing articles of commerce, and to promote the trade of the country.

Intent of the statute the same as the common law.

And the word "manufactures," coupled with the words "raising prices of commodities at home, or hurt of trade," in the exception contained in the statute, show that the intent of the exception was precisely the same as that of the Common Law.

Mitchell v. Reynolds.

The judgment delivered by the Court of King's Bench, in the case of *Mitchell* v. *Reynolds* (*p*), (which occurred about eighty years after the passing of the statute,) contains a most important exposition of the law relating to monopolies in general, in which the Court lays down what they deemed capable of being made the subject of a grant by letters patent.

After stating that other monopolies granted by the Crown are void, the Court said (*q*), that "A grant of the sole use of *a new invented* ART, is good, being indulged for the encouragement of ingenuity; but this is tied up by the statute of 21 James I. c. 3. s. 6, to the term of fourteen years; for after that time it is presumed to be a known *trade*, and to have spread itself among the people." And after stating the reasons why restraints of trade created by grants and charters from the Crown, and by-laws, are generally void (*r*), the Court proceeds to say, "But none of the cases of customs, by-laws to enforce these customs, and *patents for the sole use of a new invented* ART, are within any of these reasons; for here no man is abridged of his liberty or disseised of his freehold; a custom is *lex loci*, and foreigners have no pretence of right in a particular society exempt from the laws of that society;

(*o*) Hawk. P. Cr. Part I. c. 79, s. 20.
(*p*) 1 P. Wms. 181; 10 Mod. 130, *S. C.*
(*q*) 1 P. Wms. 183.
(*r*) 1 P. Wms. 188.

and as to new invented ARTS *nobody can be said to have a right to that which was not in being before*; and therefore it is but a reasonable reward to ingenuity and uncommon industry."

The case of *Mitchell* v. *Reynolds* was cited, and highly approved of by the Court of Common Pleas, in the case of *The Master, Wardens and Society of Gunmakers* v. *Fell* (*s*).

The same law is laid down in Bacon's Abridgment under the title Monopoly (*t*), where it is said, "But it seemeth clear that the King may for a reasonable time make a good grant to any one of the sole use of *any* ART invented or first brought into the realm by the grantee." Bacon's Abridgment.

And under the title prerogative (*u*), in the same work, is the following passage to the same effect, "It is agreed that the King may for a reasonable time grant to a person the sole use of *any* ART first invented by him; *and this it seems the King might do at Common Law, and is therefore excepted out of the Statute of Monopolies.*"

It seems therefore that at Common Law, any new *art* of producing an article of trade or commerce might be made the subject of a patent privilege; and the grant of such a privilege appears to come precisely within the description of grants of privilege of the sole working or making of any manner of new manufactures excepted in the Statute of Monopolies. Common law authorities agree with the statute.

The law as laid down in the Common Law authorities which have been cited respecting the subjects of patent privileges, appears to have been lost sight of in the cases which have been decided on the subject since the passing of the Statute of Monopolies. Indeed in almost all the subsequent cases the Courts appear to have decided the questions before them, merely upon the construction of the word "manufactures," contained in the sixth section of the Statute of Monopolies. Common law authorities lost sight of since the statute.

The consequence has been a great deal of confusion and uncertainty as to what might be made the subject of a grant by patent, within the meaning of the word "manufactures," much if not all of which might have been avoided if the old authorities had not been so entirely neglected.

According to the reported cases on Patent Law, it was long Long doubtful whether a mode

(*s*) Willes. R. 388.
(*t*) Bac. Abr. tit. Monop.
(*u*) Bac. Abr. tit. Prerog. (F. 4.)

or process could be the subject of a privilege.

doubted whether a mode, method, or process of itself, and apart from its produce or results, could legally be made the subject of a patent privilege; and this point remained doubtful until the question was expressly decided by the Court of Common Pleas, in favour of such a grant, in the recent case of *Crane* v. *Price* (*x*).

Dicta in favour of such privileges.

Prior to that decision, however, there were many cases and dicta to be found in our books, which strongly supported the general opinion of the profession that such grants were valid.

Boulton v. Bull.

Thus in the case of *Boulton and Watt* v. *Bull* (*y*), the Lord Chief Justice *Eyre* said, "When the effect produced is some new substance or composition of things, it should seem that *the privilege* of the sole working or making ought to be for such new substance or composition, without regard to the mechanism or process by which it has been produced, which though perhaps also new, will be only useful as producing the new substance. When the effect produced is no substance or composition of things, the patent can only be for the mechanism, if new mechanism is used, *or for the process, if it be a new method of operating* with or without old mechanism by which the effect is produced." His Lordship also said, that in the list of patents with which he had been furnished, there were several for new methods of manufacturing articles in common use, where the sole merit and the whole effect produced were the saving of time and expense, and thereby lowering the price of the article, and introducing it into more general use. And his Lordship added, that he thought these methods might be said to be new manufactures in one of the common acceptations of the word, as we speak of the manufacture of glass, or any other thing of that kind. And speaking of the patent in question in that case, the same learned Judge said, "The patent cannot be for the effect produced, for it is either no substance at all, or what is exactly the same thing as to the question upon a patent, no new substance, but an old one produced advantageously for the public. It cannot be for the mechanism, for there is no new mechanism employed: it must then be for the method; and I would say, in the very significant words of Lord *Mansfield*, in the great

(*x*) 4 M. & G. 580.

(*y*) 2 H. Bl. 463.

case of the copyright (*z*), it must be for method detached from all physical existence whatever." And in another part of his judgment his Lordship said, "Under the practice of making we may class all new artificial manners of operating with the hand, or with instruments in common use, *new processes in any art* producing effects useful to the public."

In the case of *The King* v. *Wheeler* (*a*), Lord C. J. *Abbott* said, in delivering the judgment of the Court, that the word "manufacture" might perhaps extend to a new process to be carried on by known implements or elements, acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or of a better or more useful kind. R. v. Wheeler.

In the case of *Hall* v. *Jarvis* (*b*), it appeared that the plaintiff's invention was, in substance, the application of the flame of gas instead of the flame of oil to remove the superfluous fibres from lace and other goods; and althought it is evident that this is a mere process, yet it was held (at Nisi Prius) that the plaintiff's patent for this invention was good. Hall v. Jarvis.

The case of *Hall* v. *Jarvis* was cited and approved of in the cases of *Losh* v. *Hague* (*c*), and *Crane* v. *Price* (*d*).

In the case of *Hill* v. *Thompson* (*e*), Lord *Eldon*, L. C., said that there might be a valid patent for a new combination of materials previously in use for the same purpose, *or for a new method of applying such materials.* And in that case the patent was for improvements in the smelting of iron, and the invention consisted only in the use and application of lime and mine rubbish in the manufacturing of iron. Hill v. Thompson.

In the case of *Morgan* v. *Seaward* (*f*), Mr. Baron *Parke* said, in delivering the judgment of the Court of Exchequer, "The word 'manufacture' in the statute must be construed one of two ways; it may mean the machine when completed, *or the mode of constructing the machine.*" Morgan v. Seaward.

And in the case of *Gibson* v. *Brand* (*g*), the Lord Chief Justice *Tindal* said, that it was not necessary in that case to go into the question, whether or not a patent can be supported for a *process* only. If the specification were properly prepared, Gibson v. Brand.

(*z*) 4 Burr. 2397.
(*a*) 2 B. & Ald. 345.
(*b*) 1 Webs. R. 100.
(*c*) *Ibid.* 207.
(*d*) 4 M. & G. 580.
(*e*) 3 Mer. 626; 1 Webs. R. 237.
(*f*) 2 M. & W. 544.
(*g*) 4 M. & G. 179.

(his Lordship said), it probably might be considered a fit subject for a patent. And then his Lordship cited the words of Lord J. C. *Eyre*, in *Boulton* v. *Bull* (*h*), and of Lord C. J. *Abbott*, in *The King* v. *Wheeler* (*i*), which have already been given.

Crane v. Price.

The case of *Crane* v. *Price* (*k*), already mentioned, at length expressly decided, that a mere process may be made the subject of a patent privilege. In that case the plaintiff's invention consisted in the use of hot air blast and stone coal in the smelting of iron. The use of hot air blast in smelting was well known before the date of the patent, and stone coal had also been used in the smelting of iron, but the two things had never been used together before the plaintiff obtained his patent. It was objected for the defendant that this combined process could not be the subject of a grant by patent; but the Court of Common Pleas held that the combination of processes invented by the plaintiff was an invention within the meaning of the statute, and might well become the subject of a patent privilege.

A new process is an invention within the meaning of the statute.

There is another case which, when properly considered, also amounts to a decision, that a process may legally be made the subject of a patent privilege.

Russell v. Cowley.

The case is *Russell* v. *Cowley* (*l*), decided by the Court of Exchequer, in which the patent in question was granted to C. Whitehouse, for certain improvements in manufacturing tubes for gas and other purposes. According to the invention a long strip of flat iron was to be prepared for welding, by being bent up or turned over at the sides, until the edges met, or nearly met, so as to form a tube. The tube was then to be heated, and to be drawn through a circular hole by which the edges of the iron were pressed together and firmly welded. It appeared that prior to the date of the patent, tubes had been made by the defendants, in a mode precisely similar in principle, but with a stamp or maundril in the centre. In fact, the plaintiff's mode of making tubes was precisely the same as the defendants, with the exception of the stamp or maundril, which according to the plaintiff's invention was entirely dispensed with, and the result was a very considerable saving in the

(*h*) 2 H. Bl. 463.
(*i*) 2 B. & Ald. 349.
(*k*) 4 B. & C. 580.
(*l*) 1 C. M. & R. 864.

expense of manufacturing tubes, and the quality of the tubes was improved. The Court of Exchequer held that the invention was an invention to manufacture tubes without the use of any maundril or internal support, and that being now it was sufficiently distinct from the prior mode used by the defendant, to enable the plaintiff to support the patent (*m*). The tubes in this case could not be the subject of the patent privilege, for they were not new; nor was there any machine which could be said to be the subject of the privilege. The only thing therefore which could be the subject of the privilege was the new art or process by means of which the edges of the strips of iron were welded together, for the purpose of manufacturing the tubes.

Observations on cases.

These cases show clearly that a process of manufacturing separate and apart, not only from the substances used in the process, but also from the things produced by means of it, may be made the subject of a patent privilege. Those cases appear however to have been decided upon the construction of the word "manufactures," contained in the sixth section of the Statute of Monopolies, and without considering what the subject of a patent privilege must in every case necessarily be; but it will be seen presently that the subject of a valid privilege must be *an art*, however it may be entitled, by whatever name it may be known. Patentees seem, indeed, to have found that this must be so, for there has been a most extensive use of such words as "mode" and "method" in the titles which have been given to patent inventions.

Meaning of the words mode and method.

The meaning of the words mode and method was much discussed in the case of *Boulton and Watt* v. *Bull* (*n*). Mr. Justice *Heath* said in that case, "When a mode of doing a thing is referred to something permanent, it is properly termed an engine; when to something fugitive, a method;" and that a "method is a principle reduced to practice." Mr. Justice *Rooke* said, that a new invented method conveys the idea of a new mode of constructing.

Doubts respecting the validity of a privilege for a method.

The narrow construction of the word "manufactures," as signifying merely things made, at one time caused great doubt

(*m*) The term granted by Whitehouse's patent was afterwards extended by the Privy Council for six years, and their Lordships highly extolled the invention; see 1 Webs. R. 473.

(*n*) 2 H. Bl. 463.

to be entertained respecting the validity of a patent, when the title described it as a mode or method, and the difficulty was only got over by disregarding the literal signification of the word used in the title, and construing it as meaning the article produced by means of the invention. The objection taken to a method being made the subject of such a privilege was, that it was a mere principle, and therefore not within the meaning of the word manufactures in the Statute of Monopolies.

Objection that a method is merely a principle.

Watt's invention.

Boulton *v.* Bull.

The leading case on this subject is *Boulton and Watt* v. *Bull* (*o*), which was an action for an infringement of a patent for an invention, intituled "a method of lessening the consumption of steam and fuel in fire-engines." The specification commenced as follows:—"My method of lessening the consumption of steam, and consequently fuel in fire-engines, consists of the following principles:" and then the patentee proceeded to describe the nature of the invention, according to which the cylinder of the engine was to be kept hot, the steam condensed in a separate vessel, the superfluous air, &c., was to be drawn out of the cylinder and condenser by air-pumps, the expansive force of steam was to be used in some cases instead of the pressure of the atmosphere, &c.

At the trial, a special case was reserved for the opinion of the Court of Common Pleas, in which it was twice argued. The principal objection taken to the patent on behalf of the defendant was that the patent was for a principle, and that a principle is not a manufacture within the meaning of the exception contained in the 6th section of the Statute of Monopolies.

The Court was equally divided in opinion respecting the validity of the patent, two of the Judges being of opinion that the invention was a manufacture within the meaning of the Patent Laws, and the other two, that it was not such a manufacture.

Mr. Justice *Rooke* said, "The term 'principle' is equivocal; it may denote either the radical elementary truths of a science, or those consequential axioms which are founded on radical truths, but which are used as fundamental truths by those who do not find it expedient to have recourse to first principles." Mr. Justice *Heath* said, "The Marquis of Worces-

(*o*) 2 H. Bl. 463; Dav. P. C., 162.

ter discovered, in the last century, the expansive force of steam, and first applied it to machinery. As the original inventor he was clearly entitled to a patent. Would the patent have been good applied to all machinery, or to the machines which he had discovered? The patent decides the question. It must be for the vendible matter and not the principle. Another objection may be urged against the patent upon the application of the principle to an old machine, which is, that whatever machinery may be hereafter invented would be an infringement of the patent if it be founded on the same principle. If this were so, it would reverse the clearest positions of law respecting patents for machinery, by which it has been always holden; that the organization of a machine may be the subject of a patent, but principles cannot." Mr. Justice *Buller* said, that "The very statement of what a principle is, proves it not to be a ground for a patent: it is the first ground and rule for arts and sciences; or, in other words, the elements and rudiments of them. A patent must be for some new production from those elements, and not for the elements themselves." And Lord Chief Justice *Eyre* said, "Undoubtedly there can be no patent for a mere principle; but for a principle so far embodied and connected with corporeal substances as to be in a condition to act and to produce effects in any art, trade, mystery, or manual occupation, I think there may be a patent."

All the four Judges before whom this case was argued were of opinion, that a principle could not be made the subject-matter of a grant by patent; but they differed in opinion as to the construction of the title and specification, two of them deeming that the intention of the patent was to grant, and of the specification to claim, the sole use of a principle which did not come within the meaning of the law in favour of patents; whilst the other two Judges were of opinion, that notwithstanding the alleged improper use of the words method and principle in the patent and specification, the invention was substantially the engine or machine by which the method or principle was to be carried into effect, and that the misapplication of the terms method and principle did not signify, because it was clear that the words in the patent and specification were substantially intended to describe the machine,

engine, and effect produced, and not merely the principle upon which the invention was founded.

R. v. Wheeler. Abstract principle not a manufacture.

In the case of *The King* v. *Wheeler* (*p*), the Court of King's Bench laid it down as law, that no merely philosophical or abstract principle can answer to the word manufactures, in the proviso in the Statute of Monopolies; and that something of a corporeal and substantial nature, something that can be made by man from the matters subjected to his art and skill, or *at the least some new mode of employing practically his art and skill, is requisite to satisfy this word.*

First principles cannot be the subject of patent privileges.

It is clear indeed that first principles, such as the fundamental laws of mechanics, chemistry, or any other science, cannot be made the subject of a patent privilege. First principles are capable of an endless variety of uses or applications, and they are the common property of all men, who are at liberty to make any use of them they may think fit, or apply them in any manner their ingenuity may suggest, provided they do not attempt to appropriate to themselves exclusively any ground preoccupied by any other person. No principle or primary law of science can of itself, and apart from the practical application of it, be capable of producing any vendible article or manufacture; and therefore unless a person who discovers such a principle or law makes some practical use of it, so as to produce some article which the public requires and will purchase, he cannot give the public the consideration which the law requires to be given for the grant of a sole privilege. The object of the law was not to reward mere speculative discovery, but to encourage industry, and procure for the public the benefit of new manufactures.

Every art must adopt principle.

But every art or invention must adopt principle, or include the application of it to some extent (*q*), and the principle of an invention thus becomes an essential part of it; indeed any new art which is made the subject of a grant by the Crown can only be some new practical application of principles or laws, which has been invented by the patentee, for the purpose of producing articles of manufacture useful to the public.

Principle frequently used

The word "principle" is frequently used in such phrases

(*p*) 2 B. & Ald. 349.

(*q*) Vide per Lord *Lyndhurst*, C. B., in *Minter* v. *Wells*, 5 Tyr. 165.

as "principle of the invention," to designate some peculiar mode or method of constructing any thing according to a particular invention. In this sense a principle signifies the particular practical application of some principle or principles, for the purposes of an invention which is properly speaking an art. Thus the principle of an invention of a new machine, signifies the peculiar art by means of which the new machine is constructed. There is nothing improper in this use of the word principle; and when it is so used, that is, when it is used to designate the peculiar mode of constructing anything according to an invention, it is clearly an art which may be made the subject of a patent privilege.

to designate method of constructing.

The form of patent for granting privileges in the useful arts, has continued to be the same in all essential particulars ever since the passing of the Statute of Monopolies; and if such a grant be examined, it will be seen that the form and effect of it are in perfect accordance with what has been stated respecting the subject of a patent privilege.

Form of patent since the statute.

It has already been shown that the effect of a patent is to grant a sole or exclusive privilege (*r*). The patent itself purports to grant such a privilege in the *invention*, and the question is, what is meant by the word invention, which according to the patent the patentee is to have the sole use of?

What is meant by the word invention in a patent?

It is important to distinguish between the use of an invention which a patentee has thus granted to him, and the articles or results which may be produced by means of the invention. At the time a patent is granted the patentee must have made the discovery or invention to which the grant relates; but an inventing or discovering of any thing is essentially an operation of the mind, and it is not necessary that the inventor should have actually made or produced any thing by means of his invention; and, indeed, one class of inventions, *viz.*, imported inventions, are hardly ever used, even experimentally, in this country before the date of the patent. And if a patentee happens to have produced any article of manufacture by means of his invention prior to the date of his patent, the privilege granted to him by the Crown does not vest in him the sole use of such article; for unless he has transferred it to some other person, he remains the proprietor

Important to distinguish between the use of an invention and its products.

Patent does not grant the use of articles produced by an art or invention.

(*r*) Vide *ante*, Chap. IV. p. 53, and *ante*, p. 78.

of it, and has the sole dominion over it as being part of his own property; and he alone has the privilege of using it as he pleases, *and that wholly independent of the privilege granted to him by his patent.* And with respect to articles which are to be made by the patentee *after* the date of the patent, it is clear that he does not acquire the sole use of them by force of the grant of privilege contained in the patent; for they must necessarily be composed of materials which he must purchase or acquire a right to without the aid of the patent; and they must also be produced by power or labour, which the patentee must pay for or bestow upon those materials in some shape or other.

An infringement consists in a use of the art comprised in a privilege.

If any person, except the patentee, make articles according to the patentee's invention, he commits an infringement of the patent, and yet the privilege granted by the patent did not vest any right in the patentee to make the particular articles which have been made in violation of the patent, for the materials of which they are composed were never his property, and therefore he could not exercise any control over them. But the person who thus makes such articles must necessarily use the art invented by the patentee, and so infringes the patent.

The art is the only subject of a privilege.

The only thing therefore which can be the subject of the privilege granted by a patent, is the ART by means of which the articles are made or manufactured; and the privilege granted by the patent not only secures to the patentee the right of using the art himself, but gives him the sole right, or the right to exercise it to the exclusion of all other persons during the term limited by the patent.

And when any one makes any thing contrary to a patent privilege, the infringement consists in the use of the art invented by the patentee, and which the patentee has, by virtue of the patent, acquired the sole privilege of exercising for his own profit and benefit (*s*).

Illustration.

To illustrate the meaning of this, let us suppose a person to have obtained a patent for an invention of a new chair. The patent privilege does not include the sole use of every or any chair made or to be made according to the invention,

(*s*) See further respecting what is an infringement of a patent, *post*, Chaps. X. and XI.

but it grants the sole use of the art, by means of which such chairs may be produced. That the patent would not in such a case grant the sole use of chairs made according to the invention is evident, because no one could be liable to an action for infringing the patent by merely sitting down upon or using a chair which may have been made by some other person in violation of the patent.

The word invention then in a patent grant means the art which the patentee alleges that he has invented, and therefore that art is the subject of the privilege which is granted by the patent.

"Invention" in a patent means the art invented by the patentee.

If a valid patent be thus construed, the subject of the privilege which it grants, will appear to be an art within the meaning of the Common Law authorities, which have been cited.

This construction of a patent agrees with the common law authorities.

It has been stated already that the object of the proviso contained in the sixth section of the Statute of Monopolies (*t*) was to preserve the Common Law authority vested in the Crown, and the words of that proviso are in accordance with the construction here put upon the grant of a patent privilege (*u*).

The Statute of Monopolies also in accordance with this construction of a patent.

The recital which has always been inserted in a patent for an invention, ever since the passing of the Statute of Monopolies, after stating the substance of the patentee's petition for a patent, *pursuant to the statute in such case made and provided*, concludes with these words, "and we being willing to give encouragement to all *arts* and inventions which may be for the public good, are graciously pleased to condescend to the petitioner's request" (*x*). This shows that the exception in the statute has always been construed to extend to grants of the sole use of useful *arts* and inventions, and that the intent of a grant by patent is to vest in the patentee the sole use of such an art, and not of the articles made according to it.

Recital in a patent shows that the privilege is intended to apply to the art.

The language of Lord *Ellenborough*, in the case of *Huddart* v. *Grimshaw* (*y*), strongly confirms the view here taken respecting the subject-matter of a privilege granted by letters patent. His Lordship there said, "In inventions of this sort, and every

Huddart v. Grimshaw. Language of Lord Ellenborough confirms what has been said.

(*t*) 21 Ja. I. c. 3.
(*u*) Vide *ante*, p. 91.
(*x*) Vide *ante*, Chap. IV. p. 47, 48.
(*y*) Dav. Pat. Cas. 278.

other through the medium of mechanism, there are some materials which are common, and cannot be supposed to be appropriated in the terms of any patent. There are common elementary materials to work with in machinery, but *it is the adoption of those materials, to the execution of any particular purpose, that constitutes the invention*: and if the application of them be new, if the combination in its nature be essentially new, if it be productive of a new end, and beneficial to the public, it is that species of invention, which, protected by the King's patent, ought to continue to the person the sole right of vending it."

The invention in that case was intituled "a new mode, or art, of making great cables and other cordage so as to attain a greater degree of strength therein by a more equal distribution of the strain upon the yarns." And, according to the construction which it is contended must necessarily be put upon the patent, the privilege it granted was the sole use of the art of making cables and cordage of a particular description; and the cables and cordage produced being clearly manufactures, the subject-matter of the grant was an invention of an art, of making a manufacture within the proviso contained in the Statute of Monopolies.

No patent for a new use of an old thing. Kay v. Marshall.

There cannot be a valid patent privilege for a new use of an old invention. This was in effect decided by the recent case of *Kay* v. *Marshall* (*z*), which was ultimately determined by the highest tribunal in the kingdom. In that case the patentee applied to flax-spinning machinery of a description which had been before applied to the spinning of cotton and other fibrous materials, and it was held by the Court of Common Pleas, afterwards by the Master of the Rolls, and ultimately by the House of Lords, that the patent was void.

The mode of producing the machinery used in that case was really an old art, and so also was the mode of spinning used by the patentee; and therefore neither of those arts could be made the subject of the privilege which the patent purported to grant. And the reason why such a patent is void, is, that there is no new art which can be made the subject of the patent privilege, the patentee having merely applied an old art to a new use.

(*z*) 5 Bing. N. C. 492; 1 Beavan, 535; and 8 Cl. & Fin. 245.

In the case of *Losh* v. *Hague* (*a*), which was an action for infringing the plaintiff's patent for "improvements in the construction of wheels for carriages to be used on railways," tried before Lord *Abinger*, C. B., it was contended that wheels invented before the date of the patent were substantially the same as the plaintiff's; and his Lordship, amongst other things, said to the jury, that "If the wheels had been made and sold to any one individual, the public's not wanting them, because there were no railways, their not being adapted to any particular use which at that time was open to the public to apply them to, makes no difference."

Losh v. Hague. A new use not the subject of a patent privilege.

In the same case, Lord *Abinger* also said to the jury (*b*), "The learned counsel has mentioned to you a particular case (*c*) in which an argand lamp, burning oil, having been applied for singeing gauze, somebody else afterwards applied a lamp supplied with gas for singeing lace, which was a novel invention, and for which an argand lamp is not applicable, because gas does not burn in the same way as oil in an argand lamp. But a man having discovered by the application of gas he could more effectually burn the cottony parts of the gauze by passing it over the gas, his patent is good. That was the application of a new contrivance to the same purpose; *but it is a different thing when you take out a patent for applying a new contrivance to an old object, and applying an old contrivance to a new object*—that is a very different thing: if I am wrong I shall be corrected. In the case the learned counsel put, he says, if a surgeon goes into a mercer's shop, and sees the mercer cutting velvet or silk with a pair of scissors with a knob to them, he seeing that would have a right to take out a patent in order to apply the same scissors to cutting a sore or a patient's skin. I do not quite agree with that law. I think, if the surgeon had gone to him (the mercer) and said, 'I see how well your scissors cut,' and he said, 'I can apply them instead of a lancet, by putting a knob at the end,' that would be quite a different thing, and he might get a patent for that; but it would be a very extraordinary thing to say, that because all mankind have been accustomed to eat soup with a spoon, that a man could take out a patent because he

New contrivance for effecting an old object is the subject of a privilege, but not the application of an old contrivance to a new object.

(*a*) 1 Webs. R. 202.
(*b*) *Ibid.* 207.
(*c*) *Hall* v. *Jarvis*, 1 Webs. R. 100.

Applying a well known thing to *an operation* analogous to what was known before, not the subject of a privilege

says you might eat peas with a spoon. The law on the subject is this; that you cannot have a patent for applying a well known thing which might be applied to 50,000 different purposes, for applying it to an operation which is exactly analogous to what was done before. Suppose a man invents a pair of scissors to cut cloth with, if the scissors were never invented before, he could take out a patent for it. If another man found he could cut silk with them, why should he take out a patent for that?" His Lordship also said to the jury, "If you are of opinion this wheel has been constructed according to the defendant's evidence by the persons who have been mentioned, long before the plaintiff's patent, that although there were no railroads then to apply them to, and no demand for such wheels, *yet that the application of them to railroads afterwards by Mr. Losh will not give effect to his patent*, if part of that which is claimed as a new improvement by him, is, in fact, an old improvement, invented by other people, and used for other purposes."

Subject of privilege in Losh v. Hague.

The subject of the patent privilege in the case of *Losh* v. *Hague* (*d*), was the art of manufacturing a certain description of carriage wheels, which were described as capable of being used on railways. And if it were shown that this art had been known and used before the date of the patent in the manufacture of wheels *for any purpose whatsoever*, the art was not new when the patent was granted; and therefore notwithstanding the new use or application of the wheels to run on railways instead of common roads, the patent would be void, such a new use, as we have shown already, not being capable of being made the subject of a patent privilege.

The observation made by Lord *Abinger*, in *Losh* v. *Hague*, that "it is a different thing when you take out a patent for applying a new contrivance to an old object, and applying an old contrivance to a new object," is most important, and shows that what the law requires is, that the art or contrivance, which is *the subject of the privilege*, *must be new*, and that it is not sufficient that the object or application of a contrivance is new if the contrivance itself be old.

That the invention of a mere process may be made the sub-

(*d*) 1 Webs. R. 202.

ject of a grant by patent, has been established by the case of *Crane* v. *Price* (*e*), although the object or produce of the invention is old and well known; but that case shows that the process itself must be new, in order to be the subject of a valid patent privilege. The "applying of a new contrivance to an old object," means a new art invented for the manufacturing articles or producing effects previously known; but the art itself, which (as we have seen) must be the subject of the patent, being new, the want of novelty in the produce of the art is no objection to the patent.

But the "applying an old contrivance to a new object," is merely a new use or application of an art or invention previously well known; and as the art or invention is not new, it cannot be granted by patent; nor, as we have already seen (*f*), can the new use of it be made the subject of such a grant of privilege.

In the case of *Hall* v. *Jarvis* (*g*), referred to by Lord *Abinger* in *Losh* v. *Hague* (*h*), the invention was of a new process of singeing the superfluous fibres of gauze or lace by means of the flame of gas; the flame of oil having been previously applied to a similar purpose; but the flame of gas, which produces a very different effect, had never been applied in the same or in any similar way. This application of gas flame was, therefore, an entirely new art; and being also an art applicable in the manufacture of vendible articles, it was clearly capable of being made the subject of a grant by patent. But if, before the date of Hall's patent, gas flame had been applied to any purpose similar to that of singeing gauze or lace, then the *art* would not have been new, and the patent would have been void. Hall v. Jarvis.

The same law is also applicable to the produce of any art, or the articles produced by means of the exercise of an art; and, therefore, a new use of such articles cannot be made the subject of a patent privilege, unless, indeed, such new use form an essential part of some other art of working or making vendible manufactures, which may legally be made the subject of a privilege. No valid privilege for the new use of articles separate from an art.

(*e*) 4 M. & G. 580.
(*f*) Vide *ante*, p. 94, 95.
(*g*) 1 Webs. R. 207.
(*h*) *Ibid.* 100.

Boulton v. Bull. In the case of *Boulton* v. *Bull*, Mr. Justice *Buller* said (*i*), "Suppose the world were better informed than it is how to prepare Dr. James's fever powder, and an ingenious physician should find out that it was a specific cure for consumption, if given in particular quantities? I think it must be conceded that such a patent would be void: and yet the use of the patent (invention) would be new, and the effect of it as materially different from what it is now as life is from death. So in the case of a late discovery, which as far as experience has hitherto gone, is said to have proved efficacious—that of the medical properties of arsenic in curing agues—could a patent be supported for the sole use of arsenic in aguish complaints?"

Observations. In the case of Dr. James's fever powder mentioned by the learned Judge, it is clear that if the original inventor had obtained a patent privilege, the subject of it would have been the new art of manufacturing the powder, which is notoriously a vendible article, and therefore, according to the definition already given, the invention would come within the meaning of the law which authorizes the grant of patent privileges for inventions. The description of the powder, "*fever* powder," would merely point out a use which *may* be made of the article produced by means of the art or invention, which would be comprised in the patent privilege: but such use of the powder would not be any part of the subject of the privilege, which would be merely the art by means of which the powder is manufactured. For the art of using the powder in curing fevers, would not be an art of manufacturing vendible articles, which, as we have seen, is requisite in order to make an art the subject of a grant by patent (*k*), and the art of using the powder in curing pulmonary consumptions would be an art of precisely the same description, totally inapplicable in the manufacturing of any vendible article, and therefore clearly not such an art as could be made the subject of a patent privilege. The only thing therefore respecting Dr. James's fever powder, which could be made the subject of a patent privilege, was the art by means of which the powder is manufactured or produced; and as that art had been known and

(*i*) Dav. P. C. 199, 200.
(*k*) Vide *ante*, p. 55, 81, and *post*, p. 101, 102.

practised in the production of the powder for the purpose of curing fevers, it could not be deemed new merely because some new use of its produce had been discovered, nor could the new use of the powder itself be made the subject of a privilege for the reason already given.

The same observations evidently apply with equal force to the supposed case of a patent for the use of arsenic in curing aguish complaints. The particular use or application of any preparation of arsenic *in curing any disorder*, not being the subject of a patent, and the art of preparing the drug for some use or purpose being known, the sole use of the art of preparing it cannot be made the subject of a patent privilege, merely because some new use or application of it has been discovered, nor could the new use of the drug be made the subject of such a privilege.

The nature of manufactures.

If we consider the nature of the articles or manufactures produced by the exercise of an art or invention, we shall find the strongest confirmation of what has been said respecting the subject of a patent privilege.

Lord Kenyon's definition of a manufacture.

In the case of *Hornblower* v. *Boulton* (*l*), Lord *Kenyon*, C. J., said, that he understood a manufacture to be something made by the hand of man. This was doubtless one of the primary significations of the word manufacture at a time when manual labour was the chief, if not the only power applicable in the production of manufactures; but that state of things has long passed away, and very few of the articleswhich are properly called manufactures, are now produced by the direct or immediate application of manual labour. As, however, all the machinery used in our manufactories is made directly or indirectly by the hand of man, and the machines themselves require the hand of man to direct and regulate them, there does not seem to be any thing improper in the application of the term manufactures, as explained by Lord *Kenyon*, to signify the products of such machinery (*m*).

Things necessary to produce a manufacture.

In order to produce a manufacture or manufactured article, three things or classes of things only are necessary: *firstly*, The crude or raw material; *secondly*, The power by which the material is operated upon; and, *thirdly*, The art, skill, or

(*l*) 8 T. R. 98; Dav. P. C. 225.
(*m*) See the double signification of the word manufacture, mentioned *ante*, p. 80.

cunning; by means of which the power is directed in its operation upon the raw material.

Materials.

Whilst matter remains in a state of nature, and before it has been operated upon, it cannot come within the meaning of the word manufacture; and for the production of many manufactures, the original elements found in nature, which enter into their composition, must be subjected to many, and frequently extremely complicated, processes.

Power.

The power which is applied to matter in its original state in order to render it fit for the use of man, may be of any description sufficient to produce the desired effect, such as manual labour, the power of the steam-engine, water power, &c. And without the requisite physical power it is clear that the raw material could not be transformed into the manufactured state.

Art or skill.

And however numerous and excellent our materials for manufacturing may be, and however great the extent of the physical power we have at command, we shall still be unable to produce any manufacture unless we have also the *art* or *skill* to direct our power or labour in its operation so as to produce the desired result. But having acquired the art or skill, and having the materials, and also the requisite power within our reach, we have no further difficulty in compassing our object in the production of any desired manufacture.

Materials and power not the subject of a patent privilege.

The raw materials which are used, and the power which is exercised, in the production of manufactures, are things which are well known, and which (apart from the question of property) may be said to be in common with all mankind, to be used or applied in any way they may think fit, and they cannot by themselves be made the subject of a patent monopoly.

An art alone can be made the subject of a privilege.

And therefore, as we have already shown (*n*), it is only the art by means of which a manufacture is produced which can be made the subject of an exclusive privilege; and it is only such an art as this that (when newly discovered) is properly an invention within the meaning of our Patent Law.

The art or invention by means of which articles of manufacture are produced, may be denominated the metaphysical part of the manufacture, for it has its origin in the mind, and by the mind must power always be directed in order to produce a manufacture.

Such arts may properly be termed useful arts, in contradistinction to the fine arts. And the nature of the art which may be made the subject of a patent privilege is well illustrated by comparing it with some of the productions of the fine arts, in which their authors or inventors obtain privileges or copyrights by virtue of the provisions of various statutes.

Distinction between the useful and the fine arts.

Thus the person who first invented the art of copper-plate engraving, or of lithography, might have had a patent privilege for his invention; for it was a new art applicable to the production of prints, according to any design which might be invented by the artist, and such prints are clearly vendible articles, or articles of commerce.

The art of engraving one of the useful arts.

A new design for a print or engraving may be made the subject of a privilege, that is to say, the author may acquire a copyright in it by complying with the provisions of certain Acts of Parliament. But such a design cannot be made the subject of a patent privilege, because, although it is new, it is not a new *art*, nor is it an art of working, or making manufactures, or articles of commerce; but, on the contrary, it is merely the produce of an art, or produced by the exercise of one of the fine arts, the art of designing, which is an old and well-known art.

A design for an engraving the produce of one of the fine arts.

The making of copies to which the privilege in such a design extends, is effected by the exercise of the art of printing, which is a very different art from that by means of which the design, or even the engraving, was produced; but in making articles according to an invention which may be legally comprised in a patent privilege, it becomes necessary to exercise the art of working or making, which has been invented by the patentee, and it may be an art applicable in the making of articles according to an infinite variety of designs.

The art must be for the production of articles of commerce.

Articles must be vendible.

The art of working or making, which is made the subject of a patent privilege, must (as already stated) be an art for the production of vendible articles, or articles of trade or commerce capable of being bought and sold. That a patent article, or article produced by means of an invention, must be vendible, is laid down in several cases (*o*), and there are two

(*o*) See per *Heath*, J., in *Boulton* v. *Bull*, 2 H. Bl. 463; per *Abbott*, C. J., in *R.* v. *Wheeler*, 2 B. & Ald. 349; and the judgment of the Court in *Cornish* v. *Keene*, 3 N. C. 570; in which last case the patent article was said to be a vendible article produced by the *art* and hand of man.

reasons why the articles manufactured according to a patent invention must be vendible: *firstly*, Because if such articles cannot be sold, the invention will not be used, and therefore will not give any new employment to the people, and the public will receive no benefit from the invention; and, *secondly*, Because the intent of the patent is to reward the inventor by means of the profit arising from the making and selling the patent articles during the continuance of the privilege.

If patent articles not vendible, the patent is void.

A patent privilege for such an art would be void, because the art is not such as comes within the meaning of the Patent Law (*p*), and therefore is not such an art as could legally be made the subject of a patent privilege.

And it has already been shown (*q*), that if the Queen's grant cannot take effect according to the intent of it, it will be absolutely void; and a patent privilege for an art which is incapable of producing vendible articles must therefore be void for both of the reasons just stated. For the intent of the grant is clearly to benefit the public and reward the patentee; and an art for producing an article not vendible cannot benefit the public, nor can a sole privilege in such an art produce any profit to the patentee.

Section II.

Of the Novelty of an Art or Invention which is required in order to make it a good Subject of a Patent Privilege.

Novelty an essential quality.

One essential requisite in every art or invention which is made the subject of a patent privilege, is, that it should be new at the time the privilege is granted. This is required for two reasons:—*Firstly*, Because no one can lawfully be deprived of the right to use a known art or trade; and, *secondly*, Because if an invention is known, the public will receive no consideration from the patentee for the grant of the sole right of using it.

Novelty required at common law.

That the grant of a privilege in a known art or trade is illegal, was decided in several cases before the passing of the Statute of Monopolies. Thus in the case of monopolies,

(*p*) Vide *ante*, p. 81, 55.

(*q*) *Ante*, p. 48.

Darcy v. *Allein* (*r*), it was determined that a patent granting the sole making of playing cards was void, the art of making cards being known at the time of making the patent. So in the *Clothworkers of Ipswich* case (*s*), it was laid down that the grant by the King of the sole right to exercise the trade or occupation of a clothworker or tailor, or of any other known art or occupation, was contrary to law, and void. And in the case of *Mitchell* v. *Reynolds* (*t*), the Court of Queen's Bench laid down as law that a grant by the Crown of the sole exercise of any *known* trade is against the Common Law and *Magna Charta*, and is therefore void.

Case of monopolies.

Clothworkers of Ipswich case.

Mitchell v. Reynolds.

The same law is laid down in Sir Edward Coke's third Institute (*u*), in Bacon's Abridgment (*x*), Hawkins's Pleas of the Crown (*y*), and Sheppard's Abridgment (*z*).

The Queen's prerogative does not extend to any thing which is injurious to her subjects (*a*). She cannot by her patent do wrong (*b*), or enable another to do so (*c*); and we have seen (*d*) that in granting the sole use of inventions, the Crown acts on behalf of *and for the benefit of the public*.

The Queen cannot do a wrong.

Every person has *primâ facie* a right to search for discoveries and improvements in the useful arts, and to use any discovery of such an art which he may make in any manner he pleases (*e*). The grant of the sole use of an invention to any person restrains every other person from using it, during the term, even if he of himself and unaided should happen to make precisely the same discovery.

Primâ facie right of every person.

It would be unjust therefore to deprive any person of his liberty to make and use such inventions, if it were not for some consideration given by the patentee to the public. The only thing which a patentee gives to the public is a knowledge of his invention, and a patent is in effect a bargain between the patentee and the public, in which the public, in consideration of an inventor communicating to them a knowledge of his invention, so that they may afterwards be enabled to practise it,

It is the consideration given to the public, which makes a patent good.

(*r*) 11 Co. 86 a; Moor. 672.
(*s*) Godb. 254; 1 Rol. R. 4.
(*t*) 1 P. Wms. 181.
(*u*) Chap. 85, p. 181.
(*x*) Titles Monop. and Prerog. (F. 4.)
(*y*) Part I. c. 79, s. 2.
(*z*) Part III. pp. 61, 62.
(*a*) Finch, 84.
(*b*) 1 Co. R. 44 b, 45 b; Noy, R. 182; 3 Shep. Abr. 48.
(*c*) Godb. 254.
(*d*) *Ante*, Chap. II. p. 7.
(*e*) Vide *ante*, Chap. III.

No consideration of invention wants novelty.

grant to him the sole use of his invention for a limited time (*f*). But if an invention is not new, the patentee does not communicate any thing to the public which they did not know before; and therefore the patentee gives them nothing which can be considered as a consideration for the grant, and therefore the patent is wholly void.

Necessity for a consideration not confined to patents.

The necessity for a consideration to support such a bargain, is not confined to the law of patents; a promise made without consideration is not binding, and no action will lie for the breach of it (*g*); for in every contract there must be some good or valuable consideration between the parties, otherwise the contract is void (*h*).

Myddleton v. Lord Kenyon.

In the case of *Myddleton* v. *Lord Kenyon* (i), Lord *Loughborough*, L. C., said that "a bargain without consideration is a contradiction in terms, and cannot exist." And as a patent is a bargain between the public and an inventor, it cannot be supported if it be made without consideration.

All the old cases mention novelty as essential.

All the old authorities respecting the prerogative of the Crown to grant patent privileges, particularly mention novelty in the art or invention as essential to render a patent valid.

Darcy v. Allin.

Thus in the case of *Darcy* v. *Allin* (*k*), already cited, it is said "where any man by his own charge and industry, or by his own wit or invention, doth bring any *new trade* into the realm, or any engine tending to the furtherance of a trade that *never was used before*, and that for the good of the realm; that in such cases the King may grant to him a monopoly patent for some reasonable time, until the subjects may learn the same, *in consideration of the good that he doth bring by its invention to the commonwealth*; otherwise not."

Hasting's case.

In *Mr. Hasting's* case (*l*), it is said that a patent was granted to him in consideration that he brought in the skill of making frisadoes as they were made in Harlem and Amsterdam, beyond seas, *being not used in England.*

Humphrey's case.

In *Humphrey's* case (*m*), a patent was granted to him for the sole use of an invention of an instrument for melting lead.

(*f*) 14 Ves. 131, 136.
(*g*) *Rann* v. *Hughes*, 7 T. R. 350; *Barrell* v. *Trussell*, 4 Taunt. 117.
(*h*) Noy, Dialog. p. 44; Max. 87; Dr. & Stu. II. 24; Finch, Law, 34; and see Dyer, 76 a; Shep. Touch. 285.
(*i*) 2 Ves. Jr. 408.
(*k*) Noy, R. 182.
(*l*) *Ibid.*
(*m*) *Ibid.* 183.

And upon his suing persons for an infringement of the patent, a question was raised whether the instrument was newly invented by him, and the Court held that if a similar instrument had been used before the grant of the patent, Humphrey could not have the sole use of the invention.

In Moore's Reports (*n*), it is laid down that the King cannot grant a patent to restrain people in their usual trades and occupations; and that no occupation can be prohibited or put in monopoly, *but only such thing as is newly invented* by the skill of man, and that may be appropriated by patent.

So in the *Clothworkers of Ipswich* case (*o*), also before cited, it is said that "if a man hath brought in a *new* invention and a *new* trade within the kingdom in peril of his life and consumption of his estate or stock, &c., or if a man hath made a *new* discovery of any thing; in such cases the King of his grace and favour, in recompence of his costs and travail, may grant by charter unto him, that he only shall use such a trade or trafique for a certain time, because at first the people of the kingdom are ignorant, and have not the knowledge or skill to use it. But when that patent is expired, the King cannot make a new grant thereof; for when the trade is become common, and others have been bound apprentices in the same trade, there is no reason that such should be forbidden to use it." Clothworkers of Ipswich case.

In the case of the *Tailors of Ipswich* v. *Sherring* (*p*), it is said that "of a *new invention* the King can grant a patent," and that "where there is no new invention, the King cannot by his patent hinder any trade." Tailors of Ipswich v. Sherring.

So in the case of *Mitchell* v. *Reynolds* (*q*), it is laid down that a grant by patent of the sole use of a *new invented* art is good. Mitchell v. Reynolds.

In Sheppard's Abridgment (*r*), it is laid down that a monopoly patent may be granted "of that which any man at his own charge, wit, and invention, shall bring in as a *new* trade or device into the realm, or any *new* engine tending to the furtherance of it, for the good of the realm." In Bacon's Abridgment (*s*), it is said that, "the King may grant to a per- Shep. Abr. Bac. Abr.

(*n*) P. 672.
(*o*) Godbolt, 254.
(*p*) 1 Rol. R. 4, 5.
(*q*) 1 P. Wms. 183, 188.
(*r*) Part III. p. 61.
(*s*) Tit. Prerog. (F. 4.)

son the sole use of any art *first invented* by him." And the same law is laid down in Hawkins's Pleas of the Crown (*t*).

Hawk. P. Cr.

The authorities which have been cited, show clearly that by the Common Law, and independent of the Statute of Monopolies, an invention is required to be new in order to be capable of being made the subject of a valid patent privilege.

Statute of Monopolies.

The proviso in the 6th section of the Statute of Monopolies (*u*), which saves the prerogative of the Crown to grant patents for inventions, declares that the previous provisions of the Act (avoiding all monopolies whatsoever) shall not extend to letters patents and grants of privilege thereafter to be made of the sole working or making "of any manner of *new* manufacture within this realm," and "which others, *at the time of making such letters patent and grants*, shall not use."

Recital makes novelty part of the consideration.

We have seen also (*x*), that every patent recites the material allegations in the patentee's petition for the patent, one of which is, that the invention is new, or that it has not been used in this country, and therefore the novelty of the invention is thus made an essential part of the consideration for the grant made by the patent.

Novelty also required by the patent.

Every patent for an invention also contains (*y*) a condition for avoiding it in case the invention is not new as to the public use and exercise of it.

The novelty of an art or invention is therefore required, both by the Common Law and the Statute of Monopolies, in order to make it the legal subject of a patent privilege; and the want of novelty in an invention granted by patent also renders the grant void, not only for want of consideration, but also by force of the condition upon which it is made.

Invention to be new to the public only.

But although an invention must be new at the time of the grant of the letters patent (*z*), it is only requisite that it should be new *to the public*, on behalf of whom the grant of the sole use of an invention is made. And, consequently, unless the public has a knowledge of an invention, or the means of knowing it, at the time a patent is granted for it, it has

(*t*) Part I. c. 79, s. 6.
(*u*) 21 Ja. I. c. 3.
(*x*) *Ante*, Chap. IV. p. 41, 42.
(*y*) Vide *ante*, Chap. IV. p. 62.
(*z*) *Galloway* v. *Bleadon*, 1 Webs. R. 525; *Cornish* v. *Keene*, 1 Webs. R. 508; and the Statute of Monopolies expressly requires that an invention must be new at the time of the making of the patent in which it is comprised.

sufficient novelty to make it the proper subject of a patent privilege.

The want of this requisite novelty in an art or invention may therefore be established in any way which shows that the public had *a knowledge of the invention, or the means of knowing it before the date of the patent.*

Public knowledge or means of knowledge shows want of novelty.

Public knowledge of an invention may be shown by the existence of some public record, or the publication of some work or paper before the date of the patent, containing a description of the invention,—or by some public use of the invention prior to the grant of the patent.

Public knowledge shown by published description or a public use.

Therefore if it be shown that an invention comprised in a patent, was described in any published work or paper, or in any public record, before the date of the patent, the invention was not then new as to the public knowledge of it, and therefore the patent is void.

Description in published work.

Thus in the case of the *King* v. *Arkwright* (*a*), it appeared that a part of the alleged invention had been described in Emerson's book on mechanics, published long before the date of the patent, and it was held that it could not therefore be made the subject of a grant by patent.

R. v. Arkwright.

And in the case of *Hill* v. *Thompson* (*b*), it was held by the Court of Common Pleas, that a book printed and published prior to the grant of the patent, which in substance informed the public of what the specification of the patent professed to inform them, completely negatived the novelty of the alleged invention.

Hill v. Thompson.

So in the case of *Huddart* v. *Grimshaw* (*c*), Lord *Ellenborough*, C. J., said that if prior to the time of a patentee obtaining his patent, "any part of that which is of the substance of the invention has been communicated to the public in the shape of a specification of any other patent, or is a part of the service of the country, so as to be a known thing, in that case he cannot claim the benefit of his patent."

Huddart v. Grimshaw.

And in the case of *Cornish* v. *Keene* (*d*), the defendants having put in evidence the specification of former patent of

Cornish v. Keene.

(*a*) Dav. P. C. 129.
(*b*) 8 Taunt. 375; and 2 B. Moore, 448, *S. C.*
(*c*) Dav. P. C. 279.
(*d*) 1 Webs. R. 510.

the plaintiff's, the Lord Chief Justice *Tindal* said, in his address to the jury, "Undoubtedly if you could show under the hand of the plaintiff, or any body's hand, that the secret had been publicly communicated to the world which was intended to be covered by the subsequent patent, there is an end to that patent; if the world at large had been informed by this specification of the fabric and manufacture, which is intended to be effected by the subsequent patent, the subsequent patent must fall to the ground, otherwise a man would have nothing to do but to take out patent after patent when the former has nearly expired, and so procure to himself an unlimited privilege."

Publication of foreign work.

The importation of a foreign book into this country, containing a description of an invention, would not be sufficient to defeat a subsequent patent for it, unless the work was actually published and sold to the public here prior to the date of the patent.

Foreign work deposited in a public repository.

If however a single copy of a foreign work is deposited in the British Museum library, or in any other place to which the public can resort to obtain information, the public has the means of knowing the nature of any art or invention which the work describes, and therefore a subsequent patent for such an invention would be void for want of novelty. In *Baron Heurteloup's case.* *Baron Heurteloup's* case (*e*), a portion of the invention had been described in a *French* work deposited in the library of the *British* Museum before the date of the patent, and therefore the patentee applied to her Majesty in council for a confirmation of his patent, which was granted accordingly.

Public use avoids a subsequent patent.

The *public* USE of an art or invention at any time before the date of the patent in which it is comprised, will also be sufficient to render the patent void. And a public use of an invention is sufficient to avoid a subsequent patent for it for *Reasons.* three reasons: *firstly*, Because the public use of an invention is evidence of a public knowledge of it; *secondly*, Because the Statute of Monopolies (*f*) expressly requires that an invention granted by patent shall be such as others (than the inventor) at the time of making the patent or grant *do not*

(*e*) 1 Web. R. 553.

(*f*) 21 Ja. I. c. 3, s. 6.

use; and, *thirdly*, Because every patent expressly requires that the invention comprised in it shall be new as to the public use of it (*g*).

Thus in *Tennant's* case (*h*), the process invented by the patentee had been used five or six years before the date of the patent, and it was held that it was therefore not a new invention, and that the patent was void. Tennant's case.

In the case of *Lewis* v. *Marling* (*i*), it appeared that the patent, dated 15th January, 1818, was for an invention of an improved shearing machine, for shearing woollen cloths, by means of rotary cutters shearing from list to list. The defence was that the mode of shearing from list to list, by means of rotary cutters, was not new at the time of the plaintiff's patent; and it was proved that in the year 1811, a specification was enrolled in *America*, for a machine to shear cloth from list to list by means of rotary cutters, and that in that year a model of an exactly similar machine was brought to *England*, and exhibited to three or four persons. It was also proved that in the year 1811, Mr. Thompson, a manufacturer in *Yorkshire*, employed workmen to make a machine from the *American* specification, and that they had set about it, but that in consequence of the Luddite riots, Mr. Thompson was afraid to have it completed. However, in answer to this, it was shown that after the riots had ceased the machine was left unfinished, and Mr. Thompson bought the plaintiff's machine. Lord *Tenterden*, C. J., said to the jury, "To show that the machine was not new, evidence is given that a model has been seen by three or four persons, and that the making of a similar machine was begun; but it appears to me that the defendant has failed to prove that such a machine was *generally* known or *generally* used in *England*, before the taking out of this patent by the plaintiffs;" and there was a verdict for the plaintiffs. Lewis v. Marling. If the prior use was not *public* it will not avoid the patent. General use.

This statement of the case of *Lewis* v. *Marling* is in accordance with the report of it contained in the fourth volume of the Reports of Messrs. Carrington and Payne (*k*). But upon a subsequent motion in the Court of King's Bench

(*g*) Vide *ante*, Chap. IV. p. 62; and in this Chap. p. 106.
(*h*) Dav. P. C. 429.
(*i*) 4 C. & P. 52; 1 Webs. R. 490.
(*k*) P. 52.

for a new trial in that case (*l*), Lord *Tenterden*, C. J., said that he had left it to the jury to say whether the invention

Public use.

"had been in *public* use and operation before the granting of the patent;" and it does not appear that any objection was made to the charge of Lord *Tenterden* to the jury on the ground that the learned Judge used the expressions, "generally known," and "generally used," instead of "publicly known" and "publicly used." There can be no doubt, how-

To avoid a patent, prior use must be public not general.

ever, that it would be a mistake to say that an invention must be *generally* known or used in order to avoid a subsequent grant of it by patent, it is sufficient if it was *publicly* known or used before the date of the patent (*m*).

Lewis v. Marling, an extreme case.

Mr. Baron *Alderson*, upon the argument of one case (*n*), said that "the case of *Lewis* v. *Marling* went to the extreme point of the law." And upon another occasion (*o*), that in the case of *Lewis* v. *Marling*, he should have entertained very considerable doubts.

Cornish v. Keene.

So in the case of *Cornish* v. *Keene* at Nisi Prius (*p*), the Lord Chief Justice *Tindal* told the jury, that if the invention was, at the time the patent was granted, in any degree of general use,—if it was known at all to the world publicly, or practised openly, so that any other person might have the means of acquiring the knowledge of it as well as the patentee, then the patent would be void.

Carpenter v. Smith. Meaning of public use.

The recent case of *Carpenter* v. *Smith* shows most clearly the meaning of the expression "public use" when applied to an invention. That case was an action for the infringement of a patent for improvements in locks; and it was shown that a lock substantially the same as the plaintiff's had been put upon a gate in a public place, and used by Mr. Davies for many years before the date of the patent. Upon the trial of the case at Nisi Prius (*q*), Lord *Abinger*, C. B., said that "public use" means this—that the use shall not be secret, but public; and that the use of the lock by Mr. Davies on his gate was a public use of it within the meaning of the clause in the

(*l*) 10 B. & C. 22.

(*m*) Vide *Carpenter* v. *Smith*, *infra*; and 9 M. & W. 300.

(*n*) In *Carpenter* v. *Smith*, 1 Webs. R. 543.

(*o*) In *Morgan* v. *Seaward*, 1 Webs. R. 190; 2 M. & W. 553.

(*p*) 1 Webs. R. 508.

(*q*) 1 Webs. R. 534.

patent, which requires the invention to be now as to the public use and exercise of it.

His Lordship also said, "If a man invents a lock, and puts it on his own gate, and has used it for a dozen years, that is a public use of it. If it were otherwise, see what the consequence would be; Mr. Davies has a lock, which he has directed to be made, and put upon his gate, sixteen years ago at least; if that was not a public use of it which prevented a man from taking out a patent, any man might go and take a model of that lock, and get a patent for it." And the learned Judge also held, that "public use and exercise" does not mean a use or exercise by the public, but a use or exercise *in a public manner*, and that such a use of an invention by *one* person would be sufficient to avoid a subsequent patent for it.

Public use is use in a public manner.

The jury in this case having found a verdict for the defendant, the plaintiff moved for a new trial on the ground of misdirection by the Lord Chief Baron to the jury, but the Court of Exchequer refused to grant even a rule *nisi* (*r*). Mr. Baron *Alderson* said, in giving judgment in this case, "Public use means a use in public, so as to come to the knowledge of others than the inventor, as contradistinguished from the use of it by himself in his chamber. How then can it be contended that the lock which has been used in public by Mr. Davies for so many years is a new invention? If the plaintiff's doctrine is correct, it would follow that if Mr. Davies were to change his lock to another gate, he would be liable to an action for an infringement of the plaintiff's patent." And Lord *Abinger* again said, that "the public use and exercise of an invention means a use and exercise *in* public, not by the public."

The law thus laid down in the case of *Carpenter* v. *Smith*, shows accurately the extent of the prior use or exercise of an invention required by law, and the proviso in a patent, in order to avoid a subsequent grant of it. Mr. Davies must have employed a workman to make the lock, and the subsequent successful use of it in public shows that the invention was not intended to be kept secret. It does not appear from the report of the case that the construction of the lock could be

Carpenter *v.* Smith shows the extent of prior use necessary to avoid a patent.

(*r*) 9 M. & W. 300.

discovered by the inspection of it upon the gate, but the person who made it had publicly used the art by which the lock was made before the date of the patent, and therefore the art was not one which came within the meaning of the law, so as to be capable of being granted by letters patent.

Jones v. Pearce.

In the case of *Jones* v. *Pearce* (*s*), it appeared that the plaintiff's patent was granted for an invention of improvements on carriage wheels. It was proved at the trial that two pair of wheels made upon the same principle as the plaintiff's invention, and nearly resembling the plaintiff's wheels, had been publicly used by Mr. Strutt before the date of the patent. Mr. Justice *Patteson* held, that if Mr. Strutt's wheels were on the same principles, and in substance the same as the plaintiff's, and used openly in public so that every body might see them, and were continued to be used up to the time of taking out the patent, then the invention was not new, and the patent was void. The jury in this case gave a verdict for the plaintiff; and it has been generally supposed that the case is one which lays down the law respecting the degree of prior use or knowledge which is sufficient to vitiate a patent, in a way very favourable for patentees. This supposition seems however to be destitute of foundation, for it appears from the charge of the learned Judge that the verdict of the jury must have been given upon the ground that Mr. Strutt's wheels were an experiment only, that he had found it did not answer, and had abandoned it as useless. And Lord *Abinger*, C. B., in the case of *Carpenter* v. *Smith* (*t*), said that he had been counsel in the cases of *Lewis* v. *Marling* (*u*), and *Jones* v. *Pearce*, and he recollected that "those cases proceeded on the ground of the former machines being in truth *mere experiments which altogether failed*."

An art once known for any purpose cannot be made the subject of a privilege for that or any other purpose.

We have seen that the subject of every privilege in an invention granted by patent, is an art by which vendible articles may be manufactured (*x*). And when we say that an invention granted by patent must be new, the meaning is, that *the subject* of the privilege or *the art* must be new at the date of the patent. Therefore if such an art has once become publicly known, or been publicly used, in any way or for any purpose

(*s*) 1 Webs. R. 122.
(*t*) 9 M. & W. 300.
(*u*) 4 C. & P. 52.
(*x*) Vide *ante*, Sec. 1, in this Chapter.

whatsoever, it cannot afterwards be made the subject of a privilege, even for any new application of it.

It has already been shown that a patent privilege cannot be sustained for a new or double use of an old art or invention (*y*). And if the cases which bear upon this subject be examined, it will be seen that the true reason is, that the art which alone can be made the subject of the patent privilege is not new, but only the use or application of it.

An art to be carefully distinguished from the use of it.

And it is necessary, in considering this subject in every case, carefully to distinguish between an art such as we have just defined, and which may be made the subject of a patent privilege, and the various uses and applications of which such an art is capable.

Patent for a new use might injure prior patentee.

If the law permitted a new use or application of a known art or invention to be made the subject of such a privilege, the patent might operate very seriously to the disadvantage of a prior patentee. For however accurately he may have described his new art or invention, if he has not pointed out all its uses or applications, he may be deprived of part of the profit to be made by his invention, by reason of some particular use of it being appropriated by a subsequent patentee.

Prior public sale will avoid a patent.

A public sale of an article made according to an art or invention will also invalidate a subsequent patent, granting the sole use of such art or invention. Such a public sale seems to be substantially the same as a prior public use or exercise of the invention, and if once a person has commenced the use of an art or invention, and made a profit of it by public sale, it would be unjust to deprive him of the benefit which he is reaping from such an application of his labour or capital (*z*).

Wood v. Zimmer. Prior sale by patentee.

In the case of *Wood* v. *Zimmer* (*a*), it appeared that the patent was for a new mode of making verdigrease, to be called *British* Imperial Verdigrease. It appeared also that the patentees had sold an article, composed precisely in the same manner as that for which the patent had been obtained, under the name of *Dutch* Imperial Green. Lord Chief Justice *Gibbs* said to the jury, with reference to the question of novelty, "Some things are obvious as soon as they are made public. Of others, the scientific world may possess itself by analysis.

(*y*) See *Kay* v. *Marshall*, and the other cases, cited *ante*, p. 94 to p. 99.

(*z*) Vide *ante*, p. 34, 35.

(*a*) Holt. N. P. C. 58.

Some inventions almost baffle discovery. But to entitle a man to a patent, the invention must be new to the world. The public sale of that which is afterwards made the subject of a patent, though sold by the inventor only, makes the patent void. It is in evidence that a great quantity was sold in the course of four months before the patent was obtained; and that the bankrupts were in the habit of selling this manufacture." And his Lordship left the question to the jury to say whether the invention was in public sale before the patent, in which case his Lordship thought the patent void, and the jury found the question in the affirmative, and consequently there was a verdict for the defendant. This case was cited and approved of in the case of *Morgan* v. *Seaward* (*b*), in which Mr. Baron *Parke* said, in delivering the judgment of the Court of Exchequer, that "If the patentee himself had before his patent constructed machines (made according to the invention) for sale as an article of commerce for gain to himself, and been in the practice of selling them publicly; that is, to any one of the public who would buy, the invention would not be new at the date of the patent. This was laid down in the case of *Wood* v. *Zimmer* (*c*), and appears to be founded in reason; for if the inventor could sell his invention, keeping the secret to himself, and when it was likely to be discovered by another take out a patent, he might have practically a monopoly for a much longer period than fourteen years."

One instance of sale may be sufficient to defeat a patent.

In the case of *Losh* v. *Hague* (*d*), Lord *Abinger*, C. B., held that a sale to any one individual would be sufficient to avoid a subsequent patent.

The same learned Judge held, in *Carpenter* v. *Smith* (*e*), that one instance of a public sale for profit, of articles made according to an invention, is such a public use and exercise of the invention as will invalidate a subsequent patent for it. And in the case of *Morgan* v. *Seaward* (*f*), although the Court of Exchequer decided that the transaction proved in that case was not such a sale as would defeat a patent, yet expressly guarded themselves against being understood as deciding that a single instance of a sale of an article, as an

(*b*) 2 M. & W. 544.
(*c*) Holt, N. P. C. 58.
(*d*) 1 Webs. R. 202.
(*e*) *Ibid.* 530.
(*f*) 9 M. & W. 300.

article of commerce to any one who chose to buy, might not be deemed the commencement of such a practice, and the public use of the invention so as to defeat a subsequent patent for it.

Sale of articles for foreign market.

And whether articles made according to an invention comprised in a patent, and sold before the date of it, were sold for home or foreign consumption, is of no importance, if the sale be public, in this country.

Thus in the case of *Carpenter* v. *Smith* (*g*), Lord *Abinger*, C. B., held that a sale of locks made according to the plaintiff's invention before the date of his patent for the purpose of being sent to *America*, would be a destruction of the novelty of his invention. And in the case of *Morgan* v. *Seaward* (*h*), the Court of Exchequer, after approving of the law laid down in *Wood* v. *Zimmer* (*i*), that a public sale of an article by an inventor will defeat a subsequent patent for it, said that they were not prepared to say that if such a sale was of articles that were only fit for a foreign market, or to be used abroad, it would make any difference.

Every part of an invention must be new.

And not only must an art or invention granted by a patent be new; but if it consist of several parts, every part of the invention must be new. And it is clear that the reasons already given for the grant of a known art being void, apply as strongly to any part of an invention granted by patent as to the whole of it.

Want of novelty in a part invalidates *the whole* grant.

And the want of novelty in any part of an art or invention not only invalidates the grant of it by patent as to the part of it which is not new, but renders the grant entirely void even as to those parts of the invention which may be new, and in every respect the legal subject of a grant by patent. The reason for this is, that the consideration for a grant by patent is what is termed in law entire, and if any part of it fail, the consideration is not sufficient to support the grant, and therefore the patent is wholly void. So also the patent is void in such a case on the ground of a false suggestion or representation appearing on the face of the patent, for the patentee, in his petition for the patent, must have represented his invention to be new; and as the petition is always recited in the patent, it appears that the representation respecting the

(*g*) 9 M. & W. 300.
(*h*) 2 M. & W. 544.
(*i*) Vide *ante*, p. 113, 114.

novelty of the invention is not true, part of the invention being old, and the consequence of the Crown having been deceived in this respect is that the whole grant is void (*k*).

Hill v. Thompson.

Thus, in the case of *Hill* v. *Thompson* (*l*), it was held by the Court of Common Pleas that if any part of the alleged discovery, being a material part, failed, (the discovery in its entirety forming one entire consideration,) the patent was altogether void.

Huddart v. Grimshaw.

In the case of *Huddart* v. *Grimshaw* (*m*), Lord *Ellenborough*, C. J., said to the jury, that if, prior to the time of the plaintiff obtaining his patent, *any part* of that which was of the substance of the invention had been communicated to the public, he could not support his patent.

R. v. Else. Bovill v. Moore.

So in the cases of *The King* v. *Else* (*n*), and *Bovill* v. *Moore* (*o*), the patents were held to be void on the ground of the patentees' claims being too extensive, and comprising things which were not new.

Gibson v. Brand.

In the case of *Gibson* v. *Brand* (*p*), it appeared that the patentees claimed eight several heads of invention, and the Court of Common Pleas held that in order to support their patent they were bound to show that each of the eight parts was new.

Brunton v. Hawkes.

In the case of *Brunton* v. *Hawkes* (*q*), it appeared at the trial that the patent was for an invention of improvements in the manufacturing of ships' anchors, windlasses, and chain cables. The mode of manufacturing anchors described in the plaintiff's specification had never been applied before to ships' anchors. But it had been applied to the adze-anchor, and the mushroom-anchor. These anchors are used only for the purpose of mooring floating lights or vessels intended to be stationary; and are never taken on board. The jury having found a verdict for the plaintiff, the defendant obtained a rule *nisi* for a new trial, which the Court afterwards made absolute. In his judgment the Lord Chief Justice *Abbott* said, "I feel myself compelled to say that I think so much of the plaintiff's invention, as respects the anchor, is not new, and

(*k*) Vide *ante*, Chap. IV. p. 42 and 48.

(*l*) 8 Taunt. 375; and 2 B. Mo. 448, *S. C.*

(*m*) Dav. P. C. 265.

(*n*) *Ibid.* 144.

(*o*) *Ibid.* 361; and 2 Marsh. 211 *S. C.*

(*p*) 4 M. & G. 179.

(*q*) 4 B. & Ald. 541.

that the whole patent is therefore void. The mode of joining the shank to the flukes of the anchor is to put the end of the shank, which is in the form of a solid cylinder, through the hollow and conical aperture, and it is then made to fill up the hollow, and to unite itself with it. Now that is precisely the mode by which the shank of the mushroom-anchor is united to the mushroom-top, by which the shank of the adze-anchor is united to its other parts. It is indeed the mode by which the different parts of the common hammer and the pickaxe also are united together. Now a patent for a machine, each part of which was in use before, but in which the combination of the different parts is new, and a new result produced, is good; because there is a novelty in the combination. But here the case is perfectly different; formerly three pieces were united together; the plaintiff only unites two; and, *if the union of those two had been effected in a mode unknown before, as applied in any degree to similar purposes, I should have thought it a good ground for a patent;* but unfortunately the mode was well known and long practised. I think that a man cannot be entitled to a patent for uniting two things instead of three, *where that union is effected in a mode well known and long practised for a similar purpose.* It seems to me therefore that there is no novelty in that part of the patent as affects the anchor, and if the patent had been taken out for that alone, I should have had no hesitation in declaring that it was bad. Then if there be no novelty in that part of the patent, can the plaintiff sustain his patent for the other part as to the mooring chain? As at present advised, I am inclined to think that the combination of a link of this particular form with the stay of the form which he uses, although the form of the link might have been known before, is so far new and beneficial as to sustain a patent for that part of the invention, if the patent had been taken out for that alone. But inasmuch as one of the things is not new, the question arises, whether any part can be sustained. It is quite clear that a patent granted by the Crown cannot extend beyond the consideration of the patent. The King could not, in consideration of a new invention in one article, grant a patent for that article and another. The question then is, whether, if a party applies for a patent, reciting that he has

discovered improvements in three things, and obtains a patent for these three things, and in the result it turns out that there is no novelty in one of them, he can sustain his patent. It appears to me that the case of *Hill* v. *Thompson*, which underwent great consideration in the Common Pleas, is decisive upon that question. In that case the patent was granted to the plaintiff for the invention of certain improvements in the smelting and working of iron; and the Court of Common Pleas appear to have considered that the improvement introduced by the plaintiff into what may properly be called the smelting of iron, was the obtaining iron from that cinder and slag which before had been thrown away as refuse, and that that might be considered as new. It appeared, however, that the plaintiff claimed further the merit of having discovered that the application of lime in certain stages of the process would cure a disease common to all iron, not merely to that which he was to produce, but to iron originally manufactured from the fresh ore. Now it turned out that that was not a discovery, for the application of lime to iron made from the cinder, originally used in making ore, was known and practised before. No two things can be more distinct in their nature than the obtaining of iron from a material from which it was impracticable to obtain it before, and the cure or prevention of a disease to which all iron was subjected. In that case, however, the Court of Common Pleas held, that admitting there was novelty in the one, yet, as there was no novelty in the other, the patent was wholly void. The only difference between that case and this is, that here the plaintiff, instead of saying that he has made certain improvements, states the improvements; but still he claims the merit of having invented improvements in all the three, and that they are new; and the consideration of the patent is the improvement in the three articles, and not in one; for an improvement in only one of them would render the patent bad. The consideration is the entirety of the improvement of the three; and if it turns out there is no novelty in one of the improvements, the consideration fails in the whole, and the patentee is not entitled to the benefit of that other part of his invention."

The ground upon which the partial want of novelty in an

invention avoids the whole grant contained in the patent was also clearly explained in the case of *Morgan* v. *Seaward* (*s*), in which Mr. Baron *Parke* said, in delivering the judgment of the Court, that "A false suggestion of the grantee avoids an ordinary grant of lands or tenements from the Crown, is a maxim of the Common Law, and such a grant is void, not against the Crown merely, but in a suit against a third person (*t*). It is upon the same principle that a patent for two or more inventions, when one is not new, is void altogether, as was held in *Hill* v. *Thompson* (*u*), and *Brunton* v. *Hawkes* (*x*); for although the statute invalidates a patent for want of novelty, and consequently, by force of the statute, the patent would be void, so far as related to that which was old, yet the principles on which the patent has been held to be void altogether is, that the consideration for the grant is the novelty of all, and the consideration failing, or, in other words, the Crown being deceived in its grant, the patent is void, and no action maintainable upon it." Morgan v. Seaward.

The specification is to be deemed a part of the patent, and the two instruments are to be construed together as one; and if it appears by the patent, or specification, that any thing is claimed by the patentee as part of his invention which is not new, the grant of privilege will be wholly void. If patentee claim anything not new his patent is entirely void.

In the case of *Campion* v. *Benyon* (*y*), it appeared that the patent was for an invention intituled "a new and improved method of making and manufacturing double canvass and sail cloth with hemp and flax, or either of them *without any starch whatever*." It appeared at the trial that the plaintiff's invention was substantially only a new mode of preparing and twisting hemp or flax for making canvass and sail cloth, and that the manufacturing of canvass and sail cloth had been known and used long before the date of the patent. The Court of Common Pleas held that this patent was void on the ground, that part of what the plaintiff had claimed as his invention was not new, and that the patent was therefore too extensive. The Lord Chief Justice *Dallas* said, "That looking at the description of the invention contained in the patent, a Campion v. Benyon.

(*s*) 2 M. & W. 544.
(*t*) *Travell* v. *Carteret*, 3 Lev. 135; *Alcock* v. *Cooke*, 5 Bing. 340.
(*u*) 2 Moore, 424; 8 Taunt. 375, *S.C.*
(*x*) 4 B. & Ald. 542.
(*y*) 6 B. Mo. 71; 3 B. & B. 5, *S.C.*

common person would think, not simply that it was an improvement in the method of making double canvass and sail cloth without starch, pre-supposing that starch had been known before, but that it was an improvement for making them without any starch whatever. From the moment I read the patent, I thought the object of the patentee was to make such canvass or cloth without any starch, and that the exclusion of that article was a new discovery, and adopted by him for the first time; nor do I now see any reason to think otherwise." And after commenting upon the specification, his Lordship said, "As well therefore on the terms of the specification, as of the patent itself, I have no doubt but that the claim of the plaintiff is of too extensive a nature; it is not confined to a new and improved method of making and manufacturing the canvass and sail cloth, either in the weaving or twisting the threads, but of manufacturing them without any starch whatever, which it appears had been done before, and was therefore not a new or original discovery. On this ground, therefore, I am clearly of opinion that the patent in question is void." Mr. Justice *Burrough* said, "The King has, in fact, been deceived in granting the patent to the plaintiff, as he has claimed what was known before, and is consequently not entitled to the discovery or invention he thereby sought to establish." And Mr. Justice *Richardson* said, "The true and sound principle is, that although on the one hand ingenious persons ought to be protected and rewarded for their discoveries, still on the other, care must be taken that others, as well as the public at large, must not be restricted from making improvements on that which is still open to their ingenuity; *viz.* of doing anything which is not peculiar to the immediate process employed by the patentee. Here the patent itself appears to consist of an improvement in making double canvass and sail cloth without starch. The specification confirms it, by referring to the advantages to be derived from the omission of that article in the manufacture of those cloths. That discovery appears to have been made long since, and therefore the patent cannot be sustained."

An improvement or addition may be the subject of a privilege.

Although every thing which is claimed by a patentee as part of his invention, and which he therefore seeks to make the subject of his patent privilege, must be new at the date of the

patent; that rule has not the effect of avoiding a patent privilege for an art or invention which is an improvement upon, or addition to, some previously known art or invention, or which is only a combination of arts or processes already known to the public.

Patentee's claim must not include anything beside the improvement, &c. he has invented.

But the patentee's claim of invention must be confined to the improvement or addition, and the patentee's claim must not extend to any part of the previously known art or invention, or the entire privilege will be rendered void under the rule of law which has just been considered, in consequence of a part of the alleged invention not being new at the date of the patent (*z*). Or if the invention be of a combination of arts before known, or if the object of the invention be the combination of things previously known to the world, the patent must be limited to the particular combination which the patentee has invented, and must not include any of the elements of the art or invention, or the patent will be entirely void for the reason just given.

The art in such a case is distinct from that upon which it is an improvement.

The reason why a patent is good in such a case is, that the art which is comprised in the privilege is quite distinct from that upon which it is an improvement, or from those of which it is a combination. And if an art of this description is sought to be made the subject of a patent privilege, the patent cannot be sustained unless the art be really a distinct substantial art, and different from the previously known art or arts of which the patentee has availed himself.

Validity of a privilege for an improvement, &c. formerly doubted.

It was formerly doubted whether a patent privilege for an addition or improvement was good, but the validity of such a privilege is now unquestionable.

3 Inst. 184.

Sir Edward Coke, in his commentary on the Statute of Monopolies (*a*), says, that "Such a privilege as is consonant to law must be substantially and essentially newly invented; but if the substance was *in esse* before, and a new additi[on] reunto, though that addition make the former more profitable, yet it is not a new manufacture in law: and so it was resolved in the Exchequer Chamber, *Pasch.* 15 Eliz. in *Bircot's* case, for a privilege concerning the preparing and melting, &c. of lead of ore:

Bircot's case.

(*z*) See *Hill* v. *Thompson*, 8 Taunt. 375; 2 B. Mo. 448; *Bovill* v. *Moore*, 2 Marsh. 211; Dav. P. C. 361; *Minter* v. *Mower*, 1 Webs. R. 142; and the other cases which have been cited.

(*a*) 3 Inst. 184.

for there it was said, that that was to put but a new button on an old coat, and it is much easier to add than to invent." We are left in ignorance as to the precise nature of the addition in *Bircot's* case, and therefore it may have been such an addition as would not even now be held sufficient to support a grant by patent.

Bircot's case not adhered to.

In the case of *Boulton* v. *Bull* (*b*), the Lord Chief Justice *Eyre* mentioned *Bircot's* case, and said that the principle on which it was determined had not been adhered to.

Particular facts of Bircot's case unknown.

And in the same case (*c*), Mr. Justice *Buller*, speaking of *Bircot's* case, says, "What were the particular facts of that case we are not informed; and there seems to me to be more quaintness than solidity in the reason assigned, which is, that it was to put a new button to an old coat, and it is much easier to add than to invent. If the button were new, I do not feel the weight of the objection that the coat on which the button was to be put was old. But in truth arts and sciences at that period were at so low an ebb in comparison with the point to which they have been since advanced, and the effect and utility of improvements so little known, that I do not think that case ought to preclude the question. In later times whenever the point has arisen, the inclination of the Court has been in favour of the patent for the improvement, and the parties have acquiesced where the objection might have been brought directly before the Court."

Buller, J., in R. v. Arkwright.

In the case of *The King* v. *Arkwright* (*d*), Mr. Justice *Buller* said, that if there was any thing material and new *which was an improvement* of the trade, that would be sufficient to support a patent.

Laurence, J., in Hornblower v. Bull.

In the case of *Hornblower* v. *Bull* (*e*), Mr. Justice *Laurence* said, that the patent must be supported as granted for an improvement and addition to old engines known and in use, and that he thought the patent was good in that point of view.

Morris v. Bransom.

And in the case of *Morris* v. *Bransom* (*f*), tried in Hilary vacation, 1776, "The question was, whether an addition to an old stocking-frame was a subject of a patent: Lord *Mansfield*

(*b*) Dav. P. C. 205; 2 H. Bl. 463, *S. C.*
(*c*) Dav. P. C. 201; 2 H. Bl. 463, *S. C.*
(*d*) Dav. P. C. 61.
(*e*) 8 T. R. 98; Dav. P. C. 221.
(*f*) Bull. N. P. 76, c.

said, if the general question of law, *viz.*, that there can be no patent for an addition, be with the defendant that is open upon the record, he may move in arrest of judgment, but that objection would go to repeal almost every patent that was ever granted. There was a verdict for the plaintiff, and 500*l.* damages, which was acquiesced in."

This case seems to have been subsequently tried again, for in the case of *Boulton* v. *Bull* (*g*), Mr. Justice *Buller* said, in giving judgment, that in *Morris* v. *Bransom*, which was tried at the sittings after Easter Term, 1776, the patent was for making oilet holes or net-work in silk, thread, cotton, or worsted; and the defendant objected that it was not a new invention, it being only an addition to the old stocking-frame. That, Lord *Mansfield* said, after one of the former trials on this patent, he had received a very sensible letter from one of the gentlemen who was upon the jury, upon the subject, whether on principles of public policy there could be a patent for an addition only. That he paid great attention to it, and mentioned it to all the Judges, and said that if there could be no patent for an addition, the point was open upon the record, and the defendant might move in arrest of judgment. And it appears that there was a verdict for the plaintiff, but no motion was made in arrest of judgment. And Mr. Justice *Buller* also said, that though his Lordship (Lord *Mansfield*) did not mention what were the opinions of the Judges, or give any direct opinion himself, yet we may safely collect that he thought, on great consideration, the patent was good, and the defendant's counsel, though they made the objection at the trial, did not afterwards persist in it. And (added Mr. Justice *Buller*) since that time it has been the generally-received opinion in Westminster Hall, that a patent for an addition is good.

Patent for an improvement good.

For some years past, very many of the patents which have been taken out have been for inventions intituled as improvements in things previously known; and there can be no question now that such a patent is good (*h*), even when it is for an improvement upon something comprised in a prior

(*g*) Dav. P. C. 202; 2 H. Bl. 463, *S. C.*

(*h*) See *Hill* v. *Thompson*, 8 Taunt. 375; 2 B. Mo. 448.

patent (*i*); but the second patent must wait until the expiration of the previous patent, until which time the patentee cannot use the prior invention, unless indeed he obtains the licence of the prior patentee.

It is to be observed, that a patent privilege is not obtained merely for an improvement or improved art, in every case in which the word improvement is used in the title of the invention. Thus, an invention may be intituled "improvements in the manufacture of lace," the object of the invention being either the production of lace of a better quality, or at a lower price; and yet the means by which that object is obtained may be some new art or some new machine totally and entirely different from anything before known or used for the manufacture of lace.

Patents for combinations have also been decided to be good.

It will be seen from the cases now to be cited, that it is equally clear that a patent privilege is good for an art or invention which is a combination of several known arts or inventions, or which has for its object the combination of several previously known articles or materials.

Hill v. Thompson.

In the case of *Hill* v. *Thompson* (*k*), Lord *Eldon*, L. C., said, that there might be a valid patent for a new combination of materials previously in use for the same purpose.

Boulton v. Bull.

In the case of *Boulton* v. *Bull* (*l*), Mr. Justice *Buller* said, that it is no objection to a manufacture that the articles of which it is composed were known and in use before the patent; provided the compound article which is the object of the invention is new.

Bovill v. Moore.

In the case of *Bovill* v. *Moore* (*m*), Lord Chief Justice *Gibbs* told the jury, that if the plaintiff had invented an engine which consisted of a perfectly new conformation of parts, although all the parts were used before, yet he would be entitled to support his patent for a new machine.

Huddart v. Grimshaw.

So in the case of *Huddart* v. *Grimshaw* (*n*), Lord *Ellenborough*, C. J., said, "I suppose it will not now be disputed that a new combination of old materials so as to produce a new effect may be the subject of a patent." And his Lordship

(*i*) *Ex parte Fox*, 1 V. & B. 67; *Crane* v. *Price*, 4 M. & G. 580.
(*k*) 3 Mer. 622.
(*l*) Dav. P. C. 199; 2 H. Bl. 487.
(*m*) Dav. P. C. 361.
(*n*) *Ibid.* 267.

afterwards said to the jury in the same case (*o*), "In inventions of this sort, and every other through the medium of mechanism, there are some materials which are common, and cannot be supposed to be appropriated in the terms of any patent. There are common elementary materials to work with in machinery, but it is the adoption of those materials to the execution of any particular purpose that constitutes the invention; and if the application of them be new, if the combination in its nature be essentially new, if it be productive of any new end, and beneficial to the public, it is that species of invention which, protected by the King's patent, ought to continue to the patentee the sole right of vending it."

Cornish v. Keene.

In the case of *Cornish* v. *Keene* (*p*), the invention was of a new elastic web, made by combining non-elastic and covered elastic threads in the warp of the web, which was woven in the common way, and in the common loom. Before the date of the patent the manufacture of webs with all the warp threads elastic was well known, and there was nothing new in the invention except the particular combination of elastic and non-elastic materials in the warp of the web. This combination the Court of Common Pleas held was an invention which might be protected by patent.

Crane v. Price.

In *Crane* v. *Price* (*q*), it appeared that Crane's patent was for an invention of "an improvement in the manufacture of iron," and the improvement consisted in combining the use of hot air blast with the use of anthracite or stone coal in the smelting of iron. Both hot air blast and anthracite coal had been used in the smelting of iron before the date of the patent, and the patentee claimed the mere combination of the two things, and distinctly disclaimed each of them separately as being well known. The Court of Common Pleas held that the new combination of processes was clearly a good subject of a grant by patent.

Omission of part of a known process, &c.

There may also be a valid patent for an invention, where every thing used by the patentee is old and well known, and the novelty consists merely in dispensing with one of several things which was before used in any branch of manufacture.

(*o*) Dav. P. C. 278.
(*p*) 3 Bing. N. C. 570; 1 Webs. 517.
(*q*) 1 Webs. R. 393; 4 M. & G. 580.

Russell v. Cowley.

Thus, in *Russell* v. *Cowley* (*r*), which was an action for the infringement of a patent granted to Whitehouse for improvements in the manufacture of tubes, it appeared that before the date of Whitehouse's patent, iron pipes had been made by turning up the edges of strips of iron plate so as to make them meet, and then by passing them in a heated state *upon a mandril*, through a circular hole between a pair of dies, to cause the edges of the strips of iron to be welded together, and so to form a tube. The invention comprised in Whitehouse's patent was to manufacture iron tubes in the same manner in every respect as already described, except that the use of a mandril was dispensed with, Mr. Whitehouse having discovered that the edges of the iron could be welded together as well without the mandril as with it, and that by dispensing with the mandril, tubes could be made much longer than with it. The Court of Exchequer held that this new invention might lawfully be made the subject of a grant by patent.

Minter v. Mower.

And in the case of *Minter* v. *Mower* (*s*), the Court of Queen's Bench intimated an opinion that a patent would not be bad merely because the invention consisted in the omission of one of the several component parts of something previously known.

Prior secret use will not avoid a patent.

It has been seen that the novelty which the law requires in order to make an art or invention the legal subject of a patent privilege, is novelty to the public; that the public must neither have a knowledge of the art, or possess the means of knowing it. But an art or invention may be new to the public notwithstanding any secret knowledge or use of it prior to the grant of a patent for it, and such a secret knowledge or use of the invention will not affect the validity of the patent.

Dolland's case.

Thus, in *Dolland's* case (*t*), the invention was of a new method of making object-glasses, and it was objected that Dolland was not the (first) inventor, because Dr. Hall had made the same discovery before him. But it was held that as Dr. Hall had confined his invention to his closet, and the public were not acquainted with it, Dolland was entitled to maintain his patent.

Lewis v. Marling.

So in the case of *Lewis* v. *Marling* (*u*), Mr. Justice *Bayley*

(*r*) 1 Webs. R. 463.
(*s*) *Ibid.* 142; and 6 A. & E. 735.
(*t*) Dav. P. C. 170.
(*u*) 1 Webs. R. 496; 10 B. & C. 2

said, that it was no objection to an inventor's patent that any one else had made a similar discovery by his mind, or had received privately a communication from abroad, which would enable him to make it, unless it had been actually made public.

Prior confidential disclosure or use of invention will not avoid a patent.

So also if the knowledge of an invention be disclosed by the inventor privately and confidentially to another, such a disclosure will not avoid a subsequent patent: and even if the invention is in consequence of such communication secretly used in the production of an article which is not sold to the public, or published to the world, the patent will not be void.

Morgan v. Seaward.

This was laid down by the Court of Exchequer in the case of *Morgan* v. *Seaward* (*x*), which was an action for the infringement of a patent granted to Mr. Galloway and assigned to Morgan the plaintiff: the jury, by direction of the Judge, gave a verdict for the defendant, upon a plea denying the novelty of the invention, with liberty for the plaintiff to move the Court (which he did) to have the verdict entered for him on that issue. The facts of the case are fully stated in the judgment of the Court, which was delivered by Mr. Baron *Parke*, who said, "The evidence was, that before the date of the patent, (which was 2nd of July, 1829,) Curtis, an engineer, made for Morgan (the plaintiff) two pair of wheels upon the principle mentioned in the patent at his own factory. Galloway, the patentee, gave the instructions to Curtis, under an injunction of secrecy, because he was about to take out a patent. The wheels were completed and put together at Curtis's factory, but not shown or exposed to the view of those who might happen to come there. After remaining a short time, the wheels were taken to pieces, packed up in cases, and shipped in the month of April on board a vessel in the Thames, and sent for the use of the Venice and Trieste Company, of which Morgan was managing director, and which carried on its transactions abroad, but had shareholders in England. Curtis deposed that 'they were sold to the Company,' without saying by whom, which may mean that they were sold by Curtis to Morgan for the Company; and Morgan paid Curtis for them. Morgan and Galloway employed an attorney, who entered a *caveat* against any patent

(*x*) 2 M & W. 544.

on the 2nd of March, and afterwards solicited the patent in question, which was granted to Galloway and assigned to Morgan. Upon these facts, the question for us to decide is, whether the jury must have necessarily found for the defendant, or whether they might have found that this invention at the date of the letters patent was new in the legal sense of that word. The words of the statute are, that 'grants are to be good of the sole working or making of any manner of new manufacture to the first and true inventor or inventors of such manufactures, which others at the time of the making such grants did not use;' and the proviso in the patent in question founded on the statute is, that if the invention be not a new invention as to the public use and exercise thereof in England, the patent should be void. The word 'manufacture' in the statute must be construed in one of two ways: it may mean the machine when completed, or the mode of constructing the machine. If it mean the former, undoubtedly there has been no use of the machine, as a machine, in England, either by the patentee himself, or any other person; nor indeed any use of the machine in a foreign country before the date of the patent. If the term 'manufacture' be construed to be 'the mode of constructing the machine,' there has been no use or exercise of it in England, in any sense which can be called 'public.' The wheels were constructed under the direction of the inventor, by an engineer and his servants, with an injunction of secrecy, on the express ground that the inventor was about to take out a patent, and that injunction was observed, and this makes the case so far the same, as if they had been constructed by the inventor's own hands in his own private workshop, and no third person had seen them whilst in progress. The operation was disclosed, indeed, to Morgan, the plaintiff, but there is sufficient evidence that Morgan at that time was connected with the inventor, and designing to take a share of the patent. A disclosure of the nature of the invention to such a person, under such circumstances, must surely be deemed private and confidential. The only remaining circumstance is, that Morgan paid for the machines with the privity of Galloway, on behalf of the Venice and Trieste Steam Company, of which he was the managing director; but there was no proof that he paid

more than the price of the machines, as for ordinary work of that description; and the jury would also be well warranted in finding that he did so with the intention that the machine should be used abroad only by this Company, which, as it carried on its transactions in a foreign country, may be considered as a foreign Company; and the question is, whether this solitary transaction without any gain being proved to be derived thereby to the patentee or to the plaintiff, be a use or exercise in England of the mode of construction in any sense which can be deemed a use by others, or a public use, within the meaning of the statute and the patent? We think not. It must be admitted that if the patentee himself had before his patent constructed machines for sale, as an article of commerce, for gain to himself, and been in the practice of selling them publicly, that is, to any one of the public who would buy, the invention would not be new at the date of the patent. This was laid down in the case of *Wood* v. *Zimmer* (*y*), and appears to be founded on reason; for if the inventor could sell his invention, keeping the secret to himself, and, when it was likely to be discovered by another, take out a patent, he might have, practically, a monopoly for a much longer period than fourteen years. Nor are we prepared to say, that if such a sale was of articles that were only fit for a foreign market, or to be used abroad, it would make any difference: nor that a single instance of such a sale, as an article of commerce, to any one who chose to buy, might not be deemed the commencement of such a practice, and the public use of the invention so as to defeat the patent. But we do not think that the patent is vacated on the ground of the want of novelty, and the previous public use or exercise of it, by a single instance of a transaction such as this, between parties connected as Galloway and the plaintiff are, which is not like the case of a sale to any individual of the public who might wish to buy; in which it does not appear that the patentee has sold the article, or is to derive any profit from the construction of his machine, nor that Morgan himself is; and in which the pecuniary payment may be referred merely to an ordinary compensation for the labour and skill of the engineer actually

(*y*) Holt, N. P. C. 58, cited *ante*, p. 113.

employed in constructing the machine; and the transaction might, upon the evidence, be no more in effect than that Galloway's own servants had made the wheels, that Morgan had paid them for their labour, and afterwards sent them to be used by his own co-partners abroad. To hold this to be what is usually called a publication of the invention in England, would be to defeat a patent by much slighter circumstances than have yet been permitted to have that effect. We therefore think, that as the jury might consistently with the evidence have found this issue (*z*) for the plaintiff, the verdict ought, pursuant to the leave reserved, to be entered on that issue for him."

Bentley *v.* Fleming.

So also in the case of *Bentley* v. *Fleming* (*a*), it appeared at the trial that the patent was for a card machine, and the patentee had before the patent lent the machine to a person in order that he might try it. The machine was placed in a room in a mill, in which men were constantly going backwards and forwards; but Mr. Justice *Cresswell* held, that the machine having merely been lent for the purpose of testing it, this did not amount to a publication.

Prior experiments will not defeat a patent.

Experiments made prior to the date of a patent, will not be any reason for objecting to a subsequent patent on the ground of want of novelty, unless the experiments were actually successful, as well as brought into public knowledge or use before the date of the patent. And the reason of this is very evident; for until the invention of an art is actually completed, a knowledge of it *cannot* be published to the world so as to defeat a patent for it.

Galloway *v.* Bleaden.

In the case of *Galloway* v. *Bleaden* (*b*), the Lord Chief Justice *Tindal*, in his charge to the jury, laid it down as law, that a mere experiment, or course of experiments, for the purpose of producing a result which is *not brought to completion*, but begins and *ends in experiment*, will not, although known to several persons, prevent a subsequent inventor who brings the invention to perfection from maintaining a patent for it. And in that case the learned Judge observed, that there had been many experiments made, tending almost, if not entirely, to the same result as the patentee's invention, and that those

(*z*) Respecting the novelty of the invention.

(*a*) 1 Car. & Kirwan, 587.
(*b*) 1 Webs. R. 529.

experiments were known to various persons; but his Lordship held that, if they rested in experiment, and in experiment only, and had not attained the object for which the patent was taken out, the patent would not be invalidated for want of novelty in the invention. And his Lordship also held, that mere experiment supposed by the parties to be fruitless and abandoned, because they had not brought it to a complete result, would not prevent a more successful competitor, who might add the last link of improvements in bringing it to perfection, from maintaining a patent for the invention.

So in the case of *Cornish* v. *Keene* (*c*), the Lord Chief Justice *Tindal* said, "A man may make experiments in his own closet for the purpose of improving any art or manufacture in public use; if he makes these experiments, and never communicates them to the world, and lays them by as forgotten things, another person who has made the same experiments, or has gone a little further, or is satisfied with the experiments, may take out a patent and protect himself in the privilege of the sole making of the article for fourteen years, and it will be no answer to him to say that another person before him made the same experiments." Cornish v. Keene.

In the case of *Jones* v. *Pearce* (*d*), which was an action for the infringement of a patent for an invention of improvements in carriage wheels, it was proved that Mr. Strutt had made and used wheels similar to the plaintiff's before the date of the patent. And Mr. Justice *Patteson* told the jury, that if they were of opinion that Mr. Strutt's wheel was an experiment, and that he found it did not answer, and ceased to use it altogether, and abandoned it as useless, and nobody else followed it up, and the plaintiff's invention which came afterwards was his own invention, and remedied the defects in Mr. Strutt's wheel, there was no reason for saying that the plaintiff's patent was not good. Jones v. Pearce.

And in *Carpenter* v. *Smith* (*e*), Lord *Abinger*, C. B., laid it down as law, that if an invention is new, the inventor shall not be prejudiced by any other man having invented it before, if he never made any use of it; because the mere speculations of ingenious men which may be fruitful of a great variety of Carpenter v. Smith.

(*c*) 1 Webs. R. 501.
(*d*) *Ibid.* 122.
(*e*) *Ibid.* 534.

inventions, if they are not brought into actual use, ought not to stand in the way of other men equally ingenious, who may afterwards make the same inventions and apply them. A great many patents (said his Lordship) have been taken out, for example, upon suggestions made in a very celebrated work by the Marquis of Worcester, and many patents have been derived from hints and speculations by that ingenious author. But yet, as he never acted upon them, as he never brought out any machines whatsoever, those patents are good. And his Lordship also held that the meaning of the words public use is this;—that a man shall not by his own private invention, which he keeps locked up in his own breast, or in his own desk, and never communicates it, take away the right that another man has to a patent for the same invention.

Section III.

Of the Utility of an Art or Invention necessary in order to support a Patent.

Object of the law is the benefit of the public.

The chief object of our Patent Law is to promote the benefit of the public by inducing inventors to give to the public a knowledge of their inventions or discoveries in the useful arts.

All the prerogatives of the Crown must be for the advantage and good of the people, otherwise they ought not to be allowed by the law (*f*). Unless therefore the exercise of the prerogative of the Crown, in granting the sole use of an invention, is for the good of the people, it is contrary to law.

The public must have a consideration for the grant.

The Queen cannot charge her subjects, or abridge them of their liberty in any way except for their benefit, or where they shall have a sufficient consideration (*g*). And it is clear that by the grant of the sole use of an invention to any person, all other persons are for a time deprived of the liberty of using the art which is comprised in the privilege granted by the patent; even if they themselves should unaided make an invention precisely similar in every respect (*h*); and in order to procure

(*f*) Bac. Abr. tit. Prerog.
(*g*) Vide 2 Rol. Abr. 172, s. 20.
(*h*) Vide *ante*, Chap. II. p. 11.

articles made according to the invention, they must also pay whatever the patentee may think fit to charge for them. In making a grant by patent of the sole use of an invention, the Queen acts on behalf of the public (*i*); and as *the public*, by means of the patent, grants a privilege to the patentee, *the public* ought to have the consideration for the grant.

Useless invention no consideration for a patent.

Unless an invention is of some use, and confers some benefit upon the public, the Crown cannot grant the sole use of it to the inventor or importer; for in order to support such a grant, there must be some consideration given to the public by the patentee; and if it appears that the art or invention which is the subject of a patent privilege, is of no use whatever to the public, the patent is void, and the grant is a nullity (*k*).

The art made the subject of a privilege must be useful.

We have already seen that the subject of a patent privilege is the art, by means of which vendible articles of manufacture are made or produced (*l*). And in speaking of the quality of public utility required by law, it must be understood, that it is the subject of the patent privilege which must be useful or beneficial to the public, that is to say, the art by means of which such articles of manufacture are produced.

Subject of privilege usually called an invention.

The subject of a patent privilege is, however, generally called by the name of an invention, and the word is used in this sense when it is said that an invention is required by law to be useful in order to be legally granted by patent. The benefit or utility which the public receives from an invention, arises from the useful employment of the labour of the people: workmen are benefited by increased means of obtaining employment and subsistence; and the rest of the public are benefited by the production of articles of trade or commerce.

Utility required by common law.

The public utility of an invention is a condition required by the Common Law (independent of the Statute of Monopolies) in order to make the invention a proper subject of a grant by patent.

Case of Monopolies.

Thus in the case of monopolies, *Darcy* v. *Allin* (*m*), it is laid down that where a man brings into the realm any new trade, *and that for the good of the realm*, the King may grant

(*i*) Per Lord *Eldon*, L. C., in *Harmer* v. *Playne*, 14 Ves. 131, 136.

(*k*) See also the observations in the first Chapter, *ante*, p. 3; respecting the necessity of utility in an invention in order to make it the subject of a valid patent privilege.

(*l*) *Ante*, s. 1, p. 77.

(*m*) Noy. R. 182.

him a monopoly for a reasonable time, "*in consideration of the good that he doth bring by his invention to the commonwealth: otherwise not.*"

Shep. Abr. In Sheppard's Abridgment (*n*), it is laid down that the King may for a reasonable time grant a monopoly patent of a new trade or device; or any new engine tending to the furtherance of it, *for the good of the realm.*

Statute of Monopolies made no change in this respect. The Statute of Monopolies (*o*) did not make any change in the law in this respect, and accordingly we shall see that there are numerous cases determined since the passing of that statute, which decide that an invention must be useful in order to be made the subject of a valid patent privilege. The 6th section of the statute, which saves the prerogative of the Crown to make these grants, does not mention utility, but requires that such grants of privilege shall not be "contrary to the law, nor mischievous to the state by raising prices of commodities at home, or hurt of trade, or generally inconvenient." It is clear that the intention of the statute was not only to confine the prerogative of the Crown within the express limits defined by the 6th section, but also to preserve all the other provisions (*p*) of the Common Law inviolate; for the 6th section of the Act concludes by declaring that such grants shall be of the same force as if the Act had not passed, and of no other. And as the Common Law, which, prior to the making of the statute, required an invention to be useful in order to be the subject of a valid grant by patent, yet remains in full force, the grant of the sole use of an invention of no public utility, would clearly be contrary to the Common Law; and contrary to law within the meaning of the statute. Every case therefore which has been determined since the passing of the statute, respecting the utility of an invention, is a decision respecting the Common Law on the subject.

Coke's commentary on the Statute of Monopolies. Commenting upon the words, "mischievous to the state by raising prices of commodities at home," in sec. 6 of the Statute of Monopolies, *Sir Edward Coke* says (*q*), that "In every such new manufacture as deserves a privilege there must be *urgen*

(*n*) Part III. p. 61.
(*o*) 21 Jac. I. c. 3.
(*p*) The whole statute is clearly declaratory of the Common Law.
(*q*) 3 Inst. 184.

necessitas and *evidens utilitas.*" And he further states that the reason why such a privilege is good in law, is "because the inventor bringeth *to and for the commonwealth*, a new manufacture by his invention, costs and charges, and therefore it is reason that he should have a privilege for his reward (and the encouragement of others in the like) for a convenient time.

In the case of *The King* v. *Arkwright* (r), which was a *scire facias* to repeal a patent for an invention, Mr. Justice *Buller* held, that it was a question for the jury whether the only new part of the machinery described in the specification was *material or useful, and that if they were of opinion that it was not so, the patent was void.* The jury found a verdict for the Crown; and although the defendant moved for a new trial on other grounds, no objection was made against the law upon this point as laid down by Mr. Justice *Buller* at the trial. R. v. Arkwright.

So in the case of *Boulton and Watt* v. *Bull* (s), Mr. Justice *Roohe* said, that the public had a right to receive *a meritorious consideration* in return for the protection which the patent claims. Boulton v. Bull.

In the case of *Turner* v. *Winter* (t), Mr. Justice *Ashurst* laid it down as law, that a patent would be contrary to law, were it not for *the advantages which the public derive* from the communication of the invention. Turner v. Winter.

In the case of *Manton* v. *Parker* (u), Lord Chief Baron *Thomson* held, that the plaintiff's patent was void on the ground of *the utility of the invention having failed*, and nonsuited the plaintiff. Manton v. Parker.

So in the case of *Manton* v. *Manton* (x), Lord Chief Justice *Gibbs* held, that in order to support a right to the exclusive enjoyment of a patent, it is necessary that the party who takes out the patent should show that the invention is *useful to the public.* Manton v. Manton.

And in *Bovill* v. *Moore* (y), the same learned Judge held, that it was necessary that the plaintiff should prove that his invention was useful. Bovill v. Moore.

(r) Dav. P. C. 138.
(s) 2 H. Bl. 463; Dav. P. C. 162.
(t) 1 T. R. 602; Dav. P. C. 151.
(u) Dav. P. C. 327.
(x) *Ibid.* 333.
(y) *Ibid.* 399.

Huddart v. Grimshaw.

In the case of *Huddart* v. *Grimshaw* (z), Lord *Ellenborough*, C. J., held, that in order to support a patent, the invention ought to be *beneficial to the public.*

Brunton v. Hawks.

In the case of *Brunton* v. *Hawks* (a), Lord Chief Justice *Abbott* left it to the jury to say whether the invention was useful. And in the case of *Russell* v. *Cowley* (b), in the Court of Exchequer, Lord *Lyndhurst*, C. B., said that the first question respecting the invention was, whether it was new and *useful*; and the rest of the Court fully concurred in opinion with his Lordship.

Russell v. Cowley.

Hill v. Thompson.

In the case of *Hill* v. *Thompson* (c), Lord *Eldon*, L. C., cited with approbation the ruling of Lord Chief Justice *Dallas* at Nisi Prius, that an invention must be useful. So in *Minter* v. *Wells* (d), Mr. Baron *Alderson* held, that in order to establish his patent, a patentee must show that his invention was useful. And the same learned Judge, in *Morgan* v. *Seaward* (e), in his address to the jury said, that if the invention was useful it was a subject to be protected by patent; but if it was of no use, then it was not a subject to be protected by patent.

Minter v. Wells.

Morgan v. Seaward.

Neilson v. Harford.

In the case of *Neilson* v. *Harford* (f), the Court of Exchequer held, that to make the patent valid, a machine constructed according to the invention must be one *beneficial to the public.*

Crane v. Price.

And in the case of *Crane* v. *Price* (g), the Lord Chief Justice *Tindal*, in delivering the judgment of the Court of Common Pleas, said, (speaking of the labour, pains, and expense incurred by the plaintiff in bringing his invention to perfection,) "If the invention be new and *useful to the public*, it is not material whether it be the result of long experiments and profound research, or whether by some sudden and lucky thought, or mere accidental discovery."

These authorities clearly establish the law to be, that an invention must be useful to the public, in order to make it a good subject of a privilege granted by letters patent. And utility is not only required by law, but appears upon the face

Utility appears by the patent to

(z) Dav. P. C. 265.
(a) See 4 B. & Ald. 541.
(b) 1 Webs. R. 467.
(c) 3 Mer. 622.
(d) 1 Webs. R. 129.
(e) 2 M. & W. 544.
(f) 8 M. & W. 806; 1 Webs. 331.
(g) 4 M. & G. 580; 1 Webs. R. 393, S. C.

of every patent to be the consideration or motive for the Queen making the grant. For we have seen (*h*), that the recital contained in patents for inventions concludes with these words, "and we being willing to give encouragement to all *arts and inventions which may be for the public good*, are graciously pleased to condescend to the petitioner's request." It is evident, therefore, that the Queen always intends that the patentee shall give to the public, as a consideration for a grant of this description, some art or invention which shall be for the public good, or in other words, useful to the public.

To be part of the consideration.

It has already been shown (*i*), that, if the consideration which the Queen intends to have for such a grant fails, the patent is wholly void. And if it should appear that an invention which is made the subject of a grant by patent is of no utility to the public, then there was no consideration for the making of the grant, and the patent is for that reason entirely void.

If the consideration fails the patent is void.

The law, however, only requires an invention to be of *some* utility, and if it is of *any* use to the public, that is sufficient, provided the Crown does not appear to have been deceived as to the extent of the utility of the invention. Thus, in the case of *Morgan* v. *Seaward* (*k*), at Nisi Prius, Mr. Baron *Alderson* held that it was not for the jury to consider to what extent the invention was useful, and that it was sufficient if the invention was of *any* use. And one part of the invention being an improvement in steam-engines, his Lordship was of opinion that if the new engine was of a different construction from any other steam-engine, and of *any* use to the public, the *utility* would be sufficient to support the patent.

The law only requires some utility.

Morgan v. Seaward.

So in the case of *Haworth* v. *Hardcastle* (*l*), which was an action for infringing a patent for an invention of machinery for taking up calicoes, muslins, linens, and other similar fabrics, for the purposes of drying, Mr. Justice *Alderson*, at Nisi Prius, directed the jury that it was sufficient if the invention was of *any* use, and the Court of Common Pleas held the direction to be right. The jury, in that case, found that the invention was useful upon the whole, but that the machine was

Haworth v. Hardcastle.

(*h*) *Ante*, Chap. IV. pp. 47, 48.
(*i*) Vide *ante*, Chap. IV. p. 48.
(*k*) 1 Webs. R. 172, 186.
(*l*) 1 Bing. N. C. 182; 4 Mo. & Sc. 720, *S. C.*, and vide *ante*, Chap. I.

not useful in some cases for taking up goods. And the Court of Common Pleas held (*m*), that this did not invalidate the patent, and therefore discharged a rule *nisi* for a new suit.

Lewis v. Marling.

If part of an invention not described as essential turns out to be unnecessary, the want of utility in that part will not avoid the patent.

In the case of *Lewis* v. *Marling* (*n*), it appeared at the trial at Nisi Prius, that the patent was for an invention of improvements in machines for shearing woollen cloths. One part of the invention described in the specification was a plush brush for raising the wool, which was afterwards found to be unnecessary, and was never used. It was objected, on the part of the defendant, that the patent was void on the ground of the brush being wholly useless; but Lord *Tenterden*, C. J., held that as the patentee did not claim the brush as an *essential* part of the machine, the want of utility in the brush did not invalidate the patent. This case afterwards came before the Court of King's Bench, upon a motion for a new trial, and the Court laid down the law in precisely the same terms as Lord *Tenterden* had at Nisi Prius. Lord *Tenterden*, C. J., said, "It does not appear that the patentee says the brush is an essential part of the machine, although he claims it as an invention. When the plaintiffs applied for the patent, they had made a machine to which the brush was affixed; but before any machine was made for sale, they discovered it to be unnecessary. I agree that if the patentee mentions that as an essential ingredient in the patent article which is not so, nor even useful, and whereby he misleads the public, his patent may be void; but it would be very hard to say that this patent should be void because the plaintiffs' claim to be the inventors of a certain part of the machine not described as essential, and which turns out not to be useful." Mr. Justice *Bayley* said, "At the period when this specification was made, the plush (brush) was in use, and there is no reason to believe that this patentee did not think it was a useful part of the machine. His patent is for an instrument, where something of that kind was always thought material, and I am of opinion that the subsequent discovery that the plush was unnecessary, is no objection to the validity of the patent. If the party knew that it was unnecessary, the patent would be bad, on the ground that this was a deception; but if he

(*m*) 1 Bing. N. C. 182; 4 Mo. & Sc. 720, *S. C.*

(*n*) 4 C. & P. 52; 10 B. & C. 22, *S. C.*

thought it was proper, and only by a subsequent discovery finds out that it is not necessary, I think that it forms a ground of objection."

Morgan v. Seaward.

And in the case of *Morgan* v. *Seaward* (*o*), Mr. Baron *Parke* said, in delivering the judgment of the Court of Exchequer, we do not mean to intimate any doubt as to the validity of a patent for an entire machine or subject, which is, taken altogether, *useful*, though a part or parts may be useless; *always supposing that such patent contains no false suggestion.*

Each invention comprised in a patent must be useful.

But if there are several distinct inventions comprised in a patent, then it is clear that *each* invention must be of *some* utility to the public, or the *whole* grant will be void.

Morgan v. Seaward.

Thus, in the case of *Morgan* v. *Seaward* (*p*), at Nisi Prius, it appeared that the invention consisted of improvements both in steam-engines and in machinery for propelling vessels. The defendants having pleaded that the invention was of no use, Mr. Baron *Alderson*, in his charge to the jury, said that they could not find a verdict for the plaintiffs unless they were satisfied that both the steam-engine and the machinery for propelling vessels were useful.

Hill v. Thompson.

The reason for this is stated very clearly by Lord Chief Justice *Dallas*, in the case of *Hill* v. *Thompson* (*q*), to be, "That if any part of the alleged discovery, being a material part, fail, (the discovery in its entirety forming one entire consideration,) the patent is altogether void." And the same law was laid down (as to novelty) by the Court of Queen's Bench, in the case of *Brunton* v. *Hawks* (*r*).

Misrepresentation respecting utility awards a patent.

And if any material part of the representation or suggestion which appears by a patent to have been made in the petition to the Crown, respecting the utility of the invention, shall fail or be untrue, the consideration fails in part, and the grant is totally void (*s*); and that not only on the ground of the partial failure of the consideration, but because the representation being false the Queen was deceived in her grant (*t*).

Turner v. Winter.

Thus in the case of *Turner* v. *Winter* (*u*), in which it ap-

(*o*) 2 M. & W. 563.
(*p*) 1 Webs. R. 172.
(*q*) 8 Taunt. 375; 2 B. Mo. 448, *S.C.*
(*r*) 4 B. & Ald. 541.
(*s*) *Bloxam* v. *Elsee*, 6 B. & C. 178.
(*t*) *Morgan* v. *Seaward*, 2 M. & W. 561.
(*u*) 1 T. R. 602; Dav. P. C. 145, *S. C.*

peared that the patent was for an invention to do three things in one process, it was objected that one of the things, *viz.* white lead, could not be produced at all; and Mr. Justice *Buller* told the jury, that if the objection was well founded it would avoid the patent. The jury having found a verdict for the plaintiff, the defendant moved the Court of King's Bench for and obtained a rule for a new trial. Mr. Justice *Ashurst* said, in delivering his judgment, "The patent is for making white lead and two other things by one process; if the process, as directed by the specification, does not produce that which the patent professes to do, the patent itself is void." And Mr. Justice *Buller* said, "If the patentee says that by one process he can produce three things, and he fails in any one, the consideration of his merit, and for which the patent was granted, fails, and the Crown has been deceived in the grant."

Bloxam v. Elsee.

In the case of *Bloxam* v. *Elsee* (*x*), the patentee had represented that his invention was a machine for making paper in single sheets, without seam or joining, *from one to twelve feet and upwards wide*, and from one to forty-five feet and upwards in length. It appeared in evidence that the machine was so constructed as to be capable of producing paper of one definite width only, and that in order to vary the width a new machine was required. It was held by the Court of King's Bench that the meaning of the patentee's representation was, that paper of various widths might be obtained by one and the same machine; and as that representation was not true, the patent was void. In delivering judgment the Lord Chief Justice *Abbott* said, "By the patent it appears that the patentee had represented to the Crown that he was in possession of a machine for making paper in single sheets without seam or joining, from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length. Upon this representation the patent is granted. The consideration of the grant is the invention of a machine for making paper in sheets of width and length varying within the limits designated. If any material part of the representation was not true, the consideration has failed in part, and the grant is consequently void, and a defendant in an action for infringing the patent has a right to say that it is so."

(*x*) 6 B. & C. 169.

And in the case of *Morgan* v. *Seaward* (*y*), it appeared that the plaintiff, by his patent and specification, claimed two separate inventions under the title of "improvements in steam-engines, and in machinery for propelling vessels, which improvements are applicable to other purposes." The defendant pleaded that the invention was not an improvement in *steam-engines*, and the jury having found a verdict for the defendants on that plea, the Court of Exchequer held, that although the jury by their verdict had found that one part of the invention was an improvement in machinery for propelling vessels, yet one of the inventions not being an improvement, the grant was wholly void. Mr. Baron *Parke* said, in delivering the judgment of the Court, "We cannot help seeing, upon the face of this patent as set out in the record, that an improvement in steam-engines is suggested by the patentee, and is part of the consideration for the grant, and we must reluctantly hold that the patent is void for the falsity of that suggestion." Morgan v. Seaward.

In the case of *Losh* v. *Hague* (*z*), in the Court of Exchequer, the invention was of improvements in wheels for railway carriages. The defendant by his second plea alleged that the improvements were only trifling and insignificant alterations in the mode of making wheels before known, and were not legal subjects of a patent. Upon the issue raised by this plea, Lord *Abinger*, C. B., left it to the jury to consider whether the invention was worth a patent or not. The question thus raised in this case seems to have been in effect, whether the representation made to the Crown, that the invention was improvements in the construction of railway carriage wheels, was true or not; for the representation must mean some substantial improvements in such wheels, and if the improvements were trifling and insignificant, the representation was false, and the patent would have been void. Losh v. Hague.

The Statute of Monopolies, it has been seen (*a*), provides that grants of privilege shall not be "contrary to the law; nor mischievous to the state by raising prices of commodities at home, or hurt of trade, or generally inconvenient." Useless invention is mischievous and contrary to law.

And in the case of *Morgan* v. *Seaward* (*a*), the Court of Exchequer said, that "A grant of a monopoly for an inven- Morgan v. Seaward.

(*y*) 2 M. & W. 544.
(*z*) 1 Webs. R. 202.

(*a*) *Ante*, p. 134.

tion which is altogether useless, may well be considered as 'mischievous to the state, to the hurt of trade, or generally inconvenient,' within the meaning of the statute of James I., which requires, as a condition of the grant, that it should not be so, for no addition or improvement of such an invention could be made by any one during the continuance of the monopoly, without obliging the person making use of it to purchase the useless invention."

An invention for an illegal purpose not the subject of a privilege.

This clause of the statute seems also to mean that the excepted grants must not be for the sole making of any thing which is to be used for any purpose which is illegal, or "contrary to law," such as implements for house-breaking, picking pockets, locks, &c. Such grants, however, it is clear would be void, not only on the ground of want of public utility, but also because they are contrary to the policy of the law; and indeed it would be absurd if, by one law, patents might be granted to reward persons for providing the means of violating any other law.

CHAPTER VI.

OF THE DURATION OF THE PRIVILEGE GRANTED BY A PATENT FOR AN INVENTION, AND THE PROLONGATION OF IT.

SEC. I.—*Of the Term which may be granted by Patent in the first instance.*
II.—*Of the Extension of the Term by New Letters Patent.*
III.—*Of the Prolongation of the Term by Act of Parliament.*

SECTION I.

Of the Term in a sole Privilege which may be granted by Patent in the first instance.

Duration of a patent at Common Law.

BEFORE the passing of the Statute of Monopolies, the Crown had power by the Common Law to grant the sole use of an invention *for a reasonable time* (*a*).

Duration of a patent since the Statute of Monopolies.

The 6th section of the Statute of Monopolies (*b*) contains a saving of this prerogative of the Crown, as to "letter patents and grants of privilege *for the term of fourteen years or under*," thereafter to be made; and it is declared that the fourteen years are "to be accounted from the date of the first letters patents or grants of such privilege," thereafter to be made, but with the proviso, that "the same shall be of such force as they should be," if the Act had not been made, "and of none other."

This statute, therefore, limited the prerogative of the Crown so far, that a patent could not be granted for *more* than four-

(*a*) Noy, 182; 3 Inst. 184; 2 Rol. R. 4; 3 Shep. Abr. 61; Bac. Abr. Monop. (A). Prerog. (F 4); 1 Hawk. P. Cr. c. 79, s. 6.

(*b*) 21 Ja. I. c. 3.

teen years, but still leaving the question open for consideration whether a patent for fourteen years was for a reasonable term; and good at the Common Law.

Sir Edward Coke says (*c*), "The cause wherefore the privileges of new manufactures, either before this Act granted, or which after this Act should be granted, having these seven properties, were not declared to be good, was for that the reason wherefore such a privilege is good in law, is because the inventor bringeth to and for the commonwealth a new manufacture by his invention, cost, and charge, and therefore it is reason that *he should have a privilege for his reward* (and the encouragement of others in the like) *for a convenient time*; but it was thought that the times limited by this Act were too long for the private, before the commonwealth should be partaker thereof, and such as served such privileged persons by the space of seven years, in working of the new manufacture (which is the time limited by law of apprenticehood), must be apprentices or servants still during the residue of the privilege, by means whereof such numbers of men would not apply themselves thereunto, as should be requisite for the commonwealth after the privilege ended. And this was the true course wherefore, both for the time passed and for the time to come, they were left of such force, as they were before the making of this Act."

It seems from this commentary as if *Sir Edward Coke* thought that the inventor ought to be rewarded by a term in proportion to the benefit of his invention to the commonwealth. The other reason which he gives against the legality of the term of fourteen years mentioned in the Act, has never been attended to; and patents for inventions have always, in practice, been granted for the full term of fourteen years allowed by law, and no patent has ever been decided to be invalid, on the ground of the term of the grant being too long.

Grants may be made for less than fourteen years.

There can be no question, however, that the Queen may grant the use of an invention for any term less than fourteen years; and the provision in the statute that the term of fourteen years is to be computed from the date of the *first* letters patent or grant, seems to show that the Queen might grant

(*c*) 3 Inst. 184; *ante*, pp. 14, 15, 16.

several terms shorter than fourteen years, provided the terms do not altogether exceed in duration the fourteen years allowed by the statute.

Section II.

Of the Extension of the Term by New Letters Patent.

Before the passing of the statute 5 & 6 Will. IV. c. 83 (*d*), the only mode by which the duration of a patent privilege in an invention could be extended, was by Act of Parliament. By the fourth section of that statute it is in effect provided, that if any person who shall obtain any letters patent, shall publish such advertisements as therein mentioned, and shall apply by petition to the Queen in council for a prolongation of his term; and if the consideration of the petition shall be referred to the Judicial Committee of the Privy Council, the petitioner, and also persons entering *caveats* against the prolongation are to be heard by their counsel and witnesses; whereupon the Judicial Committee of the Privy Council may report to the Queen, that a further extension of the term should be granted, not exceeding seven years. And her Majesty is thereby authorized and empowered, if she shall think fit, to grant new letters patent for the invention, for a term not exceeding seven years after the expiration of the first term (*e*).

Stat. 5 & 6 Will. IV. c. 83.

Sec. 4.

Upon report of judicial committee further term not exceeding seven years may be granted.

We have seen that the object of our Patent Law is to reward those who give to the public the knowledge of new and useful inventions, and in this manner to encourage others to give the public the benefit of such inventions (*f*).

Object of the law to reward inventors.

The principle upon which an extension of a patent privilege is granted to a patentee, is, that he has not been rewarded or sufficiently rewarded for the benefit which the invention has conferred upon the public.

Extension granted because patentee not rewarded.

When an inventor has obtained his patent, he must in the first place apply himself to the task of bringing his invention

Time lost in bringing inventions to perfection.

(*d*) See the statute in the Appendix, Chapter I. s. 1.

(*e*) For the proceedings to be taken in order to obtain the prolongation of a patent term, see the Practice, *post*, Chap. XII.; and for the construction of the act see *Russell* v. *Ledsam*, not yet reported.

(*f*) Vide *ante*, Chap. III.

to such a degree of perfection as to make it useful to the public, and in doing so, must necessarily incur expense and expend a considerable portion of the term granted by the patent.

Difficulty of introducing new articles.

And however useful and meritorious an invention may be, it is generally very difficult to introduce new articles into such general use as to remunerate the patentee for his necessary outlay; and in many instances a patentee does not during the term of fourteen years, allowed by law to be granted to him in the first instance, receive anything like an adequate reward for the benefit which he confers upon the public.

Justice of following act, the principle of the law.

It is but just, therefore, that the law should follow out the principle upon which patents for inventions are granted; and where it is shown that a patentee without any fault of his own has not been remunerated for his labour, and necessary outlay, or has not been adequately rewarded for the benefit which the invention has conferred upon the public, he ought to have such a further term granted to him as will be sufficient for effecting both those objects.

Intent of the statute to provide more adequate rewards.

Considering the general object of our Patent Law, and the preamble of the statute 5 & 6 Will. IV. c. 83, there can be no doubt that the intent of the 4th section of that Act was to provide for the more adequately rewarding of inventors, where they have given the public useful inventions, and have received no sufficient remuneration. And there can be no *question respecting the good policy of granting such extensions*, in proper cases, for obtaining "the more ample benefit of the public" (*g*) from such meritorious inventions.

Petitioner must show both utility of invention and want of remuneration.

Acting upon this intent of the law, and also in accordance with the grounds upon which Acts of Parliament have been granted for extending the terms granted by patents, the judicial Committee of the Privy Council require every petitioner, for the prolongation of a patent term, to show not only that the invention is of considerable benefit to the public, but also that he has been unable to obtain any sufficient remuneration for his ingenuity and necessary outlay (*h*). And the practice of the Judicial Committee has been to report in favour of

(*g*) These words are in the preamble of the statute 5 & 6 Will. IV. c. 83.

(*h*) See further, as to what must be proved in support of a petition for prolongation of a patent term, Practice, Chapter XII.

extensions for such terms as the merits of inventions, and the exigencies of the cases, require. In some cases the full term of seven years has been granted, but in many others, the extension has been for shorter periods.

Power of prolongation extended to 14 years by 7 & 8 Vict. c. 69. s. 2.

Cases have occurred in which the extra term of seven years authorized by the statute 5 & 6 Will. IV. c. 83, s. 4, would entirely fail to remunerate an inventor sufficiently, and therefore the power granted to the Queen in Council, was, by s. 2, of the stat. 7 & 8 Vict. c. 69 (*i*), extended so as to authorize grants being made in such cases for terms not exceeding fourteen years.

The object to remunerate patentees.

The object of this enactment also clearly appears on the face of it to be, to enable inventors to obtain a due remuneration for their expense and labour in perfecting their inventions in cases where an additional term of seven years would be insufficient for that purpose.

The privy council will sometimes require an assignee to reward the original patentee.

The object of the Patent Law being to reward meritorious inventors, the Privy Council will sometimes, in case of an application by an assignee of a patent for a prolongation, carry the object of the law into effect by annexing a condition in favour of the original patentee to the grant of the prolongation which the assignee seeks to obtain.

Whitehouse's patent.

Thus, in the case of *Whitehouse's* patent (*k*), the application for an extension of the term was made by the assignee of the patent, and it appeared that the assignment under which he claimed reserved an annuity of 300*l.* a year to the patentee. The Judicial Committee of the Privy Council deemed the case to be a fit case for an extension of the term for six years, but granted it only upon condition that the patentee had an annuity of 500*l.* a year secured to him during the continuance of the additional term, which was granted in pursuance of their Lordship's report. Upon the new patent being granted, the securing of this annuity to the first patentee was recited as part of the consideration for the grant of the patent to the assignee, and the performance of the assignee's agreement to pay the annuity was secured by a proviso in the patent, that the patent should be void if the assignee failed to perform his

(*i*) See the statute in the Appendix, Chap. I. s. 1.

(*k*) 1 Webs. R. 473.

agreement (*l*). Such cases as this are calculated to produce a very beneficial effect, as evincing a determination on the part of those who so ably administer the law to do justice to meritorious inventors, and reward them (as far as the law enables them) according to the degree of their merits.

Privy council will consider the position of licensees.

In granting a prolongation of a patent term, the Judicial Committee of the Privy Council will also take into consideration the position of licensees, and see that they are not unfairly prejudiced by the prolongation. A person who obtains a licence to use a patent privilege, only purchases the right during the continuance of the patent privilege; but he also makes the purchase, and perhaps invests considerable capital in machinery, or stock for working the invention, with the expectation that he will be at liberty to enjoy the unrestricted use of the invention at the end of the term.

New privilege would prejudice licensees.

But if a new privilege be granted to the patentee, to take effect from the expiration of the first, licensees under the first patent would be unable to continue the use of the invention without the consent of the patentee under the new patent, who might impose oppressive terms upon them, or altogether refuse a renewal of their licences. The fair and equitable mode of adjusting the respective rights of a patentee and his licensees in such a case seems to be, that every licensee should have the privilege of using the invention during the continuance of the new patent upon the same terms as he enjoyed his former licence.

Patentee must arrange with licensees.

Therefore, whenever there are several licensees entitled to use a patent invention, the patentee will not be able to obtain an extension of his term, unless he makes some arrangement with them, or undertakes to grant them licences upon the same terms as their former licences. It was for this reason that in the case of *Southworth's* patent (*m*), the petitioner proved in evidence that arrangements had been made with all the licensees that they should have licences on the same terms in the event of the term of the patent being extended.

Privy council will not interfere with legal or equitable claims.

But the Judicial Committee of the Privy Council will not, in other cases, interfere in favour of parties who, not being inventors, set up legal or equitable claims to participate in the

(*l*) 1 Webs. R. 476, n. (*h*).

(*m*) 1 Webs. R. 486, 487.

benefits to arise from the prolongation of a patent privilege, but will recognize the legal proprietors of the first patent only, leaving other parties to pursue their legal or equitable claims before the ordinary tribunals (*n*).

Some doubt having arisen in the construction of section 4 of the statute 5 & 6 Will. IV. c. 83, respecting the power conferred by that Act to grant prolongations in cases where patentees have wholly or partly assigned their privileges (*o*), the question was set at rest by the statute 7 & 8 Vict. c. 69, s. 4 (*p*), by which it is declared that an extension may be granted either to an assignee or assignees, or to the original patentee or patentees, or to an assignee or assignees and patentee or patentees conjointly.

Doubts as to power to grant extensions to assignees of patents obviated by 7 & 8 Vict. c. 69, s. 4.

Section III.

Of the Prolongation of the Term in a Patent, by Act of Parliament.

Before the Crown was enabled to grant an extension of a patent term, by the statute 5 & 6 Will. IV. c. 83, s. 4, (mentioned in the preceding section of this Chapter,) the terms of patents for inventions were frequently prolonged by Parliament. The practice of prolonging patents in this manner seems to have originated soon after the passing of the Statute of Monopolies (1623), for we find an order of the House of Commons respecting petitions for bills to extend the terms in patents dated as far back as 1685.

Patent terms formerly prolonged by parliament.

Many of the Acts which have been passed for this purpose are mentioned in the Appendix to the Report of the Committee of the House of Commons in 1829, respecting the Law of Patents.

Almost all (if not all) the Acts which have been passed to extend the terms granted by patents, have been granted by Parliament upon the ground of the utility or benefit of the inventions to the public, and the Acts themselves recite this

Acts were granted because inventions useful.

(*n*) See the case, *Wright's* patent, 1 Webs. R. 561.

(*o*) In *Southworth's* case however Lord *Brougham* said, that the new letters patent ought to be granted to the parties who had a legal interest in the existing patent.

(*p*) See the stat. in the Appendix, Chap. I. s. 1.

to be the reason or motive for granting the extension sought by the patentees.

In granting extensions under the 5 & 6 Will. IV. c. 83, s. 4, and 7 & 8 Vict. c. 69, s. 2, the Judicial Committee of the Privy Council seem to have considered themselves (as in truth they are) merely acting in the place of Parliament; and in execution of the powers thus delegated to them, have granted extensions of terms in patents in such cases only as Parliament would have granted them.

No Acts passed since 5 & 6 W. IV. c. 83.

There have been no Acts passed for prolonging such terms since the statute 5 & 6 Will. IV. c. 83 came into operation; and since the statute 7 & 8 Vict. c. 69, extends the power of the Queen in Council so as to authorize a prolongation for an additional term of fourteen years, there seems to be very little probability of any application to Parliament for such an Act being successful.

And it is clear that such an application would not succeed in any case except under extraordinary circumstances, and in all probability not until the patentee has obtained an extension of his term by a new patent under the recent statutes and found that the extended term is insufficient to procure him an adequate remuneration.

CHAPTER VII.

OF THE SPECIFICATION OF AN INVENTION WHICH IS MADE THE SUBJECT OF A PATENT PRIVILEGE.

Specifications were unknown until the reign of Queen Anne; but before that time, it was usual in a patent, granting the sole use of an invention, to insert a recital containing a description of the invention which was made the subject of the grant (*a*). And there can be little doubt that a patent without such a recital, and also without a condition requiring a specification or description of the invention in some way or other for the use of the public, would be absolutely void for want of consideration.

Specification unknown until the reign of Queen Anne.

The descriptions of inventions which were formerly contained in patents were, however, very meagre and unsatisfactory, and the practice being found inconvenient, about the middle of the reign of Queen Anne it became usual to insert in patents merely a short description or title of the invention, but at the same time with a proviso requiring that the patentee should enrol a particular description of the invention in Chancery, within a short time after the date of the patent.

Origin of specification.

This was the origin of the instruments which are now generally denominated specifications.

The specification or description of a patent invention, by instrument enrolled in Chancery, is not however required either by the Common Law or by the Statute of Monopolies, as has frequently been supposed, but only by the condition or proviso which is contained in the patent itself.

Specification required by proviso in the patent only.

The form of this condition in patents (*b*) invariably provides that if the patentee shall not *particularly describe and ascertain the nature of his invention, and in what manner it is to be performed* by an instrument in writing under his hand and

Form of proviso.

(*a*) Vide *ante*, Chap. IV. p. 69.
(*b*) See the Form, *ante*, Chap. IV. p. 68.

seal, and cause the same to be enrolled in Chancery within the time named (four or six months) after the date of the patent, then the patent and the privilege granted by it are to cease and become void.

Two things required.

There are two things required by this proviso: *first*, That the patentee shall describe his invention by an instrument in writing, usually termed a specification; and, *second*, That this instrument shall be enrolled in Chancery, within a limited time, so as to become a record for the benefit of the public. We will first consider the specification itself.

If patentee dies before specification the patent is void.

The condition requires that the specification shall be under the hand and seal of the patentee (*c*), or if there be two or more patentees, then under the hand and seal of the patentees, or of one of them. But no executor, administrator, assignee, nor any other person except the patentee himself can make a valid specification of the invention. And, therefore, in case of the death of the patentee before specification of the invention, the patent must become void for want of a compliance with this condition.

Must be in writing.

A specification is also required to be in writing, and it may be written upon parchment, vellum, or paper, but it is apprehended not upon any other substance (*d*). But, although it must be in *writing*, it is not necessary that it should be entirely in *words*, it may be made partly in writing, and partly by means of plates, drawings, or figures.

Drawings or figures may also be used.

Macfarlane v. Price.

In the case of *Macfarlane* v. *Price* (*e*), Lord *Ellenborough*, C. J., said, that the patentee in his specification ought to inform the person who consults it, what is new and what is old; he should say, my improvements consist in this, describing by words if he can, or if not, by reference to figures.

Bloxam v. Elsee.

In the case of *Bloxam* v. *Elsee* (*f*), Lord Chief Justice *Abbott* said, "An inventor of a *machine* is not tied down to make such a specification, as, by words only, would enable a skilful mechanic to make the machine, but he is to be allowed to call in aid the drawings which he annexes to the

(*c*) Although a specification is, in pursuance of the condition, always made under the hand and seal of the patentee, it seems that it is not a deed, for an instrument requires delivering as well as sealing in order to become a deed; Shep. Touch. 54, 55; Co. Lit. 36, a; Perkins, s. 137.

(*d*) Vide Shep. Touch. 54; Co. Lit. 229, a.

(*e*) 1 Stark. R. 199.

(*f*) 1 C. & P. 558, 564.

specification; and if, by a comparison of the words and the drawings, the one will explain the other sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient."

In the case of *The King* v. *Arkwright* (*g*), Mr. Justice *Buller* directed the jury, that in determining the specification they were to consider it in conjunction with the plan annexed. And Mr. Baron *Alderson* directed the jury in a similar manner in the case of *Morgan* v. *Seaward* (*h*). R. v. Arkwright.

It is, however, no objection to a specification that it has no drawing annexed to it, if it sufficiently describes the invention (*i*). Nor is it any objection that the drawings annexed to a specification are roughly executed, if they are sufficient with the specification to enable a competent person to use the invention (*k*). Want of drawings no objection.

There is no particular form requisite for a specification, nor are there any technical words necessary to be used in describing a patent invention. No particular form requisite.

The instrument must, however, in some way at least refer to the patent intended to be specified, or contain words which sufficiently indicate an intention to perform the condition in the patent. Must refer to patent.

Custom has, however, sanctioned a particular form for the commencement or introductory part of specifications, which patentees, with great prudence, almost invariably adopt. Form generally used.

Specifications framed in the usual way commence in the same form as a deed poll, with a direction such as the following:—"To all to whom these presents shall come, or be made known, I, James Gowland, of Leathersellers Buildings, London Wall, in the City of London, Chronometer Maker, send greeting." And this direction is proper, because all persons are interested in the subject of the patent, and are at their peril bound to take notice of the contents of the specification *as enrolled* (*l*); and it will become essentially a part of the patent itself, if it be a sufficient and legal compliance with the condition upon which the patent was granted. Commencement.

(*g*) Dav. P. C. 128.
(*h*) 1 Webs. R. 173, 176.
(*i*) Per *Rook*, J., in *Boulton* v. *Bull*, Dav. P. C. 188, 189.
(*k*) Per *Gibbs*, C. J., in *Bovill* v. *Moore*, Dav. P. C. 369.
(*l*) 1 Co. R. 45, a.

Recital of patent.

The specification then proceeds to recite the grant by patent of the invention intended to be specified in a form substantially as follows:—"Whereas her most excellent Majesty, Queen Victoria, by her letters patent, under the Great Seal of Great Britain, bearing date at Westminster, the day of in the year of her said Majesty's reign, did give and grant unto me the said James Gowland, my executors, administrators, and assigns, her especial licence, full power, sole privilege and authority, that I, the said James Gowland, my executors, administrators, and assigns, and such others as I, the said James Gowland, my executors, administrators, and assigns, should at any time agree with, and no others, from time to time, and at all times thereafter during the term of years therein mentioned, should, and lawfully might make, use, exercise, and vend, within that part of the United Kingdom of Great Britain and Ireland, called England, the Dominion of Wales, and Town of Berwick-upon-Tweed [the Islands of Guernsey, Jersey, Alderney, Sark and Man, and all her said Majesty's colonies and plantations abroad], my invention of '*a certain improvement, or certain improvements in the mechanism of Timekeepers,*' in which said letters patent there is contained a proviso, that I, the said James Gowland, shall particularly describe and ascertain the nature of my said invention, and in what manner the same is to be performed, by an instrument in writing, under my hand and seal, to be enrolled in her said Majesty's High Court of Chancery, within [six] calendar months next, and immediately after the date of the said in part-recited letters patent, as reference being thereunto had will more fully and at large appear."

This recital is amply sufficient to identify the patent, and the invention which is intended to be described. It is also useful, if not indeed necessary, in order to give notice to the public of the grant and authority in pursuance of which the description is made and enrolled amongst the public records of the country.

Declaration of intent.

The specification then, according to the usual form, proceeds to declare the intent of the instrument thus:—

Without drawings.

"Now, know ye, that in compliance with the said proviso, I, the said James Gowland, do hereby declare that the nature

of my said invention, and the manner in which the same is to be performed, are described and ascertained as follows (that is to say): my said invention consists," &c.

Then follows the description of the invention which is intended to be given in compliance with the condition in the patent.

But if the patentee makes use of drawings to aid him in describing his invention, the form is as follows:— With drawings.

"Now, know ye, that in compliance with the said proviso, I, the said James Gowland, do hereby declare that the nature of my said invention, and the manner in which the same is to be performed, are described and ascertained with the aid of the drawings annexed hereto (or appearing on the margin of these presents) by the words, letters, and figures following (that is to say): my said invention," &c.

After which follows the description of the invention, referring from time to time to the drawings when necessary.

This commencement of an ordinary specification is sufficient to show that the intent is to specify the invention comprised in the patent which is recited. This commencement sufficient to show intent.

Some such declaration of the intent or purpose of the instrument is clearly necessary, for if a specification was entirely without such a declaration, it would be difficult, if not impossible, to ascertain to what it referred, and therefore it could not be a sufficient compliance with the condition in the patent. Some declaration of intent necessary.

The effect of this commencement is, *primâ facie*, to claim as part of the invention every thing comprised in the following description (*m*). And therefore, if anything is comprised in the description which forms no part of the invention, it becomes necessary afterwards to disclaim it, in order to prevent the patent from being void by reason of the claim being too extensive. Effect of the commmencement.

Having examined the formal commencement of a specification, we now come to the consideration of the essential or substantial part of it.

The condition already stated requires that this instrument shall "*particularly* describe and ascertain" the invention, Must *particularly* describe the invention.

(*m*) *Bovill* v. *Moore*, Dav. P. C. 399.

and that it shall describe and ascertain not only "the *nature* of the invention," but also "*the manner in which it is to be performed.*"

The patent itself merely contains what is called the title of the invention; but the terms in which titles usually describe inventions in patents, do not descend to any particularity, and they never give any precise information respecting the nature of the inventions, much less as to the manner in which they are to be carried into effect.

Must show what the invention is.

The condition in a patent, therefore, requires that the specification shall contain a *description* of the invention, and the description is required to be *particular*, so that it may clearly *ascertain* what the invention is.

Must show how it is to be performed.

We have seen that the subject of every patent, granting the sole use of an invention, is in fact a sole privilege of using an art for manufacturing vendible articles (*m*). The condition for specification, therefore, requires that that instrument shall describe not only the nature of the art or invention, but *the manner in which it is to be performed.*

Object of the proviso requiring a specification.

The object of the proviso or condition which requires the enrolment of a specification is two-fold: first, That the public may know what it is they are prohibited from using during the term granted by the patent (*n*); and, secondly, That after the term has expired, the public may have the full benefit of the invention which forms the consideration for the grant.

Harmar v. Playne.

Thus, in the case of *Harmar* v. *Playne* (*o*), Lord *Ellenborough*, C. J., said, that the object of requiring a specification to be enrolled seemed to be to enable persons of reasonable intelligence and skill in the subject-matter to tell, from the inspection of the specification itself, what the invention was for which the patent was granted, and how it was to be executed. And in the case of *Bovill* v. *Moore* (*p*), Lord Chief Justice *Gibbs* said, that the object of the condition which requires the specification is, that the patentee shall thereby describe the mode of the manufacture, so as to enable any person to make it after his term is expired.

Bovill v. Moore.

Public entitled to know what

The patentee is required to enrol a specification of his in-

(*m*) Vide *ante*, Chap. V. s. 1, p. 77
(*n*) *Macfarlane* v. *Price*, 1 Stark. R. 201.
(*o*) Dav. P. C. 316.
(*p*) Dav. P. C. 398.

vention, because the public is entitled to know what the patent has been granted for, what they are prohibited from doing during the existence of the patent privilege, and what they are to become entitled to when it expires, as the consideration for the grant which has been made by the Crown on their behalf. the patent is for.

The vague description of an invention in the title of it contained in a patent, gives little if any notice to the public of the real nature of the manufacture they are prohibited from using, and unless some specific information were to be given to persons respecting what they are commanded by the patent to refrain from doing, they could not be punished for any violation of the patent right committed in ignorance of its nature and extent. Title gives little if any information.

Whenever therefore an action is brought against a party for infringing a patent, in order to ascertain whether he is guilty of an infringement or not, it is necessary to ascertain whether the thing which is complained of as a contravention of the patent, is really or substantially described in the patentee's specification, as the whole or part of the invention for which the patent was granted (*q*). And if the specification does not sufficiently describe some art of manufacturing which is substantially the same as that used by the party charged with the infringement, no action can be maintained against him for such an alleged violation of the patent privilege. Description must include infringement.

In the case of *Morgan* v. *Seaward*, Mr. Baron *Alderson* held (*r*), that the patentee ought to state in his specification the precise way of doing every thing which is part of his invention; and that if any thing cannot be completely done by following the specification, then a person will not infringe the patent by doing it. Morgan v. Seaward.

And in the case of *Nielson* v. *Thompson* (*s*), Lord *Cottenham*, L. C., said that the public are entitled to know for what it is that the patentee claims as the invention, that they may be saved inconvenience upon the subject; therefore the specification must tell the public for what it is that he claims protection. Nielson v. Thompson.

A patent for an invention in fact contains a bargain made between the Queen acting on behalf of the public, and an in- Patent contains a bargain to be construed as other bargains.

(*q*) See further as to what is an infringement, *post*, Chap. XI.

(*r*) 1 Webs. R. 182.

(*s*) *Ibid.* 283.

ventor, by means of which the inventor obtains the sole right for a limited time to use the art which he has discovered, in consideration of his giving to the public a knowledge of his invention (*t*), so as to enable other persons to use it after the expiration of his privilege. And such bargains are to be judged on the principle of keeping good faith by making a fair disclosure of the invention, and to be construed as other bargains (*t*).

Law relating to specification much discussed.

No branch of Patent Law has undergone more discussion or consideration than that relating to the specification, and more patents have failed by reason of defects in their specifications than from any other cause.

Specification for some purposes part of patent.

For many purposes the specification must be considered as part of the patent itself, for it is enrolled in pursuance of an authority contained in the patent, and therefore it may perhaps be laid down, that for all purposes except for showing its own sufficiency or proving a due compliance with the proviso, by which it is required to be enrolled, it must be considered as part of the patent itself.

Hornblower v. Boulton.

Thus in case of *Hornblower* v. *Boulton* (*u*), Mr. Justice *Grose* said, "I consider the patent and specification so connected together as to make a part of each other, and that to learn what the patent is, I may read the specification, and consider it as incorporated with the patent." There are indeed no other means of obtaining any definite information respecting the invention which is comprised in a patent, than by having recourse to the specification; and therefore for the purpose of a patentee showing what his invention is; and, (in answer to any objections made to it,) that it possesses all the qualities of novelty, utility, &c., required by law; as well as that any act which he complains of was really an infringement of his patent, the patentee is at liberty to refer to his specification, and to treat it as part of his patent.

Crossley v. Beverley.

Thus, in the case of *Crossley* v. *Beverley* (*x*), which was an action for the infringement of a patent, Mr. Justice *Bayley* said, "I think the specification and the patent are to be taken

(*t*) See the observation of Lord *Eldon*, C. J., in *Cartwright* v. *Amatt*, Dav. P. C. 317, 318; *Harmar* v. *Playne*, 14 Ves. 131, 136.

(*u*) 8 T. R. 105; Dav. P. C. 230, *S. C.*

(*x*) 9 B. & C. 62; 1 Webs. R. 117, *S. C.*

as one muniment in enforcing this claim on the part of the patentee." Unless there be some variance between the title in the patent and the description contained in the specification, the specification must be deemed *primâ facie* to describe the same invention, as that in respect of which the patentee originally petitioned the Crown for a patent privilege, and the description must, for all purposes, be deemed a part of the patent, except for the purpose of determining whether the patentee has sufficiently described the nature of the invention, and the manner in which it is to be used or performed according to the stipulations contained in the proviso in the patent, in pursuance of which he has enrolled it.

Object of specification to be considered.

In considering the requisites of a specification, it is necessary to have regard not only to the words of the proviso in the patent, but also to the object with which a specification is required, and which has already been mentioned, *viz. the furnishing of sufficient and certain information to the public respecting what they are prohibited from doing whilst the privilege continues, and what they will be enabled to do after it is expired.*

Object.

Difficult to frame a perfect set of rules.

Many rules have been laid down by different writers respecting the requisites of a specification, but it is difficult, if not impossible, to lay down such a set of rules as will be applicable to every possible case.

General rules only can be given.

All that can be done is to state such rules as are of most general application; and by citing the decided cases and dicta of the judges on the subject, the reader will be better enabled to apply those rules in practice to the construction of the instrument. It ought always, however, to be borne in mind, that the enrolment or publication of the specification is to be the performance by the patentee of his part of the bargain which he has made with the public, and that part of the bargain *he is expected to perform with perfect good faith.*

Must describe the same invention as the patent.

1. The patentee must in his specification describe the invention which is comprised in his patent, and not any other; and if it appears that there is any variance, or that the invention as described in the specification is not precisely similar to that mentioned in the patent, the patent will be void.

R. v. Wheeler.

Thus, in the case of *The King* v. *Wheeler* (*y*), it appeared

(*y*) 2 B. & Ald. 345.

that the invention was described by the title in the patent as "a new or improved method of drying and preparing malt." The specification stated the invention to consist in heating malt to a high degree, so that it should be changed to a deep brown colour. The jury having, by direction of Lord Chief Justice *Abbott*, returned a verdict for the Crown, the defendant moved for a new trial, which the Court of King's Bench refused, and the Lord Chief Justice, in delivering the judgment of the Court, said, "The defendant has represented himself to the Crown to be the inventor 'of a new or improved method of drying and preparing malt.' Malt was an article of common use before the granting of this patent, possessing qualities long and well known, and prepared or made by a process practised for many years, of which drying was one of the last stages. And it is in our opinion impossible to read this patent without supposing the patentee to claim the merit of having invented some new or improved method, either of organ or process of preparing, or at least of drying this old and well known article. Then, has the patentee by his specification shown himself to be the inventor of any method of drying or preparing this well known article? For this we are to look at the specification; and we there find that he claims to be the inventor, not of a method of drying or preparing this well known article, but of a method of giving to it, when previously prepared, some qualities which it did not possess before, or which it possessed only in a very slight degree; namely, the qualities of being soluble in water, and colouring the liquor in which it shall be dissolved, which latter is the object in view. And this is to be effected by a second and additional process, the application of a very high degree of heat. We think *the invention mentioned in this specification so entirely different from that mentioned in the patent, as that the latter* (if any such there be) *remains wholly undescribed and unspecified*, and consequently that the issue (respecting the sufficiency of the specification) could not be found for the defendant."

The invention mentioned in the specification being different from that mentioned in the patent, the specification is insufficient.

Campion v. Benyon.

So in the case of *Campion* v. *Benyon* (*z*), Lord Chief Justice *Dallas* said, with respect to the specification of an invention, that if there be any departure in terms from the

If in the specification there is

(*z*) 6 B. Mo. 82.

patent, the whole is void; it must be commensurate with the patent itself. And in the same case, Mr. Justice *Burrough* said, that it is clear that the specification must cover and support the patent.

any departure in terms from the patent, the whole is void.

2. The patentee must in his specification make a full and complete disclosure of the nature of his invention, and of the manner in which it is to be performed.

Patentee must make a full and complete disclosure.

In the case of *The King* v. *Arkwright* (*z*), Mr. Justice *Buller* said, that the public have a right to a fair, full, and true description of the invention in the specification.

R. v. Arkwright.

Public have a right to a full description.

So also in the case of *Turner* v. *Winter* (*a*), Mr. Justice *Ashurst* said, that it is incumbent on a patentee to give a specification of his invention in the clearest and most unequivocal terms of which the subject is capable. And his Lordship added, that "It is certainly of consequence that the terms of the specification should express the invention in the clearest and most explicit manner." And in the same case (*b*), Mr. Justice *Buller* said, "Many cases upon patents have arisen within our memory, most of which have been decided against the patentees, upon the ground of their not having made a full and fair discovery of their inventions. *Whenever it appears that the patentee has made a fair disclosure*, I have always had a strong bias in his favour, because in that case he is entitled to the protection which the law gives him."

Turner v. Winter.

Specification must be clear and explicit.

In the case of *Lewis* v. *Marling* (*c*), Mr. Justice *Bayley* said, that in order to support a patent, it is necessary that the specification should make a full disclosure to the public; but if he makes a full and fair disclosure, *as far as his knowledge at the time extends*, he has done all that is required.

Lewis v. Marling.

Must make a full disclosure.

So also in the case of *Morgan* v. *Seaward* (*d*), Mr. Baron *Alderson* laid it down, that the public have a right to expect and require that the specification shall be fair, honest, open, and sufficient, and contain a full description of the way in which the invention is to be carried into effect. And his Lordship told the jury that the question respecting the specification was, whether upon the whole evidence they were of

Morgan v. Seaward.

Must fairly and fully describe the invention.

(*z*) Dav. P. C. 61.
(*a*) Dav. P. C. 151.
(*b*) *Ibid.* 153.
(*c*) 10 B. & C. 22; 1 Webs. R. 496.
(*d*) 1 Webs. R. 174, 179.

opinion that the specification did fairly and fully give to the public that information which the public were entitled to receive.

Specifiation must be intelligible.

3. The specification must be intelligible, so that every person may be able to understand it, and learn from a perusal of it, what the art or invention is to which the patent is intended to apply. It must also describe the invention accurately so that no person shall be deceived or misled, and if the invention consists of several parts, it must contain a sufficient and correct description of every part.

Must describe every part accurately.

Hill v. Thompson.

In the case of *Hill* v. *Thompson* (*e*), Lord *Eldon*, L. C., laid it down that a specification must be intelligible, and clearly express what the patentee claims as his invention.

Must be clear and intelligible.

Turner v. Winter.

In the case of *Turner* v. *Winter* (*f*), it appeared that fusion was necessary to one part of the patent process. The specification directed heat to be continued until the effect was produced; but although it spoke of calcination, it did not mention fusion, and Mr. Justice *Buller* held that the omission rendered the specification insufficient.

When fusion necessary, not sufficient to direct heat to be continued until effect produced.

Campion v. Benyon.

In the case of *Campion* v. *Benyon* (*g*), Lord Chief Justice *Dallas* said, with respect to the specification, that it must contain a full and accurate explanation how the invention is to be carried into effect. And in the same case, Mr. Justice *Park* said, that in the specification of a patent, the nature of the invention must be accurately and particularly described, and *the statement of the claims* of the patentee must be set forth in the most minute detail.

Must contain full accurate explanations.

Claims to be stated minutely.

Morgan v. Seaward.

In the case of *Morgan* v. *Seaward* (*h*), Mr. Baron *Alderson* said, that if either of the patentees' inventions (there were two comprised in the patent) was insufficiently specified, the patent would fail; for if a person runs the hazard of putting two inventions into one patent, he cannot hold his patent unless each can be supported as a separate patent. And in order to support the patent, each invention must be described in the specification in such a manner as to enable people clearly to know what the invention is, and how it is to be carried into effect.

Every part must be accurately described.

(*e*) 3 Mer. 626; 1 Webs. R. 237, *S. C.*

(*f*) Dav. P. C. 154.

(*g*) 6 B. Mo. 82, 83.

(*h*) 1 Webs. R. 173.

So in the case of *Jones* v. *Ripley* (*i*), Lord *Denman*, C. J., held that if a specification be silent as to part of an invention stated in the title, or as to any part of the invention which is essential, the plaintiff will be nonsuited. Jones v. Ripley. Must not be silent as to any part of invention.

But in the case of *Nickels* v. *Haslam* (*k*), in which the invention was intituled "improvements in the manufacture of plated articles," and the specification described one improvement only, the Court of Common Pleas held that the specification was sufficient (*l*). Nickels v. Haslam.

4. In making the claim of invention, the specification must accurately point out what is claimed, and if the claim be wrong, the patent cannot be sustained, although the specification describes (without claiming) what the patentee really invented. If the claim in a specification is inaccurate the patent is bad.

Thus, in the case of *Sanders* v. *Aston* (*m*), it appeared that the patent was for "improvements in constructing or making buttons." The specification claimed the invention to be an improvement (upon a prior invention of the plaintiffs) by substituting flexible for metal shanks to buttons. The substitution of flexible for metal shanks, however, was not now, and therefore not sufficient to support the patent. The specification described the application of a toothed collet in the production of the flexible shanks in a particular way, which was now; but it did not any where appear in the specification that the patentee relied upon the collet as a material part of his invention, and there were other modes in which the object of the invention could be accomplished. The Court of King's Bench held that as the patentee had not claimed the use of the particular mode of substituting the flexible shank by means of the toothed collet, the patent was void. Sanders v. Aston. If the only thing which is new be not claimed as the invention, the patent is void.

So in the case of *The King* v. *Cutler* (*n*), it appeared that the defendant's patent, (of January, 1815,) was for an invention of "*improvements applicable to fire-places*, stoves, &c." (*o*). It appeared also, from the specification, that the invention consisted of a new mode of feeding the fire in a grate by a supply of fuel from below, instead of from above in the usual way. The R. v. Cutler. If the claim contained in the specification is incorrect, the mistake is fatal.

(*i*) 2 Rep. Arts. 150, N. S.; 5 L. Jour. C. S. 35; Webs. P. L. 137, (108*).
(*k*) 8 Jur. 474.
(*l*) See *Bainbridge* v. *Wigley*, Rep. Pat. 1829; Appendix, p. 197; 18 Rep. Arts. 127.
(*m*) 3 B. & Ad. 881.
(*n*) 1 Stark. R. 354.
(*o*) See Pritchard's list of patents, p. 103, No. 1405.

coals intended to be consumed in the course of the day were to be deposited in a chamber beneath the grate, so placed that the higher surface of the chamber was to be on a level with the lower surface of the grate. The fire being afterwards lighted in the grate, as the coals in the grate were gradually consumed, their place was to be supplied by winding up the coals from the chamber by means of a rack and pinion. The coals, as long as they remained in the box, were unignited, the air being excluded from below, and they did not become ignited until by being wound up into the grate, they had been brought into contact with the coals previously ignited, and exposed to the access of the air. The defendant, in his specification, summed up his claim thus: "My invention consists in this, that the fuel necessary for supplying the fire shall be introduced at the lower part of the grate in a perpendicular, or in an oblique direction. As to the manner of performing it, it is set forth in the annexed descriptions and drawings." Before the date of the patent, a grate had been made for cooking, which was furnished with a door; when this door was open, the grate in no respect differed from an ordinary one (*p*), but when the door was shut, no part of the grate was visible except a few of the highest bars; and the whole of the grate having been filled with coals, and the coals within the bars above the door having been lighted, the coals in the lower part of the grate were carried up for the purpose of supplying the consumption above by means of a rack and pinion, at the discretion of the cook. The principle of this grate, it was contended, was precisely the same with that for which the patent was claimed; the lower part of the grate when the door was shut being in effect a closed chamber to which the air had no access, and the coals being gradually wound up from this chamber so as to afford a supply to the fire above. The same principle had been applied to a common grate long before the date of the patent. It was contended for the defendant that his invention went beyond that exhibited in these grates; in the latter there was no fresh introduction of fuel into the grate, so as to give a perpetual supply, there was nothing more than a means of contracting or compressing coals already

(*p*) The grate must have been *deeper* than ordinary grates.

within the grate, which could not be done without gradually diminishing the size of the grate itself. According to the defendant's construction, on the contrary, the chamber was independent of the grate, placed below it, and the fuel was gradually wound up from the chamber, without at all contracting the size of the grate itself. Lord *Ellenborough*, C. J., was of opinion that "The principle on which the two grates were constructed, was *identical with that described in the terms of the specification*, which was for a mode of supplying fuel from below, and there was nothing predicated in the specification of raising the fuel from below the grate; it was merely for elevating a supply of fuel from below, and that the defendant had confined himself, by thus summing up the extent of his invention, to the benefit of this principle."

Specification must not be ambiguous.

5. The language of a specification must not be ambiguous; but must be as clear and precise as the nature of the subject will admit.

Turner v. Winter.

Thus in the case of *Turner* v. *Winter* (*q*), Mr. Justice *Ashurst* said, that it is incumbent on a patentee to give a specification of his invention in the clearest and most unequivocal terms of which the subject is capable. And that if there is any unnecessary ambiguity affectedly introduced into the specification, the patent is void. And in the case of *Campion* v. *Benyon* (*r*), Lord Chief Justice *Dallas* expressed himself nearly to the same effect.

Unnecessary ambiguity will avoid a patent.

Campion v. Benyon.

Galloway v. Bleaden.

So in the case of *Galloway* v. *Bleaden* (*s*), the Lord Chief Justice *Tindal* said, that if there is a want of clearness in a specification so that the public cannot afterwards avail themselves of, much more if there is any studied ambiguity in it, so as to conceal from the public that which the patentee for a term is enjoying the exclusive benefit of, the patent itself would be completely void.

Want of clearness, or studied ambiguity will render a patent void.

Specification must give the best of patentee's knowledge.

6. When an inventor applies for his patent, he describes the nature of his invention in general terms, and it is to be presumed, in the absence of any thing to show the contrary, that he has contracted to give the public the whole of his discovery, and all his knowledge on the subject, as the consideration for the privilege granted to him by the Crown. It is indeed ab-

(*q*) Dav. P. C. 151.
(*r*) 6 B. Mo. 81.
(*s*) 1 Webs. R. 524.

solutely essential for the protection of the public, that this rule should be adopted and acted upon, for patentees would otherwise be enabled to commit great frauds, by concealing the most important parts of their inventions.

The specification must therefore describe the invention according to the best of the patentee's knowledge.

R. v. Arkwright. Thus in the case of *The King* v. *Arkwright* (*t*), Mr. Justice *Buller* said, that a specification must put the public in possession of the invention in as ample and beneficial a way as the patentee himself uses it. So in the case of *Turner* v. *Winter* (*u*), the same learned Judge said, that if the patentee makes the article for which the patent is granted, with cheaper materials than those which he has enumerated in his specification, although the latter will answer the purpose equally well, the patent is void because he does not put the public in possession of his invention, or enable them to derive the same benefit which he does himself.

Turner v. Winter.

Bovill v. Moore.

Must enable the public to use the invention to the extent most beneficial within the knowledge of the patentee at the time.

And in the case of *Bovill* v. *Moore* (*x*), Lord Chief Justice *Gibbs* said, "There is another consideration respecting the specification which is also a material one, and that is, whether the patentee has given a full specification of his invention, not only one that will enable a workman to construct a machine answering to the patent, but one that will enable a workman to construct a machine answerable to the patent *to the extent most beneficial within the knowledge of the patentee at the time;* for a patentee who has invented a machine useful to the public, and can construct it in one way more extensive in its benefit than another, and states in his specification only that mode which would be least beneficial, reserving to himself the more beneficial mode of practising it, although he will have so far answered the patent as to describe in his specification a machine to which the patent extends; yet he will not have satisfied the law by communicating to the public the most beneficial mode he was then possessed of for exercising the privilege granted to him."

Morgan v. Seaward.

Must state the mode by which invention most

And in the case of *Morgan* v. *Seaward* (*y*), Mr. Baron *Alderson* said, that if a patentee is acquainted with any particular mode by which his invention may be most conve-

(*t*) Dav. P. C. 106.
(*u*) *Ibid.* 154.
(*x*) Dav. P. C. 400; 2 Marsh. 211.
(*y*) 1 Webs. R. 174.

niently carried into effect, he ought to state it in his specification. conveniently carried into effect.

7. And if the patentee omits or conceals any material part of the invention, or anything which he knows to be useful, tho specification will not be sufficient. If any thing omitted or concealed the patent void.

Thus, in the case of *Liardet* v. *Johnson* (*z*), which was an action for infringing a patent for steel trusses, the patentee omitted what was very material for tempering the steel, which was rubbing it with tallow. And because this was omitted the specification was held to be insufficient, and the patent was avoided. Liardet v. Johnson. Omission of any thing material is fatal.

So in the case of *Neilson* v. *Harford* (*a*), Mr. Baron *Parke* told the jury that if they thought the patentee knew that partitions were useful (in their blowing apparatus which he had invented), and omitted to state that in the specification, that would make the specification void. His Lordship also said, that if the partitions were necessary to make the apparatus operate beneficially, in that case the patent would be void, because it was not introduced as a necessary circumstance into the specification. And that if the patentee had known that the tubular form (of a part of the apparatus) would answer best, he ought to have introduced it, and the specification would have been bad upon the ground that he concealed the best mode of working out his own discovery. Neilson v. Harford. If patentee omits anything he knows to be useful the patent is void. Or if he omits anything which is necessary.

The case of *Wood* v. *Zimmer* (*b*), was an issue out of Chancery to try the validity of a patent granted to Jacob Zinck, in which the invention was described as a method of manufacturing verdigrease. The specification stated it to be produced from certain proportions of granulated copper and oil of vitriol, boiled a certain time in a copper of a particular construction (which was described), and afterwards strained off and mixed with a solution of potash or soda. It appeared, however, that Zinck was accustomed clandestinely and unobserved by his workmen to put aquafortis into the boiler, by means of which the copper was dissolved more rapidly, but the specification did not mention aquafortis in any way whatever. Wood v. Zimmer. If anything which the patentee knows to be useful is omitted the patent is void.

Lord Chief Justice *Gibbs* said, "A man who applies for a patent, and possesses a mode of carrying on that invention in

(*z*) Buller, N. P. 76; Dav. P. C. 155.
(*a*) 1 Webs. R. 321, 322.
(*b*) Holt, N. P. C. 58.

the most beneficial manner, must disclose the means of producing it in equal perfection, and with as little expense and labour as it costs the inventor himself. The price that he pays for his patent is, that he will enable the public, at the expiration of his privilege, to make it in the same way, and with the same advantages. If any thing which gives an advantageous operation to the thing invented be concealed, the specification is void. Now, though the specification should enable a person to make verdigrease substantially as good without aquafortis as with it; still, inasmuch as it would be made with more labour by the omission of aquafortis, it is a prejudicial concealment, and a breach of the terms which the patentee makes with the public." And the jury having found that aquafortis was used by the inventor as an ingredient in the verdigrease, his Lordship held that the patent was void.

Bovill v. Moore. Concealment of anything beneficial will render the patent void.

So also in the case of *Bovill* v. *Moore* (*c*), already cited, Lord Chief Justice *Gibbs* held, that if at the time when the patentee obtained his patent he was apprized of a more beneficial mode of working his invention, and did not by his specification communicate it to the public, that would be a fraudulent concealment from the public, and would render his patent void. And his Lordship told the jury, that if they thought that the patentee had studiously kept it back from the public, in order that he might have an advantage over others, that would be a suppression that would avoid his patent.

Lewis v. Marling. Must not suppress anything.

In the case of *Lewis* v. *Marling* (*d*), Mr. Justice *Bayley* said, that if a patentee suppresses any thing, or if he does not communicate all he knows, his specification is bad.

Morgan v. Seaward. Must give all his knowledge.

And in *Morgan* v. *Seaward* (*e*), Mr. Baron *Alderson* also held, that a patentee ought to give to the public all the knowledge he himself has respecting his invention.

8. And the rule that a patentee must give the public the benefit of all his knowledge respecting his invention, has been carried so far, that in the case of *Crossley* v. *Beverley* (*f*), it was laid down that he must give to the public all improvements which he may invent after obtaining his patent, and before the enrolment of his specification. In that case the

Must give the whole of patentee's knowledge up to the time of specification. Crossley v. Beverley.

(*c*) Dav. P. C. 401; 2 Marsh. 211, *S. C.*
(*d*) 10 B. & C. 22; 1 Webs. R. 496.
(*e*) 1 Webs. R. 182.
(*f*) 9 B. & C. 63.

invention was of "an improved gas apparatus," and it appeared that between the date of the patent and the specification, the patentee invented improvements in the apparatus which he described in the specification as part of his invention. The improvements clearly came within the meaning of the title contained in the patent, and all formed part of the same apparatus, the effect being in fact more completely to carry into effect the object which the patentee had in view when he made his invention. It was objected, that the patent was void by reason of the patentee having inserted improvements in his specification which formed no part of the invention for which he had obtained his patent. The Court of King's Bench, however, held, that the insertion of these improvements in the specification not only did not render the patent void, but that it was the duty of the patentee to communicate them to the public. Lord *Tenterden*, C. J., said, in giving judgment, "I do not see myself why time is allowed to prepare the specification, except upon the idea that the person, at the time he took out his patent, has not brought his machine, or whatever he has invented, to that degree of perfection which it may be supposed he is capable of bringing it to, and therefore he is allowed further time to do it." And Mr. Justice *Bayley* said, "I think it is most beneficial to the public to say, that it is the duty of the inventor, if, between the period of taking out the patent and enrolling the specification, he makes discoveries which will enable it better to effectuate the thing for which the patent was obtained, not only that he is at liberty to introduce them into his patent, but that it is his bounden duty so to do, and that it is not sufficient for him to communicate to the public the knowledge which he had at the time he obtained the patent, but he ought to communicate to the public the knowledge he has obtained before the specification."

So also in the case of *Jones* v. *Heaton* (*g*), Lord Chief Justice *Tindal* held, that a patentee is bound to give in his specification the most improved state of his invention up to the time of enrolling his specification.

Jones v. Heaton. Must give most improved state of invention at the time of specification.

9. Every thing necessary to the working of the invention must

Every thing

(*g*) 11 Lon. J. C. S.; Webs. P. L. 137 (129).

necessary must be described.

be described, for if that be not done, the specification will not particularly ascertain the manner in which it is to be performed, as required by the proviso in the patent. The patentee must therefore give the public every information which is necessary to enable them completely to perform every part of the patent process which is now, although it may be sufficient to refer in general terms to such things as are old or well known.

De Rosne v. Fairie.

If specification omits anything necessary to carry the invention into effect the patent is void.

In the case of *De Rosne* v. *Fairie* (*h*), it appeared that the plaintiff's patent was for an invention intituled "improvements in extracting sugar or syrups from cane juice, and other substances containing sugar, and in refining sugar and other syrups." The specification stated the invention to consist in a means of discolouring (depriving of colour) syrups of every description by means of charcoal produced by the distillation of bituminous schistus alone, or mixed with animal charcoal, and even of animal charcoal alone; the charcoal to be disposed of on beds very thick on a filter of any suitable form. After describing the process, the patentee in the specification said, "The carbonization of bituminous schistus has nothing particular, it is produced in close vessels, as is done for producing animal charcoal; only it is convenient, before the carbonization, to separate from the bituminous schistus the sulphurets of iron which are mixed with it." But the patentee did not describe any mode by which the sulphurets of iron could be separated from bituminous schistus. It did not appear clear upon the evidence whether bituminous schistus was or was not capable of being purified from the sulphurets of iron with which it is mixed, so that it should not be prejudicial to the sugar by colouring it in the course of the operation. The defendant objected to the sufficiency of the specification, because it did not show in what manner bituminous schistus could be purified from iron. Lord *Abinger*, C. B., directed the jury to find a verdict for the plaintiff or defendant according as they found the description of the bituminous schistus to be sufficient, or insufficient, so that all the world could or could not use it. The jury gave a verdict for the plaintiff, but the Court of Exchequer set it aside, and granted a new trial.

(*h*) 5 Tyr. 393.

Lord *Abinger* in giving judgment, said that his impression at the trial was strong that there was no evidence to go to the jury in support of the patent, and that it was incumbent on the plaintiff to show either that there was some bituminous schistus found in this country, which, after having been exposed to the process of distillation described in the specification, might be used with effect, and without detriment to the sugar, though one of its component parts, iron, was not entirely removed from it; or that there was some known process of removing that iron from it. It appeared by the evidence that in all the various forms in which the article (bituminous schistus) exists in this country, sulphuret of iron is found; and the witnesses not describing any known process by which it could be extracted, his Lordship was of opinion that the plaintiff ought to have proved one of two things, either that the sulphuret of iron in bituminous schistus is not so absolutely detrimental as to make its presence disadvantageous to the process, (in which case the patent would be good,) or that the process of extracting the iron from it is so simple and known, that a practical man would be able to accomplish it with ease. And his Lordship added, that as the plaintiff had not given any evidence to show that bituminous schistus, in the state in which it is found and known in England, could be used in the process with advantage, the defendant was entitled to a nonsuit.

The rest of the Court (Mr. Baron *Parke*, Mr. Baron *Bolland*, and Mr. Baron *Alderson*) entirely agreed with the Lord Chief Baron; and Mr. Baron *Alderson* added, that if it had been shown that bituminous schistus, deprived of iron, could be made by a process known to ordinary chemists of skill, or that it was a substance capable of being ordinarily purchased in the market as an article of commerce, it would have been unnecessary to have shown (in the specification) the operation of separating the iron from it.

So in the case of *Macnamara* v. *Hulse* (*i*), Lord *Abinger*, C. B., was of opinion that the specification was bad, because it did not mention the angles at which the patentee's paving blocks were to be cut according to his invention. Macnamara *v.* Hulse.

And in the case of *Neilson* v. *Harford* (*k*), Mr. Baron Neilson *v.* Harford.

(*i*) Car. & Marsh. 478.

(*k*) 1 Webs. R. 317, 321.

Bad if anything necessary omitted.

patentee had omitted to make mention, in his specification, of anything which was necessary for the beneficial use or enjoyment of the invention, the specification would be bad.

Known parts need not be minutely described.

10. When a patent is obtained for an improved machine or other article, it seems to be unnecessary minutely to describe all the known parts of the old machine. In case of *Harmar* v. *Playne* (*l*), Lord *Ellenborough*, C. J., said, "It may not be necessary in stating a specification of a patent for an improvement, to state precisely all the former known parts of the machine, and then to apply to those the improvement; but on many occasions it may be sufficient to refer generally to them. As in the instance of a common watch, it may be sufficient for the patentee to say, take a common watch, and add or alter such and such parts, describing them."

Harmar v. Playne. Unnecessary to describe well known things.

Must enable others to practise the invention.

11. The specification must be sufficient to enable persons not only to understand the nature of the invention, but also to put it into successful practice.

Newberry v. James. Must enable others to use the invention.

Thus in the case of *Newberry* v. *James* (*m*), Lord *Eldon*, L. C., said, that in order to support a patent, the specification should be so clear as to enable all the world to use the invention as soon as the term for which it has been granted is at an end. So it was laid down in *Liardet* v. *Johnson* (*n*); that the question respecting a specification is, whether it is sufficient to enable others to make the patent article, for the meaning of the specification is, that others may be taught to do the thing for which the patent is granted, so that after the term, the public shall have the benefit of the discovery.

Liardet v. Johnson. Must enable others to make the patent article.

R. v. Arkwright. Must be sufficient to teach others to use the invention.

In the case of *The King* v. *Arkwright* (*o*), Mr. Justice *Buller* said, that "It is clearly settled as law, that a man, to entitle himself to the benefit of a patent for a monopoly, must disclose his secret and specify his invention in such a way that others may be taught to do the thing for which the patent is granted; for the end and meaning of the specification is to teach the public, after the term for which the patent is granted, what the art is."

Morgan v. Seaward.

And in the case of *Morgan* v. *Seaward* (*p*), Mr. Baron

(*l*) Dav. P. C. 318.
(*m*) 2 Mer. 451.
(*n*) Bull. N. P. 76.
(*o*) Dav. P. C. 106.
(*p*) 1 Webs. R. 173.

Alderson said, that the invention must be described in the specification in such a manner as to lead people clearly to know what the invention is, and how it is to be carried into effect.

In the case of *Bovill* v. *Moore* (*q*), Lord Chief Justice *Gibbs* said, that a patentee ought in his specification to describe the mode of the manufacture, so as to enable any person to make use of it after his term has expired. Bovill v. Moore.

And in the case of *Galloway* v. *Bleaden* (*r*), Lord Chief Justice *Tindal* laid it down, that if there was a want of clearness in the specification, so that the public could not afterwards avail themselves of the invention, the patent would be completely void. Galloway v. Bleaden.

12. The specification must be understood as addressed to persons of ordinary skill and ordinary knowledge of that branch of the useful arts to which the invention relates. Specification addressed to persons of ordinary skill.

Thus in the case of *Morgan* v. *Seaward* (*s*), Mr. Baron *Alderson* said to the jury in summing up, "A specification is addressed to all the world; and therefore all those possessed of a competent skill ought to be able to construct the machine by following the specification. The specification should be such as to enable a workman of *ordinary* skill to make the machine." And the learned Judge afterwards added (*t*), that the question respecting the specification was, whether a man of ordinary knowledge and skill, bringing that ordinary knowledge and skill to bear upon the subject, would be able to make the patent machine from the instructions contained in the specification. Morgan v. Seaward. Must enable persons of ordinary knowledge to use the invention.

And in the case of *Neilson* v. *Harford* (*u*), Mr. Baron *Parke* said, in summing up to the jury, that if a person of ordinary and competent skill would be enabled by the specification to erect the patent machine, the specification would be good. And the learned Judge went on to say, that the jury were not to ask themselves the question, whether persons of great skill—a first-rate engineer or a second-class engineer—whether they could do it; because generally those persons are men of great science and philosophical knowledge, and they Neilson v. Harford. Specification not addressed to persons of great skill and knowledge.

(*q*) Dav. P. C. 361.
(*r*) 1 Webs. R. 524.
(*s*) 1 Webs. R. 176.
(*t*) *Ibid.* 178.
(*u*) *Ibid.* 314-322.

would, upon a mere hint in the specification, probably invent a machine which would answer the purpose extremely well; but that is not the description of persons to whom a specification may be supposed to be addressed; it is supposed to be addressed to a practical workman, who brings the ordinary degree of knowledge, and the ordinary degree of capacity, to the subject; and if such a person would construct an apparatus that would answer some beneficial purpose, according to the terms of the specification, then the specification is good, and the patent may be supported.

It is addressed to persons of ordinary knowledge and capacity.

Elliott v. Aston.

And in *Elliott* v. *Aston* (*x*), Mr. Justice *Coltman*, speaking of the specification, said, that the question was, whether the patentee had given such a description in his specification as would enable a workman of competent skill to carry the invention into effect.

Manton v. Manton.

And in the case of *Manton* v. *Manton* (*y*), Lord Chief Justice *Gibbs* said, that it was necessary that the patentee should show that he had accurately explained the nature of his invention in his specification, so as to enable a person of tolerable skill to make the thing by means of his specification.

Brooks v. Ripley.

In the case of *Brooks and another* v. *Ripley and another* (*z*), Lord *Lyndhurst*, C. B., said, that if the specification was not sufficiently clear to be understood by an ordinary workman, witnesses will not be allowed to be called to explain the intention of the patentees, and the plaintiffs will be nonsuited.

Not necessary to be so minute as to instruct ignorant persons.

13. But it is not necessary that a specification should describe an invention, and the manner in which it is to be performed, so fully as to instruct persons wholly ignorant of the subject.

Arkwright v. Nightingale. Specification not addressed to ignorant men.

Thus, in the case of *Arkwright* v. *Nightingale* (*a*), Lord *Loughborough* said, that a specification is addressed to persons having skill in the subject, not to men of ignorance; and if it is understood by those whose business leads them to be conversant in such subjects, it is sufficient.

R. v. Arkwright. Mechanical men of common understanding.

In the case of *The King* v. *Arkwright* (*b*), Mr. Justice *Buller* said, that if the specification be such that *mechanical men* of common understanding can comprehend it to make a machine by it, it is sufficient; but then it must be such, that

(*x*) 1 Webs. R. 224.
(*y*) Dav. P. C. 349.
(*z*) 2 Lon. J. C. S. 35; Webs. P. L. 134 (102).
(*a*) Dav. P. C. 56.
(*b*) *Ibid.* 106.

mechanics may be able to make the machine by following the directions of the specification.

In the case of *Hornblower* v. *Boulton* (c), Mr. Justice *Grose* said, that if the specification be such as to enable *artists* to adopt the invention, and make the manufacture, it is sufficient. Hornblower v. Boulton.

In the case of *Huddart* v. *Grimshaw* (*d*), Lord *Ellenborough*, C. J., said, that the specification must convey to the public a corresponding advantage with that of the patentee, whose sole right is protected for a time, so that any person who is skilled in the subject, upon looking at the specification, may be able to accomplish the end. Huddart v. Grimshaw. Persons skilled on the subject.

In the case of *Harmar* v. *Playne* (*e*), Lord *Ellenborough*, C. J., said, that the object of requiring a specification to be enrolled, seemed to be to enable persons of reasonable intelligence and skill in the subject-matter to tell, from the inspection of the specification itself, what the invention was for which the patent was granted, and how it was to be executed. And also, that when Lord *Mansfield* said (in the case of *Leardet* v. *Johnson* (*f*),) that the meaning of the specification was, that others might be taught to do the thing for which the patent was granted, it must be understood to enable persons of reasonably competent skill in such matters to make it; for no specification would probably enable a ploughman, utterly ignorant of the whole art, to make a watch. And his Lordship afterwards said, that a person must carry a reasonable knowledge of the subject-matter with him, in order clearly to comprehend specifications of inventions though intended to be fairly made. Harmar v. Playne. Must enable persons of reasonable intelligence and skill to know what the invention is, and how used. A person must carry with him a reasonable knowledge of the subject.

So also, in the case of *Rowntree* v. ——— (*g*), before Lord *Eldon*, which was an action for infringing a patent for a method of applying fire for heating boilers, &c., the patent was held to be void, because the jury was of opinion that the specification was not sufficiently clear to enable an ordinary tradesman to put the invention in practice. Rowntree v. ——— If the specification not sufficient to instruct an ordinary tradesman the patent void.

In the case of *Morgan* v. *Seaward* (*h*), Mr. Baron *Alderson* said, in his charge to the jury, that a specification ought to Morgan v. Seaward.

(c) Dav. P. C. 228.
(d) *Ibid.* 279.
(e) *Ibid.* 316.
(f) Bull. N. P. 76.
(g) Parl. Rep. 192.
(h) 1 Webs. R. 174.

Must be framed so as not to require more than the ordinary knowledge of a competent workman.

be framed so as not to call on a person to have recourse to more than those ordinary means of knowledge (not invention) which a workman of competent skill in his art and trade may be presumed to have. You may call upon a man to exercise all the actual existing knowledge common to the trade, but you cannot call upon him to exercise any thing more.

Bickford v. Skewes. Not addressed to persons entirely ignorant.

So in the case of *Bickford* v. *Skewes* (i), Lord *Denman*, C. J., said, in delivering the judgment of the Court of Queen's Bench, the specification is addressed, not to persons entirely ignorant of the subject-matter, but to artists of competent skill in that branch of manufactures to which it relates.

Specification must be sufficient without addition.

14. And a specification must be sufficient to enable persons of ordinary skill to use the invention *without any new inventions or additions of their own, or any assistance from others.*

R. v. Arkwright. Must be sufficient without requiring any addition or invention.

Thus, in the case of *The King* v. *Arkwright* (k), Mr. Justice *Buller* laid it down as law, that the specification ought to be such that mechanics might be able to make the (patent) machine, by following the directions of the specification without any new inventions or additions of their own; and this was strongly approved of by Mr. Baron *Alderson*, in the case of *Morgan* v. *Seaward* (l), in which his Lordship said, that the public ought to be told the manner in which the thing may be done in respect of which the patent is granted, not by themselves becoming inventors of a method of carrying it into effect, but by following the specification, without making any new invention, or any addition to the specification.

Specification ought to be sufficient according to the knowledge of workmen at the time it is given.

Mr. Baron *Alderson* also held, in *Morgan* v. *Seaward*, that the specification ought to be sufficient to enable workmen of ordinary and competent skill and knowledge to use the patent invention without any other instructions. And that, in judging of the sufficiency of the specification, the criterion is, whether *at the time when the specification is given to the world* a person would be able by means of it and his ordinary knowledge and skill, to use the invention without deriving information from any other source.

Neilson v. Harford.

And in the case of *Neilson* v. *Harford* (m), the Court of Exchequer held, that to be valid, a specification should be

(i) 1 Webs. R. 218.
(k) Dav. P. C. 106.
(l) 1 Webs. R. 173, 174.
(m) 1 Webs. R. 371; 8 M. & W. 806.

such as if fairly followed out by a competent workman without invention or addition, would produce the article for which the patent is taken out.

Specification must not describe the invention so as to render experiments necessary.

15. The specification must not cast upon the public the trouble of making experiments to enable them to use the invention; nor will it be sufficient if it merely suggest something as likely to be useful. The representation of the patentee to the Crown that he had made an invention must be taken to mean, that he had made a complete invention; and it therefore was his duty to give the public such complete information as would render it unnecessary for them to make experiments to enable them to carry the invention into effect.

Turner v. Winter.

Must enable persons to use the invention without trying experiments.

Thus, in the case of *Turner* v. *Winter* (*n*), Mr. Justice *Ashurst* said, that the terms of the specification should express the invention in the clearest and most explicit manner; so that a man of science may be able to produce the thing intended without the necessity of trying experiments.

Morgan v. Seaward.

Must give sufficient information to render experiments unnecessary.

In the case of *Morgan* v. *Seaward*, Mr. Baron *Alderson* held, that if a specification does not give such information as will render it unnecessary for parties to make experiments, it is insufficient (*o*). And his Lordship also said, that a specification must not merely suggest something that will set the mind of an ingenious man at work, but it must actually and plainly set forth what the invention is, and how it is to be carried into effect so as to save a party the trouble of making experiments and trials (*p*).

Neilson v. Harford.

So in the case of *Neilson* v. *Harford* (*q*), Mr. Baron *Parke* told the jury, that if experiments were necessary in order to enable a person to construct the patent machine, the specification was defective. But if experiments are only necessary in order to produce the greatest beneficial effect, the specification would not for that reason be insufficient (*r*).

Crompton v. Ibbotson.

If specification states anything which will lead

In the case of *Crompton* v. *Ibbotson* (*s*), Lord *Tenterden*, C. J., said, "The patent was obtained for the discovery of a proper conducting medium. The plaintiff found, after repeated trials, that nothing would serve the purpose except

(*n*) Dav. P. C. 152.
(*o*) 1 Webs. R. 180.
(*p*) *Ibid.* 175.
(*q*) *Ibid.* 320, 326.
(*r*) See also *Macnamara* v. *Hulse*, Car. & Marsh. 477.
(*s*) Dan. & Lloyd, 33.

others to make useless experiments it will be bad.

the cloth described in his specification; yet he says the cloth may be made of any suitable material, and merely that he prefers the particular kind there mentioned. *Other persons, misled by the terms of this specification, may be induced to make experiments which the patentee knows must fail;* and the public, therefore, has not the full and entire benefit of the invention,—the only ground on which the patent is obtained."

False representation in specification avoids a patent.

16. It has already been shown in a former part of this work (*t*), that a false representation or suggestion to the Crown of anything material respecting the invention will render the patent void by reason of the fraud practised upon the Crown. And as against the patentee it must be presumed that when he applied for the patent, he made the same statements to the Crown as those contained in the specification.

Anything which is false or misleads renders a patent void.

And if a specification be false or untrue in any material particular, or if it be framed so as to mislead or puzzle, the patent will be void. The patent being a bargain between the public and the patentee, the specification is the price which he pays for the privilege granted to him in his invention. And if he inserts anything in his specification which is untrue, or calculated to mislead or puzzle, he commits a breach of good faith, and the specification being a fraud upon the public the patent is void.

R. v. Arkwright.

If false or defective the patent is void.

Thus in the case of *The King* v. *Arkwright*, Mr. Justice *Buller* said, in his charge to the jury, that if the specification in any part of it was materially false or defective, the patent could not be supported (*u*). His Lordship also held, that if certain things mentioned in the specification were of no use, and merely thrown in to puzzle, the patent was void (*x*).

Turner v. Winter.

Anything which tends to mislead avoids the patent.

In the case of *Turner* v. *Winter* (*y*), Mr. Justice *Ashurst* said, that if there was anything in the specification which tended to mislead the public, or if the process as directed by the specification did not produce that which the patent professes to do, the patent was void. And in the same case Mr. Justice *Buller* said (*z*), that if the patentee could only make the patent article with two or three of the ingredients mentioned in the specification, and if he had inserted others which

(*t*) *Ante*, Chap. IV. p. 42.
(*u*) Dav. P. C. 106.
(*x*) *Ibid.* 118.
(*y*) *Ibid.* 151, 152.
(*z*) *Ibid.* 154.

would not answer the purpose, that would avoid the patent (*a*). The same law was laid down by the Court of Queen's Bench in the case of *Bickford* v. *Skewes* (*b*).

Bickford v. Skewes.

In the case of *Lewis* v. *Marling*, Lord *Tenterden*, C. J., said (*c*), that if a patentee mentions that as an essential ingredient in the patent article which is not so, nor even useful, and whereby he misleads the public, his patent might be void; and indeed there can be little doubt that it would be so. And in the same case, Mr. Justice *Bayley* said (*d*), that if a patentee by his specification misleads the public, his specification is void. So if he says that there are many modes of doing a thing, when in fact one only will do, this will avoid the patent.

Lewis v. Marling.

If specification misleads the public the patent is void.

In the case of *Neilson* v. *Harford* (*e*), Mr. Baron *Parke* held at Nisi Prius that a material statement in the specification being incorrect or untrue would avoid the patent. And in the same case (*f*), the Court of Exchequer held that a specification would be bad which contains a false statement in a material circumstance, of a nature that if literally acted upon by a competent workman would mislead him, and cause the experiment to fail.

Neilson v. Harford.

If a material statement incorrect the patent is void.

In the case of *Savory* v. *Price* (*g*), it appeared that the patent was for an invention of a neutral salt, which is called seidletz powder. The new salt or medicine was composed of three ingredients: 1st, Rochelle salts; 2nd, Carbonate of soda; and 3rd, Tartaric acid. These ingredients were well known substances before the date of the patent, but the patentee, instead of describing them by any of their known names, inserted in his specification three recipes numbered 1, 2, and 3, the produce of which respectively were the three substances already mentioned. The specification then described the modes and proportions in which the three ingredients produced by the three recipes were to be mixed together in order to produce the "seidletz powder;" and it was proved that the mixture answered the purpose stated by the patentee. Lord Chief Justice *Abbott*, however, held that the

Savory v. Price.

If unnecessary descriptions are introduced in order to mislead, the patent is void.

(*a*) See also *Crompton* v. *Ibbotson*, Dan. & Lloyd, 33, cited *ante*, p. 177.
(*b*) 1 Webs. R. 218; 1 Q. B. 938.
(*c*) *Ibid.* 495.
(*d*) *Ibid.* 496.
(*e*) 1 Webs. R. 295.
(*f*) 8 M. & W. 806.
(*g*) Ry. & Mo. N. P. C. 1.

Patentee ought to point out the plainest and most easy way of using the invention.

patent was void, and said, "It is the duty of any one to whom a patent is granted to point out in his specification the plainest and most easy way of producing that for which he claims a monopoly; and to make the public acquainted with the mode which he himself adopts. If a person on reading the specification would be led to suppose a laborious process necessary to the production of any one of the ingredients, when, in fact, he might go to a chemist's shop and buy the same thing as a separate simple part of the compound, the public are misled. If the results of the recipes, or of any one of them, may be bought in shops, this specification, tending to make people believe an elaborate process essential to the invention, cannot be supported" (*h*).

If he leads people to suppose a laborious process is necessary when in fact it is very simple, the specification is bad.

Need not particularize every thing which will produce the effect.

17. Although the condition which requires the specification makes it necessary that it should describe the invention with particularity, it seems that it is not necessary that the specification should particularize every thing which will produce the effect intended by the patentee.

Bickford v. Skewes.

Thus, in the case of *Bickford* v. *Skewes* (*i*), the Court of Queen's Bench held, that it was immaterial if other materials not specified, but within the description given in the specification, would answer the purpose, and that it was certainly not necessary to specify all articles that would answer the purpose.

De Rosne v. Fairrie.

But in the case of *De Rosne* v. *Fairrie* (*k*), Mr. Baron *Alderson* said, that a specification must state one or more methods which can be followed for the purpose of accomplishing and carrying into effect the invention.

Form need not be described unless essential.

18. The particular form of a machine or patent article need not be described, if the shape does not form an essential part of the invention.

Neilson v. Harford.

Thus in the case of *Neilson* v. *Harford* (*l*), the patentee stated, that the shape of the vessel in which the air was to be heated was immaterial, and the Court of Exchequer held that the specification was sufficient.

Things necessarily implied need not be described.

19. It seems that things necessarily implied need not be particularized in the specification.

(*h*) See also *Crompton* v. *Ibbotson*, Dan. & Lloyd, 33, cited *ante*, p. 177.
(*i*) 1 Webs. R. 218; 1 Q. B. 938.
(*k*) 5 Tyr. 407.
(*l*) 1 Webs. R. 295-328.

Thus, in the case of *Boulton* v. *Bull* (*m*), Lord Chief Justice *Eyre* said, "Suppose a new invented chemical process, and the specification should direct that some particular chemical substance should be poured upon gold in a state of fusion, it would be necessary, in order to this operation, that the gold should be put into a crucible, and should be melted in that crucible; but it would be hardly necessary to state in the specification the manner in which, or the utensils with which, the operation of putting gold into a state of fusion was to be performed. They are mere incidents with which every man acquainted with the subject is familiar." Boulton v. Bull.

In the case of *Crossley* v. *Beverley* (*n*), the patent was for an invention of "an improved gas apparatus." It appeared from the evidence that the specification did not give any directions respecting a condenser, which was well known to be an essential part of every gas apparatus. It was objected for the defendant, that the things comprised in the specification would not make a gas apparatus, because it would be incomplete for want of a condenser. Lord *Tenterden*, C. J., said, that a workman who was capable of making a gas apparatus would know that he must put that in. And his Lordship held, that although the specification did not direct a condenser to be put in, yet, as it did not say that it was to be left out, the specification was sufficient. Crossley v. Beverley.

20. Although a specification must describe an invention with sufficient precision to make it a compliance with the condition in the patent, yet it seems that absolute or perfect precision is not practicable, and cannot therefore be required. Absolute precision impracticable.

Thus, in *Boulton* v. *Bull* (*o*), Lord Chief Justice *Eyre*, after observing as to the specification in that case that more precision was not necessary, said that absolute precision was not practicable. Boulton v. Bull.

In the case of *Arkwright* v. *Nightingale* (*p*), Lord *Loughborough* said, that "the clearness of the specification must be *according to the subject-matter of it*," and if it is understood by those whose business leads them to be conversant in such subjects, it is sufficient. Arkwright v. Nightingale. Clearness must be according to the subject.

(*m*) Dav. P. C. 215.
(*n*) 3 C. & P. 515.
(*o*) Dav. P. C. 216.
(*p*) Dav. P. C. 56.

There must be no misdescription.

21. There must be no misdescription of the invention, or of any part of it. And if any part of the invention is misdescribed in any material particular, the specification will be bad.

R. v. Metcalfe.

If the invention is incorrectly described the patent is void.

In the case of *The King* v. *Metcalfe* (*q*), the patent was obtained for the manufacture of hair brushes, which were described to be tapering brushes (*r*). It appeared from the specification that the mode of manufacturing the patent brushes differed from the common mode, chiefly in this respect: that the specification directed, that the hairs or bristles were to be taken of the length of an inch and a quarter, and before their insertion in the holes in the stock of the brush were to be mixed up together; so that when they were collected and drawn through the holes, and secured by a brass wire, the bristles would be of unequal lengths; whereas, according to the usual mode, the bristles were to be inserted in the stock, so as to be as nearly of the same length as possible, and were afterwards cut down, so as to be of the same length. Lord *Ellenborough*, C. J. held, that the invention was 'not properly described, and said, "Tapering means gradually converging to a point. According to the specification, the bristles would be of unequal length, but there would be no tapering to a point, which the description assumes." It was contended for the defendant, that the description was sufficient, as each tuft of hairs converged to a point, and the brushes were known in the trade by the description of tapering brushes. Lord *Ellenborough* said, "If the word tapering be used in its general sense, the description is defective; there is no converging to a point. If the term has had a different meaning annexed to it by the usage of trade, it may be received in its perverted sense. At present, however, I cannot hold out any prospect that the difficulty arising from the grammatical construction can be removed." The defendant having failed to give any evidence to remove the difficulty, Lord *Ellenborough* advised the jury to find that the brush was not a tapering, but only an unequal brush, and there was a verdict for the Crown accordingly. The defendant

(*q*) 2 Stark. R. 249.

(*r*) The patent described the invention to be of "a tapered hair or head brush."—Pritchard's List of Patents, No. 1592, p. 115.

afterwards moved the Court of King's Bench for a new trial on this point, but the Court refused even to grant a rule *nisi*.

In the case of *Felton* v. *Greaves* (*s*), it appeared that the patent had been obtained for an invention of a machine for sharpening knives, razors, scissors, and other cutting instruments. The machine described in the specification was proved to be useful for sharpening knives, but would not do for sharpening scissors, and for this reason Lord *Tenterden*, C. J., held that the patent was void. Felton v. Greaves. If invention is not applicable in the way represented the patent is void.

So also in the case of *Bainbridge* v. *Wigley* (*t*), in which it appeared that the patent was for improvements on the flageolet or English flute. In the specification it was stated that by the improvements the instrument produced *notes* not before produced on the old instrument. It also appeared in evidence that the invention was a great improvement, but only *one* new note was produced. Lord *Ellenborough*, C. J., held that this was fatal to the patent, the consideration on which it was granted not being truly stated. For the patentee had stated that by his improvement he had given new *notes*, when in fact he had given but one new note (*u*). Bainbridge v. Wigley. If invention is described as improvements, and the specification describes only one improvement, the patent is void.

It is to be observed, that in each of the cases of *R.* v. *Metcalfe* (*x*), *Felton* v. *Greaves* (*y*), and *Bainbridge* v. *Wigley* (*z*), just cited, the patentee had made a false representation to the Crown respecting his invention, and that false representation avoided the patent (*a*). False representations in the cases just cited.

22. If an invention be properly and sufficiently described in a specification, it seems that if any unnecessary matter which may have been inserted will not vitiate the specification, if the public is not misled in any way, but will be rejected as surplusage. Surplusage immaterial.

Thus, in the case of *Boulton* v. *Bull* (*b*), Lord Chief Justice *Eyre* said, that if there was a specification which went to the subject of the invention as described in the patent, he thought that the rest might very well be rejected as superfluous. Boulton v. Bull.

23. But if the specification describes more than the Must clearly point out what

(*s*) 3 C. & P. 611.
(*t*) Parl. Rep. 1829, p. 197.
(*u*) Sid vide *Nickels* v. *Haslam*, 8 Jur. 474, cited *ante*, p. 163.
(*x*) 2 Stark. R. 249.
(*y*) 3 C. & P. 611.
(*z*) Parl. Rep. 1829, p. 197.
(*a*) Vide *ante*, Chap. IV. p. 48, and in this Chap. p. 178.
(*b*) Dav. P. C. 216.

is new, and distinguish the invention from what is old.

invention itself, it must clearly point out which of the things described are old and which of them are new. And if the subject of the patent privilege be an addition to, or an improvement upon, an old machine or other article, the specification must not describe the whole machine or article without distinguishing between the old and the new parts. For the proviso in the patent (*c*) requires that the invention shall not only be ascertained, but ascertained with particularity, and it is impossible to contend that an invention is so ascertained by a specification, if it describes without distinction many things which are old, as well as the invention itself.

Invention must be particularly ascertained.

Williams v. Brodie.

Old and new parts described without distinction patent void.

Thus, in the case of *Williams* v. *Brodie* (*d*), the invention was an improvement upon an old stove, but in the specification the whole stove was described, including both the old and the new parts, without describing the invention as a new improvement upon an old thing, and it was held that the patent was therefore void.

Manton v. Manton.

Specification must separate new from old.

In the case of *Manton* v. *Manton* (*e*), Lord Chief Justice *Gibbs* said, that in order to support a patent, the party who takes it out must show that he has accurately explained the nature of his invention in his specification, *separating that which is new from that which is old.*

Hill v. Thompson, in Chancery patent for a combination must not claim the old materials.

In the case of *Hill* v. *Thompson* (*f*), Lord *Eldon*, L. C., said, that there may be a valid patent for a new combination of materials previously in use for the same purpose, or for a new method of applying such materials. But in order to its being effectual, the specification must clearly express that it is in respect of such new combination or application, and of that only, and not lay claim to the merit of original invention in the use of the materials.

Hill v. Thompson, C. P. Specification must distinguish between an entirely new discovery and an improvement.

And in *Hill* v. *Thompson* (*g*), in the Court of Common Pleas, the Lord Chief Justice *Dallas* said, "This, like every other patent, must undoubtedly stand on the ground of improvement or discovery. If of improvement, it must stand on the ground of improvement invented; if of discovery, it must stand on the ground of the discovery of something altogether new; *and the patent must distinguish and adapt itself accord-*

(*c*) Vide *ante*, p. 151, 155.
(*d*) Dav. P. C. 96, 97.
(*e*) *Ibid.* 319.
(*f*) 3 Mer. 622.
(*g*) 8 Taunt. 375; 2 B. Mo. 413.

ngly. If the patent be taken out for discovery, when the alleged discovery is merely an addition or improvement, it is scarcely necessary to observe that it will be altogether void."

So in the case of *Minter* v. *Wells* (*h*), the invention claimed was the application of self-adjusting leverage to the back and seat of a chair, and Mr. Baron *Alderson* held, that if any self-adjusting leverage had been, before the plaintiff's patent, applied to a chair, the patent would be void, because the specification, by describing self-adjusting leverage, generally claimed too much.

Minter v. Wells.

Claim too general if any thing coming within the description was known before.

In the case of *Carpenter* v. *Smith* (*i*), Lord *Abinger*, C. B., laid it down that a patentee should state in his specification what he claims to be new, and what he admits to be old; for if the specification states simply the whole machinery which he uses, and which he wishes to introduce into use, and does not state that he claims either a particular part, or the combination of the whole as new, then his patent must be taken to be a patent for the whole, and for each particular part, and his patent will be void if any particular part turns out to be old, or the combination itself is not new.

Carpenter v. Smith.

Patentee must state what he claims to be new and what he admits to be old.

In the case of *Macfarlane* v. *Price* (*k*), it appeared that the patent was for an invention of improvements in the making of umbrellas and parasols. The specification professed to set out the improvements as specified in certain descriptions and drawings annexed. The subjoined description contained a minute detail of the construction of umbrellas and parasols, partly including the usual mode of stretching the silk of the umbrella by means of metallic stretchers or rods attached to a tube moveable along the stem, and also certain improvements, which consisted chiefly in the insertion of the stretchers, which were knobbed at the end, in sockets formed in the whalebone, instead of attaching them to the whalebone in the usual way, by means of forked ligaments, which came in contact with the silk, the advantage of which was, that by the specified mode, the bone being interposed between the stretcher and the silk, the stretcher did not wear the silk in spreading the umbrella, as it was apt to do in umbrellas of the old construction, where the stretcher came in contact with

Macfarlane v. Price.

(*h*) 1 Webs. R. 130.
(*i*) *Ibid.* 532.
(*k*) 1 Stark. R. 199.

the silk. Some other advantages, of minor importance, were also stated, and drawings were given of the umbrellas and parasols in their improved state. Throughout the whole specification, no distinction was made between what was new and what was old. Upon an objection taken by the defendant that the specification was insufficient, it was contended for the plaintiff that the specification was sufficient, since one of the annexed drawings contained a representation of the particular invention, which had been pirated, and was confined to the exhibition of the insertion of the knobbed stretchers in the whalebone sockets, from which an artist would be able to construct an umbrella on the improved plan. But Lord *Ellenborough*, C. J., said, "The patentee in his specification ought to inform the person who consults it what is new and what is old. He should say, My improvement consists in this, describing it by words if he can, or if not, by reference to figures. But here the improvement is neither described in words nor by figures, and it would not be in the wit of man, unless he were previously acquainted with the construction of the instrument, to say what was new, and what was old. The specification states that the improved instrument is made *in manner following*: this is not true, since the description comprises that which is old as well as that which is new. Then it is said, that the patentee may put in aid the figures, but how can it be collected from the whole of these in what the improvement consists. A person ought to be warned by the specification against the use of the particular invention; but it would exceed the wit of man to discover from what he is warned in a case like this." And his Lordship held, that the patent was void, and nonsuited the plaintiff.

Specification ought to inform the public what is new and what is old.

R. v. Nickels. In the case of *The Queen* v. *Nichels* (*l*), the patent had been obtained for an invention entituled, "improvements in machinery for recovering fibres applicable in the manufacture of braid and other fabrics;" the defendant's specification commenced in the usual form, *viz.* by declaring that the nature of the invention, and the manner in which it was to be performed, were "described and ascertained in and by the following statement thereof, reference being had to the drawing

(*l*) MS.

annexed, and to the figures and letters marked thereon (that is to say), the invention relates "to certain improvements in, or additions to, the apparatus or parts constituting what is called braiding or plaiting machines, whereby I am enabled, &c." The defendant then proceeded to describe different kinds of braided fabrics which the machinery would produce, after which he proceeded as follows: "The construction of braiding or plaiting machinery, wherein all the threads partake of like movements, and all aid in forming the fabric of plaited threads, being well known in the manufacture of braids, it will not be necessary to enter into a long description of the same. *All that will be required to make the invention clear, and enable a workman acquainted with such machinery, readily to perform my invention.*" It would be expected from this, that the specification was about to declare what it is, which would be sufficient to enable a workman to perform the invention; but the sentence is not completed, the patentee merely proceeding to say "which is (*m*) only applicable to such machines as work with four or more heads or circular tables for actuating a system or series of bobbins, &c." The specification then proceeded to describe the uses of the machinery for making the various fabrics which it was intended to produce, after which it described the drawing annexed. The specification did, in fact, describe the whole of the machinery, including both the old parts, and those claimed by the patentee to be new; but it did not in any part of it point out which of the parts were new, and which of them were old. At the end of the specification the defendant stated, that he made no claim to any of the parts of the apparatus constituting the machine separately, nor combined so far as the same had been before known; but there was nothing in the specification which could enable any person to ascertain to which of the parts of the machinery the disclaimer was intended to apply. It was objected by the counsel for the prosecutor, that the specification was insufficient, because it clearly appeared upon the face of it that some parts of the machinery de-

(*m*) These words, "which is," &c. follow immediately after the portion of the specification ending with the words "perform my invention," as given above.

scribed were old, and there was no part of that document which either pointed out what was the new invention claimed by the patentee, or the old parts which he disclaimed. It was contended for the defendant, that he was at liberty to give evidence to show what was new and what was old; but the cases of *The King* v. *Wheeler* (*n*), and *Neilson* v. *Harford* (*o*), were cited to show that the construction of the specification was for the Court, and not the jury, and that such evidence was not admissible. Lord *Denman*, C. J., adopted the language of Lord *Ellenborough*, in the case of *Macfarlane* v. *Price* (*p*), and said, that the alleged improvements were not sufficiently ascertained or described, either by words or by figures, and that it would not be in the wit of man to discover from the specification what was new, or what was old, or what he was warned from doing. His Lordship also held, that parol evidence was not admissible to explain the specification, and show what was new, and he directed the jury to give a verdict for the Crown, which was done accordingly.

Must not claim more than patentee is entitled to.

24. The patentee must not in the specification claim more than is granted by the patent, or more than he is fairly entitled to; and if he attempts to appropriate more to himself than he is actually entitled to, the grant of privilege contained in the patent will be wholly void.

Hill v. Thompson.

If specification claims too much the patent is void.

Thus in the case of *Hill* v. *Thompson* (*q*), Lord *Eldon*, L. C., said, that the specification must not attempt to cover more than that which is the only proper subject for the protection of a patent. And his Lordship said, that he was compelled to add, that if a patentee seeks by his specification any more than he is strictly entitled to, his patent is thereby rendered ineffectual, even to the extent to which he would be otherwise fairly entitled.

R. v. Elsee. If the claim in the specification is so general in terms as to include anything before known, the patent is void.

In the case of *The King* v. *Elsee* (*r*), the patent was for a new invented manufacture of lace called French or ground lace. The specification went generally to the invention of mixing silk and cotton thread upon the frame. On the part of the prosecutor it was clearly shown that, prior to the pa

(*n*) 2 B. & Ald. 345.
(*o*) 8 M. & W. 806.
(*p*) 1 Stark. R. 199, cited *ante*, p. 185.
(*q*) 3 Mer. 622.
(*r*) Dav. P. C. 144.

tent, silk and cotton thread had been used together, and intermixed upon the same frame, and the defendant's counsel acknowledged the fact; but said he could prove clearly that the former method of using the silk and cotton thread was quite inadequate to the purpose of making lace, on account of its coarseness, and that the defendant alone had invented the method of intermingling them, so as to unite strength with firmness. Mr. Justice *Buller* said, "It will be to no purpose. The patent claims the exclusive liberty of making lace composed of silk and cotton thread mixed, not of any particular mode of mixing it, and therefore, as it has been clearly proved and admitted that silk and cotton thread were before mixed on the same frame for lace in some mode or other, the patent is clearly void, and the jury must find for the Crown." And a verdict was given for the Crown accordingly.

So in the case of *Minter* v. *Mower* (*s*), the Court of Queen's Bench held the patent to be void, because the specification claimed more than the patentee had invented, and would have included something which was known before the date of the patent. Minter v. Mower.

In *Jessop's* case (*t*), the patent was held to be void, because it extended to the whole watch, and the invention was of a particular movement only. And in *Boulton* v. *Bull* (*u*), Mr. Justice *Buller* said, that when a patent is taken for an improvement only, the public have a right to purchase that improvement by itself, without being incumbered with other things. So in the case of *Losh* v. *Hague* (*x*), Lord *Abinger*, C. B., said, a man can always take out a patent for a new improvement, but when he makes his specification, he must take care that he does not put among his improvements that which another man had before made, or had got a patent for. Jessop's case. Boulton v. Bull. Losh v. Ague.

In the case of *Huddart* v. *Grimshaw* (*y*), Lord *Ellenborough*, C. J., said, that if a patentee in his specification oversteps his right, and appropriates more than is his own, he cannot avail himself of it. And if he states that which of itself is not new, but old and known to the world, though it was unnecessary for him to do so, yet having done so, he has overstepped Huddart v. Grimshaw. If patentee oversteps his right the patent is void.

(*s*) 6 A. & E. 735.
(*t*) Dav. P. C. 203.
(*u*) *Ibid.*
(*x*) 1 Webs. R. 206.
(*y*) Dav. P. C. 279.

his right, and has included in his patent that which is not his invention, and his patent would be void.

Campion v. Benyon.

In the case of *Campion* v. *Benyon* (*z*), the Court of Common Pleas held the plaintiff's patent to be void, because it had been taken out for more than he had invented or discovered.

Bovill v. Moore.

If patentee exceeds the limits of his invention the patent is void.

In the case of *Bovill* v. *Moore*, Lord Chief Justice *Gibbs* laid it down (*a*), that if the patentee in his specification had exceeded the limits of what he had invented, and of which he was entitled to the sole privilege, though in other respects there might be no objection to his patent, that would overturn it, for he would not then have registered (enrolled) a specification of his invention, it would be irregular in having exceeded the limits of the invention. And his Lordship afterwards said, that if the patentee had, in his specification, asserted to himself a larger extent of invention than belonged to him; if he stated to himself to have invented that which was well known before, then the specification would be bad, because it would affect to give him, through the means of the patent, a larger privilege than could legally be granted to him. In this case the invention was stated to be of a machine or machines for manufacturing lace, and the specification described the whole machine, without pointing out any particular part or parts of it, as the invention of the patentee. And the Lord Chief Justice held (*c*), that if a combination of a certain number of the parts of the machine up to a given point had existed before the date of the patent, and if the patentee's invention sprung from that point, and added other combinations to it, then the specifications stating the whole machine as his invention was bad. And his Lordship left it to the jury to say whether they thought the patentee had in his specification described an invention to a greater extent than the proof went to establish. And his Lordship said, in answer to an observation by a juryman, that even if the patentee had claimed too much inadvertently, and not fraudulently, yet he must answer for his inadvertence. The jury found a verdict for the defendant, and upon a motion for a new trial, the Court of

If invention be an addition or improvement, and the specification describes the whole machine, the patent is void.

If patentee claims too much inadvertently the patent is void.

(*z*) 6 B. Mo. 71; and see the words of *Richardson*, J., *Ibid.* p. 86.
(*a*) Dav. P. C. 398.
(*b*) *Ibid.* 404.
(*c*) *Ibid.* 413.

Common Pleas approved of the direction given to the jury by the Lord Chief Justice, and refused to grant even a rule *nisi* (*d*).

No objection that improvements made between the patent and specification are described.

It is no objection to a specification, however, that the patentee has described in it improvements which he has made between the date of the patent and the date of the specification. And indeed it seems rather to be the patentee's duty to give the public the full benefit of all his knowledge respecting the invention at the time when he specifies it (*e*).

Specification made sufficient by reference to a former specification.

There is one case, *Harmar* v. *Playne* (*f*), in which it was held, that a specification was sufficient, although it could not be ascertained what the patentee's improvements were, except by comparing the specification with a prior specification which had been enrolled by the same patentee, and to which he referred. The circumstances of that case were peculiar, and the decision does not break in upon the principle of any of the cases which have been cited.

Harmar v. Playne.

First patent, 20 March, 1787.

In *Harmar* v. *Playne* (*f*), a case was stated by the Lord Chancellor for the opinion of the Court of King's Bench, from which it appeared that "by letters patent dated 20th March, 1787, the King granted to John Harmar, the plaintiff, for fourteen years, the sole privilege of making, using, and vending a certain machine by him invented for raising a shag on all sorts of woollen cloths, and cropping or shearing them, which, together, come under the description of dressing woollen cloths; and also for cropping and shearing of fustians, with the usual proviso or condition for avoiding the patent on failure of enrolling a specification. In pursuance of this proviso, Harmar duly enrolled a specification of the said invention, with drawings of the machine in the margin thereof. On the 29th March, 1794, his Majesty granted another patent to Harmar, whereby, after reciting that Harmar had obtained letters patent of the 20th March, 1787, authorizing him to make, use, and vend his invention of a machine for raising a shag on all sorts of woollen cloths, &c., for fourteen years; and further, that he had invented considerable improvements in the said machine, for which improvements in the said

Second patent 29 March, 1794, reciting first patent.

(*d*) 2 Marsh. 211.

(*e*) Vide *ante*, p. 168, and the cases of *Crossley* v. *Beverley*, and *Jones* v. *Heaton*, there cited.

(*f*) 11 East. 101; and Dav. P. C. 311, *S. C.*

machine he prayed his Majesty's letters patent for the exclusive enjoyment thereof for fourteen years, pursuant to the statute; the letters patent, therefore, granted to him the sole privilege and authority to make use and vend his said invention, and have the whole profit thereof. The letters patent also contained a proviso that if Harmar should not particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, by an instrument in writing under his hand and seal, and cause the same to be enrolled in the Court of Chancery, within one calendar month next, and immediately after the date of the said letters patent, then they should become void. In pursuance of this proviso, Harmar did, in due time, enrol a specification in Chancery, with drawings of the machine in the margin thereof: the introductory part of which specification was as follows: 'To all to whom, &c. I, John Harmar, of Sheffield, send greeting, Whereas his Majesty, by his letters patent, dated the 29th day of March, in the thirty-fourth year of his reign, hath granted to me his special licence, &c., that I, my executors, administrators and assigns, at all times during the term of years therein expressed, should and lawfully might make, use, and vend the machine by me invented and found out, for raising a shag on all sorts of woollen cloths, &c., and that I should enjoy the whole profit, &c., of the said invention for fourteen years, from the date of the said letters patent, according to the statute, &c. And whereas in the said letters patent there is a proviso or condition, that if I, the said John Harmar, should not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, by an instrument in writing under my hand and seal, and cause the same to be enrolled in the Court of Chancery within one calendar month after the date of the said letters patent, that then the said letters patent, and all liberties, &c. thereby granted, should be void. Now, know, ye, that in obedience to the said letters patent, and proviso therein contained, I, the said John Harmar, do, by these presents, particularly describe and ascertain the nature of the said invention, referring to the drawings in the margin of these presents, which I explain as follows." The specification then proceeds under different letters of the

Specification of second patent.

alphabet, corresponding with similar letters on the drawing, to set forth a full description of the whole of the machine; and the specification ends with these words: "And I, the said John Harmar, do hereby declare that my said invention is intended to be worked in the manner hereinbefore particularly mentioned." *It was admitted by the defendant*, that the improvements for which the second patent was granted are included in the general description of the second or improved machine, as set forth in the specification of the second patent; and *that the second specification does contain a full and proper description of the whole machine in its improved state.* But the second specification does not in any manner point out or describe the improvements upon the former machine by any verbal description, or by any delineation or mark in the drawing; and which drawing is not a representation of the improvements alone, but of the whole machine in its improved state; nor are the improvements in any manner substantively and individually explained by the second specification; nor is the machine in the improved state contradistinguished from the state and condition of it under the former patent by any explanation whatever, nor by any delineation or mark in the drawing. *But what the former machine was, and what were the said improvements thereupon, are ascertainable and appear by referring to the first specification and the drawings thereon, and comparing the second specification and the drawings thereon with the same.* The defendants insisted that the second specification was not a due performance of the condition of the second patent; and the question, therefore, for the opinion of the Court was, whether the proviso or condition in the letters patent of the 29th of March, 1794, had been duly performed by the enrolment of the said specification thereof."

It was contended for the patentee, that as the second patent and specification referred to the first, and therefore directed a party to the source from which information might be obtained, the second specification was a "sufficient compliance with the condition in the patent. *That the patentee had only an exclusive right to the whole combination for which his (second) patent was granted, and the use of particular parts only would be no breach of his rights; that the description, therefore, of the particular improvements, distinct*

from the parts in general use before, would be useless to all, and less intelligible to many." During the course of the argument, Lord *Ellenborough*, C. J., said, "The difficulty which presses most is, whether this mode of making the specification be not calculated to mislead a person looking at it, and induce him to suppose that the term for which the patent is granted may extend to preclude the imitation of other parts of the machine than those for which the new patent is granted; when he can only tell by comparing it with some other patent what are the new and what are the old parts: and if this may be done by reference to one, why not by reference to many other patents, so as to render the investigation very complicated! It may not be necessary, indeed, in stating a specification of a patent for an improvement, to state precisely all the former known parts of the machine, and then to apply to those the improvement; but, on many occasions, it may be sufficient to refer generally to them. As in the instance of a common watch, it may be sufficient for the patentee to say, take a common watch, and add or alter such and such parts, describing them." For the defendant it was contended that the specification ought to have informed the public what the thing was for which the patent was granted, and how it was to be made, and not merely inform them where else that information was to be acquired, as that would not be a compliance with the condition in the patent. And also that the true sense of the condition was to give the public direct and complete information of the manner of executing the invention, without further search or trouble. Mr. Justice *Le Blanc* said; "There lies the difficulty; for, suppose the specification had merely described the improvement, such as the addition of a crank or a screw to such or such a part, must not the party still have referred to the original specification, or at least have brought a full knowledge of it with him, before he could understand truly how to adopt the new parts described to the old machine?"

Lord *Ellenborough* also said, "I own I was disposed to think that it was a departure from the terms of the proviso for the patentee merely to tell the inquirer who came to consult the specification, how he might learn what the invention was, instead of giving him that information directly. But

I feel impressed by the observation of my brother Le Blanc, that the trouble and labour of referring to and comparing the former specification with the latter, would be fully as great if the patentee only described in this the precise improvements upon the former machine. Reference must, indeed, often be necessarily made in these cases to matters of general science, or the party must carry a reasonable knowledge of the subject-matter with him in order clearly to comprehend specifications of this nature, though fairly intended to be made. We will, however, consider the case and certify our opinion."

The Court afterwards certified to the Lord Chancellor that they were of opinion that the condition in the second patent had been performed by the enrolment of the specification.

Observations upon Harmar v. Playne.

The reasons of the Court for their opinion in this case were not given, and therefore it is not quite certain whether they held the specification to be made good by the reference to the prior patent and specification, or whether the second patent was in fact not for the improvements themselves separate and apart from the former machine, but for the new combination of parts (*h*), in which case the description of the entire machine was correct and proper. If the Court was of opinion that the patent was for the improvements separate and distinct from the previously known parts of the machine, then they must have held that the specification was made good by the reference to the prior patent. And if this be so, it is to be observed, that this case does not, as has been supposed, amount to a decision that parol evidence may be given to show which of the parts of the machinery were new and which were old. The specification must be deemed by the reference to include all that was contained in the former specification, *which is recorded in the same place as the second specification*, and the reference to the former patent and specification shows most clearly that the patentee did not intend in his second specification to claim those parts of the machinery which were comprised in the first, and which were therefore clearly old at the date of the second patent. The former parts then being in effect disclaimed, and it being admitted by the defendant

(*h*) See what was contended for the patentee, stated *ante*, p. 193.

that the specification did sufficiently describe all parts of the machinery, the only effect of the decision in *Harman* v. *Playne* is, that reference being made to a former specification which is contained amongst the records of the same Court as the second, the first specification may be used as evidence to show which of the parts or things mentioned in the second specification are not intended to be claimed as part of the second invention.

Claim of invention or disclaimer.

In specifying an invention, it is generally necessary, in order to make the instrument intelligible, to describe things which form no part of the invention; and it has consequently become usual, at the end of a specification, to insert a clause, whereby the patentee particularly points out all that he claims as his invention, or disclaims all that is not of his invention; and many specifications contain both a claim and a disclaimer.

Any material mistake in the claim or disclaimer, in a specification, is fatal: the patentee cannot be entitled to anything more than he claims, and if he claims more than he ought, the patent is void.

R. v. Cutler.

In the case of *The King* v. *Cutler* (*i*), the defendant's invention was materially different from what was known before the date of the patent, but in summing up his claim, he confined himself to that which was old, and his patent was, consequently, held to be void.

R. v. Elsee.

In the case of *The King* v. *Elsee* (*k*), the patentee made his claim too extensive, and his patent was, therefore, held to be void.

So also the patents were held to be void by reason of the claims being too extensive in the cases of *Campion* v. *Benyon* (*l*), *Bovill* v. *Moore* (*m*), *Minter* v. *Mower* (*n*), and several other cases.

Saunders v. Aston.

And in the case of *Saunders* v. *Aston* (*o*), the specification omitted to claim the only thing which was new, and the patent was held void.

Construction of specifications.

The various cases which have been cited show the requisites of a specification as a performance of the condition contained in the patent, in pursuance of which it is enrolled. The

(*i*) 1 Stark. R. 354, cited *ante*, p. 182.
(*k*) Dav. P. C. 144.
(*l*) 6 B. Mo. 71.
(*m*) Dav. P. C. 361.
(*n*) 6 A. & E. 735.
(*o*) 3 B. & Ad. 881.

general rule for the construction of a specification, (the object or purpose of the instrument being borne in mind,) is precisely the same as that which applies to all other instruments, and which was so clearly expressed by Lord *Ellenborough*, C. J., in the case of *Robertson* v. *French* (*p*), in which that eminent judge, speaking of a policy of assurance, said, "The same rule of construction which applies to all other instruments applies equally to this instrument, of a policy of insurance, *viz.* that it is to be construed according to its sense and meaning, as collected in the first place from the terms used in it, which terms are themselves to be understood in their plain, ordinary, and popular sense, unless they have generally, in respect to the subject-matter, as by the known usage of trade, or the like, acquired a peculiar sense distinct from the popular sense of the same words; or, unless the context evidently points out that they must, in the particular instance, and in order to effectuate the immediate intention of the parties to that contract, be understood in some other special and peculiar sense."

General rule.

Robertson v. French.

Specifications and patents were formerly construed more strictly against patentees than they are now, which induced Lord *Tenterden*, C. J., in the case of *Hullett* v. *Hague* (*q*), to say, "I cannot forbear saying, that I think a great deal too much critical acumen has been applied to the construction of patents, as if the object was to defeat and not to sustain them."

Specifications formerly construed more strictly.

In the case of *Russell* v. *Cowley* (*r*), Mr. Baron *Parke* said, in giving judgment, that, "In the construction of a patent, the Court is bound to read the specification so as to support it, if it can fairly be done." Mr. Baron *Alderson* concurred, and said, "We ought not to be astute to deprive persons of the benefits to be derived from ingenious and new inventions."

Russell v. Cowley.

The use of words in an improper sense will not vitiate a specification if the intention be clear, and the public is not misled.

Construction of words.

In the case of *Bloxam* v. *Elsee* (*s*), the specification contained several Gallicisms; as, the French word "vice," for a screw, &c.: but the specification does not appear to have been held bad on that ground.

Bloxam v. Elsee.

(*p*) 4 East, 135-136.
(*q*) 2 B. & Ad. 377.
(*r*) 1 Cr. M. & R. 864.
(*s*) 1 C. & P. 563, 568.

De Rosne v. Fairrie.

So in the case of *De Rosne* v. *Fairrie* (*t*), the patentee, who was a Frenchman, in his specification, used the word "discolouring," to signify depriving of colour, and the word "baked," instead of the word crystallized, but the specification, was not held to be defective on that ground.

Neilson v. Harford

And in the case of *Neilson* v. *Harford* (*u*), the Court of Exchequer construed the word effect in one part of the specification as meaning beneficial effect, because it was evidently used in that sense in some other parts of the specification (*x*). And Lord *Lyndhurst*, L. C., afterwards approved of that construction of the specification (*y*).

(*t*) 5 Tyr. 393; 2 C. M. & R. 476. Webs. R. 340, 369.
(*u*) 8 M. & W. 806. (*y*) 1 Webs. R. 373.
(*x*) And see *Neilson* v. *Harford*, 1

CHAPTER VIII.

OF THE CONFIRMATION OF PATENTS, AND THE ALTERATION AND AMENDMENT OF PATENTS, SPECIFICATIONS, AND ENROLMENTS.

SEC. I.—*Of the Confirmation of Patents under the Stat.* 5 & 6 *Will. IV. c.* 83, *sec.* 2.

II.—*Of the Alteration of Patents and Specifications by Memorandum or Disclaimer under the Stat.* 5 & 6 *Will. IV. c.* 83, *sec.* 1.

III.—*Of the Alteration and Amendment of Patents, Specifications, and Enrolments at Common Law.*

SECTION I.

Of the Confirmation of Patents under the Statute 5 & 6 *Will. IV. c.* 83, *sec.* 2.

Want of novelty avoids a patent.

IT has been shown in a former part of this work (*a*), that a want of novelty in the whole or any part of an invention which is made the subject of a grant by patent, renders the patent entirely void. And if it can be shown that a description of any part of the invention was contained in any document published in any part of Great Britain or the colonies before the date of the patent, the patent cannot be sustained, even if it be shown that the invention has not been used in any way whatsoever. Thus if any part of the invention was described in a work printed and published in British North America before the grant of the patent, the patent is void, even if the invention has never been known or used in England (*b*).

Stat. 5 & 6 Will. IV. c. 83, provides a remedy for cases of hardship. Sec. 2.

This strict rule of the law was, in some cases, productive of great hardship, but until the passing of the statute 5 & 6 Will. IV. c. 83, the patentee was without remedy.

By section 2 of that statute it was enacted, "That if in any

(*a*) *Ante*, Chap. V. s. 2, p. 102.
(*b*) See *Brown* v. *Annandale*. 1 Webs. R. 433.

If invention was unknown to patentee discovered or used before the patent.

suit or action it shall be proved, or specially found by the verdict of a jury, that any person who shall have obtained letters patent for any invention or supposed invention, was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same or some part thereof before the date of such letters patent, or if such patentee or his assigns shall discover that some other person had, unknown to such patentee, invented or used the same, or some parts thereof, before the date of such letters patent, it shall and may be lawful for such patentee, or his assigns, to petition his Majesty in council to confirm the said letters patent, or to grant new letters patent, the matter of which petition shall be heard before the Judicial Committee of the Privy Council; and such committee upon examining the said matter, and being satisfied that such patentee believed himself to be the first and original inventor, and being satisfied that such invention, or part thereof, had not been publicly and generally used before the date of such first letters patent, may report to his Majesty their opinion that the prayer of such petition ought to be complied with, whereupon his Majesty may, if he think fit, grant such prayer; and the said letters patent shall be available in Law and Equity to give to such petitioner the sole right of using, making, and vending such invention as against all persons whatsoever, any law, usage, or custom to the contrary thereof notwithstanding: Provided that any person opposing such petition shall be entitled to be heard before the said Judicial Committee: Provided also, that any person party to any former suit or action touching such first letters patent, shall be entitled to have notice of such petition before presenting the same."

Upon petition of patentee the patent may be confirmed if invention not publicly used before date of patent.

New or confirmed patent to be available.

Persons entitled to be heard in opposition.

Act only applies when patentee was ignorant of the defect in his title.

This provision of the Act is only intended to apply to cases in which it shall appear that the patentee at the time he obtained his patent was ignorant of his title being defective, and believed himself to be the *first and original* inventor.

Act does not apply if the patentee was not the *true* inventor.

If the defect in the patentee's title arise from the circumstance of his not having been a *true and actual* inventor, he cannot have been ignorant of the fact, and the statute is inapplicable to such a case (*b*). But if the patentee did actually

(*b*) Vide *ante*, Chap. III. as to who is the true and first inventor of an invention within the meaning of the law.

make the invention, and if at the time when he obtained his patent, he did really believe that he was the *first* inventor, he is enabled by the Act upon discovering that he was not the *first* inventor, to petition for a confirmation of his patent.

Does apply if he was not, but believed he was the *first* inventor.

The defects which may be cured by a confirmation are such as arise out of the fact of an invention having been invented or used before the date of the patent. A confirmation would therefore obviate any objection to a patent, either on the ground of the patentee not being the *first* inventor, or the invention not being new at the date of the patent, provided the invention or some part of it had not been publicly *and* generally used before the date of the patent.

Applies to defects arising out of prior invention or prior use; but not if invention publicly and generally used.

A confirmation is to render the patent available to give the petitioner "the sole right of using, making, and vending the invention as against all persons whatsoever, any law, usage, or custom to the contrary thereof notwithstanding." Although these words are very general and would seem to cure any defect in the patentee's title, yet it is evident that the intent is that a confirmation should only have the effect of obviating objections arising from the invention having been invented or partially used before the date of the patent, leaving the patent still open to all other objections to which it may be liable.

Effect of a confirmation.

The granting of a confirmation is entirely discretionary with the Judicial Committee of the Privy Council, and will only be exercised in extreme cases, and where the confirmation will not prejudice any existing rights.

Confirmation discretionary with privy council.

In *Baron Heurteloup's* case (*c*), it appeared that the petitioner had, in May, 1834, obtained a patent for an invention of "improvements in certain parts of certain descriptions of fire-arms." A portion of the invention consisted of a small tube made of soft metal, and filled with detonating powder for priming the gun, the end of the tube being advanced to the touch-hole by the action of cocking the gun, while a small piece is cut off just by the touch-hole, and detonated there by the falling of the hammer, without exploding the powder in the remaining part of the tube. The petitioner had discovered that a prior patent was granted in France to one Valdahon for an invention, part of which consisted of a straw filled with

Baron Heurteloup's case.

(*c*) 1 Webs. R. 553.

detonating powder brought to the touch-hole of the gun, and cut off, as required, to prime and fire; but the mode of bringing the straw tube to the touch-hole was totally different from the petitioner's, and did not constitute the gun a self-priming gun. Valdahon's invention had never been used in France, England, or elsewhere, and was not known in England otherwise than by a French work, a copy of which had been deposited in the British Museum two years before the date of the petitioner's patent. Under these circumstances, the Judicial Committee of the Privy Council, after notice to Valdahon, recommended a confirmation of the petitioner's patent, which was granted accordingly.

Wells' case.

In *Wells'* case (*d*), it appeared that the petitioner was assignee of a patent, granted in May, 1831, to Gibbins and Westrupp, for an invention of "improvements in an apparatus for converting sea water, or otherwise impure water, into fresh and pure water." The application was opposed on the ground that part of the invention had been published many years before the patent in a well known book, and had also been made the subject of two prior patents, but had not been publicly or generally used. It was also objected, that the petitioner's proper remedy was by disclaimer of that part of the invention which was old (*e*). Lord *Lyndhurst* said, that he did not think the clause of the Act was ever intended to apply to the case where the patentees chose to shut their eyes, when they might have gone to the office and seen the prior specifications. The Act could never be intended to apply to a case when two patents have been taken out for the same thing, that the subsequent patentee should have a right to come to the Court to apply to have the exclusive benefit of the invention adversely to the rights and interests of the former patentee. And the petition was dismissed with costs.

(*d*) 1 Webs. R. 554.
(*e*) As to Disclaimers, see the second section of this Chapter.

Section II.

Of the Alteration of Patents and Specifications by Memorandum or Disclaimer under the Statute 5 & 6 Will. IV. c. 83, s. 1.

Want of novelty in any part of invention renders a patent void.

If a patent is granted for two inventions, and either of them does not possess the requisite degree of novelty, the patent is entirely void, and cannot be sustained for the other invention, even if it be perfectly free from objection. So if any part of what a patentee claims by his specification as part of his invention, was not new at the date of the patent, the patent is entirely void (*f*).

Misdescription of invention also avoids a patent.

When the title of an invention is inaccurate, and misdescribes the invention in any one respect, the patent is void on the ground of a misrepresentation, although there may have been no intention whatsoever to deceive either the Crown or the public (*g*).

Insufficiency also renders a patent void.

And if a specification is insufficient as to any part of the invention comprised in the patent, or if it contains any misstatement respecting any material particular relating to the invention (however inadvertently inserted) the patent is entirely void (*h*).

Such defects incurable before the stat. 5 & 6 Will. IV. c. 83.

Before the passing of the statute 5 & 6 Will. IV. c. 83, such defects as these were incurable, and there are several instances of parties losing the benefit of highly meritorious inventions in consequence of such objections being taken to part of the invention which were perfectly immaterial to the real merits of the case. This was a great defect and a serious reproach to our Patent Law, but it has been to a great extent, if not wholly, removed by recent statutes.

Sec. 1. Any person having obtained a patent for an invention may,

By section the first of the statute 5 & 6 Will. IV. c. 83 (*i*), it was enacted, (so far as the enactment relates to England,) "That any person who as grantee, assignee, or otherwise, hath obtained, or shall hereafter obtain, letters patent, for the sole

(*f*) As to the novelty of an invention, vide *ante*, Chap. V. p. 102.

(*g*) As to the title of an invention, vide *ante*, Chap. IV. p. 43.

(*h*) As to the requisites of a specification, vide *ante*, Chap. VII. pp. 151, 159, 162, 178.

(*i*) See the statute in the Appendix, Chap. I. s. 1.

with leave of attorney-general, enter a disclaimer or alteration of part of title or specification.

making, exercising, vending, or using of any invention, may, if he think fit, enter with the Clerk of the Patents of England, having first obtained the leave of his Majesty's Attorney-general or Solicitor-general, certified by his fiat and signature, —a disclaimer of any part of either the title of the invention or of the specification, stating the reason for such disclaimer, —or may with such leave as aforesaid enter a memorandum of any alteration in the said title or specification; (not being such disclaimer or such alteration as shall extend the exclusive

Disclaimer or memorandum of alteration to be deemed part of the patent or specification.

right granted by the said letters patent;) and such disclaimer or memorandum of alteration being filed by the said Clerk of the Patents, and enrolled with the specification, shall be deemed and taken to be part of such letters patent, or such specification in all Courts whatever: Provided always that any

Caveat may be entered against disclaimer or alteration.

person may enter a caveat, in like manner as caveats are now used to be entered, against such disclaimer or alteration; which caveat, being so entered, shall give the party entering the same a right to have notice of the application being heard by the Attorney-general or Solicitor-general respectively: Provided also that no such disclaimer or alteration shall be

No disclaimer or alteration receivable in evidence in any action pending except *scire facias*.

receivable in evidence in any action or suit (save and except in any proceeding by *scire facias*) pending at the time when such disclaimer or alteration was enrolled; but in every such action or suit the original title and specification alone shall be given in evidence, and deemed, and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted: Provided also that it shall be

Attorney-general may require applicant to advertise.

lawful for the Attorney-general, or Solicitor-general, before granting such fiat, to require the party applying for the same to advertise his disclaimer or alteration in such manner as to such Attorney-general or Solicitor-general shall seem right, and shall, if he so require such advertisement, certify in his fiat that the same has been duly made."

Two proceedings, disclaimer and memorandum of alteration.

There are two proceedings made available to a patentee under this section of this Act:—*firstly*, a *disclaimer* by means of which he may get rid of any objectionable part either of the title in the patent, or of the description in the specification; and, *secondly*, a *memorandum of alteration* by which he may cure any misdescription of the invention either in the patent or in the specification.

1. *Disclaimer.*

A disclaimer may be entered by any person, who, as "grantee, assignee, or otherwise," has *obtained* a patent. Who may enter a disclaimer.

In the construction of this part of the enactment it was decided, in the case of *Spilsbury* v. *Clough* (*h*), that a patentee who had assigned over the whole of his interest in his patent, and afterwards obtained a re-assignment of a portion only, is competent to enter a disclaimer under the Act of Parliament. Spilsbury v. Clough.

Mr. Justice *Patteson* in that case expressed an opinion that the patentee is the proper person to enter a disclaimer under the Act, even if he have parted with all his interest in the patent, assignees being in the opinion of that learned Judge, and also the rest of the Court, sufficiently protected by the power given them to enter *caveats* and oppose a disclaimer before the Attorney or Solicitor-general.

The opinions expressed by the Judges in the case of *Spilsbury* v. *Clough* (*l*), just cited, raised great doubt whether an assignee of a patent was enabled to enter a disclaimer under the statute, but all doubt and difficulty on this subject has been obviated by the subsequent Act of 7 & 8 Vict. c. 69 (*m*); by section five of which it was enacted, "That in case the original patentee or patentees hath or have departed with his or their whole, or any part of his or their, interest by assignment to any other person or persons, it shall be lawful for such patentee, together with such assignee or assigns, if part only hath been assigned, and for the assignee or assignees, if the whole hath been assigned, to enter a disclaimer and memorandum of alteration under the powers of the said recited Act; and such disclaimer and memorandum of such alteration having been so entered and filed, as in the said recited Act mentioned, shall be valid and effectual in favour of any person or persons in whom the rights under the said letters patent may then be, or thereafter become legally vested; and no objection shall be made in any proceeding whatsoever on the ground that the party making such disclaimer or memorandum of such alteration had not sufficient authority in that behalf. Doubts whether assignee could enter a disclaimer. Obviated by 7 & 8 Vict. c. 69, s. 5. If part of a patent has been assigned, disclaimer may be entered by patentee and assignee jointly, or if the whole, then by the assignee alone.

(*k*) 2 Q. B. 466.
(*l*) *Ibid.*
(*m*) See the statute in the Appendix, Chap. I. s. 1.

The granting of leave to enter a disclaimer is discretionary.

In order to enter a disclaimer, the leave of the Attorney or Solicitor-general must be obtained, and the granting of leave is entirely discretionary with either of those officers to whom the application may be made. The leave to enter a disclaimer must be certified by the fiat and signature of the Attorney-general (*n*), before it can be entered by the Clerk of the Patents, or enrolled in the manner required by the Act.

Cases in which disclaimers are applicable.

It is difficult to lay down any certain rule respecting the cases in which disclaimers are available or expedient. The power granted by the statute, is, however, chiefly applicable to cases in which patentees after they have obtained their patents or enrolled their specifications, find that they have included something for which a patent cannot be sustained. Thus, if a patentee finds that a part of his invention does not contain the requisite degree of novelty, he may by a disclaimer obviate an objection which would have the effect of avoiding his patent entirely. So if he finds that he has inadvertently omitted to describe in his specification a portion of the invention particularly mentioned in the title, that part of the title may be got rid of by a disclaimer.

Or if the patentee discovers that he has made his claim of invention more extensive than is warranted by the title, the redundant part may be disclaimed (*o*). Want of utility in any part of an invention will render a disclaimer necessary, if the useless part be a separate portion of the invention, or if the utility of that particular part appears to have formed part of the consideration for the patent grant (*p*). So if a portion of the invention will not produce the effects stated by the patentee, he may disclaim the objectionable part.

Disclaimer must not extend the patent right.

But a disclaimer must not be such as will extend the right granted by the patent. This was a very necessary provision to make for the protection of the public and subsequent patentees; for if a patentee's power of disclaiming had not been limited in this way, he might, under pretence of disclaiming something contained in the title or specification, really extend the operation of the patent much beyond the original invention for which it was granted.

(*n*) See the Forms in the Appendix, Chap. II. s. 2.

(*o*) As to the titles of inventions, see Chap. IV. *ante*, p. 43.

(*p*) See Chap. V. s. 3, p. 132, as to the utility of inventions.

A party entering a disclaimer must take especial care that it does not violate the statute in this respect, for he enters the disclaimer at his own peril, and if it be contrary to the statute, it will be void, notwithstanding the leave granted by the Attorney or Solicitor-general (*q*). And if a disclaimer does not come within the provision of the Act in this respect, it will not only be void, but may be very prejudicial to the patentee. It may contain (amongst the reasons for the disclaimer) an admission that there is something comprised in the title or specification for which the patent cannot be sustained.

A party enters a disclaimer at his own peril.

If contrary to the act it will be void.

The disclaimer must show the reason for making it, as, for instance, that the patentee has discovered that the parts disclaimed were not new, or are not useful, or that they will not produce the effects stated, or that doubts are entertained respecting such matters. And it seems that a patentee is required to state his reason not only that the Attorney or Solicitor-general may be better able to judge of the propriety of assenting to it, but also that the public may be better enabled to understand how it varies the effect of the patent.

Reasons to be stated in disclaimers.

Advertisements may be and always are required to be published, giving notice of the application for a *fiat* (*r*). *Caveats* may be entered against leave being given to enter a disclaimer, and the application for leave may be opposed by parties who have entered *caveats*. This provision is intended not only for the benefit of the public, but also for the protection of assignees and licensees having an interest in the patent (*s*), so that they may be enabled to oppose leave being granted to enter any disclaimer which may operate to their prejudice.

Notice of application.

When the disclaimer is completed and the *fiat* obtained, it is to be filed by the Clerk of the Patents, and enrolled with the specification, and then it becomes in effect a part of the patent and specification to which it relates. But the entry of a disclaimer will not have the effect of making a void patent good, *ab initio*, as to the undisclaimed parts of the invention, so as to make any person a wrong doer by relation. This was decided in the case of *Perry* v. *Skinner* (*t*), in which it was

Effect of a disclaimer when enrolled.

Does not make patent good *ab initio*.

(*q*) See the observations of the Master of the Rolls in *re Sharpe's* patent, 1 Webs. R. 641.

(*r*) See the rules of practice on this subject in the Appendix, Chap. I. s. 2; see also the practice, *post*, Chap. XII.

(*s*) See *Spilsbury* v. *Clough*, 2 Q. B. 466.

(*t*) 2 M. & W. 471.

Act did not intend to make a party a wrong doer by relation.

held that although the Act is obscurely worded, yet the intent could not have been to make a party a wrong doer by relation, and therefore that the Act must be understood as if it had said that after a disclaimer had been filed and enrolled, the disclaimer should be "deemed and taken to be part of such letters patent, or such specification, *from thenceforth* in all Courts whatsoever." The chief difficulty in construing this section of the Act of Parliament arises from the introduction of the proviso that a disclaimer should not be receivable in evidence in any action (except an action of *scire facias*) pending at the time when it is enrolled, and which would seem to be unnecessary if a disclaimer could not affect any thing done prior to the enrolment. But notwithstanding this difficulty, the Court of Exchequer held, in the case of *Perry* v. *Skinner* (*u*), just cited, that an Act of Parliament cannot be construed, so as to make a party a wrong doer by relation unless the words showing such an intent are manifest and plain.

Object of disclaimer.

The object of a disclaimer must always be to cure some defect in a patent, or obviate some doubt respecting its validity, and as it must state the reason why it is made, it will in some cases bear evidence upon the face of it of an admission by the patentee, that there was something for which he could not sustain the patent.

Admission that patent was void prevents any action for a prior infringement.

With respect to the disclaimed parts in such cases, it is clear that the patentee by the disclaimer abandons all right to them; and as to the residue of the invention, he will be debarred from proceeding against any one for a prior infringement of the privilege, if he has admitted that it was void until the defect was cured by the disclaimer.

Action may be maintained if patent not admitted to be void.

There may however be cases in which a disclaimer will contain no admission of the prior invalidity of the patent; and in such cases it seems that the disclaimer will not affect the patentee's right to recover damages for an infringement of the undisclaimed parts of the invention before the enrolment of the disclaimer (*x*).

In what suits a disclaimer to be given in evidence.

The proviso declares that a disclaimer is not to be receivable in evidence in any action or suit pending at the time it is enrolled (except an action of *scire facias*), and that in such

(*u*) 2 M. & W. 471.
(*x*) See per *Tindal*, C. J., in *Slocker* v. *Waller*, 9 Jur. 136.

actions or suits the original title and specification alone are to be given in evidence. The intent of this proviso is, that a patentee shall not be enabled to give a disclaimer in evidence to the prejudice of any party against whom he may then have any action or suit pending, but it could hardly be intended that the defendant in such a suit should not be at liberty to make use of a disclaimer as evidence against the patentee, if it contains any admission respecting the prior invalidity of the patent. In such a case the disclaimer shows that the supposed privilege which the defendant is alleged to have infringed had no legal existence at the time when the alleged infringement was committed, and the patentee ought not to be permitted to enforce a patent against a defendant which he admits contained something that rendered it void; and it may be that that part of the invention which the defendant is charged with pirating, may be the very part which the patentee has disclaimed.

Patentee prevented from giving evidence of disclaimer in actions pending.

Defendant may use disclaimer in evidence.

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2. *Memorandum of Alteration.*

The provisions of the statutes 5 & 6 Will. IV. c. 83, and 7 & 8 Vict. c. 69, are precisely the same with respect to a memorandum of alteration as with respect to a disclaimer. The same persons who are enabled to enter disclaimers may also enter memorandums of alterations, provided they obtain the requisite leave.

Memorandum of alteration.

A memorandum of alteration is available for the purpose of correcting any mistake or misdescription in the title of the invention, or in the specification, or for the purpose of explaining anything in the specification which is not sufficiently intelligible.

For what purpose a memorandum of alteration available.

The patentee must be careful to see that any alteration he may seek to make, will not be such as, if valid, would have the effect of extending the exclusive right granted by the patent. The Attorney or Solicitor-general will only examine a proposed alteration or disclaimer with a view to see how far it may affect the rights and interests of other parties, and the public in general, leaving the patentee to take care of his own interest, and if he enter a memorandum of alteration

Alteration must not extend the patent right.

which is not warranted by the statute, it will be void, and may be very prejudicial to his interests.

The provision in the Act that a disclaimer or alteration shall not be such as to extend the patent right, must however be understood with some qualification; for if a disclaimer or memorandum of alteration has the effect of rendering a void patent valid, it may be said in one sense to extend the patent right. It seems that the true question in all cases will be, whether a disclaimer or alteration made by a patentee would have the effect of extending the patent privilege, if the patent were a valid patent at the time the disclaimer or alteration is filed and enrolled. If the disclaimer or alteration could not produce such an effect, then it would not be void as having a tendency to extend the patent right; but if the patent and specification, and the disclaimer or alteration, taken and construed together, purport or appear to be more extensive in effect than the patent and specification alone, then the disclaimer or memorandum of alteration is not warranted by the statute, and is therefore null and void.

Reason for alteration need not be stated.

The Act requires that the reason for a disclaimer should be stated, but is silent with respect to any statement of the reason for an alteration, and that was probably because it would be difficult to make any alteration beneficially for the patentee, without the reason being apparent in some way or other. It is however usual in practice to state the reason why an alteration is made.

A proposed memorandum of alteration must be advertised in the same way as a disclaimer, and may be opposed in a similar manner (*y*).

Effect of a memorandum of alteration.

The observations which have been made (*z*) respecting the effect of a disclaimer apply also to a memorandum of alteration. It is clear from the express provisions of the Act of Parliament, that a memorandum of alteration could not be used in evidence in any action pending at the time it was enrolled. But if the alteration which has been made does not show that the patent was void before the making of the alteration, there does not seem to be any reason for concluding that the memorandum of alteration should have the effect of de-

(*y*) Vide *ante*, p. 204, and the rules in the Appendix, Chap. I. s. 2.

(*z*) Vide *ante*, p. 205.

priving the patentee of any remedy against prior infringers (*a*). Thus suppose a patentee to make an alteration for the purpose of rendering his specification more clear and explicit, and obviating any doubt respecting its sufficiency, he does not admit the invalidity of his patent, but he thinks it prudent to provide against an adverse decision on a doubtful point. In such a case it would be hard to deprive a patentee of his remedy against parties for prior infringements, if it should turn out that the patent was really valid and sufficient, without the alteration which he has only made by way of precaution. But if a patentee were under such circumstances to proceed against any person for a prior infringement, he must show that the patent was sufficient without the aid of the memorandum of alteration, which he could not be permitted to give in evidence, but the defendant would be at liberty to give the instrument in evidence against the plaintiff if it contained any admission respecting the prior invalidity of the patent.

Disclaimer and alteration may be in one instrument.

It frequently happens that a patentee desires not only to make a disclaimer, but also an alteration in some part of the title or specification of his invention; and in such a case the disclaimer and alteration may both be effected by one instrument.

Section III.

Of the Alteration and Amendment of Patents, Specifications, and Enrolments at Common Law.

Alterations and amendments at Common Law.

The statute 5 & 6 Will. IV. c. 83, left untouched the Common Law power of altering and amending the entries and proceedings relating to patent grants; and there are several alterations and amendments which can only be made at Common Law.

Chancery records in custody of the Master of the Rolls.

In three out of the four superior Common Law Courts the records are supposed to be in the custody of the chief Judge of the Court, and therefore all writs of error are directed to him alone, commanding him to return the records into the Court of Error; and he alone has the power of appointing the officers of the Court. But in the Chancery, which is the other

(*a*) See *Perry* v. *Skinner*, and *Stocker* v. *Waller*, cited *ante*, p. 208.

superior Common Law Court, the records are not in the custody of the Lord Chancellor, (who is, properly speaking,) the sole Judge of the court) (*b*); but they are placed in the custody of the Master of the Rolls, who is, by virtue of his office, keeper of the records of that Court (*c*).

Lord Chancellor has jurisdiction to order alterations or amendments.

As sole Judge of his Court, the Lord Chancellor clearly has jurisdiction over the Chancery records, to order any alterations or amendments which may be found necessary, in the same way as the Judges of the other Common Law Courts at Westminster order such alterations or amendments to be made in the records of their Courts, although the records are in the custody of the chief Judge only, or of the officers of the Court, who are for that purpose his deputies.

Master of the Rolls has also jurisdiction to order alterations or amendments.

And the Master of the Rolls, as the keeper of the records of the Court, has authority over all the officers whose duty it is to prepare, examine, and preserve the records; and has jurisdiction to order such alterations or amendments in the rolls of the Court as may be necessary in order to make them correct records of the acts or judgments of the Court, which are intended to be therein recorded.

It would be beside the purpose of this work to enter into much detail respecting the Common Law power of amendment possessed by our Courts; ample information on the subject will be found in several of our abridgments, digests, and books of practice (*d*).

Records relating to patent grants.

The records of the Court of Chancery relating to a patent grant are, first the Privy Seal bill, or writ of Privy Seal, directed to the Lord Chancellor, and by virtue of which he makes the patent, and this writ when filed in Chancery becomes a record of that Court. Upon this writ is written the *recepi* required by the statute 18 Hen. VI. c. 1, which is also an entry of record. The patent made by the Lord Chancellor in pursuance of the writ of Privy Seal, is also a record of the Court of Chancery (*e*), although it is delivered to the

(*b*) 4 Inst. 79.

(*c*) The Master of the Rolls is now, under the statute 1 & 2 Vict. c. 94, the keeper of all the public records of the kingdom.

(*d*) See the title "Amendment," in Bacon's Abridgment, Comyn's Digest, and Viner's Abridgment; see also the Chapter on Amendment in Tidd's Practice, and *Blackamore's* case, 8 Co. R. 156, a; and *Wynne* v. *Thomas*, Willes, 563.

(*e*) Vide *ante*, Chap. IV. p. 36.

grantee as a muniment of his title. Letters patent are always enrolled or entered upon rolls called Patent Rolls, and such enrolments are records of this Court. A specification must also be enrolled within the time limited by the patent, and that enrolment is also a record of the Chancery. A disclaimer or memorandums of alteration must be enrolled with the specification, and must be considered as part of the same record.

All these records, except the letters patent, pass into and remain in the custody of the Master of the Rolls, as keeper of the records of the Court.

Writ of Privy Seal.

With respect to the Privy Seal bill, or writ of Privy Seal, the Master of the Rolls has merely a right to the custody of it, in order to preserve it amongst the other records of the Court, but he has no authority to alter or amend it in any way. It is the writ upon which the Lord Chancellor's authority to make a patent was founded, and it is preserved amongst the records of the Court, in order to show by what authority the patent was made (*f*), the patent itself always referring to the writ by the usual conclusion, "By writ of Privy Seal" (*g*). This writ is issued by the Lord Privy Seal, under the seal of his office, and it can only be altered or amended by the same authority as that which made it, *viz.* the Lord Privy Seal. The Master of the Rolls will in all proper cases allow the Lord Privy Seal or his officer to have access to the writ for the purpose of altering or amending it in any way that may be necessary in pursuance of any authority received from the Crown (*h*), but by the alteration it becomes in effect a new writ (*i*), and must be again delivered to the Lord Chancellor, as his authority to alter and reseal the patent, and another *recipi* must be written upon the writ, or recorded in some other way in pursuance of the statute 18 Hen. VI., c. 1 (*j*). And when a party is applying to have a writ of Privy Seal altered, it seems to be proper that he should be required to deliver the letters patent to the proper officer of

Patent ought to be delivered into Court before the writ of Privy Seal is altered.

(*f*) See 8 Co. R. 18, b. 2 Inst. 555, 556.

(*g*) See Chap. IV. p. 74.

(*h*) There must be a fiat or warrant of the Attorney or Solicitor-general to show the consent of the Crown.

(*i*) See the case of *Knight* v. *Warren*, 7 Dowl. 663.

(*j*) This is in accordance with what was stated by Lord *Cottenham*, L. C., in *Nickels'* case, Turner & Phillips, 47; 1 Webs. R. 662, 663, *S. C.*

the Court before the writ is altered; for otherwise the party might afterwards neglect to carry in the patent to have it altered and resealed, and then there would be a patent in existence which would appear not to be warranted by the writ of Privy Seal.

Patent.

The patent we have seen is a record of the Court of Chancery, containing the Queen's grant made by the Court in pursuance of the writ of Privy Seal (*l*). This record does not remain in the Court, but is delivered into the custody of the grantee, immediately after it is made as an evidence of his title to the privilege which the Queen has granted him. It is scarcely necessary to observe, that the grantee himself has no authority to alter or amend the patent in any respect; indeed the alteration of it by him or any other person without lawful authority would be a serious offence (*m*).

Patent can only be altered or amended by the Lord Chancellor.

The writ of Privy Seal for the making of a patent is directed to the Lord Chancellor alone, and confers authority upon no other person; the letters patent which he makes in pursuance of such a writ never pass into the custody of the Master of the Rolls, and therefore the Master of the Rolls has no jurisdiction whatever over the patent (*n*). The Lord Chancellor is, in fact, the only person who has any jurisdiction over a patent, and that jurisdiction he has over the patent as well as over all the other records of his Court. Therefore, whenever a patent is to be altered or amended in any respect, the alteration or amendment can only be made by the Lord Chancellor, and he can only give effect to any alteration or amendment of it by the same means that he made the patent, *viz.* by affixing to the patent, as altered, the Great Seal, which is in his custody (*o*).

Must be resealed after alteration.

Alteration of a patent.

Whenever the Lord Chancellor has executed a writ of Privy Seal, by making a patent in the form commanded, and it is afterwards discovered that a patent in that form is not that which was intended, the whole of the previous proceedings may, by her Majesty's command, be altered so as to make them according to the intent; and the altered writ of Privy Seal being redelivered to the Lord Chancellor, his Lordship

(*l*) Vide Chap. IV. *ante*, p. 36.

(*m*) See stat. 11 Geo. IV. & 1 Will. IV. c. 66, s. 2; Hawk. P.C. c. 70, ss. 1, 8 & 9; 1 Hale, 178, 184; 3 Inst. 16.

(*n*) *Nickels'* Case, Turner & Phillips, 44; 1 Webs. R. 659, *S. C.*

(*o*) Beames' Orders, 67.

thus acquires jurisdiction to make the patent correspond with the new form given him in the writ, if he thinks it lawful or proper so to do (*p*). What may thus be done by the Lord Chancellor, in pursuance of this new command, will properly be termed an *alteration* of the patent, and not an amendment of it, for the writ of Privy Seal having previously been fully executed, his Lordship has no power to make the alteration without a new command from her Majesty, and the altered patent is, in fact, a new patent (*q*). If any authority were necessary to show that the Lord Chancellor must have a new warrant to alter a patent, it would be furnished by the case of *ex parte Beck* (*r*), in which it appeared that a *caveat* had been entered against putting the Great Seal to a patent for an invention which was afterwards made, bearing date 12th August, 1784; the Lord Chancellor, upon hearing the petition, took some time to consider of it, and did not make his order until the 27th August. The patentee did not enrol his specification until the 18th of December, 1784, supposing that the patent bore date the day the final order was made by the Lord Chancellor, but he then found that the four months limited for the enrolment of his specification had expired. The patentee then petitioned the Lord Chancellor to alter the patent by making it bear date the 27th of August instead of the 12th; but his Lordship (Lord *Thurlow*) refused, and said, that although he was perfectly satisfied that the patentee was well entitled to his patent, and that his case was a very hard one, yet he could not make such a use of his power as Keeper of the Great Seal, as to alter a patent in any degree upon an application of that sort.

Ex parte Beck.

In Beames' Orders (*s*), the form of order in *Sir Kenelm Digby's* case is given, from which it appears that the King had by letters patent granted to Sir K. Digby certain lands escheated to his Majesty by the death of *J. C.*, without heir, part of which lands were in Kent, and were so mentioned in the office found, and in the bill signed for the patent, but at the Signet Office, "by mistake of the clerk taking the L for a K,

Sir K. Digby's case.

(*p*) Vide *ante*, Chap. IV. p. 37, as to the act of the Court of Chancery in making a record of the Queen's grant.

(*q*) See the case of *Knight* v. *Warren*, cited, *ante*, p. 213, n. (*i*).

(*r*) 1 Br. 78.

(*s*) P. 66.

are mentioned to lie in com. Kauk," and by that error were so mentioned both in the writ of Privy Seal, and the patent, and in the enrolment. Sir K. Digby then petitioned the King for a warrant to amend the patent, which was granted (signed by the Attorney-general), and upon seeing the King's bill, and the Signet bill, as altered in pursuance of the King's command, the Lord Chancellor ordered the writ of Privy Seal and the patent to be amended and resealed, and the enrolment to be also amended accordingly. It is also stated by the order in this case, that *the seal was to be taken from the patent*, and that it was then to be altered and resealed, which shows that when resealed, it would, in effect, be a new instrument.

Mode of altering a patent.

But if a patent should happen by mistake to be made in a form different from that commanded by the writ of Privy Seal, the writ has not been executed, and the Lord Chancellor has jurisdiction without further authority from the Crown to reform the error which has been committed, because until that is done he has not executed the writ of Privy Seal, and the alteration which he may thus make will properly be termed an amendment of the patent.

If patent not made in pursuance of writ of Privy Seal, Lord Chancellor may amend it.

The redelivery of an altered Privy Seal bill to the Lord Chancellor, does not make it imperative upon him to alter the patent accordingly, unless he is of opinion that the alteration will not unfairly prejudice third parties, and will not make the patent contrary to law. If the alteration sought to be made is unopposed, the patent will be altered and resealed, as a matter of course, unless the alteration appears to be objectionable to the Chancellor or his officers. If the alteration is opposed, as it may be on a *caveat* entered for that purpose (*s*), the Lord Chancellor must then exercise his judgment on the matter, and make or refuse the alteration as he may think just or expedient under the circumstances. Thus in *Nickels'* case (*t*), it appeared that the patentee had petitioned the Crown for a patent for an invention of "improvements in machinery for covering fibres applicable in the manufacture of braid and other fabrics;" but a mistake was made by a clerk in the Secretary of State's office, who prepared the Queen's warrant, and who introduced the word

It is not imperative upon the Lord Chancellor to alter a patent.

If alteration opposed, Lord Chancellor must exercise his judgment.

Nickels' case.

(*s*) See the practice as to such oppositions, *post*, Chap. XII.

(*t*) Turner & Phillips, 36; 1 Webs. R. 662, 650, *S. C.*

"recovering" into the title of the invention instead of the word "covering." This mistake was not discovered at the time, and not only the Queen's warrant, but all the other proceedings, including the Privy Seal bill, the patent, and the enrolment of the patent, contained the word "recovering" in the title instead of the word "covering;" and the docket-book, which is open to the public, and which is always resorted to by the public to obtain a knowledge of what a patent has been obtained for, also stated the patent to have been granted for improvements in machinery for *recovering*, &c. The patent was obtained in this way in April, 1838, and a specification was enrolled in October of the same year, in which the patent was referred to as a patent for "improvements in machinery for *covering*, &c." In the month of June, 1840, the patentee commenced proceedings against the London Caoutchouc Company for an alleged infringement of his patent, and the Company soon afterwards sued out a writ of *scire facias* to repeal the patent. Pending these proceedings, the patentee procured the Privy Seal bill and the prior proceedings to be altered by substituting the word "covering" for "recovering" in the title, and then without the writ of Privy Seal having been redelivered, he petitioned the Lord Chancellor to amend the patent accordingly, and carried the patent into Court to be resealed, when it was discovered that the patent had been altered after it was sealed, by erasing the letters "re" from the commencement of the word "recovering" in the title of the invention, but no explanation was given respecting the manner in which this alteration had been made (*u*). The petition being opposed by the London Caoutchouc Company, Lord *Cottenham*, L. C., (without hearing the counsel for the Company,) said, that he would do nothing but what was usual, that is to say, that he should at all events only reseal the patent upon the Privy Seal bill being properly brought before him, and that he should not even do that without taking care that it should not prejudice other persons. And on a subsequent day his Lordship said, that the only terms on which he would entertain the application to amend the patent at all were, that the patentee should abandon and pay the

(*u*) This fact is omitted in Mr. Webster's report of the case.

costs of all proceedings then pending, and undertake not to bring any other action for the infringement of his patent up to that time. The petitioner declined to accede to these terms, and the Lord Chancellor, therefore, not only refused to grant the petitioner any relief, but also ordered him to pay the costs of the London Caoutchouc Company in opposing the petition (*x*).

At a subsequent period the action against the London Caoutchouc Company came on for trial, and at the suggestion of the learned Judge who presided, a compromise was effected between the parties; and the Privy Seal bill, having been redelivered to the Lord Chancellor, his Lordship, with the consent of the Company, ordered the patent to be amended and resealed, *the petitioner undertaking to bring no action for any infringement before the resealing*, and the patent was afterwards amended and resealed accordingly.

Effect of the Alteration in Nickels' case.

It is difficult to say what is the effect of such an alteration and resealing of a patent as in *Nickels'* case. The statute 18 Hen. VI. c. 1, requires that the day of the delivery of the writ of Privy Seal to the Chancellor shall be entered of record, which is always done by the usual *recepi* being written in the margin of the writ. When an alteration has been made in the writ of Privy Seal, it must be redelivered to the Chancellor, and a new *recepi* written upon it (*y*). It seems therefore that the alteration in the writ of Privy Seal makes it essentially a new writ. The statute just cited also enacts, that a patent made in pursuance of the writ shall bear date the day of the delivery so recorded, *and not before*; and that if any letters patent be made to the contrary *they shall be void*. In *Nickels'* case the redelivery of the writ of Privy Seal was recorded by a *recepi* in the usual way, but the patent, after it had been altered, was resealed as of the same date as before; and therefore the altered patent bore date on a day before the day of the redelivery of the writ of Privy Seal, which seems to be contrary to the provisions of the statute of 18 Hen. VI. c. 1, just cited. The patentee however was in a difficult position, for his patent was void for want of a proper specification, and therefore it was necessary to procure an alteration

(*x*) The order for the payment of these costs is not stated in either of the reports of the case.

(*y*) Vide *ante*, p. 214.

in the patent; if he had procured the altered patent to be resealed as of the day when the altered writ of Privy Seal was delivered to the Lord Chancellor, the patent would have borne date on a day long after the enrolment of the specification, and the patent would thus have been avoided by reason of the want of novelty in the invention at the date of the patent. The course which the patentee took was that which was the best under the circumstances, but it is very doubtful whether the alteration has given him any better title than he before possessed. The apparent want of jurisdiction in the Lord Chancellor to make a valid amendment of a patent under such circumstances is a serious defect in the law, which ought to be remedied by Parliament.

Mode of making an alteration.

In the course of the argument of *Nickels'* case, Lord *Cottenham* said (*z*), that he had some doubt as to the mode in which an alteration was to be made when the letters patent had been actually enrolled. His Lordship added, however, that he had been furnished with the only instance of the kind which he was told existed, and it was effected in this way. An application had been made to Lord *Alvanley* when he was Master of the Rolls to alter the enrolment. He thought he could not do it, because it would make the enrolment vary from the letters patent; and afterwards, on communication with the Lord Chancellor, who thought the case was one in which an alteration ought to be made in the patent, the Master of the Rolls came into the Lord Chancellor's Court, and under the authority of the Lord Chancellor, the patent having been altered was resealed, and then the Master of the Rolls made the enrolment correspond with the patent so altered.

Enrolment of patent.

The enrolment of a patent is an entry of the patent upon record, which is made for the purpose of showing what the Lord Chancellor has done in pursuance of the Queen's writ of Privy Seal. This entry is made upon one of the rolls called the Patent Rolls, for the current year of the Queen's reign: and although the enrolment is, in practice, (for the sake of convenience merely,) copied from the writ of Privy Seal, it is in fact an enrolment of the patent, and not of the writ of

(*z*) Turner & Phillips, 48; 1 Webs. R. 663, *S. C.*

Privy Seal (*a*). After the enrolment has been prepared, it passes into the custody of the Master of the Rolls, who thus acquires jurisdiction over it (*b*).

Enrolment of patent examined and corrected by Clerk of Petty Bag.

The writ of Privy Seal comes into the custody of the Master of the Rolls as well as the enrolment, and the officers of the Petty Bag (to which office the enrolment is transmitted after it is prepared) examine it in order to see that it has been properly prepared by the enrolment clerks, and if it is found erroneous or defective, the officers, as deputies of the Master of the Rolls, have authority to make the necessary corrections.

Master of the Rolls has power to order amendments.

So also if the enrolment should at any time afterwards be found to be erroneous in any respect, the Master of the Rolls clearly has jurisdiction to correct the error. The Master of the Rolls has indeed exercised this jurisdiction from a very early period, several instances of which will be found referred to in a note to the report of *Nichels*' case, before the present Master of the Rolls (*c*). So if it becomes necessary at any time to alter or amend the patent, the enrolment must be altered or amended in the same manner, and the Master of the Rolls will see that the enrolment is made to correspond with the altered patent.

Lord Chancellor has jurisdiction to order amendments and rescind or vary orders made by the Master of the Rolls.

The Lord Chancellor has also jurisdiction, not only to order any alteration in an enrolment which may be necessary in order to make it in accordance with the patent, but has power to vary or rescind any order for an amendment made by the Master of the Rolls.

Thus in *Nichels*' case (*d*), the Master of the Rolls had ordered an alteration to be made in the enrolment of the patent, which had the effect of making the enrolment vary from the patent; and upon an appeal to the Lord Chancellor against this order of the Master of the Rolls, it was objected by the respondents that the Lord Chancellor had no jurisdiction, but Lord *Cottenham*, L. C., held that he had jurisdiction, and said that the Master of the Rolls either had jurisdiction or no jurisdiction; if he had jurisdiction, then the Lord Chancellor had jurisdiction also upon appeal against his order; and that if the Master

(*a*) See *Nickels*' case, Turn. & Phil. 36.

(*b*) See the practice, *post*, Chap. XII.

(*c*) 4 Beavan, 567, 570; see the same cases mentioned in a note to Mr. Webster's report of *Sharp's* case, 1 Webs. R. 647, n. (*b*).

(*d*) See the reports of the case in 4 Beavan, 563; Turn. & Phil. 36; 1 Webs. R. 650-656. The point above stated is not however mentioned by any of the reporters.

of the Rolls had no jurisdiction, the Lord Chancellor had jurisdiction to set aside his void order.

It is of the utmost importance that the enrolment of a patent should be strictly in accordance with the patent itself, for by the statute 3 & 4 Ed. VI. c. 4, amended by 13 Eliz. c. 6, an exemplification or constat of the enrolment may be pleaded and given in evidence in the same manner as the patent itself. Importance of enrolment being in accordance with patent.

In *Nickels'* case (*e*), it appeared that the patentee had procured a mistake in the title of his invention to be rectified in all the proceedings prior to the patent, including the writ of Privy Seal; but in consequence of difficulties already alluded to (*f*), he was desirous of avoiding any alteration in the patent itself. He therefore applied to the Master of the Rolls (*g*) to have the enrolment altered so as to make it correspond with the writ of Privy Seal, intending to offer the enrolment in evidence, but he did not procure the patent to be altered. The Master of the Rolls, upon proof that it was the practice to prepare the enrolment from the writ of Privy Seal (which always contains the form of the patent), ordered that the enrolment should be altered so as to make it conformable with the altered writ of Privy Seal, and the enrolment was altered accordingly. Upon the argument of the case, the Master of the Rolls (Lord *Langdale*) had great doubt respecting his authority to make the alteration in the enrolment without a previous alteration in the patent, but being impressed with the peculiar hardship of petitioner's case, and after a conference with the Lord Chancellor, his Lordship thought it best to raise the question respecting the legality of such an alteration in the enrolment by making an order, and thus compelling the opposing party to carry the case before the Lord Chancellor by way of appeal. Nickels' case.

Upon an appeal to the Lord Chancellor (Lord *Cottenham*), this order was discharged, and his Lordship said in delivering judgment, "I have communicated with the Master of the Rolls since the case was argued, and the Master of the Rolls entirely concurs with me in the opinion which I understand that he intimated when the case was before him, that nothing can Enrolment must not differ from the patent.

(*e*) 4 Beavan, 563; Turner & Phil. 36; 1 Webs. R. 650, *S. C.*

(*f*) *Ante*, p. 218.

(*g*) 4 Beavan, 563.

be permitted to remain which will enable the party to produce an enrolment differing from the letters patent. If any doubt could exist upon that point upon other grounds, it would be removed by the statute of Elizabeth (*h*), which enables parties, by producing the enrolment (*i*), to dispense with the necessity of producing the letters patent, that provision evidently proceeding on the assumption, that the enrolment correctly represents what is contained in the letters patent. The title of the party derived from the Crown rests on the authority of the letters patent, the enrolment being only permitted to be used for the purpose of showing what the patent was, or rather of preventing the danger which might otherwise arise from attempts to alter the letters patent, which, being in the possession of the party, are of course more exposed to frauds and other casualties than the enrolment, which is kept in this Court, can be." And after suggesting an application for an amendment of the patent, his Lordship added, "The patentee may be assured that he will, in no event, be permitted to produce, as evidence of his patent, an enrolment which does not represent what the letters patent contain."

The Lord Chancellor accordingly afterwards discharged the order of the Master of the Rolls, and Lord *Langdale*, M. R., concurred with the Lord Chancellor in discharging it, and in ordering the enrolment to be restored to its former state, which was done accordingly.

Enrolment of specification.

The specification is an instrument in writing under the hand and seal of the patentee, describing his invention in the manner required by a proviso in the patent (*k*). The enrolment of that instrument is an entry of it upon record, also made in pursuance of the proviso contained in the patent, for the purpose of informing the public of the nature of the invention, and the manner in which it is to be exercised. This entry is made upon one of the rolls, called the Rolls of Surrenders and Specifications, which are prepared in several offices in Chancery (*l*).

(*h*) 13 Eliz. c. 6.

(*i*) That is an exemplification of the enrolment.

(*k*) Vide *ante*, Chap. VII. p. 151, respecting the specification.

(*l*) They are the Enrolment Office, the office of the Rolls Chapel, and the office of the Petty Bag.

These records or rolls also pass into the custody of the Master of the Rolls, and as the keeper of them he has jurisdiction to make any alteration or amendment which may be necessary to make the enrolment correctly represent what the specification was at the time when it was brought into Court to be enrolled. Cases of this kind have occurred in which the enrolments have been amended by order of the Master of the Rolls, and there can be no question about the legality of such amendments.

These rolls in custody of the Master of Rolls, who may order amendments.

There are also several instances in which amendments or rather alterations of a very different description have been authorized by the Master of the Rolls.

Alteration of enrolments of specifications.

Thus in *Redmund's* case (*m*), it appeared that the clerk who had copied the specification, had by mistake transposed some of the references to the plan, and nearly seven years after the date of the patent the specification having been corrected, the enrolment was by order of Sir *John Leach*, the Master of the Rolls, altered so as to make it conformable with the altered specification.

Redmund's case.

So in *Whitehouse's* case (*n*), it appeared that in the original specification the word "wire" was by mistake substituted for the word "fire," and was so enrolled. Nearly five years afterwards, and of course long after the expiration of the time within which the patentee was bound to enrol his specification, the mistake in the specification was corrected, and the enrolment of it altered accordingly, by order of Lord *Gifford*, the then Master of the Rolls.

Whitehouse's case.

Similar alterations were also made in *Rubery's* case (*o*), in *Green's* case (*p*), in *Faulkner's* case (*q*), in *Fisher's* case (*r*), and in several others.

Other cases.

In *Sharp's* case (*s*), Lord *Langdale*, M. R. said, speaking of these cases of amendment, or rather alterations:—"In every case which has occurred, it has plainly been intended to do no more than amend mere slips or clerical errors made by the parties, or the agents of the parties, who, intending to make an accurate enrolment, have, by mere inadvertence,

Sharp's case.

(*m*) 5 Russ. 44.
(*n*) 1 Webs. R. 649, n. (*m*).
(*o*) *Ibid.*
(*p*) 13 Jan. 1830.
(*q*) 15 April, 1836.
(*r*) 17 August, 1836.
(*s*) 1 Webs. R. 646.

made an enrolment which was not what it purported to be, a true statement of that which the party intended at the time; and not only has strict evidence of error been required, but in in order to enable any third party to dispute the validity of the amendment, and of the order, it has been directed that the order itself should be indorsed on the enrolment."

Observations upon cases.

It seems however that in making these orders, some objections to them have been lost sight of. The proviso in a patent which requires the specification, makes it necessary that the patentee should do two things, which are perfectly distinct from each other. He must firstly ascertain and describe the nature of his invention, and the manner of using it, by an instrument under his hand and seal, and that he must do within the time limited in the proviso. He must also, within the same time, cause that instrument to be enrolled or entered upon the rolls of the Court for the benefit of the public. These two things are perfectly separate and distinct; and in actions at Law issues are frequently taken separately upon each of them (*s*). When the fact is put in issue, the patentee must show that he had made a sufficient specification within the time limited by the patent, and that quite independent of the question respecting the enrolment. If the patentee has made a sufficient specification within due time, it is unnecessary to alter it; and if the specification was not sufficient, then the patentee has not complied with the proviso, and his patent is void. But it is a principle in Law that a record cannot be contradicted, so far at least as it alleges an act done by the Court; and a record must always be presumed to have been in the same state ever since it was made (*t*) It may therefore appear in a case such as those alluded to, that a sufficient specification was enrolled on a certain day, and if so, no person can be permitted to deny the record in that respect, even if the specification itself, and also the enrolment of it, were ever so vicious, until long after the time limited for the enrolment had elapsed. And the indorsement upon the roll of the order under which an alteration may have been made will not in any way assist a person who may desire to object to the en-

(*s*) Vide *post*, Chap. X. s. 2, and the forms of pleas in the Appendix, Chap. II. s. 4.

(*t*) See Com. Dig. tit. Record, (A), (E).

rolment, for the order forms no part of the record; and it would be contrary to all principle to allow a record to be contradicted or varied by anything which is not of as high a nature as itself. By allowing such an amendment as this, therefore, it seems that a patentee is enabled by the record to prove the performance of part of the condition contrary to the fact, and the opposite party is estopped by the record from denying what the record thus untruly alleges.

The Court has no jurisdiction whatever to alter the specification itself, any more than this or any other Court of Common Law can alter or amend a deed between parties (*u*); and not only is there nothing to amend by in such a case (*x*), but the amendment is made contrary to the fact.

Such alterations seem not to have been permitted without considerable doubt; for it will be seen from the observations of Lord *Langdale*, M. R., in *Sharp*'s case (*y*), that the object in authorizing such alterations has been, to allow patentees to make them at their own peril, and under the (at least questionable) presumption that the indorsements upon the rolls would enable other parties to show the real state of the facts. Doubts respecting such alterations.

Courts of Record have long exercised jurisdiction in making such alterations and amendments in their records as may be necessary for the purpose of relieving parties who may be prejudiced by any act of the Courts, or of their officers.

Thus a judgment may be signed *nunc pro tunc* when a judgment has been delayed by the act of the Court, but not if the delay has arisen from the act of the parties (*z*). And the same reason entitles a patentee to have the enrolment of his specification corrected if erroneously prepared by the mistake or neglect of an officer of the Court, but not where the error has arisen from his own negligence.

These observations are made with the utmost deference to the very eminent Judges who have allowed alterations to be made; and with respect to the law, as the writer humbly conceives it to be, not as it ought to be. There can be no question that the Master of the Rolls ought to be authorized

(*u*) See the case of *Steel*, demandant, *Clenell*, tenant, and *Benn*, vouchee, 6 Taunt. 145.

(*x*) See the case of *Wynne and Another*, demandants, *Thomas*, tenant, and *Apperley and Wife*, vouchees, Willes, 563.

(*y*) Cited *ante*, p. 223.

(*z*) See Tidd's Practice, Archbold's Practice, and the other books of practice.

to allow such alterations to be made, and all doubt on the subject ought to be set at rest by the Legislature.

Enrolments of disclaimers and memorandums.

Disclaimers and memorandums of alteration under the statute 5 & 6 Will. IV. c. 83, sec. 1, must be enrolled in like manner as specifications; and most of the observations which have been made respecting the enrolments of specifications, are also applicable to the enrolments of disclaimers and alterations.

Disclaimers and memorandums of alteration not records.

Disclaimers and memorandums of alteration are, in pursuance of the statute just mentioned, filed with the Clerk of the Patents; but as the statute does not direct them to be filed *of record*, it seems that they cannot be considered as records of the Court of Chancery.

Can only be amended by the leave of the Attorney-general and the Lord Chancellor or Master of the Rolls.

A disclaimer or memorandum of alteration could not be altered or amended without the order or consent of the Attorney or Solicitor-general; and as the document is filed with the Clerk of the Patents, who is an officer of the Court of Chancery, it seems that no alteration or amendment of it ought to be made without the order or consent of the Lord Chancellor or Master of the Rolls.

Master of the Rolls may amend the enrolment.

The Master of the Rolls has jurisdiction to amend the enrolment of a disclaimer or memorandum of alteration, so as to make the enrolment correspond with the document itself; but he has no authority to alter it in any other way. Nor has the Master of the Rolls jurisdiction to order a memorandum of alteration which has been enrolled in pursuance of the statute to be taken off the file, or to order the enrolment of that document, or any part of it, to be expunged from the records of the Court.

No jurisdiction to order disclaimer or memorandum to be taken off the file or expunged from the roll.

Sharp's case.

Master of the Rolls no jurisdiction to remove a memorandum of alteration from the rolls of the Court.

Thus in *Sharp's* case (*z*), application was made to the Master of the Rolls to remove from the rolls of the Court a memorandum of alteration which had been enrolled under the provisions of the statute, in pursuance of the fiat of the Solicitor-general. It was contended that the effect of the memorandum was to extend the right granted by the patent, and that it was therefore contrary to the statute and *void*. Lord *Langdale*, M. R., however decided that the memorandum was to be considered as part of the specification, and that he had no jurisdiction to make the order which was prayed for.

(*z*) 3 Beavan, 245; and 1 Webs. R. 641.

CHAPTER IX.

OF THE NATURE OF THE RIGHT OR PROPERTY OF AN INVENTOR IN HIS INVENTION, AND THE DISPOSITION THEREOF.

SEC. I.—*Of the Nature of the Right or Property.*
II.—*Of Assignments in Fact and in Law.*
III.—*Of Licences.*
IV.—*Of Surrenders.*

SECTION I.

Of the Nature of the Right or Property of an Inventor in his Invention.

Inventor's right to his invention.

It has frequently been contended that every person has as much natural and moral right to the produce of his mental exertions, as to the profits of his corporeal labour or industry. The subject was much discussed in the copyright case of *Millar* v. *Taylor* (*a*), to which the reader is referred. The composition of a literary work is not, however, quite analogous to the invention of a new manufacture. The author of a literary work, it may correctly be said, actually *creates* the work which is the produce of his labour; he does not merely invent or discover it, for it could not have any previous existence. An author, therefore, may very fairly contend that he has a natural right of property in his work, and the law gives him an exclusive copyright as a reward for his labour, *without the aid of any grant from the Crown.* But a person who invents or discovers any new manufacture, merely discovers an art of practically applying some of the laws of nature in the manufacture or production of articles of commerce. The laws or principles which an inventor thus ap-

Difference between the author of a literary work and an inventor.

An author creates the produce of his labours.

An inventor discovers that which before had existence although unknown.

(*a*) 4 Burr. 2303.

plies must have had existence, and must have been capable of the practical application invented, prior to the discovery being made; although, perhaps, both the laws or principles themselves, and the particular application of them, may have been unknown to the world.

An inventor does not create, but only finds out something which had prior existence.

An inventor, in fact, does not create, but only invents or finds out something which had a prior existence, although unknown to the world, in precisely the same way as persons make discoveries in geography and astronomy. If Milton had not written "Paradise Lost," it is extremely improbable that it would ever have been written at all. But if Watt had never published his invention, it would most probably have been discovered, long ere now, that a condensing steam-engine is worked with more economy when the steam is condensed in a separate vessel, and not in the cylinder.

Inventor has no right independent of a grant.

The expediency of encouraging persons to make discoveries in the useful arts and manufactures cannot for a moment be doubted; but an inventor has no right, independent of a grant made to him by authority of a positive law, to prevent other persons from using an art or making any particular application of the laws of nature, merely because he was the *first* person to discover the art or application which he claims as his invention.

No natural right to prevent any other person from *making* and using the invention.

No inventor can, in fact, have any natural right to prevent any other person from *making* and using the same, or a similar invention, and therefore the law does not recognize any right or property whatsoever in an invention which is not made the subject of a grant by patent.

Inventor may keep his discovery secret.

It is true that an inventor may keep his discovery secret from all the world, and if he can he may use it in secret for his own advantage and profit.

Few inventions can be profitably used in secret.

But few arts or inventions are of such a description as to be capable of being profitably used in secret so as to prevent them from becoming known to the public. Sooner or later an invention will either be divulged by persons employed by the inventor, or be detected by an examination of its results or products which the inventor must vend for the purpose of making his invention profitable.

The law does not deprive an

The law does not deprive an inventor of any advantage he may obtain from the secret use of his invention, but it will

not recognize anything like a right of property in his invention, nor will it interfere to prevent others from using the invention, if they obtain a knowledge of it without being guilty of any breach of trust.

Inventor of the right to a secret use of his invention, but will not recognize any property in it.

The law in fact says, that in order to acquire any right or privilege in an invention, such as can be recognized or protected, an inventor must give the public the benefit of the invention after a certain time. But if once the inventor rejects the advantage which the law holds out to him in the shape of a temporary privilege, and uses his invention for his own profit, he can never afterwards acquire any right or property in his invention which the law will protect or recognize (*b*).

To acquire a right, an inventor must give a consideration to the public.

In the case of *Canham* v. *Jones* (*c*), a bill was filed in Chancery by the plaintiff as proprietor of a recipe for preparing Velno's Vegetable Syrup, which it was stated had been purchased by Mr. Swainson, and bequeathed to the plaintiff. The bill prayed for an injunction to restrain the defendant from selling an article under the same name as the plaintiff's. The defendant demurred to the bill, and Sir *Thomas Plumer*, V. C., in giving judgment, said, "This bill proceeds upon an erroneous notion of exclusive property, now subsisting in this medicine, which Swainson having purchased, had a right to dispose of by his will; and, as it is contended, to give the plaintiff the exclusive right of sale of. If this claim of monopoly can be maintained without any limitation of time, it is a much better right than that of a patentee; but the violation of right, with which the defendant is charged, does not fall within the cases in which the Court has restrained a fraudulent attempt by one man to invade another's property,—to appropriate the benefit of a valuable interest in the nature of good-will, consisting in the character of his trade or production, established by individual merit; the other representing himself to be the same person, and his trade or production the same, as in *Hogg* v. *Kirby* (*d*), combining imposition on the public with injury to the individual. This is not that sort of case. The observation is correct, that the bill stating the defendant's medicine to be spurious, asserts it not to be the

Canham v. Jones.

No exclusive property in a medicine.

(*b*) See *Morgan* v. *Seaward*, 2 M. & W. 559.

(*c*) 2 Ves. & B. 218.

(*d*) 8 Ves. 215.

same as the plaintiff's. The defendant does not hold himself out as the representative of Swainson, setting up a right in that character to the medicine purchased by him; but merely represents, that he sells not the plaintiff's medicine, but one of as good a quality. He is perfectly at liberty to do so. If any exclusive right in this medicine ever existed, it has long expired. The foundation of this bill therefore, the exclusive right asserted by the plaintiff, failing, all the consequential relief falls with it; and the demurrer must be allowed."

Newberry v. James.

In the case of *Newberry* v. *James* (*e*), it appeared from the bill filed in the Court of Chancery, that by certain articles of agreement between Dr. James, the inventor and proprietor of certain pills for the gout, rheumatism, &c., and Newberry the plaintiff's deceased father, it was agreed that James should prepare the aforesaid pills, and sell and deliver them to Newberry at a certain rate, to supply his customers, and that James should not sell any of such medicines to any other person except in the course of his private practice. Newberry was also to be instructed in the secret of preparing the pills, but it was not to be disclosed by him except to his representatives after his death. It also appeared that letters patent had been granted in 1747, to James, for the exercise of his invention; and that James had assigned to Newberry, his executors, &c., one moiety of the invention during the term of fourteen years. The agreement contained in the articles was to be continued so long as either of the parties, their executors, &c., or any or either of them, should desire. Newberry bequeathed to the plaintiff all his interest in the preparing and vending the medicines. The defendants had succeeded to the rights of James who died in 1776. The bill prayed a specific performance of the agreement, and an injunction to restrain the defendants from disclosing the secret of preparing the medicines except to the persons mentioned in the agreement. An injunction was granted *ex parte*, only as to the sale of the medicines, expressly without prejudice to any question that might be made as to the possibility of sustaining such an injunction. On a motion to dissolve the injunction, Lord *Eldon*, L. C., said, "That the difficulty in such a case was, how

Equity cannot decree the

(*e*) 2 Mer. 446.

to decree the specific performance of the agreement. Either it was a secret, or it was none. If a secret, what means did the Court possess, of interfering so as to enforce its own orders? If none, there was no ground for interfering. In this case, the medicines in question were the subject of a patent which had expired; and the agreement which the bill sought to enforce was an agreement by which, independently of the patent, the proprietors had entered into covenants not to sell that which was the subject of the patent except to each other. But in order to support a patent, the specification should be so clear as to enable all the world to use the invention so soon as the term for which it has been granted is at an end." Lord *Eldon* concluded by saying that "He thought he ought not to continue the injunction; and that, if he did not mention the case again, (which he did not do,) his opinion must be considered to be that the injunction must be dissolved."

Specific performance of a contract to sell a secret invention or prevent the disclosure of it.

In the same case a similar agreement had been made between James and the plaintiff respecting an invention by James of certain pills called Analeptic Pills, but for which no patent had been obtained. Lord *Eldon* remarked, that "With regard to the Analeptic Pills, if the art and method of preparing them were a secret, what signified an injunction, the Court possessing no means of determining, on any occasion, whether it had or had not been violated? The Court of Chancery could do nothing but put the parties in a way to try their legal rights by an action. That was the utmost extent to which it would go, and he would not even order the injunction to be continued in the mean time, till an action should be tried. The only way by which a specific performance could be effected would be by a perpetual injunction; but this would be of no avail, unless a disclosure were made to enable the Court to ascertain whether it was or was not infringed; for if a party comes here to complain of a breach of injunction, it is incumbent on him first to show that the injunction has been violated."

Same case.

Injunction to restrain publication of a secret would be useless. The Court has no means of determining whether it has been violated.

In the case of *Williams* v. *Williams* (*f*), the plaintiff in his bill (filed in Chancery) stated that he had intrusted the defendant (his son) with a secret of making a medicine. Upon a motion to dissolve an injunction which had been obtained, Lord *Eldon*, L. C., said, "So far as the injunction

Williams v. Williams.

(*f*) 3 Mer. 157.

goes to restrain the defendant from communicating the secret, upon general principles, I do not think that the Court ought to struggle to protect this sort of secrets in medicine. The Court is bound indeed to protect them in cases of patents to the full extent of what was intended by the grant of the patent, because the patentee is a purchaser from the public, and bound to communicate his secret to the public at the expiration of the patent. Then whether the principle can be extended to such a case as this—whether a contracting party is entitled to the protection of the Court in the exercise of its jurisdiction to decree the specific performance of agreements, by restraining a party to the contract from divulging the secret he has promised to keep, that is a question which would require very great consideration. But the present case is not one which calls for the determination of it. If the defendant has already disclosed the secret, the injunction can be of no use. If he only threatens to disclose, it then becomes necessary to look at his affidavit; and by that he insists that what he has to disclose is no secret at all—then how is the Court to try this question? Or what can the Court do with the case altogether?" And his Lordship dissolved the injunction.

Patentee ought to be protected because he is a purchaser from the public.

Whether a party is entitled to protection by restraining a party to a contract from divulging a secret, *quære*.

In the case of *Yovatt* v. *Winyard* (*g*), a motion was made for an injunction to restrain the defendant from making use of or communicating certain recipes for veterinary medicines, and from printing and publishing certain papers of directions for the mode of administering them. The plaintiff who was the proprietor of the medicines had employed the defendant as an assistant under an agreement, by which he was to be instructed in the general knowledge of the business, but was not to be taught the mode of composing the medicines; afterwards the defendant left the plaintiff, and the latter had lately discovered that he had while in his service surreptitiously got access to his book of recipes and copied them, and was selling the medicines with printed papers for administering them, which were almost literal copies of those composed by the plaintiff. Lord *Eldon* granted the injunction upon the ground of there having been a breach of trust and confidence; but confined it, so as not to prevent the defendant from adminis-

Yovatt v. Winyard.

When there has been a breach of trust respecting a secret medicine, the Court of Chancery will grant protection.

(*g*) 1 Jac. & W. 394.

toring the medicine to any animals then under course of treatment, it being stated in the papers of directions, that a sudden discontinuance would be prejudicial.

Inventor no property except under a patent.

It appears from the cases which have been used, that an inventor has no property in his invention; and has no interest in it, which can be recognized by law, except under a patent grant, or for the purpose of obtaining such a grant.

Inventor may maintain an action for breach of an agreement respecting an invention, *for which he intende to take a patent.*

Smith v. Dickenson.

Although an inventor has no property in his invention except that which is given him by the Patent Law, yet he has such an interest in his invention *for which he proposes to take out a patent*, as to enable him to maintain an action for a violation of a contract respecting it. Thus in the case of *Smith* v. *Dickenson* (*h*) an action was brought upon an agreement by the defendant, not to avail himself of or to take any undue advantage of a communication made to him by the plaintiff, of an invention for which the plaintiff intended to take out a patent. It appeared that the defendant had committed a breach of the agreement by fraudulently obtaining a patent for the invention in his own name; and the Court of Common Pleas held that the plaintiff was entitled to recover damages against the defendant for this breach of the agreement.

Subject of a patent grant is a privilege.

It has already been shown (*i*), that the subject of the grant by patent of an invention, is the sole right or exclusive privilege to use the invention, and which must be a new art of manufacturing vendible articles or commodities.

Privilege has existence only by force of the patent.

The privilege which a patent thus confers upon an inventor, has existence merely by force of the patent, which, in fact, creates the right, as well as grants it to the patentee.

Is of an incorporeal nature.

Such a privilege is of an incorporeal or metaphysical nature, exists merely in idea and abstracted contemplation, and entirely apart from all physical and corporeal existence whatsoever. It is, in fact, a mere naked right, which if the patent itself did not make assignable, would be inseparable from the person of the grantee (*k*). It may properly be defined to be an incorporeal chattel, which the patent impresses with all the characters of personal estate, by limiting it to the grantee, his executors, administrators, and assigns.

Incorporeal chattel.

(*h*) 3 B. & P. 630.

(*i*) *Ante*, Chap. IV. p. 53, and Chap. V. s. 1, p. 78.

(*k*) See the judgment of *Littledale*, J., in *Duvergier* v. *Fellows*, 10 B. & C. 829.

Section II.

Of Assignments of Patent Rights in Fact and in Law.

The right or privilege granted by a patent is of a personal nature, and but for an express provision in the patent, by which it is granted, it would be inalienable (*l*). Thus in the case of *Duvergier* v. *Fellows* (*m*), Mr. Justice *Littledale* said, that such a privilege cannot be assigned at all unless power to that effect is given by the Crown.

Limitation of the privilege.

A patent privilege in an invention is always granted to the patentee, his "executors, administrators, and assigns." The words "executors, administrators, and assigns" are words of limitation, which communicate an assignable quality to the privilege granted by the patent.

The words of limitation make the privilege assignable.

Patent may be assigned either by deed or by act of law.

A patent privilege may be assigned either by the act or deed of the patentee himself, or by act and operation of law.

Assignment by act of the patentee must be *by deed.*

The patent makes no provision as to the form or manner in which assignments may be made of the privilege which it grants. But it seems clear that an inventor cannot assign or grant over his patent privilege except by deed. For it is a privilege of such a nature as cannot be granted without deed (*n*); and the rule of law is, that things which can only be granted or created by deed, can only be assigned by deed (*o*).

Patent requires licences to be under seal.

The patent requires that licences granted by the patentee shall be under his hand and seal (*p*), and it seems difficult to avoid coming to the conclusion that an assignment is intended to be made in at least as solemn a manner as a licence.

Power *v.* Walker.

Lord *Ellenborough*, C. J., said in the case of *Power* v. *Walker* (*q*), respecting the assignment of a copyright, "if the licence which is the lesser thing must be in writing, *a fortiori*, the assignment which is the greater thing must also be" (*r*).

If licence must be under seal, *a fortiori*, an assignment must be so.

(*l*) Br. Abr. Franch. pl. 38; Shep. Touch. 239, 240; see the preceding section of this Chapter, *ante*, p. 233.

(*m*) 10 B. & C. 829; and see the observation of *Dampier*, J., in *Power* v. *Walker*, 3 M. & S. 9, as to the assignment of a copyright.

(*n*) Co. Lit. 9, b. 172, a.; Shep. Touch. 229-231.

(*o*) 3 Co. R. 63, a. *Lincoln College* case.

(*p*) Sed vide *Chanter* v. *Dewhurst*, 8 M. & W. 823.

(*q*) 3 M. & S. 9.

(*r*) The stat. 8 Ann. c. 19, requires that licences to use copyrights shall be in writing.

The same principle seems to be clearly applicable to assignments of patent rights; and as the patent requires a licence to be granted under hand and seal, that is by deed, the conclusion seems almost irresistible that an assignment must also be made by a deed or instrument under hand and seal.

No particular form of assignment.

Although an assignment of a patent right by the act of the patentee himself must be made by deed, there is no particular form of words necessary in order to effect the transfer of the right (*s*); the ordinary rule of law respecting the construction of deeds being, "that the construction be favourable, and as near to the minds and apparent intents of the parties as possible it may be and law will permit" (*t*).

Cartwright *v.* Amatt. Covenant to assign may amount to an assignment.

Thus, from the case of *Cartwright* v. *Amatt* (*u*), it seems that a covenant to assign a patent upon the happening of a given event, will as soon as the event happens amount to an actual assignment of the patent.

No limit as to the persons who may assign.

There is no limitation contained in a patent as to the persons who may exercise the power of assigning, and therefore a patent right may be assigned not only by the patentee himself, but also by any person who may become entitled to it as assignee.

A condition in the patent limits the number who may be entitled to the privilege.

But every patent contains a condition limiting the number of persons who may *at any one time* become legally entitled to the privilege which it grants. The condition formerly contained in patents restrictive of assignments was much more stringent than that which has been adopted for some years past.

The condition formerly allowed only five persons to be interested, but now extends to twelve.

By the old condition the patent was declared to be void in case of any assignment to more than five persons; but the condition now always inserted permits assignments to be made to twelve persons. The old form also provided that the patent should become void for many causes respecting which patents are now silent (*x*).

Effect of condition now inserted in patents.

The condition now inserted in patents provides, that if the patent, or the liberties and privileges thereby granted, shall become vested in, or in trust for more than twelve persons, or their representatives, at any one time, as partners dividing

(*s*) See Forms in the Appendix, Chap. II.

(*t*) Shep. Touch. 86, 83, and the authorities there cited.

(*u*) 2 B. & P. 43.

(*x*) See the present form of condition, *ante*, Chap. IV. p. 66.

or entitled to divide the benefits or profits obtained by reason of the patent (reckoning executors or administrators for the single person they represent) then the patent is to be void.

Object of the condition.

This condition seems to be inserted with the object of preventing a patent from being made the means of creating an oppressive monopoly by a large number of persons associating together for the purpose of working the patent privilege. By this clause in a patent it seems that the patentee is not prevented from assigning to more than twelve persons if the assignees do not become entitled to the profits arising from the patent *as partners*, for if the assignees are entitled severally, and work the patent privilege independent of each other, and not as partners, there will be such a competition amongst them, that the public will be protected, and will not suffer from the effects of any monopoly.

Assignment to more than twelve only vitiates the patent if they become entitled as partners.

If the condition is violated, the patent becomes void.

If a patent right is once dealt with contrary to the condition upon which the patent is granted, it is clear that the privilege is not merely suspended, but becomes absolutely void and can never afterwards be enforced. And if the parties, who were possessed of a patent right, which has become void by reason of a violation of the condition respecting assignments, attempt to enforce it by action in a Court of Law, the defendant may plead that the patent has been avoided as a defence to the action (*y*).

Patentee cannot, after assignment, contest the validity of the patent.

The patentee or assignor of a patent (which we have seen can only be assigned by deed) cannot, after the assignment, be permitted to contest the validity of the patent, for he is estopped by his deed [illegible]terwards denying its validity (*z*). The doctrine of estoppel as applicable to such cases, was much discussed in the case of *Bowman* v. *Taylor* (*a*), to which, and the cases there cited, the reader is referred.

Bowman v. Taylor.

Covenants for title.

Upon the assignment of a patent right, the person making the assignment usually enters into covenants with the assignee respecting his title, and the validity of the patent; and if the deed does not contain any express covenant on the subject, it seems that a covenant for title on the part of the assignor will not be implied from the words, "bargain, sell, and as-

(*y*) *Durergier* v. *Fellows*, 5 Bing. 218; *S. C.*, in error, 10 B. & C. 826.

(*z*) *Oldham* v. *Langmead*, cit. 3 T. R. 439; *Bowman* v. *Taylor*, 2 A. & E. 278.

(*a*) 2 A. & E. 278.

sign," contained in the operative part of the instrument (*b*). For the law will not create any covenant respecting anything merely of a personal nature.

Parties making assignments ought therefore to have covenants for title inserted according to their intent, and see that they are restricted or unrestricted in such a manner as may be actually agreed upon.

Hesse v. Stevenson.
Effect and construction of covenants for title.

In the case of *Hesse* v. *Stevenson* (*c*), it appeared that the assignor of certain shares in a patent entered into a covenant with the assignee, that he had good right, full power, and absolute and lawful authority to assign and convey the shares; and that he had not by any means directly or indirectly forfeited any right or authority he ever had or might have had over the shares; and it was held that the generality of the former words in the covenant were not restrained by the latter words, and therefore the want of title in the assignor was a breach of the covenant, although the defect was not occasioned by any forfeiture committed either directly or indirectly by the assignor.

Assignments by act and operation of law.

Assignments by act and operation of law take place where a person becomes entitled to a patent privilege without any deed of conveyance from the person to whom he succeeds, or under whom he claims.

Words of limitation in a patent.

The form of a patent itself expressly provides that the devolution of the patent right shall be to the patentee, his executors, administrators, and assigns. These words of limitation make the patent right an assignable chattel interest, assignable by act and operation of law, in the same manner as any other chattel. In case of the death of the patentee or his assignee, the privilege descends to his executor if he made a will, and if not, then to his administrator, as an assignee in Law.

In case of patentee's death the privilege vests in his executor or administrator.

The limitation makes the privilege assignable.

A patent does not mention all the cases in which persons may become assignees in law; but the words executors, administrators, and assigns, which are added after the name of the patentee, and which are clearly words of limitation, sufficiently indicate the intention of the Crown that the patent privilege is to be of an assignable nature; and the law im-

(*b*) See Bac. Abr. tit. Covenant (B.) Ro. Abr. 519, l. 49.
(*c*) 3 B. & P. 565.

plies therefore that it is to be assignable either by deed or in law, in the same way as other chattel interests.

Patent of a bankrupt or insolvent patentee passes to his assignees.

If therefore the owner of a patent privilege becomes bankrupt, his assignees become entitled to the property by virtue of their appointment (*d*). So if he takes the benefit of the Act for the Relief of Insolvent Debtors, all his right will vest in the assignee appointed by the Court for the relief of insolvent debtors. And if a patentee after his bankruptcy, but before he obtains his certificate, obtains a patent for an invention, the right to it vests in the assignees appointed under his previous bankruptcy (*e*).

Section III.

Of Licences.

Doubtful whether licences could be granted without a power in the patent.

We have already seen (*f*) that a patent right would not be assignable, but for an express provision contained in the patent itself. It may be questionable whether a patentee would have authority to grant licences if there was no express power in the patent enabling him to do so, but the patent does in fact contain such a power.

Patent grants the sole privilege to the patentee, his executors, &c. and prohibits all others from using the invention without licence.

The patent grants (*g*) unto the patentee, his executors, administrators, and assigns, the especial licence, full power, sole privilege, and authority, that he and they, *or such others as he or they shall agree with*, and no others, shall use, exercise, and vend the invention; and immediately after the grant a prohibition is inserted in the patent (*h*), which commands all persons that they shall not, during the term granted by the patent, either directly or indirectly, make, use, or put in practice the invention, or any part of it, nor in anywise counterfeit, imitate, or resemble the invention, nor make, nor cause to be made, any addition to, or subtraction from, the invention, whereby to pretend themselves the inventors or devisors thereof, *without the consent, licence, or agreement* of the patentee, his executors, administrators, or asssigns, *in writing, under his or their hands and seals*, first had and obtained.

(*d*) See *Hesse* v. *Stevenson*, 3 B. & P. 565; *Bloxam* v. *Elsee*, 6 B. & C. 169; 1 C. & P. 558, *S. C.*

(*e*) *Hesse* v. *Stevenson*, 3 B. & P. 565.

(*f*) *Ante*, p. 234.

(*g*) Vide *ante*, p. 52.

(*h*) Vide *ante*, Chap. IV. p. 59.

The power of granting licences is thus expressly conferred upon a patentee, and those claiming under him. And provision is made that the power shall be granted only in a particular manner, that is under hand and seal. Every instrument under hand and seal is not a deed, but as the patentee must by the instrument make a GRANT of an authority or permission, it seems that a *deed* must be intended.

Power of licensing thus granted to be executed by deed.

In the recent case of *Chanter* v. *Dewhurst* (*i*), it was held by some of the Judges that a licence must not be under seal. Mr. Baron *Parke*, however seems to have entertained some doubt, but it was not necessary to decide the point.

Chanter v. Dewhurst.

Under the old form of condition against an assignment to more than five persons, it was considered doubtful whether a grant of a licence to more than five persons was not such an assignment, within the meaning of the condition, as would avoid the patent (*k*). In order to obviate this doubt a clause is now inserted in all patents, whereby it is provided, that nothing therein contained shall prevent the granting of licences in such manner, and for such considerations, as they may by law be granted (*l*).

Old form of condition.

Clause now inserted respecting licences.

A licence to use an invention comprised in a patent is in fact a grant of a right by the patentee to the licensee (*m*); and during the time it is in force, it exempts the licensee either from the whole or some portion of the prohibition contained in the patent, and enables him to exercise the whole or some particular part of the privilege granted by the patent.

Licence to use an invention is a grant.

Licences are sometimes granted generally, and therefore include a right to use every part of the patent privilege, but they are frequently granted in a restricted form.

Various kinds of licences.

Thus, a licence may be granted so as to continue in force during the whole of the term mentioned in the patent, or for any shorter term. So it may extend over all parts of the realm comprised in the patent, or it may be restricted to some particular district or districts. And a licence may be granted so as to entitle the licensee to use the whole of the invention,

(*i*) 12 M. & W. 823.

(*k*) See 6 Jarm. Byth. Conv. 188, n. (*a*).

(*l*) Vide *ante*, Chap. IV. pp. 66, 68.

(*m*) See respecting the difference between a licence and a grant, 15 Vin. Abr. tit. Licence (A).

or only some particular portion of it, or to use it only for some particular purpose.

Licences revocable or irrevocable.

Licences are sometimes made revocable, and are sometimes expressed to be irrevocable. If a licence be granted generally, without expressing it to be irrevocable, it may be doubtful whether it could be revoked or not (*n*). But if, from an examination of the whole of the instrument, it appears that the parties must have intended the licence to be irrevocable, the licensee would be entitled to retain his licence notwithstanding any attempt by the patentee to revoke it.

Revocation how to be made.

The revocation of a licence, it seems, ought to be by instrument under the hand and seal of the patentee, for it is a general rule that a deed cannot be altered or varied except by deed (*o*). But that does not prevent the parties to a licence from providing for the determination or cessor of the licensee's privilege, either by notice, or in any other manner, without the solemnity of a deed.

Exclusive licence.

An exclusive licence is sometimes granted by a patentee for the whole or some particular part of the invention, and for the whole or some particular part of the kingdom comprised in the patent. Such a licence vests in the licensee the sole right to exercise the patent privilege, or that particular part of it to which the licence extends.

Usually contains a covenant not to grant any other licence, &c.

Doubtful whether it divests the patentee of power to grant a licence inconsistent with it.

An exclusive licence usually contains a covenant by the patentee, that he will not grant any other licence to interfere with the licensee's privilege. But it is doubtful whether such a licence or covenant divests the patentee of all power to grant a licence contrary to his covenant, although he would clearly render himself liable to an action, if he were to grant a licence contrary to his covenant.

Exclusive shows that licensee is to have the sole right.

Unless the patentee retains a right to use the invention himself, an exclusive licence for the entire term of the patent shows that the parties to it intended the licensee to have the *sole* right to exercise either the whole or some particular portion of the privilege comprised in the patent; and also, that the patentee should not have power to grant any other licence to use the

(*n*) See *Wood* v. *Ledbitter*, 9 Jur. 187.

(*o*) See Noy, Max. p. 4, dial. ten, p. 45; *Winter* v. *Foweracres*, 2 Rol. R. 39; *Thompson* v. *Brown*, 7 Taunt. 656, and the cases there cited.

patent privilege, or the portion of it which is comprised in the licence.

The whole of the patentee's interest in the patent privilege, or in a particular portion of it, is therefore intended to be vested in the licensee; and if there is nothing in the licence to indicate an intention to the contrary, it would seem that the instrument ought to be construed as amounting to an assignment of the whole or of that part of the patent privilege which is comprised in it.

If the whole of patentee's interest is vested in the licensee, the licence will amount to an assignment.

And if the licence contains no reservation to the patentee, or any condition to avoid the licence, the sole right vested in the licensee must have been intended to be indefeasible, and there would be nothing which could render it necessary that the patentee should continue even in the nominal possession of the patent privilege, or of that part of it which is comprised in the licence.

If there is no reservation, it is unnecessary that patentee should continue possessed of the privilege.

It seems that such an exclusive licence operates as a grant of the whole, or of some particular part, of the patent privilege; and that it amounts to an assignment to the licensee, in the same way that a demise by a lessee of the premises comprised in his lease for the whole of the term granted to him, amounts to an assignment to the under lessee (*p*). For an assignment is a transfer or making over to another of the whole right of the assignor in the thing transferred (*q*); and any words which show a sufficient intent to transfer that part of the patent privilege would be sufficient to cause an instrument to operate as an assignment (*r*).

An exclusive licence seems to operate in the same way as a demise by a lessee for the whole of his term.

It was determined in the case of *Protheroe* v. *May* (*s*), that an exclusive licence granted to more than twelve persons does not invalidate the patent under the condition against assigning to more that twelve persons. But there were reservations to the licensees made by the licence in that case, and also provisoes for determining the licence, from which it is to be inferred that the parties did not intend the instrument to operate as an assignment, and if it did not operate as an assignment, it could not affect the validity of the patent. The reservation of a sum of 2*l.* for every ton of soap made by the

Protheroe v. May.

Exclusive licence to more than twelve persons will not avoid a patent if the licence does not amount to an assignment.

(*p*) See *Palmer* v. *Edwards*, 1 Doug. 187, n.; *Parminter* v. *Webber*, 8 Taunt. 593; 2 B. Mo. 656; Shep. Touch. 266.

(*q*) 2 Bl. Com. 326.

(*r*) Vide *ante*, s. 2, p. 235.

(*s*) 5 M. & W. 675.

licensees in that case *during the continuance of the licence*, shows that the intent of the parties was, that the instrument should operate as a licence and not as an assignment; and indeed the payments to be made by the licensees, shows that they were not to be entitled to divide the profits to be obtained by reason of the patent, in such a way as to bring them within the meaning of the condition against an assignment to more than twelve persons.

An exclusive and irrevocable licence to more than twelve persons, extending to the whole of the privilege would be such an assignment as would render the patent void.

An exclusive and irrevocable licence to use a patent invention, and extending to the whole of the district comprised in the patent, would, it seems, amount to an assignment of the whole of the patent privilege for the reasons already given (*t*), because the licensee would obtain the whole right which was vested in the patentee. And if such a licence, or rather assignment, were made to more than twelve persons, it seems that the effect of it would be to avoid the patent (*u*).

An exclusive licence extending only to a part of the privilege would not render the patent void.

But such a licence granted only for a part of the invention comprised in the patent privilege, or for a portion of the district comprised in the patent, does not seem to be in violation of the condition in the patent, even if it should amount to an assignment, for the licensees or assignees would not be entitled to divide the profits or benefits arising from the whole of the patent privilege amongst themselves, nor would they be entitled as partners with the patentee or grantor of the licence to divide the profits arising from the privilege within the meaning of the condition in the patent.

Whether a licence can be assigned without an express power.

We have seen that the privilege granted by a patent could not be assigned unless it was made assignable by the patent itself (*x*). And it seems that the same rule is applicable to a licence granted under the authority of the patent. For a licence merely grants a power, or dispenses with a right or remedy, and therefore confers a mere personal right upon the licensee which cannot be transferred to any other person, unless the grantor in the instrument itself makes the privilege which he grants assignable.

Licences to licensees, their executors, &c., assignable.

Licences are, however, frequently granted to licensees, their executors, administrators, and assigns, and then they become of course assignable and transmissible in the same way as a

(*t*) Vide *ante*, p. 241.
(*u*) Vide *ante*, s. 2. p. 236.
(*x*) Vide *ante*, s. 2. p. 234.

patent privilege (*y*). And it would seem that the assignment of a licence, like the assignment of a patent, ought to be made by deed under hand and seal.

No restriction as to the consideration for a licence.

There does not appear to be any restriction with respect to the consideration for which a licence to use a patent privilege may be granted. A deed in itself imports a consideration (*z*), and as a licence must be granted by deed, it seems that no consideration is necessary to render it valid (*a*). Nor does the grant of such a licence seem to be within the meaning of the statutes of 13 Eliz. c. 5, and 27 Eliz. c. 4.

Consideration generally received.

A patentee, however, generally receives a consideration of some description for the grant of a licence, and frequently reserves an annual or periodical payment, either of an amount certain, or varying according to the extent to which the licensee may use the invention.

Covenants usually inserted.

A licence usually contains mutual covenants between the patentee and licensee. If a consideration is paid for the licence the patentee usually enters into covenants respecting his right to grant the licence, and frequently also respecting the validity of the patent (*b*).

No covenants can be implied.

If a licence contains no express covenant by the patentee, the words give and grant usually inserted in the instrument, will not, it seems, import a covenant in law by him, that he had good right to grant the privilege expressed in the instrument, for it is laid down in our law books (*c*), that the law will not create a covenant respecting a personal thing. And the privilege granted by a patent being limited to the patentee, his executors, administrators and assigns, it has the nature of personalty impressed upon it.

Therefore, in all cases in which a licensee intends to have the benefit of covenants by the patentee for his title to grant the licence, care should be taken to insert express covenants to the effect intended by the parties (*d*). And in some cases licensees are fairly entitled to such covenants, especially where

(*y*) As to the assignment of a patent, see in this Chap. s. 2, p. 234, *ante*.

(*z*) See Plowd. 308.

(*a*) The proviso in a patent, stated, *ante*, p. 66, declares that nothing in the patent contained shall prevent the granting of licences in such manner, *and for such considerations*, as they may by law be granted.

(*b*) See the Form in the Appendix.

(*c*) See Com. Dig. tit. Covenant (A 4).

(*d*) See the Form of a Licence in the Appendix, Chap. II., which contains the usual covenants for title by the patentee.

being themselves without the means of ascertaining the validity of the patent, they may, on the faith of the licence and the validity of the patent, embark considerable capital in business for the manufacture of the patent article.

Covenants by licensees.

When a licence is granted in consideration of periodical or other payments, it usually contains covenants on the part of the licensee with the patentee to pay the sums reserved. And where the payments reserved are to vary according to the extent to which the licensee shall use the privilege, the licence also contains covenants by the licensee to render accounts, to be properly verified, and sometimes to permit periodical inspections of premises, machinery, &c. And in cases where payments are reserved, and covenants are entered into by the licensees, it is usual to insert conditions avoiding the licences if the licensee shall fail to pay any of the sums reserved, or to perform any of the covenants (*e*).

Conditions for avoiding licences.

Covenants and conditions are absolutely necessary for the protection of the patentee.

The covenants on the part of the licensee and proviso for avoiding the licence, are indeed absolutely necessary for the security of the patentee in all cases where there are any payments reserved. If a licence be assignable, the licensee might after assigning his licence become insolvent or quit the country, so that the patentee could not have any remedy against him for the non-payment of the reservations contained in the licence. And as the assignee would not be bound by the covenants of the licensee (*f*), the patentee would have no remedy against him in a Court of Law, and would be driven to have recourse to a suit in Equity.

Provisions for proceedings to protect the patent.

In an exclusive licence the licensee should take care to make provision for proceedings to be taken against persons who may infringe the patent. The licensee himself could have no adequate remedy without the assistance of the patentee, unless the exclusive licence could be construed to amount to an assignment. It is usual in exclusive licences for the patentee to covenant with the licensee to proceed against persons who infringe, or to permit the licensee to do so in the patentee's name (*g*).

Licensee cannot dispute the

We have seen (*h*), that a patentee cannot, as between him-

(*e*) See the covenants in a Form of Licence contained in the Appendix.

(*f*) See 5 Co. R. 16, b, and 17, a.

(*g*) See Forms in the Appendix.

(*h*) Vide *ante*, p. 236, and the case of *Oldham* v. *Langmead*, cit. 3 T. R. 439.

self and a person to whom he has assigned his patent, be permitted to question the validity of the patent. And it has been held that the same doctrine is applicable as between a patentee and his licensee (*i*). Validity of patent.

Whenever a licence is about to be granted, the parties should determine whether the licensee is to be at liberty to question the validity of the patent or not, and care ought to be taken that the instrument is framed accordingly.

If the deed of licence contain recitals or statements which amount to admissions, that the patent is valid in any respect; such as—that the patentee was the true and first inventor, that the invention was new, or useful, or that the specification was sufficient, the licensee will be bound by estoppel not afterwards to deny that the patent is invalid for anything which is contrary to what is asserted by the deed (*k*). Licensee estopped by statements in licence.

And it does not signify whether the matter of estoppel is stated by way of recital or otherwise, if the words appear to be the words of the party who is sought to be bound by estoppel. And when a person is thus estopped or prevented from asserting anything contrary to his admission under his hand and seal, the estoppel is conclusive in a Court of Law, if properly pleaded by the other party. But if a patentee joins issue upon an allegation made by a licensee contrary to an admission in his deed, instead of pleading the estoppel, the deed will be *evidence* for the patentee, but will not as evidence be *conclusive* (*l*). Estoppel may be by recital.

A licensee who has paid an annuity in consideration of a licence, to use a patent privilege which afterwards turns out to be void, cannot however recover back the money he has paid in an action for money had and received (*m*). But if a licensee is not estopped by his deed from disputing the validity of the patent, he may, in answer to an action of covenant for money reserved by the licence, plead anything which shows that the patent is void. This was decided in the case of *Hayne* v. *Maltby* (*n*); and although some doubt was expressed Licensee cannot recover back payments he has made. But if not estopped, may dispute the validity of the patent in an action for money reserved by the licence. Hayne *v.* Maltby.

(*i*) *Baird* v. *Neilson*, 8 Cl. & Fin. 726.
(*k*) *Bowman* v. *Taylor*, 2 A. & E. 278.
(*l*) *Bowman* v. *Rostron*, 2 A. & E. 295.
(*m*) *Taylor* v. *Hart*, 1 N. R. 260.
(*n*) 3 T. R. 438.

by the Court of Queen's Bench respecting the authority of that case in *Bowman* v. *Taylor* (*o*), yet it is conceived that the only doubt is whether the defendant, in *Hayne* v. *Maltby*, was not estopped from denying the validity of the patent, not whether he might not set up the invalidity of the patent as an answer to the action in case he was not estopped.

Chanter v. Leese.

And in the case of *Chanter* v. *Leese* (*p*), it appeared that a licence had been granted to the defendants by a memorandum of agreement, (not under seal,) to use the inventions comprised in several patents, a yearly payment of 400*l.* being reserved. In an action to recover a half-yearly payment of the 400*l.*, the defendant pleaded that the invention comprised in one of the patents was not new, and the Court held the plea to be a good answer to the action. No notice seems to have been taken in that case of another ground of defence, of which the defendants might have availed themselves. The licence being by memorandum only, and not under seal, was void (*q*); and therefore the defendants had no consideration for the payment of the tribute money reserved by the licence (*r*).

A patentee ought never, therefore, to grant a licence by any instrument not under seal; because the licensee might, in answer to any action for money reserved by the patent, plead that the instrument was not under seal, and therefore void.

Section IV.

Of the Surrender of a Patent.

Patentee may surrender his privilege.

A PATENTEE or his assignee may also dispose of his patent privilege by a surrender to the Crown; and the effect would be to extinguish the privilege.

If there are several patentees or assignees, they must all join in making a surrender; but it is conceived that a joint patentee or assignee might surrender his part of the patent.

The surrender of a patent must be made by deed, enrolled

(*o*) 2 A. & E. 278.
(*p*) 4 M. & W. 295.
(*q*) But see *Chanter* v. *Dewhurst*, 12 M. & W. 823.
(*r*) See *Bird* v. *Higgenson*, 2 A. & E. 696; and *S.C.* in error, 6 A. & E. 824.

in Chancery (*s*). A surrender is of no effect until it is enrolled, even if the patent be cancelled (*t*), for the rule of Law is, that nothing can be conveyed to the Queen except by matter of record (*u*).

(*s*) See Com. Dig. Pat. (G), and the authorities there cited.

(*t*) Com. Dig. Pat. (E) (G).

(*u*) Noy, Max. p. 18, dial. ten, p. 34.

CHAPTER X.

OF THE REMEDIES FOR PATENTEES, AND FOR THE PUBLIC RESPECTIVELY.

SEC. I.—*Of the various Remedies provided by Law for Patentees and the Public.*
II.—*Of an Action for the Infringement of a Patent.*
III.—*Of a Suit in Equity to restrain the Infringement of a Patent, and obtain an Account of Profits.*
IV.—*Of an Action for Penalties for counterfeiting a Patentee's Name or Device.*
V.—*Of other Remedies for Patentees.*
VI.—*Of an Action of* scire facias *to repeal a Patent.*
VII.—*Of the Revocation of a Patent.*

SECTION I.

Of the various Remedies provided by Law for Patentees and the Public respectively.

Patent privileges worthless without legal remedies.

IT is evident that a privilege, such as that granted by a patent for an invention, would be worthless if the law did not provide some remedy for the patentee against those who may invade it. The right to any species of corporeal property may to a great extent be vindicated by the physical means at the command of the owner; but with respect to an incorporeal chattel right, such as a patent privilege, which is a mere creature of the law, the proprietor must depend almost entirely upon the law itself for vindication and support.

Patent privilege entirely dependent upon the law.

Imperfections in remedies for patentees.

It is to be regretted that the remedies which the law has provided for patentees are very imperfect, and insufficient for the protection of their rights from invasion.

Cause of imperfections.

Many of the imperfections of those legal remedies, however, have arisen from the peculiar nature of patent rights,

and the difficulty of providing adequate remedies for patentees without producing too great an invasion of the rights of the public. We have seen (*a*), how much doubt and uncertainty has prevailed as to what can be made the subject of a patent privilege, and there has been nearly as much uncertainty (*b*) respecting the degree of novelty, and the utility which an invention must possess in order to support a patent. When the existence of so much perplexity and confusion in the law respecting the nature and effect of patent privileges is remembered, it cannot be considered extraordinary that the remedies provided for patentees and the public are very far from being perfect.

Doubts respecting subject of privileges.

Many of the grievances under which patentees formerly laboured have been recently removed by the legislature (*c*), and others have ceased to exist since our Courts have begun to construe the law more liberally in favour of patentees.

Several of patentee's grievances removed.

In former times slight defects were held sufficient to avoid patents, and our Courts seemed always to look upon patent rights with the utmost jealousy. This feeling against patentees was doubtless produced by the widely spread and deeply rooted aversion to all monopolies which was engendered by the monstrous oppression practised by means of patent grants previous to the passing of the Statute of Monopolies. That statute completely suppressed all unlawful grants, and most effectually guarded the rights of the public against illegal monopolies; but notwithstanding the securities which the statute provided for the public against illegal monopolies, it is singular enough that a period of two centuries should have elapsed before the public prejudices against grants of patent privileges to inventors disappeared, and before the Judges began to determine questions respecting patent rights fairly between the patentees and the public.

Public feeling against monopolies formerly extended to patents.

Statute of Monopolies suppressed illegal grants.

Two centuries required to extinguish public feeling against patent privileges.

Our Courts now universally adopt the principle laid down by Lord *Eldon*, L. C., in the case of *Cartwright* v. *Eamer* (*d*), that a patent contains a bargain made between the public (represented by the Crown) and the patentee, to be judged of

Principle that patent a bargain to be judged of as other bargains now adopted.

(*a*) Vide *ante*, Chap. V. sec. 1, p. 77.
(*b*) Vide *ante*, Chap. V. ss. 2 & 3, pp. 102, 149.
(*c*) See 5 & 6 Will. IV. c. 83; 2 & 3 Vict. c. 67; and 7 & 8 Vict. c. 69.
(*d*) 14 Ves. 131, 136.

like other bargains. And accordingly any question which may now arise respecting the validity of a patent for an invention will be determined fairly and impartially between the parties in litigation, and without any strained or strict construction being put upon the law, or patent, in favour of or against either party.

Patents formerly failed chiefly by reason of insufficient specifications.

If the reported patent cases which have been decided in our Courts of Law are examined, it will be found that in a great majority of those which were formerly determined against patentees, the parties failed to support their patents on the ground of the insufficiency of their specifications. And, indeed, if we look at the vague and meagre descriptions of their inventions which patentees were formerly in the practice of inserting in their specifications, we cannot be surprised that our Courts should have held that those instruments did not sufficiently comply with the conditions or provisoes contained in patents by which they are required to be enrolled.

Specifications formerly very imperfect.

Specifications now much more perfect.

But the decisions of our Courts avoiding patents on the ground of insufficient specifications, have been productive of great benefit to the public, and indeed to patentees themselves. For specifications are now drawn in a manner much more perfect than they were formerly, (although there is still room for very considerable improvement), and consequently not only are the public now more frequently put in possession of the information they are entitled to receive, but patentees much less frequently fail to support their patents, on the ground of the insufficiency of their specifications.

Remedies for patentees.

The chief remedies of which a patentee may avail himself in case his privilege is invaded, are, an action at Law, and a suit in Equity, against the violators of his privilege, both or either of which he is at liberty to adopt.

Action at law.

By an action at Law a patentee may recover, from a person who has violated his patent, damages for the injury which he has sustained by the violation of his right.

Suit in equity.

In a suit in Equity, the patentee may not only compel a person who has infringed his privilege to account for all the profits which he has made by the piracy, but may also obtain an injunction, restraining the guilty party from again infringing the patent.

Action for penalties.

Patentees are also enabled by the statute of 5 & 6 Will. IV.

c. 83, s. 7, to maintain actions for penalties against those who may counterfeit any names or devices upon their patent articles.

Remedies against patentees.

The remedies which the law provides for the public against illegal patents are twofold:—*firstly*, Any one against whom proceedings may be taken by a patentee, is enabled to defeat the action or suit by showing that the patent in question is void; and, *secondly*, Any person prejudiced by an illegal patent is entitled, upon certain terms, to bring an action, called an action of *scire facias*, in the name of the Queen, against the patentee or his assignee, for the purpose of repealing the patent.

Patents always contain a proviso under which they may be avoided by the Queen or her Privy Council, if they are found to be contrary to law (*d*).

Section II.

Of an Action at Law for the Infringement of a Patent.

Infringement entitles patentee to an action for compensation.

The injury which a patentee sustains by the infringement of his patent entitles him to maintain an action at Law against the wrong doer, to recover compensation for the damage he has sustained (*e*).

Form of action.

Such injuries are in law technically denominated *torts*, but as the wrongful act is not committed with any direct force or violence, and the injury is only the indirect effect of the wrongful act of the defendant, the form of action which a patentee can maintain is that description of action of *tort* called an action of *case*, or *trespass on the case* (*f*).

Parties to action.

In such an action, the patentee or other party in whom the legal right to the patent privilege was vested at the time of the infringement, must be made plaintiff, and the person who has directly or indirectly committed or authorized the alleged wrongful act must be defendant.

Who to be plaintiff.

A patentee who has not assigned any part of his privilege must be the sole plaintiff. But if a patentee has assigned over to another the whole of his privilege, he ceases to have any interest, and cannot maintain an action for the infringe-

(*d*) See the condition, *ante*, p. 62, and in the Form of Patent in the Appendix, Chap. II. s. 1.

(*e*) Bull. N. P. 76.

(*f*) See Chit. on Pl. Vol. I.

ment of the patent. And if a patent be assigned to a single person, he alone must be plaintiff in an action for infringing it; and the patentee cannot be made a co-plaintiff, for he has ceased to have any interest in it. If there are several patentees, they may all join in bringing the action; and if a patentee has assigned a part only of his patent right, he and his assignee may be joined as plaintiffs in any action for infringing the patent (*h*).

And if a patent has been assigned in several shares, all the assignees may join in bringing an action; and it is conceived that it makes no difference whether the title of the several assignees accrues to them by only one or by several deeds. But it has never been decided whether one of several patentees, or an assignee of a portion of a patent privilege, can sue alone for the damages which he has sustained by the infringement of the patent. There does not seem to be any good reason why such a part proprietor should not be able to sue alone, although the language of the Court of King's Bench in a somewhat similar case (*i*) seems to be an authority to the contrary.

Executors and administrators.

If a patentee dies during the existence of his patent right, we have seen that his interest vests in his executor or administrator (*k*), and the executor or administrator will of course have the same right to an action for an infringement of the patent as the deceased patentee had, or would have had, if living. If there are several executors, all must join in bringing an action, for a probate obtained by one of such executors inures to the benefit of all (*l*). If there are several administrators, they must all be joined as plaintiffs in the action.

Assignees of a bankrupt or insolvent patentee.

The assignees of a bankrupt or insolvent patentee may maintain an action for a violation of his patent right (*m*); for, as we have seen (*n*), the whole of the bankrupt or insolvent patentee's interest passes to his assignees by virtue of their appointment. All the assignees must of course join in bringing any action.

(*h*) See *Boulton & Watt* v. *Bull*, 2 H. Bl. 463, and several subsequent cases in which patentees and assignees have joined in bringing actions.

(*i*) *Weller* v. *Baker*, (Case of Dippers, at Tunbridge Wells,) 2 Wils. 423.

(*k*) Vide *ante*, Chap. IV. p. 58; Chap. IX. s. 237.

(*l*) See Williams's Law of Executors.

(*m*) See the case of *Bloxam* v. *Elsee*, 1 C. & P. 558; 6 B. & C. 169.

(*n*) Vide *ante*, Chap. IX. s. 2, p. 238.

It has never been decided whether the assignees in Law of a proprietor of part of a patent privilege can be joined as plaintiffs with the other proprietors, but there seems to be no reason why they should not.

Who may be made defendants.

The action may be brought against several defendants, where they have been guilty of any joint act of infringement, but not otherwise. And if several persons have been guilty of a joint infringement, the plaintiff may, at his election, sue all or any number of them at his election (*o*).

Declaration.

The declaration (*p*) usually commences with an averment, that the patentee was the true and first inventor of the invention comprised in his patent, and that it was a new invention. Such an introductory averment does not, however, seem to be essential; and it is sometimes omitted, particularly when brevity is desired. The declaration then states the grant contained in the patent upon which the defendant is sued, and that may be done either by setting out the operative words of the patent, or by stating the effect of the instrument as a grant to the patentee and a prohibition to all other persons.

Must show under what seal patent made.

In declaring upon a patent it must be shown under what seal it was made (*q*). English patents for inventions granted since the union with Ireland, must have been made under the Great Seal of the United Kingdom (*r*). A declaration upon such a patent therefore describes it as "letters patent under the Great Seal of the United Kingdom of," &c. (*s*). English letters patent are always dated at Westminster, (being the place where the Court of Chancery usually sits,) and of the day they are sealed with the Great Seal. A declaration therefore usually describes the patent to bear date at Westminster, of the day upon which they purport to be made.

Date or time of making must be stated.

A date is not necessary to the validity of a patent (*t*), but if it be not dated, the plaintiff, in declaring upon it, must show when it was made, for otherwise it would not be certain whether the Act complained of as an infringement was done within the term granted by the patent. In such a case the plaintiff may have recourse to the writ of Privy Seal and *recepi*, the enrolment

(*o*) 1 Saund. 291, e.

(*p*) See the Forms of Declaration, *post*, Appendix, Chap. II. s. 4.

(*q*) Com. Dig. Pat. (H).

(*r*) See *R.* v. *Bullock*, 1 Taunt. 71; *R.* v. *Yandell*, 4 T. R. 521.

(*s*) See the Form of Declaration in the Appendix, Chap. II. s. 4.

(*t*) Plowd. 231; Vin. Abr. prerog. (G. b, 3).

of the patent, and the docket paper, and state the time of the making of the patent as accurately as possible. In ancient times the clerks in Chancery not unfrequently omitted the dates of letters patent, but such mistakes are now of very rare occurrence.

Profert.

In declaring upon letters patent it is necessary to make profert of them, that is, to make an offer to prove what the plaintiff is about to state respecting the effect of them, by producing and showing them to the Court (*u*). If profert be omitted, the declaration will be bad on special demurrer; and before the statute 4 & 5 Ann. c. 16, the omission was a good cause of general demurrer (*x*).

Statement of specification.

An action is never brought for the infringement of a patent until after the invention has been specified; and as the general language of the title gives little or no information respecting the real nature of an invention, if such an action were to be brought before specification, it is most probable that a jury would not give him a sufficient amount of damages to carry costs. The time for specification then having passed before the commencement of the action, it seems that the plaintiff must show that he has performed the condition of the patent, which requires him to enrol a specification (*y*); and therefore the declaration in such an action always states in what manner the patentee has complied with that condition. It is not, however, usual to set out the specification in the declaration at full length, but merely to allege that the patentee has, in pursuance of the proviso contained in the patent, described the invention by an instrument under his hand and seal, and has caused that instrument (which is commonly called the specification) to be enrolled in Chancery, within the time limited by the patent.

Not usual to set out specification at length.

In some cases desirable, if not necessary to set out the description.

In some cases, however, it is desirable, if not necessary, to set out the description of the invention contained in the specification; as, for instance, where there has been a disclaimer or memorandum of alteration filed and enrolled under the statute 5 & 6 Will. IV. c. 83, s. 1, which perhaps could not be understood without reference to the specification.

(*u*) Dyer, p. 29, b, pl. 199, and p. 54, a, pl. 17; 10 Co. 94, b.

(*x*) *Dr. Leyfield's* case, 10 Co. R. 88, a, 94, b.

(*y*) See per *Tindal*, C. J., in *Mumls* v. *Foster*, 1 Dowl. & Low. 742, and Com. Dig. Pleader, C. 62.

Although a specification is an instrument under hand and seal, yet it is not a deed, nor is it an instrument of which the plaintiff need to make profert in his declaration. Profert of specification not necessary.

When any part of the title or specification has been disclaimed or altered under the statute 5 & 6 Will. IV. c. 83, s. 1, the disclaimer or memorandum of alteration must be stated in the declaration, for the statute provides that the disclaimer or memorandum of alteration shall be deemed and taken to be part of the patent or specification. Statement of disclaimer or alteration.

If the plaintiff, or any one of several plaintiffs, claims under an assignment of the patent declared upon, the assignment must be stated in the declaration, so as to show his title to the patent right. An assignment, we have seen, must be made by deed (*z*), and should be so stated in the declaration. But the omission to state that an assignment was made by deed is only matter of form, and is aided after verdict (*a*). And when an assignment by deed is pleaded in the declaration, the plaintiff must make profert of it in the ordinary way (*b*). Statement of assignment.

If the action is brought for an infringement of a new patent, granting an extension of the original term, the declaration must, of course, set out the new patent, or state the effect of it. But it seems that it is not necessary in such a case to allege in the declaration that the grantee of the new patent has complied with all the preliminaries required by the statute 5 & 6 Will. IV. c. 83, s. 4; and that if the patentee has not complied with them, the defendant must plead the non-compliance with the statute in defence to the action (*c*). Declaration upon a patent for the prolongation of a privilege.

The plaintiff's title to the privilege he claims, having been shown by stating the patent, the specification and the assignments (if any) under which he claims, and also any disclaimer or memorandum of alteration varying his privilege, he must next show in respect of what injury he complains against the defendant. This is done in that part of the declaration called the breach, in which the plaintiff points out the particular breach of duty committed by the defendant. Breaches.

It was formerly the practice to insert several counts in a declaration upon a patent, each count alleging the infringe- Formerly usual to insert several counts in a declaration.

(*z*) *Ante*, Chap. IX. s. 2, p. 234.
(*a*) *Keene* v. *Cornish*, MS.
(*b*) See the Forms of Declaration in the Appendix, Chap. II. s. 4.
(*c*) See *Russell* v. *Ledsam*, in the Exchequer; but not yet reported.

ment in a different form. Since the pleading rules of H. T., 4 Will. IV. 1834 (*d*), it has not been usual or proper to insert more than one count in a declaration for infringing a patent, but a plaintiff is at liberty to insert as many breaches as he pleases, and it is usual to allege several (*e*).

Several breaches now inserted.

Allegation of time in breach.

In every breach the wrongful act of the defendant is alleged to have been committed after the making of the patent, and within the term of years which it grants, and this is necessary because the allegation of time in the breach is immaterial, and therefore it would not sufficiently appear, that the alleged grievance was committed during the existence of the patent, unless there was an express allegation to that effect, and without such an allegation, the breach would be bad on special demurrer.

Breach in a declaration after a disclaimer.

If there has been any disclaimer or alteration of any part of the title or specification, the plaintiff ought generally to allege in every breach, that the grievance was committed after the disclaimer, or memorandum of alteration, was enrolled under the provisions of the statute. For if the disclaimer or memorandum of alteration shows that, until it was enrolled, the patent was void, the defendant could not be liable to an action for any infringement committed before the enrolment.

Perry v. Skinner.

Thus in the case of *Perry* v. *Skinner* (*f*), where the patentee had disclaimed part of the invention described in the specification, the Court of Exchequer held that the defendant was not liable for any infringement committed by him before the enrolment of the disclaimer, although the part of the invention which he had infringed had not been disclaimed.

Breach in a declaration after an assignment.

So also if the plaintiff, or any one of several plaintiffs, is an assignee, it should be alleged in the breaches that the infringements were committed after the making of the assignment under which he claims; for an assignee cannot recover damages for any infringement of a patent prior to the time when his title accrued to him by virtue of his deed of assignment, which, we have seen, must be stated in the declaration (*g*). And even if the assignment of a patent were also to contain an assignment of the patentee's right to damages for infringements committed prior to the assignment, the

Chose in action cannot be assigned.

(*d*) See Charn. N. R. 125.
(*e*) See the various Forms of Breach in the Appendix, Chap. II. s. 4.
(*f*) 2 M. & W. 471.
(*g*) *Ante*, p. 255.

assignee could not recover such damages in an action at Law, for the assignment of such a *chose in action* would be held to have no operation in a Court of Law, whatever it might have in a Court of Equity.

Breach alleges acts to have been done wrongfully and to deprive patentee of his profit.

The wrongful acts stated in the breaches are always alleged to have been done, not only "wrongfully and injuriously," (as in all actions on the case), but also with the intent to deprive the plaintiff of "the profits, benefits, and advantages which he might and otherwise would have derived and acquired from the making, using, exercising, and vending his invention." This is done, because it is necessary to show, on the face of the declaration, that the acts complained of were not only wrongful; but also that they were injurious to the plaintiff by depriving him of the profits of his invention. But it is unnecessary to prove this allegation of intent to injure the plaintiff further, than by giving evidence of the acts of infringement complained of; for every person must be presumed to be aware of the existence of the patent, and to intend what must necessarily be the effect of the wrongful acts which he is about to commit.

Must show that wrongful acts were done without licence.

Every breach must also show that the acts complained of were done without the licence of, and against the will of, the patentee, or those claiming under him, because the patent only prohibits those from using the invention who have not the licence, consent, or agreement, of the patentee, his executors, administrators or assigns.

What is a breach of a patent privilege.

A person is guilty of a breach of a patent privilege when he has directly or indirectly used the art or invention which has been made the subject of the privilege, or applied it in any way for his own profit or benefit. And if the defendant has employed means only colourably different to produce the same or a similar result, yet he is guilty of an infringement if he has in fact used the art which is the subject of the privilege. The nature of the art or invention which can be made the subject of such a privilege has been considered in a former part of this work (*g*), and it is always necessary to determine what is the subject of the privilege comprised in a patent, in order to see whether the defendant has committed a breach of the

(*g*) *Ante*, Chap. V. s. 1, p. 77.

privilege. It is a very common mistake to confound the purposes or objects of an invention with the art or invention itself. And it frequently happens that the use of the produce of an art or invention is erroneously deemed to be the use of the art or invention itself. To be an infringement of a patent privilege, the defendant's act must be either a use of the art invented by the patentee, or a fraudulent imitation of it, made for the purpose of evading the privilege, and not such a distinct art or invention as would be sufficient to support a patent (*h*).

Breaches usually alleged in terms of granting, and prohibitory parts of patent.

It is usual in declarations for infringing patents to allege breaches in the terms of the granting and prohibitory parts of the patent; that the defendant did "use," "exercise," or "put in practice" the invention, or some part of it; or did "make" articles according to the invention, or some part of it; or did "vend" or sell such articles; or did "counterfeit," "imitate," or "resemble" the invention; or make some "addition unto," or "substraction from," the invention, "whereby to pretend himself the inventor or deviser thereof" (*i*). And in the case of *Minter* v. *Williams* (*k*), it was laid down by the Judges of the Court of Queen's Bench, that this is the proper mode of alleging the breaches of a patent.

Signification of the word invention in a breach.

When it is alleged in a breach respecting an infringement, that the defendant has used, exercised, or practised *the plaintiff's invention*, the word invention must be understood in the sense in which it is used in the patent (*l*); that is, as signifying the art which has been invented by the patentee, and which has been made the subject of the privilege comprised in the plaintiff's patent.

If alleged act not an infringement, defendant may demur.

Minter v. Williams.

If the plaintiff alleges a supposed wrongful act in a breach which does not, *as alleged*, amount to an infringement of the patent, the defendant may demur to the breach.

Thus, in the case of *Minter* v. *Williams* (*m*), the plaintiff

(*h*) The various acts which amount to infringements of patent privileges are more particularly examined in Chap. XI. respecting the evidence upon a plea of not guilty.

(*i*) See the various forms in the Appendix, Chap. II. s. 4; and the evidence to be given upon the plea of not guilty, *post*, Chap. XI. s. 1.

(*k*) 4 A. & E. 251; 1 Webs. R. 135, *infra*.

(*l*) Vide *ante*, Chap. V. s. 1, p. 91.

(*m*) 1 Webs. R. 135.

alleged as a breach, in one count of the declaration, that the defendant *exposed to sale* divers chairs which were intended to imitate and resemble, and did imitate and resemble, the plaintiff's invention. To this the defendant demurred, and the Court of Queen's Bench held, that the breach was insufficient, and gave judgment for the defendant.

For the defendant in that case, it was contended that the word vend in the patent meant to sell (*n*), or expose for sale, and several dictionaries were cited in order to show that the word vend has both these significations. It was also contended, that exposing to sale is comprehended within the words, "use" and "exercise," in the granting part, and the words "use or put in practice" in the prohibitory part of the patent. In giving judgment in this case, Mr. Justice *Patteson* said, "In drawing declarations for the infringement of a patent, pleaders have always used the words of the patent, either those in the granting or prohibiting part of it. I cannot doubt, for a moment, that there is a clear distinction between vending and exposing to sale, notwithstanding the authority of the dictionaries referred to. The plaintiff should in his declaration use the words either of the granting or prohibiting part of the patent. This is quite a new course of pleading to put in a word which does not occur in the patent. If the word vend really does mean 'to expose to sale,' as well as to 'sell,' the count should have charged the defendant with vending; and the act of exposing to sale might have been proved in support of it." Mr. Justice *Coleridge* said, "In the granting part of this patent the words are, 'make, use, exercise, and vend,' and then in the prohibiting part the words are rather different, for an obvious purpose; they are, 'make, use, or put in practice.' Now we are to see whether this count, either referring to the granting or prohibiting part, *necessarily imports an offence.* The words of the count are, that the defendant did 'wrongfully and unjustly expose to sale,' &c.; and it is said that these words necessarily import a vending within the granting part of the patent. It is argued that an exposing to sale is included within the meaning of the word 'vending'; but even upon

Vending and exposing to sale not the same.

(*n*) The sale of articles is commonly alleged as an infringement in patent actions.

that construction the count would be defective, inasmuch as the evidence instead of the words of the patent is put upon the record. It seems to me that 'vending' imports the habit of selling, and 'selling,' the act of sale. If we read the word 'vend' as expressly inserted in the prohibitory part of the grant (*o*), we ought only to give it there the meaning which would effectuate the purpose of the patent—the prevention of acts injurious to the patentee, with as little restraint on the public as possible. It must be taken here that the defendant has only exposed for sale; that whatever may have been his original purpose in so doing, or whatever motive has supervened, he has abstained from selling. Now I cannot say that such a mere exposure to sale is necessarily injurious to the patentee; it may, on the contrary, be very beneficial; it is not, therefore, necessarily the vending which is exclusively granted to him. As to 'using and exercising,' those words cannot be fairly resorted to, when we find with them (*p*) the word 'vending,' and that is passed by (*q*). But if they could the argument would be the same; this might be an innocent using and exercising, and so not prohibited."

Usual to allege a selling.

It has, however, been customary in some cases to depart from the exact terms of the patent in alleging breaches; thus it is usual to allege as a breach that the defendant did "*sell*" articles made according to or by means of the invention. And this seems to be sufficient, for a selling must clearly be a vending within the meaning of the patent (*r*).

Infringements must be alleged to have been in breach of the patent.

The infringements stated in a breach must also be alleged to have been committed in breach of the patent privilege, or, in the ordinary language of the forms, in breach of the said letters patent, and against the privileges thereby granted.

Allegations of breach are divisible.

The allegations contained in a breach are divisible; and a plaintiff may maintain his action, although he does not prove every thing alleged in a breach, if he proves such a part of it as actually amounts to an infringment of the patent. Thus,

(*o*) A patent grants to the patentee the sole right to "make, use, exercise, and vend" the invention; but in the prohibition to others it commands that they shall not "make, use, or put in practice," the invention, the word "vend," being in that part of the patent wholly omitted; vide *ante*, Chap. IV. pp. 52, 59.

(*p*) In the granting part of the patent.

(*q*) That is, passed by in the prohibitory part.

(*r*) Vide *ante*, Chap. IV. pp. 54, 55.

in *Gillett* v. *Wilby* (*s*), it was held, that an allegation that the defendant had imitated the plaintiff's improvements was a divisible allegation; and proof that the article made by the defendant imitated one of the plaintiff's improvements, was sufficient to enable him to support the action. Gillett v. Wilby.

At the end of the breach or of the breaches (if there is more than one) the plaintiff states the amount of damage which he has sustained by the wrongful acts of the defendant. Statement of damage.

It is usual to allege damage to a large amount, but the only object in so doing seems to be, not to prejudice the plaintiff's right afterwards to recover a large sum in Equity for the loss he has sustained; the amount of damages recovered in an action at Law being almost always merely nominal.

If the plaintiff sues as an executor or administrator he must, at the end of the declaration, make a profert of his probate, or of his letters of administration, so as to prove his right to sue in his representative capacity. Profert of probate or administration.

In some actions, when the breaches in the declaration describe the alleged wrongful acts of the defendant in very general terms, the Courts will order the plaintiff to deliver to the defendant particulars of the breaches of contract, or wrongful acts of which he complains (*t*). The reason why the Courts order particulars in such cases is, that the defendant cannot know with certainty what the plaintiff intends to prove against him at the trial, and therefore may be unable to prepare for his defence, and liable to be taken by surprise at the trial. The power of the Courts to order such particulars is derived from their general jurisdiction over the proceedings before them, and not from the provisions of any statute. Acting upon this practice, the Court of Exchequer, in the recent case of *Perry* v. *Mitchell* (*u*), ordered the plaintiff to deliver to the defendant a particular in writing of the infringements on which he intended to rely. In that case, the action was for infringing two patents for improvements in pens, and the specification set forth and described thirteen different pens, containing an indefinite number of slits and adjustments. The declaration assigned as breaches, the making, &c., of pens and nibs, in imitation of parts of the invention, with Particulars of breaches or infringements. Perry v. Mitchell. Particulars of infringements ordered to be delivered.

(*s*) 9 C. & P. 334.

(*t*) See Tidd's Practice, and the other books of practice.

(*u*) 1 Webs. R. 269.

divers additions thereto and subtractions therefrom. Upon an affidavit for the defendant of the circumstances, and stating that inasmuch as neither the parts, nor the additions or subtractions were mentioned, it would be impossible to prepare the notice of objections to be delivered with the pleas, or to know what evidence to adduce; the Court made a rule absolute, ordering the plaintiff to deliver particulars of the infringements, and to specify and point out the particular pens, &c., in respect of which such infringements had taken place.

Plaintiff will not be ordered to produce a specimen.

But the Courts will not order the plaintiff to produce to the defendant a specimen of his patent article, for the specification gives all the information the defendant can require; and the effect of such an order would merely be to enable the defendant to ascertain the evidence which the plaintiff will produce at the trial (*x*).

Oyer.

R. *v.* Amery.

It has been laid down in all the modern books of practice, upon the authority of the case of *The King* v. *Amery* (*y*), that oyer of letters patent cannot be demanded. It will be observed, however, that it was not necessary to determine the point in the case of *The King* v. *Amery*, for the demand of oyer was too late, and therefore not admissible in that case. We have seen (*z*) that a plaintiff must in his declaration make profert of his patent; and the rule is, that a defendant is entitled to demand oyer of any instrument of which the plaintiff necessarily makes profert (*a*).

Defence to an action for an infringement.

A defendant in a patent action is at liberty to avail himself of two different kinds of defence to the action: *firstly*, he may deny that the plaintiff has any title to the privilege stated in the declaration, either on the ground that there is no such patent in existence as the plaintiff alleges, or that the patent is defective and void, and therefore the same as if there were no patent at all; and, *secondly*, he may deny that he has committed any infringement of the plaintiff's patent right. And every defendant may avail himself of both or either of these different lines of defence to a patent action.

Pleas in bar to declaration.

In order to defend himself in such an action, the defendant

(*x*) *Crofts* v. *Peach*, 2 Hodg. 110; 1 Webs. R. 268.
(*y*) 1 T. R. 149.
(*z*) *Ante*, p. 254.
(*a*) Tidd's Prac. c. xxiii. p. 586; and see the observation of *Tindal*, C. J., in *Muntz* v. *Foster*, 1 Dowl. & Low. 741, 742.

must state his grounds of defence in one or more pleas, which he pleads to the declaration (*b*) in bar of the plaintiff's claim to recover damages against him.

Not guilty formerly the only plea.

Before the pleading rules, made in pursuance of the statute 3 & 4 Will. IV. c. 42, s. 1 (*c*), the only plea used in patent actions was the plea of not guilty, under which the defendant might take any objection he pleased to the validity of the patent.

Not guilty only denies the breach.

Since the pleading rules above mentioned (*d*) came into force (*e*), the plea of not guilty has ceased to have such an extensive effect as it had formerly; and that plea now merely amounts to a denial, that the defendant has been guilty of the wrongful acts complained of by the plaintiff in the breach or breaches alleged in the declaration, and does not raise any question respecting the validity of the patent.

Nul tiel record cannot be pleaded to a patent.

We have seen (*f*) that a patent is a record; and if it be pleaded by the patentee with a profert, (which supposes a production of the instrument, and showing it in open Court,) the other party cannot plead *nul tiel record* to it (*g*). Because the patent being in contemplation of law in Court at the time of pleading, it manifestly appears that there is a record; and therefore the defendant cannot be permitted to say that there is no record (*h*). In cases in which the plea of *nul tiel record* is admissible, the plaintiff has stated a judgment, or other matter which he has offered to prove *by the record* of it, the record not being in Court at the time, the plea in such case alleging that there is no record of the judgment or other matter alleged, and thus compelling the plaintiff to prove his allegation, by causing the record to be produced in Court. But the words "letters patent under the Great Seal," import an instrument which is and must be a record; and to say that there is no record of a patent, would be to say that there is no record of a record, which would be absurd.

A patent cannot be denied, for the Great Seal proves itself.

And if a patent be pleaded in the declaration with a profert, the defendant cannot deny it by saying that there is no

(*b*) In a work of this description it is unnecessary to say anything respecting pleas in abatement. For information respecting such pleas see Com. Dig. tit. Abatement; Chit. on Pleading, vol. i.

(*c*) See Charnock's New Rules.

(*d*) Reg. Gen. H. T. 4 Will. IV. 1834.

(*e*) 15 April, 1834.

(*f*) *Ante*, Chap. IV. p. 36.

(*g*) 6 Co. R. 15, b; Doct. pl. 307, 308; Plow. 232.

(*h*) Co. Lit. 260, a.

patent (*i*). For the Great Seal (which must be attached to a patent) proves itself (*k*); and the patent being (in contemplation of Law) in Court at the time of declaring, it appears to the Court that there is a patent under the Great Seal, and therefore the defendant cannot be permitted to deny an allegation which the Court and the parties must see is perfectly true.

But the effect of the patent may be denied.

But a patent for an invention is in the nature of a grant, as well as a record, and therefore the defendant is permitted to deny that it has the effect stated by the plaintiff in his declaration. The plaintiff must state the purport of the patent as a grant of privilege to the inventor, his executors, administrators, and assigns; and the defendant is permitted to deny the statement by a plea of *non concessit* (*l*), alleging in substance that the Queen did not make such grant as stated by the plaintiff, in manner and form as in the declaration mentioned (*m*).

And if a plaintiff does not correctly set out the form or effect of his patent, the only way in which the defendant can object to the misstatement is by pleading a plea of *non concessit*. It was supposed by some persons that although *non concessit* might be pleaded to a patent granting land, &c., yet that it was inapplicable as a plea to a patent granting the sole use of an invention. The recent case of *Beddells* v. *Massey* (*n*) however decides that the plea is proper in a patent action. In that case the plaintiff obtained a rule *nisi* to strike out the plea of *non concessit*, on the ground that it could not be pleaded in a patent action; but after argument the Court of Common Pleas discharged the rule with costs. And in the case of *Bunnett and Corpe* v. *Smith* (*o*), a Judge at Chambers refused the defendant leave to plead this plea, but the Court of Exchequer afterwards held that the defendant ought to be permitted to plead the plea.

Plea of *non concessit* may be pleaded to a patent for an invention.

Beddells v. Massey.

Bunnett v. Smith.

If a plaintiff have no such patent as he alleges, it may be denied by a plea of *non concessit*.

If a person should proceed by action upon a pretended grant of an invention by patent, when, in fact, no such grant was ever made, it is scarcely necessary to observe that the

(*i*) 4 Co. R. 71, b.; Doct. plac. 352; Plow. 232.

(*k*) Vide *ante*, Chap. IV. p. 36.

(*l*) Co. Lit. 260, a; Doct. plac. 307, 308; 4 Co. R. 71, b; 2 Rol. Abr. 191, b, 20; Dyer, 242, a.

(*m*) See the Forms of such Pleas in the Appendix, Chap. II. s. 4.

(*n*) 8 Jur. 808; 2 Dowl. & L. 322.

(*o*) 13 M. & W. 552.

defendant may show, by way of defence to the action, that there never was any such patent as alleged. The mode of doing this is by a plea of *non concessit* (*p*), by which the defendant denies that her Majesty did make such gift or grant of privilege as in the declaration alleged; and the plaintiff being thus put to the proof of the allegation contained in his declaration, he will fail at the trial if he cannot produce a patent containing the alleged grant of privilege.

Non concessit applicable whenever patent void, *ab initio*.

The plea of *non concessit* seems, also, to be applicable in every case in which the patent was void *ab initio*, and therefore never had any operation as a grant (*r*). But if the patent was originally good, and only became void by matter subsequent, as the nonperformance of some condition contained in it, the plea of *non concessit* is inapplicable; for, although the grant may have become void, it could not be said that the Queen did not make such a grant.

Cannot be pleaded if patent originally good.

Reason why a defendant is permitted to question the validity of a patent.

It is a principle in law, that the Queen cannot be considered to intend wrong to any one; or, as it is sometimes expressed, the Queen can do no wrong (*q*). And the law provides that any patent which is contrary to law, or prejudicial to the public, shall be absolutely void, not only by virtue of the law itself, but as being contrary to the Queen's intent. To allow such a patent to be put in force would be contrary to the Queen's intention; and, therefore, the formal grant it contains is unavailing in a Court of Law, if the party proceeded against can show any valid objection to it. Every grant made by patent has this condition, either expressly or tacitly annexed to it;—that it shall not be contrary to law, or operate to the prejudice of her Majesty's subjects. And if the grant be contrary to this condition, it cannot be enforced against any person in any Court of Law or Equity.

Grounds upon which a defendant may take objections to a patent.

In an action brought upon a patent objections may be taken to it on three different grounds: *first*, that it is contrary to the express provisions of the Common or Statute Law; *secondly*, that the Queen has been deceived in some material particular, respecting the grant contained in the patent; and, *thirdly*, that some of the conditions or provisoes contained in the

(*p*) See the Forms in the Appendix, Chap. II. s. 4.

(*q*) Vide *ante*, Chap. IV. p. 38.

(*r*) Vide *post*, p. 268.

patent have been violated (*r*). There are several objections, however, which may be taken to a patent on more than one of these three grounds, and some which may be taken upon all three of them.

Objections usually taken.

The principal objections usually taken to a patent are the following:—

1st. That the patentee was not the inventor or importer of the alleged invention.

2nd. That the title misrepresents or improperly describes the invention.

3rd. That the invention is not an invention of such a nature as may be made the subject of a patent privilege.

4th. That the invention was not new to the public at the date of the patent.

5th. That the invention is of no use to the public.

6th. That the patentee has not properly specified his invention.

Other objections may however be taken to the validity of a patent, some of which will be noticed hereafter.

Objection that patentee was not the inventor.

The first of these objections, *viz.*, that the patentee was not the inventor or importer of the invention, shows that a patent is void because the patentee was not a person who was capable of taking such a grant of privilege as comprised in the patent (*s*).

This objection to a patent invalidates it upon each of the three grounds already adverted to.

Patent can only be granted to an inventor.

According to both the Common Law and the Statute of Monopolies (*t*), the grant of the sole use of an invention can only be made to the person who is the true and first inventor of a new manufacture, or who first imports a knowledge of such a manufacture from abroad; and the Statute of Monopolies (*t*) avoids all such patent grants to any other person (*u*).

A false representation that patentee, the inventor, avoids the grant.

A patent always shows by the recital of the petition upon which it was founded, that the patentee represented that he was the true and first inventor of the alleged invention; or

(*r*) Vide *ante*, Chap. IV. p. 36, respecting the construction of patents.
(*s*) Vide *ante*, Chap. III. ss. 2, 3.
(*t*) 21 Ja. I. c. 3, s. 6.
(*u*) Vide Chap. III. *ante*, p. 21.

that he had acquired a know'edge of it from a foreigner residing abroad, and therefore was the importer of it into this country; and if the representation was untrue the Queen was deceived, and therefore her grant is void (*x*).

And every patent contains a proviso, that if the patentee was not the true and first inventor or importer (as the case may be) of the invention comprised in it, the grant and patent may be avoided (*y*). Proviso that patent shall be void if patentee not inventor.

The usual form of plea for raising this objection, alleges that the patentee was not the true and first inventor of the invention mentioned in the declaration (*z*). If the declaration contains an allegation that the patentee was the true and first inventor, the plea is merely a traverse or denial of that allegation; and therefore the defendant concludes by putting himself upon the country (*z*), so as to tender an issue in fact for trial by a jury. But when the declaration contains no such allegation, the plea must aver that the patentee was not the true and first inventor of the invention, and that by reason thereof the patent is void; and then conclude with a verification, as it is called, whereby the defendant offers to prove the matters alleged in the plea (*z*). Plea that patentee was not the inventor.

When the patent is set out on oyer, or when the declaration states the recital contained in the patent, by which it appears that the patentee represented to the Crown that he was the true and first inventor, a plea in the usual form is sufficient to enable the defendant to take this objection to the patent, on the ground that the patentee made a false suggestion to the Queen. But if the recital is not stated in the declaration, the defendant must in his plea aver that the patentee did make such a representation to the Queen, and that the Queen made the grant upon that representation; and then the plea must allege that the representation was false, and that the patent is therefore void (*a*). The plea must of course conclude with a verification. Plea of false representation that patentee was the inventor.

When the patentee has imported the invention, the plea that he was not the true and first inventor, would be sufficient to Plea that patentee was not the importer.

(*x*) Vide *ante*, Chap. III. p. 21; Chap. IV. p. 39.

(*y*) See Chap. IV. p. 62, *ante*, and the Form of a Patent in the Appendix, Chap. II. s. 1.

(*z*) See the Forms in the Appendix, Chap. II. s. 4.

(*a*) See the Form in the Appendix, Chap. II. s. 4.

raise the question whether he was the true and first inventor within the meaning of the Statute of Monopolies (*b*). In many cases, however, the best course for the defendant to adopt, is to plead a plea, setting out the representation made to the Crown by the patentee, and alleging that the representation was false, that the Crown was deceived in making the grant, and that the patent is therefore void (*c*).

Effect of the plea.

In whichever of these forms the plea is pleaded, it will be sufficient if the plaintiff joins issue upon it to enable the defendant to take advantage of this objection, on the ground that the patent is contrary to both the Common Law and the Statute of Monopolies.

The objection that patentee not the inventor may be taken under a plea of *non concessit*.

It seems, however, that this objection, that the patentee was not the true and first inventor, may also be taken under the plea of *non concessit*, which has already been mentioned (*d*). That plea alleges that the Queen did not make the grant alleged in the declaration; and if it can be shown that the patent mentioned in the declaration was void; at the time it was made, it could not grant the privilege which the plaintiff alleges, for nothing could pass by a void instrument (*e*). And it is clear that if a patent were to be granted to a person who was not the true and first inventor, or importer of the invention, it would be absolutely null and void, for it would not be within the exception contained in the sixth section of the Statute of Monopolies (*f*), and therefore it would be made void, and of none effect, by the first section of that statute.

Objection that patentee was not the inventor is different from an objection that the invention was not new.

It is a very common error to suppose that the objection to a patent, that the patentee was not the true and first inventor, is the same as the objection that the invention was not new at the date of the patent. The two objections are however perfectly distinct, and different from each other. The one objection is applied to the patentee, and shows that he is not a person capable of sustaining such a grant; and the other objection is applied to the invention, and shows that it could not be made the subject of a patent privilege.

It is true that if it be shown that the invention comprised

(*b*) Vide *ante*, Chap. III. s. 3, p. 26.
(*c*) See the Form in the Appendix, Chap. II. s. 4.
(*d*) *Ante*, p. 264, 265.
(*e*) Vide Co. Lit. 260, a, and the other authorities, cited *ante*, p. 264, n. (*l*).
(*f*) Vide *ante*, Chap. III. p. 21.

in a patent was known to the public before the date of the patent, although the patentee may in fact have invented it, yet he cannot have been the *first* inventor, for some one must have invented and given the invention to the public before the date of his patent (*g*). But an invention may be perfectly new to the public, and yet the patentee may not be the *true* and first inventor. For he may have purloined it from another, or it may have been communicated to him by one of his fellow-subjects, in either of which cases he could not be the *true* inventor.

The objection that the patentee was not the true and first inventor, is, in fact, something more than the objection that the invention is not new, for it shows that the patentee did not make the invention (*h*).

Objection that title misrepresents the nature of invention.

The objection that the title in a patent misrepresents the nature of the invention, or improperly describes it, is taken to the patent, on the ground that the Queen has been deceived by a false representation or suggestion of the patentee.

It is the duty of a petitioner for a patent to see that the Queen is properly informed respecting the nature of his invention, and the grant which he seeks to obtain (*i*); he gives a title to his invention, in his petition, at his own risk and peril, and if he makes any misrepresentation respecting it, his patent will be absolutely void.

Cases in which inventions are intituled improvements and are not so.

This objection is most frequently taken in cases in which the inventions are intituled or represented by the patentee to be improvements in something previously known, or to be applicable to some particular purposes, as in the following instances:—"improvements in elastic fabrics;"—"improvements in the manufacture of iron;"—"improvement in machinery for covering fibres applicable in the manufacture of braid and other fabrics," &c., &c.

Patentees who have obtained patents for inventions described in this manner, must have represented to the Crown that their inventions were such improvements, or were applicable in the particular manner mentioned in the titles of their inventions (*k*); and if their inventions were not such improve-

(*g*) Vide *ante*, Chap. III. s. 4, p. 33.
(*h*) Vide *post*, Chap. XI. Evidence.
(*i*) Vide *ante*, Chap. IV. p. 42.
(*k*) Vide *ante*, Chap. IV. p. 45; and the Form of Petition for a Patent in the Appendix, Chap. II. s. 1.

ments as represented, or were not applicable in the way alleged, their patents are void by reason of the false representation or suggestion made to the Crown.

Form of plea for raising this objection.

This objection is best taken by a plea, setting out the representation made to the Queen by the patentee respecting his invention, being improvements in some description of manufacture; stating also that the Queen acted upon the representation in making the grant, and then alleging that the representation, or some part of it, was false, and that by means thereof the patent is void (*l*). But the objection may also be taken under the plea of *non concessit*; for if the representation was false the patent is void, and therefore has no operation as a grant of privilege in manner stated in the declaration (*m*). And where an invention is misdescribed in the title, the plea of *non concessit* seems to be the proper plea for taking that objection to the patent; for the patent expresses a grant different from that which the Queen must have intended, and therefore it is null and void (*n*).

Non concessit.

Title of invention too large.

When the title contained in a patent is too large, and includes more than the patentee has actually invented, it is clear that the patent purports to make a more extensive grant than the Queen can have intended, and therefore the patent is wholly void (*o*). And a defendant may, in an action upon such a patent, avail himself of the objection either by the plea of *non concessit*, or by a plea showing that the Crown was deceived by a false representation. The objection it seems is also admissible under a plea denying the sufficiency of the specification.

Morgan v. Seaward.

In the case of *Morgan* v. *Seaward* (*p*), it appeared that the patent had been obtained for an invention of "certain improvements in steam-engines, and in machinery for propelling vessels, which improvements were applicable to other purposes." The defendant pleaded (thirdly) that the alleged invention was not an improvement in steam-engines, and the defendant at the trial obtained a verdict upon that plea. The plaintiff moved for judgment, *non obstante veredicto*, or a

(*l*) See the Form of Plea in the Appendix, Chap. II. s. 4.

(*m*) Vide *ante*, p. 264, 268, respecting this plea.

(*n*) That a patent is void if it be contrary to the intent of the Queen; vide *ante*, Chap. IV. p. 48.

(*o*) Vide *ante*, Chap. IV. p. 46.

(*p*) 2 M. & W. 544.

replender upon the finding upon the third issue; and in delivering the judgment of the Court of Exchequer, Mr. Baron *Parke* said, "The suggestion in the letters patent is, that Galloway had invented certain improvements in steam-engines, and in machinery for propelling vessels, which improvements were applicable to other purposes; and the patent is granted for the invention of those improvements. But unless the specification be referred to, to explain the title of the patent, it is doubtful whether the invention claimed is of improvements in steam-engines, as connected with other machinery only, or of improvements in steam-engines for whatever purpose they may be employed. Upon reference to the specification there is no doubt that the claim is of the latter description; but that instrument is not stated in the record, and upon what appears on the record, it is by no means clear that the patentee does claim an improvement in steam-engines, unconnected with the machinery. And if he does not, the plea would probably have been bad on demurrer, as it is uncertain whether it does not deny the invention to be an improvement in steam-engines, unconnected with the machinery. But after verdict, this objection is removed: for it is a rule that if an issue could have been material, the Court, after verdict, ought to intend it to be so, *Kempe* v. *Crews* (*q*); and as the plaintiff did not demur, it must be taken that he admits that the plea is to be understood as denying the invention to be an improvement in steam-engines in that sense in which it is used in the patent itself; and the jury must be intended so to have found." And the Court gave judgment for the defendant on the third issue.

Uncertainty in the plea cured by the verdict.

In the case of *Morgan* v. *Seaward* (*r*), just cited, it was also held by the Court of Exchequer, that a plea denying that the invention was such an improvement as alleged by the patentee was different from a plea alleging that the invention was of no use to the public. And the same law was laid down by the Court of Common Pleas in the case of *Bedells* v. *Massey* (*s*).

Plea denying an invention to be an improvement, different from a plea that it is of no use.

If the invention mentioned in the declaration in a patent action, is not an invention of such a nature as may be made

Objection that the invention is not of such a

(*q*) 1 Ld. Ray. 167.
(*r*) 2 M. & W. 544-560.
(*s*) 2 Dowl. & Low. 322.

nature as may be made the subject of a privilege.

the subject of a patent privilege, the defendant may take the objection by a plea in bar to the action (*t*). The nature of the inventions which may be made the subject of such privileges has already been considered in a former part of this work (*u*), to which the reader is referred.

Plea for raising this objection.

It has been usual to raise this objection by a plea alleging that the invention is not an invention of any manner of manufacture, and that the patent is therefore void (*t*); and that plea is intended to raise the question whether the invention be an invention within the meaning of the exception contained in the *sixth* section of the Statute of Monopolies (*x*).

It seems, however, that the proper form of plea for this purpose would be a plea alleging that the privilege granted by the patent is not a privilege for the sole working or making of *any* manner of manufacture (*y*). Whatever may be the form of plea which is adopted, the objection is taken to the patent on the ground that it is contrary to the express provisions of the Statute of Monopolies (*z*).

This objection, it seems, may also be taken to a patent under the plea of *non concessit*, for if the invention is one which cannot be made the subject of a patent privilege, the patent is rendered void by the express provisions of the Statute of Monopolies, and cannot operate as a grant in the way alleged by the plaintiff (*a*). It seems that the objection *may* also be taken under a plea alleging that the invention is not an invention of a *new* manufacture (*b*), but not under a plea which merely alleges that the invention is not new to the public (*c*), nor under a plea alleging that the specification is insufficient (*d*).

A plea that an invention was not at the time of the making of the patent a manufacture within this realm within the meaning of the statute (*e*), has, however, been decided to be a bad plea, on the ground that it is ambiguous, and uncertain whe-

(*t*) See the Forms of Pleas in the Appendix, Chap. II. s. 4.

(*u*) *Ante*, Chap. V. s. 1, p. 77.

(*x*) 21 Jas. I. c. 3.

(*y*) See the Form of Plea in the Appendix, Chap. II. s. 4.

(*z*) 21 Ja. I. c. 21, s. 6.

(*a*) As to the effect of this plea, vide *ante*, p. 264, 268.

(*b*) *Walton* v. *Bateman*, 3 M. & G. 773.

(*c*) *Walton* v. *Potter*, 1 Webs. R. 585; 3 M. & G. 411; and see *Elliott* v. *Aston*, 1 Webs. R. 223.

(*d*) *Jupe* v. *Pratt*, 1 Webs. R. 150, 151.

(*e*) 21 Ja. I. c. 3, s. 6.

ther it is intended to raise the question of the invention being new, or a manufacture within the meaning of the statute (*f*).

Objection that the invention is not new.

The objection that the invention comprised in a patent privilege is not new to the public, is taken both on the ground that the patent is contrary to the Common Law and the Statute of Monopolies, and also that the patentee has made a false representation to the Crown. The Statute of Monopolies, we have seen (*g*), expressly provides that a patent shall be void if the invention comprised in it was not new at the time of the making of the patent; and the Common Law also required that an invention should be new, in order to be made the subject of a grant by patent (*h*). A patent also shows that the patentee represented to the Crown that his invention was new, and if it was not so, the falsehood of the representation rendered the patent absolutely void (*i*).

Pleas for raising the objection of want of novelty.

When this objection is taken on the ground that the patent is contrary to the Common Law or Statute of Monopolies, it is sufficient for the defendant in his plea to state that the invention was not new to the public at the time of the making of the grant, and that by reason of such want of novelty the patent is void (*k*). The objection may also be taken under a plea alleging that the invention is not an invention of a *new* manufacture (*l*). And on the ground that the patent was originally void (*m*), it seems that it might also be taken under a plea of *non concessit*.

Invention not useful.

We have seen in preceding parts of this work (*n*), that an invention must be useful in some degree in order to be made the subject of a valid patent privilege.

The objection to a patent because the invention is not useful, it seems may be taken on the ground that the patent is contrary to law (*o*), and that it is contrary to the intent of the Queen (*p*). And if the patentee appears by the recital of his petition to have represented his invention to be useful, the

(*f*) *Spilsbury* v. *Abbott*, 1 Webs. R. 255.

(*g*) *Ante*, Chap. V. s. 2, p. 106.

(*h*) *Ante*, Chap. V. s. 2, p. 102.

(*i*) *Ante*, Chap. IV. p. 48, and vide *ante*, p. 63.

(*k*) See the Form of Plea in the Appendix, Chap. II. s. 4.

(*l*) *Walton* v. *Bateman*, 3 M. & G. 773.

(*m*) Vide *ante*, p. 264.

(*n*) *Ante*, Chap. I. p. 3, and Chap. V. s. 3, p. 132.

(*o*) See *Morgan* v. *Seaward*, 2 M. & W. 544.

(*p*) See Chap. V. s. 3, *ante*, p. 132.

patent will be void if the invention is not useful at all, or not useful in the way alleged by the patentee.

Plea for raising the objection of a want of utility to the public.

If the objection be taken on the ground that the grant is contrary to law, it cannot be sustained unless there is a total want of utility (*q*); and therefore a plea for raising that objection must allege, that the invention is not of *any* use, benefit, or advantage to the public (*r*). When the objection is taken on the ground that the patent is void by reason of a false representation, the plea for raising the objection must be framed according to circumstances. If the false representation appears on the face of the declaration, a plea alleging the want of utility may be sufficient; but if not, the plea must state the false representation made to the Crown, and then allege that it was false, and the patent therefore void (*s*).

And it seems that this objection may also be taken to a patent under the plea of *non concessit*, for if the patent be *void* in consequence of the inutility of the invention, it could not operate as a grant of privilege to the patentee in the manner alleged by the plaintiff (*t*).

But the utility of an invention is not put in issue by a plea denying that the invention is a new manufacture (*u*).

Morgan v. Seaward.

In the case of *Morgan* v. *Seaward* (*x*), the Court of Exchequer intimated a doubt as to whether the proper form of plea ought not to be in the words of the statute, that the patent was contrary to Law, or mischievous to the State, &c. (*y*), and not merely to plead the want of utility.

Jupe v. Pratt.

And in the case of *Jupe* v. *Pratt* (*z*), Mr. Baron *Alderson* intimated an opinion that it is not sufficient for such a plea to say that the invention is not useful, and that it ought to allege the invention to be prejudicial, as in *Arkwright's* case (*a*). The learned Judge seems to refer to the first suggestion in the writ of *scire facias*, in the case of *The King* v. *Arkwright* (*a*), but Mr. Justice *Buller* in that case held, that

(*q*) See Chap. I. p. 3, and Chap. V. s. 3, p. 102.

(*r*) See the Form of the Plea in the Appendix, Chap. II. s. 4.

(*s*) See the Form of such a Plea in the Appendix, Chap. II. s. 4.

(*t*) Vide *ante*, pp. 264, 268, as to the effect of this Plea.

(*u*) *Walton* v. *Bateman*, 1 Webs. R. 623.

(*x*) 1 Webs. R. 187-197; 2 M. & W. 544.

(*y*) See 21 Ja. I. c. 21, s. 6.

(*z*) 1 Webs. R. 151.

(*a*) Dav. P. C. 61.

the suggestion was too general, and that the prosecutor could not be permitted to give evidence in support of it (*b*).

Notwithstanding those authorities, a plea merely denying the utility of the invention in general terms, is pleaded in almost every action for the infringement of a patent; and it is probable that whenever the sufficiency of the plea is made the subject of judicial determination, it will be held to be valid on the ground stated in a former part of this work (*c*).

In the case of *Losh* v. *Hague* (*d*), the defendant raised an objection to the validity of the patent, by a plea alleging that the improvements invented by the plaintiff were trifling and insignificant, and not legal subjects for the grant of the patent. No decision was, however, necessary respecting the sufficiency of the plea, for the plaintiff joined issue upon it, and the issue was found for the plaintiff.

Losh v. Hague. Invention trifling and insignificant.

In the cases of *Morgan* v. *Seaward* (*e*) and *Beddells* v. *Massey* (*f*), it was held, that a plea denying the utility of an invention is quite different from a plea alleging that the plaintiff had falsely alleged his invention to be improvements.

Plea denying utility different from a plea that invention not an improvement.

Every patent for the sole use of an invention contains a proviso or condition, requiring that the patentee shall particularly describe and ascertain the nature of his invention, and the manner in which it is to be performed, by an instrument (usually called a specification), and to cause it to be enrolled in Chancery within a certain time after the date of the patent; and it is expressly declared that the patent shall be void if the condition is not complied with (*g*).

Objection that no sufficient specification has been enrolled.

The objection that the patentee has not enrolled a sufficient specification can only be taken to the patent on the ground that the non-performance of the condition has rendered the patent void, for a specification is not required either by the Common Law or the Statute of Monopolies.

Can only be taken on the ground of non-performance of the condition.

There are two objections which may be taken to a patent under this condition: the one upon the ground that there is no specification at all, or no sufficient specification; and the other upon the ground that the specification was not enrolled at all, or was not enrolled in due time. These two objections

Two objections, want of a sufficient specification, want of an enrolment.

(*b*) Dav. P. C. 79.
(*c*) Vide *ante*, Chap. I. and Chap. V. sec. 3.
(*d*) 1 Webs. R. 202.
(*e*) 2 M. & W. 544.
(*f*) 2 Dowl. & Low. 322.
(*g*) Vide *ante*, Chap. IV. p. 68, and Chap. VII. p. 151.

are frequently taken by separate pleas. The total want of a specification is a thing which rarely occurs, and therefore the common form of the objection is, that the specification which the patentee has made is insufficient.

Plea for raising the objection.

This objection is sometimes raised by a plea alleging that the patentee did not, by the instrument in writing under his hand and seal in the declaration mentioned, particularly describe

Plea that specification insufficient.

and ascertain the nature of the invention, and in what manner it is to be performed, in manner and form as in the declaration alleged (*h*). A plea in this form merely questions the sufficiency of the particular specification mentioned in the declaration, and must conclude to the country (*i*).

Plea setting out the specification.

It is frequently desirable that the specification should be put upon the record, in order that the defendant may have the benefit of objections arising from defects appearing on the face of it, either on demurrer or in a Court of Error. In order to do this, it is usual to set out the specification in the plea, and annex any plans or drawings contained in the specification; and then to conclude with a special traverse alleging that the plaintiff did not by the specification particularly ascertain and describe his invention as alleged in the declaration (*h*).

And in the case of *Muntz* v. *Foster* (*l*), the Court of Common Pleas held, that such a plea concluding with a common instead of special traverse, was bad on special demurrer.

Reference to specification as set out in a previous plea.

But if the specification has been set out in any previous plea, it will be sufficient to refer to the instrument as there set out, and conclude with a traverse of the performance of the condition in the patent as alleged in the declaration (*h*).

Plea that the specification was not enrolled.

The objection that the specification has not been enrolled, or not enrolled within due time, may be taken by a plea alleging that the specification or instrument in writing in the declaration mentioned was not enrolled within six (or four) calendar months after the date of the patent, as alleged in the declaration (*m*). And such a plea seems to be the proper plea for merely putting in issue the plaintiff's allegation of an enrolment of his specification in due time. It will be observed

(*h*) See the Form in the Appendix, Chap. II. sec. 4.
(*i*) *Bentley* v. *Goldthorp*, 9 Jur. 470.
(*k*) See the Form of Plea in the Appendix, Chap. II. s. 4.
(*l*) 1 Dowl. & Low. 737.
(*m*) See the Form of Plea in the Appendix, Chap. II. s. 4.

that the condition requiring the enrolment of a specification is not a condition precedent; but it seems that it is necessary for the patentee to allege that he has complied with the condition (*n*).

Plea that no sufficient specification has been enrolled.

The usual form of plea alleges that the patentee did not cause any sufficient specification to be enrolled within the time limited by the patent, and that by reason thereof the patent became void (*o*).

Title too large.

A patentee is bound to describe every part of the invention comprised in his patent, and if he fail to describe any part of it sufficiently, the patent is void (*p*). Where a patent contains a title too large for the actual invention of the patentee, the defendant may in some cases take advantage of the objection under a plea denying the sufficiency of the specification (*q*).

Part of invention not described.

For if it appears upon the face of the specification, that the patentee has neglected to describe something comprised in the patent privilege, the patent must be void by reason of the non-compliance with the condition. But the objection cannot be taken under that plea, unless it clearly appears upon the face of the specification, that the patentee has not described some part of the invention.

Other objections to a patent.

In addition to the objections which have already been mentioned, there are others which may be taken to a patent by proper pleas, such as, that the patent has become void by an assignment to or in trust for more than twelve persons, contrary to the condition of the patent; that the object of the invention was contrary to law, as for instance an invention of implements for housebreaking; or that the patentee has refused to supply articles for the public service, contrary to the condition in his patent.

Defendant may be precluded from taking any objection to the patent.

A defendant in an action for the infringement of a patent may, under some circumstances, be precluded from taking any objection to the validity of the patent.

Oldham v. Langmead.

Thus, in the case of *Oldham* v. *Langmead* (*r*), which was an

(*n*) See the judgment of *Tindal*, C. J., in *Muntz* v. *Foster*, 1 Dowl. & Low. 741, 742; and vide *ante*, p. 254.

(*o*) See the Form in the Appendix, Chap. II. s. 4.

(*p*) Vide *ante*, Chap. VII. p. 162.

(*q*) See the case of *Neilson* v. *Harford*, 1 Webs. R. 373.

(*r*) Cit. 3 T. R. 439.

In an action by an assignee, the patentee is estopped from objecting to the patent.

action brought by the assignee of a patent against the patentee, it was held by Lord *Kenyon*, that the defendant, the patentee, could not be permitted to show that the invention was not new, contrary to his own deed by which he had assigned the patent to the plaintiff (*s*).

Bowman v. Taylor.

A licensee estopped from objecting to the patent.

So also in the case of *Bowman* v. *Taylor* (*t*), in which it appeared that by a deed made between the plaintiff and the defendant, after reciting that the plaintiff had invented certain improvements in power-looms for which he had obtained a patent, and had enrolled a specification of the invention in pursuance of the patent, the plaintiff, for the consideration mentioned in the deed, agreed to permit the defendant to use the invention, and the defendant covenanted with the plaintiff to pay him certain sums of money for the use of the invention. The plaintiff brought the action for certain sums which had become due in pursuance of the deed, but which the defendant had not paid. The defendant pleaded three pleas in which it was alleged, that the patent was void on the ground that the invention was not new, that the plaintiff was not the inventor, and that the plaintiff had not enrolled a specification. And it was held upon demurrer that the defendant was estopped by the deed from taking the objections to the patent, which were mentioned in the pleas (*u*).

Not guilty.

The last plea which it is necessary particularly to mention, is the plea of not guilty; by which the defendant says that he is not guilty of any of the grievances alleged in the declaration. This plea, as already stated (*x*), had formerly a much more extensive operation in a patent action than it has at present: before the new pleading rules (*y*), made in pursuance of the stat. 3 & 4 W. IV. c. 42, s. 1, this plea had the effect of compelling the plaintiff to prove every thing necessary to support a patent for an invention; and also enabled the defendant to raise any objection he might think fit to the patent, and to make almost every possible defence to the action.

Effect of the plea limited to a denial of the breach.

By the new pleading rules, the effect of this plea is now limited to a denial of the wrongful acts complained of in the

(*s*) See Chap. IX. s. 2, *ante*, p. 236.
(*t*) 2 A. & E. 278.
(*u*) See also the case of *Baird* v. *Neilson*, 8 Cl. & Fin. 726, in the House of Lords, which was an appeal from a decision of the Court of Session in Scotland.
(*x*) Vide *ante*, p. 263.
(*y*) R. G. H. T. 4 Will. IV. 1834; Charn. New Rules, p. 125.

declaration; it does not therefore put in issue or deny the making of the invention, its novelty or utility, the grant of the patent, or the enrolment of the specification, or any other thing alleged in the declaration, except the breaches. The effect therefore of the plea is merely to deny the allegations contained in the breaches, it being admitted for the purposes of the issue raised on this plea, that the plaintiff is possessed of the patent privilege he alleges, and that it is a good and valid privilege (*z*).

Other defences to a patent action.

There are also other matters of defence which a defendant may avail himself of in a patent action, some of which may here be mentioned.

Thus, if a patent has been repealed by *scire facias*, the defendant in an action upon the patent will be at liberty to plead the judgment to repeal the patent in bar of the action (*a*). So if a patent has been made void by a declaration under the Privy Seal, or under the hands of six Privy Counsellors (*b*), such a declaration would be a defence to an action for infringing the patent. And if the patentee has been convicted of an offence which causes a forfeiture of the patent, it is apprehended that the forfeiture might be set up as a defence to any action he might bring upon the patent. If a patentee should commence an action for an infringement of his patent, after it had been assigned over to another, or after he had become bankrupt, or taken the benefit of the Insolvent Act, the assignment, bankruptcy, or insolvency might be pleaded as a defence to the action. And if he surrenders his patent to the Crown by a deed enrolled in Chancery, the surrender might be pleaded as a defence to any subsequent action he might bring for an alleged infringement of the patent.

Rule to plead several matters.

In an action for infringing a patent the defendant is allowed to plead several pleas, so as to raise every objection which can be taken to the validity of the patent, and the Court will always grant a rule permitting him to plead a *sufficient* number of pleas for that purpose. A patent action is, indeed, almost always brought for the purpose of trying the validity of a patent, and frequently in pursuance of an order of the Court of Chancery; and if the defendant was not permitted fairly

(*z*) Vide *post*, tit. Evidence, Chap. XI. Sci. fa. pl. 138, 131.
(*a*) Bro. Abr. title Pat. pl. 23; and (*b*) Vide *ante*, Chap. IV. p. 64.

to raise every legal objection to it, the object with which the action is brought would be frustrated.

Defendant will not be permitted to plead pleas which are not necessary or issuable.

But a defendant will not be permitted to plead more pleas than necessary, or to plead them in such a form that the plaintiff cannot take issue upon them. A defendant can rarely plead to a declaration in a patent action without obtaining an order for more time to plead than is allowed in the first instance, and he cannot obtain the order except upon the terms of pleading issuably. The defendant is, therefore, under the terms of this order bound to plead such pleas as the plaintiff can raise issues upon (either in Law or in fact), which will fairly decide the questions between the parties to the cause.

Beddells v. Massey, and Nickels v. Ross.

In each of the recent cases of *Beddells* v. *Massey* (c), and *Nichels* v. *Ross* (*d*), the defendant pleaded the following pleas: 1st, *Non concessit*. 2nd, That the patentee was not the true and first inventor. 3dly, That the invention was not an invention of such improvements as represented by the patentee, and therefore that the patent was void. 4thly, That the invention was not an invention of any manner of manufacture. 5thly, That the invention was not new. 6thly, That the invention was of no utility to the public. 7thly, That the specification mentioned in the declaration did not sufficiently describe the invention. 8thly, That the patentee did not enrol any sufficient specification; and, 9thly, Not guilty. The plaintiff in each of those cases obtained a rule to show cause why two of the pleas should not be struck out, (the first and third,) but the Court of Common Pleas, after argument, discharged the rules with costs.

Bunnett v. Smith.

In the case of *Bunnett and Corpe* v. *Smith* (*e*), which was an action by a patentee and the assignee of a moiety of a patent, the defendant applied to a Judge at Chambers for leave to plead similar pleas to those pleaded in *Beddells* v. *Massey*, with an additional plea traversing the allegation of assignment of a moiety of the patent. The learned Judge refused to allow the defendant leave to plead either *non concessit*, or the plea traversing the assignment. But the Court of Exchequer held that those two pleas were proper pleas, and gave the defendant leave to plead the whole of the Pleas.

(c) 2 Dowl. & Low. 322.
(*d*) Not yet reported.
(*e*) 13 M. & W. 552.

The pleas just mentioned to have been pleaded in the cases cited are indeed now the usual pleas to a declaration in a patent action; and although they do not raise every possible ground of defence, they are amply sufficient in a great majority of cases.

The pleas just mentioned are the usual pleas.

In the recent case of *Bentley* v. *Keighley* (*f*), the Court of Common Pleas allowed the defendant to plead a plea that a part of the invention was not a manufacture, in addition to a plea that the whole invention was not a manufacture within the meaning of the statute. And the Court granted leave to plead the additional plea in this case, on the ground that there might be a doubt whether a plea that the whole invention was not a manufacture within the statute, would enable the defendant to raise the objection that a part of it was not such a manufacture.

Bentley v. Keighley.

Plea will be allowed in a doubtful case.

But in the case of *Clark* v. *Kenrick* (*g*), in which a part of the invention had been disclaimed, under the statute 5 & 6 Will. IV. c. 83, s. 1, the Court of Exchequer refused to allow the defendant to plead pleas applicable to the whole invention, and also similar pleas to that part which was undisclaimed.

Clark v. Kenrick.

Pleas to the whole, and also to undisclaimed part, not allowed.

Several of the pleas which have been noticed, merely traverse some allegation contained in the declaration, and therefore conclude by the defendant putting himself upon the country, (as it is called,) so as to tender an issue in fact for trial by a jury. To such pleas the only replication necessary is a common joinder, by which the issue in fact is actually raised for trial.

Replications.

If a plea that the patentee was not the true and first inventor be merely a traverse of an allegation contained in the declaration, it must of course conclude to the country, and the replication to such a plea will therefore be a mere joinder of issue (*h*). But if the plea is not a traverse of any thing alleged in the declaration, it must show that the patent is void by reason of the patentee not being the true and first inventor, and conclude with a verification. The replication to such a plea must therefore allege affirmatively that the patentee was the true and first inventor of the invention, with a conclusion to the country (*h*). When the plea sets out the representa-

Replication to plea that patentee not the inventor.

(*f*) 1 Dowl. & Low. 944.
(*g*) 1 Dowl. & Low. 392.
(*h*) See a Form in the Appendix, Chap. II. s. 4.

tion made by the patentee that he was the true and first inventor, and then concludes by an averment that the representation was untrue, and that the patentee was not the true and first inventor, and the patent therefore void, the plaintiff is put to his election which part of the plea he will traverse. If the plea does not state correctly the representation which the patentee actually made to the Crown, it will be sufficient for the plaintiff to deny that part of the plea which alleges that he made the representation; but if the defendant sets out the representation correctly, then the only course for the plaintiff to adopt is to deny the latter part of the plea, and allege that the representation was correct (*i*).

Replication to a plea denying that invention is an improvement, or applicable in the way alleged.

So with respect to a plea denying that the invention is such an improvement as described in the title, or that it is applicable in manner mentioned in the title. In such a case if the declaration contain any express allegation of which the plea is a mere traverse, the plea will conclude to the country, and the replication will be only the common joinder of issue. But if the plea sets out the representation made to the Crown that the invention was an improvement of the description, or was applicable in the way mentioned in the title, alleging that the representation was false, and that the patent was therefore void, the plaintiff must, in his replication, either deny that such a representation was made, or allege that the representation was true,—of course concluding to the country (*k*).

Replication to a plea denying the utility of the invention.

The replication to a plea merely traversing an allegation contained in the declaration respecting the utility of the invention, will, of course, be only the common joinder. But if the plea alleges that the invention was of no use to the public, and that by reason thereof the patent was void, such a plea must conclude with a verification, and the replication to it must allege affirmatively that the invention was of use to the public.

Replication to a plea denying the novelty of the invention.

The same observations apply to a plea putting in issue the novelty of the invention: the replication to such a plea will either be a common joinder, or a traverse of the allegations of the plea as to the want of novelty.

Replication to a plea alleging

A plea alleging that the invention is not such an invention as

(*i*) See the Forms in the Appendix, Chap. II. s. 4.

(*k*) See the Forms in the Appendix, Chap. II. s. 4.

may be made the subject of a patent privilege, is generally framed in the terms of the sixth section of the Statute of Monopolies (*l*), and will seldom be a traverse of any allegation in the declaration. The replication to such a plea must therefore allege that the invention is such an invention as may be legally made the subject of a privilege, with a conclusion to the country.

that the invention cannot be the subject of a patent privilege.

A plea merely denying the sufficiency of the specification as alleged in the declaration, or the enrolment of it, will only require the common joinder by way of replication. But when the plea alleges that for want of a specification, or for want of a specification having been enrolled within six months, the patent has become void, the plaintiff must show a sufficient specification or enrolment in his replication.

Replication to plea denying the sufficiency of the specification.

The pleadings in a patent action very rarely extend beyond a rejoinder, for the replication is almost always either a joinder of issue, or a mere traverse of the defendant's plea. Therefore when a rejoinder becomes necessary, it is generally a mere similiter for the purpose of joining issue.

Rejoinder.

The plaintiff or defendant in a patent action may, of course, demur at any stage of the pleadings in precisely the same way as in other actions.

Demurrer.

It is rarely expedient for a plaintiff to demur in such an action, for a plaintiff's object is generally to establish his legal title to his patent privilege with as little delay as possible; and a demurrer is almost certain to postpone the final determination of a cause.

Rarely expedient for plaintiff to demur.

A defendant in such an action can rarely plead without having obtained an order for time, by which he is laid under terms to plead issuably: and in order to comply with these terms, the defendant must plead pleas upon which the plaintiff can join issue, and go to trial upon the merits.

If a defendant plead any plea in violation of these terms in such an order, the plaintiff may sign judgment against him as for want of a plea. The plaintiff therefore has sufficient security that a defendant in such an action will not plead a frivolous plea; and if a plea is good in substance, it can seldom be beneficial for a plaintiff to demur to it on account of

(*l*) See the Forms in the Appendix, Chap. II. s. 4.

any defect in form merely. And indeed he ought never to demur to any pleading of the defendant on the ground of informality only, or in any case, unless he will be prejudiced by pleading over instead of demurring.

Seldom for the benefit of a defendant to demur.

And it is seldom for the benefit of a defendant in such an action to demur, for during the time the action is pending, he must generally be uncertain respecting his right to manufacture the article which is complained of as an infringement of the patent; and if it should ultimately turn out that he has been violating a valid patent right belonging to the plaintiff, he will have been employing his time and capital for the benefit of the plaintiff, who will be entitled to the whole of the profits.

It must always require some considerable time to bring a patent action to a determination; and for the reasons already given, it is not often to the interest of either party to cause more delay by any unnecessary demurrer. Demurrers, therefore, are rarely seen in such an action, each party preferring to take issue in fact upon the pleading of the opposite party when he can do so safely and without prejudice to his case.

Notice of objections.

Before the making of the new pleading rules, the defendant in a patent action was permitted to raise every possible objection to the patent by way of defence, under the plea of not guilty (*m*). This operated very much to the prejudice of patentees, who were frequently taken by surprise at the trial by some objection which was quite unexpected. The new pleading rules operated very beneficially by limiting the effect of the plea of not guilty to a denial of the alleged wrongful act or acts stated in the declaration, and by compelling the defendant to raise the objections which he intends to take to the patent by some plea showing the ground upon which he alleges that the patent is void.

Stat 5 & 6 Will. IV. c. 83, s. 5.

Defendant on pleading to give plaintiff notice of objections.

By the 5th section of the statute 5 & 6 Will. IV. c. 83, it was enacted, "That in any action brought against any person for infringing any letters patent, the defendant on pleading thereto shall give to the plaintiff [and in any *scire facias* to repeal such letters patent, the plaintiff shall file with his de-

(*m*) Vide *ante*, p. 278.

claration] a notice of any objections on which he means to rely at the trial of such action; and no objection shall be allowed to be made on behalf of such defendant [or plaintiff respectively] at such trial, unless he prove the objections stated in such notice: Provided always, that it shall be lawful for any Judge at Chambers, on summons, served by such defendant [or plaintiff] on such plaintiff [or defendant respectively], to show cause why he should not be allowed to offer other objections whereof notice shall have been given as aforesaid, to give leave to offer such objections on such terms as to such Judge shall seem fit."

No objection to be allowed unless defendant prove the objections in the notice.

Judge may give leave to offer other objections.

It is probable that, at the time this Act was drawn, the beneficial operation of the new pleading rules, in favour of patentees in patent actions, was unknown, or not considered; but be that as it may, the statute was passed *after* the new pleading rules came into operation, and therefore the enactment in question must be deemed to have been made for the purpose of giving the plaintiff in a patent action some benefit other than that which he derived from the new pleading rules.

Act passed after new pleading rules, and therefore intended to give plaintiffs additional benefits.

For this reason it has been decided that it is not sufficient, in a notice given under the statute, to specify every objection in as general terms as in a plea. In some cases indeed a plea states an objection with as much particularity as can be required in a notice: thus, the objection that the patentee was not the true and first inventor, is stated with as much particularity in a plea as can possibly be required in a notice of objections, for the nature of the subject does not admit of anything more being stated, unless the defendant was to mention the evidence by which he would establish his objection; and it is clear that the statute was not intended to compel a defendant to state his evidence in the notice. But whenever a plea will enable a defendant at the trial to raise several different and distinct objections to the patent, the patentee is entitled under the statute to notice of the objections upon which the defendant intends to rely in a form more specific and particular than the plea.

Notice must not be as general as the pleas.

Except in cases where nothing more can be given without stating the evidence.

If a plea enables a defendant to offer several distinct objections, they must be particularized.

It has been decided that the Courts of Common Law have jurisdiction over the notices to be given in pursuance of this statute; and that whenever such a notice is not sufficient, the defendant may be ordered to amend it in the several re-

Courts have jurisdiction over notices, and may order better notices to be delivered.

spects in which it is insufficient, or to deliver a fuller and more particular notice (*n*).

Power of Courts to order better notices derived from their general jurisdiction over proceedings before them.

The power of the Courts to order further and better notices of objections, is derived from their general jurisdiction over all proceedings in actions before them, precisely in the same way as they derive their power over particulars of a set-off, pleaded by a defendant in pursuance of the statute of set-off, from their general jurisdiction.

Differences in opinions respecting the particularity of notices.

There has been some difference in opinion amongst the Judges respecting the particularity necessary to be observed in framing notices under this statute; but almost all the reported cases on the subject have arisen upon applications for further and more particular notices of objections, and there are very few reported cases of decisions respecting the sufficiency of such notices to let in any particular objection at *Nisi Prius*.

Only question at Nisi Prius is, whether notice sufficiently extensive.

Indeed it has been decided, that the only question which can arise at *Nisi Prius* respecting such a notice is, whether the language of the notice is sufficient to include any particular objection made by the defendant (*o*).

Fisher *v.* Dewick.

In the case of *Fisher* v. *Dewick* (*p*), it was decided, that a notice of objections which is vague, and calculated to mislead the plaintiff, is not a sufficient compliance with the statute, and a further and better notice was ordered. And it was held in that case, that an objection, "That if any part be new the same is useless and unnecessary," was insufficient; and that the defendant should have pointed out what part. And an objection, "That the improvements, or some of them, have been used long before," was also held insufficient, because the defendant ought to have pointed out which of the improvements had been used before.

Notice which is vague and calculated to mislead insufficient.

Bulnois *v.* Mackenzie. Order that defendant should give names, &c. of persons who used the inven-

In the case of *Bulnois* v. *Mackenzie* (*q*), it appeared that one of the objections stated that the invention had been used by *J. H. M.*, and others, before the grant of the patent. *Vaughan*, J., at Chambers, ordered (amongst other things) that the defendant should furnish the plaintiff with the names,

(*n*) *Bulnois* v. *Mackenzie*, 4 Bing. N. C. 127; *Losh* v. *Hague*, Gods. 2nd ed. 239.

(*o*) *Neilson* v. *Harford*, 1 Webs. R. 370; 8 M. & W. 822.

(*p*) 1 Webs. R. 264; 4 Bing. N. C. 706.

(*q*) 4 Bing. N. C. 127.

addresses, &c., of the persons referred to in this objection; but the Court of Common Pleas afterwards set aside so much of the order as related to the names, addresses, &c. of these persons.

tion before the date of the patent set aside.

In the case of *Galloway* v. *Bleaden* (r), the defendant had delivered a notice stating that the invention was old, and had been used by persons named, and divers other persons, before the date of the patent. Upon a summons at Chambers in this case, *Coltman*, J., ordered that the names, addresses, and descriptions of the persons who had used the invention to be given, and the words "and divers other persons" to be struck out.

Galloway v. Bleaden.

Names, &c. ordered to be given.

In the case of Jones v. *Berger* (s), one of the defendant's objections was, that the patentee was not the true and first inventor, the same having been published by certain persons named in the specifications of their patents (which were sufficiently referred to), "and also by other persons in other books and writings" before the date of the patent. The Court of Common Pleas held this objection was insufficient, and ordered the defendant to specify the books he intended to rely upon. Another objection was, that the invention had been known and practised by persons at Nottingham and elsewhere, before the patent. The Court held this objection also to be insufficient, and ordered the words "and elsewhere" to be struck out, and the names of the other places inserted.

Jones v. Berger.

Books ordered to be specified.

Names of places to be given.

In the case of *Heath* v. *Unwin* (t), the defendant gave notice of the following objections: *first*, that the patentee was not the inventor of the improvements, in respect of which the patent was alleged to be in force; *secondly*, that the specification and disclaimer in the declaration mentioned did not sufficiently describe the nature of the invention, and the manner in which it was to be performed; *thirdly*, that the invention did not produce the effect stated in the specification, nor was such effect produced by the plaintiff in the manner therein stated; *fourthly*, that the invention was not new, and was either wholly or in part used and made public before the

Heath v. Unwin.

(r) 2 Chit. Arch. Prac. 1031; 1 Webs. R. 522.

(s) 5 M. & G. 208; 1 Webs. R. 544, *S. C.*

(t) 2 Dowl. & Dowl. 482; 10 M. & W. 681, *S. C.*

obtaining the letters patent; *fifthly*, that the invention did not essentially differ from other similar inventions, which were in public use at or before the granting of the said letters patent; *sixthly*, that the defendant had the plaintiff's leave and licence to make use of the improvements for which the letters patent were granted. The plaintiff obtained a rule to show cause why the defendant should not deliver a further and better particular of the objections intended to be relied on. The Court of Exchequer held, upon the authority of the case of *Fisher* v. *Dewick* (*u*), that the fourth objection was insufficiently stated; and that it was not sufficient to say that an alleged invention was *wholly or in part* made public before the obtaining the letters patent, but that it should be shown what part was so used. The Court therefore ordered the fourth objection to be amended, but held that all the other objections were sufficiently stated. In giving judgment in this case, Lord *Abinger*, C. B., (after expressing an opinion that the fourth objection was not sufficient,) said, that "With respect to the second (objection), surely it is enough for the defendant to say that the specification does not properly set forth the invention. *The legislature never intended that the defendant should argue his case in the statement of objections, which he delivers in compliance with the Act.*"

All the objections except the fourth sufficiently stated.

In the case of the *Queen* v. *Walton* (*x*), which was a *scire facias* to repeal a patent, the notice of objections stated, that before the granting of the defendant's patent, a patent, comprehending part of the invention claimed by him, had been granted to one Thomas Hancock, and that part of the invention used, but neither the declaration nor the notice of objections specified the name of any person supposed to have used such part of the invention. The defendant applied to the Master of the Rolls for an order upon the prosecutors to deliver a particular of such names, but the order was refused. After the record had been brought into the Court of Queen's Bench, the defendant obtained a rule in the latter Court calling upon the prosecutor to show cause "why he should not deliver to the attorney or agent for the defendant a state-

R. v. Walton. Order for names, &c. of persons who had used the invention refused by Master of the Rolls.

(*u*) 4 Bing. N. C. 706.

(*x*) 2 Q. B. 969.

ment in writing containing the names and places of abode of the persons whom he intended, upon the trial of the cause, to prove had manufactured or used the invention; or why, in default thereof, the prosecutor should not be precluded from giving evidence of such prior manufacture or use." The rule was obtained on an affidavit, stating that the defendant had no other means of gaining the information required, and was in danger of being taken by surprise at the trial, unless the particulars were ordered. The Court after argument and taking time to consider, discharged the rule, and Lord *Denman*, C. J., said, in delivering the judgment of the Court, "We agree with the Master of the Rolls, rather than with the Court of Common Pleas (*y*), and think that the particulars should not be ordered."

And the Queen's Bench discharged a rule *nisi* for such names, &c.

In the case of *Russell* v. *Ledsam* (*z*), which was an action for the infringement of a patent, for an additional term granted to the assignee of the original patent, the defendant gave notice of objections:—*first*, That the original patentee was not the true and first inventor; *secondly*, That the invention was not new; *thirdly*, That the new letters patent and the report of the Judicial Committee of the Privy Council, whereon the new letters patent were founded, were obtained by fraud and misrepresentation. The plaintiff obtained a rule *nisi* for further and better particulars of the objections, which the Court made absolute as to the second and third objections, but discharged it as to the other. In delivering the judgment of the Court of Exchequer, *Parke*, B., said, "The principal point discussed was, whether or no it was necessary in an objection on the ground that the patentee was not the first inventor, or that the invention was not new, that the defendant should state who was the first inventor, or when and in what place, and under what circumstances, it was used before. This point is not new, for it has been already before this Court, and also before the Court of Common Pleas, in the case of *Bulnois* v. *Mackenzie* (*a*). In that case the Court of Common Pleas would not require those particulars to be given,

Russell v. Ledsam.

Defendant will not be compelled to state who was the first inventor, or under what circumstances the invention was used before the date of the patent.

(*y*) In *Jones* v. *Berger*, 1 Webs. R. 544, cited *ante*, p. 287.

(*z*) 11 M. & W. 647; 1 D. & L. 347.

(*a*) 4 Bing. N. C. 127.

and their example has been followed by this Court, in the case of *Heath* v. *Unwin* (*b*). In the subequent case, however, of *Jones* v. *Berger* (*c*), the Court of Common Pleas deviated from their former decision in *Bulnois* v. *Mackenzie*, and compelled the defendant to give the name of the first inventor. On consideration of the matter, however, we think that we ought to abide by the cases of *Heath* v. *Unwin*, and *Bulnois* v. *Mackenzie*, and that no particulars of the circumstances under which this invention may have been previously used, should be required from the defendant; and we are fortified in this view by the decision of the Court of Queen's Bench, in the case of *Regina* v. *Walton* (*d*), in which they adopted the same view. That was originally an application to the Master of the Rolls, which afterwards came before the Court of Queen's Bench, which we find, on enquiry, to have determined this point the same way. On the authorities, therefore, we are bound to say that no such particulars ought to be required as are here asked for; and the argument is very strong to confirm the propriety of that course, *viz.*, that to require the defendant to afford this information, would be throwing the burden of proof on the wrong party. This rule must, therefore, be discharged as to this part of it, and can only be made absolute so far as it requires the defendant to point out whether he means to object to the patent altogether, as being granted for what was in reality an old invention; and if he only proposes to object to part, then he must state what part. If he means to object to the entire patent, he may state that he objects to it generally as not new; if he means to object to a particular part, he must designate that part. Then with respect to another objection which has been made, relative to the part of the notice which reiterates the terms of the plea that the patent was obtained by fraud, covin, and misrepresentation, we certainly think that the defendant ought to state in what that fraud consisted, and what was the species of misrepresentation by which he means to allege that the patent was obtained from the Privy Council. This rule will therefore be made absolute so far as it requires the defendant to furnish better particulars

To require defendant to give the information would throw the burthen of proof on the wrong party.

Defendant must state whether the whole or part of invention not new.

Particulars of fraud must be stated.

(*b*) 2 Dowl. & Dowl. 482; 10 M. & W. 684, *S. C.*

(*c*) 5 M. & G. 208; 1 Webs. R. 544.

(*d*) 2 Q. B. 969.

of the fraud, covin, and misrepresentation mentioned in the plea, and also so far as requiring the defendant to state either that he objects to the patent generally as not being a new invention, or that he only objects to part of it on that account, in which case he must specify what part. In all other respects the rule must be discharged."

Bentley v. Keighley.

And in the recent case of *Bentley* v. *Keighley* (*e*), in the Court of Common Pleas, the notice of objections stated that the invention was known to M. R. "*and others*," before the date of the patent; and that from them, or one of them, the patentee acquired a knowledge of the invention: that M. R., J. W., "and others," were respectively the first and true inventors:—and that the invention before the date of the patent was used by M. R., the patentee, "and others." The plaintiff obtained a rule *nisi* for a better notice of objections, and it was objected that the words "and others" made the notice too general, and that they ought to be expunged, but the Court discharged the rule.

Common Pleas refused to strike out the words "and others."

Although plaintiffs always profess to apply for further and better particulars of objections, on the ground that the notice does not furnish them with sufficient information; the real motive generally is to get rid of some of the objections, or to restrict the defence as much as possible. The object of the statute, however, was not to limit the defence, but to diminish the expense at the trial, and prevent the patentee from being taken by surprise (*f*).

Object of the statute was not to limit the defence.

But as a defendant in a patent action always takes care to state every possible objection which can be taken to the patent, the plaintiff does not really derive any advantage from the notice; and it is not improbable that section *five* of the statute 5 & 6 Will. IV. c. 83, which gives the plaintiff a right to the notice, will be repealed as useless, and productive of much unnecessary cost and vexation.

Notice of little benefit.

Patent actions are always tried at *Nisi Prius*, and not at the bar of the Court, although the Court might, if it pleased, order a trial at bar. Few causes require so much care and industry in preparing for trial as patent actions, in which very nice points of law, and difficult questions of fact, must often

Trial.

(*e*) 1 Dowl. & Low. 946.

(*f*) Per *Tindal*, C. J., *Fisher* v. *Dewick*, 1 Webs. R. 267; 4 Bing. N. C. 706.

be decided between the parties; and it will frequently happen that a party will succeed or fail in obtaining a verdict, according to the industry with which he has got up his case for trial. Properly to understand the questions raised in such actions, and prepare the necessary proofs, a competent knowledge not only of law, but also of science in general, and the useful arts, are essentially requisite.

Plaintiff entitled to have his action tried although a *scire facias* is pending.

The plaintiff is entitled to have his action tried notwithstanding the pendency of an action of *scire facias* to repeal the patent. For the plaintiff has no means of compelling a prosecutor to proceed to trial with a *scire facias*, and even if he had the means, the result must be deemed to be uncertain; and if the patentee obtains a verdict in the *scire facias*, he will have been prejudiced by the trial of his action for an infringement having been delayed.

Muntz v. Foster.

In the case of *Muntz* v. *Foster* (*g*), in the Common Pleas, which was an action for damages for the infringement of the plaintiff's patent, it appeared that the defendants (who were under an injunction) had brought an action of *scire facias* to repeal the plaintiff's patent, and that according to the ordinary practice of the Queen's Bench it would have been tried before the action in the Common Pleas; but that in consequence of special circumstances the trial of the *scire facias* had been delayed. The questions respecting the validity of the patent were the same in each case, and the defendants in the Common Pleas having obtained a rule *nisi* to postpone the trial of the action in that Court, it was contended for them, that as the right of the plaintiff to maintain the action might be altogether destroyed by the proceeding in *scire facias*, they ought not to be compelled to go to trial in the action for an infringement, but that the proceedings ought to be staid; that the defendants being under an injunction, the plaintiffs could not be prejudiced by the delay, the delay being rather to the prejudice of the defendants, who were willing to submit to the injunction in the mean time. But the Court discharged the rule, and the Lord Chief Justice *Tindal* said, in giving judgment, "As a general rule, a plaintiff has a right to have his cause go on to trial according to the ordinary course of

Court will not stay a trial because a *scire facias* is pending.

(*g*) 1 Dowl. & Low. 942.

business. Special circumstances may exist, upon which the Court may see fit to interpose; but the present does not appear to us to be a case in which we ought to interfere, by staying the proceedings in the action."

Trial will only be stayed under special circumstances.

But in the case of *Patteson* v. *Holland* (*h*), in the Common Pleas, where one action for the infringement of a patent had been tried, and a rule *nisi* for a new trial had been obtained and argued; and it appeared that another action was pending in that Court for another infringement of the same patent, and that a *scire facias* had been sued out to repeal the patent, the Court suspended their judgment upon the rule for a new trial, and ordered the trial of the other action to be postponed until after the trial of the *scire facias*.

Patteson v. Holland.

Trial of a second action postponed where *scire facias* pending.

And in the case of *Smith* v. *Upton* (*i*), in the Common Pleas, it appeared that the defendant had sued out a *scire facias* to repeal the plaintiff's patent, and a verdict had been obtained for the Crown, but a rule *nisi* for a new trial was pending in the Queen's Bench. Whilst the rule for a new trial was pending in the Queen's Bench, the defendant in the action in the Common Pleas gave notice of trial by proviso, but the Court, upon the application of the plaintiff, made a rule absolute for postponing the trial.

Smith v. Upton.

Trial postponed where *scire facias* pending and notice of trial by proviso given.

The defendant in a patent action almost always pleads not guilty, or some other plea, raising an issue upon which the burthen of proof rests with the plaintiff. The plaintiff's counsel in such an action, therefore, generally obtains the right to begin, and also to reply, at the trial of the cause, if the defendant calls witnesses. As the determination of the issues, in fact, in an action respecting a patent frequently turns upon nice distinctions and the credit to be given to the respective witnesses, the right to reply is generally esteemed to be of the greatest value; and a defendant will sometimes have recourse to an action of *scire facias*, in order to obtain this advantage.

Right to begin and to reply.

The reading of the notice of objections will not give the plaintiff's counsel a right to reply; and it seems that the proper course is, that the notice should be read at the time the pleadings are opened (*k*).

(*h*) T. T. 1845, not yet reported.
(*i*) 6 M. & G. 251.
(*k*) *Neilson* v. *Harford*, 1 Webs. R. 309, n. (*h*).

Objections at the trial.

It is provided by the 5 & 6 Will. IV. c. 83, s. 5, already noticed (*l*), that no objection shall be allowed to be made on behalf of a defendant at the trial, unless he prove the objections stated in his notice. The language of this enactment is very extraordinary; and it seems that according to the letter of this law, if a defendant were to prove the objections stated in his notice, he would not be prevented from taking other objections (*m*). This, however, could hardly be the intention of the legislature; and although there has been no decision upon the point, yet it is apprehended that a defendant cannot be permitted to take any objection which is not actually stated in the notice. For in a subsequent part of the same section of the Act, it is provided that a Judge at Chambers may give leave to a defendant to offer other objections beside those included in his notice, which would have been unnecessary if the proof of the objections stated in the notice would enable the defendant to take others also.

The only question at the trial respecting a notice is, whether the language of it is sufficiently extensive.

There are very few, if any, reported decisions respecting the sufficiency of notices to let in the defendant's objections at *Nisi Prius*. It has, however, been held, that the only question which can arise at *Nisi Prius* respecting such a notice is, whether the language of it is sufficiently extensive to include any particular objections sought to be raised by the defendant (*n*).

The statute only extends to objections to the validity of the patent.

It seems that the provision of the statute respecting notices must be construed to extend only to objections *to the validity of the patent;* and that it is unnecessary (although usual) to state in the notice of objections that the defendant will deny the alleged infringement of the patent. And if a defence to the action should be a denial under the plea of *non concessit*, that there is in fact any such patent as the plaintiff alleges, it does not appear to be necessary to state the defence in the notice of objections; for if the defence can be sustained, it is not an objection to a patent, no such patent as alleged being in existence. So if the defendant objects to the patent being received in evidence for want of a stamp, the objection does not seem to be one of which notice need be given to the plaintiff.

(*l*) Vide *ante*, p. 284.

(*m*) Vide per *Rolfe*, B., in *Neilson* v. *Harford*, 1 Webs. R. 332.

(*n*) *Neilson* v. *Harford*, 1 Webs. R. 370.

The defendant cannot at the trial be allowed to take any objection to the validity of the patent, unless he has raised the objection by a proper plea (*o*), even if proper notice has been given of the objection (*p*); for the notice of objections was not intended to supersede the necessity of the pleas required by the rules of pleading.

Defendant cannot take any objection without a proper plea.

But although a defendant is at liberty to take any objection to a patent which comes fairly within the meaning of the language in his notice, yet he must make the objection clear at the trial, so that the plaintiff's attention may be called to it, or the defendant will not afterwards be allowed the benefit of his objection upon a rule *nisi* to enter a nonsuit or verdict for him (*q*).

Defendant must state his objections clearly at the trial.

It is the province of the jury at the trial to determine each issue in fact which is developed by the pleadings; but they have nothing to do with the notice of objections further than to decide whether the several objections raised by the defendant are founded in fact, the sufficiency of the notice to let in the objections being a question for the Judge.

Sufficiency of notice of objections to be determined by judge.

Although the maintenance of patent rights is in some measure an infringement of the rights of the public (*r*), yet the interest which the public has in the encouragement held out to inventors by the grant of such exclusive rights is quite as great.

Interest of the public in having questions respecting patents fairly decided.

In the trial of a patent action, therefore, the public is only interested to have the questions as to the validity or invalidity of the patent fairly decided between the parties. But even if it were to the interest of the public to have a particular patent destroyed, yet at the trial of an action upon such a patent the consideration of the benefit or convenience which would accrue to the public by having the patent destroyed must be entirely disregarded.

The benefit to the public by destruction of a patent not to be considered.

Thus in the case of *Arkwright* v. *Nightingale* (*s*), it was urged by the defendant's counsel, that it was highly for the public benefit that a verdict should be given against Mr. Arkwright the patentee; but Lord *Loughborough*, before whom

Arkwright v. Nightingale.

(*o*) *Walton* v. *Potter*, 1 Webs. R. 601.

(*p*) *Gillet* v. *Wilby*, 1 Webs. R. 270; 9 C. & P. 334.

(*q*) *Beckford* v. *Skewes*, 1 Webs. R. 219.

(*r*) Vide *ante*, Chap. I. p. 2.

(*s*) Dav. P. C. 51, 52, 55.

the cause was tried said, "We must never decide private rights upon any idea of public benefit. I must tell the jury that they must shut out that part of the argument. I cannot let a cause between *A.* and *B.* be determined upon consequential reasons, that it is beneficial to the public that *A.* should prevail." And although it was urged for the defendant, that by the statute against monopolies (*t*), no patent is to prevail that is generally inconvenient or against public trade, yet his Lordship held that the question of public benefit must be excluded; and said, that "Nothing could be more essentially mischievous than that questions of property between *A.* and *B.*, should ever be permitted to be decided upon considerations of public convenience or expediency. The only question that can be agitated in Westminster Hall, is which of the two parties in law or justice ought to recover."

Damages.

The plaintiff in a patent action is, strictly speaking, entitled to recover such an amount of damages as will fairly compensate him for the injury which he has sustained by reason of the wrongful Acts of the defendant proved at the trial. Patent actions, however, are generally brought merely to try the validity of the letters patent, and not for the recovery of substantial damages from the defendants. It is usual, therefore, to ask and obtain a verdict for nominal damages only, for a patent being once established at Law, the Court of Chancery will afterwards support, and effectually protect, the rights of the patentee.

Usual to give a verdict for nominal damages only.

What must be proved to obtain substantial damages.

In order to recover substantial damages in a patent action, it would be necessary for the plaintiff to give such evidence as would enable the jury to estimate the extent of the loss and injury which he has sustained; and in the absence of such evidence, the plaintiff is not entitled to more than nominal damages. And even in a second action upon a patent which has been held to be valid, the plaintiff is not entitled, in the absence of such evidence, to more than nominal damages (*u*).

Difficulty of procuring evidence of infringements.

The infringement of a patent is usually carried on in secret; and even when that is not so, a patentee would find much difficulty in procuring the evidence necessary to show the

(*t*) 21 Jac. I. c. 3, s. 6.

(*u*) *Minter* v. *Mower*, 1 Webs. R. 138; see the observations of Lord *Loughborough*, in *Arkwright* v. *Nightingale*, Dav. P. C. 55.

actual extent to which a defendant has carried the infringement so as to enable a jury to award him an adequate remuneration for the injury he has sustained.

Plaintiff may recover recompence in equity.

In a Court of Equity, however, where a defendant is obliged to make full discovery on oath of all the particulars in any way relating to the infringement of the patent, and the amount of profit he has thereby made, as well as to produce all his books, accounts, &c., the plaintiff may recover some adequate recompence for the amount of his losses (*x*).

Plaintiff's have in some cases recovered substantial damages at law.

There have been cases, however, in which plaintiffs have recovered substantial damages for the infringement of their patent rights (*y*); and where a plaintiff is able to give evidence of any considerable amount of infringement, it may be better in some cases at once to seek for substantial damages at the hands of a jury rather than have recourse to dilatory and expensive proceedings in the Court of Chancery.

If a suit in equity is pending, plaintiff should not ask more than nominal damages.

If a suit in Equity is pending or intended to be commenced against the defendant in a patent action, the plaintiff ought not to ask for more than nominal damages at the trial of the action; for he cannot claim to be recompensed twice, and if he has once asked a jury to assess them, he cannot afterwards, it is apprehended, go into a Court of Equity, and say that the jury have not sufficiently recompensed him for the injury which he has sustained.

Usual to endeavour to procure a verdict for 40*s.* to carry costs.

But it is usual for a plaintiff to endeavour to procure a verdict for forty shillings at least, because a verdict for a smaller amount of damages will not, since the passing of a recent statute (*z*), enable him to recover his costs in the action.

Motion for new trial generally made.

New and important points of law frequently arise at the trial of patent causes, and a verdict for the plaintiff or defendant in such a cause is generally followed by an application by the unsuccessful party for a new trial, for a nonsuit, or for judgment, notwithstanding the verdict. There is, however, nothing particular respecting such applications which need to be noticed in a work of this description.

(*x*) Vide sec. 3, *post*, in this Chap.

(*y*) See *Lewis* v. *Mc Ling*, 4 C. & P. 52, in which the plaintiff obtained a verdict for 200*l.* damages. There is, however, no subsequently reported case in which more than nominal damages was recovered.

(*z*) 3 & 4 Vict. c. 24.

Costs. Nominal damages formerly carried costs.

Before the passing of a recent statute, (3 & 4 Vict. c. 24,) nominal damages in a patent action were sufficient to entitle the plaintiff to recover his full costs against the defendant; but the Judge before whom the action was tried might have certified, under the 43 Eliz. c. 6, s. 2, to deprive the plaintiff of costs.

Stat. 3 & 4 Vict. c. 24, s. 1.

By the statute 3 & 4 Vict. c. 24, s. 1, so much of the 43 Eliz. c. 6, as relates to costs in actions of trespass on the case, (which includes patent actions) is repealed; and by section 2, it is enacted, "That if the plaintiff in any action of trespass, or trespass on the case brought in any of the Courts at Westminster, or the Courts of Common Pleas at Lancaster or Durham, shall recover by the verdict of a jury less damages than forty shillings, such plaintiff shall not be entitled to recover or obtain from the defendant, in respect of such verdict, any costs whatever, whether it shall be given upon any issue or issues tried, or judgment shall have passed by default, unless the Judge or presiding officer before whom such verdict shall be obtained, shall *immediately afterwards* certify on the back of the record, or on the writ of trial or writ of inquiry, that the action was really brought to try a right, besides the mere right to recover damages for the trespass or grievance for which the action shall have been brought, or that the trespass or grievance in respect of which the action was brought, was wilful and malicious."

If plaintiff recover less damages than 40*s.* he is not to be entitled to any costs.

Unless the Judge certify that the action was brought to try a right.

Statute deprives plaintiff of costs unless he obtains a certificate.

The effect of this enactment is to deprive the plaintiff in a patent action of any costs whatever, unless he procures a certificate by the Judge who tries the cause that the action was really brought to try a right, besides the mere right to recover damages (*a*).

Gillet *v.* Green.

In the case of *Gillet* v. *Green* (*b*), which was tried immediately after the stat. (3 & 4 Vict. c. 24,) came into operation, the effect of the statute upon patent actions was not adverted to. The plaintiff in that case obtained a verdict for nominal damages, but did not apply for a certificate under the Act; and it was held by the Court of Exchequer, that the statute clearly applied to the action, and deprived the plaintiff of all right to costs. And in the same case it was held, that the

Certificate can only be granted.

(*a*) See the Forms of Certificates in the Appendix, Chap. II. s. 4.

(*b*) 7 M. & W. 347.

Judge had not power afterwards (several months had elapsed) to grant the plaintiff a certificate, and the Court intimated that it might even be a question whether the Judge could grant the certificate after another cause had been called on.

Immediately after trial.

By the statute 5 & 6 Will. IV. c. 83, s. 6, it is enacted, "That in any action brought for infringing the right granted by any letters patent, in taxing the costs thereof, regard shall be had to the part of such case which has been proved at the trial, which shall be certified by the Judge before whom the same shall be had, and the costs of each part of the case shall be given according as either party has succeeded or failed therein, regard being had to the notice of objections, as well as the counts in the declaration, and *without regard to the general result of the trial.*"

Stat. 5 & 6 Will. IV. c. 83, s. 6. In taxing costs, regard to be had to part of case proved and certified by judge.

It was decided in the case of *Losh* v. *Hague* (*c*), that this enactment does not repeal sect. 74 of the general rules of Hilary Term, 2 Will. IV. (*d*), as to patent actions. By that rule, it is ordered that "No costs shall be allowed on taxation to a plaintiff upon any counts or issues upon which he has not succeeded; and the costs of all issues found for the defendant shall be deducted from the plaintiff's costs."

The statute does not repeal R. G. H. T. 2. Will. IV. s. 74. Costs to be allowed to each party upon the issues upon which he has succeeded.

In *Losh* v. *Hague* (*c*), there were four issues raised by the pleadings, and the defendant had given notice of seven objections to the patent. At the trial the defendant succeeded in establishing one of his objections, which was applicable under the third issue, but failed as to his other objections, and the plaintiff had a verdict upon the other three issues. The issue upon which the defendant succeeded being a bar to the whole cause of action, the Master in taxing the costs allowed the defendant *the general costs* of the cause, as well as those on the third issue, from which he deducted the plaintiff's costs of the three issues upon which he had succeeded. It was contended for the plaintiff, that the above section of the general rules was rendered inoperative by the 6th section of the stat. 5 & 6 Will. IV. c. 83; and that the plaintiff was therefore entitled to three fourths of the *general* costs of the cause. The Court of Exchequer, however, held that the statute had not the effect contended for, and that the defendant was entitled to the general costs of the cause.

Losh v. Hague.

(*c*) 7 Dowl. 495. (*d*) Charn. New Rules, p. 64.

Treble costs. Stat. 5 & 6 Will. IV. c. 83, s. 3.

Judge may certify that the validity of a patent came in question before him.

By the stat. 5 & 6 Will. IV. c. 83, s. 3, it is enacted, that "If any action at Law [or any suit in Equity] for an account shall be brought in respect of any alleged infringement of such letters patent heretofore or hereafter granted [or any *scire facias* to repeal such letters patent], and if a verdict shall pass for the patentee or his assigns, [or if a final decree or decretal order shall be made for him or them upon the merits of the suit,] it shall be lawful for the Judge, before whom such action shall be tried, to certify on the record (*d*), [or the Judge who shall make such decree or order, to give a certificate under his hand,] that the validity of the patent came in question before him; which record or certificate being given in evidence in any other suit or action whatever touching such patent, if a verdict shall pass, or decree or decretal order be made in favour of such patentee, or his assigns, he or they shall receive treble costs in such suit or action, *to be taxed at three times the taxed costs*, unless the Judge making such second or other decree or order, or trying such second or other action, shall certify that he ought not to have such treble costs (*e*).

Certificate being given in evidence in any other suit if patentee obtain a verdict, he is to receive treble costs unless judge certifies to the contrary.

Object of the statute to protect established patents.

Great cost of establishing patents.

The object of this enactment was doubtless to protect a patentee who has fairly once established the validity of his patent in a Court of Law or Equity. A patentee can rarely establish the validity of his patent without incurring a very large amount of costs both at Law and in Equity; and when he does at last succeed in his object, he finds that he is not allowed on taxation as against his opponent much more than half the amount of the costs he has incurred.

This is a most serious grievance to patentees, but it is difficult to provide a remedy. The subject of a patent must be new to every one to whom the patentee may apply for assistance; and he almost always finds that he must remunerate men of science and skill for their loss of time in making themselves sufficiently acquainted with the subject of his invention to enable them to give evidence in his favour.

There are some costs which a defendant cannot be called

The amount of costs which a patentee must incur in this manner is sometimes very great; but when the validity of a patent has not been previously established in a Court of Law,

(*d*) See the Forms of Certificate in the Appendix, Chap. II. s. 4.

(*e*) See the Forms of Certificate in the Appendix, Chap. II. s. 4.

it is difficult to say that a defendant should be compelled to pay the amount of costs which the plaintiff may have so incurred. Our law reports show that patent actions have raised points of law most difficult to determine, and respecting which Judges of the greatest eminence have differed in opinion. The plaintiff's right on the one hand to a patent privilege, and the defendant's right on the other hand, as one of the public, to the use and exercise of the alleged invention, may, and frequently does, depend upon questions of science or fact the most difficult to solve. It would hardly be fair, therefore, to saddle a defendant with the payment of the costs of determining questions of so much doubt and difficulty. And it has been held (*f*) that a plaintiff is not entitled to the costs of experiments necessarily made for the purposes of procuring evidence in the cause.

upon to pay if patent not previously established.

It seems to be a fair rule to lay down, that a party who succeeds in a cause (whether plaintiff or defendant) should be allowed upon taxation all the costs which he has necessarily or fairly incurred in order to procure success; but this or any other general rule which could be laid down, would be most difficult of application in practice.

Rules respecting the taxation of costs difficult of application.

The rules of taxation which prevail in our Courts might, however, be very advantageously relaxed in favour of parties trying such causes as patent actions. The very strict manner in which our Courts have at all times taxed costs as between party and party seems to have had its origin in a desire to repress frivolous and vindictive litigation; and there can be no doubt that the effect has been to diminish such litigation very much. But the application of the existing strict rules of taxation to patent actions frequently operates very unfairly to the prejudice of successful parties in such actions, by depriving them of a large amount of their costs, although such costs are such as every prudent man would have incurred in order to insure success. A more liberal mode of taxing costs in such actions would be a great boon to the parties, and remove many of the difficulties under which they labour.

Rules of taxation might be beneficially relaxed in patent actions.

Before a patentee has established his claim to a patent privilege by legal proceedings, he has no proof of his title except his patent, and that has been obtained upon his own unsupported

A patentee who has established his patent at law is fairly

(*f*) *Severn* v. *Olive*, 3 B. & B. 72.

entitled to be better protected.

representation. But when a patentee's title to a patent privilege has been once fairly established in a Court of Law or Equity, he stands in a very different position; and he may very fairly claim to be better protected by the law than a patentee, who has no verdict, judgment, or decree, evidencing his title to such a privilege. It would not be fair to extend the protection to a patentee who has established his patent right in an action at Law, so far as to prevent any person from afterwards contesting the validity of the patent; for the defendant in an action might, through ignorance or collusion with the plaintiff, suffer him to obtain a verdict, and other persons may afterwards be able to show that the patent is void. But when the patentee has the evidence of a verdict or judgment in his favour, it is only proper that he should be so far protected; that if he is again compelled to try the validity of his patent, he should be enabled to recover the full amount of his costs if he again succeeds in establishing his title. The object of the enactment already stated (*g*) was to indemnify patentees against their costs in actions which they may be compelled to bring after they have established their patent, and also to deter persons from committing vexatious infringements of such patents by the penalty of treble costs.

Protection cannot be extended so far as to prevent others from disputing the patent.

But patentee ought to recover full costs if he succeeds in other actions.

Object of the statute to indemnify patentees, and prevent vexatious infringements.

In order to obtain the protection of this enactment, however, it is not sufficient for a patentee merely to obtain a verdict or decree, but he must also obtain the certificate of the Judge before whom the cause was tried or heard, that the validity of the patent came in question before him. And this is made necessary because the pleadings in a cause might, upon the face of them, appear to raise almost every possible question respecting the validity of the patent; and yet the defendant may not at the trial or hearing raise any such question.

To obtain the protection of the statute a certificate is necessary.

Thus in the case of *Stocker* v. *Rodgers* (*h*), the defendant pleaded pleas putting the validity of the patent in issue (*i*); but he offered no defence at the trial, and consented to a verdict for forty shillings damages. The learned Judge (*Erskine*, J.,) who tried the cause, refused to give the plaintiff a certificate that the validity of the patent came in question; and

Stocker *v.* Rodgers.

Where a verdict is obtained by consent, a certificate will not be granted.

(*g*) *Ante*, p. 300.
(*h*) 1 C. & K. 99.
(*i*) The pleas denied the novelty of the invention and the sufficiency of the specification.

his Lordship said, "I think that as this is a verdict by consent, and as no evidence has been adduced before me, I ought not to grant a certificate. My certificate would affect third parties; and it would be possible, in a case like the present, for two parties, by collusion, to consent to a verdict in favour of a patent; and if they could obtain a certificate under the third section of the statute, to use it afterwards to the injury of another party who was really contesting the validity of the patent."

It is sufficient if validity of patent comes partly in question.

But in a case where the validity of the patent did partly come in question, a certificate was granted although the defendant did not call any witnesses (*l*).

Treble costs how taxed.

The costs which this statute enabled the plaintiff in a second or subsequent action to recover, were treble costs, *to be taxed at three times the taxed costs.* The term treble costs in our Courts does not mean three times the amount of the parties' taxed costs; being in fact less than twice the amount of such costs. The amount of treble costs is made up thus: to the sum allowed to the party for costs taxed in the ordinary way is added one half of that sum, and also one fourth of the same sum, and these three sums being added together form what is technically termed treble costs (*m*). But this statute provided, that the treble costs to be allowed to patentee plaintiffs should be not the ordinary treble costs, but treble costs "taxed at three times the taxed costs."

Extra amount of costs intended as a penalty.

The amount awarded to a plaintiff for costs in pursuance of this statute, might be more than the amount which he actually incurred in the action; but the intention no doubt was, that he should receive the sum (if any) which he recovered from the defendant above the actual amount of his costs, by way of a penalty, and to indemnify him against losses, the amount of which could hardly be ascertained.

Treble costs taken away by stat. 5 & 6 Vict. c. 97, and full costs given.

The amount of costs to be allowed to a plaintiff in pursuance of this statute, has, however, been materially varied by the recent statute of 5 & 6 Vict. c. 97, which, in fact, takes away treble costs altogether, except under private or local Acts, and substitutes what may be termed *full costs* instead.

Stat. 5 & 6 Vict. c. 97. s. 1.

By the first section of that Act it is enacted, that "so

(*l*) *Gillet* v. *Wilby*, 9 C. & P. 334; 1 Webs. R. 270.

(*m*) See Tidd's Practice, and Chit. Arch. prac. tit. Treble Costs.

All enactments giving treble costs or more than usual costs repealed.

Parties to be entitled to full costs instead of treble costs, &c.

much of any clause, enactment, or provision in any public Act or Acts, not local or personal, whereby it is enacted or provided that either double or treble costs, or any other than the usual costs between party and party, shall or may be recovered, shall be, and the same are hereby repealed: Provided always, that instead of such costs the party or parties heretofore entitled under such last-mentioned Acts to such double, treble, or other costs, shall receive such full and reasonable indemnity as to all costs, charges, and expenses incurred in and about any action, suit, or other legal proceeding, as shall be taxed by the proper officer in that behalf, subject to be reviewed in like manner and by the same authority as any other taxation of costs by such officer."

Costs under 5 & 6 Will. IV. c. 83, s. 3, must now be *full costs*.

The costs, therefore, to be allowed to a plaintiff in a second or subsequent action upon a patent, under the 5 & 6 Will. IV. c. 83, s. 3, as altered by the 5 & 6 Vict. c. 97, s. 1, must be taxed in such a way as to be a "full and reasonable indemnity as to all costs, charges, and expenses incurred in and about" the action (*n*). It is difficult to say what construction will be put upon this statute, but there can be little doubt that it will be construed liberally, and that a plaintiff will under these statutes be allowed the amount of his costs taxed as between attorney and client.

Judge may certify to deprive plaintiff of full costs in a second action.

The right of a patentee to have full costs under these two statutes, in a second or other subsequent action, is, however, dependent upon the discretion of the Judge before whom the cause is tried, who may certify so as to deprive him of such costs. By the 5 & 6 Will. IV. c. 83, s. 3, already stated (*o*), it is provided that a patentee shall recover treble costs in a second or other subsequent action, unless the Judge trying such second or other action shall certify that he ought not to have such costs. That provision of course extends to the full costs by the stat. 5 & 6 Vict. c. 97, s. 1, substituted for treble costs, and enables the Judge to certify that a plaintiff ought not to have such costs.

Intent of the statute.

It seems to have been intended by this provision, that although, as a general rule, a patentee in a second or other action, should have treble (now full) costs; yet, that if it should

(*n*) See the Form of Certificate, under these two statutes, in the Appendix.

(*o*) *Ante*, p. 300.

appear to the Judge trying the second or other action, that the patentee ought not to have such costs, the Judge might certify so as to prevent him from obtaining them.

Such a provision was necessary in order to enable a Judge to prevent a patentee from availing himself of a certificate obtained in an action tried by collusion for the purpose of obtaining it. And there may be many other cases in which a Judge would not allow a patentee to have full costs under the statutes; as, if it should appear to him that an action was a harsh or unnecessary proceeding; or that the defendant did not question the validity of the patent, but defended the action *bonâ fide* for the purpose of trying a doubtful question of infringement; in such cases it is to be apprehended that a Judge would certify in order to prevent a plaintiff from obtaining more than ordinary costs from a defendant.

Power of certifying to deprive plaintiff of full costs necessary to prevent collusion.

The form of certificate in such a case would be under the first statute, as altered by the second, that the plaintiff ought not to have full and reasonable indemnity as to all his costs, charges, and expenses, in pursuance of the statutes (*p*).

Form of certificate.

Section III.

Of a Suit in Equity.

It is a general rule, that a person is entitled to maintain a suit in Equity only when he can have no adequate or sufficient remedy in a Court of Law. The objects which a patentee has in view when he has recourse to legal proceedings against any person who infringes his patent, are: *firstly*, To put a stop to the further invasion of his rights; and, *secondly*, To recover a recompence for the injury which he may have sustained by the violation of his patent privilege.

Remedy in equity when none at law.

Objects of a patent suit.

In order to restrain the further infringement of a patent, it is absolutely necessary to have recourse to a suit in Equity; for a Court of Law has power only to give a patentee damages for any injury he may have sustained by the actual violation of his right, after it has been committed; and such a Court has no means or power to interfere, so as to protect a patentee against the future invasion of his rights.

Court of law has no power to prevent future infringements.

(*p*) See the Form of Certificate in the Appendix, Chap. II. s. 4.

Court of equity, by injunction, can restrain parties from infringing.

But a Court of Equity by means of its process of injunction, has power to command a person who has once violated a patent right, to refrain from committing any repetition of the offence, or again violating the patent in any manner whatsoever. And if such a person afterwards violates the patent, he makes himself liable to be punished by attachment, and imprisonment for contempt, at the discretion of the Court.

No sufficient means of recovering recompence for infringement at law.

Nor has a Court of Common Law the means of enabling a patentee to recover an adequate recompence for the violation of his privilege. The infringement of a patent is generally committed in secret, or, at all events, under such circumstances as to preclude the possibility of procuring sufficient legal evidence of the extent of the infringement. There is, in consequence, frequently very much difficulty in the way of procuring evidence of a violation of the patent by a suspected person, and it would be almost impossible in any case to show by legal evidence in a Court of Law the full extent of the injury which the patentee has sustained by the infringement of his patent. But a Court of Equity has a power, not possessed by a Court of Law, of compelling a defendant to answer on oath the complaint made against him by the plaintiff's bill, and to make a full discovery of every thing which is necessary to enable the Court to do justice between the parties.

Court of equity can compel defendant to account and make discovery.

Patentee has no adequate remedy at law.

It is evident from what has been stated, that a patentee cannot have any adequate remedy in a Court of Law against parties who may infringe his patent; and therefore it has been held that he is entitled to the aid and protection of a Court of Equity, whenever his patent privilege has been invaded.

Equity will only protect a clear legal right.

But the privilege conferred by a patent is a legal right (*q*), which, according to the declaration contained in the Statute of Monopolies (*r*), ought only to be tried by the Common Law of the realm. It is a maxim that equity follows the law, and therefore a Court of Equity will only protect the clear and undoubted legal right of a patentee.

If patentee's title is denied it must be tried at law.

And if this title of a patentee is denied by a defendant in Equity, the Court cannot dispense with the necessity which the plaintiff is under to prove a clear and undisputed *legal*

(*q*) As to the Nature of the Right, see Chap. IX. s. 1.

(*r*) 21 Jac. I. c. 3, s. 2.

right to the patent privilege which he seeks to protect. Before a patent privilege has been established by a verdict, the title of the patentee depends entirely upon his patent, *which he has obtained by means of his own ex parte and unsupported representations to the Crown*; and that circumstance alone would induce a Court of Equity to give a defendant a proper opportunity of contesting the validity of the patent in a Court of Law. And even if a patentee has succeeded in obtaining a verdict against one person for infringing his patent, another person who is defendant in a subsequent suit, will still be allowed to contest the validity of the patent in a Court of Law (*s*). For he ought not to be prejudiced by any proceeding to which he was no party, and he may be in possession of evidence which was unknown to a former defendant; or the defendant in a former case may, either through design or ignorance, have neglected to take any available objection to the validity of the patent.

Defendant has a right to dispute the validity of a patent, even if tried before.

Defendant ought not to be prejudiced by previous proceedings, and may possess further evidence.

The usual mode of trying the validity of a patent is by an action brought by the patentee for an infringement of his exclusive privilege, in which the defendant pleads pleas, and delivers a notice, raising objections against the validity of the patent (*t*). The same object may, however, be attained by an issue directed by the Court of Chancery, or by an action of *scire facias* to repeal the patent (*u*). And a defendant in Equity, or any other person aggrieved, is always at liberty to try the validity of a patent by suing out a *scire facias* to repeal it (*u*).

Mode of trying the validity of a patent at law.

From what has been stated it follows, that although a patentee is entitled to the interposition of the Court of Chancery in his favour, yet the proceedings in that Court can only be sustained for the purpose of protecting a patent right to which he can show, by the judgment of a Court of Law, that he has a legal title. But when that right has been established by such a judgment, between the patentee and the party against whom he is proceeding, the Court of Chancery will not only restrain the defendant from committing any further violation

Suit can only be sustained to protect a patent established at law.

If patent established by a judgment at law, patentee is entitled to an injunction and an account.

(*s*) See the observations of the Vice-Chancellor in *Russell* v. *Barnsley*, 1 Webs. R. 472.

(*t*) As to such an action, vide *ante*, s. 2, p. 251.

(*u*) As to a *scire facias*, see sec. 6 in this Chapter.

of the patent privilege, but will compel him to recompense the patentee for all the profits which he has lost by means of the infringement (*x*).

Parties to the suit.

The rules of the Court of Chancery with respect to the parties to a patent suit, are somewhat different from the rules of our Courts at Law, respecting the parties to a patent action. Thus, an action at Law for the infringement of a patent, no one can be a plaintiff unless he is either a patentee, or can show a legal title by assignment to the whole or a part of the patent privilege. But in the Court of Chancery a person may be made a plaintiff or co-plaintiff, when he has any equitable interest in the patent privilege, although such equitable interest does not amount to a legal title.

Plaintiffs.

Unless a patentee has parted with his patent right or some portion of it, he alone will of course be the plaintiff in any suit respecting his patent. So also an assignee of the whole of a patent privilege must be the sole plaintiff, for the patentee has parted with his interest in the subject-matter of the suit. If a patent is granted to several persons, they may all be joined as plaintiffs in a suit; and so also if a patent has been assigned to several persons, they may all be made plaintiffs.

When a portion of a patent has been assigned, the patentee and the assignee may be made co-plaintiffs. And although different portions of a patent right are vested in several persons by different titles, they may all be joined as plaintiffs in a suit. Although it is usual when a patent privilege is vested in several persons to make them all plaintiffs in a suit, there does not seem to be any reason why any one of such parties might not alone maintain a suit for the protection of his own share in the patent, although it would in such a case be necessary to make his co-patentees defendants in the suit.

Defendants.

The person who has committed the infringement complained of, must of course be made a defendant in the suit; and if the infringement was committed by several persons jointly, they ought all to be made defendants. But if several persons separately commit acts of infringement of the same patent, they cannot all be made defendants in one suit; but must be proceeded against by separate suits (*y*).

(*x*) See further as to an Account of Profits, *post*, in this Chapter.

(*y*) See *Dilly* v. *Doig*, 2 Ves. Jun. 486.

If there happens to be any person interested in a patent privilege who will not consent to be made a co-plaintiff in a suit, he must of course be made a defendant (*z*).

In a patent suit the bill sometimes commences with a short statement of the facts upon which a petition for the patent must have been grounded; such a statement is not, however, absolutely necessary, and where brevity is desirable it ought to be omitted. The bill then states the grant of the exclusive privilege of using the invention as made by the patent. It is not necessary to set out the patent at length, but merely to state the substance or effect of it, and the proviso requiring the specification; and the statement ought always to conclude by craving leave to refer to the patent itself (*a*).

Bill.

Statement of patent.

After stating the grant made by the patent, the bill proceeds to show that the patentee has performed the condition upon which he obtained his privilege by enrolling a specification within the time limited by the patent. It is not requisite that the specification should be set out at length in the bill, unless perhaps in case of a disclaimer or memorandum of alteration having been filed under the stat. 5 & 6 Will. IV. c. 83, when it may be necessary to set out both documents, so as to show the effect of the disclaimer or alteration. But in other cases if the bill sufficiently alleges the performance of the condition in the patent, it is unnecessary to set out the specification.

That condition has been performed.

Specification need not be set out at length.

In the case of *Kay* v. *Marshall* (*b*), the plaintiff in his bill set forth a patent granting to him the sole use of an invention of a new and improved machinery for spinning flax, &c., with the ordinary proviso requiring the enrolment of a specification. The bill then stated, that by an instrument in writing or specification under his hand and seal, dated, &c., and duly enrolled, the plaintiff, in pursuance of the proviso contained in the patent, particularly set forth, described, and ascertained the nature of his invention, and its several parts, and in what manner the same was to be performed; and that he thereby declared that what he claimed as his invention, &c., setting out the claim of invention made in the specification. The

Kay v. Marshall.

(*z*) See *Westhead* v. *Keene*, 1 Beavan, 287.

(*a*) See the Forms in the Appendix, Chap. II. s. 5.

ly. & Cr. 373.

defendants put in a general demurrer to the bill; and amongst other objections it was urged for the defendants, that the plaintiff's claim of invention was vague and uncertain, and that he did not state his title with sufficient certainty, and that he was bound to set out the specification fully, instead of contenting himself with a mere allegation that it sufficiently described the nature of his invention, and referring to it for greater certainty. But Lord *Cottenham*, L. C., overruled the demurrer, and said, in giving judgment (*inter alia*), "The bill states that the plaintiff has obtained a patent for a new and improved machinery for preparing and spinning flax, hemp, and other fibrous substances; and that in his specification duly enrolled he set forth, described, and ascertained the nature of his said invention, and the several parts thereof, and by what means the same was to be performed. This is all that the bill states of the specification. Upon the face of the bill, therefore, he alleges that he did by his specification do all that his patent required him to do, namely, describe and ascertain the nature of the invention, and in what manner the same was to be performed; what follows is merely the claim, not intended to be any description of the means by which the invention is to be performed, but introduced for the security of the patentee, that he may not be supposed to claim more than what he can support as an invention. It is introduced, lest in describing and ascertaining the nature of his invention, and by what means the same is to be performed (particularly in the case of a patent for an improvement), the patentee should have inadvertently described something which is not new in order to render his description of the improvement intelligible. The claim is not intended to aid the description, but to ascertain the extent of what is claimed as new. It is not to be looked to as the means of making a machine according to the patentee's improvements. If, therefore, the specification as containing the description be sufficiently precise, it cannot be of any consequence that expressions are used in the claim, which would be too general if they professed to be part of the description."

It is sufficient if defendant alleges that he did by his specification all that was required by the patent.

Westhead v. Keene.

In the subsequent case of *Westhead* v. *Keene* (c), it ap-

(c) 1 Beavan, 287.

peared that the plaintiff's patent had been obtained for an invention of an improved method of cutting caoutchouc or India rubber, &c.; the bill alleged that in compliance with the proviso in the patent, the plaintiff did particularly describe and ascertain the nature of the invention, and in what manner it was to be performed, by an instrument in writing under his hand and seal, explaining therein the aforesaid particulars by drawings, and a description thereof, which (it was alleged) could not be set out in the plaintiff's bill; and that he did enrol the said instrument or specification within the six months in the patent mentioned. To this bill the defendants demurred, and contended that the plaintiff ought to have set out the specification at full length in order to enable the Court to judge of its validity. But Lord *Langdale*, M. R., held, that he was bound by the case of *King* v. *Marshall* (*d*), on the authority of which he overruled the demurrer.

Disclaimer must be stated.

When any part of the title of the invention or of the specification has been disclaimed or altered, the bill must at least show the nature of the disclaimer, or memorandum of alteration which has been filed under the statute. And it is very questionable whether the whole of the disclaimer or memorandum of alteration should not be set out in the bill.

Assignee must state his title.

If a plaintiff, or of one of several plaintiffs, sues as assignee, his title must be stated in the bill.

Interlocutory injunction.

It has already been stated (*e*), that the relief afforded to a patentee by the Court of Chancery, is only in aid of his legal title, and that the Court will not dispense with a trial at Law if required by a defendant. But it has become the established practice of the Court, that when a patentee can show that he has possession of a patent privilege, under colour of a title, not evidenced merely by his patent, but also supported by the verdict of a jury, or by long and undisputed enjoyment, and can also show that the defendant against whom he is proceeding has violated the privilege, he shall have immediate relief, and the protection of an interlocutory injunction; that is to say, an injunction granted before the hearing, by which the defendant will be commanded to refrain from infringing the patent until he answers the bill, or until

If patentee has a colourable title, he is entitled to an interlocutory injunction.

(*d*) 1 My. & Cr. 373, cited *ante*, p. 309.

(*e*) *Ante*, p. 306, 307.

But only on the terms of trying the right at law.

the hearing or the further order of the Court. But the plaintiff will in such a case be put under terms to commence an action, so that the defendant may have an opportunity of trying the validity of the patent; and if it should be found to be invalid, the injunction will be dissolved as of course.

Principle upon which the Court acts.

The principle upon which the Court acts in such cases appears to be this, that although a defendant has a right to dispute the plaintiff's legal title from which he derives his claim for relief in Equity, yet when a patentee plaintiff in Equity can show a *primâ facie* title at Law to his patent privilege, the Court will give credit to such a title, and grant him the protection of an injunction until the defendant has had the opportunity of contesting the sufficiency of the title in a Court of Law. And even if such a *primâ facie* title appears to the Court to be doubtful, still the relief prayed for will not on that ground be refused.

Court will act upon a *primâ facie* title even if doubtful.

Jurisdiction clearly defined in several cases.

This part of the jurisdiction of the Court is very clearly defined and explained by several eminent Judges who have presided in this Court.

Boulton v. Bull.

If the case of *Boulton* v. *Bull* (*g*), a bill was filed for an injunction to restrain the defendants from infringing a patent for an invention of a new fire-engine, which had been prolonged by Act of Parliament for twenty-five years. The plaintiffs had been in possession of their patent privilege twenty-seven years, and obtained an interlocutory injunction; the question of the validity of the patent, to be tried in an action at Law. The plaintiffs brought their action in the Court of Common Pleas, and obtained a verdict at *Nisi Prius*, subject to the opinion of the Court upon a case stated. Upon argument of that case the Court was equally divided in opinion, and consequently no judgment was given (*h*). The defendant moved to dissolve the injunction, but Lord *Loughborough*, L. C., refused the motion; and in giving judgment said, "I cannot put the patentees upon the acceptance of terms that, upon collateral reasons, they think may be disadvantageous to the exercise of the right *of which they are in full possession*: neither can I put them out of possession upon the difference of opinion of the Court. That is not the fault

Twenty-seven years' possession a sufficient *primâ facie* title.

(*g*) 3 Ves. 140.
(*h*) 2 H. Bl. 453; and see *Hornblower* v. *Boulton*, 8 T. R. 95.

of the plaintiffs. What has passed in the Court of Common Pleas does not shake their right, but strongly supports it. The verdict, though it has failed of effect, is not to be disregarded. The opinions of the Judges on both sides are deserving of great respect. If nothing can be done upon this, there must be another action. *In the mean time the injunction must be continued.* I will not put them to compensation. I will not disturb the possession of their specific right. It is of notoriety that this fire-engine has been erected in many parts of the country with great advantage."

Universities of Oxford and Cambridge v. Richardson.

In the case of *The Universities of Oxford and Cambridge* v. *Richardson*, Lord *Eldon* observed, in giving judgment upon a motion to dissolve an injunction (*k*), "It is then said, in cases of this sort, the universal rule is, that if the title is not clear at Law, the Court will not grant or sustain an injunction until it is made clear at Law. With all deference to Lord Mansfield, I cannot accede to that proposition so unqualified. There are many instances in my own memory in which this Court has granted or continued an injunction to the hearing, under such circumstances. In the case of patent rights, if the party gets his patent, and puts his invention in execution, and has proceeded to a sale, that may be called possession under it, however doubtful it may be whether the patent can be sustained; this Court has lately said, possession under a colour of title is ground enough to enjoin and to continue the injunction till it shall be proved at Law that it is only colour and not real title. There have been several instances of late. Can it be said that the patent in the case of *Boulton and Watt* (*l*) was not doubtful? The Court of Common Pleas were divided upon the validity of it. Upon the first argument in the Court of King's Bench they were inclined to hold it bad; but they altered their opinion, and decided in favour of it. This Court enjoined them all the time during the pendency of the proceedings at Law, upon the ground that they had had possession of the invention under colour of the title which a patent, questionable in that degree, gave. That declaration, therefore, is not to be understood in that unqualified manner."

Possession under colour of title a sufficient ground for an injunction until trial.

Harmer v. Playne.

In the case of *Harmer* v. *Playne* (*m*), upon a motion to dis-

(*k*) 6 Ves. 707.
(*l*) *Boulton* v. *Bull*, 2 H. Bl. 453.
(*m*) 14 Ves. 130.

solve an injunction, an objection was taken to the plaintiff's specification; and although Lord *Eldon*, L. C., expressed great doubts respecting the sufficiency of the specification, yet upon the ground of the length of enjoyment of the patent right which the plaintiff had had, he refused to dissolve the injunction; but his Lordship directed a case to be sent to the Court of Common Pleas for their opinion. His Lordship said, in giving judgment, "The ground upon which, where doubt is excited in the mind of the Court, an injunction is granted until the legal question can be tried, a ground that was acted upon in the case of *Boulton and Watt* (*n*), in some cases preceding that, and some that have occurred since, is this; where the Crown on behalf of the public grants letters patent, the grantee, entering into a contract with the Crown, the benefit of which contract the public are to have, and the public have permitted a reasonably long and undisputed possession under colour of the patent, the Court has thought, upon the fact of that possession proved against the public, that there is less inconvenience in granting the injunction, until the legal question can be tried, than in dissolving it at the hazard that the grant of the Crown may in the result prove to have been valid. The question is not really between the parties upon the record; for, unless the injunction is granted, any person might violate the patent; and the consequence would be, that the patentee must be ruined by litigation. In the case of *Boulton and Watt*, therefore, though a case of great doubt, upon which some of the ablest Judges in Westminster Hall disagreed, yet upon the ground of the possession by the patentees against all mankind, the injunction was granted until the question could be tried; and the result of the trial being in favour of the patent, proved that the conduct of the Court in that instance was at least fortunate."

Ground upon which an injunction is granted until a trial.

His Lordship, then, after making some observations respecting an apparent defect in the specification said, "*I feel very considerable doubt whether that can be made good; but there has been possession sufficient under this patent to make it fit that it should be tried*; taking care that it shall be tried speedily. It may be put in the shape of a case, stating the

Injunction will be granted notwithstanding doubts, if plaintiff has a *primâ facie* title.

(*n*) *Boulton* v. *Bull*, 3 Ves. 140.

specification under the first patent, the second patent, and specification; then stating facts sufficient to introduce the question, as a question of law, whether the condition for enrolling a specification had been duly complied with."

In the case of *Hill* v. *Thompson* (*o*), the same learned Judge said, "The principle upon which the Court acts in cases of this description is the following:— Where a patent has been granted, and an exclusive possession *of some duration* under it, the Court will interpose its injunction, without putting the party previously to establish the validity of his patent by an action at Law. But where the patent is but of yesterday, and, upon an application being made for an injunction, *it is endeavoured to be shown* in opposition to it that there is no good specification, or otherwise that the patent ought not to have been granted, the Court will not, from its own notions respecting the matter in dispute, act upon the presumed validity or invalidity of the patent without the right having been ascertained by a previous trial, but will send the patentee to law, and oblige him to establish the validity of his patent in a Court of Law before it will grant him the benefit of an injunction."

Hill v. Thompson.

If possession of some duration, injunction will be granted without a previous trial.

If patent recent, it must first be established at law.

The case of *Hill* v. *Thompson* is in fact the leading case on this subject, and has been adopted and constantly acted on by all subsequent Judges in this Court.

Hill v. Thompson, the leading case.

In the case of *Collard* v. *Allison* (*p*), the patent had been granted *twelve years* before, for an improvement in the manufacture of grand square pianofortes. The plaintiffs filed affidavits in support of a motion for an injunction in the usual way. The defendants by their answer, and by affidavits in opposition to the motion, admitted that if the patent was valid, they had infringed it; but they denied the validity of the patent, and stated facts to show that *the plaintiffs had not been in the exclusive and undisturbed enjoyment of the patent right* as alleged in their bill. Lord *Langdale*, M. R., refused to grant the plaintiffs an interlocutory injunction, but directed an action to be brought, putting the defendants under terms to accept of short notice of trial and keep an account. The motion was afterwards renewed before Lord *Cottenham*, L.C., by way of appeal, but his Lordship refused the motion. His

Collard v. Collard.

Length of time will not entitle plaintiff to an injunction before trial, if possession not exclusive.

HARVARD LAW SCHOOL LIBRARY.

(*o*) 3 Mer. 622.

(*p*) 4 My. & Cr. 987.

Lordship said, in delivering judgment in this case, "It is not my intention to express any opinion upon the validity of the patent, namely, as to whether the peculiarity of construction here claimed constitutes such an improvement as would be the subject of a patent; because I have always thought the decision of that question should devolve upon that jurisdiction in which questions of law are more properly decided. It is not my intention, therefore, to express any opinion on the point, *further than to say this, that it is by no means so clear that that is a ground on which a patent could be maintained.* Independently of that circumstance, however, there is very contradictory evidence as to whether it is a novelty or not. Persons whose opinions must in their profession be held in great esteem, give conflicting testimony on this point. [His Lordship here stated the substance of the affidavits respecting the novelty of the invention, and proceeded:]—The effect of these contradictory statements, therefore, as the matter now stands, leaves considerable doubt upon the question, whether that which is now claimed is a novelty or not; and that circumstance would make it my duty to send the question to Law and prevent me from granting an injunction in the mean time. But then it is said there is possession of the patent, and that possession of a patent for a certain length of time gives such a title as the Court will protect until a trial at Law can be had. And certainly if I found that manufacturers of pianofortes had acquiesced, and that there was no doubt upon that point to which I have before referred (*s*), I should have adopted the course which Lord *Eldon* adopted, and which I have followed, of protecting the right until the trial should have been had. *For that purpose, however, I ought to have very satisfactory evidence of exclusive possession.* Now, I find here that certain manufacturers state that they abstained from making pianofortes in this manner out of respect for the plaintiffs as having a patent; while other manufacturers again say that they have always made them in this manner. Which of these statements is true I am not called upon to decide; but the discrepancy does throw sufficient doubt on the case to prevent my interfering by injunction. The result is, that this

If there is no doubt that others have acquiesced for some time, the patent will be protected.

But there ought to be very satisfactory evidence of exclusive possession.

(*s*) Whether the invention could be the subject of a patent.

case, in my opinion, wants that evidence of exclusive possession upon which Lord *Eldon* acted in the case that has been referred to; and that there is so much doubt as to the novelty of what is claimed, and as to the validity of a patent for such a manufacture, that I do not feel that I ought to interfere."

If defendant has acknowledged plaintiff's title, an injunction will be granted.

If a defendant has acknowledged the validity of the patent in any way, that will be deemed sufficient *primâ facie* evidence upon which to grant an interlocutory injunction, until a trial at Law.

Thus, in the case of *Muntz* v. *Grenfell* (*t*), it appeared that in articles of agreement between the plaintiff and the defendant, respecting the patent (which had expired), the patent had been dealt with as a valid patent, and Vice-Chancellor *K. Bruce* granted an injunction until the trial of an action at Law.

Primâ facie title against a patentee or licensee.

So also if bill be filed by an assignee of the patent against the patentee, the patent will be deemed valid as against the patentee (*u*). And if the defendant has previously used the invention under a licence (since expired), the plaintiff will be deemed as against him to have a sufficient *primâ facie* title (*x*).

Injunction does not issue as a matter of course, or until a party has evinced an intent to infringe.

Although an injunction merely commands a party to do that which it is his duty to do, namely, abstain from infringing the patentee's privilege; yet it cannot be had as a matter of course. For it is to be presumed that every one will obey the law which is declared in the prohibitory part of the patent, commanding all persons within the limits of the privilege, that they shall not use, exercise, or put in practice the patentee's invention; and, therefore, the Court cannot be called upon to interfere until the defendant has evinced an intention to do that which will be a violation of the patent privilege.

Court will not interfere until the patent has been violated.

Parties who are about to infringe a patent, seldom give notice of their intention; and, therefore, it has been laid down that the Court will not interfere until a party has shown by violating the patentee's privilege, that he disregards the command contained in the patent, and that he will therefore probably again infringe the patent privilege.

Hill *v.* Thompson.

Thus, in the case of *Hill* v. *Thompson* (*y*), it was laid

(*t*) 7 Jur. 121.
(*u*) Vide *ante*, Chap. IX. s. 2, p. 236.
(*x*) Vide *ante*, Chap. IX. s. 3, p. 244.
(*y*) 3 Mer. 622.

Injunction will not be granted until defendant has actually infringed.

down by Lord *Eldon*, L. C., that before an injunction is granted against a defendant, it should be clearly shown that he has actually infringed the plaintiff's patent (*z*).

If the infringement is doubtful, an injunction will not be granted.

If it should appear to the Court that it is doubtful whether the alleged infringement is really a violation of the plaintiff's patent right, an injunction will not be granted; or, if an injunction has been granted upon an *ex parte* application, it will be dissolved, but the defendant will be compelled to keep an account of all the alleged pirated articles which he may make or sell until the question is determined at Law.

Morgan v. Seaward.

Thus, in the case of *Morgan* v. *Seaward* (*a*), which was a suit to restrain the infringement of a patent for improvements in machinery for propelling vessels, it was doubtful whether the propeller made by the defendants was an infringement of the plaintiffs' patent, and Sir *L. Shadwell*, V. C., dissolved the injunction. His Honor, after comparing the alleged infringement with the invention as specified, said, "The alteration is therefore not merely colourable, but, *primâ facie*, a decided improvement, by the introduction into a combination of three things of that which is not noticed at all in the specification. That is, however, the proper question for a jury to consider; the Court has merely to decide what is to be done in the mean time. Now it is possible a jury may find there had been no invasion of the patent. If that were so, and the injunction should be continued, where is the justice? There is no power in the Court to make the plaintiffs pay the defendants' damages on the ground that the injunction has been continued too long. On the other hand, if the jury shall declare that there has been an infringement of the patent, the Court has a power over the defendants; and the proper measure of damages will be the amount of the engines sold, and the profit derived therefrom."

The question of infringement being doubtful injunction will not be granted, for the defendant might be injured by an injunction, and could recover no recompence.

Negligence will disentitle a patentee to an interlocutory injunction.

A patentee may by his own negligence disentitle himself to the benefit of an interlocutory injunction, however good his *primâ facie* title may be. Thus, if a defendant has, with the full knowledge of the plaintiff, erected large works for the manufacture of an article which it is alleged is an infringement of the patent, the plaintiff cannot afterwards have the

(*z*) See in a subsequent part of this Chapter what must be proved by affidavit in order to obtain an injunction.

(*a*) 1 Webs. R. 167.

benefit of an interlocutory injunction, but must first establish his title at Law as against the defendant, the defendant being put upon terms to keep an account of the articles which he shall in the mean time manufacture.

In the case of *Neilson* v. *Thompson* (*b*), it appeared that the defendants had, with the full knowledge of the plaintiffs, and at considerable expense, erected apparatus for the use of hot-blast in the manufacture of iron, and continued to use their apparatus for some time, but refused to accept a licence, or to pay the plaintiffs a shilling a ton, which was demanded for licence duty. The plaintiffs filed their bill in Chancery for an injunction, and alleged that they had allowed the defendants to go on in the expectation that after a trial of the process they would have taken a licence, and paid the required duty of a shilling a ton. In support of an application for an interlocutory injunction, the plaintiffs' affidavits stated that between fifty and sixty persons had taken licences to use the invention upon payment of a shilling a ton, that various infringements had been committed by parties (about four years after the date of the patent) who submitted upon proceedings being commenced against them. The defendants disputed the validity of the patent, but the plaintiffs relied upon a twelve years' possession of the patent privilege as a sufficient *primâ facie* title upon which to found their claim for an injunction, and Sir *L. Shadwell*, V. C., being satisfied that the patent had been infringed, granted the injunction. The defendants then appealed to the Lord Chancellor (Lord *Cottenham*), who allowed the appeal, and his Lordship, in giving judgment, said, "If you (the defendants) are willing to deal with the shilling a ton as the Court may direct, and to do that upon grounds quite unconnected with the merits of the case, I think I ought to deal with this question of the injunction; because this is not like the case referred to where the party had been in possession of a patent, and somebody else had done that which was an infringement, provided the patent be good;—because here the plaintiff's own statement is, without raising any doubt as to how far that may be correct, assuming the whole statement

Neilson v. Thompson.

Plaintiff having knowingly permitted the defendants to erect their works, cannot have an injunction before a trial at law.

(*b*) 1 Webs. R. 275.

to be true;—that in the year 1839, he was aware that these defendants were at some considerable expense in preparing the apparatus for the purpose of using this hot-blast, and he never interfered to stop them, but permitted them to go on, as he says, under the expectation that they would pay him a shilling a ton after a certain time. That is the position in which he has by his own act placed the defendants. Nothing that took place could preclude the defendants from the right of disputing the plaintiff's right as a patentee; but they have at very considerable expense erected this machinery, and from that time to the present have been using it, the plaintiff being aware of it, at least from some time in 1839 (the precise day is not stated), and stood by and permitted them to do this. If he is entitled as patentee, it would be extremely hard for the Court to do anything to prevent his receiving that which he is entitled to receive, and in expectation of which he permitted the defendants to go on with their works. But, on the other hand, it would be extremely hard, indeed, to tell the defendants that they shall not use the works, which, with the plaintiff's knowledge, they have prepared at a very considerable expense; and as to telling them they may go on with the cold-blast instead of the hot-blast, I am told that the difference between the use of the one and of the other is an expense of nearly double, even if it were possible; at all events, they may sustain that loss in the interval until the right is tried. *It seems to me that stopping the works by injunction under these circumstances is just inverting the purpose for which an injunction is used. An injunction is used for the purpose of preventing mischief; this would be using the injunction for the purpose of creating mischief, because the plaintiff cannot possibly be injured.* All that he asks, all that he demands, all that he ever expects from these defendants is one shilling per ton. He has not a right to say to them, you shall not use this apparatus; he cannot do so after the course of conduct he has adopted; he may no doubt say with success, if he is right, you shall pay me that rent which the others pay, and in the expectation of which I permitted you to erect this machinery. Therefore in no possible way can the plaintiff be prejudiced; but the prejudice to the defendants must be very great, indeed, if they are for a short period prevented

An injunction is used to prevent mischief, and if stopping a defendant's works which have been carried on with the plaintiff's connivance, will cause great loss, an injunction will not be granted before a trial at law.

from using at their furnaces that apparatus, which, with the consent of the plaintiff they have erected. The object, therefore, is, pending the question, which I do not mean to prejudice one way or the other by anything I now say, to preserve to the parties the opportunity of trying the question with the least possible injury to the one party or the other; and, I think, the injunction would be extremely prejudicial to the defendants, and do no possible good to the plaintiff, for the purpose for which it may be used. It may, by operating as a pressure upon the defendants, produce a benefit; but that is not the object of the Court: the object of the Court is to preserve to each party the benefit he is entitled to, until the question of right is tried; and that may be entirely secured by the defendants undertaking to keep an account not only for the time to come, but from the time when the connexion first commenced, and undertaking to deal with that account in such a way as the Court may direct; and if the plaintiff is entitled, the Court will have an opportunity of putting the plaintiff precisely in the situation in which he would have stood if this question had not arisen. If it shall turn out that the patent is not valid, the Court will deal with it accordingly; and that will, I think, most effectually prevent all prejudice."

If a defendant has actually infringed a patent, the patentee has a right to the protection of an injunction, although the defendant promises not to repeat the offence. Thus, in the case of *Losh* v. *Hague* (*c*), Sir *L. Shadwell*, V. C., said, "I do not think it enough on a question of injunction, for the defendant to say, why he has done the thing complained of, but will not do it again. If a threat had been used, and the defendant revoked the threat,—that I can understand as making the plaintiff satisfied; but if once the thing complained of has been done, I apprehend this Court interferes, notwithstanding any promise the defendant may make, not to do the same thing again."

If a defendant has infringed, plaintiff is entitled to an injunction, although defendant promises not to repeat the offence.

Losh v. Hague.

The protection which the Court of Chancery gives to a patentee by injunction, extends to the prevention not only of the manufacture and sale of the patent article during the

Chancery will protect a patentee by injunction against the sale,

(*c*) 1 Webs. R. 200.

after the expiration of the patent, of articles made during its continuance.

term of the patent, but also of the sale of articles, after the expiration of the patent term, which have been made during its continuance.

Crossley v. Beverley, and Crossley v. Derby Gas-light Company.

Thus, in the case of *Crossley* v. *Beverley, and Crossley* v. *The Derby Gas Light Company* (*d*), it appeared, upon a motion for an injunction (4th Dec. 1829), that the plaintiff was the assignee of a patent, granted in 1815, for the manufacture of gas meters of a peculiar construction; and had recently succeeded in establishing his right by recovering a verdict at Law. The patent was to expire in the course of a few days. The plaintiff moved *ex parte* on the bill, which was verified by affidavits proving the infringement, that the defendant might be restrained from selling or disposing of any of the gas meters in question which had been piratically made during the continuance of the patent. The defendant, it was suggested, had a large stock of the pirated articles on hand ready to be thrown into the market as soon as the monopoly was at an end; which they had no right to do to the detriment of the plaintiff, who had the exclusive privilege of *manufacturing* them during the fourteen years. And Lord *Lyndhurst*, L. C., granted the injunction.

Plaintiff may move for an interlocutory injunction *ex parte*, or upon notice. Benefit of moving for injunction.

In order to obtain an interlocutory injunction before a trial, the plaintiff may at his election either move for it *ex parte*, or after notice of motion given to the defendant. A plaintiff generally does move for such an injunction, because, even if the Court should refuse to grant the injunction as prayed, the defendant will be put upon the terms of keeping an account of all the patent articles which he may afterwards make or sell during the pendency of proceedings at Law (*e*); and the plaintiff will not be guilty of *laches* by delaying to bring his cause to a hearing in the mean time.

Motion for injunction *ex parte*.

When a plaintiff's title to his patent has been established by some previous proceedings in a Court of Law, or after long and undisputed possession and exercise of the patent privilege, it is usual to move *ex parte* for an interlocutory injunction. Such motions are indeed frequently made immediately after the bill has been filed, and before the defendant has been served with the *subpœna*; and it is the usual course in such cases to serve

(*d*) 1 Russ. & Mylne, 166.

(*e*) Vide *post*, in this section, as to the terms imposed upon the parties on a motion for an injunction.

the defendant with a copy of the *subpœna*, and of the injunction, or a notice of the order for it, at the same time.

Ought not to be made unless plaintiff is certain that he can sustain the injunction.

The requisite proofs in support of a motion for an interlocutory injunction will be stated presently; and a plaintiff ought not to make such an application *ex parte*, unless he is certain that he will be able to sustain his right to the injunction: for if the Court, upon such a motion being made, should have any doubt respecting the plaintiff's title, or any other part of his case, the motion will be directed to stand over until notice has been given to the defendant.

Disadvantage of moving *ex parte*.

If a plaintiff obtains an *ex parte* injunction in a case where his right to it is doubtful, he places himself in a disadvantageous position; because in such a case he is not allowed any time beyond the two-day notice of motion to answer the affidavits upon which the defendant may move to dissolve the injunction. And if a plaintiff is not entitled to an interlocutory injunction, he increases the costs very unnecessarily by moving for it *ex parte*, instead of making the motion after notice to the defendant.

Motion for injunction after notice.

When a patent is recent, and the validity of it has not been previously tried in a Court of Law, it is generally better to move for an interlocutory injunction after giving the defendant notice of the plaintiff's intention to make the motion; for in such a case the Court seldom grants an interlocutory injunction against a defendant, who can throw any suspicion upon the plaintiff's title, or the validity of his patent; and the chief object of the motion in such a case, therefore, is to have the defendant put under the terms of keeping an account of all the patent articles he may manufacture and sell. According to the old practice the plaintiff could not without the special leave of the Court, give the defendant notice of a motion until he had entered an appearance; but the practice has been altered, so that the plaintiff may give such a notice at any time after the appearance is due, but not before, without obtaining leave for the purpose.

Advantage of moving for injunction after notice.

The advantages of moving for an interlocutory injunction after notice are: first, a saving in expence, (the motion to dissolve being rendered unnecessary;) and in the next place, sufficient time being upon such a motion allowed to both parties

to answer the affidavits of each other, there is much less probability of either party being taken by surprise.

Plaintiff may move for injunction any time before the hearing.

The plaintiff may in fact move for an interlocutory injunction at any time before the hearing of the cause, but it is seldom that such a motion is made after answer to the bill, unless the answer contains admissions which are sufficient to entitle the plaintiff to the injunction. If a plaintiff intends to move for an interlocutory injunction, he always endeavours to do so before the defendant has put in his answer to the bill; for after the answer is once put in, the plaintiff cannot, for the purpose of any subsequent motion, by affidavit contradict any of the statements contained in the answer. And if he delays to make an application until some time after the suit has been commenced, the Court will not be disposed to grant his application unless he can give a satisfactory reason for the delay.

Ought to move before answer.

Application for injunction after a trial.

After a patentee plaintiff has succeeded in establishing his patent right against the defendant in a Court of Law, he may move upon affidavit of the fact (*f*), for an interlocutory injunction; or, if such an injunction has been before granted and dissolved, then to revive it, for the purpose of restraining the defendant from committing any further infringement of the patent before the hearing of the cause.

Court will not generally grant an injunction immediately after verdict for the plaintiff, if defendant intends to move for a new trial.

The Court will not generally grant an injunction immediately after the plaintiff has obtained a verdict at *Nisi Prius*, or before the defendant has had an opportunity of moving for a new trial. In many patent cases a verdict is obtained subject to the opinion of the Court *in banc*, upon a point of law; and it seldom happens that a plaintiff obtains a verdict so free from doubt either as to law or fact, that a defendant has not a fair pretext for an application for a nonsuit or a new trial. Indeed grave questions of law, such as frequently arise in patent actions, cannot conveniently be decided or even discussed before a Judge at *Nisi Prius*; and it is the constant practice to reserve them for the decision of the Court sitting *in banc*.

It would be unfair under such circumstances to grant an injunction against a defendant until he has had a full oppor-

(*f*) See the Form of Affidavit in the Appendix, Chap. II. s. 5.

tunity of having the determination of the Court of Common Law, in which the action is pending, upon any point of law, which is at all material for his defence; and the Court of Chancery would be very unwilling to grant an injunction until the defendant had an opportunity of applying to the Court of Common Law for that purpose.

In the case of *Hill* v. *Thompson* (*g*), the Court of Chancery had dissolved an injunction obtained *ex parte*; and immediately after the plaintiff had obtained a verdict at *Nisi Prius*, (which was in the vacation,) he applied to the Court to revive the injunction. The defendant stated in answer to the application that he intended to move for a new trial, and mentioned the ground upon which he intended to move; and Lord *Eldon*, L. C., refused to grant the injunction. His Lordship said, in giving judgment, "And when I see that this question clearly arises, the only other question which remains is, whether I can be so well satisfied with respect to it, as to take it for granted that no argument can prevail upon a Court of Law to let that first question be reconsidered, by granting the motion for a new trial. If this be a question of law I can have no right whatever to take its decision out of the jurisdiction of a Court of Law, unless I am convinced that a Court of Law must and will consider the verdict of the jury as final and conclusive. But this only brings it back to the original question; and I see enough of difficulty and uncertainty in the specification, and enough of apparent repugnance between the specification and the patent itself, to say, that it is impossible I can arrive at such a conclusion respecting it, as *to be satisfied that there is no ground for granting a new trial.* In the order I formerly pronounced, was contained a direction that the defendants should keep an account of iron produced by their working in the manner described in the injunction. If the injunction is to be now revived, the whole of their establishment must be discharged between this and the fourth day of next term, when it is intended to move for a new trial: the result of which may be that the defendants have a right to continue the works, to do which they will then be under the necessity of recommencing all their operations, and

Hill v. Thompson.

Injunction will not be granted unless it clearly appears that there is no ground for granting a new trial.

Mischief of granting an injunction if defendant succeeds in obtaining a new trial.

(*g*) 3 Mer. 626.

making all their preparations and arrangements *de novo* (*h*). It appears to me that this would be a much greater inconvenience than any that can result from my refusal in the present instance to revive the injunction (*i*). My opinion, therefore, is, that this matter must stand over until the fifth day of next term, when I may be informed of the result of the intended application for a new trial; the account to be taken, in the mean time, as before."

Collard v. Allison.

Where it is shown that defendant intends to move for a new trial, the application for an injunc- will be directed to stand over.

In the case of *Collard* v. *Allison* (*k*), the plaintiffs renewed a motion for an interlocutory injunction on the first day of the term after they had obtained a verdict; but it appeared on affidavit that a bill of exceptions had been tendered at the trial, and that the defendants were about to move for a new trial; the Lord Chancellor directed the application to stand over until the result of the motion for a new trial should be known. The defendants accordingly moved for, and obtained, a rule *nisi* for a new trial; and the motion for an injunction coming on again before the Lord Chancellor, his Lordship said, that under the circumstances in which the case then stood at Law,—a rule to show cause why a new trial should not be had, having been granted,—he must consider the legal title of the parties as still undecided, and he therefore refused the application.

If defendant has obtained a rule *nisi* for a new trial, an application for an injunction will be refused.

Renewal of application for injunction after a trial and judgment.

After the plaintiff has obtained a verdict in an action at Law against the defendant, and the defendant failing to obtain a new trial, or get the verdict set aside, the plaintiff has also obtained judgment in the action; it is almost a matter of course to revive or grant an injunction (*l*). And such an injunction will not be refused, merely because the defendant has brought a writ of error against the judgment in the action; or, because he wishes to have the opinion of another Court of Law.

Cornish v. Keene.

An injunction will be granted after plaintiff has obtained a

Thus in the case of *Cornish and Sievier* v. *Keene and another* (*m*), the plaintiffs (one of whom was an assignee of a moiety of the patent,) obtained a verdict in an action against the defendants; and after a rule *nisi* for a new trial was dis-

(*h*) See the observations of Lord *Cottenham*, L. C., in *Neilson* v. *Thompson*, 1 Webs. R. 286.

(*i*) See the judgment of *Shadwell*, V. C. E., in *Morgan* v. *Seaward*, 1 Webs. R. 168.

(*k*) 4 My. & Cr. 487.

(*l*) *Russell* v. *Cowley*, 1 Webs. R. 471; *Neilson* v. *Harford*, 1 Webs. R. 373.

(*m*) M.S.

charged, final judgment was signed, and then the plaintiffs applied to the Court of Chancery for an injunction against the defendants. The application was opposed by the defendants on two grounds: first, because the defendants had brought a writ of error to reverse the judgment in the action; and, secondly, because the bill in Chancery did not sufficiently allege the assignment of a moiety of the patent to one of the plaintiffs. In answer to these objections, it was stated by the plaintiffs, that the only ground of error assigned by the defendants was, that the declaration in the action did not allege the assignment to one of the plaintiffs to have been made by deed, and that no ground of error was alleged as to any of the issues respecting the validity of the patent; all of which had been determined in favour of the plaintiffs, the object of the defendants being merely to take advantage of an alleged formal defect in the declaration, for the purpose of reversing the judgment in the action. And it was also contended, that even if the judgment were to be reversed (*m*), yet the purpose for which the action was commenced had been answered by the determination of all the questions between the parties respecting the validity of the patent. To the second objection, it was answered for the plaintiffs, that such an objection could not be taken upon a motion for an injunction; and that even if the bill was defective, as alleged, it might afterwards be amended. Lord *Langdale*, M. R., said, that it was clear that the writ of error did not affect the merits of the case; and that whatever might be the effect of it if successful, the plaintiffs had sufficiently established their title against the defendants, to entitle them to the protection of an injunction. And with respect to the other objection, his Lordship said, that if the bill was defective in the respect alleged by the defendant, the Court would most probably allow it to be amended; but whether the bill was defective or not, still the plaintiffs were entitled to an injunction.

Judgment, although the defendant has brought a writ of error, and notwithstanding any defect in the bill in point of form.

In the case of *Neilson* v. *Harford* (*n*), the plaintiffs moved to revive an injunction after they had obtained a verdict and judgment against the defendants, in an action at Law, for the infringement of the plaintiffs' patent. The motion was op-

Neilson v. Harford.

If the Court is satisfied respecting the result of a trial,

(*m*) The judgment was afterwards affirmed in the Exchequer Chamber.

(*n*) 1 Webs. R. 373.

an injunction will not be refused because the defendant desires to have the judgment of another Court of Law.

posed by the defendants, upon the ground that there was a difference in opinion amongst the Judges in the Court of Law, on giving judgment upon a rule for a new trial; that the defendants had been deprived of the means of bringing a writ of error, and were desirous of having the advantage of the judgment of another Court of Law. In giving judgment in this case, Lord *Lyndhurst*, L. C., said, "This was a motion to revive an injunction. The injunction had been dissolved by the late Chancellor, the defendants undertaking to keep an account, and the plaintiffs either to bring or to proceed in an action at Law for the purpose of trying the validity of the patent. The action has since been tried, and judgment has been entered up in the Court of Exchequer. It is under these circumstances, almost a matter of course that the injunction should be allowed. On the part of the defendants, it has been stated, that the learned Judge who tried the case, and who was one of the Judges of the Court where the question was finally decided, dissented from the opinion of the rest of the Court; and it is also stated, on the part of the defendants, that from the course which the proceedings took, they were deprived of their right of bringing a writ of error. I have, in consequence of these objections, thought it my duty to read the report of the trial and of the proceedings in the Court of Exchequer. I do not find that the learned Judge, to whom reference was made, did dissent from the opinion of the rest of the Court. He said, undoubtedly, that it was a question of nicety, and he entertained great doubts with respect to the question; but he himself delivered the judgment of the Court, and said, in the course of delivering that judgment, that he could not say that the construction put by the Court upon the specification was wrong. With respect to the other objection that was made, namely, that the defendants were deprived by the course of proceeding, of bringing a writ of error, the facts of the case appear to be these. Towards the conclusion of the trial, the learned Judge suggested, as the proper course to be pursued, that the facts should be stated in the shape of a special case; or that they should be put upon the record, in order that the case might go, if necessary, to the last resort. The counsel for the plaintiffs assented to this; at least he assented to leave the

facts stated in the shape of a special case, with a view to its being afterwards turned into a special verdict, in order that the question might be upon the record. The counsel, however, for the defendants, the late Attorney-general, finding the opinion of the learned Judge with him, thought that a different course would be most advantageous for his clients, and he adopted it. He insisted that the verdict should be entered on the issues;—and I think, in pursuing that course, he waived any further right to a writ of error, and made his election to abide by the decision of the Court of Exchequer. Under such circumstances, I do not think it reasonable, the decision of the Court being against him, that he should now turn round and say, that I ought to have the advantage of the other course of proceeding at the expense of the plaintiffs. I am the less disposed to depart from the usual course in cases of this kind, after having attentively considered the judgment of the Court, as compared with the specification. I think the construction put upon the specification is a reasonable construction. The whole question turns upon the meaning of the word 'effect' in the specification, as to the sense in which that word was used by the patentee, and, I think, adverting to the other parts of the specification, that the construction put upon it by the Court of Exchequer is a reasonable and proper construction; and, I think, adverting to the last clause of the specification, that that must be the meaning of the word effect in that clause; and that, therefore, it would be difficult, consistently with the rules of law, by which an instrument must be construed, taking it altogether, to have put another construction on the instrument. An objection was taken arising out of the form of pleading, by Mr. Roupel; but it does not appear to me that there is any validity in that objection. The case is of this description. The plaintiffs allowed the defendants to use the patent, by way of trial, for a certain period. They did use it for that period, and kept an account, and rendered that account. They were allowed to make this trial with a view afterwards of taking a licence, and paying, if they thought proper, a certain allowance for using the patent. They did not take the licence. They afterwards continued to use it. They refused to render any further account, in consequence of which notice was given to them to discontinue using the patent; and after

that notice was served upon them, it was clear, if they continued the use of the patent, and they did, they would be liable to an action, and liable also to a proceeding in this Court, and an injunction. For these reasons, I am of opinion that the injunction ought to be allowed."

Motion to dissolve an injunction.

When an injunction has been granted upon an application, *ex parte*, the defendant may, and generally does move upon affidavits (*o*) to dissolve it. If he can show that the plaintiff's title to his patent privilege is bad, or that he has not such a *primâ facie* title as entitles him to an interlocutory injunction, the Court will dissolve it. So also if it shall appear that the defendant has not actually infringed the patent, or did so with the connivance of the plaintiff, or that the question of infringement is doubtful, the injunction will not be continued. And if the plaintiff has obtained an injunction, *ex parte*, upon affidavits which were insufficient, the injunction will be dissolved with costs (*p*); and it seems properly so, for the plaintiff has induced the Court to grant an injunction upon defective affidavits, upon which it could not have been obtained if the attention of the Court had been called to them.

Defendant may move before or after answer.

The defendant may move to dissolve an interlocutory injunction either upon affidavits alone before answer put in, or he may move upon the coming in of the answer, either with or without affidavits.

Advantages of moving after answer.

In some cases it is of the utmost importance to have the determination of the Court as to the continuance of the injunction decided with as little delay as possible, and in such cases it would be impossible to wait until the answer could be put in. when the answer can be put in before moving to dissolve, it is better to do so, as the defendant will thus obtain some advantages which he would not otherwise possess. Thus the plaintiff cannot after answer contradict anything contained in the answer (*q*).

If defendant disputes the validity of the patent, he must move to dissolve an *ex parte* injunction.

A defendant against whom an injunction has been obtained upon motion, *ex parte*, will (if he disputes the validity of the patent) move to dissolve the injunction, even when he knows that the plaintiff has a sufficient *primâ facie* title to sustain the injunction, because he has no other means of compelling

(*o*) As to the Affidavits, vide *post*, in this section.

(*p*) *Sturtz* v. *De la Rue*, 5 Russ. 322.

(*q*) Vide *ante*, p. 324.

the plaintiff to bring an action to try the validity of his patent, and the motion will only be refused upon the terms of the plaintiff undertaking to bring such an action.

Motion to dissolve in consequence of plaintiff's delay in his action at law.

If a plaintiff neglects to bring his action to trial within reasonable time, the defendant may move to dissolve an interlocutory injunction. For the plaintiff is bound to use all reasonable diligence in bringing the cause to trial for the purpose of ascertaining his rights, even when the order under which the action is brought is silent on the subject (*r*). And the reason of this is, that the patent may, notwithstanding the plaintiff's *primâ facie* title, turn out to be void, and the defendant ought not, therefore, to be kept under the restraint of an interlocutory injunction any longer than is really necessary for the purpose of enabling the plaintiff to establish his title if he have any. And if the rule of the Court were otherwise, a plaintiff would have the means of very greatly oppressing an innocent defendant. So long as the injunction is allowed to continue, the plaintiff is in possession of all he seeks to obtain, the exclusive enjoyment of the privilege; and therefore he is seldom anxious to expedite the proceedings more than is absolutely necessary. But if the patent is void, the injunction whilst it continues is restraining the defendant from doing that which he has a right to do, and is doing him an injury for which he cannot obtain any recompence.

Plaintiff bound to use diligence in his action.

If the patent is void, the defendant is injured and cannot obtain a recompence.

For, as observed by Sir *L. Shadwell*, V. C. E., in *Morgan* v. *Seaward* (*s*), "There is no power in the Court to make the plaintiff pay the defendant damages, on the ground that the injunction has been continued too long." And it must be borne in mind that the defendant is not the only person interested, for the public at large has also an interest in having a speedy determination of a question which affects their rights, and there may be many persons acting under the restraint which the knowledge of an injunction having been granted in one case is certain to produce.

Morgan v. Seaward.

When a plaintiff has obtained an interlocutory injunction against the defendant, and the defendant afterwards obtains a verdict and judgment in an action brought by the plaintiff to try the validity of the patent, the defendant may immedi-

Motion to dissolve after verdict for the defendant.

(*r*) Vide *post*, in this section, as to the terms upon which injunctions are granted.

(*s*) 1 Webs. R. 168.

ately apply to the Court to dissolve the injunction, and the motion will be granted almost as of course. But it is probable that the Court would not grant such a motion merely after verdict, or until the plaintiff had had an opportunity of moving for a new trial (*t*).

Affidavits in support of a motion for an injunction.

In support of an application for an interlocutory injunction, a plaintiff must procure all the material allegations contained in his bill (*u*), to be verified by affidavit (*x*). And if any additional facts are necessary to be proved in order to entitle the plaintiff to the immediate interposition of the Court, they must be brought before the Court in the same way.

In whatever form the question respecting a plaintiff's right to an injunction may arise, it must be determined in the same way.

In whatever form the question may come before the Court respecting a patentee plaintiff's right to have the protection of an interlocutory injunction before a trial at Law between the parties, whether upon an application *ex parte*, or after notice, or upon a motion to dissolve, it must be determined in the same way; and, therefore, the facts which a plaintiff must prove upon affidavit, in order to procure an injunction, will be the same in whatever form he may make his application.

What must be proved by affidavit in support of a motion for an injunction.

And in order to obtain the protection of an interlocutory injunction, all the material allegations in the bill, and all facts material to support the plaintiff's title, must be proved by affidavit to the satisfaction of the Court.

Affidavit of grant of patent and enrolment of specification.

If the patentee is himself a plaintiff, he ought in his affidavit to state the grant of the patent; that he properly described his invention in a specification under his hand and seal, and caused it be duly enrolled in Chancery within the time limited for that purpose by the patent. If the specification is set out in the bill, it will be sufficient for the affidavit to state that the specifiation is there correctly set forth.

If specification not set out in the bill, a copy must be verified.

But when the specification is not stated in the bill, a copy of it ought to be brought before the Court verified by affidavit, in order to show not only the performance of the condition in the patent which requires the specification but also the nature of the invention, so that it may be seen whether it was a proper subject for a patent privilege, and whether the defendant has actually violated the patent.

(*t*) See *Boulton* v. *Bull*, 3 Ves. 140; and *Collard* v. *Allison*, 4 My. & Cr. 487.

(*u*) See the Form of a Bill in the Appendix, Chap. II. s. 5.

(*x*) See the Forms of Affidavits in the Appendix, Chap. II. s. 5.

If there has been any disclaimer, or alteration of the title, or of the specification, the plaintiff must by affidavit show that the disclaimer or memorandum of alteration have been duly made, entered, and enrolled; and a copy of it must be verified by affidavit in the same way as the specification.

Disclaimer and alteration must be brought before the Court in the same way.

If the plaintiff should happen to be an assignee of a patent, and cannot procure the patentee's affidavit in support of his application, the matters already stated as necessary to be proved may be sworn to by the plaintiff, or any other person who may take the trouble to inform himself properly on the subject.

Affidavit may be made by a person having competent knowledge.

Any assignment of the patent right, under which a plaintiff claims, must be proved by the affidavit of the attesting witness; or if his affidavit cannot be obtained, then in the best way the plaintiff is able, the absence of the attesting witness's affidavit being properly accounted for. If the attesting witnesses are all dead, the proper mode of proving the deed will be by an affidavit of the handwriting of the attesting witness or witnesses, and also of the assignor who executed it.

Assignment of a patent must be proved by the affidavit of the attesting witness.

If the plaintiff, or one of the plaintiffs, was himself the patentee, he must in his affidavit state that he invented or imported the invention comprised in his patent, and that he believes that he was not only the true, but also the first inventor or importer of it in this country. And a patentee plaintiff should in his affidavit state his belief, not only at the time of his application for his patent, but also at the time of the swearing his affidavit, that he was the true and first inventor of the invention. This was laid down very clearly by Lord *Eldon* in the case of *Hill* v. *Thompson* (*y*), in which his Lordship said, "That when in future an injunction is applied for *ex parte*, on the ground of the violation of a right to an invention secured by patent, it must be understood that it is incumbent on the party making the application to swear, *at the time of making it*, as to his belief that he is the original inventor; for although when he obtained his patent he might very honestly have sworn as to his belief of such being the fact, yet circumstances may have subsequently intervened, or information been communicated, sufficient to convince him

A patentee plaintiff must, in his affidavit, state that he was the true and first inventor.

Hill *v.* Thompson.

Plaintiff must state his belief at the time of making his affidavit.

(*y*) 3 Mer. 622.

that it was not his own original invention, and that he was under a mistake when he made his previous declaration to that effect."

Neilson v. Thompson.

Whether the rule laid down by Lord Eldon in Hill v. Thompson, is applicable to motions not made *ex parte*, *quære?*

In the case of *Neilson* v. *Thompson* (*z*), in answer to an objection that the patentee's affidavit did not state his belief at the time of swearing it, that he was the true and first inventor, it was stated by counsel in argument, that the doctrine of Lord *Eldon* in *Hill* v. *Thompson* (*a*), already stated (*b*), only applied to cases of *ex parte* applications for injunctions, and that it was unnecessary, upon an application for an injunction after notice, that the patentee should state his belief, at the time of the swearing of his affidavit, that he was the true and first inventor. It does not appear, from the report of the case of *Neilson* v. *Thompson* (*c*), that the Vice-Chancellor noticed the objection to the patentee's affidavit, or whether the objection was pressed by the counsel for the defendant. The application for an injunction in that case was, however, made after notice, and as his Honor granted the injunction, it may be contended that he virtually overruled the objection. But the plaintiff's claim for an injunction in the case of *Neilson* v. *Thompson*, as it appeared before his Honor, was very strong; for it appeared that there had been an enjoyment of the patent right for upwards of twelve years, and that about four years after the patent had been granted, proceedings had been taken against several parties for infringements, and that they had all submitted and taken licences from the patentee (*d*). Under such circumstances, any formal objection to the plaintiff's affidavits would only have induced the Court to postpone the hearing of the application until the defect was cured.

The rule laid down in Hill v. Thompson intended to apply to all cases.

If the language of Lord *Eldon*, in *Hill* v. *Thompson* (already cited) (*e*), is examined, will be found that the reason for the rule which he laid down in that case, is quite as much applicable to the case of an application after notice as a motion for an injunction *ex parte*. His Lordship was laying down a

(*z*) 1 Webs. R. 276, n. (*a*).
(*a*) 3 Mer. 622.
(*b*) *Ante*, p. 325.
(*c*) 1 Webs. R. 275.
(*d*) The facts here stated are as they appeared before the Vice-Chancellor; they afterwards appeared somewhat differently upon appeal to the Lord Chancellor, who dissolved the injunction, 1 Webs. R. 278.
(*e*) *Ante*, p. 325.

rule which was to apply to all future cases, and although he only mentions applications *ex parte*, that was probably because interlocutory applications (that is applications before the hearing) were then almost always made *ex parte*; and an examination of the subsequent passages, in his Lordship's judgment, will show that there can be little doubt that the rule was intended to apply to *all* interlocutory applications for injunctions which must be supported by the patentee's affidavit. It seems but reasonable that this should be so, for a patentee may have ascertained since the grant of his patent, that he was not the first inventor; and he ought to put the Court in possession of all the knowledge he has on the subject, and state (if the fact be so) that the then state of his knowledge on the subject enables him to swear that he believes that he was the true and first inventor at the date of his patent. What has been said respecting the construction of the rule laid down in *Hill* v. *Thompson*, is strongly confirmed by the subsequent case of *Sturtz* v. *De la Rue*.

Sturtz v. De la Rue.

In *Sturtz* v. *De la Rue* (*f*), the plaintiff had filed his bill for an injunction to restrain the infringement of a patent granted to J. G. Christ. The affidavit of the plaintiff (upon which an *ex parte* injunction had been obtained) stated, that by certain letters patent the patentee Christ was authorized to exercise and make use of, within England, &c. "a certain invention in the said letters patent recited to have been, as it had in fact been, as deponent verily believes, communicated to the said John George Christ by a certain foreigner residing abroad." There was not in the bill, or in the affidavits on which the injunction was obtained, any other allegation as to the originality of the invention, or as to its not having been previously known or used in this country.

Upon a motion to dissolve the injunction, Lord *Lyndhurst*, L. C., held, that it could not be sustained in consequence of a defect in the specification. It was then contended for the defendant that the injunction ought to be dissolved with costs; because the plaintiff had not stated in the affidavits on which he obtained it, nor alleged in his bill, that to the best of his knowledge and belief, at the time

(*f*) 5 Russ. 322-328, 329.

when he applied for the injunction, the invention mentioned in the patent was new, or newly introduced into this country, and Lord *Eldon's* dictum in *Hill* v. *Thompson* (*g*), was relied on. Lord *Lyndhurst*, L. C., said, "There can be no doubt that when a party comes for an injunction against the infringement of a patent, he ought to state that he believes *at the time when he makes the application*, that the invention was new, or had never been practised in this kingdom at the date of the patent. It is not enough that it was believed to be new, at the time when the patent was taken out." And his Lordship accordingly dissolved the injunction *with costs*.

Plaintiff must state that he believes at the time he makes the application that invention was new.

If the patentee is not a plaintiff in the suit, application ought to be made to him to make such an affidavit, with respect to his belief that he was the true and first inventor in the manner already mentioned. If such an affidavit cannot be procured, the reason why it cannot be obtained should be stated on oath in order to induce the Court to dispense with it.

If patentee not the plaintiff, application ought to be made to him to make an affidavit.

In the case of *Bickford* v. *Skewes* (*h*), the patentee being dead, such an affidavit could not be procured, but nevertheless Lord *Cottenham*, L. C., granted an interlocutory injunction. And if such an affidavit is dispensed with, then proof of the novelty of the invention at the date of the patent, and that the patentee gave a knowledge of it to the public by his specification, must be taken to be *primâ facie*, evidence that he was the true and first inventor.

Bickford *v.* Skewes.

If patentee be dead, an injunction will be *granted on an* affidavit that the invention was new.

The plaintiff's affidavits ought also to show that the invention was new to the public at the date of the patent. This is a matter of fact respecting which others may have as much information as the patentee, and therefore a plaintiff ought always in support of his title to procure the evidence of some competent person, on affidavit, that the invention was new to the public at the date of the patent. No person can speak positively with reference to the question of the novelty of an invention on any particular day; and if he had not known it prior to that day, he can only state that fact, and that he believes that the invention was then new and unknown to the public. The value of a person's testimony in favour of the novelty of an

Affidavit as to novelty of invention by competent person.

No person can speak positively respecting the novelty of an invention on any particular day.

(*g*) 3 Mer. 624, cited *ante*, p. 325. (*h*) 1 Webs. R. 211.

invention must, therefore, materially depend upon his means of knowledge; and his affidavit in support of an application for an interlocutory injunction, ought to show what degree of probability there was of his being acquainted with the invention if it had been known to the public. The testimony of a person whose pursuits were not likely to lead him to a knowledge of a novelty in the particular article of manufacture, which formed the subject of the patent invention, would be of no value; for the object of such testimony is to prove, that it is improbable that the particular manufacture was known to the public at the date of the patent, the degree of improbability of course depending upon the means of knowledge possessed by those who say that they believe it was new.

Affidavit must state the witnesses means of knowledge, &c.

Thus, if a patent invention relates to lace machinery, a plaintiff in support of an application for an injunction, ought to procure the affidavit of a lace manufacturer, and also of a lace machine maker, stating their ignorance of the invention at the date of the patent, and that they verily believe it to be new to the public. So with respect to a patent for an improvement in watches, a plaintiff ought to apply to a watchmaker for testimony in favour of the novelty of his invention; and the belief of a person in no way connected with the manufacture of watches, and therefore, not likely to obtain early intelligence of such an invention, would be of no value.

Affidavit ought to be made by a person conversant with the particular subject.

It must also appear by the affidavits in support of the application that the invention is useful to the public, for we have seen (*i*), that utility to the public in some degree, is a necessary quality in an invention, to render it a legal subject of grant by patent. But the degree of utility is not material in support of the patentee's legal title; it is sufficient if the invention is of some use or benefit to the public. The degree of utility is, however, of some importance with reference to a plaintiff's claim to an interlocutory injunction; for the Court would more readily interfere for the purpose of protecting a patentee, who by his invention confers some considerable benefit upon the public, than one whose invention is so trifling and frivolous that it is almost worthless.

Affidavit as to utility.

A plaintiff must therefore procure the evidence of some

(*i*) *Ante*, Chap. V. s. 3, p. 132.

competent person upon affidavit, respecting the utility of the invention; and it is always advisable to show the extent to which the public has been benefited by the invention.

Previous trial or other proceedings.

If the validity of the patent which is made the subject of the suit, has been established by the verdict of a jury against some other party, that fact ought to be brought before the Court, on affidavit, in support of the application for an injunction. So, if there have been any other proceedings taken upon the patent in which the patentee has been successful.

Licences taken, acquiescence by the public, &c.

And if persons have taken licences for the use of the invention, or if the patentee has enjoyed the undisputed exercise of his patent privilege for several years, these facts, or any other which tend to show an acquiescence on the part of the public to the patentee's title, ought to be brought before the Court.

Length of undisputed possession necessary to support an application for an injunction.

It would be difficult to fix any particular length of undisputed enjoyment which would be sufficient to entitle a patentee to an injunction before a trial at Law. In the case of *Boulton* v. *Bull* (*k*), in which the plaintiffs obtained such an injunction, there had been twenty-seven years' possession of the patent right. In *Harmer* v. *Playne* (*l*), there had been a possession of thirteen years; and in *Neilson* v. *Thompson* (*m*), the Vice-Chancellor granted an injunction after twelve years' possession.

In the case of *Losh* v. *Hague* (*n*), Sir *L. Shadwell*, V. C., held that an uninterrupted enjoyment of seven years was sufficient to entitle the plaintiff to an interlocutory injunction. And in the case of *Bickford* v. *Skewes* (*o*), a possession of six years was held to be sufficient.

But so short a period as twelve months was held by Lord *Eldon*, L. C., in the case of *Hill* v. *Thompson* (*p*), to be insufficient. In that case his Lordship, after laying down the principle upon which such injunctions are granted, said, "But it is enough in the present case to resort to the principle already laid down, and which is the same that governed the cases (which have been cited) of *Harmer* v. *Playne* (*q*), and

(*k*) 3 Ves. 140.
(*l*) 14 Ves. 136.
(*m*) 1 Webs. R. 277.
(*n*) *Ibid.* 200.
(*o*) *Ibid.* 211.
(*p*) 3 Mer. 622.
(*q*) 14 Ves. 136; decided in April, 1817.

Boulton v. *Bull* (*r*); because it cannot be said, that there has been, in this case, such a possession or enjoyment under the patent, as would induce the Court to continue the injunction upon such evidence as is here afforded, until its validity has been tried at Law. Here the patent bears date, July 1814, and the specification, January 1815; and it appears by the affidavits, that the works were not completed so as to carry on the operations under the patent until July 1816,"

Affidavits as to infringement.

In order to obtain an injunction, the affidavits in support of the application must show clearly, and to the satisfaction of the Court, that the act done by the defendant, and which the plaintiff complains of as an infringement, was actually a violation of the plaintiff's patent privilege.

Specimen of patent article ought to be produced.

Whenever the invention is of such a nature as to permit the exhibition of specimens of the plaintiff's patent article, they ought to be verified on affidavit, so that the Court may have the opportunity of inspecting them, and of comparing them with any similar article of the defendants which is complained of as an infringement.

Specimen of infringement.

So, whenever a specimen of the alleged infringement can, without inconvenience, be brought before the Court for inspection, it ought to be made an exhibit to the affidavit of the person who proves the committing of the infringement, so that the Court may be able to compare it with the plaintiff's patent article, or the description in the specification.

Models.

And when it is impracticable to bring specimens into Court for inspection, it is very desirable (if practicable) to produce models, in order to show more clearly both the nature of the invention and the alleged infringement.

Hill v. Thompson.

In the case of *Hill* v. *Thompson* (*s*), it was laid down by Lord *Eldon*, L. C., that the affidavits in support of a motion ought to state particularly in what the alleged infringement consists; and that it is not enough merely to represent that the defendant has made an article in the way described in the specification, but that it should be shown before any injunction is granted, that the patent was actually infringed by doing that which forms the essence of the invention.

Affidavits must state in what the infringement consists.

Plaintiff must show that he

(*r*) 3 Ves. 140.

(*s*) 3 Mer. 622.

has used due diligence.

dition in applying to the Court after he has obtained a knowledge of the infringement having been committed by the defendant; for if he knowingly allows a person to go on for some time doing that which he says is an infringement of his patent, he cannot afterwards claim the protection of an interlocutory injunction, but must first establish his title against the defendant in a Court of Law (*t*). But a patentee may have such information as convinces him that a person is infringing his patent, and yet be unable to procure sufficient legal evidence to prove an actual infringement to the satisfaction of the Court. In such a case a patentee cannot be guilty of *laches* in not applying to the Court until he is really in a position to prove the infringement, provided he makes proper exertion to obtain the requisite proof.

Losh v. Hague.

In the case of *Losh* v. *Hague* (*u*), in which an application for an injunction was opposed by the defendant on the ground of delay, Sir *L. Shadwell*, V. C., said, "As to the length of time that has elapsed, I do not think there is much in that. On the 23rd of March, the plaintiff received some information that there was an invasion of his patent, and some portion of time it appears was spent in making inquiries; there was notice distinctly given on the 8th of May. Then some further correspondence takes place, and letters between the parties; and then a bill is filed on the 7th of July, and the application is virtually made. I cannot but think, therefore, that the plaintiff has come in sufficient time."

Affidavits to obtain an injunction after verdict in an action against the defendant.

When a plaintiff moves for an injunction, or to revive an injunction, after obtaining a verdict and judgment in an action at Law against the defendant, the statements contained in his bill must be verified by affidavit; but as the verdict which has been obtained will support the plaintiff's allegations respecting the validity of the patent, and the infringement of it, it will be unnecessary to procure the affidavit of any person in support of the plaintiff's allegation as to the novelty or utility of the invention, or the sufficiency of the specification.

If the plaintiff has, upon the occasion of a previous motion in the suit, sufficiently verified all the allegations contained in his bill, it will only be necessary, upon the subsequent motion,

(*t*) See the case of *Neilson* v. *Thompson*, before the Lord Chancellor, on Appeal, 1 Webs. R. 278.

(*u*) 1 Webs. R. 200.

to show by affidavit the nature and result of the legal proceedings which have taken place. For the purposes of this motion, the plaintiff's affidavits ought to show who were the parties to the action at Law, the form and cause of action, the substance of the several issues raised by the defendant respecting the validity and infringement of the patent, the verdict of the jury, and the judgment thereon which the plaintiff has obtained (*x*).

Affidavits must show the nature of the proceedings at law and the result.

The defendant may either in opposition to the plaintiff's application for an interlocutory injunction, or in support of a motion to dissolve such an injunction, file affidavits in answer to those of the plaintiff, and also for the purpose of proving any objection which he intends to take to the plaintiff's patent. Thus, the defendant may by affidavit show that the plaintiff was not the true and first inventor, that the invention was not new, that the specification was insufficient, or any other fact that would show that the plaintiff's patent is void. He may also show that the plaintiff has not sufficient *primâ facie* proof of a legal title to his privilege to induce the Court to grant him an interlocutory injunction, or that the defendant has not committed any infringement of the patent.

Defendant's affidavits in opposition to an injunction, or to dissolve an injunction.

In answer to the affidavits, filed by the plaintiff in support of his application, the defendant is frequently compelled to show by his affidavits the whole of his case against the plaintiff, in order to prevent the granting of the injunction as prayed. This exposure of the defendant's case is frequently a great disadvantage to him, upon the subsequent trial of an action against him in a Court of Law; and cases have sometimes occurred in which it has been deemed better for a defendant to submit to an injunction, than to run the risk of exposing the whole of his case upon the affidavits in opposition to the plaintiff's application.

Disadvantage to a defendant in showing his case before a trial.

In order to show that the patentee was not the true and first inventor, the defendant must prove by affidavit either that a knowledge of the invention was communicated to the patentee by some other person (not being a foreigner resident abroad), before the date of the patent; or that the invention was not new at the time the patent bears date (*y*).

How to show that the patentee was not the inventor.

(*x*) See the Forms of Affidavits in the Appendix, Chap. II. s. 5.

(*y*) Vide *ante*, Chap. III. s. 4, p. 31; and *post*, Chap. XI.; and Index, tit. Evidence.

How to show that invention was not new.

To show that the invention was not new, the defendant's affidavits must prove that the invention was known to the public, or had been used in public, at the date of the patent (*z*).

Affidavits in support of objections to specification.

The material part of the specification ought to be set out by the plaintiff, either in his affidavits, or in his bill verified by affidavit; and the defendant may take any objection to its sufficiency which is apparent upon the face of it. But if any part of it is untrue, or if it is insufficient for any reason not appearing upon the face of the instrument, the defendant must bring the necessary proofs in support of his objections before the Court upon affidavit (*a*).

That defendant has not infringed.

In order to show that he has not been guilty of an infringement, the defendant may prove either that the plaintiff's affidavits are untrue, or that what he has done or made is no violation of the plaintiff's patent right (*b*).

Affidavits upon an appeal motion.

Upon an appeal motion to the Lord Chancellor to dissolve an injunction, the defendant may not only use the affidavits previously filed, but may also file such additional affidavits as may be necessary in support of his case (*c*).

Affidavits to dissolve an injunction after verdict for defendant.

In order to dissolve an injunction against a defendant after he has succeeded in obtaining a verdict against the plaintiff upon a trial at Law, he must show by affidavit the nature of the proceedings which have taken place, the verdict of the jury upon some issue which was taken respecting the validity or infringement of the patent, and the judgment thereon of the Court of Law (*d*).

Upon disposing of a motion for or against an injunction, the Court usually imposes terms upon the parties.

Upon disposing of an opposed application for an interlocutory injunction, or upon a motion to dissolve an interlocutory injunction, it is usual for the Court to impose upon one or both of the parties (if there has been no previous trial at Law between them) such terms as may be deemed equitable and necessary, in order to enable the Court to do justice effectually between them. The Court may, however, grant or refuse an injunction *simpliciter*; but it is not very probable that such a case will arise as will induce the Court to take such a course.

(*z*) Vide *ante*, Chap. V. s. 2, p. 102; and *post*, Chap. XI.; and Index, tit. Evidence.

(*a*) Vide *ante*, Chap. VII. p. 151; and Index, tit. Specification.

(*b*) Vide Index, titles, Evidence and Infringement.

(*c*) See *Neilson* v. *Thompson*, 1 Webs. R. 278.

(*d*) See the Forms of Affidavits in the Appendix, Chap. II. s. 5.

In the case of *Hill* v. *Thompson* (*e*), upon a motion to revive an injunction, Lord *Eldon*, L. C., in giving judgment thus explains the mode in which the Court disposes of an application for an interlocutory injunction: "Upon an application to this Court for what may be called the extra relief which it affords on a clear *primâ facie* case, the Court will use its discretion; and if it sees sufficient ground of doubt will either dissolve the injunction absolutely, or direct an issue, or direct the party applying to bring his action; after the trial of which either he may apply to revive if successful, or else the other party may come before the Court, and say I have displaced all his pretensions, and am entitled to have my costs and the expences I have sustained, by being brought here, upon an allegation of right which cannot be supported. And as in this instance the Court will sometimes add to its more general directions, that the party against whom the application is made, shall keep an account pending the discontinuance of the injunction, in order that, if it shall finally turn out that the plaintiff has a right to the protection he seeks, amends may be made for the injury occasioned by the resistance to his just demands."

Hill v. Thompson.

Mode of disposing of an application for an interlocutory injunction.

And in the subsequent case of *Bacon* v. *Jones* (*f*), the various modes in which applications for interlocutory injunctions may be disposed of, are stated by Lord *Cottenham*, L. C., in his judgment, thus: "The jurisdiction of this Court is founded upon legal rights; the plaintiff coming into this Court on the assumption that he has the legal right, and the Court granting its assistance upon that ground. When a party applies for the aid of the Court, the application for an injunction is made either during the progress of the suit, or at the hearing; and in both cases, I apprehend, great latitude and discretion are allowed to the Court in dealing with the application. When the application is for an interlocutory injunction, several courses are open; the Court may at once grant the injunction, *simpliciter*, without more; a course which though perfectly competent to the Court, is not very likely to be taken where the defendant raises a question as to the validity of the plaintiff's title; or it may follow the more

Bacon v. Jones.

Jurisdiction founded on legal right.

Upon application, the Court may grant an injuction *simpliciter*.

(*e*) 3 Mer. 622.

(*f*) 4 My. & Cr. 433.

Usual practice either to grant the injunction directing the plaintiff to proceed at law, or to suspend the grant of it until a trial directing the defendant to keep an account.

usual, and, as I apprehend more wholesome practice in such a case, of either granting an injunction, and at the same time directing the plaintiff to proceed to establish his legal title, or of requiring him first to establish his title at Law, and suspending the grant of the injunction until the result of the legal investigation has been ascertained, the defendant in the mean time keeping an account. Which of these several courses ought to be taken, must depend entirely upon the discretion of the Court, according to the case made."

Terms imposed on the grant of an injunction.

It is now the almost invariable practice when an interlocutory injunction is granted (before a trial at Law between the parties), to order that the plaintiff shall bring such action as he may be advised against the defendant for an infringement, in order to try the validity of the patent, and whether the defendant has actually violated the plaintiff's patent privilege.

Court will sometimes *order plaintiff* to proceed within a specified time.

The Court will also in some cases order the plaintiff to proceed within a specified time; and even if the order is silent on the subject, the plaintiff must proceed to trial with all practicable expedition, or the Court will dissolve the injunction. For the defendant being under the restraint imposed upon him by an injunction, has a right (unless he has himself been guilty of *laches*) to insist that the plaintiff shall proceed with his action to try the validity of the patent, with as little delay as practicable.

Plaintiff must proceed to trial with reasonable expedition.

Bickford v. Skewes.

Thus, in the case of *Bickford* v. *Skewes* (*g*), Lord *Cottenham*, L. C., said, "The mode in which the Court will deal with the plaintiff if he does not proceed to trial, is to deprive him of that *primâ facie* right which the injunction gives him." And his Lordship also said, that if there had been in that case promptness on the part of the defendant, he should have thought it very reasonable to compel the plaintiff to go to trial at the assizes next after issue joined.

If plaintiff does not proceed to trial he will be deprived of injunction.

Defendant guilty of *laches*, cannot compel plaintiff to proceed with so much expedition.

If the defendant has been guilty of *laches*, as where he has submitted to an interlocutory injunction for a long period before he brings a motion to dissolve it before the Court, he is not entitled to put the plaintiff upon terms to use so much expedition in bringing the action to a trial.

Plaintiff is left to proceed with

It is not usual to impose any other terms than these upon

(*g*) 4 My. & Cr. 498.

the plaintiff, and the object being to test the validity of the plaintiff's title to his patent privilege, he is left to proceed by action in the best way he can for the purpose of establishing his right. Thus in the case of *Boulton* v. *Bull* (*h*), the first action having failed to produce any result, in consequence of the Court of Common Pleas being equally divided in opinion, a second action became necessary; and Lord *Rosslyn*, L. C., in dismissing a motion to dissolve an *ex parte* injunction, refused to impose any terms upon the plaintiff as to the Court in which the second action should be tried.

His action in the best way he can.

Boulton v. Bull.

Before the new pleading rules (*i*), it was sometimes desirable to put the questions at issue between the plaintiff and defendant into the shape of an issue to be tried in a Court of Law, in order that the precise questions for determination might be more distinctly brought before the Court and jury at the trial. But since the making of the pleading rules, already mentioned, the same reason for adopting an issue instead of an action no longer exists; for the defendant in an action is, by the new pleading rules, compelled to raise every objection which he takes to the validity of the patent by a proper plea, and under the 5 & 6 Will. IV. c. 83, s. 5., is bound to give the plaintiff notice of every objection which he intends to take at the trial. The practice of sending issues to be tried in a Court of Law respecting the validity of patents, has, therefore, been discontinued; and indeed it is more for a plaintiff's interest to have his patent right tried in an action than by an issue, for in an issue he would not be entitled to a notice of objections under 5 & 6 Will. IV. c. 83, s. 5.

Before the new pleading rules, questions respecting patents were sometimes determined by issue.

Practice of sending such issues to be tried at law has been discontinued.

And if the plaintiff is desirous of having his right tried by an action at Law, the Court will permit such an action to be brought, although the defendant does not ask to have such terms imposed upon the plaintiff; or even if the defendant, having already sued out a *scire facias* to repeal the patent, opposes any order being made for the plaintiff to bring an action (*k*).

If plaintiff is desirous of trying his right by an action, the Court will give him permission, although the defendant has sued out a *scire facias*.

When the Court refuses an interlocutory injunction, or dissolves it upon motion, and sends the plaintiff into a Court of

Upon refusing or dissolving an

(*h*) 3 Ves. 140.
(*i*) Reg. Gen. H. T. 4 Will. IV. 1834; Charn. New Rules, p. 125.
(*k*) *Beddelle* v. *Massey*, cor. Sir *L. Shadwell*, V. C. E., E. T. 1844.

Injunction, defendant is put upon terms to keep an account.

Law to establish his right; it is the almost invariable practice to lay the defendant under terms to keep an account of all the profits which he may make, by means of the manufacture and sale of the patent article; so that if the plaintiff shall succeed in establishing his right, the Court may be enabled to recompense him for his loss in the mean time, by ordering the defendant to pay him the amount of the profit, which he the defendant has made by means of the infringement.

Formerly a defendant was sometimes ordered to admit an infringement.

Formerly when the plea of not guilty put in issue not only the infringement, but also the validity of the patent, if the Court saw *no ground whatsoever* for disputing the fact of infringement, the defendant would be ordered to admit at the trial that he had infringed the patent. And that was done because it was deemed desirable to ensure a trial of the questions between the parties respecting the validity of the patent, and the accidental failure to prove an infringement would have caused the plaintiff to be nonsuited, and the chief object of the trial would thus be frustrated. This reason, however, for ordering such an admission to be made, now no longer exists, for even if a plaintiff should fail to prove an infringement in support of the issue on the plea of not guilty, yet he may succeed in obtaining a verdict upon all the other pleas denying the validity of the patent.

No reason now for ordering such an admission to be made.

Usual upon an injunction being refused to order plaintiff to bring an action.

And upon an injunction being refused or dissolved, it is also usual to order the plaintiff to bring an action precisely in the same way as if the injunction was granted or continued (*l*).

Case for the opinion of a Court of Law.

In a case where there is no question of fact in issue between the parties, as in *Harmer* v. *Playne* (*m*), the Court has deemed it better to put any mere question of law between them, into the shape of a case for the opinion of a Court of Law.

Admission of title as assignee.

Morgan *v.* Seaward.

The Court has sometimes ordered the defendant to admit the title of the plaintiff as assignee of the patent, *Morgan* v. *Seaward* (*n*). But such an order is now rarely made, because it might tend very much to the prejudice of the defendant. For if the declaration alleges title in a sole plaintiff, or in one

(*l*) Vide *ante*, p. 344.
(*m*) 14 Ves. 136.
(*n*) 1 Webs. R. 167.

of several plaintiffs under an assignment, the defendant will be compelled either to traverse the title so stated, or (by not traversing it) to admit it; and if he admits it, he will ever afterwards be estopped from denying the title which is alleged in the declaration.

Bunnett v. Smith.

Thus, in the case of *Bunnett and Corpe* v. *Smith* (*o*), the declaration alleged an assignment of one moiety of the patent by the patentee to his co-plaintiff, and the defendant traversed that allegation in the declaration (*p*). The plaintiffs then applied to the Vice-Chancellor for an order to compel the defendant to admit the assignment, but his Honor refused to make such an order, but ordered that such an action should be tried as would decide the legal rights of the parties. The propriety of leaving a plaintiff to pursue his legal right in such a case cannot be doubted, for any other course might prejudice the defendant; and if the plaintiff has no legal right, he has no title to the interposition of a Court of Equity, which is only to be granted in support of the plaintiff's legal right.

If it be deemed necessary the Court will direct that each party shall produce all documents, &c., in his custody or power relating to the matters in question (*q*).

Inspection will be ordered if necessary.

When the plaintiff has procured strong presumptive evidence that the defendant is infringing his patent, and is unable to obtain clear or satisfactory proof without an inspection of the defendant's machinery or premises, the Court will order the defendant to permit an inspection, on behalf of the plaintiff, by proper persons to be named in the order (*r*). And in cases where it appears to be necessary for the ends of justice, the Court will also order the plaintiff to permit a similar inspection by persons on behalf of the defendant (*s*).

Object of the Court in imposing terms.

The object of the Court in imposing terms upon the parties

(*o*) Mich. Vac. 1844, V. C. E.

(*p*) See *Bunnett and Corpe* v. *Smith*, 13 M. & W. 552.

(*q*) See the orders made in *Morgan* v. *Seaward*, 1 Webs. R. 169; and in *Russell* v. *Cowley*, *Ibid.* 458.

(*r*) See *Morgan* v. *Seaward*, 1 Webs. R. 169; *Russell* v. *Cowley*, 1 Webs. R. 458; *Brown* v. *Moore*, cit. 3 Swan. 264; *Kynaston* v. *East India Company*, 3 Swan. 248; *East India Company* v. *Kynaston*, 3 Bl. Ap. Ca. 153; and the cases cited in the notes to the last case.

(*s*) See *Russell* v. *Cowley*, 1 Webs. R. 459.

in this way, is that the real and substantial questions at issue between them may be tried with as little delay as compatible with the attainment of justice; with as little injury as possible to either party, (it being uncertain until after the trial at Law which of the parties is in the wrong,) and so that when the legal rights of the parties have been ascertained, the Court may be enabled to do substantial justice between them. But it is not imperative upon the Court, either upon granting, refusing, or dissolving an interlocutory injunction, to put the parties under any terms whatsoever (*r*). For a plaintiff may, at any time, obtain leave of the Court to bring an action at Law against the defendant for the purpose of establishing his patent right. And a defendant in Chancery may without any such leave bring a *scire facias* to repeal the patent (*s*), and so procure the determination of any questions respecting the validity of the patent.

Not imperative upon Court to impose terms.

Wilson v. Tindal.

In the case of *Wilson* v. *Tindal* (*t*), before Lord *Langdale*, M. R., his Lordship did, in fact, impose upon the plaintiff the usual terms of bringing an action to try his right, but expressed himself strongly of opinion that the Court might grant an injunction without imposing such terms. His Lordship said in giving judgment, "Having regard to the arguments on the validity of the patent to the enjoyment of it by the plaintiffs, and to the evidence which appears upon the affidavits which have been made in this case, I am of opinion that the injunction which is applied for ought to be granted. The question for consideration is, whether any terms ought to be imposed upon the plaintiffs, or whether any other mode of investigating the facts than that which is adopted in the usual course of proceeding in this Court ought to be adopted. It is to be observed, that all orders made on applications of this kind are merely interlocutory orders; they do not bind the right between the parties. The injunction which I have stated it to be my intention to grant will be an injunction of course only till further order. It will not be a perpetual injunction, not an injunction to continue during the continuance

Order for an injunction is merely an interlocutory order, and does not bind the right.

(*r*) See *Bacon* v. *Jones*, 4 M. & C. 433, cited *ante*, p. 343; and *Wilson* v. *Tindal*, cited, *infra*.

(*s*) See the 6th Section of this Chap.

(*t*) 1 Webs. R. 730.

of the patent. Notwithstanding this order the defendant may put in his answer; he may displace all the affidavits which have been filed on both sides. The plaintiff and the defendant may respectively proceed to evidence; they may bring this cause on for a hearing, and upon the hearing of the cause, the whole case, the law regarding the patent, and the facts which will appear upon the depositions, will have to be reconsidered; and that reconsideration may for anything that can be known to the contrary, justly and in a result different from that which I have come to upon the present occasion. The defendant having his option to adopt this course of proceeding, has at the bar expressed his desire to have this matter tried at Law. If he were left merely to prosecute a *scire facias* for the repeal of the patent, there would be one part of the question which he might in that way try. But there are other questions subsisting between the parties regarding matters of fact which could not be tried in that way. Now it has been stated by Lord *Cottenham*, that he recollected no instance in which the Court has not adopted the course of directing the trial of an action; he has stated that to be the result of his experience. I certainly am very reluctant to try my own memory against that, but I should have supposed that there were instances in which that had been done. It is not the right of parties in every case to have an action tried in a Court of Law; it is a question of convenience, and the Court is to exercise a fair discretion. I have no doubt whatever of the competency of this Court to grant an injunction *simpliciter*. Neither had Lord *Cottenham* any doubt of it (*u*). But the question is, whether, when there is an opportunity for carrying the matter further, it is not on the whole a convenient course of proceeding to have it tried before the tribunal which is most proper for the determination of the legal question, and by which the facts can be better investigated than they can here. It is not, therefore, upon the ground of any doubt as to the validity of the patent that I make the order which I am about to make; but it is because the nature of the case entitles the defendant to a further investigation in

The cause may proceed notwithstanding.

Defendant might bring his *scire facias*.

A trial at law is not of right.

Court may grant an injunction *simpliciter*.

Question respecting proceedings at law is, what is the most convenient course.

Court will give defendant the benefit of a trial at law even when it does not doubt the validity of the patent.

(*u*) This clearly appears from Lord *Cottenham's* judgment in *Bacon* v. *Jones*, 4 M. & Cr. 436, cited *ante*, p. 343.

one form or other, and the most convenient and most effective mode appears to me to be that which has been mentioned; namely, by bringing an action in a Court of Law. Notwithstanding, therefore, the very forcible arguments I have heard upon this subject, I think I must in this case, as has been done in so many other cases, direct the plaintiff to bring an action to try this right, the injunction being granted in the terms of the notice of motion."

Demurrer to bill.

If a plaintiff's bill does not show sufficient title to the relief which he seeks to obtain, the defendant may demur to the bill; and if the demurrer be allowed, it will of course put an end to the suit. Upon a demurrer to a bill for an injunction to restrain the infringement of a patent, it is contrary to the practice of the Court to order the demurrer to stand over with liberty to the plaintiff to bring an action to try the validity of the patent.

Kay v. Marshall.

The practice of the Court upon a demurrer to such a bill was laid down so very clearly by Lord *Cottenham*, L. C., in his judgment in the case of *Kay* v. *Marshall* (*x*), upon an appeal from an order of Sir *L. Shadwell*, V. C., that it will be sufficient here to give an extract from the judgment. His Lordship said, "To this bill the defendant put in a general demurrer; and upon the argument in the Court below, the Vice-Chancellor ordered the demurrer to stand over with liberty to the plaintiff to bring an action to try the validity of the patent. No instance has been produced of such a course having been ever taken *upon a demurrer*; and I am of opinion that, however beneficial it might be in the result, by bringing the question in issue to a speedy determination, it is too great a departure from the practice of the Court, and too inconsistent with the nature of the question before the Court upon a demurrer, to be supported.

Upon a demurrer to a bill, it is contrary to the practice to order the demurrer to stand over until after a trial.

Upon a demurrer, no question of fact in issue.

Upon a demurrer no question of fact can be in issue; the question being, not whether the plaintiff be entitled, but whether, if all he say be true, he is entitled. Every allegation, therefore, however false in fact, must be taken to be true; but in the action, the question will not be what legal consequences will follow a state of circumstances such as the

(*x*) 1 My. & Cr. 373.

bill alleges, but what are the rights of the parties upon a state of circumstances proved to exist, and which may be totally at variance with the allegations in the bill. The question being, what is the law upon an admitted state of facts, it would not be according to the course of the Court to send such a question to a jury; but there is in this case the additional objection, that the facts before the jury will not necessarily be the same as are stated in the bill. It is no answer to the objection to say, that by the modern course of proceeding at Law, the grounds upon which the verdict of the jury has proceeded will appear upon the record. This circumstance may no doubt render the verdict more useful in ascertaining the rights of the parties; but it may still leave the question quite open as to what is the result in law of the facts stated in the bill. I am, therefore, of opinion that the order appealed from cannot stand. It remains to be considered whether the demurrer ought to have been allowed or overruled; and upon this view of the case, I must assume that the Vice-Chancellor thought that he could not allow the demurrer, and in that opinion I think he was right. The plaintiff alleges that he has been in possession of his patent right for ten years, and that he has within that time established his right at Law. *The equitable relief flows from the legal title*, and the question is, whether upon the statements in the bill the Court can take upon itself to decide that the plaintiff has no legal title. If the plaintiff asking the equitable relief upon the ground of a legal title, states upon his bill a title which cannot be supported at Law, the defendant may take advantage of it by demurrer; but if the plaintiff states himself to stand in the position of having so far established his title at Law as to give him at least a *primâ facie* title, this Court will so far give credit to such circumstances, as to afford him the aid of its jurisdiction until the suit shall be in such a state as to call upon the Court for a decision, or to direct such proceedings as may be necessary to complete the investigation of the right at Law. Many cases were cited to show that upon demurrer the Court enquires, not whether the plaintiff may have a title from the facts stated, but whether he has stated a good title. But the cases which stand upon legal titles differ from those in which the title is alto-

The question is, what is the law upon an admitted state of facts.

The question raised by a demurrer cannot be submitted to a jury.

The question is, whether the bill states a sufficient *primâ facie* legal title.

Cases upon legal titles different from

those upon equitable titles.

If plaintiff has established his title at law against defendant, the Court will not refuse him assistance because it disapproves of the decision at law.

gether equitable. If, for instance, a plaintiff comes here for equitable relief after he has established his right at Law against the defendant, the Court will not withhold its assistance because it may doubt or disapprove the decision at Law. What then is the state of the plaintiff's legal right as he states it in his bill? That he has been in the enjoyment of it for ten years, and that he has in actions against others established it at Law. There is, therefore, possession of a considerable duration strengthened by the verdict obtained, *though not thereby conclusively established against the defendants.* To refuse to entertain the suit, would be to deprive the plaintiff of the benefit of his possession. In *Boulton* v. *Bull* (*y*), Lord *Rosslyn* refused to dissolve an injunction, although the Court of Common Pleas had been equally divided upon the validity of the patent. There had indeed been long possession in that case, but the right was at that time very doubtful; and Lord *Rosslyn* proceeded upon the ground that he would not disturb the possession. In *Harmer* v. *Playne* (*z*), Lord *Eldon* acted upon the same principle, and said that where the public had permitted enjoyment under a patent for a reasonably long time, the Court would give credit to the patent until the legal question could be tried; and he therefore granted an injunction, although he expressed great doubt as to the validity of the patent. In that case the patent was of thirteen years' standing. In *Hill* v. *Thompson* (*a*), Lord *Eldon* again laid down the same rule, observing, that where a patent had been granted, and an exclusive enjoyment of some duration had existed under it, the Court would interfere by injunction without putting the party previously to establish his title at Law; but that where the patent was but of yesterday, and its legality was disputed, the Court would not act upon its own notions of the validity or invalidity of the patent without the right having been first established at Law. In that case the motion was made in the year 1817. The patent was taken out in the year 1814, and the specification bore date in January 1815; but the invention had not been used until July 1816. These, indeed, are all cases of injunction; but the principle applies

(*y*) 3 Ves. 140.
(*z*) 14 Ves. 133.
(*a*) 3 Mer. 622.

equally to cases of demurrer. The Court may refuse an injunction in many cases in which the facts, if stated upon the bill, would preclude a demurrer; but it could not grant an injunction upon facts which, if stated upon the bill, would make the bill demurrable. If the facts do not give the Court jurisdiction, no injunction could issue; and for the same reason a demurrer would hold if facts of that description constitute the bill. If the plaintiff in this cause should ever apply for an injunction, the truth of the statement upon the bill to which I have adverted will then come in question. Upon the demurrer the truth of it cannot be questioned; and this bill represents such an enjoyment of possession under the patent, not by acquiescence merely, but by force of the assertion of title at Law, as within the authority of cases I have referred to, entitles the plaintiff to have his legal title recognized in this Court, until a proper occasion shall arise for having its validity ascertained. That I have already said cannot be done upon demurrer. Upon these grounds I am of opinion that this bill states such a case as precludes the Court from saying, upon demurrer, that the legal title under which the plaintiff claims is bad; the order of the Vice-Chancellor must therefore be discharged, and the demurrer overruled."

Upon demurrer the truth of the bill cannot be questioned.

In the case of *Hicks* v. *Raincock* (*b*), the defendant demurred to the plaintiff's bill on the ground that he had not established his right at Law to his patent, but the demurrer was overruled.

Hicks v. Raincock.

If the defendant wishes to avoid the necessity of answering the bill, and making a discovery which would compel him to set out accounts of great length, he must put in a plea; and if a single plea will not be sufficient to enable him to make his defence, he must apply for leave to plead double.

Defendant may plead to the bill.

In *Kay* v. *Marshall* (*c*), after a demurrer to the bill had been overruled, the defendant applied for leave to plead double, which was granted accordingly.

Kay v. Marshall. Leave to plead double.

If a defendant does not demur or plead to the bill, he must within due time after appearance put in his answer to it. By his answer he ought to show what objections (if any) he makes

Defendant's answer to the bill.

(*b*) 2 Dick. 647. (*c*) 1 Keen. 190.

to the validity of the patent, and also whether he admits or denies the alleged infringement (*d*).

Defendant's objections to the patent ought to be stated.

The various objections which may be taken to a patent have already been adverted to (*e*), and each objection ought to be stated as clearly and distinctly as practicable, without going into the evidence by which the objections are intended to be sustained. The objects for stating the objections in this way are, that the plaintiff may be prevented from using any affidavits in contradiction to matters which are stated in the answer, and also from using the answer as evidence against the defendant at the trial at an action at Law. It is usual indeed for a plaintiff to press for the answer, in order that he may be able to give any admissions it may contain in evidence against the defendant upon a trial at Law; but the answer rarely becomes available for that purpose, for a defendant generally has objections to take to the patent, which is put in suit against him, and if he takes care to state those objections distinctly on the face of the answer, the plaintiff will not give in evidence a document which would destroy his title.

Answer ought to be put in immediately.

The plaintiff generally moves for an interlocutory injunction before the defendant has put in his answer; but if plaintiff does not move immediately, the defendant ought to put in his answer with all possible dispatch, so as to prevent the plaintiff from afterwards using any affidavits which contradict the statements it contains. And as already stated (*f*), if the plaintiff has obtained an injunction *ex parte*, the defendant ought if he can to put in his answer before he moves to dissolve it.

Further proceedings in a suit.

It is not often that a patent suit proceeds further than a motion for or to dissolve an injunction after the legal rights of the parties have been determined by a trial at Law.

If the plaintiff succeeds at law he is entitled to the relief prayed by his bill.

If the patent has been established in a Court of Law against all the objections taken to it by the defendant, and it has been shown that the defendant has actually committed an infringement of the patent privilege, the plaintiff is clearly entitled to the relief sought for in his bill, *viz.*—an injunction to restrain the further violation of his patent right, and a

(*d*) See the Form of an Answer in the Appendix, Chap. II. s. 5.

(*e*) In the 2nd section of this Chap. *ante*, p. 268.

(*f*) *Ante*, p. 330.

account of the profits which he has lost by means of the infringements already committed by the defendant. In such a case it would be useless for a defendant further to resist the plaintiff's claim to equitable relief, for the determination of the legal rights of the parties respectively by a Court of Common Law, is that upon which the Court of Chancery will act, unless it can be shown that the determination was fraudulently or unfairly obtained.

If the defendant succeeds, the plaintiff has no title to relief.

If on the other hand the defendant has fairly obtained a verdict upon any issue in an action brought to try the validity of plaintiff's patent, by which it is shown either that the patent is void, or that the defendant has not infringed it, there is an end to the plaintiff's title to the relief prayed for by his bill. For a patentee can only have relief in Equity in support of a good and legal patent privilege, and the jurisdiction of the Court is only exercised in favour of a plaintiff, when it can be shown that the defendant has actually violated the patent, or at all events threatened to do so.

Parties generally compromise after a trial at law.

For these reasons the unsuccessful party in proceedings at Law generally submits, and the further progress of the suit is rendered unnecessary by a compromise.

But if the defeated party will not submit, the suit must proceed.

But if the party defeated in the proceedings at Law does not think fit to submit, or thinks that he can succeed in Equity, notwithstanding the adverse judgment of a Court of Law, the suit must proceed to a hearing in the ordinary manner (*g*).

To obtain a decree for an account plaintiff must proceed to a hearing.

So also if the plaintiff having obtained a legal decision in his favour, and in consequence of a compromise being refused, or any other cause, he is desirous of recovering a remuneration for his loss, he must proceed with his suit to a hearing in order to obtain a decree for an account of the profits which he has lost by means of the defendant's infringements.

When cause proceeds, witnesses must be examined and cause set down in the usual way.

When the cause proceeds to a hearing, the plaintiff must support all the allegations contained in his bill by the examination of witnesses, or other evidence, in the usual way; and set down the cause for a hearing so as to obtain a decree for a perpetual injunction, and the taking of an account of the profits lost by the plaintiff.

Verdict and judgment at

When a cause comes on for hearing, the Court will deem

(*g*) See the observations of Lord *Langdale*, M. R., in *Wilson* v. *Tindal*, cited *ante*, p. 348.

law will be deemed conclusive, unless they can be impeached.

the verdict of a jury, and the judgment of a Court of Law in an action tried between the parties, to be conclusive as to their legal rights, unless the verdict or judgment can be impeached. If the plaintiff has succeeded, he will be entitled to a decree, and if the defendant, the bill will be dismissed with costs.

Court may direct further proceedings at law.

If the Court, however, should see any good reason for doubting the correctness or sufficiency of a verdict or judgment at Law, it may direct such further legal proceedings as it shall deem necessary for determining the rights of the parties in a Court of Law, the bill being retained until the decision has been obtained.

If no action has been tried between the parties, the Court may either itself determine any question raised respecting the validity of the patent, or may send the question to a Court of Law to be determined, retaining the bill until the question is determined (*h*).

Plaintiff may obtain an injunction at the hearing, although he has not moved for an interlocutory injunction.

Bacon v. Spottiswoode.

If a plaintiff neglects to move for an interlocutory injunction, that will not deprive him of the right to an injunction at the hearing if he can show sufficient merits. This was laid down by Lord *Langdale*, M. R., in the case of *Bacon* v. *Spottiswoode* (*i*), who in giving judgment in that case, said: "I think that if a plaintiff be entitled to an injunction on the merits, and on the evidence produced at the hearing, he is not to be deprived of that right, because he has not moved for an injunction at a previous stage of the cause. The answer may be so speedily put in, and so framed, that it would be perfectly absurd for the plaintiff to move for an injunction (*k*), although he might be entitled to an injunction upon the merits at the hearing."

Not *necessary* for plaintiff to try an action before the hearing, but it is rarely expedient not to do so.

Bacon v. Jones.

Nor is it absolutely necessary that a plaintiff should proceed to try the validity of his patent at Law, before the hearing of his cause in Equity, so as to entitle him to an injunction; although it can be very rarely advisable to bring a cause to a hearing before he has established his title in a Court of Law.

In the case of *Bacon* v. *Jones* (*l*), Lord *Cottenham*, L. C.,

(*h*) See *Feto* v. *Guppy*, 1 M. & Cr. 487.

(*i*) 1 Beavan, 382.

(*k*) Vide *ante*, p. 324, respecting the rule, that a plaintiff cannot, for the purpose of obtaining an interlocutory injunction after answer, contradict the answer in any respect as to the plaintiff's want of title, &c.

(*l*) 4 My. & Cr. 433.

after stating the various modes in which applications for interlocutory injunctions might be disposed of, said: "When the cause comes to a hearing the Court has also a large latitude left to it; and I am far from saying that a case may not arise in which, even at that stage, the Court will be of opinion that the injunction may properly be granted without having recourse to a trial at Law. The conduct and dealing of the parties, the frame of the pleadings, the nature of the patent right, and of the evidence by which it is established, these and other circumstances may combine to produce such a result; although this is certainly not very likely to happen, and I am not aware of any case in which it has happened. Nevertheless, it is a course unquestionably competent to the Court, provided a case be presented which satisfies the mind of the Judge, that such a course, if adopted, will do justice between the parties. Again the Court may at the hearing do that which is the more ordinary course; it may retain the bill, giving the plaintiff the opportunity of first establishing his right at Law. There still remains a third course, the propriety of which must also depend upon the circumstances of the case; that of at once dismissing the bill."

A case may arise in which an injunction would be granted at the hearing without a previous trial.

Bill may be retained to give plaintiff an opportunity of establishing his right at law.

Or may be at once dismissed.

But if a plaintiff does not proceed to establish his right at Law before the hearing, it will not be sufficient for him merely to make out a *primâ facie* case; he must establish an unexceptionable title, or he must show to the Court some good reason why he has not taken proceedings for establishing his right in a Court of Law. This was decided in the cases of *Bacon* v. *Spottiswoode* (*m*) and *Bacon* v. *Jones* (*n*), in which the plaintiff having neglected to proceed to a trial, failed to make out a clear title at the hearing, and the Master of the Rolls made decrees dismissing the plaintiff's bills with costs; and an appeal to the Lord Chancellor, in *Bacon* v. *Jones* (*o*), was also dismissed with costs. The principle upon which the Court acts in such cases is most clearly explained in the judgments of the Master of the Rolls and the Lord Chancellor in the two cases just cited. The Master of the Rolls (Lord *Langdale*) said (*p*), "These two bills were filed to obtain an injunction to restrain an alleged infringement on the plaintiff's

If plaintiff does not establish his right at law before hearing, it will not be sufficient merely to make out a *primâ facie* case.

Bacon *v.* Spottiswoode, and Bacon *v.* Jones.

If plaintiff neglects to proceed to a trial, and fails to make out a clear title, his bill will be dismissed.

(*m*) 1 Beavan, 382.
(*n*) *Ibid.*
(*o*) 4 M. & Cr. 433.
(*p*) 1 Beavan, 388.

patent, and for consequential accounts. When a cause of this kind is brought to a hearing (an occurrence which does not frequently happen), it is for the purpose of having an injunction made perpetual, or continued during the legal right of the plaintiff under his patent; and it appears to me, that however unusual the circumstance may be, the plaintiff is not precluded from asking for an injunction by the fact of his not having applied for it on interlocutory motion: but the usual course being to ask for the injunction as an immediate protection on interlocutory motion, and the Court having then an opportunity of directing such proceedings, if any, as may be required to determine the validity of the patent; it seems, that the plaintiff, if he omits to move for the injunction at an early period in the cause, first shows that he does not consider the injunction as immediately necessary for the protection of his interest, and next *imposes upon himself the obligation of making out a clear and unexceptionable title at the hearing.* It would be very inconvenient if the plaintiff, having neglected to employ the means in his own power, or which the Court would have afforded him, to establish the validity of his patent, should be permitted to avail himself of doubts which he has himself left, for the purpose of obtaining further time to do the same thing which he ought to have done before. I think, that, at the hearing of the cause, the Court has to look at the facts produced in evidence, for the purpose of considering whether a perpetual injunction should then be granted. On an interlocutory order, it has to look at the facts produced in evidence, for the purpose of considering whether an injunction should be granted till the right can be tried, or further investigated. It is truly said, that where a patent has been granted, and there has been an exclusive possession of some duration under it, the Court may interpose its injunction, without putting the party previously to establish the validity of his patent by an action at Law; but this interposition must nevertheless depend, to a considerable extent, on the circumstances of the case, and the nature of the defence. The Court is not bound to grant the injunction merely because a patent has been granted and exclusively enjoyed for some time; and when the cause is brought to hearing, I apprehend that the plaintiff ought to show his title clearly: and that, if he fails

If plaintiff omits to try before the hearing, he must make out a clear title.

Inconvenience produced by plaintiff delaying to proceed to a trial.

At the hearing Court not bound to grant an injunction upon a *primâ*

in that, and has not previously obtained an injunction, he will not be allowed to use the facts proved in the cause as evidence of a *primâ facie* case, giving him a right to further delay, for the purpose of enabling him to establish more satisfactorily the legal title upon which alone his equity is founded.

facie case, or unless plaintiff shows a clear title.

In this particular case, having regard to the nature of the patent and the specification, and to the defence, the nature of the alleged infringement, and all the facts which have been now proved, I think that the Court would not upon the same facts have granted or continued an injunction previously to the validity of the patent being established by an action at Law; and, therefore, that the plaintiff has not done that which it appears to me he must be deemed to have undertaken to do before he set down his cause for hearing; he has not made out a clear and unexceptionable title; and having failed to do so, the question which I have had to consider in his favour is, whether the bills should be retained for a year, in order to give him an opportunity of now bringing actions; but, for the reasons which I have stated, I think that this ought not to be done; and having regard to the nature of the suit, and the sort of jurisdiction which the Court exercises in such cases, I am of opinion that the bills must be dismissed with costs."

If plaintiff neglects to proceed to a trial before the hearing, and fails to make out a clear title, his bill will be dismissed with costs.

And upon the appeal, Lord *Cottenham*, L. C., in giving judgment said, "Generally speaking, a plaintiff who brings his cause to a hearing is expected to bring it on in such a state as will enable the Court to adjudicate upon it, and not in a state in which the only course open is to suspend any adjudication until the party has had an opportunity of establishing his title by proceedings before another tribunal. And I think the Court would take a very improper course if it were to listen to a plaintiff who comes forward at the hearing, and asks to have his title put in a train for investigation without stating any satisfactory reason why he did not make the application at an earlier stage. When he comes forward upon an interlocutory motion, the Court puts the parties in the way of having their legal title investigated and ascertained; but when a plaintiff has neglected to avail himself of the oppor-

Plaintiff is expected to bring his cause to a hearing in such a state as will enable the Court to adjudicate.

If plaintiff asks at the hearing for a trial at law, he must explain his delay.

If plaintiff neglects to avail himself of the

opportunity of proceeding to a trial before the hearing, it is a question of discretion whether Court will then assist him.

tunity thus afforded, it becomes a mere question of discretion how far the Court will assist him at the hearing, or whether it will then assist him at all. If, indeed, any circumstances had occurred to deprive him of that opportunity in the progress of the cause, the question might have been different. But in this case I have not heard any reason suggested why the plain and ordinary course was not taken by the plaintiffs of previously establishing their right at law. They might have brought their action before filing the bill, or they might, after the bill was on the file, have had their right put in a train for trial. Instead of that, *they have allowed the suit to remain perfectly useless to them for the last four years.* They knew of the alleged infringement in the month of August 1835; and from that time till the hearing there was no moment at which they might not, by applying to the Court, have had liberty to bring an action to establish their title at Law. It is obvious that such a line of proceeding exposes a defendant to inconveniences which are by no means necessary for the protection of the plaintiff. It is no trifling grievance to a defendant to have a Chancery suit hanging over him for four years, in which, if the Court shall so determine at the hearing, he will have to account for all the profits he has been making during the intermediate period. Is a defendant to be subject to this annoyance without any absolute necessity, or even any proportionate advantage to his adversary, and without that adversary being able to show any reason why he did not apply at an earlier time? It appears to me that it would be very injurious to sanction such a practice, more especially when I can find no case in which the Court has thought it right to retain a bill simply for the purpose of enabling a plaintiff to do that which these plaintiffs might have done at any time within the last four years. It was much more regular and proper that the plaintiffs should have taken steps for putting the legal right in a course of trial. Those steps they have not chosen to take; and it is now impossible to put the defendants in the same position in which they would have stood if such a course had been originally adopted. For these reasons, I am of opinion, that the Master of the Rolls, finding that the evidence in the cause was not

Plaintiff may have liberty to bring an action at any time before the hearing.

When plaintiff has been guilty of great delay, the Court will not give him further time to establish his right.

No case in which the Court has retained a bill to enable the plaintiff to do that which he has had ample opportunity of doing previously.

such as he could act upon with safety, came, in the exercise of his discretion, to a sound conclusion, when he refused to grant the injunction or retain this bill."

When plaintiff has proved his title and an infringement, he is entitled to a decree.

Whenever a plaintiff in a patent suit has made out a good and legal title to the privilege granted to him by his patent, and has proved that his privilege has been violated by the defendant, he is entitled to the relief prayed by his bill, and a decree that the defendant be restrained by injunction from committing any further infringement, and that he render an account of all the profits which he has made by invasion of the plaintiff's privilege.

Injunction granted at the hearing perpetual.

The injunction which a plaintiff obtains by decree, is not merely temporary, or until further order, like an interlocutory injunction, but extends to the whole duration of the patent privilege; and not only applies to the particular mode of infringement proved against the defendant, but to all other modes in which the patent privilege may be violated.

Plaintiff's right to an account depends upon his title to an injunction.

The plaintiff is also entitled to an account of profits in a patent suit, whenever he has made out a title to the interposition of the Court by injunction in his favour; and the Court gives him an account, in order that his remedy may be complete. But if the plaintiff fails to make out his claim to an injunction, he cannot have a decree for an account (*q*).

Difficulty of taking an account.

In consequence of the difficulty of working out a decree for taking an account of profit, such an account is rarely taken (*r*).

It is difficult to define the extent to which the Court can

(*q*) *Bailey* v. *Taylor*, 1 Russ. & My. 73.

(*r*) The practical difficulties in the way of the working out such a decree are clearly shown by the judgment of the Lord Chancellor in the case of *Crossley* v. *The Derby Gas Light Company*, 3 M. & Cr. 428. The bill in that cause, after stating the plaintiff's title to a patent for making gas-meters, and alleging that the defendants had made gas-meters, which were infringements on the patent, and had used them in carrying on their works or had sold and disposed of them for profit, prayed that the defendants might account for all such meters so sold or disposed of or used, and for the full value thereof, or other profit of the sales, or other disposition or use thereof. By the decree an account was directed of what profit had been received, and what benefit derived from the use of such gas-meters as were made and manufactured during the existence of the letters patent, from six years previous to filing the bill and down to the date of the decree, and it was ordered that the defendants should pay to the plaintiff what should be found due upon taking such account. The Master, by his report, "Found and certified that a benefit had been obtained by the defendants by the use of meters in saving gas equal to 2*s*. 6*d*. for every 1000 cubic feet of gas, equivalent to profit, and thereby enabling the Com-

go in compelling the defendant to account to the plaintiff for profits. It is clear that the Court will give to the plaintiff all

pany to sell at 10*s.*, and that 25 per cent. had been saved by the use of meters; and it appeared by the books of the Company that the defendants, by hand-bills printed and delivered to customers in July, 1821, determined that meters should be furnished free of expense; and that the Company hoped to be able to furnish gas permanently to those who used meters at 7*s.* 6*d.* per 1000 cubic feet. And it also appeared that the Company, on the 8th of May, 1822, made an order, that all persons having more than one light, or having but one light, which was not publicly exposed, should give notice of their intention to receive a gas-meter ten days before Midsummer-day then next; and in case of their omitting to give such notice the pipe of communication would be cut off. And upon the whole consideration of the several states of facts and the evidence so laid before him, the Master allowed and found that the benefit, including profit received, derived by the defendants from the use of such gas-meters as were made and manufactured during the existence of the letters patent, from six years previous to filing the plaintiff's bill down to the date of the decree, amounted to the sum of 6,000*l.*" To this report the defendants took several exceptions, which came on for argument before the Master of the Rolls on the 6th of May, 1837, when his Lordship made an order referring it back to the Master to review his report, with a direction that he should state to the Court the grounds upon which he came to the conclusion which he might arrive at.

The plaintiff appealed against that order, but the Lord Chancellor (Lord *Cottenham*) dismissed the appeal with costs.

His Lordship, after stating the objects of the bill and the substance of the decree, said, in delivering judgment:—

"This decree was pronounced by the Vice-Chancellor, in March, 1834, and was, upon appeal, affirmed by Lord *Brougham*; and the only duty of the Court upon the exceptions to the Master's report, now before me upon appeal from the order of the Master of the Rolls, is to put a construction upon the decree, and decide whether the Master has properly taken the account referred to him by the decree. The Master of the Rolls appears to have stated that he was unable to ascertain the grounds upon which the Master had reported the sum of 6,000*l.* as the result of the account, and referred it back to the Master to review his report, and to state the grounds upon which he came to the conclusion he might arrive at, not to state the grounds of the report already made. There is not, therefore, the difficulty urged at the bar in support of the appeal, that, as the reference cannot be made to the same Master, some variation in the order of the Master of the Rolls was, at all events, necessary. If the Master of the Rolls is to be taken to mean that he did not understand how the evidence stated in the report could have led the Master to the conclusion to which he came, I entirely concur in that opinion; but it appears to me that the grounds upon which the Master proceeded do appear upon the report, and that they do not support the conclusion. He states, that he found from the evidence that benefit, equivalent to profit, and equal to 2*s.* 6*d.* upon every 1,000 cubic feet, had been obtained by the use of the meters, and that 25 per cent. had been saved by the use of the meters. He then states the particular grounds of this conclusion, which are, hand-bills circulated by the Company in 1821, intimating the Company's intention of furnishing meters free of expense, and that the Company hoped to be able to furnish gas permanently, to those who used meters, at 7*s.* 6*d.* per 1,000 cubic feet, the price to those who did not use meters being 10*s.* Also an order of 1822, by which certain persons were not to be served with gas unless they used meters; and he then reports 6,000*l.* to be the result of the account, a sum which appears to have been produced by calculating 2*s.* 6*d.* upon each 1,000 cubic feet of gas supplied, rejecting, however, some hundreds of pounds, which, if the principle were correct, ought to have been added to the 6,000*l.*

the profits which the defendant has actually made by infringing the plaintiff's patent privilege, but in the absence of

"It is obvious that a suggestion never acted upon, that the Company might at some future time supply gas to those who used meters at 2*s.* 6*d.* per 1,000 cubic feet less than to those who did not, can be no ground for estimating the profit actually derived from the use of them. But there was another statement of the Company in evidence which was much relied upon, namely, that not more than three-fifths of the gas made was paid for. This was a vague statement, not to be relied upon in executing a decree directing an account of profit to be taken.

"The grounds, however, upon which the Master proceeded, and upon which it was attempted to support his report, were these: the Company charge 10*s.* per 1,000 cubic feet; the quantity supplied is calculated by the ascertained consumption of a certain number of burners in a given time; and if the burners were always in a proper state, and the time were never exceeded, all the gas supplied would be paid for. But that is not the case; frauds are practised by altering the burners and exceeding the stipulated time, so that it is found that, instead of 1,000 cubic feet being consumed in the given time, a much larger consumption takes place, equal to one-fourth more; that is, 1,250 cubic feet are consumed instead of 1,000; but as the Company charge 10*s.* per 1,000 feet, that is 2*s.* 6*d.* for every 250 cubic feet, the loss of the 250, that is of the difference between the 1,250 and the 1,000 is worth 2*s.* 6*d.*, and as by the use of the meter these frauds are prevented, the Company save 250 cubic feet upon every 1,000 cubic feet, which is equivalent to 2*s.* 6*d.* for every 1,000 cubic feet.

"Now assuming these figures to be correct—and if the principle followed be not just, there is no necessity for enquiring whether they are so or not—the calculation proceeds upon the supposition that 2*s.* 6*d.* is the value to the Company of 250 cubic feet of gas; whereas it appears that the Company have been supplying, not 1,000 cubic feet, as calculated, but 1,250 cubic feet for 10*s.*; nay, much more, for it is admitted that 10 per cent. is lost under either system before the gas comes to the consumer's premises, so that 1375 must be made for every 1,000 paid for; and if their proposal of charging 7*s.* 6*d.* only be used as evidence against them, it would show the value of the 1,000, or rather 1,100, cubic feet to be 7*s.* 6*d.* and not 10*s.* The whole principle of the calculation appears to me to be founded in error. The supposed profit is in fact a protection against a loss. The sum charged for any quantity of gas supplied, must not only cover all the expenses of the establishment, machinery, materials, labour, and interest of capital, but also the profit of the Company. The actual loss sustained in making 250 cubic feet over and above the 1,000, cannot, however, be measured by a proportional part of these charges and outgoings. By far the greater part of these would be the same, though 1,000 only were produced. After printing 1,000 copies of a newspaper, the expense to the proprietor, of printing 250 more will very little exceed the value of the paper and labour employed; and if we suppose some defect in the machinery for printing, in consequence of which 250 copies out of every 1250 are rendered unfit for use, would not the loss consist in the paper and other materials, and the labour employed in printing the 250 useless copies?—would it be reasonable to calculate the loss at one-fourth part of the price for which the 1,000 good copies were sold? By the same rule, if the Company were repaid the value of the materials actually consumed in producing the additional 250 cubic feet, and of the additional labour paid for, with a due allowance for the additional wear of the machinery employed, their loss would be repaid to them. The Master, by the course he has adopted, has not only charged upon these 250 cubic feet a proportion of all the cost and expense of the establishment, machinery, and interest of capital, but of the profit of the Company. It is clear that the Company have not, in making the additional 250 cubic feet, sustained this loss. The amount, therefore, would be

all authority on the subject, it is impossible to say whether the Court can also compel the defendant to pay the plaintiff

the measure of the profit or benefit derived from the use of meters. The Master has not even carried out his own principle, for he has not allowed for the cost of the meters, or for any expenses by which a saving has been effected.

"That the Master has not adopted a correct mode of estimating the profits derived from the use of meters, seems to me quite clear. It is therefore impossible to confirm his report; but it is also, I think, impossible to allow the exceptions, all of which assert the proposition that no benefit or profit has arisen from the use of the meters, within the meaning of the decree. Of this I felt no difficulty at the hearing of this appeal; but I felt the same anxiety which the Master of the Rolls has expressed, to make, if possible, such a declaration of the opinion of the Court upon the construction of the decree, as might guard the parties against the chance of a second failure before the Master. Upon carefully considering all the circumstances of the case, however, I am satisfied that I cannot do so consistently with the usual practice of the Court, or with any certainty in the present state of the inquiry, of not promoting instead of preventing the chance of error. There is nothing doubtful or ambiguous in the terms of the decree, nothing therefore to be explained by any explanatory Order, and I have no authority to depart from, or in any respect to vary the directions it contains.

"I am quite aware of the difficulty which may, indeed must, arise in doing with accuracy what the decree directs. To ascertain the profits created by the application of particular means, and, for that purpose, to refer a just proportion of the profits made to some only of the agents employed, may involve questions of the greatest nicety; but such is the duty which the decree has imposed upon the Master. A similar duty was imposed and similar difficulties were experienced in *Brown* v. *De Tastet* (*). There the object was to ascertain the profits made by the use of a particular portion of the capital employed; here, by the application of a particular part of the machinery used. In that case the plaintiff had, I believe, ultimately to lament, that in attempting to give to her what abstractedly she was thought to be entitled to, the means by which that object was to be attained were not sufficiently considered. It is easy to foresee many of the difficulties which may arise in taking the accounts directed by the decree, but impossible by anticipation to prescribe to the Master the means of solving them. Some considerations, indeed, though essentially affecting the profits in question, seem to be beyond the reach of calculation. It is obvious, for instance, that the use of the meters, by preventing fraud and the effects of negligence, would enable the Company to supply the gas at a lower rate, and so either cause an abatement, or prevent an increase in the charge; the necessary consequence of which would be to increase the consumption, and add to the profits. But to what extent this effect was thereby produced, and what profits were thereby created, it is impossible to appreciate. In any business in which much money is lost by bad debts, those consumers who pay may be supposed generally to indemnify the tradesman against the dishonesty of others, by the additional price they are compelled to pay; but, if all paid, the same profit would result from selling at lower prices, and the additional profits from the increased consumption would be great, but incapable of being reached by previous calculation.

"So long as it shall be the course of this Court to direct such accounts of profits,—and there are many precedents to support them,—(whether those precedents justify the decree in this case, it forms no part of my duty to enquire,) such among other difficulties will arise, which must be in some manner surmounted. This can only be attempted, when they actually occur, in pursuing the investigation directed. It is impossible, by any declaration or direction, to provide for them by anticipation.

* Jac. 284. See also Lord *Brougham's* observations in *Docker* v. *Somes*, 2 My. & K. 665-8.

the amount of any other loss which he has sustained, in consequence of the defendant violating the patent.

The amount of profits which the defendant has actually obtained by means of the infringement of the patent, is properly the subject of an account, and may be ascertained by an inquiry before the Master, although there are many difficulties in the way which prevent such an account from being satisfactory. But if the plaintiff should be held to be also entitled to recover in Equity, the amount of all the loss which he has sustained by reason of the violation of his right, it is quite clear that it would not be practicable to ascertain the amount by an account in the Master's office; and, therefore, it seems that the only course would be to send an issue into a Court of Law, to have the amount of the damages sustained by the plaintiff assessed by a jury.

Usual to compromise the claim for an account.

In consequence of the difficulties in the way of taking an account of profits under a decree, and the vexatious nature of the proceeding, it is usual for the parties to determine the amount of profit for which the defendant is to account by agreement, and it is clearly to the interest of both parties to do so.

Account may be waived.

If the amount of profit for which the defendant would have to account is very small, the plaintiff may waive the account (*r*), and after having obtained an injunction, if the defendant submits it would be useless to proceed with such a suit to a hearing.

I regret the difficulties to which the plaintiff is exposed in prosecuting the right which the decree gives him; and that I have not the means, in this state of the proceedings, to assist him. But I would seriously submit to the consideration of both parties the expediency of terminating this contest by some compromise and arrangement. The plaintiff has very large rights under the decree, but is met by very serious difficulties in obtaining the fruits of it. The defendants, on the other hand, have this difficulty hanging over them; and although they may trust to the difficulties in the way of the plaintiff, they may be assured that the decree has in it that, which must, if prosecuted, subject them to great vexation and expense, independently of what they may have ultimately to pay from the result of the account. It is a case, therefore, in which it would seem that a reasonable compromise must be for the benefit of both the parties litigant; and it was for the purpose of informing them of what, in my view of the case, constitutes the real situation of each, in the hope of leading both to think seriously of the evils of further litigation, that I have been induced to go more into detail, than the duty I have at present to perform seemed to require. Upon the whole, I am of opinion that the Master of the Rolls made the proper order, and that if the contest is to continue, the present Master must renew the attempt to take the account directed by the decree."

(*r*) See *Fradella* v. *Weller*, 2 Russ. & M. 247.

If a plaintiff intends to waive his right to an account, he ought to give the defendant notice of his intention, and if the defendant submits and pays all the plaintiff's costs, further proceedings will be unnecessary. But if the defendant refuses to submit or to pay the plaintiff's costs, the cause must proceed to a hearing, and the plaintiff will then obtain a decree for a perpetual injunction, and for the payment of his costs of suit (*s*).

If the defendant submits, a decretal order ought to be made to give effect to the agreement between the parties.

If patent previously tried, certificate should be given in evidence to obtain full costs.

If the validity of the patent upon which the plaintiff is proceeding has been previously established by any judgment or decree, and a certificate obtained, the certificate ought to be given in evidence so as to entitle the plaintiff to full costs, under the statute 5 & 6 Will. IV. c. 83, s. 3 (*t*), as altered by the 5 & 6 Vict. c. 97, s. 1 (*u*). But the Judge making a decree or decretal order may certify to prevent the plaintiff from obtaining any more than ordinary costs (*x*).

Judge may certify that validity of patent has come in question.

When the validity of the patent actually comes in question at the hearing upon the making of a decretal order, the Judge is authorized by the statute 5 & 6 Will. IV. c. 83, s. 3 (*y*), to certify that fact, so as to enable the patentee to obtain full costs in any future proceedings upon the patent. And if the plaintiff has not already procured such a certificate (*z*), he ought to apply to have one granted to him (*a*).

Section IV.

Of an Action for Penalties for Counterfeiting the Name or Device of a Patentee.

Offence of counterfeiting patentee's name or mark.

The statute 5 & 6 Will. IV. c. 83, has provided an additional protection to patentees against persons who may be guilty of counterfeiting or imitating their names, marks, or devices, upon articles made according to or in imitation of their inventions,—

(*s*) *Fradella* v. *Weller*, 2 Russ. & M. 247.
(*t*) Stated *ante*, p. 300.
(*u*) *Ibid.* p. 303.
(*x*) Vide *ante*, pp. 300, 304.
(*y*) Stated *ante*, p. 300.
(*z*) See the form of certificate in the Appendix, Chap. II. s. 5.
(*a*) See the observations respecting costs in section 2, *ante*, p. 301.

By sect. 7, of that statute, it is enacted, "That if any person shall write, paint, or print, or mould, cast, or carve, or engrave or stamp, upon any thing made, used, or sold by him, for the sole making or selling of which he hath not or shall not have obtained letters patent, the name or any imitation of the name of any other person, who hath or shall have obtained letters patent for the sole making and vending of such thing without leave in writing of such patentee or his assigns:—or if any person shall upon such thing, not having been purchased from the patentee, or some person who purchased it from or under such patentee, or not having had the licence or consent in writing of such patentee or his assigns, write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word 'patent,' the words 'letters patent,' or the words 'by the King's patent,' or any words of the like kind, meaning, or import, with a view of imitating or counterfeiting the stamp mark or other device of the patentee; or shall in any other manner imitate or counterfeit the stamp, or mark, or other device of the patentee; he shall for every such offence be liable to a penalty of 50*l.*, to be recovered by action of debt, bill, plaint, process, or information, in any of his Majesty's Courts of Record at Westminster, or in Ireland, or in the Court of Sessions in Scotland,—one half to his Majesty, his heirs and successors, and the other to any person who shall sue for the same: Provided always, that nothing herein contained shall be construed to extend to subject any person to any penalty in respect of stamping, or in any way marking, the word 'patent' upon any thing made, for the sole making or vending of which a patent before obtained shall have expired."

5 & 6 Will. IV. c. 83, s. 7.

If any person shall write, paint, &c. upon any thing made, used, or sold by him, the name, or any imitation of the name of a patentee;

or shall upon any such thing, write, paint, &c. the words 'patent,' 'letters patent,' &c., for the purpose of counterfeiting a patentee's stamp, mark, &c.

or in any other way counterfeit the stamp, &c. of a patentee;

the offender shall be liable to a penalty of 5*l.*, to be recovered by action of debt;

one half for the king, the other half for the informer.

Before the passing of this statute, the only remedy which a patentee had against any person for imitating his name or device was, by a bill in Chancery for an injunction, or an action at Law for the damages which he might have sustained (*c*).

Remedies before the statute.

There are two offences mentioned in this section of the statute:—*firstly*, The counterfeiting or imitating the name of any patentee; and, *secondly*, The counterfeiting or imitating of any stamp, mark, or device of a patentee.

Two offences mentioned in the statute.

(*c*) Vide *post*, sec. 5, in this Chapter.

Offence of imitating or counterfeiting a patentee's name.

Under the first clause of the section, the offence of imitating or counterfeiting a patentee's name may be committed in eight different ways; *viz.*—by writing, painting, printing, moulding, casting, carving, engraving, stamping the name, or any imitation of it, without the leave in writing of the patentee or his assigns. The offence must be committed upon something for the sole making and vending of which the patentee has obtained his letters patent; and it would seem, therefore, that the article or thing upon which such an offence is committed must be a thing the making or vending of which would be an infringement of the patent.

Must be committed upon something for which a patent has been obtained.

And upon something made, sold, or used by the offender for which he himself has not a patent.

And the offence may be committed upon any such pirated article or thing which is *made*, *used*, or *sold* by the offender. But the penalty is only imposed with reference to something made, used, or sold by the offender, *for the sole making or selling of which he has not himself obtained letters patent.*

Whether the Act applies to any thing done after the expiration of the patent.

It may be doubted whether this protection given to a patentee against the use and imitation of his name, is intended only to apply to acts done during the continuance of his patent term; or whether it is also to apply to the use and imitation of a patentee's name, after the expiration of his privilege. The Act makes it an offence in any person to copy or imitate the name of "any other person, who hath or shall have obtained letters patent," &c.; and these words seem to be large enough to include the copying or imitating of the name of a patentee, whose patent has expired. But the preamble of the Act shows (*d*), that the objects of the legislature in altering the Law touching letters patent were "*as well for the better protecting of patentees in the rights intended to be secured by such letters patent*, as for the more ample benefit of the public from the same;" and it will most probably be held, that the intention was that the seventh section should only apply to acts done during the existence of a patent.

Selling an article with a counterfeit name, no offence.

It will be observed that a person who may use or sell any article or thing having a patentee's name counterfeited or imitated upon it, will be guilty of no offence under this statute; if he did not himself counterfeit or imitate the name in the manner mentioned in section 7.

If a patentee on his own

And according to the strict interpretation of the words

(*d*) See the Act in the Appendix, Chap. I. s. 1.

used in the Act, if a patentee were, upon articles made by himself, according to his own patent invention, to counterfeit or imitate the name of another patentee, he would be guilty of no offence within the meaning of this statute. For the words are, "if any person shall write, paint, &c., upon anything made, used, or sold by him, *for the sole making or selling of which he hath not, or shall not have obtained letters patent*," &c. Therefore every thing made, used, or sold by a person according to his own patent invention, is excepted from the things upon which the offence of counterfeiting or imitating may be committed by writing, painting, &c., as mentioned in the Act. And if the thing upon which the writing, painting, &c., is done, has been made according to an invention comprised in a patent granted to the person himself who counterfeits another patentee's name by so writing, painting, &c., it follows that such writing, painting, &c., is not such a writing, painting, &c., as according to the strict meaning of the words of the statute is made any offence.

patent articles counterfeits the name of another patentee, *quære*, whether any offence?

And it may even be questionable whether the exception would not extend to things made by a person according to an invention comprised in an expired patent.

The *second* kind of offence within this section of the statute, is the counterfeiting or imitating any stamp, mark, or other device of a patentee.

Offence of counterfeiting stamp, &c.

It is necessary carefully to examine the words of the second clause of this section of the statute with reference to this offence. The clause commences, "or if any person shall upon *such thing*," &c. and that of course means a thing made, used, or sold by the offender, and for which he himself has no patent, but which is comprised in a patent granted to another person.

Must be committed upon something for which the offender has no patent, but for which some other person has a patent.

It is also further provided, that the thing upon which the offence is committed must also be a thing which has not been "purchased from such patentee, or some person who purchased it from or under such patentee;" the words "such patentee," meaning "a patentee who hath or shall have obtained letters patent for the sole making or vending of such thing," as expressed in the first branch of the section; and it is no offence unless the act is done by a person "not having had the licence or consent in writing of such patentee." The of-

And upon something not purchased of the patentee.

fence may be committed not only by writing, painting, printing, &c., as mentioned in the first clause of the section, but also by otherwise marking the word "patent," the words "letters patent," or the words "by the King's patent," or any words of the like kind, meaning or import. And the act must be done with a view of imitating or counterfeiting the *stamp mark*, or other device of the patentee.

Must be done with intent to counterfeit patentee's stamp, &c.

A general provision is then added, which makes it equally an offence if a person (that is such a person as before described) shall, in any other manner, imitate or counterfeit the stamp, or mark, or other device of the patentee.

An offence to counterfeit any stamp, mark, &c.

The same difficulties arise in construing the second clause of the section as in construing the first, and to which allusion has already been made. Thus it is uncertain whether it would be an offence under this statute, if a person were to imitate a patentee's stamp or mark after his patent had expired; or, whether, if a person upon any thing made, according to his own patent invention, were to imitate or counterfeit the stamp mark or device of another patentee, he would be guilty of an offence within the meaning of the second clause of the section. And the difficulty is not at all diminished by the proviso at the end of the section, by which it is declared, that nothing therein contained shall be construed to extend to subject any person to any penalty in respect of stamping, or in any way marking, the word "patent" upon anything for the sole making or vending of which a patent has expired.

Same difficulty in construing the second branch of the section as the first.

And a question may arise upon the construction of either clause of the section; *viz.* whether, if a person imitates or counterfeits a patentee's name or mark upon a wrapper, or anything containing a pirated article, he will be guilty of an offence within the meaning of the statute.

Whether counterfeiting a name or mark upon a wrapper is any offence.

The penalty of 50*l.* imposed on an offender for *every* offence he commits, may be recovered not only by the patentee himself, but by any person who shall sue; one-half for the use of her Majesty, the other half for the use of the plaintiff himself.

Who may sue for penalties.

Penalties may be recovered by action of debt, bill, plaint, process, or information in any of her Majesty's Courts of Record at Westminster. The description in the Act does not, strictly speaking, apply to the Court of Queen's Bench, for

How to be recovered.

that Court is in contemplation of law held before the Queen herself, wheresoever she shall be in England; but the Courts of Common Pleas, and Exchequer of Pleas, are, in fact, located at Westminster. It seems that no penalty under this section could be recovered in a County Palatine Court, or in any inferior Court of Record.

The declaration in an action of debt for penalties under this statute must show the grant of a patent to a patentee, against whom the offence has been committed, and the due enrolment of a specification-precisely as in an action for an infringement of the patent. It must also state that the defendant had not obtained any patent for the article upon which he committed the offence, and then, (in such of the words of the statute as are applicable to the case,) allege the committing of the offence for which a penalty has become payable. Declaration.

It has not been decided whether a defendant can make a good defence to such an action on the ground of the patent granted to the patentee being void. But a void patent may properly be considered as no patent at all, and could not have the effect of granting to the patentee the sole making or vending of the article upon which the alleged offence has been committed. It seems therefore that a defendant ought to be allowed to show as a defence that the patent was void and inoperative, for in that case the article upon which the imitating or counterfeiting has been committed would not be an article upon which an offence could be committed within the meaning of the statute. Defence. Patent void.

By the statute 21 Ja. I. c. 4, s. 4 (*e*), the defendant in a final action is enabled to plead not guilty, or that he owes nothing, and to give the special matter in evidence; under that statute, therefore, the defendant is enabled to plead *nil debet* to an action of debt for penalties under the 5 & 6 Will. IV. c. 83, s. 7. But according to a general rule made by the Judges (*f*), he must in the margin of the plea write the words "By statute." Plea.

It seems also that if the defendant is entitled to set up the invalidity of the patentee's patent as a defence to the action,

(*e*) See this section of the statute in the Appendix, Chap. I. s. 1.

(*f*) Reg. Gen. T. T., 1 Vict. 1838; 8 A. & E. 279; 4 Bing. N. C. 816.

he may do so under the plea of *nil debet*, and need not give any notice of the objections which he intends to take to the patent, the fifth section of the statute being inapplicable.

Statute of Limitations.

An action against a person for a penalty under this statute comes within the meaning of the stat. 31 Eliz. c. 5, s. 5 (*g*), and therefore must be commenced within one year after the fact committed, if the action is brought by the patentee or an informer, and within two years if the Crown sues for the penalty (*h*).

Section V.

Of other Remedies available for Patentees.

Patentees have other remedies in common with other persons.

Patentees have no peculiar remedies except those already mentioned, but there are others which they (in common with other persons) may avail themselves of.

Deceitfully selling articles as of the manufacture of some other person.

Thus, if a person deceitfully sells articles as of the manufacture of a patentee or of any other person, such an act is a fraud upon the patentee, or other person by whom the offender pretends that the articles were manufactured, and the law provides the person injured with a remedy against the offender.

Mode of practising the deceit immaterial.

It does not signify in what manner the offender compasses his purpose; whether by counterfeiting a name, word, mark or device, upon the spurious articles themselves, or upon the envelopes in which they may be wrapped, or by using any other means so as to deceive the public, and induce them to purchase goods as the goods of another, when they really are not so.

Remedies, action at law, and suit in equity.

The remedies available against such offenders are, an action to recover damages for the loss or prejudice sustained by the person injured in consequence of the offender's fraudulent act; and a suit in Chancery for an injunction to restrain the offender from continuing the fraud.

Action for damages sustained by the fraud.

The form of action for such an injury is trespass on the case, and the plaintiff is entitled to recover nominal damages upon proof of his cause of action, although he does not show

(*g*) See this section of the statute in the Appendix, Chap. I. s. 1.

(*h*) See a Form of Plea of the stat. 31 Eliz. c. 5, s. 5, in the Appendix.

that he has been deprived of any particular amount of profit by means of the defendant's fraud.

Thus, in the case of *Blofield* v. *Payne* (*i*), which was an action on the case against a person for wrapping hones in envelopes resembling those of the plaintiff, it was held by the Court of King's Bench, that although the plaintiff did not prove that he had sustained any actual damage by means of the deceit, and the jury found that the defendant's hones were not inferior to the plaintiff's, yet the plaintiff was entitled to recover nominal damages, for the defendant's act was a fraud against the defendant, and was to some extent an injury to the plaintiff.

Blofield v. Payne.

Plaintiff entitled to recover damages.

Nor does it signify that the spurious articles made or sold by an offender are of as good a quality as those of the person injured, for the purchasers of such spurious articles are induced to purchase by means of false representations or appearances which lead them to believe that the goods are the goods of the injured person, and the offender has no right to avail himself of the good name or reputation of another, or to deprive him of any portion of the profit which his manufacturing or commercial fame may enable him to acquire.

It does not signify that defendant's articles are as good as the plaintiff's.

And therefore in the case of *Blofield* v. *Payne* (*k*), it was held by the Court, that although the jury had found that the defendant's hones were not inferior to those of the plaintiff, the plaintiff was nevertheless entitled to recover damages against the defendant for the fraudulent imitation of the plaintiff's articles.

Blofield v. Payne.

And a person who manufactures goods deceitfully marked, so as to resemble the goods of another person, and for the purpose of being sold to the public by retailers as the goods of another person, is liable to such an action, although he does not himself actually make any misrepresentation respecting the manufacture of the goods.

If goods are deceitfully marked so as to resemble the goods of another, the maker is liable although he does not actually make any misrepresentation.

Thus, in the case of *Sykes* v. *Sykes* (*l*), it appeared that the plaintiff made and sold goods, which he was accustomed to mark with the words "Sykes' patent;" and that the defendant (being of the same name as the plaintiff) made and sold goods to retailers, which he also marked with the words "Sykes'

Sykes v. Sykes.

(*i*) 4 B. & Adol. 410.
(*k*) *Ibid.*
(*l*) 3 B. & C. 541.

patent." The declaration charged the defendant with deceitfully selling goods so marked, as and for goods of the manufacture of the plaintiff. The defendant did not himself represent the goods to be of the plaintiff's manufacture, but he sold them to retailers for the express purpose of being resold as goods of the plaintiff's manufacture. And upon a motion for a new trial, it was held by the Court of King's Bench, that the declaration was substantially proved, and a rule *nisi* for a new trial was refused (*m*).

Suit in Chancery to restrain the continuance of the fraud.

But although a patentee, or other person thus injured can maintain an action at Law against the offender, he can seldom prove the actual extent of the injury which he has sustained, so as to enable a jury to award him any recompence in the shape of damages. Nor can he in a Court of Law obtain any remedy for preventing the continuance of such fraudulent acts. There being, therefore, no adequate remedy at Law for a person thus injured, he is entitled to the extraordinary aid of a Court of Equity, and he may accordingly maintain a suit for an injunction to restrain the offender from committing any repetition of his fraudulent acts.

Ransome v. Bentall.

Thus, in the case of *Ransome* v. *Bentall* (*n*), the plaintiffs had obtained a patent for the manufacture of case-hardened ploughshares, which they were accustomed to mark with the words "Ransome's patent," and with the letters "H. H." to denote the shares being case-hardened, and also with certain numbers, as No. 6, to denote their size. The defendant had marked ploughshares, "Ransome's and Co. H. H. 6," and the plaintiff's bill prayed that the defendant might be restrained from selling ploughshares marked with any of those words, letters, or figures, or any words, letters, or figures, which purported to represent that they were made by the plaintiffs. The defendant admitted that he had used the words "Ransome and Co." under belief, as he stated, that the patent had expired; but he claimed the right of using the letters and figure "H. H. 6." The Vice-Chancellor, however, granted the injunction, and said, "The defendant is, in fact, asking me to sanction the commission of a fraud. If he had been in the habit of marking his ploughs with only "H. H. 6," and

Defendant restrained from using any words, &c. to represent that his goods were made by the plaintiffs.

(*m*) See the cases of *Southerne* v. *Howe*, 2 Rol. R. 26; *Singleton* v. *Bolton*, 3 Doug. 293.

(*n*) 3 Law J. N. S. 161.

if I could see the marks so placed, that no person could be deceived in purchasing the ploughs, then I might refuse the injunction as to that part of the prayer. But here the defendant wants me to decide, *ab ante*, that no possible use of "H. H. 6" may not have the effect of misleading persons; and, therefore, the whole prayer must be granted."

In the case of *Knott* v. *Morgan* (*s*), an injunction was obtained upon an *ex parte* application, restraining the defendant from running or using for the conveyance of passengers his omnibus in the bill mentioned with the names "London Conveyance," or "Original Conveyance Company," thereon or affixed thereto; and also from running or using for the conveyance of passengers any omnibus, &c., having the names "Conveyance Company," "London Conveyance Company," or any colourable imitation of such names thereon or affixed thereto. The bill was filed by four of the proprietors of the London Conveyance Company on behalf of themselves and the other proprietors, who were numerous. It was urged for the defendant, upon a motion to dissolve the injunction: first, that the plaintiffs were the only persons named in their licence, and that pursuant to the stat. 2 & 3 W. IV. c. 120, ss. 9 & 11, the licence ought to have contained the name of every proprietor; and, secondly, that the plaintiffs had no right to appropriate to themselves the title of "London Conveyance Company" or to claim a monopoly in the words "Conveyance Company," &c. Lord *Langdale*, M. R., however refused the motion with costs, and said in giving judgment, "The first question is, whether the plaintiffs are entitled to sue; and I think that, in the absence of any evidence to the contrary, I must presume that the Commissioners of Stamps, in whom the Act of Parliament has vested the power of licensing the proprietors of stage carriages, have granted to the plaintiffs a proper licence, and that the plaintiffs have consequently a right to sue. The only other question is, whether the defendant fraudulently imitated the title and insignia used by the plaintiffs for the purpose of injuring them in their trade; and, upon the affidavits and evidence before me, I have not the least doubt that the defendant did intend to induce the

Knott v. Morgan.

Defendant restrained from using any words, &c. in imitation of those used by the plaintiffs.

(*s*) 2 Keen, 213.

public to believe that the omnibus which he painted and appointed, so as to resemble the carriages of the plaintiffs, was, in fact, an omnibus belonging to the plaintiffs and the other proprietors of the London Conveyance Company. It is not to be said that the plaintiffs have any exclusive right to the words 'Conveyance Company,' 'or 'London Conveyance Company,' or any other words; but they have a right to call upon this Court to restrain the defendant from fraudulently using precisely the same words and devices which they have taken for the purpose of distinguishing their property, and thereby depriving them of the fair profits of their business by attracting custom on the false representation, that carriages, really the defendant's, belong to, and are under the management of the plaintiffs. I am not satisfied that the injunction has been drawn up exactly in the words in which it ought to have been framed. Let the orders dated the 27th day of July last, be varied, therefore, so that the injunction may be awarded to restrain the defendant, Robert Morgan, his servants and agents, from running, or in any manner using, or causing to be used, for the conveyance of passengers, his omnibus in the bill mentioned, or any other omnibus, having painted, stamped, printed, or written thereon the words or names 'London Conveyance,' or 'Original Conveyance Company," or any other names, words, or devices painted, stamped, printed, or written thereon, in such manner as to form, or be a colourable imitation of the names, words, and devices painted, stamped, printed, or written on the omnibuses of the plaintiffs; and let the defendant pay to the plaintiffs their costs of this application."

An appeal motion to discharge this order was afterwards heard before the Lord Chancellor, and discharged with costs.

Section VI.

Of the Remedies for the Crown and the Public, by scire facias, *to repeal void or illegal Patents.*

Patent rarely refused.

Although patents for inventions are not demandable as of right, yet they are in practice rarely refused, the reason being,

as stated in the Attorney-general's report, that the grant is entirely at the risk of the petitioner for the patent.

Attorney-general relies solely on petitioner's statement.

The Attorney-general, or officer who advises the Crown, must in every case in which the grant of a patent is not opposed, rely solely on the statements of the person petitioning for the patent, and no one can be present on behalf of the public to controvert any of the statements he may make in support of his claim for a patent (*u*).

Party opposing can obtain no information except the title.

Even in opposed cases the party opposing can obtain no information respecting the nature of the invention for which a patent is sought, except what he may acquire from the title of the invention inserted in the petition, which we have seen is always couched in the most general and indefinite terms, and quite insufficient to enable any person to understand precisely what the invention really is.

No person allowed to hear the statements of petitioner.

And an opposing party is not allowed to be present to hear the statements of a petitioner in support of his claims for a patent, because the opposing party would thus acquire a knowledge of the invention, and would be enabled to defeat the inventor's claim to a patent; for he might publish it to the world, before the inventor could obtain his patent, and so render the patent absolutely void.

Proceeding to obtain a patent is *ex parte*.

Patents for inventions must always, therefore, be obtained by means of proceedings substantially *ex parte*, and in the absence of any person competent to guard the rights of the public, so far as respects the truth of the representations upon which the patents are obtained.

Crown grants always obtained by petition.

Crown grants are indeed almost always obtained by means of representations made by, or on the behalf of the grantees, and as the sovereign is so much occupied with the affairs of the state, it would be impossible always to ascertain with certainty whether the representations of a petition for a grant by patent were true or not.

Crown specially protected against false petitions.

The law, therefore, takes especial care to protect the Crown against false petitions and representations (*v*). It is accordingly laid down that it is the duty of every one obtaining a grant from the Queen, to see that she is correctly informed respecting the grant (*x*).

If Crown deceived, patent void.

And if it appears that the Queen has been deceived in any material particular, by a false representation or suggestion of the

(*u*) A patent is granted, as of course, if not opposed.

(*v*) See 10 Co. R. 113, b.

(*x*) 1 Co. R. 52, a.

grantee, the patent will be wholly void (*y*). And when facts are recited in a patent respecting the subject-matter of the grant, it will be presumed that the statements contained in the recital were represented or suggested to the Queen by the patentee (*z*).

Particulars respecting the invention stated in petition and recited in the patent.

The material particulars respecting an alleged invention for which a party seeks to obtain a patent, must, as has already been observed (*a*), be stated in the petition for the patent. The petition must therefore state, that the petitioner is the inventor or importer of the invention, and that the invention possesses the qualities of novelty, utility, &c., so as to be the proper subject of a grant by patent (*b*). The substance of the petition for a patent is always recited in the patent itself, and therefore the patent itself shows upon what representations of the patentee it has been granted (*c*); and if the patentee has represented any thing which was untrue in any material particular, or has induced the Crown to make an illegal grant, the patent is entirely void.

Remedy for the public by *scire facias.*

The various objections which can be taken to a patent for an invention, by a person against whom the patentee may institute legal proceedings, have already been considered (*d*); and the law provides a remedy for the public by action of *scire facias*, in which similar objections may be taken, and if any valid objection is sustained, the result is, that the patent is repealed or annulled, and ordered to be cancelled.

Queen may proceed by *scire facias* to cancel a patent.

The Queen has by the Common Law an undoubted right to proceed by *scire facias* to repeal and cancel a patent respecting which she has been deceived, or by which her subjects are prejudiced. This was laid down by the Judges in the House of Lords in the case of *The King* v. *Butler* (*e*), and there are several old authorities to the same effect (*f*). In the *Magdalen College* case (*g*), it was said, that "The law has given the King a great prerogative above any of his subjects, that

R. v. Butler.

Magdalen College case.

(*y*) Vin. Abr. Prerog. (O. b.); and vide Chap. IV. *ante*, p. 39, 42.

(*z*) 5 Co. R. 55, b.; 10 Co. R. 112, a.; and vide Chap IV. *ante*, p. 42.

(*a*) *Ante*, Chap. IV. p. 41.

(*b*) See the Form of Petition in the Appendix.

(*c*) Vide *ante*, Chap. IV. p. 41.

(*d*) Section 2 in this Chapter, *ante*, p. 266.

(*e*) 3 Lev. 220, 221.

(*f*) See Staund. Prerog. 84, a.; Brook, Abr. Pat. 14, Petit. 11, and Sci. Fa; Rol. Abr. Prerog. (S.) p. 191; 21 Ed. III. 47 B. & 10 Co. 113, b.

(*g*) 11 Co. R. 74, b.

where by fraud or false suggestion he is deceived, that he himself in such cases shall avoid his own grant *jure regio.*" And in *Legat's* case (*h*), it was said, that "When upon false insinuations or pretences the King makes any grant, as of any monopoly, &c., which, in truth, is to the prejudice of the King and commonwealth, the King *jure regio* shall avoid such grants, *and such letters patent by judgment of law shall be cancelled.*" Legat's case.

The proceeding for avoiding and cancelling a patent by *scire facias* is taken in the Common Law side of the Court of Chancery, being the Court in which the patent was made. *Scire facias* is in Chancery.

It has already been shown (*i*), that a patent is a record made by the Lord Chancellor, as Judge of the Court of Chancery; and that an enrolment of every patent remains of record in that Court, although the patent itself is always delivered out of Chancery to the grantee. Patent is a record.

In the fourth Institute (*k*), Sir *Edward Coke* says, that in Chancery there are two Courts:—"one ordinary, *coram domino rege in Cancellaria*, wherein the Lord Chancellor or Lord Keeper of the Great Seal proceeds according to the right line of the Laws and Statutes of the Realm, *secundum legum et consuetudinem Angliæ*; another extraordinary, according to the rule of Equity, *secundum æquum et bonum.*" And that of the former, or Common Law Court, the Lord Chancellor or Lord Keeper is the sole Judge; but in cases of difficulty he may call to his assistance any of the Judges of the Common Law Courts (*l*). 4 Inst. c. 8. Lord Chancellor judge of the Common Law Court.

It seems, however, that in all matters of practice the Master of the Rolls, as chief officer of the Court (*m*), may act in the absence of the Lord Chancellor; and it has been the constant practice for the Master of the Rolls to attend to such matters, and to transact all such business of the Court as may be done by a Judge at Chambers. Master of the Rolls decides matters of practice.

In this Common Law Court the Lord Chancellor has power to hold plea of *scire facias* to repeal letters patent under the Great Seal, and to cancel the patent, and also the enrolment Chancellor has power to hold plea of *scire facias* to cancel patents.

(*h*) 10 Co. R. 113, b.
(*i*) *Ante*, Chap. IV. p. 36.
(*k*) P. 79.
(*l*) 4 Inst. 84; and see *Ross* v. *Pope*, Plow. 72.
(*m*) See 4 Inst. 82-97; the Master of the Rolls is also keeper of the records of the Court, see Chap. VIII. s. 3, p. 211.

of it (*n*); and Sir *Edward Coke* says (*o*), "Our Lord Chancellor of England is called *Cancellarius a Cancellando*, i. *à digniori parte*, being the highest point of his jurisdiction to cancel the King's letter patents under the Great Seal, and damning the enrolment thereof by drawing strikes through it like a 'lettice.'"

Jurisdiction to cancel patents is necessarily incident to Chancery.

It seems that this jurisdiction, which the Court of Chancery possesses, is necessarily incident to the office of Chancellor, or to the Great Seal which he holds.

Mayor, &c. of Liverpool v. Chancellor of Lancaster.

Thus, in the case of *The Mayor and Burgesses of Liverpool* v. *the Chancellor of the County Palatine of Lancaster* (*p*), in the Queen's Bench, it appeared that there was a *scire facias* (in the Chancery of Lancaster) to repeal a charter granted to that Corporation, under the Great Seal of the County Palatine. To this suit a prohibition was moved for, for want of jurisdiction in the Court. But it was resolved that that Court had jurisdiction of the cause, and amongst other reasons which were given for that judgment, it was declared that this authority was incident to the Seal of the County Palatine; that the complaint of the writ being that the Chancellor had wrongfully put the Seal to it, it was proper to be examined in that Court where the Seal was kept.

Jurisdiction flows from the Great Seal.

And it is evident that this jurisdiction of the Lord Chancellor's flows from the Great Seal, for the very object of the suit and of the judgment is, that the letters patent be recalled back into the same place from whence they went forth under the Great Seal, that they may be cancelled; that is, that the Great Seal may be taken off (*q*).

The object of the suit is to have the patent restored into Chancery to be cancelled.

This indeed is shown by the form of the writ itself, which commands the sheriff to give notice to the patentee to appear in Chancery, and show why the letters patent and enrolment should not be cancelled, *and the letters patent restored into Chancery, there to be cancelled* (*r*). And the prayer of judgment by the Attorney-general at the end of the declaration is to the same effect (*s*).

Great Seal of Great Britain.

After the Act of Union with Scotland (*t*), the Great Seal became the Great Seal of Great Britain, but that did not

(*n*) 4 Inst. 79-88.
(*o*) 4 Inst. 88.
(*p*) 1 Str. 151.
(*q*) Vide 1 Str. 151-158.
(*r*) Lilly, Entr. 419.
(*s*) See the Form in the Appendix, Chap. II. s. 7.
(*t*) 5 Ann. c. 8, Art. 24.

alter the jurisdiction of the Court of Chancery respecting patents for inventions (*u*).

Great Seal of the United Kingdom.

So after the Union with Ireland, the Great Seal of Great Britain was destroyed, and the Great Seal which has since been used, is the Great Seal of the United Kingdom (*x*). But the jurisdiction of the Court of Chancery respecting patents for inventions is still confined to England, Wales, and the colonies.

4 Inst. c. 7.

In the fourth Institute (*y*), Sir *Edward Coke* says, that a *scire facias* to repeal a patent may be brought in the Queen's Bench, and he cites a case in the Year Books, 3 Hen. IV. fol. 6 (*z*), pl. 29. In that case it appears that a *scire facias* was sued in the King's Bench by one J. Knightly against one L. to repeal a patent, granted by the King to L. who alleged that Knightly had in Chancery sued out another *scire facias* to repeal the same patent which was then pending, and demanded judgment of the writ. But the only point upon which judgment was given, was that the plaintiff might have as many writs of *scire facias* as he pleased, and the reason seems to have been, that the effect of all the writs could only be to repeal the patent. The same case is also stated in Brook's Abridgment (tit. *Briefe*, pl. 104), to the same effect as here given, but with a "*quod quære*," added to it.

Whether a *scire facias* may be brought in the Queen's Bench, *quære?*

21 Ed. III. f. 47.

In the Year Book, 21 Ed. III. fol. 47, pl. 68, there is an authority, however, to the effect that a *scire facias* to repeal a patent *can only be in Chancery*, and this case is stated as law by Brook in his Abridgment (*a*).

Scire facias can only be in Chancery.

Scire facias cannot issue out of Queen's Bench.

It seems to be clear indeed that such a *scire facias* could not issue out of the Court of Queen's Bench, for the writ must be founded upon some matter of record, and that Court has no enrolment of the patent or other record upon which the writ could be founded. Thus, in Jenkins's Reports (*b*), it is laid down that the King's Bench cannot award a *scire facias* against a patentee, for that Court has not the record.

R. v. Butler.

In the case of *The King* v. *Butler* (*c*), upon a demurrer to a *scire facias* to repeal a patent, the Lord Chancellor gave judgment for the Crown to repeal the patent, and a writ of

Scire facias founded on a record in Chancery.

(*u*) *R.* v. *Hare*, 1 Str. 146-158.
(*x*) See the cases of *R.* v. *Bullock*, 1 Taunt. 71; and *R.* v. *Yandall*, 4 T. R. 521.
(*y*) P. 72.
(*z*) Misprinted, fol. 7.
(*a*) Title, Petit. pl. 11.
(*b*) P. 134—3rd Century, case 74.
(*c*) 3 Lev. 220-223.

error was brought in the House of Lords to reverse the judgment. In answer to an objection taken to the writ, it was conceded that a *scire facias* ought to be founded on a record; but it was resolved by the Judges, that the writ in that case was founded on a record, for the patent was enrolled in the Court of Chancery.

The record is the enrolment of the patent.

It has already been stated (*d*), that every patent is enrolled in the Court of Chancery, and the enrolment is the record upon which the writ of *scire facias* issues. This is shown indeed by the form of the writ itself, which, after stating the patent, always concludes with these or similar words, "As by the said letters patent enrolled before us in Chancery is more fully manifest and appears" (*e*).

Scire facias may, in some cases, be made returnable in the Queen's Bench.

Although a *scire facias* must therefore issue out of Chancery, yet it seems that it may in some cases be made returnable in the Queen's Bench.

Thus, in the case in Jenkins just cited (*f*), it appears that an office found for the King for certain land was traversed in Chancery, the land being first granted over by the King by patent; issue was joined in Chancery, and that issue sent into the Queen's Bench to be tried. And it was resolved, that, notwithstanding the transcript of the record had been sent into the Queen's Bench, a *scire facias* might be awarded out of Chancery returnable in the King's Bench.

Such a *scire facias* only ancillary to another suit.

In this case it will be observed, that the *scire facias* was necessary to warn the patentee, and to enable the King's Bench to determine the right to the land; it became necessary incidentally to determine a question respecting the validity of the patent, but the writ was merely ancillary to another suit, and the object of it could not be to *cancel* the patent, although the effect of the suit might be to declare the patent to be void.

Brewster *v.* Weld.

In the case of *Brewster* v. *Weld* (*g*), a *scire facias* was sued out of Chancery, returnable in the Queen's Bench, to repeal letters patent of the Rectory of Aldgate; but it seems, from the report of the case, that the Court of Queen's Bench doubted whether the writ being founded upon a record of the Court of Chancery was returnable in the Queen's Bench, but

Court of Queen's Bench doubted whether a *scire facias* to repeal a patent could be returnable in that Court.

(*d*) *Ante*, Chap. IV. p. 38.
(*e*) Lilly, Entr. 411-415; and see the Form in the Appendix, Chap. II. s. 7.
(*f*) P. 134, pl. 74.
(*g*) 6 Mod. 229.

the point was not decided. That Court, however, compelled the Sheriff to return the writ, although it was alleged that the Court of Chancery had superseded it, and the writ was returned accordingly.

It is not stated upon what ground the plaintiff sued out the *scire facias*, but it is to be inferred that it was because the patent was to his prejudice in some way; for it is stated, that "it was resolved that if letters patent be to the prejudice of another, he may have a *scire facias* upon the enrolment thereof in Chancery to have them repealed as well as the Queen may" (*h*).

Scire facias to cancel a patent must be in Chancery.

It will be found, however, upon a careful consideration of all the reported cases of *scire facias*, that although the Court of Queen's Bench may hold plea in some cases where the validity of letters patent come in question; yet, where an action of *scire facias* is brought, not only to repeal the grant, but also to cancel the patent and the enrolment of it, (and this is always so in a *scire facias* to repeal a patent for the sole use of an invention,) then the action must be in Chancery, for the Court of Queen's Bench has no power to cancel the records of the Court of Chancery.

Queen's Bench no power to cancel Chancery records.

Chancery Common Law actions are in Petty Bag office.

The office called "the Petty Bag" is the office of the Court of Chancery, in which all the Common Law proceedings of the Court are carried on; and all pleadings and other Common Law proceedings are intituled "In the Petty Bag Office in Chancery." The legal proceedings of this Court, as stated by Sir *Edward Coke* (*i*), "remain *in filaciis*, being filed up in the office of the Petty Bag." And it appears from the same authority (*k*), that "the process in this Court is under the Great Seal, according to the course of the Common Law."

Master of the Rolls principal officer.

The principal officer of this branch of the Court is the Master of the Rolls, under whom are the Clerks of the Petty Bag, who have the exclusive privilege of acting as the attornies of the suitors of the Court.

Clerks of Petty Bag the only attornies.

The business was formerly carried on by the Clerks of the Petty Bag, in the names of the Six Clerks, but they are now enabled to conduct the proceedings in their own names.

(*h*) There does not appear to have been any further proceedings taken in this case, at least no further report of it appears in any of our books of reports.

(*i*) 4 Inst. 80.

(*k*) *Ibid.* 82.

Stat. 5 & 6 Vict. c. 103, s. 1. Clerks of Petty Bag to be nominal attornies.

By the statute 5 & 6 Vict. c. 103, s. 1, the offices of the Six Clerks were abolished; but it is by section 3, of the same Act, provided that the clerks in the Petty Bag shall be nominal attornies in all causes in the Petty Bag in which Six Clerks might have been such attornies if that Act had not passed; and that the entry of any clerk of the Petty Bag of rules in causes in the Petty Bag, shall have all the effect such entry could have had if that Act had not passed, and a similar entry had been made by a Six Clerk.

Scire facias issues out of Petty Bag office.

It is out of this office that the writ of *scire facias* issues, and in this office all the proceedings in the action must be taken, until the record is carried into the Court of Queen's Bench, for the purpose of a trial, and that is only done when there are issues in fact to be tried by a jury.

Scire facias lies in three cases.

It is laid down in the fourth Institute (*l*), that a *scire facias* lies to repeal letters patent in three cases:—"*firstly*, When the King by his letters patent doth grant by several letters patent one and the self-same thing to several persons, the former patentee shall have a *scire facias* to repeal second patent; *secondly*, When the King granteth any thing that is grantable upon a false suggestion, the King by his prerogative *jure regio* may have a *scire facias* to repeal his own grant; *thirdly*, When the King doth grant any thing which by law he cannot grant, he *jure regio* (for the advancement of justice and right) may have a *scire facias* to repeal his own letters patents."

Scire facias is a remedy both for the Crown and the public.

The action of *scire facias* is a remedy provided by the law not only for the Crown on behalf of the public, but also for any of her Majesty's subjects who can show that a void or illegal patent operates to his prejudice.

Butler's Case.

Thus, in *Sir Oliver Butler's* case (*m*), Lord Chancellor *Finch* (who was assisted by two of the Judges) said, that "Where a patent is granted to the prejudice of the subject, the King of right is to permit him, upon his petition, to use his name for the repeal of it, in a *scire facias* at the King's suit, and to hinder multiplicity of actions upon the case, for such action will lie notwithstanding such void patent" (*n*). So, in

The Queen is of right to permit a subject to sue by *scire facias*.

(*l*) 4 Inst. 88.
(*m*) 2 Ventr. 344.
(*n*) That means that the patentee may proceed by action upon the patent, and put the defendant to the cost and vexation of having to plead and prove the invalidity of it.

the Court of Queen's Bench, in the case of *The Queen* v. *Acres* (*o*), it was also said, that the Crown *de jure* ought to permit subjects in such cases to sue in the name of the Queen (*p*).

Illegal patent prejudicial to every one.

A void or illegal patent for an invention is actually in law prejudicial to every one of her Majesty's subjects, for it commands them to abstain from the use of the art or invention comprised in it; and indeed, as we have already shown (*q*), a patent for an invention deprives every person (except the patentee) of the right or liberty which he had before of inventing and using the particular art which is made the subject of the patent grant. For this reason every person is presumed to have such an interest in a patent for an invention, that if he alleges that it is illegal or void, he is entitled as of right to a *scire facias* in the name of the Queen in order to repeal it.

Action commenced by an original writ of *scire facias*.

The action is commenced by a writ called a *scire facias*, from two Latin words used in the writ in former times, when our legal proceedings were written in that language; and the action derives its name from the same source. The writ is an original writ (*r*), founded upon the record or enrolment of the patent, and matters suggested to the Court as a ground for repealing the patent (*s*).

No petition for writ necessary.

It was formerly the practice to present a petition to the Crown, praying for leave to sue out a *scire facias* to repeal a patent containing a grant of land, or of a market, or any similar grant; but that practice never prevailed with respect to actions of *scire facias* to repeal patents for inventions (*t*).

Statement of facts must be furnished.

In order to sue out a *scire facias*, the prosecutor's solicitor must prepare a short statement of facts containing the date of the patent, the title of the invention, the prosecutor's name and address, and mentioning whether the validity of the patent has been tried, and the result of any proceedings which may have been taken. This statement must be delivered to the clerk of the Petty Bag (*u*).

(*o*) 10 Mod. 354.

(*p*) See also 1 P. Williams, 217; Vin. Abr. Prerog. (M. b, 9) pl. 10, (U. b) pl. 8, and the authorities there cited.

(*q*) *Ante*, Chap. II. pp. 11 and 12.

(*r*) 1 Str. 43.

(*s*) Bro. Ab. Sci. Fa. pl. 8.

(*t*) The late Mr. Abbott (who was upwards of fifty years in the Petty Bag Office, and during forty-eight years acted as the officer of the Court,) informed the writer that he had never known any petition presented in a *scire facias* to repeal a patent, and that according to the practice of the Court no petition was necessary.

(*u*) See a Form in the Appendix, Chap. II. s. 7.

Copy enrolment of patent must be procured.

The prosecutor's solicitor ought also to procure a copy of the enrolment of the patent, to repeal which the *scire facias* is to be brought, to enable the clerk of the Petty Bag to set it out correctly in the writ; and it is always best to procure an office copy of the enrolment.

Duty of clerk to draw the writ.

It is the duty of the clerk of the Petty Bag, who acts for the prosecution, to draw and prepare the writ of *scire facias*, for which he is entitled to be paid as the prosecutor's attorney in the action (*x*).

Generally drawn by counsel.

It very frequently happens, however, that nice and difficult questions are intended to be raised by the suggestions in the writ, and therefore it has become a common practice for the prosecutor's solicitor to get a draught of the intended writ drawn or settled by counsel, and take it to the Petty Bag Office as instructions for the writ. If that course is not adopted, the prosecutor's solicitor must prepare a statement in writing of the several grounds upon which he seeks to repeal the patent, and deliver the statement to the clerk of the Petty Bag, as his instructions for the preparation of the writ.

Draught writ and statement submitted to Attorney-general.

When the draught writ has been prepared, a fair copy of it is laid before the Attorney-general, by the clerk of the Petty Bag, together with the statement of facts already mentioned, in order to obtain his *fiat*, which is necessary to authorize the issuing of the writ.

Fiat.

The *fiat* is indorsed upon the back of the copy of the writ, and is always obtained as a matter of course. This *fiat* gives the requisite permission for the prosecutor to sue in the name of the Queen to revoke and cancel the patent, but it is only granted upon condition that the prosecutor gives security by bond to the chief clerk of the Petty Bag.

Bond.

Reason for requiring security.

The reason for requiring this security is, that patentees may not be vexatiously harassed by actions of *scire facias*, in which they could not recover costs against the prosecutor, and the condition of the bond is, that if the defendant obtains a verdict and judgment in the action, the prosecutor shall pay him the amount of his costs taxed as between attorney and client.

(*x*) The whole of the business of the office is however transacted by a gentleman (Mr. Abbott), who acts as the deputy of each of the three clerks. The business is however nominally distributed amongst the clerks of the Petty Bag, according to an old rule of practice; and the clerks divide amongst them the profits which arise from their *nominally* acting as attornies for parties in the Court, according to the same rule.

This security was first required to be given by Sir *Archibald Macdonald* (*y*), when he was Attorney-general about the year 1790, the amount of the bond then required being 500*l.* But since the year 1836, when Sir *John* (now Lord) *Campbell* was Attorney-general, the amount has been 1000*l.* in ordinary cases. The amount of the bond in other cases is entirely discretionary in the Attorney-general, who will, in extraordinary cases, order security to be given to a sufficient amount to cover the probable extent of defendant's costs in defending the action.

When security first required.

The bond is prepared by the clerk of the Petty Bag, and must be entered into by the prosecutor with two sufficient sureties according to the amount required (*z*).

Two sureties required.

The clerk of the Petty Bag will furnish the prosecutor's solicitor with a copy of the intended bond for perusal, in order that he may introduce the names of the prosecutor's sureties; which being done, the copy must be returned into the office of the Petty Bag to have the bond engrossed.

The prosecutor's solicitor is required to certify that the proposed sureties are sufficient for the amount of the intended bond. The object of this is, that the solicitor may be rendered responsible for the sufficiency of the sureties which he proposes, and there can be no doubt that *knowingly* misrepresenting the sufficiency of sureties would be deemed a contempt of the Court.

Prosecutor's solicitor must certify that sureties are sufficient.

In town cases the bond is required to be executed in the presence of one of the clerks at the office of the Petty Bag, for which purpose the prosecutor and his sureties usually attend at the office. But one of the clerks will be sent to witness the execution of the bond by any person in London who cannot conveniently attend at the office, for which a small fee is payable. The execution of the bond in country cases, or in town cases by any party who resides in the country, must be attested by a Master extraordinary in Chancery.

Bond to be executed at Petty Bag Office, or before a Master extraordinary.

The person to be made defendant in an action of *scire facias*, to cancel a patent, ought to be he who is entitled to the privilege granted by the patent, and therefore is interested in

Who ought to be made defendant.

(*y*) Afterwards Lord Chief Baron.

(*z*) See the Form of Bond in the Appendix, Chap. II. s. 7.

the continuation or destruction of it; and who having the custody of the patent itself, may be compelled to restore it into Chancery to be cancelled, if the Court gives judgment for the Crown.

Patentee. The patentee must be made defendant in the action, if he has not parted with the whole of his interest in the patent by assignment, bankruptcy, or otherwise. If the patentee has assigned a part of his patent right, the assignee ought to be made defendant jointly with the patentee.

When patent has been assigned. When the patentee has assigned the whole of his patent privilege, the assignee should be made defendant; but if the prosecutor does not possess certain knowledge respecting the assignment, it will be better to make the patentee and assignee joint defendants in the action, leaving the patentee to plead the assignment in abatement, or in bar of the further prosecution of the suit against him.

When patentee has died, become bankrupt, &c. If a patentee or assignee, possessed of a patent privilege or of any part of it, dies, or becomes bankrupt, or insolvent, his executors, administrators, or assignees, must be made defendants, for his interest in the privilege would vest in them by operation of law (*z*). And if a *scire facias* were to be issued against a deceased patentee, it would seem that a judgment in such an action would be erroneous, for there would be no person who could be summoned, or who could answer the suggestions contained in the writ, and the parties actually entitled to the patent privilege might have a good defence to the action. So, it is conceived, that if a *scire facias* were to be sued out against a patentee *after* he has parted with the whole of his interest, a judgment in the action could not be allowed to prevail against the party actually entitled to the patent privilege.

First writ into Middlesex. The first writ of *scire facias* is always directed to the sheriff of Middlesex, because the record upon which the writ is founded remains at Westminster, in that county.

Form of the writ. The writ states the effect of the patent more or less fully, according to circumstances, and then refers to the enrolment of the patent in verification of the statement. The writ then proceeds to set out the suggestions upon which the prosecutor seeks to repeal the patent, commencing with the words—

Suggestion. "Whereas we are given to understand that, &c."

(*z*) Vide *ante*, Chap. IX. s. 2, p. 237.

And in the case of *The King* v. *Butler* (*a*), in the House of Lords, it was resolved by the Judges, that an allegation in a *scire facias* commencing with these words was sufficient to put the defendant to answer the allegation. R. v. Butler.

The first suggestion in a *scire facias* is usually—"That our said grant was and is contrary to law, and was and is prejudicial and inconvenient to our subjects in general." But the suggestion is useless in this form, because too general.

And in the case of *The King* v. *Arwkright* (*b*), Mr. Justice *Buller* would not allow evidence to be given under an issue taken upon this suggestion.

Suggestions which may be introduced.

The prosecutor is at liberty to introduce into the writ any suggestions which show that the patent was originally void, or that it has become void since it was made. The objections which may thus be suggested in a *scire facias* to repeal a patent are substantially the same as the objections which may be raised by pleas in an action for infringing the patent, and which have already been stated (*c*).

Allegation that patent void.

The suggestions contained in the writ are followed by an allegation stating the effect of the various matters contained in the suggestions in these words—"By reason and means of which said several premises the said letters patent, so, as aforesaid, granted to the said *A. B.* are and ought to be void, and of no force or effect in law."

Command to summon defendant.

The writ then proceeds to recite, that the Queen being willing that what is just should be done, commands the sheriff to summon the defendant to appear in Chancery on a certain day to show if he has any thing to say why the patent and the enrolment of it should not for the reason stated in the writ be cancelled and vacated, and the letters patent restored into Chancery there to be cancelled.

Teste. Return.

This writ must be tested in the name of the sovereign on some day in term, and must be made returnable in term. There ought to be fifteen days at least between the teste and return of the writ.

Chancery being moveable, writ is returnable wheresoever it shall be.

Although the public sittings of the Court of Chancery are always held within the city of Westminster, and almost all the offices of the Court are within that city; yet the Court is

(*a*) 3 Lev. R. 222.
(*b*) Dav. P. C. 79.
(*c*) *Ante*, sec. 2, p. 266, in this Chapter.

in fact a moveable Court, that is, a Court which may be held any where in England. For this reason a *scire facias* and all other writs to be returned into Chancery, are, in point of form, made returnable in Chancery, wheresoever it shall be, on the return day.

R. v. Hare. *Scire facias* returnable wheresoever Chancery shall be, is good.

In the case of *The King* v. *Hare* (*d*), a *scire facias* was made returnable before the King in Chancery, on a day named, wheresoever it (the Chancery) should then be. The defendants pleaded in abatement to the writ, and objected that it ought to have been made returnable wheresoever the Chancery should then be in *England*. It was alleged that the Great Seal, after the union with Scotland, became the Great Seal of Great Britain; that the words wheresoever it shall then be, meant wheresoever the Chancery shall then be in Great Britain, and that if the Lord Chancellor should have the Great Seal in Scotland at the return of the writ, the Chancery would be then in Scotland, and that as no English subject would be compelled to appear to answer process at any place out of England, the writ was void. It was shown, however, that the form of the writ was warranted by the Register and numerous precedents, and the Lord Chancellor *Parker*, assisted by Sir *Joseph Jekyll*, Master of the Rolls, held that the writ was good.

But when the writ was made returnable wheresoever the Chancery should be in *Great Britain*, it was held that it was bad, and it was for that reason abated (*e*).

Seal.

The writ must be sealed with the Great Seal, for which purpose it will be taken by a clerk in the Petty Bag Office to the Great Seal. General Seal days in term time are every Tuesday, Thursday, and Saturday, and the first and last days of term; and in vacation, four days appointed for that purpose by the Lord Chancellor.

Fees.

The writ is usually sealed on one of these General Seal days, when the fee is sixpence only. But if expedition is necessary, a Special Seal may be obtained at any time, the cost of which will be 3*l.* 1*s.* This is generally called an opening Seal, on account of a fee being paid for opening the Seal

(*d*) 1 Str. 146.

(*e*) Vide the judgment of the Lord Chancellor in *R.* v. *Hare*, 1 Str. 158; and *Sir C. Moore's* case, cited 1 Str. 153.

for the particular occasion. The writ may also be sealed at a private Seal, that is, the writ may be left at the Great Seal to be sealed before the next General Seal, if the Great Seal should happen to be opened for any other purpose. The cost of this last Seal is nine shillings.

When the writ has been sealed, and the proper bond given, the former will be delivered by the clerk of the Petty Bag to the prosecutor's solicitor, by whom it must be taken to the sheriff to be executed.

Return of *nihil.*

When the defendant does not reside in the county of Middlesex, it is only necessary to get the writ returned *nihil*, which the sheriff will do as of course upon application at his office.

Execution of the writ.

But if the writ is to be executed in Middlesex, the prosecutor's solicitor should deliver a copy of the writ to the sheriff, along with the original, and the sheriff will make out his warrant to two of his officers (*f*), who will summon the defendant.

Defendant how summoned.

The defendant may be summoned anywhere within the county, (whether he resides or has a place of business within it or not,) by delivering to him a copy of the writ and summons. And if he resides or has a place of business in the county, he may be summoned by leaving the copy writ and summons at his dwelling-house or place of business, for personal service is not necessary.

Return of *scire feci.*

When the defendant has been summoned, the sheriff will return the writ accordingly (*g*).

Second writ, *alias*, or *testatum.*

Upon a return of *nihil* the prosecutor will be entitled to sue out a second *scire facias*, which may be either an *alias*, or a *testatum*, according to circumstances. If the defendant cannot be summoned in England, the second writ will be an *alias*, and like the first writ directed to the sheriff of Middlesex.

If the defendant can be summoned in any other county in England besides Middlesex, the second writ *may* be a *testatum*, directed to the sheriff of the county in which the defendant resides (*h*). Although it is the usual and proper course to sue out a *testatum* in such a case, it seems that the prosecutor is not bound to do so, but may have an *alias* into Middlesex,

(*f*) See the Form in the Appendix, Chap. II. s. 7.

(*g*) See the Form in the Appendix, Chap. II. s. 7.

(*h*) See the Form of the Writ in the Appendix, Chap. II. s. 7.

even when the defendant is known to reside or could be summoned elsewhere in England.

Not necessary that defendant should be summoned.

It is not necessary that the defendant should be actually summoned upon either of the writs in order to enable the prosecutor to proceed, for if the defendant does not appear upon a second return of *nihil*, and within eight days after the entry of the usual rule to answer, judgment may be signed against him by default (*i*). But in order to enable the prosecutor to sign judgment by default, the first writ must be lodged in the sheriff's office, two days at least before the return day, and the second writ must lie four clear days in the sheriff's office, exclusive of the day of lodging it, the day of the return, and any intervening Sunday.

If the defendant in such a case could show that he had no notice of the proceedings, a judgment by default would most probably be set aside, and the defendant let in to plead and defend the action.

Notice to defendant if not summoned.

Therefore, if the defendant should not be summoned upon either of the writs, it would be prudent for the prosecutor to endeavour to give the defendant notice of the writ before he proceeds to sign judgment, and if the defendant were to neglect to enter an appearance and plead within a reasonable time after notice of the proceedings, the Court would not be inclined to render him any assistance.

Rule to return the writ.

If the sheriff should neglect to make a return to a writ of *scire facias*, he may be compelled by a rule of the Court to do so, and the rule may be had upon application at the office of the Petty Bag.

Rule to answer.

Upon the return of the sheriff to the first or second writ that the defendant has been summoned, or to the second writ *nihil*, the prosecutor may enter a rule for the defendant to answer the matters in the writ, for the writ is in the nature of a declaration (*k*), and if the rule be entered on any rule day except the last day of term the defendant must appear and answer within eight days, or in default the Crown will be entitled to judgment. The eight days are to be reckoned exclusive of the day of entering the rule, and exclusive of the last day, if it be a Sunday. If the rule is entered on the last

Defendant must appear and answer within eight days.

(*i*) *R.* v. *Eston*, Dyer, 198, a.

(*k*) Vide *Vaughan* v. *Floid*, 1 Sid. 406.

day of term, the defendant must appear and answer within the first four days of the following term.

In the Petty Bag rules can only be entered in term time, and only on certain days in the term, called rule days. According to the practice of the Court, the second day of the term, the same day in every subsequent week in the term, and the last day of the term, are the days for entering rules. Rule days in the Petty Bag Office.

The effect of a judgment by default will be to avoid the patent (*l*). Thus, in the case of *The King* v. *Toly* (*m*), the defendant having been summoned, made default, and judgment was given, that the letters patent and enrolment should be vacated, and it was done accordingly. Effect of judgment by default.

Judgment was signed in the same manner in the case of *The King* v. *Blage* (*n*), after the defendant had been returned as summoned and made default.

In order to appear, the defendant's solicitor must instruct the clerk of the office of the Petty Bag to enter an appearance for him, which he will accordingly do in the name of one of the clerks of the Petty Bag (*o*), (according to a rotation established by the practice of the Court,) and the clerk in whose name the appearance is entered will be the defendant's nominal attorney throughout the action, so far as relates to the proceedings in the Court of Chancery, and will accordingly be entitled to all the fees. Although the clerks of the Petty Bag are, amongst them, entitled to all the emoluments arising from their offices as the nominal attornies of parties in actions there, they never personally interfere in the business of the office, the whole of which is transacted by a deputy (*p*) and his assistants. Appearance.

The defendant ought to appear immediately after the return of the writ, for the rule to answer only allows him eight days both to appear and answer; and if the prosecutor is ready with his declaration, the defendant obtains no more time by delaying to enter his appearance. But by delaying to Defendant ought to appear immediately after the return of the writ.

(*l*) H. T. 4 Hen. VI. 12, B.; Bro. pat. pl. 20; Sci. fa. pl. 131, 138.

(*m*) Dy. 197, b.

(*n*) *Ibid.*

(*o*) The present clerks are: John Benthall, Esq., Senior clerk; Thomas Hall Plumer, Esq., Second clerk; and Lancelot Baugh Allen, Esq., Junior clerk.

(*p*) Mr. Abbott, a most efficient and obliging officer, who is thoroughly conversant with the practice of the Court; and to whom the author is under great obligations for much valuable information respecting the practice of the Court.

enter his appearance, the defendant may be prejudiced, for he cannot obtain an office copy of the declaration until he has appeared; and if he does not appear soon after the entry of the rule, he will not be able to obtain an office copy of the declaration until the time has nearly expired.

Declaration when necessary.

A declaration only becomes necessary when the defendant appears to defend the action, and then it is to be prepared and filed by the clerk of the Petty Bag. The prosecutor is at liberty to declare immediately after the defendant has appeared; and it is always advisable to have the declaration and notice of objections ready to file immediately the appearance is entered, in order to prevent delay, for if the declaration is not filed on the same day that the defendant enters his appearance, the defendant will be entitled to eight days to plead after the filing of the declaration.

Declaration when to be filed.

The declaration may be filed at any time after the entry of the rule to answer, and after the defendant has actually appeared; whether it be in the term in which the rule is entered, or in the following vacation. But a declaration cannot be filed in vacation, whether the defendant has appeared or not, unless a rule to answer has been entered—and that can only be done in term time. The new pleading rules of H. T. 4 Will. IV. 1834 (*q*), do not affect the practice of the Court in this respect, for they do not apply to actions at the suit of the Crown, nor, it seems, to actions pending in the Court of Chancery.

Title.

The declaration must be intituled of the term in which it is filed, or if it be filed in vacation, then as of the preceding term.

Form of declaration.

The declaration (*r*) sets out the writ of *scire facias* upon which the defendant has been summoned, or if the defendant has not been summoned, then the *alias* or *testatum* writ, the return of the sheriff, the appearance of the defendant; and then concludes with a prayer of judgment by the Attorney-general, that the patent and enrolment may be cancelled, vacated, and disallowed, and the patent restored into Chancery there to be cancelled.

No rule to plead necessary.

No rule to plead becomes necessary upon filing the declaration, for the defendant answers upon the writ, and the rule to

(*q*) Charn. N. R. 125.
(*r*) See the Form in the Appendix, Chap. II. s. 7.

answer is the only rule which is necessary for compelling the defendant to plead.

The prosecutor must also, in pursuance of the statute 5 & 6 Will. IV. c. 83, s. 5 (*s*), file with the declaration a notice of the objections on which he means to rely at the trial of the action. The notice (*t*) will be substantially the same as a notice given by a defendant in an action for the infringement of a patent, the form and requisites of which have already been considered (*u*). In order to do this, the prosecutor's solicitor procures a draught of the notice to be settled by counsel, and takes a copy of it to the Petty Bag Office, where a fair copy will be prepared by the officer, and filed with the declaration. Notice of objections.

The Court of Chancery has the same jurisdiction over this notice as the other superior Courts have over notices of objections delivered in actions for infringements of patents pending before them. And if the notice filed by the prosecutor is insufficient, the Master of the Rolls will, upon the application of the defendant, order the prosecutor to amend his notice, or file a further and better notice. If notice insufficient, Master of the Rolls will order a further notice.

An office copy of the declaration and notice of objections is made at the Petty Bag Office for the defendant's solicitor in order to enable him to prepare instructions for the pleas, and his client's defence to the action. Office copies furnished to defendant.

The defendant is, according to the practice of the Court, allowed eight days to plead after the entry of a rule to answer, which is entered on any rule day except the last day of the term, and if entered on the last day of the term, then he need not plead until the fourth day of the following term. Time for pleading.

But although a rule calls upon the defendant to answer or plead within eight days, he cannot be compelled to plead within that time after entry of the rule, unless the declaration is filed on the same day that he enters his appearance. If the declaration is filed on any day subsequent to the day on which the defendant appears, he has eight days to plead after the filing of the declaration, within which time he must plead without any fresh rule being entered. If the rule orders If declaration not filed on the day of appearance, defendant has eight days to plead after it is filed.

(*s*) See the Act in the Appendix, Chap. I. s. 1.

(*t*) See the Form of the Notice in the Appendix, Chap. II. s. 7.

(*u*) *Ante*, s. 2, p. 284.

the defendant to answer within the first four days of the following term, he need not plead within that time unless the declaration has been filed at least eight days before the fourth day of the term. And if the declaration is not filed in due time, the defendant is allowed eight days to plead after the filing of it.

Judgment by default.

If the defendant fails to plead before the closing of the office on the last day of his time to plead, judgment may be signed against him by default on the opening of the office on the following morning.

Further time to plead.

The defendant may, if necessary, obtain further time to plead by application to the Master of the Rolls. The secretary of the Master of the Rolls will, for this purpose, grant the defendant's solicitor a summons calling upon the prosecutor or his solicitor to show cause why the defendant should not have further time to plead, and on the hearing of the summons, his Lordship will grant further time if he thinks it necessary, but not so as to delay the prosecutor in going to trial. And if the additional time required by the defendant will prevent the plaintiff from giving the usual notice of trial, the defendant will be laid under terms to accept of short notice of trial, or such notice of trial as the prosecutor can give.

In a case (*x*), in which the defendant had previously obtained an order for time to plead, Lord *Langdale*, Master of the Rolls, laid the defendant under terms to plead issuably. But in the first order for time, his Lordship refused to impose any terms. There is no certain rule, however, on the subject, and his Lordship will in every instance exercise his discretion according to the particular circumstances of the case.

M. R. no jurisdiction to strike out any of the suggestions.

The defendant must plead or demur to all the suggestions contained in the writ, and within the time allowed by the practice of the Court, or the order of the Master of the Rolls. And the Master of the Rolls has no jurisdiction to strike out any of the suggestions contained in the declaration (*y*), for the declaration would then vary from the writ, the tenor of which it purports to set out. Nor can the Master of the Rolls order a *nolle prosequi* to be entered as to any of the suggestions (*y*).

Attorney-general may

But the Attorney-general has power to control the pro-

(*x*) *R.* v. *Nickels*, MS.

(*y*) *R.* v. *Newall*, MS.

secutor's proceedings in the action, and he may at any time interfere and enter a *nolle prosequi* as to the whole or any part of the suggestions contained in the writ, subject of course to an application to the Lord Chancellor, who would have jurisdiction to order a *nolle prosequi* to be struck out in the same way as the other Courts of Law may set aside a plea of a release of a *chose in action* executed by a nominal plaintiff after he has assigned it over for a valuable consideration. If the prosecutor should insert any suggestion upon which the defendant could not take any material issue either in law or in fact, the Attorney General will direct a *nolle prosequi* as to so much of the writ.

enter a *nolle prosequi.*

And if the prosecutor should be desirous of getting rid of any of the suggestions in the writ, he may do so by *nolle prosequi*, at the time of declaring, or at any time afterwards (*z*).

Prosecutor may enter a *nolle prosequi.*

If the defendant does not plead to the declaration in due time, judgment by *nil dicit* may be signed against him, and the patent will be repealed.

Judgment by *nil dicit.*

Thus, in the case of *Hunt* v. *Coffin* (*a*), judgment by *nil dicit* was given against the defendant by Cardinal *Wolsey*, Lord Chancellor, assisted by the Judges, that the patent should be revoked (*b*).

Hunt v. Coffin.

If the matters alleged in the writ are not sufficient to repeal the patent, the defendant may demur to the whole writ and declaration (*c*). But if only part of the suggestions are insufficient, the defendant must not demur to the whole writ, but to those suggestions only which are insufficient, and plead to the others (*d*). The demurrer alleges that the matters contained in the writ, or some particular suggestions, are insufficient in law to cause the patent to be cancelled or vacated, and the prosecutor may join in demurrer, alleging that the matters are good and sufficient to cause the patent to be cancelled and vacated (*e*).

Demurrer.

The defendant may either plead in abatement (*f*), or in bar

Defendant may plead in

(*z*) See the forms in the Appendix, Chap. II. s. 7.

(*a*) Dy. 197, b.

(*b*) See also 37 Hen. VI. 14 A.; Bro. Abr. tit. Sci. Fa. pl. 131-138.

(*c*) See the Form in the Appendix, Chap. II. s. 7.

(*d*) See the Form of Demurrer to a Suggestion in the Appendix, Chap. II. s. 7.

(*e*) See the case of *R.* v. *Butler*, 3 Lev. 220, and the Forms in the Appendix, Chap. II. s. 7.

(*f*) See *R.* v. *Hare*, 1 Str. 146, in which the defendant pleaded in abatement.

abatement or in bar.

to the declaration (*g*). But if a *scire facias* has sufficient matter it will not abate for surplusage not material (*h*).

Patentee who has assigned, ought not to be compelled to answer.

If a patentee has assigned the whole of his interest in the patent before the commencement of the action, there seems to be no reason why he should be compelled to answer the suggestions contained in the writ. For he has no interest in the privilege, and ought not, therefore, to be compelled to defend the grant made by the patent; nor will he be able to deliver up the patent to be cancelled if judgment be given against him.

Assignment pleadable in abatement or in bar.

The assignments of patents, however, are not registered either in Chancery or elsewhere, and therefore a prosecutor will presume, *primâ facie*, (unless he has certain information to the contrary,) that the patentee continues to be possessed of the patent right, and issue the writ against him accordingly. But it seems to be reasonable that the patentee should in such a case be allowed to disclaim all interest in the patent, and to plead the assignment either in abatement or in bar of all further proceedings against him. There is no reported case in which such a plea has been decided to be good in a *scire facias* to repeal a patent; but there are authorities which in principle seem to warrant what has been stated (*i*). Thus, in a real action (*k*), the object of which was to recover land, the defendant might plead *non-tenure* generally in abatement (*l*). The defendant in such a plea alleged that he was not tenant of the land at the time of suing out the writ, and it was unnecessary for him to show who was tenant (*m*).

The proper form of plea for a patentee to adopt in such a case seems to be a plea alleging that the defendant by a deed made between himself and the assignee, before the commencement of the suit assigned the patent privilege to the assignee, and delivered to him the patent, and that he the defendant has ceased to have any interest in the patent privilege, or any control over the patent (*n*).

Reason why patentee sued.

A *scire facias* to repeal and cancel a patent is sued out

(*g*) See Tidd's Practice (9th Edit.) c. xliii. p. 1095.

(*h*) 8 Co. R. 26, b.

(*i*) Vide Co. Ent. 624; Vin. Abr. Abat. (O).

(*k*) Real actions have been abolished.

(*l*) Lutw. 37, 851, b; Cro. Eliz. 559; Com. Dig. Abat. (F. 14.) 1. 3.

(*m*) Com. Dig. Abat. (F. 14.) 4.

(*n*) See the Form of Plea in the Appendix, Chap. II. s. 7.

against the patentee, because he is the person who is entitled to the privilege granted by the patent, and who has the custody of the patent itself as the evidence of his title. And (unless he has assigned his interest) he is therefore the person who is interested to defend the legality of the grant against the suggestions made in the writ; and he is the person who must be called upon to restore the patent into Chancery, if judgment should be given to cancel it.

After assignment patentee has no interest.

But after an assignment, the assignee becomes the party interested to defend the patent privilege; and he obtains the custody of the patent, over which the patentee ceases to have any power or control, and in fact he becomes as it were an entire stranger.

Judgment against patentee ought not to prevail against assignee.

If the action were to proceed against the patentee to trial and judgment, it seems that such a judgment ought not to prevail against the assignee, for he would be no party to it; and it might be carried on by collusion with the patentee, and he might have no notice of the proceeding. The assignee would most probably, in such a case, succeed in reversing or vacating such a judgment, either by writ of error or by *audita querela*.

Whether plea would be in abatement or in bar.

It is difficult, however, to say whether such a plea must be pleaded in abatement of the writ, or whether the defendant might not plead it either in abatement, or in bar. Thus, it has been held, that in replevin for goods, the defendant may plead property in a stranger, either in abatement, or in bar of the action (*o*). The safest course, therefore, is to plead the plea in abatement, for after a judgment of *respondeas ouster*, the plea might be pleaded in bar.

Plea would give a better writ.

Such a plea, if pleaded in abatement, would enable the prosecutor to proceed against the assignee, and therefore it would give him a better writ. And the patentee would for ever be estopped from alleging that he had any interest in the patent.

Expediency of pleading an assignment.

It may in some cases be very expedient for a patentee to plead the assignment of his patent to another; for if he has assigned his patent with a covenant respecting the validity of it, or the sufficiency of his title to it, it might be to his disadvantage to allow the prosecutor to obtain a judgment by de-

(*o*) Com. Dig. tit. Abat. (B. 1.)

fault. And if he is not bound to defend the patent right, he will be desirous to avoid the costs of defending the action upon the merits (*p*). If the defendant pleads in abatement, it seems that the plea ought to be verified by affidavit, as required by the statute 4 Ann. c. 16, s. 11.

Defendant cannot plead double.

If the defendant pleads in bar to the action, he cannot plead double to any part of the writ, for the Crown not being named in sect. 4 of the statute 4 Ann. c. 16, is not bound by it.

Attorney-general *v.* Allgood.

Thus, in the case of *The Attorney General* v. *Allgood* (*q*), which was an information of intrusion, it was held by the Court of Exchequer, that the defendant was not entitled to plead several matters.

R. *v.* Archbishop of York.

In the case of *The King against the Archbishop of York* (*r*), in *quare impedit*, the Court of Common Pleas held, that the defendant was not enabled by the statute to plead two pleas (*s*).

How to proceed if defendant pleads double.

Dendy *v.* Chitty.

If the defendant were to plead several matters in distinct pleas to the declaration, it seems that the prosecutor might take the course adopted in *Dendy* v. *Chitty*, and *Luxford* v. *Chitty* (*t*). In each of these cases the defendant Chitty, in the County Court, pleaded two pleas, the general issue and set-off. The plaintiff replied to the first plea only in each case, paying no attention to the second plea, and upon a trial he had a verdict. The defendant afterwards brought a writ of false judgment in each case, and assigned for error the want of a replication to the plea of set-off, but the Court of Queen's Bench held that the plaintiffs in the Court below had a right to treat the second plea as surplusage, and the judgment was affirmed. In the case of *The Queen* v. *Nickels* (*u*), in *scire facias*, where the defendant pleaded several matters, the prosecutor obtained a summons calling upon the defendants to show cause why the pleas should not be set aside for irregularity, and Lord *Langdale*, M. R., after consulting some of the Judges, made an order for setting aside the pleas for irregularity *with costs*.

R. *v.* Nickels.

Defendant ought to plead

The defendant is at liberty to plead any matter he pleases

(*p*) See further as to matters which may be pleaded in abatement, under the title Abatement, in Com. Dig.

(*q*) Parker, p. 1 and 15.

(*r*) Willes, 533; Barnes, 353, *S. C.*

(*s*) See also *R.* v. *Caldwell*, Forrest, 57; and *Glemham's* case, Poph. 144.

(*t*) 3 A. & E. 319.

(*u*) *R.* v. *Nickels*, MS.

in bar to the several suggestions contained in the writ, and it is the usual and better course to plead to each suggestion separately, and the pleas are generally mere traverses of the various suggestions (*x*).

separately to each suggestion.

If prosecutor does not set out the specification in the writ, it may be advisable for the defendant to set it out in his pleas, in which case it is generally best to do so in the plea to the suggestion that the patentee has not enrolled any sufficient specification.

Setting out specification in plea.

The defendant's pleas or demurrers are to be prepared and filed by the clerk of the Petty Bag, but it is usual to procure a draught of them to be drawn or settled by counsel, and deliver a copy to the officer of the Court as his instructions for the pleas.

Defendant's pleas prepared by clerk of Petty Bag.

Special pleas and demurrers require to be signed by counsel in the same way as in other actions.

Signature of counsel.

If any of the defendant's pleas are insufficient, the prosecutor may of course demur, and as the provisions of the statutes 27 Eliz. c. 5. and 4 Ann. c. 16, s. 1, respecting demurrers, do not apply to actions at the suit of her Majesty, it seems that a demurrer by the Crown need not be special, except perhaps for duplicity.

Demurrer to a plea.

It is seldom that any other replication than the common joinder becomes necessary in this action, for the pleas in general are simple traverses of the various suggestions in the writ.

Replication.

The prosecutor's demurrer or replication is to be prepared and filed by the clerk of the Petty Bag, in the same way as the declaration.

The issue (*y*) is also prepared by the prosecutor's nominal attorney or clerk of the Petty Bag, and delivered to the defendant's attorney or clerk.

Issue.

The clerk of the Petty Bag will also engross the record, and if there are issues to be tried by a jury, will make a transcript of it to be taken into the Queen's Bench, in order to have the issues tried there.

Record and transcript.

When there are any issues to be tried, except those which

Where a trial may be had.

(*x*) See the Forms of Pleas in the Appendix, Chap. II. s. 7.

(*y*) See the Form in the Appendix, Chap. II. s. 7.

must be tried by a jury, the trial may take place in the Court of Chancery (*y*). Thus, an issue in law raised by a demurrer may be decided by the Lord Chancellor, who is the sole Judge of this Court (*z*); and this having been done by Lord Chancellor *Finch* in *Sir Oliver Butler's* case (*a*), the judgment was afterwards affirmed in the House of Lords (*b*). So if an issue is to be tried by the certificate of the Bishop, as an issue *ne unque accouple in loyal matrimonie*, the certificate may be made returnable in the Court of Chancery, and judgment given there (*c*). Or if an issue be taken upon the custom of London, which is to be tried by the mouth of the Recorder, judgment may be given thereon in the Court of Chancery (*d*). And if there be demurrer as to part and issue to the country as to the residue, the demurrer may be determined in Chancery before the record is delivered into the Queen's Bench (*e*).

It seems that the record may in some cases be delivered into the Queen's Bench, and judgment given on the demurrer there (*e*). But that of course only applies to cases in which the Court of Queen's Bench has jurisdiction, not to actions of *scire facias* in which it is sought to *cancel* as well as repeal letters patent, for the Queen's Bench has no authority to cancel any of the records of the Court of Chancery, much less letters patent under the Great Seal, which no Judge except the Lord Chancellor has any jurisdiction over (*f*).

Issue cannot be tried by a jury in Chancery.

An issue cannot be tried by a jury in Chancery, for that Court has no authority to call a jury to its bar (*g*). But when there is any issue joined in an action in that Court, which must be tried by a jury, the Court awards a *venire facias* to the sheriff returnable in the Queen's Bench (*h*), upon a day certain in term, and the same day is given to the parties, that is, to the Attorney-general, and the defendant, to be in the Queen's Bench (*i*). The record is then to be taken into

(*y*) *Blakeston's* case, W. Jon. 83.
(*z*) 4 Inst. 80.
(*a*) 2 Ventr. 344.
(*b*) 3 Lev. 220.
(*c*) *Blakeston's* case, W. Jon. 83; Latch, 3.
(*d*) W. Jon. 83.
(*e*) *Jefferson* v. *Dawson*, 1 Sid. 437; 1 Lev. 283, *S. C.*
(*f*) Vide *ante*, Chap. VIII. s. 3, p. 214.
(*g*) 4 Inst. 80; 2 Ro. R. 291; Br. Abr. Jurisdic. pl. 48; Latch, 3, *Blakeston's* case.
(*h*) Al. 14; 1 Ro. Abr. 372, l, 31; Br. Abr. Jurisdic. pl. 48.
(*i*) See the Forms in the Appendix, Chap. II. s. 7.

the Queen's Bench in order that the issues may be there tried (*k*).

No writ of *mittimus* is necessary for this purpose, because both the Courts are in contemplation of law held in the same place (*l*), that is, before the Queen herself, wheresoever she shall be in England. The record is therefore taken, and delivered into the Queen's Bench by the Lord Chancellor as the sole Judge of his own Court, without any other than his own authority, and, as it is stated in the record, by his own proper hands (*m*). But although the record always states the delivery of the record to be by the proper hands of the Lord Chancellor, it is sufficient if it be done by the hand of any officer of the Court.

No *mittimus* necessary.

Thus, in the case of *The King* v. *the Warden of the Fleet* (*n*), after issue joined the record was carried into the Queen's Bench by the clerks of the Petty Bag without any order of the Court, in order to have the issue tried, and it was held that the record was well removed, for what is done by the hand of the proper officer of the Chancellor may be well enough said to be done by him *propria manu*. And the record is, according to the present practice, delivered by the clerk of the Petty Bag to the prosecutor's solicitor, who (being an officer of the court) carries it into the Queen's Bench.

R. v. Warden of the Fleet.

In an action of *scire facias* to repeal and cancel a patent, the record thus delivered into the Queen's Bench is merely a transcript, or the tenor of the Chancery record, the original record being retained in the Petty Bag Office (*o*).

Record sent into Queen's Bench is a transcript.

The record must be transmitted into the Queen's Bench to try the issues in fact (*p*), and cannot be sent to the Common Pleas, or to any other Court (*q*). And the *venire facias* which is issued out of Chancery must be made returnable in the Queen's Bench (*r*).

Record must be sent into Queen's Bench.

The *venire facias* must be directed to the sheriff of Mid-

Venire facias directed to sheriff of Middlesex.

(*k*) See 4 Inst. 80.
(*l*) 10 Ed. III. 59, pl. 62.
(*m*) See also 4 Inst. 80.
(*n*) 1 Eq. Cas. Abr. 128.
(*o*) It is otherwise, however, in an action of *scire facias*, upon a recognizance in which the whole record, including the recognizance itself, is transmitted into the Court of Queen's Bench, M. 24 Ed. III. 73, pl. 9.
(*p*) Bro. Abr. Sci. Fa. pl. 154.
(*q*) Latch, 3; Al. 14; W. Jon. 82; Jenk. 133, ca. 71.
(*r*) Jenk. 133, ca. 71; Brook. Abr. Jurisdic. pl. 48.

dlesex, the record upon which the action is founded being in that county (*s*).

Does not state the issues.

The *venire facias* issued out of Chancery does not state the issues to be tried by the jury, but merely that the jury are to take cognizance upon their oaths in a plea of *scire facias* between the Queen and the defendant (*t*).

Stury and Stury.

And in the case of *Stury* and *Stury* (*u*), the Court of King's Bench held, that such a writ was good, being in the form warranted by the practice of the Court of Chancery out of which it issued.

Alias venire issues out of Queen's Bench.

If a writ of *venire facias juratores*, issuing out of Chancery and returnable in the Queen's Bench, be not returned in the latter Court according to the exigency of the writ, an *alias venire facias* shall issue out of the Queen's Bench and not out of Chancery (*x*).

Notice of trial.

The practice is for the clerk of the Petty Bag to give notice of trial in the Petty Bag Office, upon the back of the issue (or it may be given separately), and the practice of the Court as to the length of notice required is the same as in causes in the Court of Queen's Bench.

Proceedings in the Queen's Bench.

If Queen's Bench has jurisdiction, action may be adjourned into Queen's Bench.

The Court of Chancery, it is said, has power to adjourn any Common Law action there pending, and transmit the record into the Court of Queen's Bench at any time (*y*), either before or after issue joined, or joinder in demurrer (*z*), and in *Sarnfield's* case (*a*), that was done even before plea pleaded. But this must of course be understood as applying only to cases in which the Court of Queen's Bench can exercise jurisdiction, not to an action in which the Chancery can alone give judgment.

If action adjourned, the record and jurisdiction transferred to Queen's Bench.

In cases when the action can be adjourned into the Queen's Bench, the whole record is sent into that Court, together with the record, if any, upon which the action is founded. As in case of a *scire facias* upon a recognizance, not only the record

(*s*) Br. Abr. Sci. Fa. pl. 189.
(*t*) See the Form in the Appendix, Chap. II. s. 7.
(*u*) 2 Rol. Rep. 291.
(*x*) 13 Ed. IV. 8; Staund. Prerog. 77, b.; Jenk. 133, ca. 71.
(*y*) 1 Ro. Abr. Chan. (F) (G), 372.
(*z*) 2 Saund. 27.
(*a*) Cited 8 Co. R. 23, a.

in the action, but also the recognizance itself, is sent into the Queen's Bench (*b*).

By the removal of the record in such cases the whole jurisdiction over the action is transferred to the Court of Queen's Bench, and in that Court alone must all the subsequent proceedings be taken in the action (*c*).

In *scire facias* to revoke a patent, *and to cancel* the patent and the enrolment; in such an action the Lord Chancellor alone can give judgment to cancel the patent and enrolment, and therefore, when a trial is to be had by a jury, the tenor, or a transcript only of the record, is sent out of Chancery into the Queen's Bench, the original record and the patent roll upon which the *scire facias* is founded being retained in the Court of Chancery.

In *scire facias* to cancel a patent, a transcript only of record sent into Queen's Bench.

After notice of trial has been given, and an entry made upon the record in the Court of Chancery, of an award of a writ of *venire facias juratores* to the sheriff of Middlesex by the Court, a day is to be given to the parties to be in the Queen's Bench, (which is always the return day of the writ,) and the Clerk of the Petty Bag then makes a transcript of the Chancery record upon parchment, and delivers it to the prosecutor's solicitor to be carried into the Queen's Bench in order that the issues may be there tried.

Transcript of record, when to be sent into Queen's Bench.

The action being at the suit of her Majesty, the transcript of the record when it is transmitted belongs to the Crown side of the Queen's Bench, and therefore it is always delivered into the Crown Office of that Court (*d*).

Transcript to be taken to the Crown Office.

The transcript of the record must be taken into the Crown Office before the first day of the *nisi prius* sitting at which the trial is intended to take place, so as to enable the prosecutor's attorney to prepare the *nisi prius* record, and take it to the Marshall's Office on or before that day. And the transcript must have annexed to it a copy of the notice of objections filed by the prosecutor in the Petty Bag Office.

When to be taken.

The clerk of the Petty Bag will also prepare the writ of *venire facias juratores*, and deliver it to the prosecutor's

Venire facias.

(*b*) Roll. Abr. Court (G) pl. 5; 24 Ed. III. fol. 73, pl. 91; See *Bishop of Bristol* v. *Procter*, 1 Ro. R. 287.

(*c*) Vide Al. 14, 17; Sty. 90, 94; 2 Saund. 27; 1 Ro. R. 287; Eq. Cas. Abr. 129.

(*d*) In actions between private persons, records out of Chancery are delivered to the officers on the Plea side of the Queen's Bench.

solicitor with a transcript of the record. The writ must be taken to the office of the sheriff of Middlesex, by whom it is to be returned into the Crown office of the Court of Queen's Bench.

Not necessary to take office copies.

It was formerly the practice to require the prosecutor and the defendant to take office copies of the record, and notice of objections as soon as it came into the Crown Office; this practice has however been abolished.

Queen's Bench record.

When the transcript of the record comes into the Queen's Bench, a record is made of the bringing of it into that Court, and setting out the whole of it verbatim (*e*). Upon this Queen's Bench record all the proceedings in that Court are entered, immediately following the transcript of the Chancery record, the proceedings in the Queen's Bench being commenced by the appearance of the respective parties in that Court.

Attornies now entitled to practise on the Crown side of Queen's Bench.

Before the passing of the recent statute of 6 & 7 Vict. c. 20, the parties prosecuting and defending an action of *scire facias* were compelled to employ clerks in Court to prosecute and defend the suit on their behalf, and the clerks in Court were in fact the actual attornies of the parties on the record. But by the 6 and 7 Vict. c. 20, s. 1, the office of clerk in Court was abolished, and by section 14 of the same Act all attornies entitled to practise in the Queen's Bench, are enabled in like manner to practise on the Crown side of that Court.

Return of *venire facias.*

The writ of *venire facias*, issued out of Chancery, is to be returned into the Crown Office of the Queen's Bench; and if it be actually returned, the return is recorded immediately after the entry of the appearance of the parties in that Court. But if the writ is not returned, an entry is made accordingly, upon which an *alias venire* may be awarded.

Alias venire.

If an *alias venire facias* becomes necessary, it must be sued out of the Court of Queen's Bench, and not out of Chancery. For the *alias* writ issues upon the entry of *vicecomes non misit breve*, which can only be in the Queen's Bench (*f*).

The *alias venire* must be in the same form as that issued out of Chancery (*g*), with the exception of the additional words—"As before we have commanded you," and the teste of the

(*e*) See the Form in the Appendix, Chap. II. s. 7.

(*f*) Staund. Prerog. 77, b.; Jenkins, 3rd Cent. p. 133, ca. 71.

(*g*) See the Form in the Appendix, Chap. II. s. 7.

writ, which must be in the name of the Chief Justice instead of the name of the Queen herself. This writ must be tested as of the day of the last continuance previous to the award of the *distringas juratores*, and must be made returnable on a day certain, or immediately, according to the form of the prior writ out of Chancery. This writ must be prepared by the prosecutor's attorney, and signed and sealed at the Crown Office (*h*), after which the sheriff's return must be procured in the usual way.

Rule to return writ.

A side bar rule may be obtained at the Crown Office (upon production of a motion paper signed by counsel,) requiring the Sheriff to return the *venire facias*, or any other writ.

Trial.

The action may be tried either at bar (*i*) or *nisi prius* (*j*).

Cannot be at *nisi prius* without consent of the Crown.

But it cannot be tried at *nisi prius* without the consent of the Crown (*k*); and if the consent of the Crown is withheld, the cause must be tried at bar (*l*). The reason of this is, that the statute of Westminster, the second, which gives the writ of *nisi prius*, is not binding upon the Crown, the Crown not being expressly named in it (*m*). The Attorney-general is not, however, entitled to a *nisi prius* as of right, but the Court may, if it think fit, grant the defendant a trial at bar (*n*).

Consent of Crown how granted.

The consent of the Crown may be granted either by writ of Privy Seal (*o*), or by warrant under the hand of the Attorney-general (*p*). It is said in Rolle's Abridgment (*q*), that if the King be plaintiff in any action, he shall not have a *nisi prius* without a writ directed to the justices for their warrant, and a case in the Year Book 24 Ed. III. 23 B. is cited (*r*). The case cited, however, was in the Common Pleas, and whatever may have been the practice in that Court, a *nisi prius* may be obtained in the Queen's Bench upon the warrant of the Attorney-general, without any writ of Privy Seal. And it is

(*h*) By 8 & 9 Vict. c. 34, s. 2, all writs on the Crown side of the Court are, after the 1st of January, 1846, to be sealed at the Crown Office.

(*i*) See *R.* v. *Hare*, 1 Str. 267; and *R.* v. *Bewdley*, 1 P. Wms. 207.

(*j*) *Eyre* v. *Taunton*, 3 Cro. 313.

(*k*) F. N. B. 241, A; Fitz. Abr. Ni. Pri. pl. 16; Bro. Abr. Nisi Pri. pl. 35; Sav. 2; 2 Inst. 424; and see Vin. Ab. (P. b); 2 Ro. Abr. 629 l, 10; Staund. 156.

(*l*) *R.* v. *Banks*, 6 Mod. 245; 2 Salk. 652, *S. C.*

(*m*) Hawk. Bk. 2, c. 42; Bro. Abr. Nisi Pri. pl. 35.

(*n*) *Astry's* case, 6 Mod. 123.

(*o*) 2 Inst. 555; 2 Ro. Abr. 629, l. 16-21.

(*p*) *R.* v. *Banks*, 6 Mod. 245; Staund. 156; and see Sav. 2.

(*q*) 2 Ro. Abr. 629; and see Vin. Ab. Trial (P. b.).

(*r*) And see Fitz. Abr. Nisi Pri. 18.

the every-day practice of the Crown Office to grant a *nisi prius* upon such a warrant.

If an action of *scire facias* were to be tried at *nisi prius*, without any writ from the Crown, or warrant from the Attorney-general, the whole proceeding would be irregular.

Trial by *proviso.*

Nor can the defendant take the action to trial at *nisi prius* by *proviso* without the consent of the Attorney-general, because no *laches* can be attributed to the Queen:—and a trial at *nisi prius* by *proviso*, without such consent would be irregular, and would be set aside (*s*).

Distringas juratores.

The writ of *distringas juratores* also issues out of the Queen's Bench, and is directed to the sheriff of Middlesex. It must be tested as of the day of the return of the *venire facias juratores*, or if there has been an *alias venire*, then as of the day of the return of the *alias* writ. This writ must be framed in accordance with the practice of the Court of Queen's Bench, and must therefore state the substance of the issues which are to be tried. It is of course to be tested in the name of the Chief Justice, and must be made returnable on a day certain in the next ensuing term before the Queen at Westminster (*t*).

The writ is to be prepared by the prosecutor's attorney (*u*), and taken to the Crown Office to be signed and sealed (*x*), and then it must be delivered to the sheriff and returned by him in the usual way.

Nisi prius record.

If the action is to be tried at *nisi prius*, the record must be prepared by the prosecutor's attorney in the ordinary way (*u*), and if the trial does not take place at the sittings next after the return of the *venire facias juratores* out of Chancery, con-

Continuances.

tinuances must be duly entered up to the time when the trial actually takes place. If the cause is to be tried by a common jury, the continuance may be by an entry of *vicecomes non misit breve* (*y*), after the award of the *venire facias*, and an award of an *alias* writ of *venire facias*, returnable immediately before the trial. But if a special jury has been

(*s*) 2 Hawk. c. 41, s. 10; *R.* v. *Banks*, 6 Mod. 245; 2 Salk. 652; 2 Ld. Ray. 1082; 11 Mod. 33, *S. C.*; *R.* v. *Dyde*, 7 T. R. 661; *R.* v. *Macleod*, 3 East, 202.

(*t*) See the rules made for the regulation of the practice of the Crown Office, Cor. Pract. Apx.

(*u*) See the Form in the Appendix Chap. II. s. 7.

(*x*) 8 & 9 Vict. c. 34, s. 2; see note (*h*), last page.

(*y*) See 1 Str. 267.

nominated and reduced, and the jury process actually returned, the continuance must be entered in the same way after the award of the *distringas juratores* (*z*).

The *nisi prius* record is a mere transcript of the Queen's Bench record, the *venue*, "Middlesex to wit," being written in the margin instead of "England to wit," which is always written in the margin of the Chancery record. The *venue* is necessarily in Middlesex, because the record upon which the *scire facias* is founded, remains in the county of Middlesex, and therefore the issues must be tried by a jury of that county (*a*).

Form of *nisi prius* record.

Venue.

The *nisi prius* record is to be prepared by the prosecutor's attorney, and taken to the Queen's Bench Office to be sealed and passed. The record ought not, however, to be sealed until the Attorney-general's warrant for a *nisi prius* has been obtained.

Nisi prius record how prepared.

A copy of the notice of objections, and the Attorney-general's warrant for the *nisi prius*, must be annexed to the *nisi prius* record, and if the cause is to be tried by a common jury, the writs of *venire facias* and *distringas*, with the sheriff's returns to those writs, must also be annexed to it, before it is carried into the Marshall's Office.

Notice of objections, &c. to be annexed.

Either the prosecutor or defendant may obtain a rule to have the action tried by a special jury (*b*). The rule is drawn up at the Crown Office upon production of a motion paper signed by counsel (*c*); no affidavit or Judge's order being necessary.

Special jury, rule for.

In order to act upon the rule, an appointment (*d*) must be obtained at the Crown Office for the nomination of the jury *there*, and the rule and appointment must be served upon the sheriff, and the opposite party. The rule must be produced at the chambers of the Lord Chief Justice, in order to have the cause marked as a special jury cause, on or before the day preceding the adjournment day of the Middlesex sittings after term (*e*). When the adverse party does not appear upon the

Appointment for nomination.

(*z*) See the Forms in the Appendix, Chap. II. s. 7; and see also *R.* v. *Hare*, 1 Str. 267.

(*a*) See Bro. Abr. Sci. Fa. pl. 189.

(*b*) See 6 Geo. IV. c. 50, s. 30.

(*c*) See Corner's Crown Practice, 137.

(*d*) See 6 Geo. IV. c. 50, s. 32.

(*e*) R. G. Hil. 44 Geo. III., 1805; Peacock, 197. The adjournment day is the second day after the first day of the sittings after term, or the third if a Sunday intervenes.

first appointment, the party which obtained the appointment must (after waiting half an hour) procure a peremptory appointment. If the adverse party does not appear upon the peremptory appointment, the party who procured it may after waiting an hour proceed with the nomination *ex parte*. The

Nomination.

nomination is made at the Crown Office by the clerk or officer there in this manner (*f*): he will draw forty-eight cards (having numbers written upon them) successively out of a ballot box, and upon drawing each card reference will be made to the name in the sheriff's book or list of special jurors opposite to the number corresponding with that on the card, and each of the names thus obtained will be placed upon the list of jurors nominated to try the action. It is usual for the parties attending to take a copy of the list so made for the purpose of making inquiries before reducing the list (*g*).

Appointment to reduce.

An appointment to reduce the number of jurors on this list from forty-eight to twenty-four may be obtained immediately or at any time after the nomination. The appointment to reduce must be served on the opposite party, and if he fail to attend the first appointment a peremptory appointment should be obtained.

Reducing the list.

If the parties both appear, the list is reduced by the prosecutor and defendant alternately striking out a name until the number of jurors on the list is reduced to twenty-four. If the opposite party fail to appear upon the peremptory appointment to reduce, the party striking the jury must produce an affidavit of the due service upon the proper party of the rule, and of the appointment to nominate and reduce, and then the Master or his clerk will strike out names for the absent party (*h*).

Reduced list.

The twenty-four names which remain in the reduced list are those of the jurors which must be summoned to try the issues joined in the action (*i*). For that purpose the reduced list is to be signed by the Master, and annexed to the *venire facias*, and taken to the sheriff. When a day for the trial of the cause has been appointed, the sheriff will summon the

(*f*) 6 Geo. IV. c. 50, s. 32.

(*g*) The sheriff is entitled to two guineas for attending, and the Master one guinea for the nomination. These fees must be paid by the party striking the jury.

(*h*) See Corner's Prac. 137, 138; Hand's Crow. Prac. 10; and *R.* v. *Hart*, 1 Cowp. 412.

(*i*) 6 Geo. IV. c. 50, s. 30.

jurors, and copy the names into a panel, and return the writ, with the panel annexed, into Court on the day appointed. And when a special jury has thus been struck and reduced, the cause cannot be tried by any other jury (*j*), unless the rule for the special jury is first discharged.

If a party neglects to proceed upon a rule for a special jury, the opposite party may.

If the party who obtains a rule for a special jury neglects to proceed to a nomination of the jury, the opposite party may obtain an office copy of the rule, and proceed upon it as if it were his own rule. So if a party after the nomination of the jury fail to proceed to reduce the list, the opposite party may obtain an appointment to reduce upon an office copy of the rule, and proceed upon it in like manner as the other party could have done.

If rule procured for delay.

If the defendant procures a rule for a special jury for the purpose of delay, and neglects to proceed to strike and reduce the jury, the prosecutor may move to discharge the rule (*k*), or he may obtain a summons calling upon the defendant to show cause why the action should not be tried by a common jury (*l*); or the prosecutor may disregard the rule, and proceed to try the action by a common jury (*m*).

Writs of *subpœna*.

Writs of *subpœna ad testificandum* and *duces tecum* in this action must be issued out of the Crown Office. In order to obtain such a writ, it must be engrossed on parchment by the attorney of the party suing it out (*n*), it must then be taken to the Crown Office with a *præcipe*, where the writ will be signed and sealed (*o*), and the *præcipe* filed. The writ must be tested as of the day it is issued.

Warrant of *tales*.

The Queen being a party to the action, a *tales* cannot be prayed by either party at the trial without the Attorney-general's warrant (*p*). Whenever the cause has been made a special jury cause therefore, each party ought to provide himself with such a warrant which will be granted as of course (*q*).

(*j*) *R.* v. *Perry*, 5 T. R. 453; and *R.* v. *Franklin*, cited there.

(*k*) *Stanbury* v. *Gillet*, 9 Bing. 319; *Phelps* v. *Kelly*, 3 M. & G. 883; *Chuck* v. *Harris*, 1 M. & G. 940; *Anon.* 1 Chit. 490, n.

(*l*) *R.* v. *Smith*, Corn. Cr. Prac. 138.

(*m*) See 1 Stark. R. 31; *Gunn* v. *Honeyman*, 2 B. & Ald. 400; *Johnson* v. *Blackwell*, 6 C. & P. 236.

(*n*) See the Form in the Appendix, Chap. II. s. 7.

(*o*) 8 & 9 Vict. c. 34, s. 2, and see n. (*h*), p. 407.

(*p*) 2 Hawk. c. 41, s. 18.

(*q*) See the Form in the Appendix, Chap. II. s. 7.

The warrant may be used or not at the discretion of the party who obtained it (*r*).

Entry of the cause for trial.

The record must be entered for trial with the Marshall of the Queen's Bench, and the record carried in to the Marshall's office in the same way as in other causes to be tried at the *nisi prius* sittings after term for Middlesex; the record must therefore be taken to the office on or before the first day of the sittings at which it is to be tried.

Proclamation at trial.

When the action of *scire facias* is at the suit of the Crown, it is necessary to make a proclamation at the trial as soon as the jury appears, for the prosecutor is not named in the record, and therefore the Court cannot have any judicial knowledge on the subject (*s*). Upon the proclamation being made, the counsel for the prosecution appears for the Crown, and then the jury is sworn and the trial proceeds.

Prosecutor entitled to begin.

The prosecutor's counsel is entitled to begin and give evidence in support of the prosecutor's objections to the patent, or such of them as are admissible under the suggestions contained in the writ. And as he is entitled to begin, so will he be entitled to the reply if the defendant should give any evidence.

Demurrer to evidence.

The Queen being a party, the defendant cannot demur to the evidence for the Crown, unless the counsel for the Crown consent; but if the consent of the Crown is refused, the Court ought to direct the jury to find the special matter, upon which the law may afterwards be adjudged (*t*).

Bill of exceptions.

There is considerable doubt whether a bill of exceptions can be allowed in any case where the Queen is a party, for the Crown is not expressly named in the statute of Westminster, the second (*u*) which gives the bill of exceptions (*x*).

It has also been doubted whether a bill of exceptions lies upon proceedings in the Petty Bag in Chancery; but that doubt seems to be set at rest by the opinion of the Judges in a case which occurred before Lord Keeper *Harcourt*. Copies of the Lord Keeper's letter to the Chief Justice of the King's

(*r*) See 6 Geo. IV. c. 50, s. 37.
(*s*) See 9 Co. R. 101, a.
(*t*) *Baker's* case, 5 Co. R. 104, a.; Co. Lit. 72, a.; Doct. plac. 119; *Middleton* v. *Baker*, Cro. Eliz. 751, 752.
(*u*) 13 Ed. I. c. 31.
(*x*) See 2 Hawk. c. 46, s. 20; *R.* v. *Vane*, 1 Sid. 85; Kely. 15; 1 Keb. 32; 1 Lev. 68, *S. C.*; Willis, 535; and 2 Inst. 427.

Bench, and the answer of the Chief Justice, with the opinion of the Judges, have been preserved in the office of the Petty Bag (*y*).

When there are several suggestions in a writ of *scire facias*, Discharge of the jury as to some of the issues.

(*y*) The following are copies of the letter and answer:

Lord Keeper's Letter to the Lord Chief Justice.

"My Lord,

"On Thursday last, Mr. Attorney-general moved the Court of Chancery to discharge a frivolous plea in abatement to a *scire facias* depending in the Petty Bag. On hearing counsel on both sides, I was of opinion that the plea was frivolous, and ordered it to be discharged. The defendant's counsel, immediately upon my pronouncing the order, produced a Bill of Exceptions, ready engrossed, in ten large skins of parchment, and desired me to seal it. I forbear to trouble your Lordship with any account with respect to the nature of the writ, or of the plea, or the manner of tendering the Bill to me.

"The length of the Bill made it necessary for me to take time to examine the truth of it; but, on further consideration, I am under some doubt whether a Bill of Exceptions lyes from a judgment given by the Court of Chancery in a suit depending in the Petty Bag.

"The mischief, in my apprehension, is the same as in the case of an erroneous judgment in any other Court of Record, and yet, since I have not mett with any president of tendering a Bill of Exceptions to the Court of Chancery, and forasmuch as the remedy for obliging the Justices to set their seals, seems very improper to be taken in the case of the Keeper of the Great Seal, I entreat the favor of your Lordship, if your Lordship conceives there is any doubt in this case, to take the opinions of all the Judges, and to give yourself the trouble of certifying their opinions to me.

"I am, my Lord,
"Your Lordship's very
"humble Servant,
"HARCOURT."

"17 *Nov.* 1711."

The Answer of the Lord Chief Justice.

"My Lord,

"I have desired the opinions of my Lord Chief Justice of the Common Pleas, my Lord Chief Baron, and the rest of the Judges upon the question proposed by your Lordship in your letter to me of the 17th of November last.

"Wiether a Bill of Exception lyes upon proceedings in the Court of Chancery in a suit depending in the Petty Bag.

"After having met, and heard Council on both sides, and conferred together, we all take the point to be entirely new, for neither any of our own experience, or reading, nor the industry of the parties or their Council, have furnished us with any one instance of a Bill of Exceptions in Chancery before this which occasions the present question. But yet, from the nature of the Act of Parliament whereby the Bill of Exceptions is given, which is an advancement of justice, the extensive words which are used in it, and the more extensive expositions which from time to time have carry'd it beyond the strict words to cases and courts within the same mischief; and because the mischief is the same in case of an erroneous judgment in the Court of Chancery as in any other Court, which your Lordship, in proposing this question, is pleased to intimate as of great weight with yourself. We are all of opinion that a Bill of Exceptions doth lye upon proceedings in the Court of Chancery in a suit depending in the Petty Bag. I could not lay this sooner before your Lordship, having not had the final resolution of the Judges till last night, when we all mett together for that purpose."

"23*rd Jan.* 1712."

each suggestion, (to be valid,) ought to show sufficient cause for the repealing and cancelling of the patent. If issue be taken upon each of these suggestions, a verdict upon any one of the issues will be sufficient to entitle the Crown to judgment; all the other issues will of course become immaterial, and the Judge it seems has authority, in such a case, to discharge the jury from giving any verdict upon them (*z*).

R. v. Nickels. Thus in the case of *The Queen* v. *Nickels* (*a*), an objection was taken by the prosecutor's counsel to the sufficiency of the specification, and as the objection arose upon the face of the specification, and respecting the construction to be put upon the words of the instrument, Lord *Denman*, C. J., directed the jury to find a verdict for the Crown upon the issue respecting the sufficiency of the specification, and discharged them from giving any verdict upon the other issues in the action (*b*).

Venire de novo. At Common Law, after the issuing of a *distringas*, a new *venire* could not be awarded (*c*), and it seems that the statutes 7 & 8 Will. III. c. 32, sec 1, and 6 Geo. IV. c. 50, s. 16, which give such a writ in other actions, do not extend to a *scire facias* in which the Queen is a party, for the Crown is not particularly named in either enactment (*d*). And in the case of *Pretious* v. *Robinson* (*e*), (which was before the passing of either of these statutes,) there was a second *venire* awarded; it was held that the trial was void.

New trial. Whether the action has been tried at bar or at *nisi prius*, the Court of Queen's Bench has power to grant a new trial (*f*). For the transcript of the record is sent into the Queen's Bench, to the end that the issues may be tried, and until the issues have been *properly* tried, the Queen's Bench cannot certify the Chancery respecting the result. It has

(*z*) *R.* v. *Johnson*, 5 A. & E. 488; *Cook* v. *Caldecott*, 4 C. & P. 315; but see *Tolson* v. *Kaye*, 6 M. & G. 589, and the observations of *Parke*, B., in *Duckworth* v. *Harrison*, 4 M. & W. 444.

(*a*) MS.

(*b*) See further on the subject of discharging a jury as to immaterial issues, *Powell* v. *Sonnett*, 1 Dow. N. S. 56; 1 Bligh, N. S. 545; 3 Bing. 381; 11 Moore, 330, *S. C.*; *Duckworth* v. *Harrison*, 4 M. & W. 444; *R.* v. *Johnson*, 5 A. & E. 488, and 6 M. & G. 259, n.

(*c*) See Tidd's Pract. c. 34, p. 779, 9th ed.

(*d*) See the case of *R.* v. *Franklin*, stated by *Buller*, J., in *R.* v. *Perry*, 5 T. R. 454.

(*e*) 2 Vent. 173.

(*f*) See *R.* v. *Bewdley*, 1 P. Wms. 207.

consequently been the constant practice to move the Court of Queen's Bench for new trials in actions of *scire facias* (*g*).

Some question was at one time made respecting the proper Court in which to sign judgment after a verdict for the Crown, but it seems that the judgment can only properly be signed in the Court of Chancery. Judgment.

It is a general rule that when a record once comes out of any other Court into the Queen's Bench, it is not to be remanded (*h*). But to that rule there are several exceptions. Thus in Brooke's Abridgment (*i*), it is stated, that "in the King's Bench they have divers precedents, that in writ of error upon a fine the record itself shall be certified, so that no more proclamations be made, and if they are reversed, that makes an end of all, but if they are affirmed, then the record shall be sent into the Common Pleas by *mittimus* to be proclaimed and engrossed." Several exceptions to the rule that Queen's Bench never parts with a record.

So if a plea of frank-fee is pleaded of land in ancient demesne, and after the proceedings have been removed into the Queen's Bench, the land is proved to be ancient demesne, the proceedings shall be remanded (*k*).

And in Keilway's Reports (*l*), it appears that a record was remanded into Chancery, by *certiorari*, to enable a party to have his livery there.

In the great majority of cases in which records are sent out of Chancery into the Queen's Bench for trial, the record is retained in the latter Court, and judgment given there (*m*); but in all these cases the Court of Queen's Bench has the same jurisdiction over the subject-matter of the suit as the Court of Chancery; in fact, every thing that is to be done in such actions after verdict, may be done as well by the one Court as the other, and therefore it would be a useless form to send the records in such actions back into Chancery. And in all those actions when the records are taken into the Queen's Bench for a trial, the original record either actually or in contemplation of law is transferred to that Court. Where Queen's Bench has jurisdiction the record is retained.

(*g*) See *R.* v. *Arkwright*, Dav. P. C. 141; *R.* v. *Wheeler*, 2 B. & Ald. 345; *R.* v. *Bynner*, not yet reported.

(*h*) See *Jefferson* v. *Morton*, 2 Saund. 23.

(*i*) Title, Record, pl. 79; see also 3 Shep. Abr. 130.

(*k*) Bro. Abr. Conusaunce, pl. 61.

(*l*) 94, b.

(*m*) See Bro. Ab. Judg. pl. 135.

Thus, in a case stated in the Year Book, 24 Ed. III. (*n*), Robert Bishop of Chester and another brought a *scire facias* against G. de M. upon a recognizance; after issue joined, the record, and also the record of the recognizance, was sent into the Queen's Bench. The Bishop being nonsuited at the trial, afterwards brought a new *scire facias* in the Queen's Bench upon the recognizance (*o*), and it was held, that he might do so, for the whole record including the recognizance itself had been removed out of Chancery into the Queen's Bench.

In *scire facias* to cancel a patent a transcript only of the record is sent into Queen's Bench.

But in a *scire facias* to repeal and cancel a patent, the original record in the action, as well as the enrolment, which is the record upon which the action is founded, both remain in Chancery, and a transcript of the record in the action only is sent into the Queen's Bench to have the issues tried by a jury. We have already seen (*p*), that the very object of the suit is to have the patent recalled back into the same place from whence they issued under the Great Seal, in order that they may be cancelled by having the Great Seal taken off. For this reason the writ of *scire facias* commands the sheriff to warn the defendant to appear in Chancery to show cause, not only why the patent should not be cancelled and vacated, *but also why the patent should not be restored into Chancery there to be cancelled.* And for the same reason the prayer of judgment by the Attorney-general at the end of the declaration is, that the patent, *and the enrolment of it*, may be cancelled, vacated and disallowed, *and that the patent may be restored into Chancery there to be cancelled.*

Upon verdict for the Crown, something to be done which cannot be done in Queen's Bench.

It is evident from what has been stated, that there is something to be done by the judgment in the action which cannot be done in the Queen's Bench, and can only properly be done in Chancery; and it is, therefore, to be inferred from the nature of the case, and independent of all other authority, that after the issues have been properly tried, and a verdict found for the Crown, the record of the verdict ought to be remanded into Chancery for the judgment to be given there. Whether it would be necessary to send the record of the verdict into Chancery if the verdict be for the defendant, it is unnecessary

(*n*) Fol. 73, B. pl. 91.

(*o*) In 2 Saund. 27, it is stated by mistake that the new *scire facias* was issued upon the record of the nonsuit.

(*p*) *Ante*, p. 380, and 1 Str. 151.

for the present purpose to enquire, and a case (if there be any such) in which judgment has been given for the defendant in the Queen's Bench after verdict will be no authority against sending the record into Chancery after a verdict for the Crown, for if the defendant is entitled to judgment the judgment renders all further proceedings unnecessary, but if the Crown is entitled to judgment, then there is something further to be done, and respecting which the Queen's Bench has no jurisdiction. It is believed, however, that there is no case in which a judgment has been given by the Queen's Bench for the defendant in a *scire facias* to *cancel* a patent, and upon principle it seems that even when the defendant obtains a verdict upon all the issues in the action, the record of it ought to be sent into Chancery; for in the first place the Queen's Bench has not the record itself but only a transcript, and in the second place, the Crown might possibly be entitled to judgment *non obstante veredicto*, which can only be given in Chancery.

Ample authority that verdict must be sent into Chancery for judgment.

There is, however, ample authority to show that after a verdict in the Queen's Bench in action of *scire facias* to *cancel* a patent, the record of the verdict must be sent into Chancery for that Court to give judgment.

4 Inst. c. 8.

Sir *Edward Coke* in the Fourth Institute (*q*) says, that after the trial has been had in the Queen's Bench, the record is to be remanded into Chancery and judgment given there. If this was intended to apply to all actions in which the records are sent out of Chancery for trial, it is clear that it is a mistake; but it seems also to be clear that there are cases to which this passage in the Fourth Institute is substantially applicable. Thus, if a traverse is taken in Chancery upon an inquisition under a writ *de lunatico enquirendo*, the issue must be sent to the Queen's Bench to be tried, but after trial that Court has no further jurisdiction, and all the ulterior proceedings must be taken in Chancery, into which Court the record must be remanded. And the passage in the Fourth Institute just cited, is also applicable to the remand of the record of a verdict in *scire facias* into Chancery, after a trial in the Queen's Bench.

Sackvill College case.

In the *Sackvill College* case (*r*), in Chancery, Chief Baron

(*q*) P. 80.

(*r*) T. Raym. 178.

Hale said, that upon an issue tried in a *scire facias*, judgment is not given in the Queen's Bench, but the record is to be returned into Chancery.

In Fitzherbert's Abridgment a case is stated (*s*), which seems indeed to be perfectly conclusive to show that a record in *scire facias* may be remanded into Chancery after a trial in the Queen's Bench.

H. 46 Ed. III. The case cited occurred in the forty-sixth of Edward the Third, and as it is most important with reference to this part of our subject, it is deemed advisable to insert here a literal translation of it, which is as follows:—

"In the time of the Father of our Lord the King a certain manor was seized into the King's hands as forfeited to the King, by cause that one R. H., who was seized of the said manor had adhered to the Scots, and the King by his patent gave the said manor to one Randulph de Vuis, in fee, to hold of him and his heirs. And R. died, and the manor descended to one R. as son and heir, who died his heir within age, by which one R. Dacr, of whom the manor was anciently held, seized the ward, and by *diem clausit extremum* returned in Chancery, all this matter is found, and R. Dacr, ousted of ward, upon which he sued petition in Parliament, setting forth all this matter, and that before the forfeiture the manor was held of him and his ancestors, and prayed that the charter of the King be repealed; and it was sent into Chancery, and upon that a *Scire Facias* issued against the heir and his friends, if they knew any thing to say for maintaining the Charter of the King. And it was returned that they were warned and did not appear, upon which the Serjeants of the King maintained that it (the manor) was held of the King before the forfeiture, and not of R. Dacre, and the other (R. Dacr) the contrary. And this record was sent into the King's Bench, and found by the Inquest of *Nisi Prius* (by letters of Privy Seal) (*t*) for the Demandant. And because that the Charter was in the Chancery all was remanded, and he prayed that the charter be repealed; and some of the justices were of opinion by cause that it came to the King by forfeiture, that it shall be held of him immediately, and well debated: and at last it was assented that the charter should be repealed, and that he should have a new charter, to hold of the chief Lord of the fee, and that there should be restitution of the ward, &c., *quod nota bene, &c.*"

Fitzherbert's Abridgment is a book of the highest authority in our law, and the case which has been cited from it seems to be conclusive to show that a record may be remanded into Chancery after a verdict in the Court of Queen's Bench. And when it is considered that upon a verdict for the Crown, there are several things to be done, which the Lord Chancellor only can do, and respecting which the Queen's Bench

(*s*) Title "Petition," pl. 19.

(*t*) There could be no *nisi prius* in such a case, without the King's writ or Attorney-general's warrant, vide *ante*, p. 407.

has no jurisdiction whatsoever; namely, to cancel the patent by taking the Great Seal off it,—to cancel the enrolment in the manner described by *Coke* (*u*),—and enter a *vacatur* on the roll; it seems to be difficult to come to any other conclusion except this, that the record of the verdict must be sent into Chancery for judgment to be given there (*x*). And, indeed, as the Queen's Bench never has before it anything more than a transcript of the Chancery record, and that merely for the purpose of trying the issues, it seems to be impossible to come to the conclusion that any judgment can be given in the Court of Queen's Bench.

And a case is stated in Rolle's Abridgment (*y*), which is not only an authority for sending the record of the verdict into Chancery for judgment, but also furnishes us with the form in which the record is to be sent into that Court. The following is the statement of the case, *viz.*—"That a manor was held of a barony of a common person, and the manor being forfeited to the King, he granted it to another to hold of himself, instead of the capital lord of the fee. That there was a petition that the charter be amended, upon which there was a plea in Chancery, and found by the escheator and by a jury in the King's Bench to be true;"—and an entry appears to have been made to the effect that,—"*because the giving of judgment upon the verdict, and execution of the judgment, belonged to the office of Chancellor, the verdict was sent into Chancery and a day given to the parties there.*" 38 Ed. III.

In accordance with the authorities here stated, the record of the verdict upon a *scire facias* was sent out of the Queen's Bench into Chancery, in the case of *The Queen* v. *Nichels* (*z*), and judgment given there for the Crown to revoke and cancel the patent, and to cancel the enrolment (*a*). A writ of error was brought upon that judgment returnable in the House of Lords, but no objection was taken in Chancery, R. v. Nichels.

(*u*) 4 Inst. 88.

(*x*) See the petition of the Commons to the King (45 Edw. III.) stated in 1 Rolle's Abr. tit. Chan. (F.) pl. 1, p. 372, "That no plea be thenceforth pleaded in Chancery unless the King be properly a party in the said plea, or *that the plea touch the office of the Chancery.*"

(*y*) 1 Ro. Abr. 534, (G.) Courts Bank le Roy.

(*z*) MS.

(*a*) It is stated in Corner's Crown Practice, p. 202, that the original Queen's Bench record was removed; but that is a mistake, it was a transcript only, the writer having seen and examined both the original record and the transcript.

to the regularity of the proceedings, nor was the want of authority in the Court of Chancery to give the judgment assigned for cause of error in the House of Lords.

It has however been contended, that judgment after verdict for the Crown *may* be given in the Court of Queen's Bench; but the cases relied on are not sufficient to show that that Court can give judgment to *cancel* a patent, and the enrolment of it (*b*).

Digges' case.

In *Digges'* case (*c*), the *scire facias* commanded the sheriff to warn the grantees named in a patent (*d*) to appear in Chancery to inform the Queen and her council wherefore the Queen's hands ought to be removed from lands, but nothing is said respecting either the revoking or cancelling the patent. And although judgment was afterwards given for the defendant in the Queen's Bench (*e*), yet the case is no authority on this subject, for no question could have been there raised respecting the cancelling of the patent, or the enrolment of it.

Mark Steward's case.

In *Mark Steward's* case (*f*), it appears that by letters patent the office of Serjeant-at-Arms had been granted to Mark Steward, who was to be attending upon the Lord Chancellor for the time being. An inquisition was afterwards taken for seizing the office into the hands of the Queen, under which it was found that Mark Steward did serve the office according to the patent, but absented himself during the time specified in the inquisition. Mark Steward traversed this inquisition, and pleaded the Queen's leave of absence during the time mentioned in the inquisition, upon which issue was joined and the record was sent into the Queen's Bench for the issue to be tried. A special verdict was given, and upon argument in the Court of Queen's Bench, judgment was given by that Court for Mark Steward, that he be restored to his office, &c. It will be observed that in this case there was nothing to be done which could not be as well done by the Queen's Bench as the Chancery, no question respecting the cancelling of the patent could have been raised, and therefore the case furnishes no authority in favour of the assertion that the Queen's Bench can give judgment to *cancel* a patent, and the enrolment of it.

(*b*) See 6 M. & G. 256, n. (a).
(*c*) 1 Co. R. 157, a.
(*d*) *Ibid.* 160, b.
(*e*) *Ibid.* 172, b.
(*f*) 9 Co. R. 99, b.

The only case in which a judgment in *scire facias* to revoke a patent has been signed in the Queen's Bench is *Sarnefield's* case, which is cited in *The Prince's* case, reported in Coke's Reports (*g*). It appears that in *Sarnefield's* case a *scire facias* was issued upon the petition of the Prince of Wales as Duke of Cornwall against Sarnefield and his wife, to repeal a *grant* made by King Richard the Second, and confirmed by King Henry the Fourth, of a manor in the county of Cornwall, to Sarnefield and his wife for their lives: and to have the manor seized into the hands of the King, as parcel of the Duchy, &c. Sarnefield being dead, his wife appeared and pleaded the grant of Richard the Second to her for her life, and prayed in aid of the King, and had it, and the Courts gave day, &c. And the Prince at the day brought a *procedendo in loquela*, and thereupon the defendant made default; and the Prince afterwards brought a *procedendo ad judicium*, upon which the Court of King's Bench gave judgment to revoke the patent, *and to seize the manor into the hands of the King, &c.* Sarnefield's case.

The object of the suit in *Sarnefield's* case, however, was to have the manor re-seized into the hands of the King; and it was necessary only to *revoke* the *grant*, in order to enable the Court to give judgment. But the Court of King's Bench did not in that case give any judgment for *cancelling* the patent, nor did they deal with the patent in any other way than by revoking it, or more correctly speaking, the *grant* it contained, in order to enable them to give judgment as commanded by the writ of *procedendo*.

It is to be observed, that the judgment in *Sarnefield's* case having been obtained by default, the case cannot be considered as one of great authority. And if the form of judgment given by the King's Bench in that case be compared with the form of a judgment in *scire facias*, in Chancery, as stated by Coke (*h*), the great difference between the two cases will be seen at once. In *Sarnefield's* case, the judgment was merely to revoke and annul the patent, nothing being said about cancelling the patent or the enrolment; but the form of a Chancery judgment is not only to revoke the patent, but to cancel it, and also to cancel and quash the enrolment. The difference

(*g*) Part 8, p. 23, a.

(*h*) 4 Inst. 88.

between the two jurisdictions is indeed apparent from the different way in which *Coke* speaks of the two Courts. He says (*i*), that *a scire facias* to *repeal* a patent may be brought in the King's Bench (*k*); but speaking of the Court of Chancery, he says, that the highest point of the Lord Chancellor's jurisdiction is "to *cancel* the King's letters patent under the Great Seal, and damning the enrolment thereof by drawing strikes through it like a lettice."

Judgment must be given in Chancery.

It appears, therefore, that there is authority for judgment being given by the Court of Chancery in a *scire facias* to *cancel* a patent, but none for giving such a judgment in the Queen's Bench; and as we have seen that the object of an action of *scire facias*, such as those now under consideration, is to cancel a patent, and the enrolment of it, which cannot be done by the Queen's Bench, or by any other authority, except the Lord Chancellor, as the sole Judge of his Court (in Common Law matters); it seems to be impossible to resist the conclusion that judgment in such an action must be given in Chancery and not elsewhere.

How to send the record of verdict into Chancery.

In order to send the record of the verdict into Chancery, the attorney of the prosecutor or defendant must make up the Queen's Bench record, by entering the *postea* upon it, after which must be entered a day given to the parties to be in Chancery, and a remand of the record into Chancery (*l*). A complete transcript of this record is then to be made, and both the record and the transcript are to be taken to the Crown Office to be numbered and stamped. The *nisi prius* record must at the same time be produced with the *postea* upon it, and the clerk at the Crown Office will indorse on that record, "Verdict recorded, and sent into Chancery for judgment," and then make a corresponding entry in his book. The Queen's Bench record is then to be taken into the treasury of that Court, and the transcript to the Office of the Petty Bag.

Nisi prius record when obtained.

The *nisi prius* record cannot be obtained until after the fourth day of term, and if a rule *nisi* for a new trial should be obtained, that record cannot be obtained until after the rule has been disposed of. The appearance of the parties on the

(*i*) 4 Inst. 72.
(*k*) See on this subject, *ante*, p. 381.
(*l*) See the Form in the Appendix, Chap. II. s. 7.

first day of the term next after the trial is always recorded in the Queen's Bench, and the proper day to give them to appear in the Court of Chancery, is the day after the motions for new trials have been disposed of, namely, the fifth day of the term; any other day in term may, however, be given. If a rule for a new trial has been obtained and discharged, proper continuances must (if necessary) be entered on the Queen's Bench record, prior to the entry of the sending of the record into Chancery.

Day to be given in Chancery.

Proceedings in Chancery after a Trial of the Issues by a Jury.

The King's Bench record of the verdict, and of all things done respecting the trial, is brought into Chancery in the same way as it is taken into the Queen's Bench, that is, in contemplation of law, by the proper hands of the Lord Chief Justice, no writ being necessary for this purpose, both Courts being supposed to be held in one place, that is, before the Queen herself (*m*). The record is however, in practice, brought into the Petty Bag in Chancery, by the attorney of the party seeking to obtain the judgment of the Court.

No writ necessary for taking the record into Chancery.

Upon the record of a verdict coming into Chancery, the whole of the proceedings in the Queen's Bench are entered upon the Chancery record; and the party entitled to judgment may then sign it in the Petty Bag Office, no rule being necessary for that purpose.

Judgment how signed.

If the Crown has obtained a verdict upon any issue by which sufficient matter appears to entitle the Crown to judgment, the judgment entered is, "That the said letters patent of our said Lady the Queen, so as aforesaid granted to the said, W. N., be revoked, cancelled, vacated and disallowed, annulled, void and invalid, and be altogether bad and held for nothing, and that those letters patent be restored into the Chancery of our said Lady the Queen, here to be cancelled, and also that the enrolment thereof be cancelled quashed and annulled" (*n*).

Judgment for the Crown.

But if the defendant has obtained a verdict upon *every* issue

Judgment for defendant.

(*m*) See 10 Edw. III. fol. 59, pl. 62.

(*n*) 4 Inst. 88.

he will be entitled to judgment, the form of which will be, "It is considered and adjudged by the same Court here, that he the said A. B., do depart hence without day in this behalf."

Motion in arrest of judgment, or for judgment *non obstante.*

If the prosecutor has obtained a verdict, the defendant may, however, move the Court (before the Lord Chancellor) in arrest of judgment; and if the defendant has obtained a verdict, the prosecutor may in like manner move for judgment, *non obstante veredicto*; and if it is intended to move the Court in that way, the party intending to move, ought to apply to the Master of the Rolls to stay the entry of the judgment, until he has had an opportunity to make the motion.

It is usual for the party signing the judgment to furnish the clerk of the Petty Bag with a draught of the intended judgment, which he will examine, and if approved of, he will enter it upon the record. Care ought to be taken to enter proper continuances when necessary.

Effect of judgment for the Crown.

The effect of a judgment for the Crown in an action of *scire facias* is to render the defendant's patent wholly void, and therefore the judgment may be pleaded in bar of any subsequent proceedings on the patent (*o*).

How the judgment is to be executed.

The prosecutor having obtained the judgment of the Court to have the patent and the enrolment cancelled, it only remains to have execution done upon the judgment by actually cancelling those two records.

Patent ordered to be restored into Chancery.

The defendant is in contemplation of law in Court at the time of giving judgment for the Crown, and must therefore be taken to be perfectly aware of the effect of the judgment. The patent was originally delivered out of Chancery to the patentee as his evidence of a grant made to him by the Crown, but by the judgment the grant is revoked, and the patent is ordered to be restored into Chancery to be cancelled, so that the patentee may not have it in his power to give any evidence of a grant which has been revoked, and has ceased to have any operation.

Defendant being in Court no writ necessary.

The defendant being in Court when he is commanded by the judgment to restore the patent into Chancery, no process is necessary (*p*), unless he refuses to bring in the patent. In

(*o*) Bro. Abr. Pat. pl. 23, Sci. fa. pl. 138, 131.

(*p*) Vide 1 Ventr. 173, and *Lawrence* v. *Martin*, 1 Salk. 7.

order to procure the patent and enrolment to be cancelled, the prosecutor must, after the entry of the judgment, make an entry upon the Chancery record, of a day given to the defendant to bring in the patent (*q*), and the day ought to be a real day in term, when the Lord Chancellor hears motions. Care must be taken to fix the day given so that a sufficient notice of it may be given to the defendant (*r*). The prosecutor ought to instruct counsel to appear for the Crown on the day appointed, when, if the defendant appears, and produces the patent, the prosecutor's counsel will move to have it and the enrolment cancelled in pursuance of the judgment, and a *vacat* or *vacatur* entered on the roll:—if the defendant appears, but does *not* produce the patent, the motion will be that the defendant stand committed for his contempt in not restoring the patent into Chancery in pursuance of the judgment (*s*). The defendant may, however, show cause why the judgment should not be carried into execution, as that a writ of error has been sued out, or is intended to be sued out; or he may ask for further time to answer the application, or to bring in the patent, and any reasonable length of time will be given if the Court thinks it necessary.

Day to bring in the patent.

Motion to cancel patent, or commit defendant for contempt.

Defendant may show cause.

If the defendant can show that he has not either the possession of or any control over the patent, the Court will not construe his conduct to be a contempt, for he cannot be required to do that which is impossible (*t*).

Excuse for not bringing in patent.

If the defendant fails to appear in pursuance of the notice, upon the day given to him on the record, the counsel for the Crown must move for a rule, or order *nisi*, calling upon the defendant to show cause why an attachment should not be issued against him for contempt.

Motion for attachment.

If the patent belongs to a corporation, it seems that a *distringas* is the proper process to compel them to bring it in to be cancelled (*u*).

When the patent is brought in by the defendant, it must be cancelled by the Lord Chancellor, or one of his officers in his presence, for the Master of the Rolls has no jurisdiction

Patent to be cancelled by the Lord Chancellor.

(*q*) See the Form of Entry in the Appendix, Chap II. s. 7.

(*r*) See the Form of Notice in the Appendix, Chap. II. s. 7.

(*s*) See *R.* v. *Cary*, 1 Vern. 131; 1 Eq. Cas. Ab. 129, *S. C.*; *Clarke's* case, 2 Q. B. Rep. 619.

(*t*) *R.* v. *Newton*, not yet reported.

(*u*) 11 Co. R. 74, a.

over the patent, and it cannot be properly cancelled by any less authority than that of the Judge by whom it was made (*u*). The cancellation is effected by cutting or tearing the Great Seal from the instrument.

Enrolment to be cancelled.

The enrolment of the patent must also be cancelled and vacated in pursuance of the judgment. To do this it is necessary to obtain the order of the Lord Chancellor, that the enrolment be cancelled and a *vacatur* entered on the roll upon which the patent is enrolled, and that the proper officer attend the Master of the Rolls with the roll for that purpose.

Enrolment how cancelled.

Sir *Edward Coke* says (*x*), that the cancelling or "damming" the enrolment is done by "drawing strikes through it like a lettice,"(*y*) and this is done under the direction of the Master of the Rolls, as keeper of the records of the Court, and he signs his name in the margin of the roll opposite the enrolment of the patent which is to be cancelled, after which the enrolment is cancelled and the *vacatur* is entered in the margin of the roll, thus:—

Vacatur.

"Cancelled this Enrolment by order of the Lord Chancellor, dated the day of *A. D.* 18 , in pursuance of the Judgment,—our Sovereign Lady the Queen against in the Petty Bag. Therefore on the day of *A. D.* 18 the letters patent and this Enrolment thereof are vacated."

Patent ought to be cancelled before the enrolment.

It seems also that the patent ought to be cancelled, or something equivalent to the cancelling of it should be done before the enrolment is cancelled. For, at any time before the patent is actually cancelled, the defendant may be enabled to get the judgment vacated or reversed, and therefore it seems to be but proper that the patent should be actually cancelled, or that some proceeding should be taken to compel the defendant to bring in the patent before the enrolment is cancelled.

Defendant will be excused if he is unable to restore the patent.

But a defendant cannot be compelled to do that which is physically impossible (*z*), as if he being merely a trustee for another delivered the patent over to his *cestui que trust*, before the action commenced, and is unable to procure the restoration of it into Chancery in pursuance of the judgment; and in such a case if the defendant will undertake to bring no writ of error, or do any thing to vacate the judgment, he will

(*u*) See 4 Inst. 88, and 10 Co. R. 67, b.

(*x*) 4 Inst. 88.

(*y*) Semble, "lattice."

(*z*) Per Lord *Lyndhurst*, L. C., in *R.* v. *Newton*, not yet reported.

be excused, until he shall (if ever) be enabled to restore the patent as commanded by the judgment.

Thus, in the recent case of *The Queen* v. *Newton* (*a*), it appeared upon a motion that the defendant stand committed for not bringing in the patent, that it was in the custody of the defendant's *cestui que trust*, who resided abroad, and that the defendant had in vain endeavoured to procure the restoration of it, and was therefore unable to obey the command given to him by the judgment of the Court. The Lord Chancellor held, that under these circumstances, if the defendant would undertake that he would not assign the patent, bring any writ of error, or do any act to defeat the judgment, he ought to be excused, and having given the required undertaking, he was accordingly excused from *then* restoring the patent into Court. R. v. Newton.

But a defendant is not, by being thus excused, wholly exempted from the duty of restoring the patent into Chancery, for he may afterwards obtain possession of it, and in that case he ought to bring it into Court in pursuance of the judgment. Defendant not absolutely excused.

In the case of *The Queen* v. *Newton*, just cited, the defendant being unable to restore the patent, the Lord Chancellor ordered that the enrolment should be cancelled without the previous cancelling of the patent, and that a *vacatur* should be entered on the roll, which was done accordingly, the defendant having further day given him to bring in the patent, until he should be able to do so. R. v. Newton. Enrolment cancelled and further day given to defendant.

The enrolment of the specification of a patent is not affected by the proceedings in *scire facias*, but will remain of record for the benefit of the public, notwithstanding the repeal and cancelling of the patent. Enrolment of specification not affected.

If the defendant obtains a writ of error to reverse or vacate a judgment for the Crown, all proceedings for the cancelling of the patent and enrolment will be stayed until judgment shall have been given upon the writ of error. When, if the judgment be affirmed, the patent enrolment must be cancelled in the way already stated. Writ of error *stays execution*.

For errors in process, or errors of fact, in this action after judgment in Chancery, the party may have a writ of error, *coram nobis in Cancellaria*, in the same way as a party can Writs of error. Error in fact.

(*a*) Cor. Lord *Lyndhurst*, L.C., assisted by Lord *Langdale*, M. R., not yet reported.

have a writ of error, *coram nobis*, upon a judgment in the Queen's Bench (*a*). But in cases where process issues out of Chancery, *returnable in the Queen's Bench*, as an execution upon a statute merchant (*b*), such a writ of error must be made returnable in the Queen's Bench.

Errors in law.

For errors in law in the Court of Chancery, a writ of error must be returnable in Parliament (*c*). And in addition to the authories cited below, the M. S. register of the cursitors, which is now in the custody of the clerk of the Petty Bag, shows that such a writ can only be made returnable in Parliament (*d*).

4 Inst. c. 8.

It is said by Sir *Edward Coke* (*e*), that upon a judgment given in Chancery, a writ of error lies returnable in the Queen's Bench. There are also several *dicta* to the same effect to be found in other books and cases (*f*), but there is no satisfactory authority in favour of such a position, for all the cases cited in support of it are cases in which the errors assigned were errors in fact or in process (*g*).

R. v. Cary.

In the case of *Rex* v. *Cary* (*h*), it was moved that the defendant be at liberty to bring a writ of error in the King's Bench, for which was cited Dyer, 315, and 4 Inst. 80. But Lord Keeper *North* said, all the books were founded only on the single opinion of Lord *Dyer* and though he thought the jurisdiction of Chancery even on the Latin or Common Law side not subjected unto, or to be controlled by the King's Bench, he would enjoin all such writs of error.

3 Bl. Com. c. 4, p. 49.

Speaking of this case *Blackstone* says in a note (*i*), the opinion of Lord Keeper *North*, that no such writ of error lay seems not to have been well considered. But the authorities which have been cited, show that Lord Keeper *North* was quite correct in what he stated; and, indeed the form of the writ of error given in the register shows conclusively that the

(*a*) 42 Ass. fol. 262, pl. 22; Bro. Abr. Error, pl. 131.

(*b*) 18 Edw. III. fol. 25, pl. 17; 17 Ass. 24; 29 Ass. 47.

(*c*) Bro. Abr. Error, pl. 95-131; Jurisdic. pl. 53; 37 Hen. VI. 13 & 14; 11 Edw. IV. 9, a.; 1 Ro. Abr. 745, l. 4.

(*d*) See the case of *The King* v. *Butler*, 2 Ventr. 344, and 3 Lev. 220, in which the writ was made returnable in Parliament, and all the Judges appear to have attended the argument.

(*e*) 4 Inst. 80.

(*f*) 3 Bl. 49; Dyer, 315; 1 Ro. R. 287.

(*g*) 17 Ass. pl. 24; 29 Ass. pl. 47; 18 Edw. III. 25.

(*h*) 1 Vern. 131; 1 Eq. Cas. 129 *S. C.*

(*i*) 3 Com. p. 49.

writ must be returnable in Parliament, and the forms in the register can only be altered by Act of Parliament (*k*).

See also the cases and authorities cited in Macqueen's Practice of the House of Lords, p. 369 to 371.

In order to obtain a writ of error in this action, the Queen being a party, it is necessary to obtain the Attorney-general's warrant for the issuing of the writ, which is always granted as of course. How to obtain a writ of error.

If the writ of error is to be returnable in parliament, (as it must be for an error in law,) a warrant must also be procured from the Secretary of State in order to authorize the issuing of the writ. The writ is prepared by the clerk of the Petty Bag, and the Master of the Rolls being the keeper of the records of the Court, the writ must be directed to and allowed by him.

It is unnecessary to state more here respecting the practice upon such writs of error; it is the same in this action as in other cases (*l*).

It is a general rule that the Queen neither pays nor receives costs in any action in which she is a party. There are indeed some exceptions to this rule, but none of them apply to a *scire facias* to repeal a patent. And the statutes 8 & 9 W. III. c. 11, s. 3, and 3 & 4 W. IV. c. 42, s. 34, relating to costs in actions of *scire facias*, do not apply to this action. No costs therefore can by law be recovered either against the Crown, or the defendant *upon the judgment* in this action (*m*). Costs. No costs recoverable upon judgment in *scire facias*.

But it has already been stated (*n*), that a prosecutor is always required to give security, by bond, to the Chief Clerk of the Petty Bag for payment of the defendants costs if he obtains a verdict and judgment in the action (*o*). Bond for payment of costs.

There is no instance however of the bond having been enforced, and it seems that the defendant would not be entitled as of right to the benefit of it, for the law, as we have seen, does not entitle him to costs in the action. If, therefore, a defendant obtains a verdict upon every issue, and consequently judgment in the action, it seems (the bond being taken in pursuance of the Attorney-general's fiat,) that the How defendant is to obtain his costs by suit on the bond.

(*k*) *R.* v. *Hare*, 1 Str. 158.
(*l*) See Macqueen's Practice, Ho. Lo. 361-372.
(*m*) *R.* v. *Miles*, 7 T. R. 367.
(*n*) *Ante*, p. 386.
(*o*) See the Form of Bond in the Appendix, Chap. II. s. 7.

defendant ought to have the Attorney-general's fiat for the payment and taxation of his costs in the action, and for putting the bond in suit, in case they are not paid. And if it should be necessary to sue on the bond, application ought to be made to the Lord Chancellor or Master of the Rolls for leave to sue in the name of the senior clerk (who is one of the officers of the Court,) for the recovery of the costs, which would only be granted upon condition that the defendant indemnifies the senior clerk against all costs and expenses of the intended proceedings on the bond.

Taxation of costs.

If the defendant obtains the necessary authority to recover his costs upon the bond, they must in pursuance of the condition be taxed as between attorney and client, and they are to be taxed by the clerk of the Petty Bag as the officer of the Court.

Costs upon interlocutory proceedings.

Although the parties to an action of *scire facias* to cancel a patent are not entitled to recover costs by the judgment in the action, the Court may, and frequently does award costs to be paid upon interlocutory proceedings.

Thus upon an application to set aside an irregular plea in the case of *R.* v. *Nickels* (*a*), Lord *Langdale*, M. R., granted the application with costs. And in the case of *R.* v. *Craufurd* (*a*), Lord *Lyndhurst*, L. C., refused a motion to rescind an order of the Master of the Rolls, and granted the prosecutor his costs of opposing the motion.

And in the case of *R.* v. *Bewdley* (*b*), the Court of Queen's Bench granted a new trial to the defendants on payment of costs.

Enforcement of orders for payment of costs under stat. 1 & 2 Vict. c. 110, s. 18.

It seems that interlocutory orders of the Lord Chancellor, or Master of the Rolls, for the payment of costs, may be enforced under the statute 1 & 2 Vict. c. 110, s. 18. The order of the Lord Chancellor, who is the sole Judge of the Court of Chancery, is in fact a rule of the Court, and the order of the Master of the Rolls may be made a rule of the Court, in the same way as the order of any Common Law Judge may be made a rule of Court. If, therefore, the Lord Chancellor, or Master of the Rolls, orders a party to pay costs, it seems that payment may be enforced under the provisions of the statute just cited, by making the order

(*a*) Not reported.

(*b*) 1 P. Wms. 224.

(when necessary) a rule of Court, and by entering the rule of record in the Court.

Section VII.

Of the Revocation of a Patent by the Queen or Privy Council.

Every patent contains a proviso (*m*), which makes the grant it contains revocable by the Queen, or by any six of her Privy Council, for certain causes which are mentioned in the proviso. Patent is revocable.

The causes for which a patent may be revoked are stated in the proviso to be, if the grant is contrary to law, or prejudicial or inconvenient to her Majesty's subjects; or, if the invention was not new, or not invented by the patentee. Causes for revocation.

These grounds for revoking a patent are in fact such as would render it void as contrary to law, and they include all the objections which may be taken to a patent, either in an action for an infringement of it (*n*), or in a *scire facias* to repeal it (*o*), except the non-performance of the proviso requiring the enrolment of a specification. Grounds for revoking are that the patent is illegal.

If a patent is void for any cause, the ordinary remedies for the Crown or the public, are only available by pleading and proving the cause of invalidity in a Court of justice, and that at a very great cost. But by this proviso the Queen or her council may declare the cause of invalidity, and the declaration will of itself have the effect of revoking or avoiding the patent, and of course of rendering all further proof than the declaration itself unnecessary. Great cost of avoiding a patent at Law.

The grant of a patent is a matter of grace and favour, and therefore as we have seen (*p*), the Crown may annex any conditions it pleases to the grant, and this condition seems to have been inserted with the view of enabling the Crown to determine any illegal grant which may be unadvisedly made, without allowing the public to be put to the trouble or cost of resisting the unlawful patent. Object of the *proviso*.

The revocation may be either by the Queen herself, or by Revocation how made.

(*m*) Stated in Chap. IV. *ante*, p. 62.
(*n*) Vide *ante*, p. 266.
(*o*) Vide *ante*, p. 389.
(*p*) *Ante*, p. 61.

six or more of her Privy Council; if by the Queen herself, the signification or declaration must be either under the signet, or the Privy Seal; if by the Privy Council, then the declaration must be under the hands of six or more Privy Councillors.

No instance of a revocation in modern times.

It is probable that it was under this or a similar proviso that Queen Elizabeth was enabled to recall the patents for monopolies which were found to be so grievous to the public during her reign. There is no instance in modern times of the determination of a patent under this proviso, but there can be no doubt that the power it confers would be exercised if a case should arise calling for such an extraordinary interference of the Crown for the protection of the public.

CHAPTER XI.

OF THE EVIDENCE TO BE GIVEN IN ACTIONS RESPECTING LETTERS PATENT.

SEC. I.—*In Actions for the Infringement of Letters Patent.*
II.—*In Actions of Scire Facias to Repeal Letters Patent.*

SECTION I.

Of the Evidence in Actions for the Infringement of Letters Patent.

1st. *Of the Burthen of Proof.*
2nd. *Of the Competency and Examination of Witnesses.*
3rd. *Of the Evidence to be given under each of the Issues in an Action for an Infringement.*

1st. *Of the Burthen of Proof.*

Burthen of proof generally upon the plaintiff.

1. THE burthen of proof at the trial is upon the plaintiff, as to almost all of the issues generally raised in an action for the infringement of a patent.

What plaintiff was compelled to prove under not guilty before the new pleading rules.

2. Before the making of the new pleading rules (*a*), all the evidence admissible in a patent action, was given upon the issue raised on the plea of not guilty. And that plea always compelled a plaintiff to prove the patent grant alleged in the declaration, that the patentee was a person capable as the inventor or importer of the invention to sustain the grant; that the invention possessed novelty and all the other qualities requisite to make it the valid subject of such a grant; that the patentee had sufficiently complied with the proviso requiring a specification; and lastly that the defendant had infringed the patent privilege (*b*).

(*a*) R. G. H. T. 3 W. IV. 1834. See Charnock's New Rules, p. 125.

(*b*) See the cases of *Turner* v. *Winter*, 1 T. R. 602; *Manton* v. *Manton*, Dav. P. C. 348; *Minter* v. *Wells*, 1 Webs. R. 129, 130.

Not guilty now denies the infringement only.

3. By the new pleading rules just mentioned, the effect of the plea of not guilty has been narrowed so as to amount only to a denial of the alleged infringement, and consequently the evidence in support of any objection which the defendant intends to take to the patent, must be given under the plea of *non concessit* or some special plea stating the particular cause for invalidating the patent upon which the defendant intends to rely. It was not intended by the new pleading rules, however, to make any alteration respecting the burthen of proof upon any matter in contest between the parties, but merely to confine the evidence at the trial to the particular matters which the defendant shall put in issue by special pleas.

Evidence of objections must now be given under special pleas.

New pleading rules not intended to shift the burthen of proof.

If *non concessit* is pleaded the plaintiff must give the patent in evidence.

4. If, therefore, the defendant does not plead *non concessit*, the plaintiff need not give the patent in evidence, for it is admitted, or what is the same thing for the purposes of the cause, it is not denied; but if that plea is pleaded the patent grant must be proved in the same way as it would have been formerly, under the plea of not guilty.

If plaintiff's title is denied in any other way, he must prove a *primâ facie* case.

5. If the defendant does not plead any plea, putting the patentee's title in issue as inventor or importer, it will be admitted; but if it be put in issue the plaintiff must prove a *primâ facie* case in support of his title. The same observation also applies to other questions respecting the validity of the patent; thus, if the novelty or utility of the invention, or the sufficiency of the specification, be put in issue by the defendant, the plaintiff will be compelled to give *primâ facie* evidence in support of his patent.

Notice of objections does not alter the burthen of proof.

6. Nor does the notice of objections required by the statute 5 & 6 Will. IV. c. 83, s. 5, make any alteration respecting the person upon whom the burthen of proof is cast on any issue to be tried between the parties. The effect of that enactment is indeed merely to entitle a plaintiff to more specific notice of the defendant's objections to the patent than are afforded by the pleas. But if the defendant by his notice takes objections to the patent on the grounds that the patentee was not the inventor, that the invention was not new or useful, or that there was no sufficient specification, the plaintiff must give sufficient *primâ facie* evidence in

support of each issue (if any) to which the defendant's objections are applicable (*c*).

2nd. *Of the Competency and Examination of Witnesses.*

(*a*) Of the Competency of Witnesses—(*b*) Of the Examination of Witnesses.

(*a*) *Of the Competency of Witnesses* (*d*).

1. The statute 6 & 7 Vict. c. 85, has made a most important alteration of the law respecting the competency of witnesses. By sect. 1 of that statute, it is enacted that no person offered as a witness, shall be excluded by reason of incapacity from crime or interest from giving evidence on the trial of any issue, joined in any suit, action or proceeding, civil or criminal, in any Court, &c., but that every person so offered shall be admitted to give evidence, notwithstanding that he may have an interest in the matter in question or the event of the trial, or of the suit, action or proceeding in which he is offered as a witness, and notwithstanding that he may have been convicted of any crime or offence. But it is provided that the Act shall not render competent any party to the suit individually named in the record, or any person in whose immediate and individual behalf any action may be brought or defended, either wholly or in part, or the husband or wife of such persons respectively. 6 & 7 Vict. c. 85. Sec. 1.

2. If a patentee has assigned the whole of his interest in his patent, there can be no doubt that he is a competent witness for the assignee in any action he may bring for an infringement of the patent (*f*). If the patentee has entered into covenants with the assignee respecting the validity of the patent, he may have an interest in the event of any action in which the validity of the patent comes in question. But in such a case it is conceived that the statute 6 & 7 Vict. c. 85 (*g*), would prevent the testimony of the patentee from being excluded, although his interest in the event would be a Competency of a patentee who has assigned his patent.

(*c*) See further as to the Notice of Objections, *ante*, Chap. X. s. 2, p. 284.

(*d*) It is only intended here to state the points relating to this subject which are peculiar to patent actions.

(*f*) Gamble, the patentee, was examined as a witness in *Bloxam* v. *Elsee*, 1 C. & P. 563.

(*g*) See the Statute in the Appendix, Chap. I. s. 1.

matter for the jury to take into consideration as tending to affect his credit.

Competency of licensee.

3. A licensee of a patent invention is also a good witness for the plaintiff in an action for an infringement of the patent.

Derosne v. Fairlie.

This was decided in the case of *Derosne* v. *Fairlie* (*h*), but it does not appear from the report of the case what description of licence the witness had obtained, it is merely stated that he had purchased a licence.

The interest of a licensee to support or defeat a patent.

4. If a licensee is empowered by his licence to use the invention in consideration of a periodical payment or rent, or a payment of a licence duty in proportion to the extent of his user of the invention; he can have no interest to *support* the patent unless the payments reserved by the licence are merely nominal, or not a full consideration for the privilege granted. Such a licensee may, however, have an interest in the *destruction* of the patent, but not any greater interest than any other of the public, unless indeed he has improvidently covenanted to pay a larger amount of licence duty than the licence privilege is worth. A licensee who has paid a gross sum of money for an irrevocable licence, or has obtained such a licence for any other consideration, has an interest in supporting the patent, for if the patent privilege be thrown open to the public, his licence can produce him no benefit.

Licensee's interest in the event only affects his credit.

5. These observations are only of importance for the purpose of directing attention to the *extent* of the interest which a licensee may have in the event of an action for an infringement so as to affect his credit as a witness, for it is clear that the statute 6 & 7 Vict. c. 85 (*i*), renders a licensee a competent witness in such an action, unless indeed the action be brought or defended for his immediate benefit. Thus, if a person had an exclusive licence for some particular district, and an action was brought by the patentee for his benefit, against a party infringing the patent within the district comprised in

But if the action is brought for a licensee's immediate benefit he is incompetent.

the licence; the licensee could not be a competent witness, for he would come within the meaning of the exception contained in the first section of the statute as being the person "in whose immediate and individual behalf" the action was brought (*i*).

(*h*) 1 Mo. & Rob. 457.
(*i*) See the Statute in the Appendix, Chap. I. s. 1.

(*b*) *Of the Examination of Witnesses* (*k*).

A drawing not made by the witness, may be put into his hand, and he may be asked if it correctly represents a machine *which he has* made.

1. Upon the examination of a witness to prove that an invention was not new, the witness proved that he had long before the date of the patent constructed a machine for the same purposes as the patent machine. A drawing, said to be a drawing of the witness's machine was produced, but the drawing had not been made by the witness, and it was objected for the patentee that the witness ought not to look at the drawing, but should describe the machine he had constructed. Mr. Justice *Bayley*, however, held that the witness might look at the drawing, and might be asked whether he had such a recollection of the machine he had made as to be able to say that the drawing was a correct representation of it (*l*).

Bloxam *v.* Elsee.

Witness cannot give evidence of what a person (under whom plaintiff claims) said respecting the contents of a deed.

2. In the case of *Bloxam* v. *Elsee* (*m*), it was proposed to ask a witness whether he did not learn from a person under whom the plaintiffs claimed title to their patent something respecting the contents of a deed; but Lord *Tenterden*, C. J., overruled the question, and held that no question could be asked as to what had been said of the contents of a written instrument, or an account of its non-production.

3rd. *Of the Evidence to be given under each of the Issues in an Action for an Infringement.*

Defendant must give a notice of all objections of which he intends to offer evidence.

1. It must be premised that in the following observations respecting the evidence to be given under each issue, it is supposed that the defendant has given a proper notice, embracing all the objections which may be taken under each issue. It has already been shown that the only question which can arise at *nisi prius* respecting a notice of objections is, whether the terms of the notice are sufficient to include any objection in support of which the defendant may tender evidence (*n*), and it seems that the notice of objections is so far to be considered

(*k*) The decisions relating to this subject in patent actions only, are here stated.

(*l*) *R.* v. *Hadden*, 2 C. & P. 184.

(*m*) Ry. & Mo. N. P. C. 187; 1 C. & P. 563.

(*n*) See further respecting the Notice of Objections, *ante*, Chap. X. s. 2, p. 284.

as part of the pleadings, that it ought to be stated or read at the same time that the pleadings are opened (*o*).

Some objections of which no notice need be given.

2. There are, however, some objections which a defendant may take at the trial, and of which it seems that he need not give any notice, as that the patent is not properly stamped (*p*), or that there is a variance between the patent as proved, and as it is set out in the declaration. So it seems that the defendant need not state in his notice that he will object that the act complained of by the plaintiff is no infringement of the patent.

Under an Issue upon a Plea of Non Concessit.

Plaintiff must give his patent or an exemplification in evidence.

1. In support of an issue joined upon the plea of *non concessit*, the plaintiff must prove a grant of privilege by the Crown, as stated in the declaration, either by the production of the patent under which he claims, or by an exemplification or *constat* of the enrolment of it under the Great Seal.

Non concessit by the said letters patent, admits that there is a patent, but denies the effect as stated.

2. When the plea of *non concessit* alleges that her Majesty did not *by the letters patent mentioned in the declaration* make such grant of privilege as in the declaration alleged, the defendant admits that there is *a* patent, but denies that the purport and effect of it is properly stated by the plaintiff (*q*).

3. The plea is sometimes, however, more extensive, and denies generally that the Queen has made such grant of privilege as the plaintiff has stated in the declaration, and the existence of *any* patent seems then to be put in issue (*r*).

Whether defendant can be allowed by plea to deny that there is *a* patent.

4. There is some doubt, however, whether a defendant can, strictly speaking, be allowed by the plea of *non concessit*, or indeed any other plea to deny that there is *a* patent. At the time of declaring, the patent is in contemplation of law produced and shown to the Court (*s*), and it has been seen (*t*) that a patent under the Great Seal being produced and shown to the Court cannot be denied, for the Great Seal proves itself, and therefore it must be apparent to the Court that the instrument produced is a patent, and it seems that the de-

(*o*) Per *Parke*, B., *Neilson* v. *Harford*, 1 Webs. R. 309.
(*p*) *Nickels* v. *Ross*, *Tindal*, C. J.
(*q*) 3 Burr. 1544; *Baddeley* v. *Leppingwell*, and 6 Co. R. 15, b, *Eden's* case.
(*r*) See the Forms in the Appendix, Chap. II. s. 4.
(*s*) Vide *ante*, p. 254, 264.
(*t*) *Ante*, p. 264.

fendant ought not to be allowed to plead a plea which is so manifestly untrue (*u*).

5. The effect of the plea of *non concessit* must, however, be substantially the same, so far as respects the evidence which it compels the plaintiff to give, in whatever form it may be pleaded; for it does not avail a plaintiff anything to have it admitted that there is some patent in existence, when the defendant denies that the plaintiff has stated the purport and effect of that patent. The consequence is that the plea of *non concessit* must always compel the plaintiff to give his patent in evidence at the trial, and in this way the defendant will obtain the same benefit as if he had denied that there was any patent in existence. For when the alleged patent is produced, and tendered in evidence by the plaintiff, the Court is bound to inspect the instrument, and see whether it really is a patent under the Great Seal or not, and if it is not sealed with the Great Seal, it cannot be received in evidence.

Effect of *non concessit* substantially the same in every form.

6. If the patent is produced it is admissible in evidence without further proof, for being under the Great Seal, of which the Courts of law take judicial notice, the seal is sufficient proof that the instrument is what it purports to be.

Patent is admissible in evidence without further proof.

7. At the Common Law no grant by the Crown was available unless it could be proved by production of the patent itself under the Great Seal (*x*). And this rule frequently operated very much to the prejudice of parties claiming under patentees, who were unable to procure the production of the letters patent.

Crown grants not available at Common Law unless proved by the patent.

8. This evil was in some measure removed by the stat. 3 & 4 Edw. VI. c. 4 (*y*), which, however, related exclusively to patent grants of land; but some question arising as to the construction of that statute, it was amended by the Act of 13 Eliz. c. 6 (*y*).

Statute 3 & 4 Edw. VI. c. 4, amended by 13 Eliz. c. 6.

Section 2 of the latter Act in substance provides, that patentees and all persons claiming under them are enabled to make such title to lands, "or other things whatsoever," specified in their letters patent, or any part thereof, by showing forth an exemplification or *constat* under the Great Seal of

13 Eliz. c. 6, s. 2. A patentee enabled to make such title to things specified in his patent by an exemplifi...

(*u*) *Eden's* case, 6 Co. R. 15, b; Plowd. 232.

(*x*) *Lane's* case, 2 Co. R. 16, b; 2 Rol. Abr. 182.

(*y*) See the Statute in the Appendix, Chap. I. s. 1.

tion of the enrolment as if the patent itself shown.

the enrolment of the letters patent (*z*), or so much thereof as shall be necessary, as if the letters patent were themselves pleaded and shown forth.

The statute applies to patents for inventions.

This enactment clearly applies to letters patent for inventions (*a*), and under its provisions a party claiming under a patent, but unable to produce it, may prove the grant of privilege he claims by an exemplification or *constat* of the enrolment of the patent. The Act does not, however, make a copy of the enrolment evidence unless it is exemplified under the Great Seal.

9. An exemplification is so called, because by it the record is exemplified (*b*), and it sets out the whole of the enrolment of the patent. The exemplification does not purport to exemplify the patent, but the enrolment only (*c*).

The patent only proves the purport of the grant it contains.

10. In whatever manner a patent may be proved it only amounts to evidence of the *purport* of the grant it contains, the effect or operation of the grant being quite a different question. And although a patent purports to grant a sole privilege to the patentee, it may be that the grant is for some reason illegal and void, and if so the patent is of no force, and

If patent void *non concessit* may be pleaded.

the grant it purports to make has no operation, and consequently it is in legal language strictly correct to say that the Queen did not make such a grant as the plaintiff alleges in his declaration, for a void grant is the same as no grant at all (*d*).

Non concessit puts the plaintiff to the proof of every thing necessary to support his title.

11. It has been shown in a preceding part of this work that the law imposes certain conditions upon the validity of a grant of a sole privilege in an invention, both with respect to the person of the grantee (*e*), and also the nature of the invention itself (*f*).

And as the plea of *non concessit* puts in issue not only the fact of a grant having in form been made by the Crown, but also all the facts which go to establish the validity of the grant, it is apprehended that (if the notice of objections be sufficient) a plaintiff will be compelled by the plea to give *primâ facie* evidence in support of his title, in the same

(*z*) As to what the enrolment is, vide *ante*, Chap. IV. p. 38.
(*a*) See 5 Co. R. 53, a, 53, b.
(*b*) 5 Co. R. 53, b.
(*c*) See Hardr. 119.
(*d*) As to the nature and effect of the Plea of *non concessit*, vide *ante*, p. 265, 268.
(*e*) *Ante*, Chap. III. p. 19.
(*f*) *Ante*, Chap. V. p. 77.

manner as he would by plea alleging, that he or the patentee was not the true and first inventor or importer of the invention, that the invention was not such an art as might be made the subject of a patent privilege, and that it did not possess the requisite qualities of novelty and utility (*g*).

Non concessit also enables the defendant to prove that the patent is void.

12. And the defendant is at liberty under this plea, not only to show that no such grant has in fact been made, but also to prove facts which are sufficient to invalidate the grant. Thus, the defendant may show that there is a variance between the statement in the declaration, and the patent given in evidence by the plaintiff. That the patent contains a false description of the invention (*h*), or in other words, that the invention is misdescribed by the title which the patentee has given it. So, he may show that the patent bears date on a day antecedent to the delivery of the Privy Seal bill to the Lord Chancellor, which renders the patent absolutely void (*i*). The defendant may also prove that the patent contains a false recital (*k*), or that it was obtained upon a false suggestion or representation (*l*), either of which will be sufficient to avoid the patent (*m*).

Objections are only available under *non concessit* if patent void *ab initio*.

13. But in order to take advantage of the invalidity of a patent under this plea, it must be shown that the patent was void, *ab initio*, and therefore the avoidance of the grant by any matter subsequent to the making of the patent, as for instance the want of a proper specification, cannot be taken advantage of under this issue, but must be specially pleaded.

Patent sufficient to prove the purport of the grant.

14. For the purpose of merely proving the purport of the patent grant as alleged in the declaration, it will be sufficient to give the patent itself in evidence. But if any question should arise under this issue, which renders it necessary to show what the invention is, the plaintiff must give his specification in evidence. Thus, if it be objected by the defendant that the patentee was not the true or first inventor, or that the invention was not new, the plaintiff must give his specifi-

Upon any question respecting the invention the specification must be given in evidence.

(*g*) As to what *primâ facie* evidence, such pleas will compel a plaintiff to give, see the subsequent parts of this Chapter.

(*h*) As to the sufficiency of a title, vide *ante*, Chap. IV. p. 43.

(*i*) 18 Hen. VI. c. 1. Appendix, Chap. I. s. 1.

(*k*) Vin. Abr. Prerog. (Q. b); 1 Co. R. 43, a.

(*l*) 1 Co. R. 43, a; Com. Dig. Grant, (G. 8), (G. 9).

(*m*) Vide *ante*, Chap. IV. p. 42, as to what false recitals and suggestions are sufficient to avoid a patent.

cation in evidence, to prove what the invention is to which the patent applies, and to enable his witnesses to give testimony respecting its novelty at the date of the patent.

Specification to be deemed part of the patent.

15. Although the specification is an instrument under the hand and seal of the patentee only, yet it derives its efficacy as evidence in such a case from the proviso in the patent itself, in pursuance of which it must have been enrolled; and therefore it may for such a purpose be considered as part of the patent itself.

Hornblower v. Boulton.

Thus, in the case of *Hornblower* v. *Boulton* (*n*), Mr. Justice *Grose* said, "I consider the patent and specification so connected together as to make a part of each other, and that to learn what the patent is, I may read the specification and consider it as incorporated with the patent."

Crossley v. Beverley.

So in the case of *Crossley* v. *Beverley* (*o*), which was an action for the infringement of a patent, Mr. Justice *Bayley*, said, "I think the specification and the patent are to be taken as one muniment in enforcing this claim on the part of the patentee, and they only."

Under an Issue upon a Plea alleging that the Patentee was not the true and first Inventor.

Plaintiff must prove that he was the true and also the first inventor.

1. Under a plea that the patentee was not the true and first inventor, the plaintiff must give *primâ facie* evidence (such as the nature of the case admits of) to show not only that he was the true or actual inventor (*p*), but also that he was the first inventor who gave or contracted to give the invention to the public.

Direct evidence of an actual inventing, can only be given by the inventor, who is not a competent witness except in an action by an assignee.

2. Invention is an act of the mind which is incapable of direct proof except by the evidence of the inventor himself, and his evidence is generally inadmissible in an action upon the patent. But when a patentee has assigned over all his interest in the patent privilege, there seems to be no reason why he should not be a good witness to prove that he did actually make the

(*n*) 8 T. R. 98; Dav. P. C. 221.
(*o*) 9 B. & C. 62.
(*p*) As to who may, as an actual inventor, be the grantee of a sole right to use an invention, vide *ante*, Chap. III. s. 2, p. 22.

invention as alleged in the petition recited in the patent. And as it is a rule that a party must produce the best evidence, the nature of the case admits of, it may even be questionable whether an assignee plaintiff is not bound in such a case to prove the affirmative of this issue by the evidence of the patentee himself, if his evidence can be procured.

Inventing indirectly proved by patentee being the first to communicate the invention.

3. In the absence of direct proof, however, it may be shown in support of this issue, that a patentee was the first to communicate a knowledge of the invention to the world, and if there be no proof that he acquired a knowledge of the invention by other means, it is only fair to presume that he was the inventor of it.

Minter v. Wells.

Thus, in the case of *Minter* v. *Wells* (*q*), Mr. Baron *Alderson* held, that the circumstance of the plaintiff being the first to introduce the invention was *primâ facie* evidence that he was the true and first inventor.

And accordingly it is the invariable practice at *nisi prius*, to prove the affirmative of this issue, (the patent being admitted,) first by giving the specification in evidence, and then showing that the invention was new, and unknown to the public at the date of the patent; and this is sufficient *primâ facie* evidence to establish the affirmative of the two propositions which the plaintiff is bound to prove, *viz.*, that the patentee was not only the true or actual inventor, but also the first to give the invention to the public.

An importer may prove a *primâ facie* case in the same way under this issue.

4. If the patentee was not an actual inventor, but merely an importer of the invention from abroad, the plaintiff would *under this form of plea* make a *primâ facie* case in precisely the same way as has been already mentioned, *viz.*, by putting the patent and specification in evidence, and proving the novelty of the invention at the date of the patent.

Defendant may show that patentee was not the true, or not the first inventor.

5. Under this issue the defendant may show that the patentee was not the true or actual inventor, and also that he was not the first inventor, which means the first person to give the public the benefit of the invention; and proof of either of these circumstances will be sufficient to entitle the defendant to a verdict.

Proof that pa-

6. In order to show that the patentee was not the true or

(*q*) 1 Webs. R. 129.

tentee not the true inventor.

actual inventor, the defendant must prove that the patentee acquired a knowledge of the invention from a British subject, or some person residing in this country, or from some other source than his own actual invention or discovery.

Cornish v. Keene.

Thus, in the case of *Cornish* v. *Keene* (*r*), the Lord Chief Justice *Tindal* held, that although the invention was now so far as the world was concerned, yet if it could be shown that the party who got the patent was not the man whose ingenuity first discovered it, that he had borrowed it from *A.* or *B.*, or taken it from a book that was printed in England, and which was open to all the world—then, although the public had the benefit of it, the patentee would not be the true and first inventor.

If patentee borrowed from another or from a book he was not the true inventor.

Tennant's case.

In *Tennant's* case (*s*), a chemist at Glasgow proved, that having frequent conversations with Mr. Tennant on the means of improving bleaching liquor, he had in one of them suggested to Mr. Tennant that he would probably attain his end by keeping the lime water constantly agitated. Mr. Tennant afterwards informed the witness that this method had succeeded. These conversations took place in 1796, and Mr. Tennant obtained his patent in 1798; and in an action which the patentee brought upon the patent, Lord *Ellenborough*, C. J., nonsuited him upon two grounds, one of which was that the chemist had suggested to him the agitation of the lime water (which was indispensable in the process), and therefore that it was not the invention of the patentee.

If any essential part of an invention communicated to patentee he was not the true inventor.

Lewis v. Marling.

So in the case of *Lewis* v. *Marling* (*t*), in which it was proved that a model and specification of a machine similar to the plaintiff's had been brought from America several years before the date of the plaintiff's patent, Lord *Tenterden*, C. J., said, at *nisi prius*, that if it were shown that the plaintiffs had borrowed from some one else, then of course their patent would fail. And upon a motion for a new trial in that case (*u*), his Lordship afterwards said, that he told the jury that if it could be shown that the plaintiffs had seen the model or specification that might answer the claim of invention. And in the same case, Mr. Justice *Bayley* said, if it had been

If patentee saw a model from which he borrowed the invention, he was not the inventor.

(*r*) 1 Webs. R. 507.
(*s*) 1 Webs. R. 125, n.; Dav. P. C. 429.
(*t*) 4 C. & P. 52; 10 B. & C. 22, *S.C.*
(*u*) 10 B. & C. 22.

shown that the plaintiff had seen the model, and had borrowed from it, he would not have been the true inventor.

In the case of *Gibson* v. *Brand* (*x*), Lord Chief Justice *Tindal* held, that proof that the patentee was the first to publish an invention to the world, was not *conclusive* evidence of his being the actual inventor, and that he would not be the inventor if it were shown that he had borrowed it from another person; for the law never intended that a person who has taken all his knowledge from the labours and assiduity, or ingenuity of another, should be the man who was to receive the benefit of another's skill Gibson v. Brand.

And if it be shown, as in *Barker* v. *Shaw* (*y*), that an invention was made by a servant, whilst in the service of his masters, the patentees, the defendant will be entitled to a verdict, for the patentees were not the true inventors. The same law was laid down by Mr. Justice *Buller*, in the case of *The King* v. *Arkwright* (*z*). Barker v. Shaw. If a servant make an invention the master cannot support a patent for it.

7. But a patentee's title as inventor will not be defeated by proof that he availed himself of the assistance of others in *perfecting* his invention. Patentee may avail himself of assistance.

Thus, in the case of *Bloxam* v. *Elsee* (*a*), it appeared that the invention consisted of a machine for making paper in continuous sheets of an indefinite length, and that the principle of the invention was the receiving the pulp to be made into paper upon a plane formed by an endless wire web, stretched upon revolving cylinders, so that the paper was moved forward as fast as it was formed. The patentee discovered the principle of this invention, but the mechanical details necessary for carrying the invention into complete effect were numerous and complicated, and therefore he engaged Mr. Donkin, an engineer, to give him his professional assistance, and several parts of the machine were suggested to the patentee by Mr. Donkin. It was objected by the defendant that the patentee under these circumstances could not be the inventor; but it was answered that Mr. Donkin was merely acting as the patentee's servant, and the objection was not sustained. Bloxam v. Elsee.

In the case of *Minter* v. *Wells* (*b*), Mr. Baron *Alderson* Minter v. Wells.

(*x*) 1 Webs. R. 628.
(*y*) Holroyd, 60; 1 Webs. R. 126.
(*z*) Printed case, and Dav. P. C. 61.
(*a*) 1 C. & P. 567.
(*b*) 1 Webs. R. 132.

The person who conceives or suggests the invention is the inventor, and his assistant is only his tool.

said to the jury in commenting upon the evidence, "Mr. Minter and Sutton were together about the time the invention took place; which of the two suggested the invention, and which carried it into effect, is a question for you to decide. If Sutton suggested the principle to Mr. Minter, then he would be the inventor. If, on the other hand, Mr. Minter suggested the principle to Sutton, and Sutton was assisting him, then Mr. Minter would be the first and true inventor, *and Sutton would be a machine, so to speak, which Mr. Minter uses for the purpose of enabling him to carry his original conception into effect.*"

If patentee an importer, his patent may be defeated in the same way.

8. If the patentee was an importer of the invention, the defendant may, under this issue, show that the patentee was not the true inventor within the meaning of the law, by proving that a knowledge of the invention was communicated to the patentee by a British subject, or that the patentee acquired a knowledge of the invention in any way (except by communication from a foreigner residing abroad) which would defeat his title as an actual inventor.

Communication from a Scotchman.

A communication from a Scotchman is not sufficient to support a patent, for in *Tennant's* case (*c*), the patent was held to be void on the ground that an essential part of the invention had been communicated to the patentee by a Scotch chemist. The point was not, however, distinctly mentioned in that case.

Brown *v.* Annandale.

A communication from any other part of the United Kingdom will not support a patent.

But the case of *Brown* v. *Annandale* (*d*) (decided in the House of Lords) shows that the words "in this realm" in the Statute of Monopolies (*e*), must now be understood to mean the whole of the United Kingdom; and as the patentee must be the true inventor within the United Kingdom, a communication of the invention made to him by any person residing within any part of it, would not enable him to support a patent.

Evidence that patentee not the first inventor.

9. To show that the patentee was not the first inventor, the defendant must prove that the public had acquired a right to the invention in some shape or other prior to the date of the patent; and proof that a prior patent had been granted for the invention would be sufficient to entitle the defendant to a verdict (*f*).

(*c*) 1 Webs. R. 125, n.; Dav. P. C. 429.
(*d*) 1 Webs. R. 433.
(*e*) 21 Jac. I. c. 3, s. 6.
(*f*) *Walton* v. *Potter*, 1 Webs. R. 591, 592.

In the case of *Forsyth* v. *Riviere* (*g*) Lord *Tenterden*, C. J., held, that if several persons simultaneously discover the same thing, the party *first* communicating it to the public, under the protection of letters patent, is the true and first inventor. So, in the case of *Cornish* v. *Keene* (*h*) the Lord Chief Justice *Tindal* said in his address to the jury,—"There may be many discoverers starting at the same time, many rivals that may be running on the same road at the same time, and the first which comes to the Crown and takes out a patent, it (the invention) not being generally known to the public, is the man who has a right to clothe himself with the authority of the patent and enjoy its benefits." If, therefore, it be shown that a prior patent has been obtained for an invention, the second patentee cannot be the *first* inventor within the meaning of the law, for the law has regard not to priority of invention, but only to priority in the communication of the invention to the public (*i*).

Forsyth v. Riviere.

Who is the first inventor.

Cornish v. Keene.

The inventor who first obtains a patent is the first inventor.

10. In order to defeat a patentee's title as first inventor, on the ground of a prior patent for the same invention, it is not necessary that a defendant should prove that the invention comprised in the prior patent is the same in every particular as that comprised in the second; it is enough to show that the plaintiff's patent extends to something for which the prior patent was obtained, and whether the objection applies to the whole or part of the invention is immaterial, for if the plaintiff fail as to any part, he must fail entirely.

It is sufficient if defendant shows that the prior patent comprises something included in the second.

And if a prior patent for the same invention has been specified before the date of the plaintiff's patent, the evidence for the defendant will be still stronger, for in that case it will appear, independent of the prior patent, that there has been a publication to the world sufficient to defeat the plaintiff's patent (*k*).

11. Proof that the alleged invention, comprised in a patent, or any part of it, was not new to the public at the date of the patent, will also be sufficient to show that the patentee was not the first inventor. And, therefore, a plea that the patentee was not the true and first inventor, puts in issue the novelty

If the invention was not new, the patentee was not the first inventor

(*g*) Chit. Prerog. Cr. 182.
(*h*) 1 Webs. R. 308.
(*i*) See the reasons for this explained in Chap. III. s. 4, *ante*, p. 31.

(*k*) *Walton* v. *Potter*, 1 Webs. R. 592; and vide *post*, the evidence upon an issue respecting the novelty of an invention.

of the invention at the date of the patent (*l*) in the same way as a plea alleging that the invention was not new as to the public knowledge and use of it (*m*).

Stead v. Williams.

And accordingly in the case of *Stead* v. *Williams* (*n*), it was held, that if an invention has already been made public in England by a description contained in a work, whether written or printed, which has been publicly circulated, the patentee is not the first and true inventor.

Prior discovery not published will not defeat patentee's title.

12. But a patentee's title as the first inventor will not be defeated by proof that a person previously made the same discovery, if a knowledge of the prior discovery is not given to the public.

Dollond's case.

Thus, in *Dollond's* case (*o*), the plaintiff had invented a new method of making object-glasses for telescopes, and it was objected that Dr. Hall had made the same discovery before him. But it was held by *Buller*, J., that as Dr. Hall had confined it to his closet, and the public were not acquainted with it, Dollond was to be considered the first inventor. The law, as laid down by Mr. Justice *Buller*, in Dollond's case, was cited and approved of by Mr. Justice *Dallas*, in delivering the judgment of the Court of Common Pleas in the case of *Hill* v. *Thomson* (*p*). And in the case of

Lewis v. Marling.

Lewis v. *Marling* (*q*), Mr Justice *Bayley* said, "If I make a discovery, and am enabled to produce an effect from my own experiments, judgment, and skill, it is no objection that some one else has made a similar discovery by his mind, unless it has become public."

Jones v. Pearce.

13. So also it was held by Mr. Justice *Patteson*, in the case of *Jones* v. *Pearce* (*r*), that a prior unsuccessful experiment will not defeat a patentee's title as first inventor, if the invention was really his own.

Prior unsuccessful experiment will not defeat a patentee's title.

Lewis v. Marling.

And in the case of *Lewis* v. *Marling* (*s*), it was proved that a model of a machine similar to the plaintiff's was brought from America, in 1811, several years before the date of the plaintiff's patent; that the model was in the same year exhibited to three or four persons, and that workmen were employed by Mr. Thompson, a manufacturer, to make a machine from it. The machine, however, was never finished,

(*l*) See *Walton* v. *Potter*, 1 Webs. R. 592.

(*m*) For the evidence upon an issue respecting the novelty of an invention, vide *post* in this Chapter.

(*n*) 8 Jur. 930.

(*o*) Dav. P. C. 170; 1 Webs. R. 43.

(*p*) 8 Taunt. 382; 2 B. Mo. 433.

(*q*) 10 B. & C. 22.

(*r*) 1 Webs. R. 122.

(*s*) 4 C. & P. 52.

and Mr. Thompson afterwards purchased the plaintiff's machine. Lord *Tenterden*, C. J., held, that as it was not shown that the plaintiff had seen the model, the evidence was not sufficient to defeat the plaintiff's title as inventor.

And in the case of *Carpenter* v. *Smith* (*t*), Lord *Abinger*, C. B., said that he was counsel in the cases of *Lewis* v. *Marling* and *Jones* v. *Pearce*, and that he recollected that those cases proceeded on the ground of the former machines being in truth mere experiments which altogether failed.

In the subsequent cases of *Cornish* v. *Keene* (*u*), *Galloway* v. *Bleadon* (*x*), and *Gibson* v. *Brand* (*y*), the same law was laid down, that evidence of prior experiments only are not sufficient to show that the patentee was not the first inventor.

Under an Issue taken upon a Plea alleging the falsehood of a Patentee's representation to the Crown, that he obtained a knowledge of the Invention by means of a communication made to him by a foreigner residing abroad.

If defendant deny the communication of an imported invention, plaintiff must prove it.

1. When a patent has been obtained for an imported invention (*z*), upon a representation to the Queen, that by means of a communication made to him by a foreigner residing abroad, he was in possession of the invention; we have seen (*a*), that the defendant may by a plea allege that the communication was false, and that the patent was consequently void (*b*). The plaintiff will by his replication to this plea allege that the representation was true (*c*), and therefore, it is apprehended that he must prove the affirmative of the issue, that a knowledge of the invention was actually communicated to the patentee in the manner alleged (*d*).

What the plaintiff must prove under this issue.

2. The plaintiff is consequently compelled to prove under this issue that a communication was made to him on some day before the date of his petition for the patent, or at all events before the date of the patent, for a communication after the date of the patent would be inconsistent with the representa-

(*t*) 9 M. & W. 300.
(*u*) 1 Webs. 508.
(*x*) 1 Webs. 525.
(*y*) 1 Webs. 628.
(*z*) Vide *ante*, Chap. III. s. 3, p. 26.
(*a*) *Ante*, Chap. X. s. 2, p. 267.
(*b*) See the form of plea in the Appendix, Chap. II. s. 4.
(*c*) Vide *ante*, Chap. X. s. 2, p. 282, and the form of replication in the Appendix, Chap. II. s. 4.
(*d*) Such proof was given in the case of *Bloxam* v. *Elsee*, 1 C. & P. 558.

tion which the patent shows that the patentee has made to the Crown. So also it must be shown that the communication was made by a foreigner, for if the communication were made by a British subject the patent could not be supported.

Tennant's case. And in *Tennant's* case (*e*), it was held, that a communication made to the inventor by a Scotchman of an essential part of the invention was sufficient to avoid the patent. It must also be proved that the foreigner was at the time of the communication resident abroad, or that his domicile was abroad, and not in this country.

Patentee must prove the truth of his representation to the Crown.

3. The necessity for proving these facts is brought upon a plaintiff by the form of the representation which a patentee must make to the Crown in order to obtain a patent for an imported invention, and the truth of which he must prove if denied (*f*).

Whether a communication from a foreigner residing in this country sufficient.

4. If it appears that the communication was made by a foreigner residing in this country; it seems that the evidence would not even show the patentee to be the true and first inventor within the meaning of the law (*g*). A foreigner who is resident in this country may himself obtain a patent for his invention, and there does not seem to be any better reason for supporting a patent for an invention acquired by communication from a foreigner permanently residing here, than for an invention which has been communicated by a British subject, in which case the law would clearly render a patent void.

Communication from a denizen.

5. And if a patent for an invention communicated by a foreigner permanently residing here were to be supported, it would be difficult to avoid extending the law also to a patent for an invention communicated by a foreigner who has been made a denizen.

Communication from a naturalized foreigner.

6. A communication from a foreigner naturalized by Act of Parliament would clearly be insufficient, for he has obtained nearly all the privileges of a natural-born subject; and is, therefore, subject to the performance of the same duties.

Evidence for the defendant.

7. Under this issue the defendant may show that the patentee acquired a knowledge of the invention in a manner

(*e*) Dav. P. C. 429; 1 Webs. R. 125, n.

(*f*) See the form in the Appendix, Chap. II. s. 1.

(*g*) Vide *ante*, Chap. III. s. 3, p. 29.

different from that which he alleged to the Crown in his petition for the patent.

Under an Issue taken upon a Plea alleging the falsehood of any other representation made by the Patentee's Petition to the Queen respecting the nature of his Invention.

1. It has been shown already (*h*), that if any material representation made by a patentee in his petition for his patent was untrue, the fraud thus practised upon the Crown has the effect of rendering the patent null and void.

Invention not an improvement.

2. An issue of this kind is most frequently raised upon the correctness of a representation respecting the nature of the invention intended to be comprised in the title which the patentee has chosen to give it; as, for instance, a representation that the invention was an improvement or improvements in some particular manufacture, or was applicable in the particular manner mentioned by the patentee in the title which he has given to his invention.

3. The law respecting the titles of inventions has already been stated in a former part of this work (*i*), where the cases on the subject of misdescriptions and misrepresentations in the titles of inventions have been digested, and to which the reader is referred.

Plaintiff must prove that the title is substantially correct.

4. The plaintiff under an issue of this description must prove that the title of the invention is substantially correct in the particulars mentioned in the plea. Thus, if the title states the invention to be an improvement in steam-engines, the plaintiff must show not only that the invention is applicable to steam-engines, but also that it is an improvement upon, or better than something which the invention is intended to supersede (*k*).

An issue respecting an invention being an improvement, not the same as an issue respecting the utility.

5. An issue respecting the invention being an improvement must not be confounded with an issue raised upon a plea alleging that the invention is useless to the public; the two issues are perfectly separate and distinct (*l*). In the one case

(*h*) *Ante*, Chap. IV. p. 42.
(*i*) *Ante*, Chap. IV. p. 43.
(*k*) *Cornish* v. *Keene*, 1 Webs. R. 503.
(*l*) *Morgan* v. *Seaward*, 2 M. & W. 544, and *Beddells* v. *Massey*, 2 Dowl. & Low, 322.

the plaintiff must give evidence respecting the utility of his invention in comparison with something previously known; but in the other case it is sufficient for him to prove that the invention is itself of some use to the public (*m*).

Evidence of invention being an improvement.

6. It is difficult to lay down any rule with respect to what a plaintiff must prove in order to show that his invention is an improvement. But if the plaintiff can prove that his invention is better or cheaper (*n*) than what was before known, he will give sufficient *prima facie* evidence in support of an issue respecting the invention being an improvement.

Each distinct part must be an improvement.

If the invention consists of several distinct things, the plaintiff must prove that every part is an improvement upon what was known before the date of the patent (*o*).

Cornish v. Keene.

In the case of *Cornish* v. *Keene* (*p*), the defendant pleaded that the invention was not an improvement or improvements in the making or manufacturing of elastic goods or fabrics applicable to various useful purposes as alleged by the patentee in the title, upon which issue was joined. The invention consisted of an elastic web which was shown to be useful for surgical purposes, but the Lord Chief Justice *Tindal* held that it was not sufficient to show that the web was useful for surgical purposes alone, but that it must be proved that the web was generally an improvement with respect to the general uses for which the fabric was intended.

If the title alleges the invention to be an improvement generally, it will not be sufficient to prove that it was so for some particular purpose only.

If invention an improvement upon another in a former patent, the specification of the former patent must be given in evidence.

7. And if a patent be obtained for an invention which is described in the specification as an improvement upon an invention comprised in a former patent, the specification of the former patent must be given in evidence in order to show what the improvement really is, and whether it is such an improvement as alleged by the patentee (*q*).

Issue upon the invention being applicable in the manner alleged.

8. Under an issue respecting the applicability of the invention in the manner alleged in the title, the plaintiff must show that the allegation is substantially true. Thus, if the title allege the invention to be an improvement in lace machines, and also applicable to stocking looms, the plaintiff must show that the invention is applicable not only to lace machines, but also to

(*m*) See the evidence to be given upon an issue respecting the utility of an invention, *post*, in this Chapter.

(*n*) See *Cornish* v. *Keene*, 1 Webs. R. 506.

(*o*) *Morgan* v. *Seaward*, 2 M. & W. 544.

(*p*) 1 Webs. R. 501, 506.

(*q*) *Lewis* v. *Davis*, 3 C. & P. 488.

stocking looms. And if he fails in proving the applicability of the invention in either respect, he will fail altogether.

Thus, it was held by the Court of Common Pleas, in *Hill* v. *Thompson* (*r*), that if any part of an alleged discovery being a material part, fail (the discovery in its entirety forming one entire consideration), the patent is altogether void. Hill v. Thompson.

9. And if the issue be taken upon the alleged nature of the invention in any other respect, the plaintiff must show that the invention is really of the nature which he has alleged, and a material variance in this respect will be fatal (*s*). Issue respecting the nature of the invention.

10. The defendant under an issue of this description, may show that the representation contained in the patentee's title was false in the particular alleged by his plea. Thus, under an issue respecting the invention being an improvement, he may prove that the invention was no improvement; and if he shows that any part of the invention was not such an improvement as alleged by the patentee, he will be entitled to a verdict. Evidence for the defendant. Defendant may prove that invention not an improvement.

This point was expressly decided by the case of *Morgan* v. *Seaward* (*t*), in which the invention was stated in the title to be improvements in steam-engines, and in machinery for propelling vessels; and it having been proved that one part of the invention was not an improvement, the Court of Exchequer held that the verdict was rightly entered for the defendant, and that the patent was void. Morgan v. Seaward.

The same law was laid down by Lord *Abinger*, C. B., in the case of *Losh* v. *Hague* (*u*), and by Mr. Justice *Buller*, in the case of *The King* v. *Arkwright* (*x*).

11. So, also, under an issue respecting the applicability of the invention to the purposes alleged by the patentee, the defendant may give evidence to show that the invention is incapable of being used or applied in the manner represented by the patentee, or that some material part of the representation is untrue. And if the defendant succeeds in showing that the representation is false in any one particular, the defendant will be entitled to a verdict. Defendant may show that *invention is not applicable in the manner represented.*

Thus, in the case of *Felton* v. *Greaves* (*y*), the patent had Felton v. Greaves.

(*r*) 8 Taunt. 382; 2 B. Mo. 433.
(*s*) See the cases of *R.* v. *Metcalf*, and *R.* v. *Wheeler*, *post*.
(*t*) 2 M. & W. 544.
(*u*) 1 Webs. R. 203, 204.
(*x*) 1 Webs. R. 72; Dav. P. C. 61.
(*y*) 3 C. & P. 611.

been obtained for an invention which the patentee intituled "a machine for sharpening knives, scissors, and razors;" and as it appeared that the machine described in the specification was inapplicable for the purpose of sharpening scissors, the patent was held to be void.

Defendant may show that invention is not of the nature alleged.

12. And under any other issue respecting the nature of the alleged invention, the defendant may show that the description which the patentee has chosen is inaccurate, either wholly or in part; and if it is shown to be false in any material particular, the defendant will be entitled to a verdict.

R. v. Metcalf.

Thus, in *The King* v. *Metcalf* (*x*), the patentee had described his invention as a tapering brush; but the patentee's brush only differed from other brushes in the circumstance of having the hairs or bristles made of unequal lengths instead of being made of a uniform length; and it was held that the nature of the invention was inaccurately described, and that the patent was therefore void.

R. v. Wheeler.

And in the case of *The King* v. *Wheeler* (*a*), the patentee had represented his invention to be "a new or improved method of drying and preparing malt." It appeared, however, that the invention was not applicable in the manufacture of the article previously known by the name of malt, but was a method of converting malt into a colouring matter, to be used in colouring beer. And it was held that the patent was void on the ground of the misrepresentation contained in the title.

Under an Issue upon a Plea alleging that the Invention was not an Invention of any manner of Manufacture, or was not of such a nature as could be made the subject of a Patent Privilege.

This issue for the Judge.

1. This issue raises a question which is more for the decision of the Judge than of the jury. The plaintiff must, however, give the specification in evidence, in order that the Judge may be enabled to see the nature of the art or invention which is comprised in the privilege granted by the patent.

Specification must be given in evidence.

And terms of art explained to

2. If there are any terms of art contained in the title or

(*x*) 2 Stark. R. 249.

(*a*) 2 B. & Ald. 249.

specification, the plaintiff ought to give evidence of the signification of those terms, and the jury must determine what the signification is, so as to enable the Judge to arrive at a right construction of the patent and specification, which, for this purpose, must be taken as one instrument.

enable Judge to determine the question.

3. The Statute of Monopolies (*b*) requires that, in order to render a patent valid, the subject of the privilege it grants must be the sole working or making of some manner of new manufacture, and the construction to be put upon this enactment in the statute has been considered in a former part of this work (c). When the nature of the art or invention has been proved by means of the specification, and the meaning of terms of art and other facts which may be necessary to the right understanding of the specification have been ascertained by the jury, it is for the Judge to determine whether the invention is an invention of some manner of manufacture within the meaning of the Statute of Monopolies.

Statute of monopolies.

Facts being ascertained question is for Judge to determine.

4. Under this issue, the defendant may also give any evidence which may be applicable to explain the signification of the terms of art contained in the title of the invention or the specification, so as to show that the nature of the art or invention for which the patent has been obtained was not within the meaning of the exception contained in the 6th section of the Statute of Monopolies.

Evidence for defendant.

Under an Issue respecting the Novelty of an Invention (d).

1. This issue compels the plaintiff to prove that the invention was new as to the public knowledge and use of it, at the time of the making of the patent (*e*). The first thing to be attended to, therefore, is the *date* of the patent, for the patent must be presumed to have been made on the day it bears date (*f*). And the patentee must be able to show *primâ facie*,

Plaintiff must prove the novelty of his invention.

(*b*) 21 Ja. I. c. 3, s. 6.

(*c*) Vide *ante*, Chap. V. p. 77.

(*d*) See Chap. V. s. 2, p. 102, respecting the degree of novelty which is requisite in order to make an invention the legal subject of a patent privilege.

(*e*) As to the burthen of proof see *Turner* v. *Winter*, Dav. P. C. 153; *Manton* v. *Manton*, Dav. P. C. 348; *Bovill* v. *Moore*, Dav. P. C. 399.

(*f*) *Ludford* v. *Gretton*, Plow. 491.

that the invention which (*g*) he gave or contracted to give to the public had not before *that day* become public property.

Whether a manufacture not in issue.

But this issue does not raise the question whether the invention is a manufacture within the meaning of the Statute of Monopolies (*h*).

What witnesses plaintiff must call.

2. In order to prove that the invention was new, the plaintiff must call witnesses whose avocations were likely to have made them acquainted with the invention if it had been known to the public prior to the date of the patent, and who can testify that it was unknown to them.

Indirect evidence only can be given.

If it were possible to obtain the testimony of every member of the community upon the point, the novelty of an invention might be capable of direct and positive proof: but as that is impossible, the law allows of the next best evidence which a plaintiff can give; *viz.*, the testimony of persons residing in this country, who were likely to have known of the invention if it had been public property prior to the date of the patent, and who can testify that the invention was unknown to them until the patentee by his patent contracted to give it to the public in consideration of the temporary privilege granted to him in the patent.

Value of evidence depends upon witness's means of knowledge.

The value of evidence of this description depends entirely upon the means of knowledge possessed by the witnesses, and the degree of probability that they would have known of the art or invention if it had been public property before the date of the patent. The evidence of a person who was not more likely to know anything respecting the invention than any other of her Majesty's subjects would be of very little value; and hardly any number of such persons would be able by their testimony to make out a *primâ facie* case in support of the novelty of the invention.

But if the plaintiff calls witnesses, who, for some time before the date of the patent, were well acquainted with the particular branch of trade or manufacture to which the invention relates, and who can prove that they were ignorant of it until after the date of the patent, that will be sufficient *primâ facie* evidence for the plaintiff on this issue.

(*g*) *Galloway* v. *Bleaden*, 1 Webs. 525; *Cornish* v. *Keene*, 1 Webs. 509.

(*h*) *Walton* v. *Potter*, 1 Webs. R. 601.

The nature of this description of evidence is most clearly explained by the Lord Chief Justice *Tindal*, in the case of *Cornish* v. *Keene* (i), in which his Lordship said in his charge to the jury, "On the part of the plaintiffs in this case the evidence is, as it necessarily must be, of a negative character. The assertion of the plaintiff Sievier is, 'At the time I took out my patent, the subject of the patent was not generally known, it was a new invention by me, and was not known to the world.' You cannot prove a negative strictly; you can only do so by exhausting the affirmative instances of it by calling persons who have never seen it (the invention,) and the more those persons are in the way of hearing of it, or seeing it, if it had existed, the stronger is that exhausting evidence, if I may so call it, in its effect and value upon the jury. From the nature of the case, it is very difficult to suppose such circumstances as that a party should distinctly and affirmatively prove that it was a new invention, and it was not known and practised at the time the patent was obtained; therefore the plaintiff calls several witnesses to prove that part of the proposition; namely, persons who had been in this trade several years." Cornish v. Keene.

Evidence of this description was also held to be sufficient to make out a *primâ facie* case for the plaintiff, by Lord Chief Justice *Gibbs*, in *Manton* v. *Manton* (k), and by Lord Chief Justice *Tindal*, in *Galloway* v. *Bleaden* (l).

3. If the invention consists of several distinct parts, the plaintiff must prove that each part of the invention was new at the date of the patent (m). And, so, if several inventions have been comprised in the same patent, each invention must be shown to be new, or the whole patent will be void (n). Each part of invention must be proved to be new.

4. The defendant must, in answer to a *primâ facie* case for the plaintiff, show that the invention was public property at the date of the patent, or in the language of the plea, that it was not then a new invention as to the public knowledge and use of it. Evidence for the defendant.

5. If it can be shown that an invention was described in a book published before the date of the patent, or in any public Prior publication in a book, &c.

(i) 1 Webs. R. 509.
(k) Dav. P. C. 350, 353.
(l) 1 Webs. R. 526.
(m) *Manton* v. *Manton*, Dav. P. C. 340, 341; *Gibson* v. *Brand*, 4 M. & G. 179; *Gillet* v. *Wilby*, 9 C. & P. 334; and *Losh* v. *Hague*, 1 Webs. R. 208.
(n) *Brunton* v. *Hawks*, 4 B. & Ald. 541.

document, such as a specification enrolled in Chancery, that will be sufficient evidence to prove that the invention was not new within the meaning of the law. For the public had already a knowledge of the invention, or what is the same thing, possessed the means of knowledge available to every one of her Majesty's subjects.

R. v. Arkwright, prior publication in a book.

Thus, in the case of *The King* v. *Arkwright* (*o*), Emerson's book on Mechanics, published prior to the date of the patent, was held to be sufficient proof that a part of the alleged invention described in that work was not new. So, in the case of *Hill* v. *Thompson* (*p*), it appeared that an essential part of the invention was described in Aikin's "Chemical Dictionary," which was published before the date of the patent, and the Dictionary was held to be sufficient evidence to show that the invention was not new.

Hill v. Thompson.

Morgan v. Seaward.

And in the case of *Morgan* v. *Seaward* (*q*) it was mentioned by Mr. Baron *Alderson* that Dr. Brewster lost the benefit of his invention of the Kaleidoscope, because it had previously been published in a book.

Cornish v. Keene.

Publication in a specification prior to the date of the patent.

In the case of *Cornish* v. *Keene* (*r*) it appeared that the patentee had previously taken out a patent which had been specified before the date of the patent, upon which the action was brought. The defendant gave an office copy of the enrolment of the former specification in evidence, in order to disprove the novelty of the invention, and the Lord Chief Justice *Tindal* told the jury that if the secret was communicated to the world by the prior specification, the subsequent patent would be rendered void by the want of novelty in the invention.

Part of invention published before the patent.

And the defendant will be entitled to a verdict if he can show such a prior publication as to any part of the plaintiff's invention.

Huddart v. Grimshaw.

Thus, in the case of *Huddart* v. *Grimshaw* (*s*), Lord *Ellenborough*, C. J., said, in his charge to the jury, that if prior to the time of the plaintiff obtaining his patent any part of that which was of the substance of the invention had been communicated to the public in the shape of a specification of

(*o*) Dav. P. C. 129.
(*p*) 8 Taunt. 382; 1 Webs. R. 247, 248.
(*q*) 2 M. & W. 553.
(*r*) 1 Webs. R. 514, 511.
(*s*) Dav. P. C. 279.

any other patent, the plaintiff could not claim the benefit of a patent.

6. But the invention comprised in a patent will not be shown to want novelty by proof that *after* the date of the *patent*, although *before* the date of the *specification*, the invention was described or mentioned in the specification of some prior patent (*t*). Publication between the date of the patent and specification immaterial.

7. Proof that a foreign work containing a description of the invention had been imported into this country prior to the patent, would not be evidence of a want of novelty, unless it could be shown that the work was *also* published, or sold to the public here, prior to the date of the patent (*u*). Proof of the publication of a foreign book.

8. The Statute of Monopolies (*x*), which, we have seen, was in affirmance of the Common Law in this respect, requires that the art which is made the subject of a patent grant shall be the sole working or making of some manner of *new* manufacture, *which others, at the time of the making of the patent, do not use*; and the patent itself contains a condition that the invention comprised in it shall be *new as to the public use and exercise of it* (*y*). And, therefore, if it can be shown that the art or invention comprised in the patent was *used* by others in public before the making of the patent, the defendant will be entitled to a verdict upon this issue. Public use of invention prior to the patent.

9. But the prior use of an invention must be shown to be a *public* use, in order to enable a defendant to succeed upon this issue, for the use of it in private would not prove that the public had acquired a knowledge of the invention, or a right to use it before the date of the patent. Prior use must be public to avoid a patent.

There is some difficulty, however, in laying down any rule in terms sufficiently definite for the purpose of determining the precise degree of publicity in the prior use of an invention, which will be sufficient to show a want of the novelty which is required by law. Difficult to define the precise degree of publicity which is necessary.

10. It is not necessary, however, for the defendant to show, in support of his case, under this issue, that there had been a *general* use of the invention before the date of the patent, it Not necessary to show a general use.

(*t*) See *Cornish* v. *Keene*, 3 Bing. N. C. 570.

(*u*) Vide *ante*, Chap. V. s. 2, p. 108.

(*x*) *Ibid.* p. 106.

(*y*) *Ante*, Chap. IV. p. 52, and Chap. V. p. 106.

is sufficient to prove that there had been a *public* use of the invention.

Lewis v. Marling, supposed to decide that a *general* use was necessary.

It was indeed at one time supposed that the case of *Lewis* v. *Marling* (*z*) had decided that a defendant was bound to show a general use of the invention prior to the patent, in order to be entitled to a verdict on this issue. It is true that according to the report of that case, at *nisi prius*, Lord *Tenterden* did make use of the words "generally known or generally used;" but his Lordship was speaking of evidence (*a*), which went merely to prove that there had been experiments made prior to the patent, which it is quite clear could not have the effect of defeating the plaintiff's claim to his patent.

Observations upon the report of Lewis v. Marling.

If the report of the case of *Lewis* v. *Marling*, at *nisi prius*, be compared with the report of the same case (*b*) upon a motion *in banc* for a new trial (*b*), it will be seen that the former differs from the latter in the statement of facts as to several material particulars. No objection was taken to the ruling of the learned Judge at *nisi prius*; and his Lordship himself says that he left the case to the Jury to say whether the invention had been "in *public* use and operation before the granting of the patent."

And in the subsequent case of *Carpenter* v. *Smith* (*c*), Lord *Abinger*, C. B., said that he had been counsel in the case of *Lewis* v. *Marling*, and also in *Jones* v. *Pearce* (*d*); and that he recollected that those cases proceeded on the ground of the former machines being in truth mere experiments, which altogether failed. From what has been said, there seems to be strong grounds for believing that some error has crept into the report of the case of *Lewis* v. *Marling*, at *nisi prius*; but however that may be, it is clear, from the authority of a great number of cases, that it is sufficient for a defendant to prove, in order to obtain a verdict on this issue, that the invention was *publicly* known, or used before the date of the patent.

Sufficient to prove a public use.

Cornish v. Keene.

If invention was before publicly known or practised.

In the case of *Cornish* v. *Keene* (*e*), it was laid down by the Lord Chief Justice *Tindal*, that if the invention was, at the time the letters patent were granted, in any degree of

(*z*) 4 C. & P. 52.
(*a*) Vide 10 B. & C. 22.
(*b*) 10 B. & C. 22.
(*c*) 9 M. & W. 300.
(*d*) 1 Webs. R. 122.
(*e*) 1 Webs. R. 508.

general use, *if it was known at all to the world publicly, or practised openly*, so that any other person might have the means of acquiring it as well as the person who obtained a patent, that would be sufficient to show that the patent was void.

And the same learned Judge, in the case of *Gibson* v. *Brand* (*f*), told the jury that it was quite clear that if, on the evidence they had heard, they were satisfied that that which was alleged to be a discovery by the plaintiffs, had been *publicly* known and practised in England, there was an end to the validity of the patent. Gibson v. Brand.

So, in the case of *Jones* v. *Pearce* (*g*), it was laid down by Mr. Justice *Patteson*, that if a wheel which had been made before the date of the patent, was on the same principles, and in substance the same as the wheel for which the plaintiff had taken out his patent (*h*); and that it *had been used openly in public* so that every body might see it, and had continued to use the same thing up to the time of the taking out of the patent, the plaintiff's invention was not new and his patent bad. Jones v. Pearce.

This ruling was mentioned in the case of *Carpenter* v. *Smith* (*i*), and approved of by Mr. Baron *Alderson*, except that his Lordship thought it need not appear that the use continued up to the time of taking out the patent. And as it is clear, both from the report of the case of *Jones* v. *Pearce* and the observation made by Lord *Abinger* in *Carpenter* v. *Smith* (*k*), that the plaintiff obtained a verdict in *Jones* v. *Pearce*, on the ground that the alleged prior use of the invention was merely experimental; the probability is, that when Mr. Justice *Patteson* was speaking of the prior use continuing up to the time of the patent being obtained, his Lordship meant that if the use continued up to the time of taking out the patent, it would show that it was not experimental merely. Not necessary that prior use should continue to the date of the patent.

11. The meaning of the term public use was much discussed in the recent case of *Carpenter* v. *Smith* (*l*). It was held by Lord *Abinger*, C. B., at *nisi prius* (*m*), in that case, that Meaning of "public use." Carpenter v. Smith.

(*f*) 1 Webs. R. 628.
(*g*) *Ibid.* 122.
(*h*) See *Hasling's* case, cited in *Darcy* v. *Allen*, Noy, 178.
(*i*) 1 Webs. R. 542.
(*k*) 1 Webs. R. 542; vide *ante*, p. 460.
(*l*) 9 M. & W. 300.
(*m*) 1 Webs. R. 530.

Public use means a use in public.

"*public use*," *means a use in public, or in a public manner*, and not a user by the public. And upon a motion for a new trial, on the ground of a misdirection (*m*), the Court of Exchequer held that the Lord Chief Baron's ruling was right; and a rule *nisi* for a new trial was refused. In giving judgment in that case, Mr. Baron *Alderson* said—"Public use means a use in public, so as to come to the knowledge of others than the inventor, as contradistinguished from the use of it by himself in his chamber."

Public use by one person sufficient to avoid a subsequent patent.

12. It is not necessary to show that the alleged invention was used by *several* persons before the grant of the patent; for if a prior user by *one* person is shown to have been sufficiently in public, that is enough to entitle the defendant to a verdict.

Manton v. Manton.

Thus, in the case of *Manton* v. *Manton* (*n*), Lord Chief Justice *Gibbs* held, that proof of the invention having been used or practised (in public) by any one person before the date of the patent, would be sufficient to show that the invention was not new, and avoid the patent. So, in the case of *Carpenter* v. *Smith* (*o*), Lord *Abinger*, C. B., held, that if it were shown that the invention had been once in public use (that is, used in a public manner, not used by the public), or had been used by half-a-dozen individuals, *or one, in a public manner*, that would be sufficient to defeat the patent. In that case a witness proved (*p*) that he had made a lock five years before the date of the patent, upon the same principle as the plaintiff's, which had been put upon a gate belonging to Mr. Davies, where the witness saw it every day; that he afterwards repaired the lock; and that it continued in use until the time it was taken off to be produced at the trial. Lord *Abinger* held this to be sufficient evidence of a public use of the invention, and told the jury that it was sufficient to justify a verdict for the defendant upon this issue. And upon a motion for a rule for a new trial in that case (*q*), on the ground of a misdirection, the Court of Exchequer held that the ruling of Lord *Abinger*, at *nisi prius*, was correct, and refused a rule.

Carpenter v. Smith.

Losh v. Hague.

So, also, in the case of *Losh* v. *Hague* (*r*), Lord *Abinger*,

(*m*) 9 M. & W. 300.
(*n*) Dav. P. C. 333.
(*o*) 1 Webs. R. 535.
(*p*) *Ibid.* 539.
(*q*) 9 M. & W. 300.
(*r*) 1 Webs. R. 205.

C. B., laid down the same law, that a single instance of public use is sufficient evidence for the defendant, upon this issue.

13. And it is sufficient if the defendant can show that the art or invention has been before used for any purpose whatever, although it has not been used for the object or purpose mentioned in the plaintiff's specification; and the reason is, that the mere new use of an old art or invention cannot be made the subject of a patent privilege (*s*).

If it be shown that invention was used before for any purpose, not the same as plaintiff applies it to, defendant is entitled to a verdict.

Thus, in the case of *Kay* v. *Marshall* (*t*), it was shown that the machinery which the patentee was the first to apply to the spinning of flax, had before been used for spinning wool, cotton, &c.; and it was held the patent was void in consequence of the want of novelty in the invention.

Kay v. Marshall.

And in the case of *Losh* v. *Hague* (*u*), in which the patent had been granted for "improvements in the construction of wheels for carriages to be used on railways;" it was proved that the plaintiff's alleged improvement had been applied in the construction of wheels to be used on common roads before the date of the patent, and before any railways had been made; and Lord *Abinger*, C. B., held the evidence sufficient proof of a want of novelty in the invention, and the defendant accordingly had a verdict. In the course of his charge to the jury, the learned Judge said—"If you are of opinion that this wheel has been constructed, according to the defendant's evidence, by the persons who have been mentioned, long before the plaintiff's patent, although there were no railroads then to apply them to, and no demand for such wheels, yet the application of them to railroads afterwards by Mr. Losh will not give effect to his patent, if part of that which is claimed as a new improvement by him, is in fact an old improvement, invented by other people and used for other purposes; that is my opinion on the law, and on that I am bound to direct you." And his Lordship added, that if the wheels had been before constructed *on the same principle* as the plaintiff's, either wholly or in part, the defendant was entitled to a verdict (*x*).

Losh v. Hague.

14. The want of novelty in an invention may also be shown by

Want of novelty may be

(*s*) Vide *ante*, Chap. V. s. 1, p. 94, and s. 2, p. 113.

(*t*) 5 Bing. N. C. 492; 1 Beavan, 535; and 8 Cl. & Fin. 245.

(*u*) 1 Webs. R. 202.

(*x*) See this case, cited more at length, *ante*, p. 95; and see also pp. 112, 113.

shown by a prior sale.

evidence that articles produced by the exercise of the art or invention were sold before the date of the patent. The reason of this is, that a sale of such articles is evidence that a prior inventor has published the invention to the world, and given the benefit of it to the public. And accordingly it is the constant practice to give evidence to prove that articles the same as the patent articles were sold before the date of the patent.

Wood v. Zimmer.

Public sale by the inventor himself will avoid a subsequent patent.

In the case of *Wood* v. *Zimmer* (*y*), it appeared that the patentees had, four months previous to the patent, sold an article composed in precisely the same manner as that for which the patent was obtained, although under a name different from that contained in the title in the patent. Lord Chief Justice *Gibbs* held, that inasmuch as the patentees sold the article previously, they gave it to the world without a patent, and could not afterwards obtain a (valid) patent for it. And his Lordship said—"some things are obvious as soon as they are made public. Of others the scientific world may possess itself by analysis, some inventions almost baffle discovery. But to entitle a man to a patent, the invention must be new to the world. The public sale of that, which is afterwards made the subject of a patent, though sold by the inventor only, makes the patent void."

Morgan v. Seaward.

Public sale by inventor before the patent will show that invention was not new.

So, in the course of delivering the judgment of the Court of Exchequer in the case of *Morgan* v. *Seaward* (*z*), Mr. Baron *Parke* said—"It must be admitted that if the patentee himself had before his patent constructed machines for sale as an article of commerce for gain to himself, and been in the practice of selling them publicly, that is, to any one of the public who would buy, the invention would not be new at the date of the patent. This was laid down in the case of *Wood* v. *Zimmer* (*a*), and appears to be founded in reason; for if the inventor could sell his invention, keeping the secret to himself, and when it was likely to be discovered by another, take out a patent, he might have practically a monopoly for a much longer period than fourteen years. Nor are we prepared to say, that if such a sale was of articles that were only fit for a foreign market, or to be used abroad, it would make any difference; *nor that a single instance of such a sale*, as an article of commerce, to any one who chose to buy, might not be

Single instance of sale sufficient.

(*y*) Holt, N. P. C. 58.
(*z*) 2 M. & W. 544.
(*a*) Holt, N. P. C. 58, stated above.

deemed the commencement of such a practice and the public use of the invention, so as to defeat a patent."

In the case of *Minter* v. *Mower* (*b*), proof of the making and sale of a single chair before the date of the plaintiff's patent, was held to be sufficient to render the patent void. And in the case of *Losh* v. *Hague* (*c*), Lord *Abinger*, C. B., held, that if the patent article had been made and sold to *one* individual before the date of the patent, that would be sufficient to entitle the defendant to a verdict. Minter v. Mower. Losh v. Hague.

15. Evidence of the public use of the invention comprised in a patent, or the sale of an article made by means of it in this country, by a single individual, at any time before the date of the patent, is sufficient to entitle the defendant to a verdict upon this issue, not only because the invention is not brought within the terms of the exception in the Statute of Monopolies (*d*), but also because at the Common Law *no one can be deprived of the right to use an invention which he had publicly used prior to the date of the patent* (*e*). Reason why single instance of sale or use sufficient.

Thus, in the case of *Minter* v. *Mower* (*f*), in which proof of the prior use of the invention by a person of the name of Brown, in a single instance only, was held to avoid the patent. One reason given by the Court for holding the patent to be void was, that it "would have actually precluded Brown from continuing to make the same chair that he had made before the patentee's discovery." Minter v. Mower.

So, in the case of *Carpenter* v. *Smith* (*g*), in which the sale and public use of a single lock, put upon Mr. Davies' gate, was held to be sufficient evidence of a want of novelty in the plaintiff's invention; one reason given by Mr. Baron *Alderson* was, that if the patent were to be held good, and Mr. Davies were to change his lock to another gate, he would be liable to an action for an infringement of the plaintiff's patent. Carpenter v. Smith.

And in the case of *Cornish* v. *Keene* (*h*), the Lord Chief Justice *Tindal* told the jury, that if the defendants had shown that they had practised the invention, and produced the same Cornish v. Keene.

(*b*) 6 A. & E. 735.
(*c*) 1 Webs. R. 206.
(*d*) Vide *ante*, p. 106, 108.
(*e*) Vide *ante*, Chap. III. s. 4, p. 33.
(*f*) 6 A. & E. 735; 1 Webs. R. 142.
(*g*) 9 M. & W. 300, stated *ante*, p. 462.
(*h*) 1 Webs. R. 501, 511.

result in their factory before the time the patent was obtained, they could not be prevented by the subsequent patent from going on with that which they had done.

Sale of articles for exportation.

16. It seems to make no difference that the articles sold before the date of the patent, and relied on as a previous publication, were purchased for the purpose of being exported. For, by a public sale, that is a sale to any one who chooses to buy; the vendor acquired a right by means of the publication, which no subsequent patentee could deprive him of.

Carpenter v. Smith.

In the case of *Carpenter* v. *Smith* (*i*), it appeared that a trader connected with the American trade, produced to a manufacturer at Birmingham an American model of a lock similar to the plaintiff's; and the manufacturer several years before the date of the patent made a parcel of six dozen locks, and another parcel of a dozen and a half locks, according to the model, and sold them to the trader for the alleged purpose of being sent to America. Lord *Abinger*, C. B., held, that the sale of these locks was destructice of the novelty of the plaintiff's patent, although sold for the purpose of being sent to America; and the Court of Exchequer afterwards refused to grant the plaintiff a rule *nisi* for a new trial (*j*).

If any part of invention not *new*, defendant entitled to a verdict.

17. If it be shown that any essential part of the invention is deficient in the requisite novelty, the defendant will be entitled to a verdict; for the consideration for the patent privilege being the novelty of the whole invention, if any part of it fail or be not new, the patent is entirely void (*k*).

Brunton v. Hawkes.

Thus, in the case of *Brunton* v. *Hawkes* (*l*), in which the invention was for improvements in ships' anchors, windlasses, and chain cables, it was shown that the alleged improvement in the anchor was not new, and it was held that the patent was therefore void.

If the specification includes *any thing* known before the date of the patent the invention is not new.

18. If the defendant can show that the description contained in the specification by reason of its generality or otherwise, has the effect of including in the patent any thing that was publicly known, or used before the date of it (*m*), so that a

(*i*) 1 Webs. R. 530; 9 M. & W. 300.

(*j*) See also *Morgan* v. *Seaward*, 2 M. & W. 544, cited *ante*, p. 464.

(*k*) See Chap. V. s. 2, pp. 115, 116, and *ante*, pp. 116, 458.

(*l*) 4 B. & Ald. 541; and see the cases, cited *ante*, p. 116.

(*m*) See the judgment of *Parke*, B., in *Russell* v. *Cowley*, 1 Webs. R. 469.

subsequent use of a thing so included in the patent would be an infringement of it; the defendant will be entitled to a verdict on this issue.

This was in effect laid down by Lord *Eldon* in the case of *Hill* v. *Thompson* (*n*), in which his Lordship said, that "if a patentee seeks by his specification any more than he is strictly entitled to, his patent is thereby rendered ineffectual, even to the extent to which he would be otherwise fairly entitled." Hill v. Thompson.

And in the case of *Losh* v. *Hague* (*o*), Lord *Abinger*, C. B., said to the jury, "a man can always take out a patent for a new improvement; but when he makes his specification, he must take care that he does not put among his improvements that which another man had before made, or got a patent for." Losh v. Hague.

19. It is therefore important, with reference to the evidence to be given under this issue, to consider what would, or would not be, an infringement of the patent; and then to ascertain whether every thing to which the patent would thus apply, was new at the date of the patent. And if the defendant can prove that there is any art or invention which was public property at the date of the patent, and which would, if used afterwards, render a person liable for an infringement of the patent, if it were valid, the plaintiff cannot have a verdict upon this issue, for he cannot show that every part of the invention was new at the date of the patent (*p*). Important to consider what would be an infringement of the patent. If defendant can show that any thing comprised in the patent was not new, plaintiff cannot have a verdict.

Thus, in the case of *Minter* v. *Mower* (*q*), it appeared that the description contained in the specification, had the effect of including a chair such as had been made and sold by a person called Brown before the date of the patent. And the Court of Queen's Bench for this reason held, that the patent was void. Minter v. Mower.

So, in the case of *Carpenter* v. *Smith* (*r*), it appeared that the invention (remaining after a disclaimer) was alleged to be an improvement in locks consisting of a combination of a sliding bolt and lever latch. The patentees claimed this combination in general terms, not in any particular manner, and Lord *Abinger*, C. B., held, that as the description contained in the specification was so general in its terms as to Carpenter v. Smith.

(*n*) 3 Mer. 626.
(*o*) 1 Webs. R. 206.
(*p*) Vide *ante*, p. 119.
(*q*) 6 A. & E. 735.
(*r*) 1 Webs. R. 538, 539.

include something which was before known, the patent was bad for want of novelty in the invention.

Williams v. Brodie.

In the case of *Williams* v. *Brodie* (*s*), the patent was held to be void, because the specification described without distinction both the old stove, and the addition or improvement invented by the patentee.

R. v. Else.

In *The King* v. *Else* (*t*), the patent was held to be void, because the patentee claimed, not merely the particular improvement which he had invented in the mode of mixing silk and cotton thread upon the frame in making lace, but the right of making lace of silk and cotton thread generally, lace having in some other way been made by the mixing silk and cotton thread before the date of the patent.

Bovill v. Moore.

See also in the case *Bovill* v. *Moore* (*u*), the patentee in his specification described the whole machine to which his invention related, without distinguishing the improvements of which alone the invention consisted, and it was held, that the patent was therefore void.

See also the cases of *Campion* v. *Benyon* (*v*), *Jessop's* case (*x*), *Macfarlane* v. *Price* (*y*), *R.* v. *Nichels* (*z*), and *R.* v. *Cutler* (*a*).

Defendant may prove a prior knowledge or use, in any part of the United Kingdom.

20. In order to obtain a verdict upon this issue, the defendant is not bound to prove a public knowledge or use of the invention within England, Wales and Berwick upon Tweed; it is sufficient if he proves such a public knowledge or use in any part of the realm, which includes the whole of the United Kingdom and all its colonies.

Brown v. Annandale. Act of Union with Scotland extended the Statute of Monopolies to Scotland.

This was in effect decided by the case of *Brown* v. *Annandale* (*b*), in the House of Lords. That case it is true was an appeal from a decision of the Court of Session in Scotland; but it is quite clear that the decision of the House is quite as applicable to an English as to a Scotch patent. The effect of that decision is in fact this, that by the Act of the Union between England and Scotland, the Statute of Monopolies (*c*) was as to patents extended to Scotland, and that from that

(*s*) Cited in *R.* v. *Arkwright*, Dav. P. C. 96.
(*t*) Dav. P. C. 144.
(*u*) 2 Marsh. 211; Dav. P. C. 361.
(*v*) 6 B. Mo. 71, cited *ante*, p. 119.
(*x*) Dav. P. C. 203.
(*y*) 1 Stark. R. 199, cited *ante*, p. 185.
(*z*) Cited *ante*, p. 186.
(*a*) 1 Stark. 354.
(*b*) 1 Webs. R. 433.
(*c*) 21 Jac. I. c. 3, s. 6.

time the words, "this realm," in the statute mean, not merely England, Wales, Berwick-upon-Tweed and the colonies, but Scotland also; and that if an invention is shown not to be new in any other portion of the realm than that to which the grant extends, the patent is void.

The words "this realm," in the statute, includes Scotland.

By the statute for the union between Great Britain and Ireland, the whole of the United Kingdom is made one realm, and therefore there can be little doubt that an invention must be new throughout that realm, including the whole of the United Kingdom, and also all its colonies, in order to support a patent. If therefore a defendant can show that the invention which forms the subject-matter of the action was publicly known and used before the date of the patent, in any part of the United Kingdom, or any of the colonies, he will be entitled to a verdict upon this issue.

Stat. of Union with Ireland.

21. Evidence of a mere discovery of the plaintiff's invention by some other person prior to the date of the patent, will not be sufficient to entitle the defendant to a verdict on this issue (*d*), unless the discovery was publicly used, or actually published to the world in such a manner that the public had acquired a right to use the invention (*e*).

What evidence will not show a want of novelty.

22. Nor will a defendant be entitled to a verdict on this issue, upon proof that a patent had been obtained prior to the plaintiff's patent for an invention for effecting precisely the same object as the plaintiff's invention, provided the plaintiff's invention is for effecting the object by means different from those used by the prior patentee.

Prior invention for effecting the same object by different means.

Thus, in the case of *Hullett* v. *Hague* (*f*), it appeared that the patentee had, by his specification, described his invention (intituled "improvements in evaporating sugar") as follows—

Hullett v. Hague.

"I do further declare that my said invention and improvement consists in forcing, by means of bellows, or any other blowing apparatus, atmospheric, or any other air, either in a hot or cold state, through the liquid or solution subjected to evaporation; and this I do by means of pipes, whose extremities reach nearly (or within such distance as may be found suitable under

(*d*) *Gibson* v. *Brand*, 1 Webs. R. 628; and see *Holland's* case, Dav. P. C. 170, and *ante*, p. 126.

(*e*) See further the observations and cases, *ante*, p. 446, as to evidence which would be insufficient to show that a patentee was not the first inventor.

(*f*) 2 B. & Ad. 370.

peculiar circumstances) to the upper or interior area of the bottom of the pan or boiler containing such liquid or solution, the other extremities of such pipes being connected with larger pipes, which communicate with the bellows or other blowing apparatus which forces the air into them." The defendant gave in evidence a prior patent and specification, comprising an invention for the same object. But it appeared that the prior patentee used pipes perforated with holes, and coiled at the bottom of the vessel, or a shallow metallic vessel of the nature of a cullender; and the Court of Queen's Bench held that as the subsequent patentee effected his object by different means, the inventions were perfectly distinct, and that the prior patent and specification were no proof of a want of novelty in his invention, although the object of the two inventions was precisely the same (*g*).

If the means used are different, the similarity of the object is not material.

Walton *v.* Potter.

New mode of producing the same object.

And in the case of *Walton* v. *Potter* (*h*), the Lord Chief Justice *Tindal* laid down the law on the subject thus—"There can be no doubt that although one man has obtained a patent for a given object, there are many modes still open for other men of ingenuity to obtain a patent for the same object; there may be many roads leading to one place, and if a man has, by dint of his own genius and discovery, after a patent has been obtained, been able to give to the public, without reference to the former one, or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent for that purpose."

Secret use will not prove a want of novelty.

Evidence of a prior use of the invention will not be sufficient to prove a want of novelty, if the invention was used secretly, or in such a manner as not to amount to a publication.

Bentley *v.* Fleming.

In the case of *Bentley* v. *Fleminy* (*i*), it appeared that the patent had been obtained for a card machine; and there was evidence that about five or six weeks before the patent was obtained, the inventor had lent his patent machine to one N., in order that he might try whether it would set the teeth of the cards, and in order to discover whether it was worth while to take out a patent for it or not. There was also evi-

(*g*) See also the case of *Russell* v. *Cowley*, 1 Webs. R. 463; and *Macintosh* v. *Everington*, 6 Rep. Arts, N. S. 317-365.

(*h*) 1 Webs. R. 590-591.

(*i*) 1 C. & K. 587.

dence that N.'s room was in a mill, and that men were constantly going backwards and forwards to and from the room. It appeared also that for some weeks before the time at which the machine was lent to N., it had been in complete working condition. It was objected on behalf of the defendant, that this was sufficient evidence that the machine had been publicly used in N.'s room before the granting of the patent; but Mr. Justice *Cresswell* held that that was not so, there being no evidence to show that the machine had been given to N. for the purpose of his giving it publicity. And it is quite clear that this evidence was insufficient, because the use of the machine was merely experimental; the knowledge communicated to N. must be deemed to have been confidential, and therefore within the meaning of the principle laid down in *Morgan* v. *Seaward* (*k*), and there was no evidence to show that persons coming into N.'s room either did or could discover the nature of the invention, and it is improbable that the nature of a complicated machine could be discovered merely by a passing sight of it. This case seems to give rise to this observation, that whenever it appears that an act done before the date of the patent, was not intended to be a publication of the invention, it will not be presumed to have amounted to a publication, unless it is clearly shown that the effect of the act was to publish a knowledge of the invention to the world.

In the case of *Bentley* v. *Fleming* (*l*), just cited, it was also proved that the inventor had a machine made according to his invention in complete working order for a long period before he took out the patent, but there being no proof of a public use of the machine, the learned Judge held that the evidence was not sufficient to invalidate the patent.

In the case of *Morgan* v. *Seaward* (*m*), an action was brought by the assignee of a patent for an invention, one part of which was an improved paddle-wheel. It was proved in evidence, that before the date of the patent (which was the 22nd July, 1829), Curtis, an engineer, made for Morgan (one of the plaintiffs) two pair of wheels upon the principle men- Morgan v. Seaward.

(*k*) 2 M. & W. 544, cited *ante*, p. 127.
(*l*) 1 Car. & Kirw. 587.
(*m*) 2 M. & W. 544, cited more fully, *ante*, p. 127.

tioned in the patent at his own factory. Galloway, the patentee, gave the instructions to Curtis under an injunction of secresy, because he was about to take out a patent. The wheels were completed and put together at Curtis's factory, but not shown or exposed to the view of those who might happen to come there. After remaining a short time, the wheels were taken to pieces, packed up in cases, and shipped in the month of April on board a vessel in the Thames, and sent for the use of the Venice and Trieste Company, of which Morgan (one of the plaintiffs) was managing director, and which carried on its transactions abroad, but had shareholders in England. Curtis deposed that "they were sold to the Company," without saying by whom, which might mean that they were sold by Curtis to Morgan for the Company; and Morgan paid Curtis for them. Morgan and Galloway employed an attorney, who entered a *caveat* against any patent on the 2nd of March, and afterwards solicited the patent in question, which was granted to Galloway and assigned to Morgan. Upon these facts, a verdict was entered for the defendant at *nisi prius*, upon a plea alleging that the invention was not new, but leave was reserved for the plaintiff to move the Court of Exchequer to have the verdict entered for him on that issue. The Court afterwards made a rule absolute for entering a verdict for the plaintiff on the ground that the disclosure was private and confidential, and that the sale of wheels was not a public sale, nor a transaction from which the inventor derived any profit (*n*).

Unsuccessful experiments will not defeat a subsequent patent.

24. Evidence of prior unsuccessful experiments will also be insufficient to defeat a patent on the ground of a want of novelty in the invention. If the prior experiments failed in producing any effect, the communication of a knowledge of them to the world could not amount to any publication of the art or invention subsequently comprised in the patent. For if the experiments were unsuccessful, the invention would be incomplete, and it would be impossible to give a knowledge of it to the world.

Jones v. Pearce. Thus, in the case of *Jones* v. *Pearce* (*o*), for an infringement of a patent for improvements on wheels for carriages, it

(*n*) See the judgment of the Court, given *ante*, p. 127.

(*o*) 1 Webs. R. 122.

appeared that wheels similar to the plaintiff's had been made and used by Mr. Strutt before the date of the patent, but that the wheels being afterwards broken they were laid aside. Mr. Justice *Patteson* told the jury, that if they were of opinion that Mr. Strutt's wheel was an experiment, and that he found it did not answer, and ceased to use it altogether, and abandoned it as useless, and no body else followed it up, there was no reason for saying that the plaintiff's patent was not good.

So, in the case of *Cornish* v. *Keene* (*p*), the Lord Chief Justice *Tindal* held, that if the evidence that is brought in any case, when properly considered, classes itself under the description of experiment only, and unsuccessful experiment, such evidence would not show the patent to be void on the ground that the invention was not new to the public. And in delivering the judgment of the Court of Common Pleas in that case (*q*), his Lordship said, "The question raised for the jury was this, whether the various instances brought forward by the defendants amount to proof, that before, or at the time of taking out the patent, the manufacture was in public use in England; or whether it fell short of that point, and proved only that experiments had been made in various quarters, and had been afterwards abandoned. This question is, from its nature, one of considerable delicacy, a slight alteration in the effect of the evidence will establish either the one proposition or the other, and the only proper mode of deciding it is by leaving it to the jury" (*r*). Cornish v. Keene.

And in the case of *Galloway* v. *Bleaden* (*s*), the Lord Chief Justice *Tindal* said, in his charge to the jury, that a mere experiment, or mere course of experiments, for the purpose of producing a result which was not brought to completion, but begun and ended in uncertain experiments,—that was not such an invention as should prevent another person who was more successful, or pursues with greater industry, the chain in the line that has been laid out for him by the preceding inventor from availing himself of it, and having the benefit of it. And his Lordship told the jury, Galloway v. Bleaden.

(*p*) 1 Webs. R. 508.
(*q*) 3 Bing. N. C. 570.
(*r*) See also the charge of Mr. Justice *Cresswell*, in *Walton* v. *Bateman*, 1 Webs. R. 619.
(*s*) 1 Webs. R. 525, 526.

that the question for them to determine was, whether on the evidence the thing itself was complete so as to be used, or whether only a series of experiments was going on (*s*).

Under an Issue upon a Plea alleging that the Invention was of no Utility (*t*).

Plaintiff must prove the utility of the invention.

1. Under this issue the plaintiff must give *primâ facie* evidence to prove that the invention which has been made the subject of the patent grant, was useful to the public at the date of the patent (*u*). But the degree of utility is quite immaterial under this issue, it is sufficient if the plaintiff can show that the invention was of *any* utility to the public (*x*). And it is to be observed that the question of utility must be determined with reference to the date of the patent, for subsequent discoveries may have rendered the invention useless. Upon this issue neither the novelty of the invention nor the sufficiency of the specification is in issue, and therefore the question to be decided is, whether that which is claimed by the specification as the patentee's invention was of public utility at the date of the patent. It is consequently necessary that the plaintiff should give his specification in evidence in support of this issue in order to show what the invention really is.

Degree of utility not material.

Utility at date of patent.

Plaintiff must prove utility of what is claimed by specification.

Specification must be in evidence.

This issue different from an issue respecting an improvement.

2. This issue, must not be confounded with an issue, respecting the invention being an improvement, in the particular kind of manufacture to which the invention relates. For upon such an issue, the plaintiff must prove that the invention was some improvement upon what was known before the date of the patent. But under an issue upon a plea alleging the want of utility in the invention, the plaintiff will make out a *primâ facie* case, if he proves the invention to be of *any* utility to the public, wholly irrespective of any thing that was known at the date of the patent (*x*).

It is sufficient if any utility proved.

Each part must be proved to be useful.

3. If there are several separate and independent parts of an invention, each part must be shown to be useful (*y*), or at all

(*s*) See also *Gibson* v. *Brand*, 1 Webs. R. 628.

(*t*) See Chap. V. s. 3, p. 132, respecting the utility of an invention which is made the subject of a patent privilege.

(*u*) *Manton* v. *Manton*, Dav. P. C. 349; *Bovill* v. *Moore*, Dav. P. C. 398, cited *ante*, p. 135.

(*x*) *Morgan* v. *Seaward*, 1 Webs. R. 172, cited *ante*, p. 137.

(*y*) *Ibid.* 172, 186.

evelts to have been of some utility at the date of the patent. And if the plaintiff fails to prove that any material part of his invention is useful, his patent is entirely void (*x*).

4. In order to succeed upon this issue the defendant must show a total want of public utility in the invention, or in the words of the plea, that it was of no use or benefit to the public. Defendant must show a *total* want of utility.

This issue is in fact taken upon a traverse of the consideration which ought to be received by the public for the patent grant, which is, the benefit or utility of the invention to the public; and unless the defendant can show a total want of utility, there will be a sufficient consideration to support the patent upon this issue. The issue is respecting the consideration.

Thus, in the case of *Lewis* v. *Marling* (*a*), it appeared that the object of the invention was the production of a machine which was useful as a whole, but it was proved that a part of it as described in the specification was useless, and yet it was held that this was not such a want of utility as would vitiate the patent (*b*). Lewis v. Marling.

5. If the patentee has represented that his invention is useful in some particular manner, the defendant may defeat the patent by proving that the representation was untrue (*c*). The defendant cannot do this, however, under a plea merely, alleging that the invention is of no use to the public, but must offer such evidence either under a plea of *non concessit*, or a special plea alleging that the patent was void in consequence of the false representation (*d*). Want of the particular utility alleged by the patentee.

Under an Issue upon a Plea alleging that there is no sufficient Specification (*e*).

1. Upon this issue the plaintiff must show (*f*), that he or the patentee has in pursuance of the proviso in the patent by Plaintiff must prove compliance with the

(*x*) *Hill* v. *Thompson*, 8 Taunt. 375; vide *ante*, p. 139.

(*a*) 10 B. & C. 22; see also *Haworth* v. *Hardcastle*, 1 Bing. N. C. 182-4; 4 M. & Sc. 720, S. C.

(*b*) And see further the cases, cited *ante*, Chap. V. s. 3.

(*c*) Vide *ante*, p. 139.

(*d*) Vide *ante*, p. 451, as to an issue respecting a false representation.

(*e*) See the various Forms of Pleas in the Appendix, Chap. II. s. 4.

(*f*) As to the Burthen of Proof, vide *ante* p. 433.

proviso for specification.

an instrument under his hand and seal, particularly ascertained and described the nature of the invention, and the manner in which it is to be performed (*g*).

Specification must be produced.

The plaintiff must therefore produce the specification itself, or account for its non production, and show that it was made under his hand and seal. And if there is an attesting witness to it, it is apprehended that he must be called as a witness at the trial, or his absence accounted for.

Must prove that it was made and enrolled in time.

2. So, also, he must show that the instrument was made and also enrolled within the time limited by the proviso in the patent. These formal proofs are, however, rarely required, the contest between the parties generally turning upon the sufficiency of the instrument itself.

If specification set out, the sufficiency of it is the only question.

The defendant sometimes in his plea sets out the specification itself, and then concludes with a special traverse of the allegation in the declaration that the patentee had sufficiently specified his invention (*h*), and in such a case the formal proofs already mentioned are unnecessary, the only question then being whether the specification is sufficient.

Sufficiency partly for Judge partly for jury.

3. The question respecting the sufficiency of the specification is a mixed question of law and fact, partly for the determination of the jury and partly for the decision of the Judge.

Hill v. Thompson.

Intelligibility for jury, extent of claim for the Judge.

In the case of *Hill* v. *Thompson* (*i*), Lord *Eldon*, L. C., said, that the intelligibility of the description of an invention is a matter of fact for the jury, but whether or not the patent is defective in attempting to cover too much is a question of law.

Neilson v. Harford.

Construction is for the Judge.

And in the case of *Neilson* v. *Harford* (*k*), it was contended that the jury were to judge of the construction to be put upon the specification, but the Court of Exchequer thought otherwise; and in delivering the judgment of the Court in that case, Mr. Baron *Parke* said, "The construction of all written evidence belongs to the Court alone; whose duty it is to construe all written instruments, as soon as the true meaning of the words in which they are couched, and the surrounding circumstances, if any, have been ascertained by the jury; and it is the duty of the jury to take the construc-

(*g*) See Chap. VII. (*ante*, p. 151), respecting the form, Requisites, and Construction of Specifications.

(*h*) Vide *ante*, Chap. X. s. 2, p. 276.

(*i*) 3 Mer. 626.

(*k*) 8 M. & W. 806; 1 Webs. R. 370.

tion from the Court, either absolutely, if there be no words to be construed as words of art, or phrases used in commerce, or surrounding circumstances to be ascertained, or conditionally, where those words or circumstances are necessarily referred to them. Unless this were so, there would be no certainty in the law, for a misconstruction by the Court is the proper subject, by means of a bill of exceptions, of redress in a Court of Error; but a misconstruction by the jury cannot be set right at all effectually."

Meaning of words of art, &c., to be ascertained by jury.

The law thus laid down (*l*) by the Court of Exchequer defines most clearly the respective duties of the Court and the jury, in determining an issue respecting the sufficiency of a specification.

4. The form, requisites, and construction of a specification have already been considered in a former part of this work (*m*), to which the reader is referred; and the only remaining branch of the subject to be considered is, what evidence may or ought to be given by the parties upon the trial of this issue.

5. Upon this issue the plaintiff is bound to prove that the description contained in the specification is sufficient to ascertain the nature of the invention, and the manner in which it is to be performed. That the burthen of proof is upon the plaintiff, was held by Mr. Justice *Buller*, in the case of *Turner v. Winter* (*n*), in which his Lordship said, "I do not agree with the counsel who have argued against this rule, in saying that it was not necessary for the plaintiff to give any evidence to show what the invention was, and that the proof that the specification was improper lay on the defendant; for I hold that a plaintiff must give some evidence to show what his invention was, unless the other side admit that it has been tried and succeeds. But whenever the patentee brings an action on his patent, if the novelty or effect of the invention be disputed, he must show in what his invention consists, and *that he produced the effect proposed by the patent in the manner specified.* Slight evidence of this on his part is sufficient; and it is then incumbent on the defendant to falsify the specification."

Plaintiff must prove the sufficiency of specification.

Turner v. Winter.

(*l*) See also the case of *R.* v. *Wheeler*, 2 B. & Ald. 349.

(*m*) *Ante*, Chap. VII. p. 151.

(*n*) Dav. P. C. 153; 1 T. R. 602.

De Rosne v. Fairie.

And this was cited and approved of by Mr. Baron *Bolland*, in the case of *De Rosne* v. *Fairie* (*o*), in which the Court of Exchequer made a rule absolute for a new trial on the ground that the plaintiff had not given sufficient evidence to explain the specification.

Manton v. Manton.

So, also, in the case of *Manton* v. *Manton* (*p*), the Lord Chief Justice *Gibbs* held that it is necessary that a patentee should show that he has accurately explained the nature of his invention in his specification (*q*).

What plaintiff must prove under this issue.

6. Under this issue the plaintiff must prove—that the specification describes the same invention as that mentioned in the patent;—that it sufficiently describes every part of the invention;—that the description it contains is sufficiently intelligible to persons of competent knowledge;—and that the invention is capable of producing all the effects specified.

That specification describes the same invention as the patent.

R. v. Wheeler.

7. And firstly, plaintiff must show that he has in his specification described the same invention as that which is comprized in the patent. In the case of *The King* v. *Wheeler* (*r*), it was held that a patent was void because the specification described a process for converting malt into colouring matter by exposing it to a high temperature, whereas the title in the specification was "a new or improved method of drying and preparing malt," and it was held that the variance rendered the patent void. But if it had been shown that an article, such as that produced by means of the patent process, was known by the name of malt, then it is conceived that the objection on the ground of variance would have been removed.

R. v. Metcalf.

Thus in the case of *The King* v. *Metcalf* (*s*), in which it was held that a patent obtained for a tapering brush was void by reason of a misdescription of the invention, Lord *Ellenborough*, C. J., seemed to be of opinion that if the term tapering brush had by the usage of trade acquired a perverted sense, evidence of the fact might have been given for the purpose of removing the objection, but in the absence of such evidence the patent was held void.

That every part of the invention is

8. The plaintiff must also show that the specification sufficiently describes every part of the invention comprised in the

(*o*) 5 Tyr. 393.
(*p*) Dav. P. C. 333.
(*q*) See further as to the Burthen of Proof, *ante*, p. 433.
(*r*) 2 B. & Ald. 349.
(*s*) 2 Stark. R. 249.

patent, and every thing which is necessary to put it into successful use and practice (*t*). For the consideration to be given to the public is the knowledge of the whole invention; and if any part of the invention is insufficiently specified, the public has not had all the consideration which was bargained for; and if the consideration fail in part, it fails altogether, and renders the patent entirely void (*u*). insufficiently described.

Thus in the case of *Morgan* v. *Seaward* (*x*), Mr. Baron *Alderson* told the jury, that the specification described two inventions, and if either of those inventions was insufficiently specified, the patent failed. And in the case of *De Rosne* v. *Fairie* (*y*), the Court of Exchequer made a rule absolute for a new trial on the ground that the plaintiff had not shown that the object or purpose of the invention could be effected by the means which were stated in the declaration. The patent in that case had been obtained for an invention intituled "improvements in extracting sugar or syrup from cane juice, and other substances containing sugar, and in refining sugar and syrup." The patentees' invention, as described in the specification, consisted in the use of the charcoal of bituminous schistus and animal charcoal combined, or either of them separately, to form a filter, through which syrup was to be passed for the purpose of separating the colouring matter from it. The patentee stated that the carbonization of bituminous schistus had nothing peculiar;—that it was produced in closed vessels as was done for producing animal charcoal, only that it was convenient before the carbonization to separate from the bituminous schistus the sulphurets of iron which are mixed with it. It was proved by Mr. Faraday, and other chemists, that there were many kinds of bituminous schistus known in England; that they varied very much in the quantity of the sulphuret of iron which they contained, and that they did not know any process by which the sulphuret of iron could be completely expelled. It was admitted that the presence of the sulphuret of iron was injurious, but the plaintiff did not state, in his specification, any mode by which it could be separated from the bituminous schistus. The Morgan v. Seaward. De Rosne v. Fairie.

(*t*) See the cases on this subject collected *ante*, Chap. VII. p. 162.
(*u*) Vide *ante*, pp. 48, 165-170.
(*x*) 1 Webs. R. 173.
(*y*) 5 Tyr. 393.

jury having upon this state of facts found a verdict for the patentee, the Court of Exchequer set aside the verdict, and ordered a new trial, on the ground that it was the duty of the plaintiff either to have shown that bituminous schistus with the admixture of sulphate of iron, as it was known to exist in England, would answer the purpose beneficially, or that the sulphuret of iron could be removed by any process known to ordinary chemists of skill.

Plaintiff must prove that it is intelligible.

9. The plaintiff must also prove that the specification is intelligible to persons having a competent degree of knowledge of the subject to which the invention relates. It has already been stated (*z*), that the intelligibility of the specification is a question for the determination of the jury, but the plaintiff is only bound to satisfy the jury that the specification is intelligible to a person of ordinary and competent skill (*a*); for, as observed by Lord *Ellenborough*, C. J., in *Harmar* v. *Playne* (*b*), "no sort of specification would probably enable a ploughman utterly ignorant of the whole art, to make a watch."

Sufficient if intelligible to persons of ordinary skill.

Gibson v. Brand.

In the case of *Gibson* v. *Brand* (*c*), the Lord Chief Justice *Tindal* said, in his address to the jury respecting the issue upon the sufficiency of the specification, "All that I mean to leave to you is the question of fact that is raised for your determination, namely, whether it is so worded, and such explanations are given in it, that a person of a sufficient degree of understanding on the particular subject, could carry the provisions of the specification into effect, and obtain the proposed result."

Galloway v. Bleaden.

And in the case of *Galloway* v. *Bleaden* (*d*), the same learned Judge, after making some observations upon the specification, said to the jury, "But the main question on this point is for you, and that is, whether it is such a fair and clear statement, that a person with a competent degree of knowledge upon the subject-matter to which the patent relates, would be able to make that which the plaintiff now enjoys the exclusive privilege of."

Sufficiency of specification

To prove the sufficiency of the specification in this respect,

(*z*) *Ante*, p. 476.
(*a*) See the cases on this subject, stated *ante*, Chap. VII. p. 173 to p. 176.
(*b*) Dav. P. C. 319.
(*c*) 1 Webs. R. 629.
(*d*) 1 Webs. R. 524.

the plaintiff must call as witnesses at the trial, persons of competent skill or knowledge in the particular branch of manufacture to which the invention belongs, and who can testify that the specification conveys to their minds sufficient information to enable them to understand what the invention really is, and also how to put it in practice, or carry the object of it into complete effect (*e*). must be proved by persons of competent skill.

In the case of *Walton* v. *Potter* (*f*), the Lord Chief Justice *Tindal* said, in his address to the jury, "Generally speaking, the rule which is laid down upon occasions when the sufficiency of the specification is called in question, is this,—that as these specifications are drawn by men who are more conversant with the particular article than juries, who are selected indiscriminately from the public, and certainly much more than Judges, whose knowledge is confined to one particular department; credit is given to witnesses, if they are conversant with the subject-matter of the invention, and are able to tell you, and you believe it, that they see enough on the face of the specification to enable them to make the article without difficulty." Walton v. Potter.

10. The plaintiff may also call witnesses to prove that they have been enabled to put the invention in practice merely by means of the instructions contained in the specification. Witnesses who have put the invention in practice.

Thus, in the case of *Cornish* v. *Keene* (*g*), the plaintiffs called workmen as witnesses, who proved that by means of the information contained in the specification, and without further instruction, they had been enabled to make the patent article. Cornish v. Keene.

Evidence of this description seems to be by far the most conclusive, with respect to the intelligibility of the specification; for the evidence of persons who have not tested the specification by actual experiment in this way, is only matter of opinion, the value of which depends very much upon the skill of the witness, and the knowledge which he possesses of the language and terms of the particular art to which the invention relates. And there is this difficulty with respect to such evidence of opinion, that the jury has no certain means of Evidence of persons who have tested the specification most conclusive.

(*e*) See *Morgan* v. *Seaward*, 1 Webs. R. 170; *Elliott* v. *Aston*, 1 Webs. R. 224.

(*f*) 1 Webs. R. 595.

(*g*) *Ibid.* 502.

knowing the degree of skill which a witness possesses, and upon that circumstance in a great measure depends the value of his testimony on this subject. The specification must be sufficiently intelligible to persons of ordinary and competent skill, and it is not sufficient if it can only be understood by persons of great knowledge and science. The persons who are called to prove the sufficiency of a specification, are generally persons of the latter class; and they may be perfectly able to understand a specification, which would be wholly insufficient to instruct any ordinary workman of competent skill. The evidence of such witnesses, in fact, merely amounts to an opinion respecting the sufficiency of the specification as instructions to an entirely different class of persons.

Meaning of terms of art must be proved.

11. So if there are any technical terms, or terms of art necessary to be explained, in order to enable the jury to understand the description contained in the specification, the plaintiff must give evidence to show what is the meaning of such terms (*h*).

Plaintiff cannot give evidence to correct a mistake.

12. It seems, however, that the plaintiff cannot be allowed to give evidence to explain or correct any mistake or mis-statement in the specification, or to show that the error could not mislead (*i*).

Plaintiff must show that invention is capable of producing the effects stated.

Felton *v.* Greaves.

13. The plaintiff must show that the invention is capable of producing all the effects stated in the title or specification, for if it does not, the public will be misled (*k*), and will not receive a portion of the intended consideration. Thus in the case of *Felton* v. *Greaves* (*l*), it appeared that the patent had been obtained for a machine to sharpen knives and scissors, but the machine as described in the specification, although useful for sharpening knives, was inapplicable to the sharpening of scissors, and it was held that the specification was not sufficient.

If invention an improvement upon a prior

14. And if the invention is described as an improvement upon an invention comprised in some prior patent, the specification

(*h*) *Derosne* v. *Fairie*, 1 Webs. R. 157, and see the case of *Neilson* v. *Harford*, 1 Webs. R. 331.

(*i*) See *Neilson* v. *Harford*, 1 Webs. R. 328; 8 M. & W. 806, *S. C.*

(*k*) *Bickford* v. *Skewes*, 1 Q. B. 938.

(*l*) 3 C. & P. 611.

of the prior patent must be put in evidence, in order to enable the jury to see what the improvements are which are comprised in the subsequent patent (*m*). patent invention, former specification must be proved.

15. In answer to a *primâ facie* case made by a plaintiff, the defendant may give evidence to prove that the specification is insufficient, and that the plaintiff has therefore failed to comply with the condition upon which he obtained his patent. Evidence for the defendant.

16. Thus the defendant may show that the invention described in the specification is not the same as that comprised in the patent, for if so, the specification cannot be a performance of the condition contained in the patent (*n*). Specification does not describe the same invention.

17. So also the defendant may show that the patentee has failed sufficiently to describe an essential part of his invention, for he was bound to describe every part of it according to the condition contained in the patent (*o*). Essential part of invention not described.

18. The defendant may also give evidence to prove that the specification, or some essential part of it, is not sufficiently intelligible to enable a workman of ordinary and competent skill to use the invention and put it into successful practice. Evidence of the insufficiency of the specification in this respect, may either consist of the testimony of persons of competent skill, that they have read the instrument and do not understand it, or think it insufficient, or of persons of competent skill who have subjected the specification to the test of actual experiment, and following the instructions it contains, have been unable to succeed in producing the result described in the specification (*p*). That specification not intelligible.

19. The defendant may also prove that the invention will not produce all or some of the effects mentioned in the specification (*q*), or that the specification is in some respect deficient, false, or fraudulent. Thus if he can prove that any thing necessary to enable a person to put the invention into successful practice has been omitted, or that the invention *as described* is of no use, the specification will be bad, and the defendant will be entitled to a verdict on this issue (*r*). Specification deficient, &c.

(*m*) *Lewis* v. *Davis*, 3 C. & P. 502.
(*n*) See the cases, *ante*, Chap. VII. p. 159, 160.
(*o*) Vide *ante*, Chap. VII. pp. 162. 167.
(*p*) Vide *ante*, p. 481, 482.
(*q*) *Turner* v. *Winter*, Dav. P. C. 152.
(*r*) Per *Parke*, B., *Neilson* v. *Harford*, 1 Webs. R. 317.

So if he can show that the invention cannot be practised without some further invention or addition to the machinery or process described by the specification, or necessarily implied by the description (*c*).

Specification false.

20. If the defendant can prove that there is any thing material stated in the specification, which is false, the mis-statement will avoid the patent (*d*). So if he can show that any statement in the specification is calculated to mislead or puzzle a person who might attempt to follow its directions (*e*).

21. And if the defendant can show that the patentee has omitted or concealed any thing relating to the invention which would have been beneficial to the public, or has not described the invention according to the best of his knowledge at the time he enrolled his specification, the patent will void, and the defendant will be entitled to a verdict on this issue (*f*).

Under an issue on a Plea alleging that the Patentee did not cause any sufficient Specification to be enrolled within due time.

Questions raised.

1. This issue raises all the same questions as the last, and also this additional question, viz.—whether the specification was enrolled within due time after the date of the patent.

What plaintiff must prove.

2. The plaintiff must, therefore, under this issue, not only prove the sufficiency of his specification (*g*), but also that it was enrolled in Chancery within the time limited by the patent (*h*). There are three offices in Chancery in which such enrolments may be made, viz. the Enrolment Office, the Petty Bag Office, and the Rolls Chapel, and a due enrolment in any one of them will be a sufficient performance of the condition contained in the patent.

(*c*) See the cases of *R.* v. *Arkwright*, Dav. P. C. 106; *Morgan* v. *Seaward*, 1 Webs. R. 170; and *Neilson* v. *Harford*, 1 Webs. R. 295, cited *ante*, Chap. VII. p. 176.

(*d*) *Bickford* v. *Skewes*, 1 Q. B. R. 938; *Lewis* v. *Marling*, 10 B. & C. 22, and vide *ante*, Chap. VII. p. 178.

(*e*) *Savory* v. *Price*, 1 Ry. & Mo. 1; *Crompton* v. *Ibbotson*, Dan. & Lloyd, 33; *Turner* v. *Winter*, Dav. P. C. 145. and *ante*, Chap. VII. p. 179.

(*f*) *Liardet* v. *Johnson*, Bull. N. P. 76; *Bovill* v. *Moore*, Dav. P. C. 400; *Wood* v. *Zimmer*, Holt, N. P. C. 58; and see *Crossley* v. *Beverley*, 9 B. & C. 62, and the cases cited, *ante*, Chap. VII. p. 167—172.

(*g*) For proofs of the sufficiency of the Specification vide *ante*, p. 475.

(*h*) Vide *ante*, p. 433, respecting the Burthen of Proof.

3. The enrolment of the specification is a record of the Court of Chancery (*i*), and if it is in the Enrolment Office, or the Petty Bag Office, it must be proved in the usual way; that is, by means of an examined copy of it. But if the enrolment be in the Rolls Chapel, which is now a branch of the public Record Office, established by the statute 1 & 2 Vict. c. 94, a copy of it, certified by the deputy keeper of the records, or one of the assistant record keepers (*k*), and purporting to be sealed or stamped with the seal of the Record Office, is by section *thirteen* of that Act made evidence without further or other proof.

Enrolment is a record.
Proof of record.

4. The record will itself show when the specification was enrolled (*l*). According to the proviso in the patent, it ought to be enrolled within a certain number of months "next and immediately after the date" of the patent. In the case of *Watson* v. *Pears* (*m*), Lord *Ellenborough*, C. J., held, that according to the proper construction of this proviso, the time within which the specification is to be enrolled must be computed exclusive of the day of the date of the patent. The patent in that case bore date the 10th day of May, 1808, and contained a *proviso* requiring a specification to be enrolled "within one calendar month next and immediately after the date" thereof. The specification was not enrolled until the tenth of June following. It was contended for the defendant that the patent was void, the specification not having been enrolled on or before the 9th day of June, when one calendar month from the date of the patent expired. It was also contended that the month must begin to run from the 10th of May, and included the whole of that day, and that it therefore could not extend to the tenth of June, there being a clear impossibility of two days of the same number being comprehended in one calendar month. For the plaintiff the case of *Thomas* v. *Popham* (*n*), was relied on. The question arose there upon the statute of enrolments, 27 H. VIII. c. 16, which enacts "that the enrolment shall be made *within six months from the date of the deed*." The indenture in issue bore date the 9th October, 1557, and it was enrolled

Record shows when enrolment made.

Watson v. Pears.

Time for enrolment to be reckoned exclusive of date of patent.

(*i*) Vide *ante*, Chap. VIII. s. 3, p. 212.

(*k*) *Quære*, whether it is necessary to prove the signature to the certificate.

(*l*) See the Form of Enrolment in the Appendix, Chap. II. s. 1.

(*m*) 2 Camp. 294.

(*n*) Dyer, 218, b., and F. Moor, 40, *S. C.*

in Chancery on the 21st of March, 1558, which was the last day of the six months reckoning twenty-eight days to each month, and exclusive of the day of the date of the instrument, and the Court there held that the Indenture was well enrolled, and that the words "next after the day of the date of the deed," excluded the day of the date. In reply, it was urged for the defence that the King's grants were liable to a different rule of construction, and that it had often been decided that where a period was to be reckoned from the date, the day of the date was inclusive. Lord *Ellenborough*, C. J., however, over-ruled the objection, and said, "It used to be held 'that from the date' includes the day, and 'from the day of the date' excludes it. But since the case of *Pugh* v. *The Duke of Leeds* (*o*), these formal distinctions have been done away; and the rule of good sense has been established, that such words shall be construed according to the meaning of the parties who use them. The case cited upon the statute of enrolments, I think is expressly in point. That shows that *the day on which the patent bears date is not to be reckoned.* The month, therefore, only began on the 11th of May, and included the tenth of June, the day on which the specification was enrolled."

What defendant may prove.

5. The defendant will be at liberty under this issue to give evidence of the same objections that he could prove under a plea denying the sufficiency of the specification (*p*).

Under an Issue on the Plea of Not Guilty.

Question raised.

1. It has already been stated (*q*) that the only question under this issue is whether the defendant has committed the alleged grievances, or, in other words, whether he has invaded the plaintiff's patent privilege in the manner alleged in the declaration.

2. The patent grant stated in the declaration, and the validity of it, are therefore admitted for the purposes of this issue; but as the title of the invention in the patent does not afford sufficient information upon the subject, it is necessary to put the enrolment of the specification in evidence, in

Plaintiff must give enrolment

(*o*) Cowp. 714.
(*p*) Vide *ante*, p. 483.
(*q*) *Ante*, p. 263, 278, 434.

order that the jury may know to what the patent privilege applies, and be enabled to judge whether any act proved to be done by the defendant amounts to a violation of the plaintiff's exclusive privilege (*r*). It would not be sufficient to put the specification itself in evidence, because no one is bound to take notice of the contents of it until it is enrolled. But when it has been enrolled in pursuance of the proviso contained in the patent, the enrolment becomes a record of which every one is bound to take notice at his peril, and therefore the plaintiff is entitled to use this record in evidence to show the nature of the invention, which is comprised in the patent privilege. For this purpose the patent and the specification may be considered as one instrument (*s*), and if a plaintiff should happen to set out his specification in his declaration, he would not be compelled to give any evidence of it under the plea of not guilty. In order to give the enrolment of the specification in evidence, the plaintiff must prove it by an office copy or an examined copy of the record in the usual way (*t*).

Of specification in evidence.

3. In support of his case under this issue, the plaintiff must prove that the defendant used the art invented by the patentee, or violated his patent privilege in the manner alleged in the declaration.

Plaintiff must prove that defendant used the art.

4. A patent privilege may be infringed in several ways:—by making or manufacturing articles for use or sale by means of the art which has been invented by the patentee, or by using, exercising, or putting the art in practice, to the prejudice of the patentee in any other way;—by vending or selling articles made in violation of the patent privilege;—by making for use or sale, or vending articles which counterfeit, imitate, or resemble articles made in pursuance of the invention, or by counterfeiting or imitating the invention in any other way. And the breaches in the declaration must of course be framed according to the nature of the infringement complained of (*u*).

Modes in which a patent privilege may be violated.

It will be convenient to consider the evidence to be given under this issue, as to each class of breaches separately.

(*r*) See *Hill* v. *Thompson*, 8 Taunt. 382; 2 B. Mo. 433; *Morgan* v. *Seaward*, 1 Webs. R. 178, 182; *Walton* v. *Potter*, 1 Webs. R. 587.

(*s*) See *Hornblower* v. *Boulton*, Dav. P. C. 229, 235; the judgment of *Bayley*, J., in *Crossley* v. *Beverley*, 9 B. & C. 62.

(*t*) Vide *ante*, p. 485.

(*u*) Vide *ante*, Chap. X. s. 2, p. 258; and the Forms of Declarations, in the Appendix, Chap. II. s. 4.

(*a.*) *Upon a Breach alleging that the Defendant has injuriously made Articles, or used the Invention in Violation of the Patent.*

Making articles according to invention.

1. It seems that a bare making of articles according to the patentee's invention is sufficient evidence of an infringement, unless it be shown that the making was merely for experiment or amusement. Thus in the case of *Jones* v. *Pearce* (*x*). Mr. Justice *Patteson* told the jury that the mere making by the defendant, of wheels such as invented by the plaintiff, would be a sufficient infringement of the patent, unless he merely made them for his own amusement or models.

Jones v. Pearce.

Using art invented by patentee.

2. So, if it be proved that the patent art has been used, exercised, or put in practice by the defendant in any other way, that will be sufficient evidence of an infringement unless it appears that the use was such as could not injure the plaintiff.

Infringement to be deemed *primâ facie* injurious.

3. And any of these acts being clearly within the meaning of the prohibition contained in the patent, they must, *primâ facie*, be deemed to be injurious to the plaintiff; and, therefore, when proved in evidence, they will be sufficient to make out the plaintiff's case, unless the defendant proves that they were innocent acts which could not prejudice the plaintiff in any way whatsoever.

Procuring articles to be made.

4. If the plaintiff can show that articles have been made in England according to the patentee's invention, and *in pursuance of the defendant's order*, or directions, that will be sufficient to entitle him to a verdict against the defendant upon this breach.

Gibson v. Brand.

Thus, in the case of *Gibson* v. *Brand* (*y*), the Lord Chief Justice *Tindal* said, in delivering his judgment, "The breach alleged in the declaration is, that the defendant infringed the patent by making, using, and putting in practice the plaintiff's invention; and the evidence is, that an order was given in England, which order was executed in England, for making articles by the same mode for which the plaintiffs had obtained their patent, which articles were afterwards received by the defendant. This is quite sufficient to satisfy an allegation that he made those articles, for he that causes and procures them to be made, may be well said to have made them himself."

(*x*) 1 Webs. R. 125.

(*y*) 1 Webs. R. 631.

Sale evidence of making or using.

5. *And it seems that the act of sale of an article made according to the plaintiff's invention is not only a direct violation of the patent (z), but is also evidence of an infringement under this breach. Thus in the case of Gibson v. Brand (a), the Lord Chief Justice Tindal, at Nisi Prius, told the jury that if the defendants had themselves sold an article of exactly the same fabric, made in the same manner as that for which the patent was taken out, such sale might be considered as a using of the invention* within the terms of the declaration (*b*).

Not necessary to show that defendant used the whole.

6. In order to make out his case, it is not necessary that the plaintiff should show that the defendant has used or exercised the whole of the art or invention comprised in the patent, it is sufficient if he can show that the defendant has used any part of it. Thus in the case of *Cornish* v. *Keene* (*c*), the patent comprised an invention which was composed of three distinct parts, and the plaintiffs proved that the defendants had used so much only of the invention as related to one of the three parts, yet the evidence was held to be sufficient to entitle the plaintiff to a verdict upon this issue (*d*). And even if the object of the invention is only the production of one particular kind of article, yet if the plaintiff proves that the defendant has used any essential part of the art or invention, that will be sufficient to entitle him to a verdict. Thus, in the case of *Jones* v. *Pearce* (*e*), Mr. Justice *Patteson* told the jury that the want of two or three circumstances in the defendant's wheel which were contained in the plaintiff's specification would not prevent the plaintiff's recovering for an infringement of his patent. And in the case of *Crane* v. *Price* (*f*), it was held by the Court of Common Pleas that as it clearly appeared on the evidence that the defendants had used the invention "either in part or in whole," the plaintiffs were entitled to a verdict on the plea of not guilty to this breach.

Cornish *v.* Keene.

Use of a distinct part an infringement.

Use of any essential part an infringement.

Jones *v.* Pearce.

Crane *v.* Price.

Defendant must be shown to have used some essential part of invention.

7. It is clear, however, that the plaintiff cannot sustain this issue merely upon proof that the defendant has done something which is mentioned or described in the specification, unless it also appears that it is *actually claimed by the paten-*

(*z*) Vide *post*, p. 491.
(*a*) 1 Webs. R. 630.
(*b*) There was no breach in the declaration in this case, alleging a sale or vending.
(*c*) 1 Webs. R. 501.
(*d*) See also *Morgan* v. *Seaward*, 1 Webs. R. 170.
(*e*) 1 Webs. R. 124.
(*f*) 4 M. & G. 580.

tee as part of the invention comprised in the patent. For an art or invention may merely amount to a combination of several arts or inventions known prior to the plaintiff's patent, and a defendant will not infringe the patent merely by using one or more of these component parts, if he do use any part of the art which is of the essence of the invention, or if he do not, in any respect, avail himself of the art invented by the plaintiff (*g*).

Direct evidence not always to be obtained.

8. The plaintiff cannot always procure direct evidence of an infringement, and is therefore obliged to have recourse to evidence of a circumstantial character. Thus, in the case of *Huddart* v. *Grimshaw* (*h*), the plaintiff was unable to give direct proof of the mode in which the defendant had made the rope, which was alleged to be an infringement of the patent, but it was proved that the defendant carried on his business secretly, and denied the plaintiff and his witnesses access to his manufactory, and that the rope made and sold by the defendant could not be produced by any other mode known to the witnesses, except the invention of the plaintiff. Lord *Ellenborough*, C. J., held this to be sufficient *primâ facie* evidence of an infringement, to call upon the defendant if he could, to show that the rope was made by some other means, and not by the use of the plaintiff's invention (*i*).

Huddart *v.* Grimshaw.

Evidence for defendant, that he has not made or used, &c.

9. The defendant may in his defence show, that what he has done did not amount to a user of the art comprised in the patent.

Articles substantially different.

He may therefore prove that the articles which he has made are substantially different from those described in the specification, or that they were manufactured in a mode different in principle from that of the patentee. And if the defendant can show that what he has done is in principle and in substance different from the plaintiff's invention, and not in form merely, he will be entitled to a verdict (*k*).

Articles made for amusement.

10. And it seems that if a defendant can show that the article which he has made according to the plaintiff's invention, was made for amusement merely, and not with any view to a sale or a beneficial use of it, he will not be guilty of an infringement.

(*g*) Vide *Hill* v. *Thompson*, 8 Taunt. 382; 2 B. Moore, 433, *S. C.*

(*h*) Dav. P. C. 265.

(*i*) See also *Hill* v. *Jervis*, 1 Webs. R. 100.

(*k*) See *Morgan* v. *Seward*, 1 Webs. R. 171; *Walton* v. *Potter*, 1 Webs. R. 585-589.

Thus in the case of *Jones* v. *Pearce* (*l*), Mr. Justice *Patteson* said to the jury, that the making of the patent wheels would be an infringement, *unless the defendant merely made them for his own amusement, or as a model.* And the reason seems to be that such a making would not necessarily be injurious to the patentee.

11. But it is no answer for the defendant to show that what he has done is an improvement upon the plaintiff's invention, if the improvement is not available without a use of the plaintiff's invention. Thus in the case of *Neilson* v. *Harford* (*m*), it appeared that the apparatus which had been made by the defendant was unquestionably a great improvement upon the plaintiff's invention, but Mr. Baron *Parke* held that it was nevertheless an infringement of the plaintiff's patent. Nor will it avail a defendant any thing in such a case, that he has himself obtained a patent for his improved invention; for the subsequent patent cannot oust the plaintiff of any part of his privilege (*n*), and therefore the defendant must wait until the expiration of the plaintiff's patent, before he can exercise any part of his invention, which requires the aid of the plaintiff's (*o*).

Not sufficient for defendant to show that what he has done is an improvement.

Neilson v. Harford.

(*b.*) *Upon a Breach alleging the vending or selling of Articles made according to the Invention* (*p*).

1. Proof of a sale by the defendant of an article which has been made according to the invention, is alone sufficient to entitle the plaintiff to a verdict upon this breach. For a sale must necessarily be injurious to a patentee to some extent, because it is chiefly by the profits arising from the sale of articles made in pursuance of his invention, that a patentee can obtain the reward which the law intends him to receive, as a consideration for the benefit which he has conferred upon the community by a publication of his invention.

Proof of sale alone is sufficient.

(*l*) 1 Webs. R. 125.

(*m*) *Ibid.* 310-328.

(*n*) See a proviso in the patent that it shall not have the effect of defeating any prior patent. Vide *ante*, Chap. IV. p. 64, 65, & Appendix, Chap. II. s. 1.

(*o*) Vide *ex parte Fox*, 1 V. & B. 67; *Harmar* v. *Playne*, 11 East, 101; 14 Ves. 130; *Crane* v. *Price*, 4 M. & G. 580.

(*p*) See the Forms of Breaches, in the Appendix, Chap. II. s. 4.

Not necessary for plaintiff to prove that articles were made in breach of the patent.

2. It is not necessary for the plaintiff to prove that the articles which the defendant has sold were made in breach of the patent privilege, for it will be presumed that they had been made by some person in violation of the plaintiff's rights, until the contrary appears. And the defendant cannot complain of this presumption, for he must know where he obtained the articles which he sold, and if they were made by the patentee or any of his licensees, the defendant can easily show that fact in his defence to the action.

Sale may be an infringement although the articles not made in breach of the patent.

3. Although it is usual to allege that the articles vended or sold by the defendant had been made or manufactured in violation of the plaintiff's privilege, yet a patent may be infringed by a sale of articles made according to the invention, although not made in violation of the patent. Thus, if articles precisely the same as the plaintiff's be made in a foreign country, or in any part of the United Kingdom to which the patent privilege does not extend, it is clear that the making of them could be no infringement of the patent; and if such articles are brought into this country for any other purpose than a sale or user of them, as for instance in order to be re-exported, it is apprehended that the importation would be no violation of the plaintiff's privilege. But if such foreign articles are actually sold in this country, then there can be no doubt that the sale of them would be an invasion of the privilege granted by the patent.

Must be articles produced by the exercise of the art.

4. But in order to amount to an infringement of the patent, the articles sold by the defendant must have been articles actually produced by the exercise of the art or invention comprised in the plaintiff's patent, or in other words, the articles must be of such a description that the making of them by any other person than the patentee, or his licensees in England, would be a violation of the patent. Thus if the patentee has invented an improved lace machine, and obtained a patent for it, the sale of a machine made according to the patentee's invention would be an infringement; but the sale of *lace*, or any other article made by means of the patent machine, would be no infringement of the patent, for the patentee's invention is the art of making the improved lace machine, and that art is not used within the meaning of the patent by a person who merely uses the machine to produce a piece of lace.

Sale of the produce of a patent machine no infringement.

5. In answer to a plaintiff's *primâ facie* case, the defendant may show that the articles which he sold were manufactured either by the patentee himself, or by some other person with his licence, and had been sold either to the defendant or to some other person. For when a patentee, or any other person by his authority, makes an article according to the invention, and sells it to the public, it must be understood that the purchaser acquires an absolute dominion over it, with a right to sell it or dispose of it in any manner he pleases. Indeed, when an article has once been sold by the patentee, or his licensee, the object of the law has been attained; the patentee has obtained (or had the means of obtaining) the profit which it was intended he should receive, and any subsequent sale of the article is not within the meaning of the prohibition contained in the patent.

Defendant may prove that articles were made by the plaintiff or his licensee.

(c.) *Upon a Breach which alleges the making for use or sale, or the vending of Articles, which counterfeit, imitate, or resemble Articles made in pursuance of the Invention; or the counterfeiting, imitating, or resembling the Invention in any other way.*

1. Under an issue upon a breach of this description, the plaintiff must prove that the articles which the defendant has made or sold, are substantially the same as those produced by the invention comprized in the patent, or that the art or invention which the defendant has used or exercised for his own profit or benefit, is in substance the same as the plaintiff's.

Plaintiff must prove that the articles are substantially the same as his own.

2. In order to see whether an act which has been done by the defendant was an infringement of the patent, it is most important to attend to what is usually called the principle of the invention. The word principle, when thus used, is not however intended to signify any of those first principles, or laws of nature, which all inventors must call into requisition, more or less, and which cannot be made the subject of a patent. By principle, in this sense, is meant a practical application of some one or more of these first principles, which is properly denominated an art, by means of which articles of commerce

Principle of invention to be attended to.

Principle means the art.

may be manufactured, and an art of this description is that which must necessarily be the subject of every valid patent privilege (*q*). Thus in the case of *Watt's* steam-engine, Mr. Watt had invented the art of making a steam-engine with a condenser separate from the cylinder, and in common parlance, it is said that the principle of that invention is the construction of a steam-engine so that the steam shall be condensed in a vessel separate from the cylinder. And whenever it can be shown that an act done by the defendant comes, in this sense of the word, within the principle of the plaintiff's invention, the act is a violation of the patent privilege, for the defendant has used the art invented by the plaintiff contrary to the prohibition in the patent. The law intends a patent to reward the patentee for his invention, by means of the profit to be derived from the exercise of the sole privilege granted by the patent; and if other parties could evade the patent privilege, by making some immaterial variation from the mode of applying the invention, or the articles to be produced by means of it, as described in the specification, the object of the patent would be entirely frustrated; for no one would pay the patentee a profit price for the patent article if he could obtain an article substantially the same at a cheaper rate.

The use of the art is an infringement.

If persons were *permitted to* evade a patent the inventor would obtain no reward.

3. The prohibitory clause contained in every patent commands all persons, except the patentee, and those he may agree with, to abstain from counterfeiting, imitating, or resembling the invention, or making any addition unto, or subtraction from, the invention, and it is conceived that this command is only an expression of what the law is on the subject of an evasion of an exclusive privilege granted to an inventor by patent (*r*).

Prohibitory clause commands all persons to abstain from counterfeiting.

4. What has been said respecting the proof of infringements upon breaches of this description will be best understood by a reference to the law, which has been so clearly laid down on the subject by several eminent Judges.

Hill v. Thompson.

5. In the case of *Hill* v. *Thompson* (*s*), Mr. Justice *Dallas* (afterwards Lord Chief Justice) said, in delivering the judgment of the Court of Common Pleas respecting the question of

A slight departure for the

(*q*) Vide *ante*, Chap. V. s. 1, p. 92.
(*r*) Vide *ante* Chap. IV. p. 59.
(*s*) 8 Taunt. 382; 2 B. Mo. 433, *S.C.*

infringement in that case, "A slight departure from the specification for the purpose of evasion only, would of course be a fraud upon the patent; and, therefore, the question will be, whether the mode of working by the defendant has, or has not, been essentially or substantially different."

purpose of evasions, a fraud on the patent.

6. In the case of *Jones* v. *Pearce* (*t*), it appeared that the plaintiff's invention was of a method of making wheels for carriages on the principle of suspension, and Mr. Justice *Patteson* directed the jury that if they thought that in the wheel made by the defendant the suspension principle was applied in the same way as according to the plaintiff's invention it was applied, the plaintiff would be entitled to recover.

Jones v. Pearce.

Application of a principle in the same way.

7. In the case of *Walton* v. *Potter* (*u*), the law on this subject was laid down by the Lord Chief Justice *Tindal*, in his address to the jury, thus, "Where a party has obtained a patent for a new invention, or a discovery he has made by his own ingenuity, it is not in the power of any other person, simply by varying in form or in immaterial circumstances the nature or subject-matter of that discovery, to obtain either a patent for it himself, or to use it without the leave of the patentee, because that would be in effect and in substance an invasion of the right; and, therefore, what you have to look at upon the present occasion, is not simply whether in form or in circumstances, that may be more or less immaterial, that which has been done by the defendant varies from the specification of the plaintiff's patent; but to see whether in reality, in substance, and in effect, the defendants have availed themselves of the plaintiff's invention, in order to make that fabric, or to make that article, which they have sold in the way of their trade; whether, in order to make that, they have availed themselves of the invention of the plaintiff."

Walton v. Potter.

A variance in immaterial circumstances will not enable a person to evade a patent.

The question is whether defendant has in substance availed himself of plaintiff's invention.

8. In the case of *Morgan* v. *Seaward* (*x*), Mr. Baron *Alderson* told the jury that on the subject of the infringement, the question was, "whether the defendant's machine was only colourably different, that is, whether it differed merely in the substitution of mechanical equivalents for the contrivances resorted to by the patentee," and that they were to look to

Morgan v. Seaward.

Substitution of mechanical equivalents an infringement.

(*t*) 1 Webs. R. 124.
(*u*) *Ibid.* 586.
(*x*) 1 Webs. R. 171.

the substance of the defendant's machine, and not to the mere form, and if it was *in substance* an infringement, they ought to find it so.

Russell v. Cowley.

If defendant adopts a mode of accomplishing an object, similar in principle to plaintiff's mode, it is an infringement.

9. In the case of *Russell* v. *Cowley* (*y*), the invention consisted of a mode of making iron tubes by passing narrow strips of iron turned up at the edges through dies or conical holes in a piece of iron. The defendant made his tubes by passing similar strips of iron between two rollers, each roller having a semicircular groove round it, so that the conjunction of the two grooves formed a round hole through which the strip of iron passed. It was proved by scientific witnesses that the defendant's mode of making tubes was similar in principle to that which had been invented by the patentee, and the plaintiff obtained a verdict on this issue (*z*).

Crossley v. Beverley.

Imitation of plaintiff's invention an infringement.

10. In the case of *Crossley* v. *Beverley* (*a*), tried before Lord *Tenterden*, C. J., it appeared that the patentee had obtained a patent for an improved gas apparatus, and the infringement complained of was a close imitation of the patent machine, the principles applied in the plaintiff's patent machine and in the defendant's being the same, and the plaintiff accordingly obtained a verdict. A motion was afterwards made in the Court of King's Bench for a new trial in this case (*b*), when the Court refused to grant a rule *nisi*, but there was no objection taken to the sufficiency of the evidence of the infringement.

Jupe v. Pratt.

Observations of *Alderson*, B., on the case of Crossley v. Beverley.

And in the subsequent case of *Jupe* v. *Pratt* (*c*), Mr. Baron *Alderson* said, speaking of the case of *Crossley* v. *Beverley*, "There never was a more instructive case than that; I remember very well the argument put by the Lord Chief Baron who led that case for the plaintiff, and succeeded. There never were two things to the eye more different than the plaintiff's invention and what the defendant had done in contravention of his patent right. The plaintiff's invention was different in form—different in construction; it agreed with it only in one thing, and that was, by moving in the water, a certain point was made to open, either before

(*y*) 1 Webs. R. 459.

(*z*) The defendant obtained a rule *nisi* to set aside the verdict for the plaintiff in this case, and enter a nonsuit, but it appears that all objection to the proof of infringement was abandoned, and the rule was discharged; see the case reported, 1 C. M. & R. 864.

(*a*) 1 Webs. R. 106.

(*b*) 9 B. & C. 63.

(*c*) 1 Webs. R. 146.

or after, so as to shut up another, and the gas was made to pass through this opening; passing through it, it was made to revolve; the scientific men, all of them, said, the moment a practical scientific man has got that principle in his head, he can multiply without end the forms in which that principle can be made to operate." And his Lordship then proceeded to say with reference to the case of *Jupe* v. *Pratt*, "The difficulty which will press on you (the plaintiff's counsel), and to which your attention will be called in the present case, is this: you cannot take out a patent for a principle; you may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle, but invented some mode of carrying it into effect. But then you must start with having invented some mode of carrying the principle into effect; if you have done that, then you are entitled to protect yourself from all other modes of carrying the same principle into effect, that being treated by the jury as piracy of your original invention."

Carrying patentee's principle into effect by any other mode is a piracy.

11. The defendant may, in answer to the plaintiff's case upon such a breach, give evidence to prove that what he has done was not an imitation of the plaintiff's invention, but was substantially different from it (*d*); or that the article which he has sold was not produced by any use or application of the art which is described in the specification.

Defendant may show that what he has done is substantially different from patentee's invention.

12. When a breach alleges that the defendant has done several acts in violation of the patent: as,—that he has made several articles according to the invention; or, that he has sold several of such articles, it is not necessary, in order to entitle the plaintiff to a verdict that he should prove that the defendant has committed the precise number of infringements alleged in the breach, for the allegation contained in a breach being divisible, it is sufficient if it be proved that the defendant has done any one act which amounts to a complete infringement of the pat[illegible]r any part of it.

Allegations in breaches are divisible.

In the case of *Gillet* v. *Wilby* (*e*), the plaintiff's patent was for an invention of improvements in a cabriolet. The breach in the declaration alleged that the defendant used

Gillet *v.* Wilby.

(*d*) See the case of *Heath* v. *Unwin*, in the Exchequer, not yet reported.

(*e*) 9 C. & P. 334.

and put in practice a cabriolet with the plaintiff's improvements, and that the cabriolet used by the defendant did imitate and resemble the plaintiff's improvements, and it was urged for the defendant that the plaintiff must show that the defendant's cabriolet imitated and resembled all the improvements. But Mr. Justice *Coltman* held that the allegation in the breach was divisible, and that it would be sufficient if the cabriolet resembled any one of the plaintiff's improvements.

Section II.

Of the Evidence in Actions of scire facias *to Repeal Letters Patent.*

1.—*Of the Burthen of Proof.*
2.—*Of the Competency of Witnesses.*
3.—*Of the Evidence to be given under each of the Issues in the Action of* scire facias.

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1. *Of the Burthen of Proof.*

Burthen of proof on the prosecutor generally.

1. In an action of *scire facias*, the burthen of proof is upon the prosecutor as to the greater number of the issues which are generally raised in such an action.

On some issues prosecutor must give *primâ facie* evidence.

2. When the patentee is seeking to enforce his privilege against one of the public in a Court of Law, the defendant is entitled to put the plaintiff to the *primâ facie* proof of all the conditions which the law requires to render the patent available. But when one of the public puts the law in motion by *scire facias* against the patentee, the position of the parties is reversed, and the prosecutor must give *primâ facie* evidence of the grounds upon which he alleges that the patent ought to be avoided and repealed. Thus under the suggestions, that the patentee was not the true and first inventor, that the invention was not new, or not useful, the prosecutor must give *primâ facie* evidence in support of the suggestions, or the defendant will be entitled to a verdict.

On some issues the burthen is

3. But there are some issues on the trial of which the burthen of proof is upon the defendant, as where issue is taken upon

a suggestion alleging the falsehood of some material representation made to the Crown by the patentee in order to obtain the patent, the defendant must, by his plea, allege that the representation was true, and he must prove the affirmative of the issue, or the prosecutor will be entitled to a verdict. So if it is suggested that the patentee has not sufficiently complied with the condition which required him to enrol a specification, the burthen of proof is upon the defendant, and he must show that he has enrolled a sufficient specification as required by the patent. upon the defendant.

4. If there is any one issue on which the burthen of proof is upon the prosecutor, his counsel has the right to begin at the trial, and this right is generally esteemed to be a great advantage. The prosecutor in this way acquiring the right to begin, it is generally deemed most convenient to go into his whole case, not only as to those issues on which the burthen of proof is upon him, but also as to the other issues. Right to begin.

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2. *Of the Competency of Witnesses.*

If the patentee is the defendant in the action, it is clear that he is not a competent witness. But if the action be brought against the assignee of the patent, then it seems that the patentee would be a good witness either for the Crown or the defendant (*f*). So a licensee would be a competent witness either for the prosecutor or the defendant, subject however to any objection affecting his credit by reason of any interest he may have in the continuance of the privilege granted by the patent (*g*). But the assignee of the patent, or of any portion of it, or a person having an exclusive licence, *and on whose behalf the action was defended*, would not be a competent witness for the defendant (*h*).

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3. *Of the Evidence to be given under each of the Issues in An action of* scire facias.

It has been shown (*i*) that the prosecutor must file a Notice of objections.

(*f*) See further on the competency of a patentee as witness, *ante*, p. 435.

(*g*) See further on this subject, *ante*, p. 436.

(*h*) Vide *ante*, p. 436.

(*i*) *Ante*, Chap. X. s. 6, p. 395.

notice of his objections with the declaration in the Petty Bag Office. A copy of this notice must be annexed to the *nisi prius* record, and for the purposes of *the trial* must be considered as part of the pleadings. The only question however which can arise at the trial respecting the notice, is, whether the terms of it are sufficient to include any objection which the prosecutor may take, under any of the issues, to the validity of the letters patent (*k*).

2. With the exception of the difference caused by the burthen of proof being thrown upon the prosecutor on many of the issues, the evidence will be substantially the same upon any issue in this action, as upon a similar issue in an action for an infringement of the patent.

Patentee not the true and first inventor.

3. Thus under an issue upon a suggestion that the patentee was not the true and first inventor, the prosecutor must prove the affirmative of the suggestion in the same way as a defendant in an action for an infringement must give evidence in support of a plea containing a similar allegation (*l*). And the defendant in *scire facias* may answer the prosecutor's *primâ facie* case by the same evidence as he might give as plaintiff upon a similar issue in an action for an infringement of the patent (*m*).

Patentee not the importer.

4. If the patent was obtained for an imported invention upon a representation that the patentee had obtained a knowledge of the invention from a foreigner residing abroad, and issue be taken upon a suggestion that that representation was false (*n*), the defendant must prove the affirmative of the issue, and show that the representation was true (*o*).

False representation.

5. The same observation applies also to an issue taken upon a suggestion of the falsity of any other representation made to the Crown by the patentee; as, a suggestion that the invention was not such an improvement or not an invention of such a nature as represented by the patentee (*p*).

Invention not the subject of a legal privilege.

6. Under an issue upon a suggestion that the invention was not of such a nature as could legally be made the subject of a patent grant, the prosecutor must give the enrolment

(*k*) *Neilson* v. *Harford*, 8 M. & W. 806; 1 Webs. R. 370, *S. C.*
(*l*) Vide *ante*, p. 443.
(*m*) Vide *ante*, p. 442.
(*n*) See the Form of the Suggestion in the Appendix, Chap. II. s. 7.
(*o*) See the Evidence, *ante*, p. 449.
(*p*) See the Evidence, *ante*, p. 451.

of the specification in evidence in order to show the nature of the invention as described by that instrument, and if it contains any terms of art which require explanation, the prosecutor must give evidence to show the signification of them. When the meaning of the specification has thus been ascertained, it is for the Judge to determine whether invention can legally be made the subject of a patent grant or not (*q*).

Issue respecting the novelty of the invention.

7. Upon an issue respecting the want of novelty in the invention, the prosecutor must prove that the invention was not new to the public at the date of the patent. The evidence to be given upon this issue is precisely the same as that to be given upon a similar issue in an action for an infringement of the patent (*r*), with this difference, that the burthen of proof is upon the prosecutor, and he must give evidence to show that the public had acquired a right to the invention before the date of the patent (*s*).

Issue respecting the want of utility of the invention.

8. Upon an issue respecting the want of utility in the invention, it must be proved on behalf of the Crown that the invention was of *no* utility whatsoever to the public (*t*). And in answer to a *primâ facie* case for the prosecution, the defendant must show that the invention was of *some* public utility, and if he can satisfy the jury that it is of *any* utility, however small, he will be entitled to a verdict (*v*).

Issue respecting the sufficiency of the specification.

9. Upon an issue taken on a suggestion that the patentee has not performed the condition requiring a specification, the burthen of proof is upon the defendant (*w*). But the prosecutor cannot make out a *primâ facie* case upon any of the issues which he is bound to prove, without giving the enrolment of the specification in evidence, and that of course is sufficient proof for the defendant that a specification has in fact been enrolled. It frequently happens also that the prosecutor finds it advantageous to set out the specification in one of the suggestions in the writ of *scire facias*, so as to be able to make use of it in a Court of Error. The question upon an issue of this description, therefore, generally is, whe-

(*q*) Vide *ante*, p. 454.
(*r*) Vide *ante*, p. 455.
(*s*) Vide *ante*, p. 457.
(*t*) Vide *ante*, p. 475.
(*v*) Vide *ante*, p. 474.
(*w*) Vide *ante*, p. 475 and 484, respecting the Proof of a Specification, and the enrolment of it.

ther the specification which the patentee has enrolled is a sufficient compliance with the condition in the patent. The evidence to be given on the one side, or on the other, has already been shown in the first Section of this Chapter, to which it is therefore sufficient to refer (*u*).

(*u*) Vide *ante*, p. 475.

CHAPTER XII.

OF THE PRACTICE RESPECTING LETTERS PATENT FOR INVENTIONS.

Sec. I.—*Of the Practice respecting the obtaining of Patents, enrolling Specifications, and altering Patents and Enrolments.*
II.—*Of the Practice respecting Disclaimers and Memorandums of Alteration.*
III.—*Of the Practice of obtaining the Confirmation and Prolongation of Patents.*

Section I.

Of the Practice respecting the obtaining Patents for Inventions, enrolling Specifications, and altering Patents and Enrolments.

1.—*Of the Practice respecting the obtaining Patents for Inventions.*
2.—*Of the Practice respecting the Enrolment of Specifications.*
3.—*Of the Practice respecting the Alterations and Amendment of Patents, Enrolments, &c.*

Patent agents.

The mode in which letters patent are to be obtained, is regulated partly by statute and partly by long established practice.

Patents for inventions are usually procured through the agency of a class of gentlemen who practise as "patent agents," and inventors generally find it better to have recourse to the assistance of those gentlemen, than to attempt to obtain their patents themselves. Indeed there can be no doubt that it is really more economical for an inventor to employ a patent agent, than to act for himself. There are several gentlemen of talent and experience who devote themselves to this practice, and every person intending to

apply for a patent, will do well to retain one of them to assist him in procuring his patent.

Any person may practise as a patent agent.

According to the existing law, it appears that any person may act as a patent agent, and it is much to be regretted that there are no means of excluding unqualified persons from practising.

Several solicitors now solicit patents.

Several solicitors have recently added the soliciting of patents to their other professional avocations, and it is probable that the profession will do so much more extensively, when the practice of obtaining patents becomes better known than it is at present.

It frequently happens that several inventions relating to the same branch of manufactures are cotemporaneously made by different persons, and if an inventor thinks it probable that application will be made for a patent for any invention similar to his own, it will be better, in the first instance, to communicate to his agent merely the title of his invention and no more.

Caveats sometimes entered.

It is sometimes deemed advisable for an inventor, in the first place, to enter caveats at the chambers of the Attorney and Solicitor-general, against a patent being granted to any other person.

What a caveat is.

A caveat against a patent is in substance a request in writing, filed in some office, and desiring that a patent may not be granted without notice to the party who enters it.

Where caveats may be entered.

Caveats against patents may be entered at the chambers of the Attorney and Solicitor-general, at the Patent Bill Office (generally called the Patent Office), the Signet Office, the office of the Lord Privy Seal, and at the Patent Office.

Form of caveat at Attorney-general's.

A caveat to be entered at the chambers of the Attorney or Solicitor-general, is usually in the form or to the effect following:—*viz.*

"Caveat against her Majesty's letters patent for [*improvements in steam-engines*] being granted to any person without notice, to me the undersigned [*Andrew Pritchard, of No.* 162, *Fleet Street, London, Patent Agent.*] Dated this [*first*] day of [*January*] 1846." "*A. Pritchard.*"

Caveat at Attorney-general's is a general caveat.

A caveat of this description is called a general caveat, because it is intended to apply, not merely to a specific application for a patent, but to all applications for patents

for inventions such as described in the caveat. But a caveat entered for the purpose of opposing a patent at the *bill*, or any later stage of the proceedings, is called a specific caveat, because it is intended to apply only to that specific application for a patent.

Object of entering caveats.

The object of entering caveats at the chambers of the Attorney and Solicitor-general is, that no application for a patent, either for the same or any similar invention, may be granted without notice of the application being given to the party entering the caveat, so that he may be enabled to oppose the grant of the patent if he thinks that it would be prejudicial to his own claim for a patent, or in any other way affect his interests. And in pursuance of such caveats, the parties entering them will obtain notices of all applications for patents for inventions which come within the meaning of the description contained in their caveats.

Caveat may be in the name of the party or his agent.

A caveat may either be entered by an inventor, or other person in his own name, or in the name of his patent agent, as may be most convenient. If entered in his own name, the clerks of the Attorney and Solicitor-general will send notices of applications for patents direct to him, but if in the name of his patent agent, the notices will go to the patent agent, and he will send a similar notice to the party employing him (*x*).

Caveats not always necessary, ought to be entered in many cases.

Caveats are not necessary in every case, but there are many cases in which inventors intending to apply for patents, ought always to enter them; as where they unavoidably run the risk of their inventions being pirated by others before they can apply for patents for them.

Caveat is necessary when an inventor must confide in others.

In the experiments which inventors must sometimes make in order to complete their inventions, they are exposed to the risk of having the fruits of their labour purloined by workmen, and others in whom they may be obliged to confide. To guard against such persons surreptitiously obtaining a patent for the stolen invention, the inventor ought to enter a caveat; but it ought always to be borne in mind that a caveat only enables the person entering it to oppose a patent being granted to any other person, it is no security against a publication of a knowledge of the invention to the world by

(*x*) See the Forms in the Appendix, Chap. II. s. 1.

any person in whom the inventor may confide, or who may surreptitiously obtain a knowledge of the invention. And such a publication would of course defeat any patent subsequently obtained even by the real inventor (*y*).

Caveats must be entered both at Attorney and Solicitor-general's chambers.

As it is the practice to refer petitions for patents to the Attorney or Solicitor-general, (to either of whom they may be taken at the will of the applicant,) an inventor must, in order to be effectually protected, enter a caveat at the chambers of each of those officers.

No particular form requisite.

Description of invention to which it is to apply.

Although the form of caveat already given (*z*) is that now usually adopted, there is no particular form necessary. The chief thing to be attended to is, the description of the kind of invention to which the caveat is intended to apply. The party who enters a caveat is not obliged to describe an invention with much particularity, and it is unnecessary that the description should be even as precise as the title of an invention in a patent.

Invention is usually described in very general terms.

It is therefore the practice in preparing a caveat, to describe in very general terms the kind of invention to which the party entering it wishes it to apply, so that he may the better insure notice of an application for a patent for any invention which may *in any degree* affect him. And a party entering a caveat having thus secured notice of all applications which can affect his interests, he can in every case in which he receives notice exercise his discretion according to the title of the applicant's invention, whether a patent for such an invention is likely to be prejudicial to him, and whether he will oppose the application or not.

Description must be clear and distinct.

An inventor must however be careful to make the description inserted in his caveat sufficiently clear and distinct, to enable the Attorney or Solicitor-general's clerk to understand clearly the kind of invention to which it is intended to apply. And if the description in a caveat is obscure, or not sufficiently distinct, the person entering it will run some risk of not receiving notice of some of the applications to which he intended it to apply. It will be better, therefore, in every case, rather to incur the cost of entering two or more caveats, than to run the risk of failing to obtain the notice which is desired.

(*y*) Vide *ante*, Chap. V. s. 2, p. 102. (*z*) *Ante*, p. 504.

Caveats are entered not only by actual inventors, but also by many other persons who are occupied in making experiments with the view to discoveries in the useful arts, and also by many who are interested as patentees, or otherwise, in any particular branch of manufactures. Such persons always describe the inventions which are intended to be comprised in their caveats in the largest and most general terms.

Caveats entered by patentees and others as well as inventors.

The object of a patentee in entering such a caveat, is to prevent any other person from obtaining a patent for a mere colourable variation of his invention. And with respect to other persons entering such caveats, their object is to prevent patents being granted for any art or manufacture already known and used by them. For although a public knowledge or use of an art or manufacture will render a subsequent patent for it void, yet persons who have acquired the right to use such an art are interested, and entitled to oppose the grant of any patent, which however illegal might bring their rights in question, and put them to the cost and trouble of establishing them against the illegal grant made to the patentee.

Object of patentees and others in entering caveats.

Such general caveats as those just mentioned are beneficial so far as they enable the parties entering them to protect their interests, by preventing any one from surreptitiously or improperly obtaining a patent to which he is not entitled.

Benefit of such caveats.

The notices of applications for patents which are given by the Attorney and Solicitor-general in pursuance of a caveat, are always sent by post to the person named in the caveat, and therefore *care ought to be taken to insert the correct address to which such notices are to be sent.*

Correct address must be inserted.

In order to enter a caveat at the chambers of the Attorney and Solicitor-general, two copies of the document must be prepared, and a copy taken to the chambers of each of those officers. The fee of five shillings must be paid with each copy of the caveat, to the clerk, who will enter it in a book kept for that purpose.

Caveat, how entered.

A caveat at the chambers of the Attorney or Solicitor-general continues in force for one year only from the time it is entered, but it may be renewed from year to year as long as the party pleases.

Caveat continues in force one year.

Whenever a petition is referred to the Attorney or Solici-

List of unexpired caveats

examined whenever a petition for a patent received.

tor-general, the clerk of the officer to whom it is taken examines the list of unexpired caveats, and if he finds that the general descriptions contained in any of them have reference to the invention mentioned in the petition, he sends notices to each of the parties who have entered such caveats.

Contents of notice which a party receives in pursuance of a caveat.

The notice of an application for a patent (*a*), which a person receives in pursuance of his caveat, states the name and address of the applicant, and the title of the invention for which the patent is sought to be obtained, and informs the person who entered the caveat that if he considers that the application will interfere with his caveat, he must return an answer within seven days from the date of the notice, otherwise the patent will be allowed to proceed.

Time allowed to answer a notice.

The time allowed for returning an answer to the notice or entering an opposition, is seven days from the date of the notice, exclusive of the day of the date.

Person receiving notice may oppose or not.

Upon receiving notice of an application for a patent, in pursuance of a caveat, the first thing to be decided is whether the title of the invention claimed by the applicant can affect the invention or interest of the person who receives the notice. If it be clear that a patent for such an invention cannot operate to his prejudice, it is unnecessary to pay any attention to the notice; but if it is apprehended that such a patent will be prejudicial to his interests, he may proceed to oppose the grant of it (*b*).

Inventor must first choose a title for his invention.

When a person has made any discovery in the useful arts for which he desires to obtain a patent, he must, in the first place, choose a title for his invention, and it is of the utmost importance that he should make a proper selection.

Title to be stated in petition.

The title of an invention is a short description or definition of it, which the inventor must state in his petition to the Crown for a patent, in order to convey some idea respecting the nature of the invention. The title which a patentee gives to his invention is always adopted in the patent, which shortly recites the material allegations of the petition upon which it is founded (*c*), the title being recited in the very words used by the inventor (*d*).

(*a*) See the Form in the Appendix, Chap. II. s. 1.
(*b*) The mode of opposing is stated, *post*, in this section.
(*c*) Vide *ante*, Chap. IV. p. 40.
(*d*) *Ibid.* 43.

The requisites of a title have already been stated (*e*), and an inventor must bear in mind that he gives a title to his invention *at his own peril;* the privilege granted by the patent will apply to whatsoever may be comprised within the meaning of the title, and no more. Requisites of a title.

There is, sometimes, much difficulty in selecting a proper title for an invention, and many instances have occurred in which inventors have lost the benefit of their patents in consequence of having given erroneous titles to their inventions. In every case of doubt or difficulty, therefore, an inventor ought to obtain advice and assistance, in order to prevent the evil consequences which might follow if he were to select an improper title. Difficulty of selecting a proper title.

In choosing a title, an inventor should attend to the following general rules:— Rules to be observed in choosing a title.

A title ought to be sufficiently extensive in its signification to include every part of the invention for which the patent is to be obtained;—it must not be so extensive as necessarily to include any thing which the applicant has not invented. It must describe the same art or manufacture as the petitioner has invented, and not another; it must not contain any misrepresentation (*f*). It need not be very definite, but it must give *some* idea of the nature of the invention, and as far as it goes it must be correct (*g*). And if it be not incorrect, the generality of the description it contains will be no objection (*h*).

It has already been shown (*i*), that an inventor is not entitled as of right to a patent for his invention, but only by the grace and favour of the Crown, acting on behalf of the public. It has also been shown that in order to obtain a patent for an invention, the inventor must apply by petition to the Queen (*k*). Inventor not entitled as of right, and must petition for patent.

In his petition, the inventor must insert his name and addition, and also state the circumstances on which he founds his claim to a patent privilege. If the petitioner is an actual inventor (*l*), he states (*m*) that he has invented the art or manufacture for which he seeks to obtain a patent; that he is the What petition must state.

(*e*) *Ante*, Chap. IV. p. 43-47.
(*f*) See the cases cited, *ante*, Chap. IV. p. 43-47.
(*g*) *Sturz* v. *De la Rue*, 5 Russ. 324.
(*h*) Vide *ante*, p. 46.
(*i*) *Ante*, Chap. I. p. 4.
(*k*) *Ante*, Chap. IV. p. 41.
(*l*) Vide Chap. III. s. 2, p. 22.
(*m*) See the Forms in the Appendix, Chap. II. s. 1.

true and first inventor of it, and that it is new, and has not been used in this kingdom to the best of his knowledge and belief. If the petitioner has imported a knowledge of the invention from a foreign country, he states that, in consequence of a communication from a foreigner residing abroad, he is in possession of the invention; that it is new, and has not been used in this country, to the best of his knowledge and belief.

Petition ought to state that invention is new in this realm.

Until recently, it was supposed that an invention would possess sufficient novelty to support a patent, if it were new in England and Wales, although known in Scotland or any other part of the United Kingdom, and therefore it has been customary in a petition for a patent merely to allege that the invention is new in England, Wales, and Berwick-upon-Tweed. But the case of *Brown* v. *Annandale* (*n*), in the House of Lords, has decided that an invention must be new in every part of the United Kingdom, and therefore a petition for a patent ought now to state that the invention is new within this realm (*o*), or within the United Kingdom.

Prayer of petition.

The prayer of a petition for a patent is, that her Majesty will be pleased to grant unto the petitioner, his executors, administrators, and assigns, letters patent for the sole use of his invention within England, Wales, and Berwick-upon-Tweed, pursuant to the statute. If the inventor desires to have his patent extended to the colonies or Channel Islands, they must be mentioned in the prayer of the petition.

The allegations of the petition must be supported by some evidence.

If a patent grant is made to an alleged inventor when he cannot give the consideration required to support it, the patent, although void, may be used to the prejudice of her Majesty's subjects. The law therefore requires that when an inventor petitions for a patent, he must correctly inform the Crown respecting the invention which is to be made the subject of the patent privilege which he seeks to obtain (*p*). And if any material statement he makes be false, the law as a penalty deprives him of his patent.

As it is not proper that the Queen should be advised to make any grant of privilege which cannot be supported, it is

(*n*) 1 Webs. R. 433.

(*o*) The words, "this realm," in the Statute of Monopolies, 21 Jac. I. c. 3, s. 6, since the Union extends to the whole of the United Kingdom.

(*p*) Vide *ante*, p. 41.

necessary that the allegations of the petition should be supported by some proof that the grant for which the petitioner asks is one that may be legally made.

Petition must be verified by a solemn declaration.

It was formerly necessary that the allegations of a petition for a patent should be verified by the affidavit of the petitioner, sworn before a Master in Chancery, but the law in this respect was altered by the statute 5 & 6 W. IV. c. 62, s. 11 (*q*), in pursuance of which the petition is now to be verified by the solemn declaration instead of the affidavit of the petitioner.

Declaration must contain the same allegations as the petition.

The solemn declaration which the petitioner makes, in support of his petition, must contain precisely the same allegations as those which are contained in the petition. And if it is the petitioner's intention also to apply for Scotch and Irish patents, that fact ought to be stated in the declaration, in order to enable the petitioner to obtain *six* months instead of *four* months, to specify his invention.

Declaration, before whom to be made.

The declaration, if made in town, must be made before a Master in Chancery, but if made in the country, before a Master extraordinary.

Petition must be left at the Home Office.

The petition for a patent, and the declaration in support of it, are to be taken to the office of the Secretary of State for the Home Department (*r*), and left there for her Majesty's answer to the petition. It is the practice for the Secretary of State to answer the petition on behalf of the Crown, by referring it to the Attorney or Solicitor-general to consider and report thereon, in order that the Crown may be advised respecting the legality of the grant which the petitioner seeks to obtain, and the expediency of granting the prayer of the petition, after which it is stated in the reference that her Majesty's further pleasure will be declared.

Petition referred to Attorney or Solicitor-general.

Reference indorsed upon petition.

The reference of the petition to the law officers of the Crown is always written under or indorsed upon the petition itself, and is to be signed by the Secretary of State (*s*). According to the usual course of business, this is generally done within *three* or *four* days after the petition and declaration have been left at the Secretary of State's Office. As the reference is always made in the same form, it is usual to take the petition

(*q*) See the material parts of the statute stated in the Appendix, Chap. I. s. 1.

(*r*) Whitehall, Westminster.

(*s*) The fee payable at the Home Office for the reference is £2 2*s*. 6*d*.

to the Home Office with the reference written under it ready for the Secretary of State's signature.

Petitioner must apply for reference.

The petitioner or his agent must apply at the Secretary of State's office for the answer to the petition, and so soon as it is ready, the petition, with the answer signed by the Secretary of State, and the declaration, will be delivered to the applicant, and they must then be taken to the chambers either of the Attorney or Solicitor-general, at the election of the party.

Petition may be taken either to Attorney or Solicitor-general.

Title is compared with descriptions in caveats.

Upon a petition being left at the chambers of the Attorney or Solicitor-general, his clerk will compare the title of the invention inserted in the petition with the descriptions which are contained in all the subsisting caveats in his office. If he thinks that none of the caveats apply to the invention, the patent will be allowed to proceed as of course; but if he is of opinion that the title relates to an invention which comes within the general description contained in any of the caveats, he sends notice (by post) of the application to each party who has entered such a caveat (*t*).

Notice to such as are applicable.

Parties who receive notice may enter opposition within a week.

The parties to whom notice has been sent, in pursuance of their caveats, have allowed them *seven* days after the date of the notice (exclusive of the day of the date), within which they must enter their opposition at the chambers of the Attorney or Solicitor-general, if they intend to oppose the patent. If no opposition is entered within the seven days, the proceedings for obtaining the patent will then be permitted to proceed, as of course.

Every person may oppose a patent who has entered a caveat.

Every person who has entered a caveat is at liberty to oppose the grant of a patent before the Attorney or Solicitor-general. For all persons are interested in such a grant which is really made on behalf of the public, and therefore any one of the public is at liberty, upon entering a caveat and opposition, to go before the Attorney or Solicitor-general to show that the petitioner has no claim to a patent, or that the grant cannot legally be made. And a caveat may be entered in order to oppose a patent at any time before the report is actually signed.

Opposing party must pay the cost of hearing the opposition.

In order to oppose a patent, it was formerly necessary merely to give notice of the opposition, or enter the oppo-

(*t*) The contents of the Notice are stated, *ante*, p. 508, and see the Form in the Appendix, Chap. II. s. 1.

sition at the chambers of the Attorney or Solicitor-general, to whom the petition for the patent had been referred. But oppositions were frequently entered solely for the purpose of delaying a petitioner, and in order to check that practice, it has been made a rule that every person who opposes a patent must deposit the fees payable for the hearing of his opposition, and the amount (3*l.* 5*s.*) must be paid to the Attorney or Solicitor-general's clerk before the opposition can be entered.

Opposition how to be entered.

The usual and most convenient mode of entering an opposition, is to prepare a note of the opposition, stating the name and address of the opposing party, and that he will oppose the grant of the patent to the person applying (*a*), and then take it to the Attorney or Solicitor-general's chambers, and pay the 3*l.* 5*s.* for the hearing of the opposition, to the clerk, who will file the note and enter the opposition.

Entry of opposition stays proceeding until the hearing.

When any person has duly entered an opposition at the chambers of the Attorney or Solicitor-general, and made the required deposit, the further progress of the proceedings for obtaining the patent will be arrested until the hearing before the Attorney or Solicitor-general, which then becomes necessary.

Summons for hearing and service.

In order to dispose of an opposition, the applicant for the patent must obtain an appointment for a hearing (*x*), and a summons to be served upon the party opposing the patent to attend on the day appointed. The summons (*y*) must be served upon the opposing party seven clear days before the day appointed for the hearing, but sending the summons by post, addressed to the opposing party by the address contained in his caveat, will be deemed sufficient service.

Hearing.

At the time appointed for the hearing, the applicant must attend at the chambers of the Attorney or Solicitor-general, with whom the petition has been lodged, and if no one appears to oppose, a report will be made in favour of the applicant as of course (*z*).

(*u*) See the Form in the Appendix, Chap. II. s. 1.

(*x*) The fees to the Attorney or Solicitor-general and clerk, for a hearing, amount to 3*l.* 5*s.*, for each party.

(*y*) See the Form in the Appendix, Chap. II. s. 1; the fee for a summons is 5*s.*

(*z*) In order to entitle a petitioner to a report in his favour as of course, for default of the appearance of a party opposing; the due service of the summons, or the sending it by post to the proper address, ought to be proved by solemn declaration made in the form given by the statute 5 & 6 Will. IV. c. 62. See a Form in the Appendix, Chap. II. s. 1.

It frequently happens that the Attorney or Solicitor-general is prevented by his other engagements from attending at his chambers at the time appointed, and in such cases the hearing will be postponed, from time to time, by the clerk until the matters of the petition and opposition can be heard; and an opposing party must attend the further appointments, from time to time made for that purpose without any fresh summons.

If the opposing party attends at the time ultimately appointed for the hearing, the applicant is first heard in support of his petition for the patent, and then his opponent is heard to state his objections to the grant of the patent.

Parties heard separately and in private.

It is the practice to hear each of the parties separately, in private, the object of which is, that no party may be prejudiced by what they may disclose to the officer of the Crown.

Reasons for hearing applicant in private.

The applicant for a patent proposes to give the public the benefit of his invention in consideration of a privilege to be granted him by the patent, and he discloses his invention to the Attorney or Solicitor-general, only for the purpose of enabling him to determine whether the Crown ought on behalf of the public to accept of the offer made by the inventor. The disclosure which an inventor thus makes to the officer of the Crown, is not therefore intended to be a publication of the invention to the world, but is made upon condition that his application for a patent privilege be granted, or if refused he shall not be prejudiced by the communication. The publication of a knowledge of an invention at any time before the date of a patent obtained for it, renders the patent void, as has been shown in a former part of this work (*z*); and to require an inventor to state the nature of his invention in detail before his opponents, would enable them to defeat his patent by publishing it to the world before the patent could be sealed. For the reasons which have been stated, the disclosure which the inventor makes to the officer of the Crown is always strictly in private, and must be deemed to be a confidential communication, unless and until the patent is granted.

Reasons for hearing opposing party in private.

The ground upon which an application for a patent is

(*z*) *Ante*, Chap. V. s. 2, p. 102.

generally opposed, is, that the opposing party claims to have a better right than the applicant to the invention, which he supposes to be described by the title contained in the petition.

The opposing party therefore discloses his invention to the Attorney or Solicitor-general, merely for the purpose of enabling that officer to determine whether his invention, and that of the applicant for a patent, are the same, or whether a patent for the one would in any respect interfere with a patent for the other. Such a disclosure must clearly be deemed to be confidential, and therefore must be made in private.

Attorney-general will decide whether inventions the same.

After hearing the parties, the Attorney or Solicitor-general will determine whether the Queen ought to be advised to grant the prayer of the petition. If he thinks that the petitioner's invention, and that of his opponent, are the same, he will not report in favour of the applicant to the prejudice of his opponent, and in such a case it is usual for the parties to join in obtaining the patent, or enter into some compromise. But if the Attorney or Solicitor-general is of opinion that the inventions are perfectly distinct, he will report in favour of the petitioner.

Other grounds upon which patent may be opposed.

There are, however, other grounds upon which an application for a patent may be opposed; as, that the invention is already publicly known in this country, that it is not such an invention as comes within the meaning of the exception contained in the sixth section of the Statute of Monopolies (*a*), or that the petitioner is seeking to obtain a patent with too large a title for some improper purpose.

If the patent would be illegal it will not be granted.

If it appears that the alleged invention of the petitioner is not such as can legally be made the subject of a patent privilege, no report will be made in his favour; but it rarely becomes necessary to refuse an application for a patent on that ground.

Description of invention to be deposited.

It is now a rule that in every opposed case, the applicant for a patent shall, if he succeed at the hearing, deposit in the chambers of the Attorney or Solicitor-general, a description of his invention, as stated by him upon the hearing, together with such drawings (if any) as may be necessary to show the general nature of it.

(*a*) 21 Jac. I. c. 3.

Description to be prepared before the hearing.

Every applicant for a patent ought, therefore, before the hearing, to prepare a proper statement, (with drawings, if necessary,) to be laid before the Attorney or Solicitor-general, and to be deposited in pursuance of the rule just stated, if the opposition should fail to prevent the grant of the patent. If the statement is not sufficiently definite, the petitioner will be ordered to amend it, and the Attorney or Solicitor-general's clerk will not receive any description as a compliance with the rule, unless it has been examined and approved of, and every sheet and drawing signed by the Attorney or Solicitor-general himself. The statement ought to be signed by the petitioner, or if that cannot conveniently be done, then by his solicitor or agent, who attends the hearing on his behalf.

Expediency of requiring descriptions to be deposited.

The practice of compelling an applicant for a patent to deposit a description of his invention, would be most useful if it were extended to all cases, for there can be no doubt that there are quite as many unopposed as opposed cases, in which the deposit of such descriptions would be a great protection to the public. There seems to be no reason why the inventor should not, in every case, be required to file such a description in general terms, of the nature and object of his invention, as would effectually prevent him from appropriating to himself by his specification, any thing to which his original application for a patent did not extend. The document so filed ought, of course, to be kept secret until after the patent has been sealed and the specification enrolled, after which it should be open to the inspection of the public.

Alteration of title.

When the Attorney-general is of opinion that the title of the invention is incorrect, or that it is unnecessarily large, and may be used for a fraudulent purpose, he will compel the applicant to alter it in such manner as he thinks fit. If the Attorney or Solicitor-general orders an alteration to be made in the title, the petition must be altered accordingly; and if the alteration is material the declaration must be altered so as to correspond with the petition, and redeclared before a Master (ordinary or extraordinary) in Chancery.

If decision be against the applicant no report is made.

If the determination of the Attorney or Solicitor-general be against the applicant, no report is drawn up, for the decision is, practically speaking, final, and therefore it would be useless

to incur the expense of preparing any report upon the matters of the petition.

Report in favour of application.

When there is no opposition to an application for a patent, or if there is an opposition, and a decision is given in favour of the petitioner, a report is made to her Majesty in favour of the grant of the prayer of the petitioner. This report is prepared by the clerk of the Attorney or Solicitor-general (*b*), and it states (*c*) the reference by virtue of which it is made, the substance of the petition and declaration made in support of it, that as it is entirely at the hazard of the petitioner whether the invention is new or will have the desired success, and that, as it may be reasonable to encourage arts and inventions for the public good, it is the opinion of the Attorney (or Solicitor) general that her Majesty may, by her letters patent, grant unto the petitioner the sole use of his invention, if her Majesty shall be pleased so to do, with a proviso requiring a specification of the invention within a certain time after the date of the patent.

Time recommended for specification.

When the petitioner has declared that he intends to apply for patents for Ireland and Scotland, the time recommended to be allowed for specification of the invention is *six* calendar months; if for Ireland or Scotland only *four* calendar months will be recommended, and in other cases two calendar months only will be allowed for that purpose. The reason for allowing a longer time for specification when the party intends to apply for Scotch and Irish patents is, that those patents require a much longer time for their preparation than English patents; and if the English specification were to be enrolled before the sealing of the Scotch and Irish patents, those patents would be void, on the ground of the invention not being new, a knowledge of the invention having been previously given to the public by the enrolment of the specification (*d*).

Under very special circumstances, the Attorney and Solicitor-general have, in some cases, recommended a longer time than six months to be allowed to the patentee (*e*). But there is no recent instance of more than the usual time being

(*b*) The fee payable for the report is 4*l.* 4*s.*

(*c*) See the Form in the Appendix, Chap. II. s. 1.

(*d*) See *Brown* v. *Annandale*, 1 Webs. R. 433.

(*e*) See Parl. Rep. Pat. pp. 6 and 26.

granted, and it would be necessary to make out a very strong case to induce the Attorney or Solicitor-general to recommend more than six months for specifying the invention.

In order to obtain more than the usual time for the enrolment of the specification, application ought to be made to the Attorney or Solicitor-general before he makes his report to the Crown, to recommend a longer time to be allowed. It is entirely in the discretion of the Attorney or Solicitor-general whether he will recommend any additional time for completing the specification, but his recommendation is not final, for the Lord Chancellor may refuse to seal the patent if he thinks the time allowed is too long. Thus, in the case of *ex parte Heathcoat in re Lacy* (e), fifteen months having been allowed for enrolling the specification, Lord *Eldon*, L. C., refused to affix the Great Seal to the patent.

Report to be taken to the Home Office.

When the report has been completed and signed by the Attorney or Solicitor-general, it will be delivered, together with the petition and declaration, to the petitioner or his agent, and all the three documents must be taken to the office of the Secretary of State for the Home Department, and left there in order to obtain the Queen's warrant.

Grant is discretionary even after a favourable report.

It is scarcely necessary to observe, that notwithstanding a favourable report by the Attorney or Solicitor-general, it is entirely discretionary with the Crown whether the desired grant shall be made or not (*f*); in practice, however, a patent is rarely refused for an invention, if the officer of the Crown advises that it should be granted.

Form of warrant.

The Queen's warrant (*g*) is directed to the Attorney or Solicitor-general, and contains her Majesty's authority to prepare a bill for the intended patent. The warrant recites the petition and the Queen's willingness to encourage all arts and inventions, which may be for the public good, and directs a bill to be prepared for her Majesty's signature to pass the Great Seal containing a grant to the petitioner of the sole use of the invention within England, Wales, and Berwick-upon-Tweed, and also, if desired, within the Channel Islands and Colonies, for the term of fourteen years, provided the petitioner, within the space of time recommended by the Attor-

(e) 29 Rep. Arts, 251.
(f) Vide *ante*, Chap. I. p. 4.
(g) See the Form in the Appendix, Chap. II. s. 1.

ney-general, cause a particular description of the invention to be enrolled in Chancery, and the warrant also directs the Attorney or Solicitor-general to insert in the bill all such clauses, prohibitions, and provisoes as are usual and necessary.

Warrant prepared at the Home Office.

The warrant is prepared by a clerk in the Home Office (*g*), after which it is to be signed by her Majesty, and countersigned by one of the principal Secretaries of State, and it is usually signed by the Secretary for the Home Department, in whose office it is prepared.

When obtained.

The warrant may usually be obtained in about a week after the report has been left at the Home Office, but the completion of it may be delayed by holidays, the absence of her Majesty from town, and many other causes.

Warrant to be taken to Patent Bill Office.

When the warrant has been completed, it will be delivered to the petitioner or his agent, upon his calling at the Home Office, and he must take it to the Patent Bill Office of the Attorney and Solicitor-general, which is usually but incorrectly called the Patent Office (*h*). The warrant will be entered by the clerk of the office or his deputy, and then delivered to the engrossing clerk to prepare the bill, after which the warrant is filed and kept in that office.

Patent Bill Office is an office of the Attorney-general for preparing bills.

The Patent Bill Office is an office of the Attorney and Solicitor-general for the preparation of bills for patents which are to pass the Great Seal. The clerks of the Patent Bill Office (*i*) are in fact the deputies of the Attorney and Solicitor-general, and as their deputies, they prepare all bills for patents, which those officers are, by warrant from the Crown, directed to prepare. And upon receiving a warrant for a bill, the engrossing clerk will prepare it as of course, if no caveat has been entered against it.

The grant of a patent may be opposed at the bill.

The grant of a patent may now again be opposed at this stage of the proceedings, and such an opposition is usually

(*g*) The fees payable at the Home Office for a warrant in ordinary cases amount to 7*l.* 13*s.* 6*d.*; if there be more than one patentee there will also be a further fee of 1*l.* 7*s.* 6*d.* for each additional name; and if the patent is to extend to the Colonies and Channel Islands there will be an additional fee of 1*l.* 7*s.* 6*d.* The warrant is liable to a stamp duty of 1*l.* 10*s.*; but it is not stamped until after it is signed, and the practice is for the clerk of the Patent Bill Office to get the instrument stamped.

(*h*) This office (which is in Serle Street, Lincoln's Inn) must not be confounded with the office which is properly called the Patent Office, or Letters Patent Office (Quality Court, Chancery Lane), in which patents are engrossed and prepared for passing the Great Seal.

(*i*) The offices are in the gift of the Attorney-general for the time being.

called an opposition at the bill. Any person may oppose a patent at this stage whether he has opposed it at the previous stage or not, and for that purpose he must enter a caveat at the Patent Bill Office, which may be done at any time before the bill has received the signature of the Attorney or Solicitor-general.

Caveat to be entered at the Bill Office.

Object of entering a caveat at Bill Office.

The object of entering a caveat is twofold: *firstly*, that the bill may not be signed without the knowledge of the party who enters it; and *secondly*, to prevent the preparation of the transcripts of the bill until the opposition is disposed of, so that the party who opposes shall not have to pay the cost of the transcripts, if it be decided that the patent cannot be granted.

Form of caveat.

The caveat (*k*) is in substance a request that a bill for a patent to the petitioner for the particular invention, may not be granted without notice to the person who enters it, and the caveat being against the grant of a specific thing to a particular person named, it is called a specific caveat,—a caveat at the previous stage (the Attorney or Solicitor-general's chambers) being on the contrary a general caveat.

To be entered with clerk.

The caveat is to be entered with the clerk of the Patent Bill Office, or his deputy, and he will send a copy or notice of the caveat to the chambers of the Attorney and Solicitor-general (*l*).

Bill prepared by clerk of Patent Bill Office.

The warrant from the Crown for the preparation of a bill for a patent, is directed to the Attorney or Solicitor-general, and it is the duty of the officer to whom the warrant is delivered to see that the bill is prepared in accordance with the directions which are contained in the warrant. The Attorney or Solicitor-general does not, however, in ordinary cases, personally superintend the preparing or settling of the bill for a patent, the duty being performed by the clerks of the Patent Bill Office, as his deputies (*m*).

The established form of patent

The bill is prepared by the engrossing clerk of the Patent

(*k*) See the Form in the Appendix, Chap. II. s. 1.

(*l*) The fee for entering the caveat is 1*l.* 1*s.*

(*m*) The fees payable at the Patent Bill Office for the bill including stamps amount to 15*l.* 16*s.* in ordinary cases; if there are two or more inventors there is a further fee of 2*s.* 6*d.* to be paid for every additional name; and if the patent is to extend to the Channel Islands and Colonies or any of them, there will be an additional fee of 2*s.* 6*d.* The stamps amount to 6*l.*, which includes 1*l.* 10*s.* for the stamp to be impressed upon the warrant.

Bill Office, who adheres strictly to the established form in which the Crown has been accustomed to grant the sole use of inventions, and inserts, as directed by the warrant, "all such clauses, prohibitions, and provisoes, as are usual and necessary" (*n*), varying them indeed in some particulars when, according to the circumstances of the case, the patent grant is to be made to an actual inventor, or to a person who is an importer of a foreign invention;—or where the grant is to extend only to England, Wales, and Berwick-upon-Tweed; or where it is also to extend to the Channel Islands and Colonies.

Is strictly adhered to.

In preparing the bill, the clerk first copies the address or direction (*o*), and then the recital from the Queen's warrant, after which follows the grant, and other clauses in the usual form, as already mentioned.

The officers of several departments of the public service sometimes require the insertion of a reservation of a right to use the invention, and in such a case the special clause or clauses to be inserted in the patent are settled by the officers of the Crown requiring the reservation, and furnished to the engrossing clerk at the Patent Office, who will submit the clause to the Attorney or Solicitor-general, and if approved of by him, insert it in the patent.

Reservations in favour of the Crown.

When it becomes necessary to make any alteration in any part of the ordinary form of bill for a patent, the alteration must be specially approved of and ordered by the Attorney or Solicitor-general before it can be made.

Form of patent how altered.

The bill for the intended patent (*p*) contains the whole of the instrument precisely as it is intended to be made, with the exception of the formal conclusion, instead of which the words, "In witness, &c. Witness, &c." are written at the end of it.

Bill contains the whole of intended patent.

The bill is always written upon parchment (*q*), and at the foot of it is written the word "Examined," opposite to which the Attorney or Solicitor-general is to sign his name, in order to

Bill to be written upon parchment and signed by Attorney-general.

(*n*) As to the Form and Construction of a Patent, and its several clauses, see Chap. IV. p. 36.

(*o*) Vide *ante*, p. 40.

(*p*) See the Form in the Appendix, Chap. II. s. 1.

(*q*) A stamp duty of 1*l.* 10*s.* must be impressed upon the bill, and upon each of the transcripts prepared for the signet and privy seal.

testify that the bill has been prepared under his authority, and in the form which he approves of.

Docket to the bill.

Underneath the bill is also to be written a docket, or statement, certifying her Majesty of the nature, form, and effect of the intended grant, that all such clauses, prohibitions, and provisoes, are inserted in the bill, as are usual and necessary in grants of the like nature, and that the bill has been prepared by warrant under her Majesty's sign manual, and countersigned by the Secretary of State (*r*). This docket or statement is also to be signed by the Attorney or Solicitor-general before the bill is taken to the Home Office.

Bill sent to Attorney-general for signature.

The bill having been thus prepared at the Patent Bill Office, it will be taken by the engrossing clerk to the chambers of the Attorney or Solicitor-general for his signature to the bill and to the docket, and it is immaterial which of them signs it. If the bill is not opposed, the clerk to the Attorney or Solicitor-general will get the bill and docket signed by that officer, and return it to the engrossing clerk, who will take it back to the Patent Bill Office.

But when the patent is opposed at the bill, the bill, when prepared as already stated, will be marked "OPPOSED" by the engrossing clerk, and will be left at the chambers of the Attorney or Solicitor-general, in order to have the opposition disposed of, and it is the practice to take it to the chambers of the officer who reported in favour of the grant of the patent. The Attorney and Solicitor-general, however, frequently hear cases and sign bills for each other.

As soon as a bill against which a caveat has been entered is received from the engrossing clerk at the chambers of the Attorney or Solicitor-general, his clerk sends notice to the clerk of the Patent Bill Office, who immediately sends notice, by post, to each person who has entered a caveat against the patent, informing him that the bill has been lodged for signature, and also informing him of the time within which an opposition must be entered and a deposit made.

Opposition must be entered

If a person who has entered a caveat at the Patent Bill

(*r*) See the Form in the Appendix, Chapter II. s. 1.

Office intends to oppose the grant of the patent, he must enter his opposition at that office within three days after the date of the notice which he receives from that office, or the patent will be allowed to proceed. And a person entering a caveat after the warrant has been lodged, must, if he receives notice at the time of the warrant having been received, immediately enter his opposition, or the proceedings for obtaining the patent will not be stayed.

within three days after notice.

A person, who has entered a caveat, may, however, enter an opposition to a patent at the Patent Bill Office, at any time before the bill has actually been signed by the Attorney or Solicitor-general, but an opposition will not be entertained afterwards, although the signed bill has not been delivered to the petitioner or his agent.

Any person may enter opposition before bill signed.

A person who intends to oppose at this stage, must also, when he enters his opposition, deposit the sum of 30*l.* as a security for costs; and if he fails to do so, he cannot be heard in opposition to the grant of the patent to the petitioner, and the bill will be prepared as of course.

Person opposing must deposit 30*l.*

The reason why this deposit is required is, that if a person intends to oppose the grant of a patent for any particular invention, he ought to be sufficiently vigilant, and make his opposition in the first instance at the report, as it is called (*s*), that is, when the applicant comes to the Attorney or Solicitor-general for a report upon his petition. And if a person who has good ground for opposing the grant of a patent is guilty of *laches*, and by his negligence causes the applicant for a patent to incur costs which would be unnecessary if he had opposed at an earlier stage, it is but just that he should pay the unnecessary costs which he has in fact caused, if he succeeds in his opposition. And if a person opposing fails to make out a sufficient case against the applicant upon the hearing of the opposition, it is but fair that he should pay the applicant the costs of the hearing which the opposition has made necessary.

Reason why deposit required.

By compelling a person who seeks to oppose at this stage, first to deposit a sufficient sum as a security for costs, the Attorney or Solicitor-general acquires the means of awarding

(*s*) Vide *ante*, p. 512.

such amount of costs as he may think just, to the party whose petition is opposed.

Entry of opposition.

In order to enter an opposition to a patent at the bill, the party opposing, his solicitor or agent, should prepare a note of the opposition stating the name and address of the opposing party, and that he opposes the grant of a bill for the patent. This note should be taken to the Patent Bill Office, and the required amount (30*l.*) deposited with the clerk of that office, or his deputy, as a security for costs, who will then file the note and enter the opposition, of which he will send notice to the chambers of the Attorney or Solicitor-general.

If opposition entered a summons must be obtained.

If the grant of a patent is opposed at this stage, and the party opposing has made the necessary deposit, and entered his opposition, the patent will not be allowed to pass until the opposition has been disposed of, and the petitioner must, in order to proceed with the patent, procure from the clerk of the Attorney or Solicitor-general an appointment for a hearing before that officer, taking care that sufficient time is allowed for serving the summons upon the opposing party to attend the hearing. The Attorney or Solicitor-general's clerk will prepare a summons for the opposing party to attend the hearing, and transmit it to the Patent Bill Office, where it will be delivered to the petitioner or his agent, by whom a copy of it must be served upon the opposing party.

Service of summons.

The summons must be served upon the opposing party, or sent to him by post, so that it may be received three clear days before the day appointed for the hearing.

Hearing.

The hearing at this stage is conducted in precisely the same manner as the hearing of an opposition at the report which has already been described (*t*).

Decision.

If the opposition is successful, all further proceedings for obtaining the patent will be stayed, but if not the bill will be signed and passed as of course.

Deposit of description.

If the patent is to be granted, the applicant must deposit a description of his invention if he has not previously done so upon an opposition at the report (*u*), and if the previous description is found to be insufficient, it will be ordered to be amended.

(*t*) *Ante*, p. 513, 514.

(*u*) Vide *ante*, p. 515.

Costs.

Although a party opposing a patent at this stage has been compelled to make a deposit as a security for costs, yet the Attorney or Solicitor-general may in his discretion either give or refuse costs as he may think fit. The general rule, however, is, that when an opposition succeeds, the petitioner for the patent is allowed the amount which he has paid for the report, the Queen's warrant, the bill, the summons and hearing, and his agency fees (*x*). And when the determination upon the hearing of an opposition is in favour of the applicant for a patent, then the opposing party must pay the petitioner's fees payable for the hearing (*y*), as well as his own costs of the opposition.

Petitioner paid his costs and balance returned to opposing party.

When the opposition has been disposed of, the clerk of the Patent Bill Office will (unless otherwise directed by the Attorney or Solicitor-general) pay the petitioner the amount he is entitled to under the general rule just mentioned, and, after also deducting the fees payable by the party who opposed the patent, return the residue of the 30*l.* to him.

Amount of costs determined by clerk, subject to appeal.

The amount of the costs to be allowed to an applicant for a patent after disposing of an opposition at the bill, will be determined by the clerk of the Patent Bill Office, according to the result of the hearing, and the rules already mentioned; but if either party is dissatisfied with the determination of the clerk, he may appeal to the Attorney or Solicitor-general before whom the matter of the opposition was heard.

To be taken to Home Office.

The bill is now ready for delivery, and may be obtained at the office upon application by the petitioner, his solicitor or agent, by whom it must be taken to the office of the Secretary of State for the Home Department (*z*).

Bill receives the sign manual.

The bill will then be laid before her Majesty by the Secretary of State for the sign manual, which is always affixed at the commencement of the instrument.

(*x*) The amount allowed the petitioner in ordinary cases is 18*l.* 10*s.* 6*d.*—being 4*l.* 4*s.* for the report; 7*l.* 13*s.* 6*d.* for the warrant; 1*l.* 1*s.* for the bill; 3*l.* 10*s.* for the warrant and hearing; and 2*s.* 2*s.* for agency fees.

(*y*) The amount usually allowed is 3*l.* 10*s.* for the petitioner's hearing and summons; the opposing party must also pay 3*l.* 5*s.*, the fees for the hearing of his opposition, which will also be deducted from the 30*l.*

(*z*) The fees upon the bill at the Home Office amount to 7*l.* 13*s.* 6*d.* in ordinary cases; if the patent is to be granted to more than one person there will be a further fee of 1*l.* 7*s.* 6*d.* for each additional name; and if the patent is to extend to the Channel Islands and Colonies, or any of them, there will be an additional fee of 1*l.* 7*s.* 6*d.*

Bill then becomes the Queen's bill.

The bill when thus completed by the sign manual is called "The Queen's bill," and it is returned to the Secretary of State's office, where an entry of it will be made in a book kept for that purpose, and then the instrument will be delivered to the petitioner, his solicitor, or agent, upon application at the Home Office.

Transcripts of bill sent to Signet and Privy Seal Offices.

After the clerk of the Patent Bill Office has prepared the bill in the manner already described, he also prepares two transcripts of it on parchment (*a*), one of which he sends to the Signet Office, and which is intended to become the signet bill, and the other he sends to the Privy Seal Office to be afterwards made the Privy Seal bill, or writ of Privy Seal.

Queen's bill to be taken to Signet Office.

When the Queen's bill has been obtained from the Home Office, it must be taken to the Signet Office (*b*) to be passed (c). The signet is a royal seal which is always in the custody of the Secretary of State, and he has clerks under him called Clerks of the Signet (*d*), to whom are assigned the office of passing the Queen's bills to the Privy Seal (*e*), and which by the statute of 27 Hen. VIII. c. 11, s. 1 (*f*), they are directed to do within eight days after the Queen's bill is received at the Signet Office.

Queen's bill filed at Signet Office.

The Queen's bill is filed at the Signet Office as the warrant to the clerk of the signet in attendance (*g*), for preparing and issuing the signet bill to the Lord Privy Seal (*h*).

Signet bill.

In order to prepare the signet bill (*i*), the clerk of the signet takes the transcript of the bill prepared and transmitted to him from the Patent Bill Office, as already men-

(*a*) Each transcript must be impressed with a stamp duty of 1*l.* 10*s.*

(*b*) No. 28, Abingdon-street, Westminster.

(*c*) Stat. 27 Hen. VIII. c. 11, s. 1. See the statute in the Appendix, Chap. I. s. 1.

(*d*) 2 Inst. 556.

(*e*) See the statutes 57 Geo. III. c. 63, and 2 & 3 Will. IV. c. 49, respecting the offices of the clerks of the signet.

(*f*) See the statute in Appendix, Chap. I. s. I.

(*g*) There were formerly four clerks of the signet who attend in person or by deputy in rotation for three months at a time; but the office of one of them has been abolished, and there are now only three clerks, each of whom attends in person, or by deputy, for four months during the year. The business of the office is, however, chiefly transacted by the record clerk.

(*h*) See 8 Co. R. 18 b.

(*i*) The fees payable for a signet bill for a patent to be granted to one person amount to 4*l.* 7*s.*; if to more than one person 5*l.* 18*s.* 6*d.* extra is payable for every additional name, and if the patent is to extend to the Colonies and Channel Islands, the additional fees amount to 13*s.* 6*d.* The expedition fee is 1*l.* 11*s.* 6*d.* for which the signet bill may be passed the same day the Queen's bill is taken to the office.

tioned, and after examining it with the Queen's bill, and thus ascertaining that the transcript is a correct copy of the bill, he writes above it a command in the Queen's name to the Lord Privy Seal, to issue the Privy Seal bill to the Lord Chancellor commanding him to make the intended patent.

Below the bill the clerk writes some words to testify that the command given is made under her Majesty's signet and the date of the bill, and then in pursuance of the statute (*k*), he subscribes his name to the bill. On the outside of the bill is also written a direction to the Lord Privy Seal (*l*).

Bill to be sealed at Home Office.

A docket of the bill having been entered in the docket book of the Signet Office, stating the name of the intended patentee, and the substance of the grant, the bill is taken by one of the clerks in that office to the office of the Secretary of State for the Home Department, where it is to be sealed with the signet, and then it is to be taken back to the Signet Office.

Opposition at Signet bill.

An opposition to a patent is now never made at the signet bill, but the writer has been informed at the Signet Office that caveats were formerly entered in that office; and there can be no doubt that any person may oppose the grant of a patent at that as well as at every other stage of the proceedings for obtaining it. The opposition would however be referred by the Secretary of State to the Attorney or Solicitor-general, and therefore, if the patent has been previously opposed, the opposition at this stage would only produce a rehearing before the same officer. And as a party would gain no advantage by such a rehearing, or by an opposition at the signet bill instead of any preceding stage, oppositions at this stage have fallen into disuse.

Signet bill sent to Privy Seal Office.

When the signet bill has been completed in the manner already described, it is to be taken to the Privy Seal Office, in order to procure the Privy Seal bill or writ of Privy Seal, and as the Signet Office and Privy Seal Office are at present both in the same building (*m*), it is usual for a clerk in the Signet Office to take the signet bill to the Privy Seal Office, when it has been completed.

The signet bill being received in the Privy Seal Office, the Privy Seal bill

(*k*) 27 Hen. VIII. c. 11, s. 1. Appendix, Chap. I. s. 1.

(*l*) See the Form of the bill in the Appendix, Chap. II. s. 1.

(*m*) No. 28, Abingdon-street, Westminster.

to be prepared in eight days.

clerk of the Privy Seal is, in pursuance of the statute 27 Hen. VIII. c. 11, s. 2, to prepare the Privy Seal bill within eight days afterwards, unless he is otherwise commanded by the Lord Privy Seal (*m*).

Patent may be opposed at the Privy Seal.

The grant of a patent may again be opposed when the bill comes to the Lord Privy Seal (*n*). For although the signet bill commands the Lord Privy Seal to issue her Majesty's warrant or writ to the Lord Chancellor to make the letters patent, yet the command is to be understood as a qualified command; that is, that his Lordship is to issue the warrant or writ if it be legal or just so to do.

Caveat at Privy Seal Office.

In order to oppose the proceedings for a patent before the Lord Privy Seal, the party opposing it must enter a caveat (*o*) and opposition at the Privy Seal Office, in the same manner as at the Patent Bill Office (*p*).

Before whom opposition heard.

An opposition at this stage has sometimes been heard before the Lord Privy Seal himself, and at other times he has referred the matter to a committee, or officer, to consider and report to his Lordship (*q*).

The Privy Seal is now seldom delivered to a lawyer, and therefore oppositions to patents at this stage have become of very rare occurrence; but the power remains, and if the Lord Privy Seal were a lawyer, it is probable that oppositions would frequently be made before him instead of the Lord Chancellor, as being less expensive and likely to be more expeditiously disposed of.

Privy Seal bill, how prepared.

In the absence of any caveat, or opposition, the clerk of the Privy Seal, in order to prepare the writ of Privy Seal, or Privy Seal bill, having examined the transcript of the bill sent from the Patent Bill Office and compared it with the signet bill, writes above the former her Majesty's command to the Lord Chancellor, that under the Great Seal in his custody, he cause her Majesty's letters to be made patent in the form which follows (*r*). And underneath the bill he writes, "Given under our Privy Seal at our Palace at Westminster," and also the date when the Privy Seal is affixed to the instrument (*r*).

(*m*) See the statute in the Appendix, Chap. I. s. 1.

(*n*) *Ex parte Daly*, Vern. & Scriv. 499.

(*o*) See the Form in the Appendix, Chap. II. s. 1.

(*p*) Vide *ante*, p. 524.

(*q*) *Ex parte Daly*, Vern. & Scriv. 502.

(*r*) See the Form in the Appendix, Chap. II. s. 1.

To the Privy Seal bill thus prepared, the clerk of the Privy Seal, subscribes his name in pursuance of the statute 27 Hen. VIII. c. 11, s. 2, and an entry or docket of it is then to be made in the docket book of the office, stating the name of the grantor, the substance of the grant, and the date of the Privy Seal bill.

Bill to be subscribed by clerk.

Documents to be sealed with the Privy Seal, which are addressed to particular officers or persons, are always folded, so that when sealed the contents may be completely concealed (*r*). The Privy Seal bill is therefore folded in this manner by the clerk, with a label attached to it and exposed to view, directed to the Lord Chancellor, to whom the bill or writ is to be delivered.

Bill folded so as to conceal contents.

There is a public seal day on Friday in every week, at which Privy Seal bills may be sealed, but a bill may be sealed at a Private Seal, on any other day on payment of an additional fee (*s*).

Public seal on Friday.

In order to procure a Privy Seal bill to be sealed on the public seal day, the signet bill must be taken into the Privy Seal Office on the day before the seal day; but a Privy Seal bill will be prepared and sealed the same day that the Signet bill is delivered at the Privy Seal Office, upon payment of an expedition fee (*t*).

Privy Seal bill when prepared.

The Privy Seal being in the custody of the Lord Keeper of it, all bills and other instruments which are to be sealed with the seal, must be taken to his Lordship, and when he is out of town, the instruments are forwarded to him by post to be sealed by one of his officers.

Privy Seal bill, how sealed.

The Privy Seal bill having been sealed is taken back to the Privy Seal Office, where the signet bill is filed, as the Lord Privy Seal's warrant for what he has done in pursuance of it (*u*).

Signet bill filed at the Privy Seal Office.

When the Privy Seal bill, or writ of Privy Seal, has thus been completed, it will be delivered to the petitioner, his solicitor, or agent, upon application at the Privy Seal Office,—to be taken into Chancery (*x*).

Privy Seal bill delivered to applicant.

(*r*) Grants which pass under the Privy Seal only, are called letters of Privy Seal, and are not folded as mentioned above, but are left open like a patent.

(*s*) Vide 2 Inst. 556; 8 Co. R. 18, b.

(*t*) 2*l*.

(*u*) 1*l*. 11*s*. 6*d*.

(*x*) The fees payable at the Privy Seal Office upon a patent to a single person for England and Wales amount to 4*l*. 2*s*.; if to more than one person 5*l*. 18*s*. 6*d*. extra is payable for each additional name, and a further fee of 13*s*. 6*d*. is to be paid if the patent is to extend to the Colonies and Channel Islands, or any of them.

Privy Seal bill to be taken to Patent Office.

The Privy Seal bill is to be taken to the Patent or Letters Patent Office (*t*), and left with the clerk of that office, or his deputy, by whom the letters patent are to be prepared, and he will take off the Privy Seal (which he must do to open the instrument) and indorse upon it the day of the month when he receives it.

Subsequent proceedings are in Chancery.

After the delivery of the Privy Seal bill to the clerk of the patents, the whole of the proceedings for obtaining a patent take place on the Common Law side of the Court of Chancery (*u*), of which the Lord Chancellor is sole Judge (*x*). And there are several officers of this Common Law side of the Court whose duty it is to prepare, seal, and enrol letters patent and other instruments which pass the Great Seal; as, the clerk of the patents (*y*), the sealer or sigillator (*z*), the chafe wax (*a*), and the clerk of the enrolments (*b*).

Making a patent is a judicial act.

It is the delivery of the Great Seal which constitutes the Lord Chancellor sole judge of the Court of Chancery, and the making of a patent by affixing the Great Seal, is a judicial act by which the Lord Chancellor, as Judge of the Queen's Court of Chancery, makes a record of the Queen's grant in pursuance of her command (*c*).

Patent may be opposed at the Great Seal.

The grant of a patent may be again opposed when the petitioner comes to the Lord Chancellor to have it made under the Great Seal, in pursuance of the writ of Privy Seal,—for, as it has already been shown (*d*), the command contained in the writ of Privy Seal must be understood as being conditional, and that the Lord Chancellor is only to make the patent if he shall be of opinion that the proposed grant will not be illegal or unjust.

Caveat.

When a person intends to oppose a patent at the Great Seal, he must enter a caveat (*e*) at the Patent Office, against affixing the Great Seal to the patent (*f*). If such a caveat be entered before the Privy Seal bill comes into the Patent Office, the person who enters the caveat will be entitled to

(*t*) In Quality Court, Chancery Lane.
(*u*) See 1 Shep. Abr. tit. Court, p. 464.
(*x*) 4 Inst. 80, 84.
(*y*) 1 Shep. Abr. tit. Court, pl. 14, p. 467; 4 Inst. 82.
(*z*) 2 Inst. 554; 4 Inst. 82; 1 Shep. Abr. p. 467.
(*a*) 4 Inst. 82; 1 Shep. Abr. p. 467.
(*b*) 1 Shep. Abr. p. 467.
(*c*) Vide *ante*, Chap. IV. p. 37.
(*d*) *Ante*, Chap. IV. p. 38.
(*e*) See the Form in the Appendix, Chap. II. s. 1.
(*f*) The fee for entering a caveat is 10*s*.

receive notice by post from the Patent Office of the Privy Seal bill having been lodged at that office.

A caveat may however be entered at the Patent Office against a patent, at any time before the Great Seal has actually been affixed to the patent, and if it be entered after the Privy Seal bill has come into the office, notice of that fact will be given to the person who enters the caveat at the time of entering it.

Caveat may be entered at any time before patent sealed.

The caveat which is thus to be entered at the Patent Office, is a specific caveat against a particular grant; and although it was formerly the practice to receive and enter general caveats at that office, in precisely the same way that such caveats are now entered at the chambers of the Attorney and Solicitor-general, that practice was abolished by order of Lord *Brougham*, L. C., and no general caveat can now be entered at the Patent Office against a patent for an invention.

No general caveat can be entered at Patent Office.

A caveat has the effect of staying all proceedings respecting the patent during the three days allowed to the party for entering an opposition.

Caveat stays proceedings three days.

When notice is sent to a person who has entered a caveat, he is (in effect) allowed three days to determine whether he will oppose the patent or not, and if he intends to oppose the preparation and sealing of the patent in pursuance of the Privy Seal bill, he must enter an opposition on or before the expiration of the third day after the date of the notice, or the patent will be allowed to pass as of course. But when a person who enters a caveat, receives notice at the time of entering it, that the Privy Seal bill has already been lodged at the Patent Office, he must then enter an opposition, or the patent will be passed as of course.

Opposition to be entered within three days after notice,

or at the time of entering the caveat.

An opposition to a patent may, however, be entered at any time before the patent has actually been sealed with the Great Seal.

May be entered any time before patent sealed.

The opposition to a patent at this stage must be entered at the Patent Office with the clerk of the patents, and it will have the effect of preventing any proceedings from being taken upon the Privy Seal bill, if none have been taken at the time it is entered; or if the opposition is not entered until after the preparation of the patent has been commenced, the entry

Opposition to be entered at Patent Office.

Effect of opposition.

will have the effect of staying all further proceedings, until the opposition is disposed of, and the Lord Chancellor orders the patent to be prepared and sealed.

Applicant must petition to have the patent sealed.

In order to discharge the caveat and remove the stop (as it is called) to the preparation and sealing of the patent, the applicant for the patent must prepare a petition stating all the facts and proceedings, and praying that letters patent may be made and sealed in pursuance of the writ of Privy Seal.

Form of petition.

The facts to be stated in the petition respecting the invention, will be the same as those stated in the petition to the Crown, and it must also be shown, that the petitioner applied by petition to the Queen, that all the necessary proceedings have been taken, that the writ of Privy Seal has been lodged at the Patent Office, and that the preparation or sealing of the patent has been prevented, by a caveat and opposition entered at the same office.

Affidavits.

The material allegations of this petition must be supported by affidavit, to be sworn before a Master (ordinary or extraordinary) in Chancery (*g*).

Petition to be lodged at Patent Office.

The petition, together with the affidavits, must be lodged at the Patent Office, and the clerk of the patents will procure the petition to be answered by the Lord Chancellor (*h*), directing it to be put in the paper for the next petition day, and the petitioner or his solicitor must immediately afterwards serve his opponent with a copy of the petition and answer.

Affidavits of party opposing.

If the party opposing wishes to bring any additional facts before the Lord Chancellor, he must do so by affidavit, sworn before a Master in Chancery, and filed at the Patent Office.

Office copies.

Each party may obtain office copies of his opponent's affidavits, or any other documents filed at the Patent Office, in the ordinary way (*i*).

Solicitors to be employed in opposed cases.

Parties soliciting an opposed patent at this stage, and the party opposing must conduct their proceedings in person, or employ a solicitor of the Court, for patent agents who are not solicitors cannot legally conduct any proceeding in Chancery.

(*g*) An affidavit to be used on the Common Law side of the Court of Chancery, ought not to be sworn before the clerk of the Affidavit Office, for he is an officer of the Equity side of the Court only.

(*h*) The fees for this amount to 13*s.* 6*d.* being the same as upon Chancery petitions.

(*i*) The cost of office copies is the same as for other office copies in Chancery, which at present is four pence for every Chancery folio of ninety words.

It is usual to apply to the Lord Chancellor to have the petition advanced, and to have a day appointed for hearing the matters of the petition and opposition, and his Lordship will generally appoint an early day for that purpose. Appointment of hearing.

The hearing sometimes takes place in the Lord Chancellor's private room, and his Lordship will, *if necessary*, hear each party separately and in private (*h*). In one case (*i*), there was a hearing in public; his Lordship then saw the parties and their models, and afterwards gave his judgment in open Court. Hearing sometimes in private.

But the parties will be heard in the presence of each other, or in public, if such a hearing will not prejudice either of them. Thus, in *Cutler's* case (*k*), the opposing party did not intend to obtain a patent for his invention, and he was therefore desirous that each party should be heard in the presence of the other, in order that he (the opposing party) might have the advantage of knowing what the petitioner's invention was, and judging whether it was such an invention as might be legally made the subject of a patent privilege. And as the petitioner had of course previously delivered the Privy Seal bill into Chancery, the Lord Chancellor was able to make a patent bearing date prior to the day of the hearing, and therefore the petitioner could not be materially prejudiced if his application for a patent was granted. For these reasons, each party was heard in the presence of the other, upon the reference by the Lord Chancellor to the Attorney-general, and afterwards before the Lord Chancellor himself. Parties heard in presence of each other, or in public in some cases.

The Lord Chancellor will generally refer the matters of the petition and opposition to the Attorney or Solicitor-general to report specially to his Lordship respecting the facts, and the propriety of granting the prayer of the petition (*l*), and direct the petition to stand over until after the report has been made. Reference to Attorney-general.

Upon such a reference the Attorney or Solicitor-general must have copies of the petition and affidavits laid before him, and he will appoint a day for hearing the parties, when he will Hearing before Attorney-general.

(*h*) See the reasons given, *ante*, p. 514, for a hearing in private before the Attorney or Solicitor-general.

(*i*) *Ex parte Fox*, 1 V. & B. 67.

(*k*) 1 Webs. R. 418.

(*l*) *Ex parte Henson in re Alcock*, 1 Webs. R. 432; *in re Cutler*, 1 Webs. R. 418.

hear the parties and their counsel separately, or in the presence of each other, according to the circumstances of the case.

Order on report.

If the parties are satisfied with the Attorney or Solicitor-general's report, the Lord Chancellor will, as of course, make an order in accordance with the recommendation contained in the report.

Hearing after report.

But if either party is dissatisfied with the Attorney or Solicitor-general's decision, he must prepare a petition to the Lord Chancellor, stating his exceptions to the report, and lodge it at the Patent Office to be answered and put in the paper in the manner already mentioned, and upon application to the Lord Chancellor, his Lordship will appoint a day when he will hear the parties and their counsel, and dispose of the petitions as he may think just.

Cutler's case.

In *Cutler's* case (*m*) there had been no opposition at any prior stage of the proceedings, and upon a petition to discharge a caveat at the Patent Office, and to seal the patent, Lord *Cottenham*, L. C., ordered the matters of the petition to be referred to the Attorney-general to enquire and report to the Lord Chancellor whether the patent ought to issue, that all parties should be restrained from doing any act respecting the invention until after the report, and that if the Attorney-general should report that the patent ought to issue, it should be sealed as of the 12th March, being the day the patent would have been sealed if there had been no caveat. The Attorney-general reported to the Lord Chancellor that he was of opinion that the patent ought not to issue, and the petitioner being dissatisfied with the Attorney-general's determination, presented another petition to the Lord Chancellor to seal the patent, stating the grounds upon which he excepted to the Attorney-general's report, and the petition was also supported by further affidavits. This petition was heard before the Lord *Cottenham*, L. C., and his Lordship ordered the patent to be sealed as prayed.

Cases of Samuda and Griffiths.

In two recent cases, *in re Samuda*, and *in re Griffiths*, each party was applying for a patent for an invention which had previously been made the subject of a *specified* patent

(*m*) 1 Webs. R. 418.

granted to Mr. Samuda for Scotland (*n*), and each party had gone through all the preliminary proceedings for obtaining a patent without opposition, but when they came to the Patent Office, each party was opposed by a caveat entered by the other. Each party then petitioned the Lord Chancellor to seal his patent, and his Lordship referred both petitions to the Solicitor-general to enquire and report whether the patents, or either of them, ought to issue. The Solicitor-general, after hearing counsel for each of the parties, reported that the invention had already been published in the United Kingdom, (in Scotland,) and therefore, according to the decision in *Brown* v. *Annandale* (*o*), it could not legally be made the subject of a patent, and that no patent ought to be granted to either of the petitioners. The petitioner *Griffiths* being dissatisfied with the Solicitor-general's report presented a second petition stating his exceptions to the report, and praying that his patent might be sealed. The matters of these petitions were heard before Lord *Lyndhurst*, L. C., when his Lordship held, that the invention having been published in another part of the realm, it could not be made the subject of a patent privilege in England, and that neither of the patents could be sealed.

Ex parte Dyer.

In *ex parte Dyer* (*p*), it appeared that a person had applied for a patent, and another person had subsequently applied for a patent for the same object. In consequence, however, of the progress of the first application having been delayed, the second applicant was in advance of the other, and in a position to seal his patent first, and Lord *Eldon*, L. C., held, that in concurrent applications for a patent, for the same object, that which obtains the Great Seal first, will have the sole right at Law, and his Lordship said, "I can see no other mode of deciding, than by awarding the patent to him who runs the quickest through the process."

Costs.

The Lord Chancellor has jurisdiction (as Judge of the Court of Chancery) to give costs to parties who appear before him upon petitions to seal patents.

Ex parte Fox.

In the case of *ex parte Fox* (*q*), Lord *Eldon*, L. C., re-

(*n*) See *Brown* v. *Annandale*, 1 Webs. R. 433.

(*o*) 1 Webs. R. 433.

(*p*) Parl. Rep. on Pat. 1829, p. 197, and *Holroyd* on Pat. 59, *S. C.*

(*q*) 1 V. & B. 67.

fused to give the petitioner his costs, on the ground that his Lordship did not think that the opposition was unreasonable.

In re Alcock. But *in re Alcock* (*r*), Lord *Brougham*, L. C., granted the petitioner his costs, and Lord *Cottenham*, L. C., ordered the opposing party to pay the petitioner's costs in *Cutler's* case (*s*). So also in *Nickel's* case (*t*), Lord *Cottenham*, L. C., ordered a party petitioning to have an altered patent resealed, to pay the costs of a party who had entered a caveat, and successfully opposed the petition.

Cutler's case. Taxation of costs. In *Cutler's* case (*u*), the costs of Cutler, the petitioner, were taxed in the ordinary manner as between party and party, and the petitioner being dissatisfied with the taxation, presented a petition to the Lord Chancellor, stating that by the taxation, the travelling expenses of the petitioner and his solicitor, incurred in procuring evidence, certain fees to counsel, scientific men, &c. &c. were disallowed, and praying that it might be referred back to the Master to review his taxation, and to allow the petitioner all costs, charges, and expenses reasonably incurred in consequence of the opposition to the patent. The petition was heard before Lord *Cottenham*, L. C., who dismissed it with costs.

If patent refused, no order drawn up unless costs ordered. If the Lord Chancellor decides that a patent ought not to be sealed in pursuance of the Privy Seal bill, it is unnecessary to draw up any order unless the petitioner is directed to pay the opposing party his costs. But the clerk of the patents records the Lord Chancellor's judgment by an indorsement on the Privy Seal bill, which is filed of record in the Patent Office.

If patent to be granted or costs paid, an order is drawn up. When the Lord Chancellor grants the prayer of a petition to have a patent sealed, or refuses it, and orders the petitioner to pay his opponent's costs, an order must be drawn up for giving effect to the Lord Chancellor's judgment. The order will be drawn up by the clerk of the patents, who will also procure the Lord Chancellor's signature to it (*v*). The order is filed in the Patent Office.

If no caveat, patent pre- If no caveat or opposition has been entered at the Patent

(*r*) Cit. 4 My. & Cr. 511, and Webs. on Pat. p. 134 (101).
(*s*) 1 Webs. R. 418.
(*t*) Turn. & Phil. 36; 1 Webs. R. 656; but not reported in the point above stated, vide *ante*, p. 218.
(*u*) 4 M. & Cr. 510.
(*v*) The cost of the order varies according to the length of it.

Office against the sealing of a patent, it will be prepared and sealed, as of course, in pursuance of the Privy Seal bill, or writ of Privy Seal. If the patent has been opposed, and the Lord Chancellor upon petition has decided that the patent must be granted, it will be prepared and sealed as soon as his Lordship's order for that purpose has been drawn up and signed.

pared as of course.

If patent opposed, it will be sealed as soon as order made.

When the patent is to be prepared, the clerk of the patents in the first place writes the *recepi* in the margin of the Privy Seal bill, stating the day when the Lord Chancellor received the bill, being the same day that the patent is to bear date. The *recepi* is to be signed by the Lord Chancellor, and it is usually in the following form:

Recepi.

"Received the [*eighteenth*] day of [*September,*] 1845."

(*Signed*) "LYNDHURST, C."

This is done in pursuance of the stat. 18 Hen. VI. c. 1 (*x*), which requires the date of the delivery of the bill to the Lord Chancellor to be entered of record in Chancery, and prohibits a patent being made in pursuance of the bill bearing date on any prior day.

Recepi made in pursuance of stat. 18 Hen. VI. c. 1.

The delivery of a Privy Seal bill to the clerk of the patents, who is the officer of the Lord Chancellor, is in effect a delivery of it to the Lord Chancellor himself, and therefore his Lordship may direct the date of the delivery to be recorded in the *recepi* as of any day after the Privy Seal bill is lodged at the Patent Office.

Date of *recepi.*

The sealing of a patent is sometimes very considerably delayed by an opposition, and in order to prevent the petitioner being prejudiced in such a case, the Lord Chancellor will generally direct the delivery of the Privy Seal bill to be recorded in the *recepi* as of the earliest day upon which the patent might have been sealed if there had been no opposition, so that the patent when made may bear date as of that day (*y*). But in other cases it is the practice to record the delivery of the Privy Seal bill as of the day when the *recepi* is signed by the Lord Chancellor, and the patent sealed. And as a party may at all times procure an unopposed patent to be prepared with expedition, and sealed

(*x*) See the Statute in the Appendix, Chap. I. s. 1.

(*y*) See *Cutler's* Case, 1 Webs. R. 418, 430.

at a private seal, it is his own fault if he is prejudiced by any delay in the preparation and sealing of it.

Clerk of patents engrosses the patent.

The clerk of the patents also engrosses the patent upon parchment, copying it verbatim from the Privy Seal bill, only instead of the abbreviated conclusion "In witness, &c., witness, &c.," he adds the proper conclusion, with the date in words at length (*x*).

Patent to be dated the day recorded by *recepi*.

According to the statute of 18 Hen. VI. c. 1 (*a*), a patent is to be made in pursuance of a warrant or writ from the Crown, bearing date the day mentioned in the *recepi*, *and not before*. And the Act declares that if any letters patent be made to the contrary they shall be void.

A patent is always dated as of the current year of the Queen's reign, not as of the year of our Lord.

Patent how subscribed.

Patents for inventions are always made in pursuance of a command to the Lord Chancellor, contained in a bill or writ under the Privy Seal, and therefore every patent of that description is subscribed, "By writ of Privy Seal," in order to show upon the face of it by what authority the patent has been made (*b*).

A patent is also to be subscribed with the name of the clerk of the patents as the officer by whom the instrument has been prepared.

Docket.

The clerk of the patents also prepares a docket (*c*) for the Lord Chancellor's signature containing the name of the party to whom the patent is to be granted, the title of the invention, the extent and duration of the grant, the time allowed for specification, and the date of the patent. The words, "By writ of Privy Seal," and the name of the clerk of the patents, are also to be subscribed to the docket.

Documents to be signed by Lord Chancellor.

The documents having been prepared in manner already described, the Privy Seal bill is laid before the Lord Chancellor to obtain his Lordship's signature to the *recepi*. The docket is also to be signed by his Lordship to authorize the sealing of the patent, and he usually signs it with his initials only.

(*x*) See the Form in the Appendix, Chap. II. s. 1.
(*a*) See the Statute in the Appendix, Chap. I. s. 1.
(*b*) Vide 8 Co. R. 18, b.
(*c*) See the Form in the Appendix, Chap. II. s. 1.

The sealing of a patent, as well as any other instrument, may take place either on a public seal day, or at a private seal (*d*). And in order to have a patent prepared and sealed on a public seal day, the Privy Seal bill must be taken to the Patent Office two clear days before the seal day. Sealing patent.

The patent is sealed by the sigillator, or sealer, to whom must be produced the docket bearing the Lord Chancellor's signature as his warrant, and the engrossment of the patent, and upon seeing that they correspond with each other, he will affix the Great Seal to the patent (*e*).

The patent having been sealed, all the documents are taken back to the Patent Office, where the Great Seal and patent will be put into a case, and then delivered to the patentee or his agent (*f*). Patent delivered to patentee.

The docket is then entered into the docket book of the Patent Office, to which the public has access, and from that book the public derive their information respecting patents which have been sealed. Entry in docket book.

The Privy Seal bills and dockets upon which patents have been made, are kept in the Patent Office until they are sent to the Enrolment Office, which is done annually in the month of October, in order that the clerk of records and enrolments may prepare the enrolments of the patents, which have been made in pursuance of those Privy Seal bills. Privy Seal bill sent to Enrolment Office.

Patents are always enrolled or entered of record, upon rolls called patent rolls (*g*), and as a Privy Seal bill contains the whole of the patent made in pursuance of it, the patent itself is always delivered to the patentee, in order that he may have evidence of his title and immediate possession of his privilege, and the enrolment is made from the Privy Seal bill. Although copied from the Privy Seal bill for the sake of convenience, the enrolment is, however, the enrolment of the patent and not of the Privy Seal bill (*h*). Patents enrolled upon patent rolls.

(*d*) Vide *ante*, p. 390. If an applicant opens the Great Seal in order to procure his patent to be sealed he must pay an extra or opening fee of 2*l*.

(*e*) The fees payable at the Patent Office for a patent to one person for England and Wales only, when sealed at a public seal, amount to 48*l*. 17*s*.; and if there are two or more patentees an additional fee of 2*l*. 13*s*. 4*d*. is to be paid; but there is no further fee when the patent extends to the Channel Islands and Colonies.

(*f*) Vide *ante*, p. 38.

(*g*) Vide *ante*, pp. 38 and 219; and 2 Blac. Com. 347.

(*h*) See *Nickel's case*, 1 Webs. R. 660.

Abbreviations.

In enrolling a patent, it is the practice to abbreviate the direction or address at the commencement of the enrolment of a patent, thus, "Victoria, by the grace of God, &c. To all to whom these presents shall come greeting, Whereas," &c., and after copying the whole of the body of the patent verbatim, then to abbreviate the conclusion thus, "In witness, &c., witness, &c., the [*eighteenth*] day (*g*) of [*September*]," and these abbreviations seem to be made for the purpose of avoiding unnecessary repetitions upon the rolls.

Patent rolls, how prepared.

The patent rolls are composed of long narrow strips of parchment called membranes, fastened together, and rolled up. The patents of each year of the Queen's reign are entered upon a distinct set of rolls, although perhaps, in contemplation of law, all the patent rolls are to be considered as but one roll or record. The patents of every year are copied upon membranes, such as have been mentioned, nearly in the order of their dates (but that is not requisite), the commencements and and conclusions of the patents being abbreviated in the manner which has been described.

Each membrane of parchment is numbered, and also indorsed in this manner:—"Patents of the [*ninth*] year of the reign of Queen Victoria," and the enrolments having been written or engrossed upon them, they are fastened together in proper order so as to form rolls, called parts, of a convenient size, and these parts are numbered in arithmetical order, "first part," "second part," and so on. There are about thirty of these parts or rolls for each year of the Queen's reign, and there are about fifty membranes in each part.

Where the rolls are kept.

The patent rolls are kept about two years in the Enrolment Office, after which they are sent to the Petty Bag Office, together with the Privy Seal bills and dockets; and the reason for adopting this practice seems to have been, that the clerks of the Petty Bag might examine the rolls and see that they were correct (*h*). It has, however, long ceased to be the practice to examine the enrolments after they are transferred to the Petty Bag Office.

The patent rolls remain in the Petty Bag Office until they are about fifteen years old, and then they are finally sent

(*g*) See the Form in the Appendix, Chap. II. s. 1.

(*h*) See Collier on Patents, p. 196.

into the Office of the Rolls Chapel, together with the Privy Seal bills.

Office copies of the enrolment of a patent may be had at any of the offices in which the enrolment is deposited (*a*).

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2. *Of the Practice respecting the Preparation and Enrolment of Specifications for Patent Inventions.*

Patentee ought to enquire if there is any prior patent with a title which might include his invention.

After a patent has been sealed, the patentee ought to examine the list of patents granted during the preceding six months, in order to ascertain whether there is any patent for an invention with such a title as would be large enough to include his invention. If he finds that the title contained in any prior unspecified patent would be sufficient to describe or include his invention, he ought to be very circumspect, and ought not to communicate his invention to any but persons in whom he can place reliance, until the prior patent has been specified. The reason is, that a prior patentee having a patent with a title sufficiently large to include the subsequent invention, might, if it came to his knowledge, introduce into his specification a description not only of his own invention, but also of that of which he has subsequently obtained a knowledge, and thus the subsequent patentee might be totally deprived of the fruits of his labour and ingenuity.

Patents occasionally obtained for a fraudulent purpose.

And it is the more necessary for a patentee to be cautious in this respect, because persons have frequently been known to obtain patents containing titles couched in the most general and indefinite terms, for the purpose of afterwards including in their specifications any novelty of which they may obtain a knowledge during the time allowed for the enrolment of that instrument, and which would be covered by the title.

Performance of condition for enrolling specification.

The patentee has now to perform the condition upon which he has obtained his patent, in pursuance of which he must, within the time limited by the proviso, ascertain and de-

(*a*) At the Enrolment Office the cost of an office copy is 8*d.* for every folio of ninety words, 2*d.* per sheet for the paper, 2*s.* for the certificate of examination, and 1*s.* for the search;—at the Petty Bag Office the charge is also 8*d.* per folio, and 2*d.* per sheet for the paper, but the certificate fee is 3*s.* 4*d.* and the search and inspection 3*s.* 6*d.*;—and at the office of the Rolls Chapel, 6*d.* per folio is charged for a plain copy, and 1*s.* per folio for an authenticated copy;—the stamps are to be paid for in addition to these fees at each of the offices.

scribe the nature of his invention, and the manner in which it is to be performed, by an instrument in writing under his hand and seal, which is usually called a specification; and he must also cause that instrument to be enrolled in Chancery.

Importance of specification.

The specification is a most important instrument, with reference to the patentee's title to the privilege granted by the patent, and the utmost care ought to be taken to prepare it it correctly.

Great skill required for preparing specification.

Few instruments require greater skill to be exercised in their preparation than specifications, and more patents have been lost in consequence of the insufficiency of specifications than for any other cause. Specifications are, indeed, now prepared in a much less objectionable manner than formerly, but there is still room for very great improvement.

Advantage of having it prepared by a competent person.

In consequence of the great cost of a patent, the patentee is generally anxious to have his specification completed at as small a cost as possible, and therefore he either prepares the instrument himself, or has recourse to the assistance of some person who is willing to render his services for a small remuneration, and such persons are generally wholly incompetent to discharge the duty of settling this most important instrument.

If an invention is really of value, the patentee will always find it cheaper to have his specification prepared or settled by a competent person, for although by so doing he will enhance the cost in some degree, yet he will render his patent more secure, and probably save the cost of proving the sufficiency of the instrument in a Court of Law.

Form and requisites of specification.

The form and requisites of a specification have already been examined in a former part of this work (*h*), to which the reader is referred. And it ought always to be borne in mind by those who settle specifications, that *the law requires the specification to be prepared with the utmost good faith on the part of the patentee*, and that too great care cannot be taken to ensure the accuracy of the instrument. The object of the specification being that the public should have information of what the prohibition in the patent extends to, during the term it grants, and what the public are to acquire the right of

(*h*) *Ante*, Chap. VII. p. 151; and see the Form in the Appendix, Chap. II. s. 1.

doing after the patent has expired; the specification should distinctly point out what the invention is, so that every one may clearly understand what he is prohibited from doing; and the manner of using or practising the invention should be described with such accuracy, that any competent person will after the expiration of the term be enabled to practise the invention without difficulty or further instruction.

Ought to be written on parchment.

The specification is usually written upon parchment, and although it might be put upon paper, it is always better to have it written upon a more durable article (*i*).

To be signed and sealed.

It must be signed and sealed by the patentee himself, or if there be two patentees, it will be sufficient if it be signed and sealed by either of them.

Acknowledgment.

If the specification is intended to be enrolled in the Enrolment Office, it must be acknowledged before a Master (ordinary or extraordinary) in Chancery (*k*), for without such an acknowledgment, it cannot be enrolled in that office (*l*). But in the Petty Bag and Rolls Chapel Offices no acknowledgment is required.

Specification where to be enrolled.

There are three offices in Chancery in which specifications may be enrolled; they are the Enrolment Office (*m*), the Petty Bag Office (*n*), and the Rolls Chapel Office (*n*), and a patentee is at liberty to enrol his specification in whichever of those offices he thinks fit (*o*).

Advantage of enrolling in the Rolls Chapel Office.

When a specification is enrolled in the office of the Rolls Chapel, the patentee and the public acquire the advantage of

(*i*) It must be stamped with the duty of 3*l.*, and a progressive duty of 1*l.* must be paid for every entire quantity of fifteen folios (of seventy-two words each) over and above the first fifteen folios.

(*k*) See the Form of Acknowledgment in the Appendix, Chap. II. s. 1.

(*l*) In Co. Lit. 225, b, it is said that no deed, &c. can be enrolled unless it be duly and lawfully acknowledged.

(*m*) Chancery Lane.

(*n*) In the Rolls Yard, Chancery Lane.

(*o*) The cost of enrolment in the Rolls Chapel Office is much less than in either of the other offices. In the Roll's Chapel Office it is sixpence for every Chancery folio of ninety words; —at the Enrolment Office the charge is 10*s.* for every membrane or skin entirely occupied by the enrolment, (a membrane usually containing about ten Chancery folios) and for any portion of a membrane less than the whole a charge is made at the rate of 6*d.* for every five lines;—the cost of enrolment at the Petty Bag Office is 10*s.* 6*d.* for every skin; any portion of a skin less than half a skin is charged as half a skin, and a portion of a skin more than half is charged as a whole skin; and the patentee is at each of those offices allowed to prepare the drawing for the roll himself, at any time within fourteen days after the specification has been left for enrolment. When the patentee does not supply the drawing for the roll, it will be prepared in the office; and of course an extra charge will be made for it.

being enabled to prove the enrolment by an authenticated copy (*p*), for that office is now a branch of the public Record Office within the provisions of the statute 1 & 2 Vict. c. 94. In consequence, however, of the facility afforded at the Rolls Chapel Office to persons examining enrolments and other records, some patentees will not enrol their specifications at that office notwithstanding the advantages of enrolling there (*q*).

Enrolment may be at any time before 12 o'clock at night.

It has already been shown within what time a specification must be enrolled, and it only need be added, that the enrolment will be in time, if the specification be left at the office for enrolment at any time before twelve o'clock at night of the last day allowed for that purpose, for the instrument is always enrolled as of the day it is left at the office for that purpose.

Rolls on which specifications entered.

In the Enrolment Office, specifications are entered (*r*) upon the "Close Rolls," being so called because upon those rolls writs close are enrolled. In each of the other offices; viz. the Rolls Chapel and Petty Bag, there is a roll called the Roll of Specifications and Surrenders, and upon that roll a specification is entered at either of those offices.

How prepared.

These rolls are prepared in a similar manner to the patent rolls, which has already been described; but they are indorsed "Close Rolls," or "Roll of Specifications and Surrenders," as the case may be.

Entry of acknowledgment.

If the specification has been acknowledged, the acknowledgment will be entered of record upon the roll (*s*) as well as the specification itself, and the date of the enrolment.

Certificate of enrolment.

When the enrolment has been completed, a certificate will be indorsed upon the specification stating that it was enrolled on the day it was left at the office for that purpose.

(*p*) Vide *ante*, p. 485.

(*q*) It is very much to be regretted that all specifications are not enrolled in one office. It is extremely inconvenient for the public to have three offices to search for enrolments; and it frequently happens that a person searches each of the offices before he finds the specification he wants—and he must pay a fee for each office he searches whether he finds the enrolment there or not. The Attorney-general might frame the condition in the form of patent, so as to compel patentees to enrol their specifications in the Rolls Chapel Office, in which the greatest facilities are afforded to the public, and the Master of the Rolls has power to order all the existing enrolments in the Petty Bag or Enrolment Office to be transferred to the Rolls Chapel.

(*r*) See the Form of Enrolment in the Appendix, Chap. II. s. 1.

(*s*) See the Form in the Appendix, Chap. II. s. 1.

The close rolls are taken from the Enrolment Office to the Rolls Chapel Office, when they are about fifteen years old. The roll of specifications and surrenders is not removed either from the Rolls Chapel or Petty Bag Office.

Close rolls more than 15 years old taken to Rolls Chapel.

Each of the enrolment offices which have been mentioned may be searched for the enrolments of specifications, by any person within the usual office hours (*t*), the fee being one shilling for each search (*u*).

Searches for enrolments.

For the same fee which is paid for a search at the Rolls Chapel Office, the party searching is entitled to peruse the whole of the enrolment of the specification, and to inspect the drawing (if any) annexed to the roll, and he may *in pencil* take extracts from or copy any part of the enrolment of a specification, or a drawing annexed to the roll. A copy of the whole, or of any part of a specification may be had at a moderate charge (*x*); and if a copy of a drawing is required, the charge is equally moderate, the party requiring it being only charged the actual cost of preparing it. These facilities have been given to the public by the Master of the Rolls (*y*), under the statute of 1 & 2 Vict. c. 94 (*z*), the Rolls Chapel Office being now a branch office of the public Record Office of the kingdom.

Facilities afforded at Rolls Chapel Office.

The copies which are furnished to applicants at the Rolls Chapel Office may, in pursuance of the statute 1 & 2 Vict. c. 94, s. 12, to be examined and certified as true and authentic copies, by the deputy keeper of the records, or one of the assistant record keepers, and sealed or stamped with the seal of the Record Office, and by sect. 13, copies so sealed

Office copies at Rolls Chapel Office.

(*t*) The office hours at the Rolls Chapel Office, and Petty Bag Office, are from 10 o'clock a. m. to 4 o'clock p. m. during the whole year; at the Enrolment Office, during each term and until the Second Seal after Hilary term, and Last Seal after Michaelmas term, the hours are, from 10 a. m. to 2 p. m., and from 6 a. m. to 8 p. m.; at other times from 10 a. m. to 3 p. m., holidays excepted.

(*u*) At the Petty Bag Office a fee of 2*s.* 6*d.* is charged for an inspection in addition to the fee for a search; but the fee for a search at the Enrolment Office includes an inspection.

(*x*) Sixpence for every Chancery folio of ninety words.

(*y*) The public are greatly indebted to Lord *Langdale*, the present Master of the Rolls, for the great facilities which he has given to parties desiring to have access to specifications. It is greatly to be regretted, however, that the privileges intended for the benefit of the public have been much diminished in value, in consequence of the small number of specifications now enrolled at the Rolls Chapel Office.

(*z*) See the Statute in the Appendix; Chap. I. s. 1.

are to be received in evidence in every case in which the original record would be received (*y*).

Copies of enrolments, &c. at Petty Bag or Enrolment Office.

At the Petty Bag or Enrolment Office, a person inspecting the enrolment of a specification is not allowed to take any extract, or to copy any part of the record, nor can he obtain a copy of any part of the enrolment without taking or at all events paying for the whole. The cost of an office copy is greater at either of these offices (*z*) than at the Rolls Chapel Office, and it is not admissible in evidence unless proved to be correct by a person who has examined it with the original record (*a*).

(3.) *Of the Practice respecting the Alteration and Amendment of Patents, Enrolments, &c.*

Prior proceedings must be altered before the patent.

When any error is sought to be amended, or alteration made in a patent (*b*), all the prior proceedings must be altered before the Lord Chancellor can alter or amend the patent in the manner desired by the patentee.

Petition to the Queen.

In order to obtain an alteration, or amendment, or alteration of the Queen's warrant and bill, and subsequent proceedings, the patentee must present a petition to the Crown, praying for the amendment or alteration which is desired, this petition must be left at the office of the Secretary of State for the Home Department, and it will be answered by the Secretary of State by a reference to the Attorney or Solicitor-general, in the same way as a petition for a patent.

Reference to Attorney-general.

When the petition with the reference has been obtained, it must be taken to the chambers of the Attorney or Solicitor-general, and an appointment must be obtained for a hearing, when the petitioner, his solicitor, or agent, must attend and support the prayer of the petition.

Caveats and oppositions.

There is no definite practice with respect to the mode of entering caveats against amendments or alterations being

(*y*) Vide *ante*, p. 485. The cost of authenticating a copy is 6*d*. per folio, which makes the total cost 1*s*. per folio besides stamps.

(*z*) See the cost of office copies, stated *ante*, p. 543, and there will be an additional charge for copying any drawing annexed to the specification.

(*a*) Vide *ante*, p. 485.

(*b*) Vide Chap. VIII. s. 3, *ante*, p. 211.

allowed, such proceedings being of rare occurrence, but it seems that they ought to be entered in the same way as other caveats, and if any one has entered a caveat with the Attorney or Solicitor-general, he will be heard in opposition to the prayer of the petition in the same way as a person is heard upon an opposition to an application for a patent. And if there have been any proceedings taken upon the patent, the Attorney or Solicitor-general will sometimes direct the petitioner to give notice of the application to the parties.

Report to be taken to Home Office.

If the Attorney or Solicitor-general reports in favour of the application, the petition and report must be taken to the office of the Home Secretary.

Alteration of Queen's warrant and Queen's bill.

Upon a favourable report being made to the Crown by the Attorney or Solicitor-general, the application for the alteration or amendment will be granted, and for that purpose the Secretary of State for the Home Department will send for the Queen's warrant and the Queen's bill, which he will take with him to an audience of her Majesty, and in her presence the alteration will be made in each of those documents. In the margin of each document will be written a memorandum signed by the Secretary of State, certifying that the alteration was made in the presence and by command of her Majesty, and stating the date when it was done, after which the documents are restored to their former custody.

Alteration of signet bill.

The next step is to procure the signet bill to be altered to make it correspond with the Queen's bill, for which purpose the clerk of the signet will obtain the signet bill at the Privy Seal Office, and having made the necessary alteration of it, and of the entry in the docket-book (when necessary), in accordance with the altered Queen's bill, he will take it to the office of the Secretary of State for the Home Department, and get it resealed, and then return it to the Privy Seal Office.

Petition to Master of the Rolls for leave to amend Privy Seal bill.

In order to procure the Privy Seal bill to be altered or amended, it is necessary to present a petition to the Master of the Rolls, stating all the facts, and praying for leave to have the Privy Seal Bill taken to the Privy Seal Office to be altered or amended and resealed. Before this petition is presented, it is necessary to obtain the signature of the Attorney or Solicitor-general to a consent on the part of the

Crown, that the prayer of it may be granted. This petition must be taken to the secretary of the Master of the Rolls, and his Lordship will grant the application if he thinks the case one in which an amendment or alteration ought to be allowed. If there be any proceedings at Law or in Equity pending upon the patent, it is usual to require notice of the application, to be given to the parties in order that they may, if necessary, be heard against the prayer of the petition (*c*).

Alteration of Privy Seal bill.

If the Master of the Rolls grants the requisite leave for the Privy Seal bill to be amended, it is taken to the Privy Seal Office, and there altered so as to make it accord with the signet bill, and it is then to be folded up and taken to the Lord Privy Seal and resealed. If the alteration affects the entry of the bill in the docket-book of the office, the entry must also be altered so as to make it correspond with the bill.

Delivery of Privy Seal bill to the Lord Chancellor.

The Privy Seal bill, or writ of Privy Seal, together with the patent, must then be taken to the Patent Office, and the Privy Seal bill must be re-delivered to the Lord Chancellor in precisely the same way as it was delivered in the first instance; and his Lordship again signs a *recepi* stating such re-delivery, and the object of it (*d*).

Recepi.

Caveats, &c. at Patent Office.

If no caveat has been entered against sealing the amended or altered patent, it will be done as a matter of course, but caveats and oppositions may be entered in precisely the same way as caveats and oppositions against the sealing of any other patent (*e*), and if there be any caveat against altering or sealing the patent, the applicant must petition in the same way as already stated (*f*), respecting an opposition to the sealing of a patent originally.

Hearing.

The hearing and proceedings upon a petition to alter or amend and reseal a patent are precisely the same as upon a petition for the sealing of a patent, except that the hearing is not in private.

Altering and resealing patent.

In order to alter and reseal a patent, the Great Seal is first to be cut off, and the required alteration having been made,

(*c*) See *Nickel's* Case, 4 Beavan, 563; 1 Webs. R. 650.

(*d*) See *Nickel's* case, Turn. & Phil. 47; 1 Webs. R. 663, *S. C.*

(*e*) Vide *ante*, p. 530.

(*f*) Vide *ante*, p. 532, and see *Nickel's* case, Turn. & Ph. 46; 1 Webs. R. 661.

the patent is to be sealed in precisely the same way as before (*g*).

The patent having been altered and resealed, the Privy Seal bill will be restored to its former custody, and then the Master of the Rolls will upon petition or application order the enrolment to be altered so as to make it correspond with the altered patent. Alteration of enrolment.

The jurisdiction of the Lord Chancellor and Master of the Rolls to alter or amend enrolments of specifications, &c. has been considered in a former part of this work (*h*) to which the reader is referred. Amendment of enrolments of specifications.

In order to procure any alteration or amendment of the enrolment of a patent or specification, the patentee must present a petition to the Master of the Rolls, stating the facts, and praying that the alteration or amendment may be made. This petition must be left with his Lordship's Secretary, and the facts stated in it must be verified by affidavit. Petition to Master of the Rolls.

If there be any proceedings pending upon the patent, the parties must have notice in order that they may oppose the alteration in case it should be to their prejudice. Notice to parties of proceedings pending.

The petitioner's counsel will be heard in support of the application, and if the application is opposed, the counsel of the party opposing will be heard in opposition to the prayer of the petition. Hearing.

If the Master of the Rolls grants the prayer of the petition, an order must be drawn up directing the alteration or amendment to be made, and the order must then be taken to the officer by whom it is to be executed. Order.

Either party may appeal to the Lord Chancellor (*i*). Appeal.

Section II.

Of the Practice respecting Disclaimers and Memorandums of Alteration, under the Statute 5 *&* 6 *Will. IV. c.* 83, *s.* 1.

Stat. 5 & 6 W. IV. c. 83. s. 1.

The enactment under which a patentee or assignee of a patent may obtain leave to alter or disclaim any part of the

(*g*) Vide *ante*, p. 539.
(*h*) Chapter VIII. s. 3. p. 211.
(*i*) Vide *ante*, p. 220.

title or specification of the invention comprised in a patent, has already been stated in a former part of this work (*i*).

Rules of practice.

Shortly after the passing of the statute, the Attorney and Solicitor-general laid down certain rules of practice (*k*), respecting the mode of proceeding by parties applying for leave to enter disclaimers or memorandums of alteration under its provisions, and those rules still remain in force.

Applicant must petition.

A person desiring to disclaim or alter any part of his title or specification must apply by petition (*l*) to the Attorney-general or Solicitor-general for leave to enter the proposed disclaimer or memorandum of alteration.

What the petition must state.

The petition must state the date of the patent, and the nature of the grant it makes, the title of the invention being stated *verbatim* as contained in the patent. The petition must also state when the specification was enrolled, and also so much of the instrument itself (if any) as may be necessary to make the petition intelligible. If the applicant is an assignee of the patent, he must state how and when he became the assignee (*m*). And the applicant must also state what the proposed disclaimer or alteration is, and the reasons why it is sought to be made.

Disclaimer and alteration by the same instrument.

When a party is desirous of disclaiming some parts of his title or specification, and of altering some other part, the petition must, of course, be framed accordingly.

Petition may be either to Attorney or Solicitor-general.

The petition may in general be addressed either to the Attorney or Solicitor-general at the election of the applicant. But if either of those officers has acted as counsel in any cause respecting the patent, it is the practice to address the petition to the other of them, and if they have both been engaged in a similar manner, then the petition may be addressed to either of them, and he will desire some gentleman who has filled the office of Attorney or Solicitor-general, to advise him respecting the disposal of the matters of the petition.

(*i*) Chap. VIII. s. 2, p. 203, 205.

(*k*) See the Rules in the Appendix, Chap. I. s. 2.

(*l*) See the Form of Petition in the Appendix, Chap. II. s. 2.

(*m*) When any part of a title or specification is disclaimed or altered by an assignee, it seems to be desirable that the assignment, under which he claims, should be enrolled in Chancery, in order that his title to enrol the disclaimer or memorandum of alteration may appear upon the records of the Court. The Attorney or Solicitor-general might require an enrolment of the deed before granting his *fiat*.

Petition with copy of specification and disclaimer to be lodged.

The petition must be lodged at the chambers of the Attorney or Solicitor-general, to whom it is addressed, and it must be accompanied by a copy of the specification and of the proposed disclaimer or memorandum of alteration.

Advertisements.

The statute (*n*) expressly authorises the Attorney and Solicitor-general to require the party applying to advertise his disclaimer or alteration in such manner as that officer may think fit, and whenever legal proceedings have been taken upon the patent, or the Attorney or Solicitor-general is of opinion that the disclaimer or alteration may prejudice third parties, he will direct the applicant to publish such advertisements as he thinks necessary, and will delay granting his *fiat* until about ten days after the advertisements have been duly published (*o*).

Caveat.

A caveat (*p*) may be entered by any person against granting a *fiat* for the entering and enrolling of a disclaimer or memorandum of alteration (*q*). Such a caveat is to be entered in the same way as a caveat against the grant of a patent, the practice respecting which has already been stated(*r*), and may be entered at any time before the actual issuing of the fiat (*s*).

Caveats are specific or general.

A caveat against a particular disclaimer or alteration which has been advertised, is a specific caveat, which is only to be entered at the chambers of the Attorney or Solicitor-general, to whom the application has been made; but parties may also enter general caveats against any disclaimer or alteration of a patent or specification, and in such cases caveats must be entered at the chambers both of the Attorney and Solicitor-general. A caveat will only be in force for one year, but it may be renewed as often as the party entering it pleases.

Notice of application.

When a patentee applies for leave to enter a disclaimer or alteration, and the advertisements (if required) have been duly published, the Attorney or Solicitor-general's clerk sends notice of the application to every person who has entered a

(*n*) 5 & 6 W. IV. c. 83, s. 1.

(*o*) The advertisements when required are usually ordered to be inserted three times in *The Times*, *The Morning Chronicle*, and *London Gazette*, and if the patentee carries on business in the country, then also in a newspaper published in the neighbourhood.

(*p*) See the Form of Caveat in the Appendix, Chap. II. s. 2.

(*q*) See the statute 5 & 6 Will. IV. c. 83, s. 1, which entitles parties to enter caveats, and to have notice of hearings.

(*r*) *Ante*, s. 1, p. 507.

(*s*) The fee for entering a caveat is 5*s*.

caveat, that if he intends to oppose the application, he must within four days send notice or enter his opposition at the chambers of the Attorney or Solicitor-general to whom the application has been made, and if no opposition be entered within the four days the petition will be treated as unopposed.

Entering opposition.

A party who intends to oppose an application for leave to enter a disclaimer or memorandum of alteration, ought to enter his opposition at the chambers of the Attorney or Solicitor-general within four days after the date of the notice which he receives; an opposition may however be entered at any time before the fiat is granted. The effect of an opposition being entered is to stay all proceedings upon the petition until the party opposing has been heard, or had an opportunity of being heard against the granting of the prayer of the petition, and he is entitled to have a week's notice of the time appointed for a hearing of the matter of the petition.

Must be a hearing in every case.

There must in every case be an actual hearing of the matters of the petition before the Attorney or Solicitor-general, at which every person who has entered an opposition is entitled to attend.

If grant of *fiat* is not opposed.

If the grant of a *fiat* is not opposed the Attorney or Solicitor-general will peruse the petition and other documents, and if it appears to him that the proposed disclaimer or alteration will not be prejudicial to the public he will grant his *fiat* for the entry and enrolment of it. But if he is not satisfied respecting the propriety of allowing the disclaimer or alteration he may require, the applicant to furnish him with further information, or to vary the form of the instrument to be entered and enrolled.

Appointment and summons.

In order to obtain a hearing, the petitioner must procure an appointment from the clerk of the Attorney or Solicitor-general, and in an opposed case also a summons for the parties to attend on the day appointed for the hearing. A copy of the summons must be served upon every opposing party.

Hearing.

At the time appointed for the hearing the application will be heard in support of his petition, and if any opposing parties attend they will also be heard before the Attorney or Solicitor-general; and this hearing is not private like the hearing upon an opposition to the grant of a patent, but each party is

heard in the presence of the other, first the applicant for a *fiat*, then each of his opponents.

Evidence.

Each party must produce such evidence of any material facts as may be satisfactory to the Attorney or Solicitor-general, but those officers are not bound to adhere strictly to the rules respecting legal evidence. Affidavits or solemn declarations made before a Master (ordinary or extraordinary) in Chancery, of the insertion of advertisements, &c., may be read at the hearing. And, in order to dispense with advertisements, the applicant must satisfy the Attorney or Solicitor-general that no legal proceedings have been taken upon the patent.

Parties may appear by agents, &c.

The parties may, and in opposed cases usually do, appear by counsel at the hearing.

Decision.

The Attorney or Solicitor-general having heard the applicant, and all his opponents, if any, will grant or refuse the application as he thinks fit. The granting of leave is entirely discretionary with the officer to whom the application is made, and his decision is final.

Disclaimer or alteration ought to be completed without delay.

If the Attorney or Solicitor-general decides that the prayer of the petition ought to be granted, the intended disclaimer or memorandum of alteration ought to be completed, and the *fiat* obtained without delay, for a caveat and an opposition may, as has already been stated, be entered at any time before the *fiat* has actually been granted (*r*).

The instrument ought to be written on parchment, and that is to be done by the party himself, his solicitor, or agent.

What is to be done to complete the disclaimer or alteration.

The statute (*s*) provides that a patentee may *enter* with the clerk of the patents a disclaimer or memorandum of alteration, "and such disclaimer or memorandum of alteration, being *filed* by the said clerk of the patents, and enrolled with the specification," shall be deemed to be part of the patent or specification. Three things are, therefore, to be done in order to comply with the provisions of this statement; viz. to enter the instrument with the clerk of the patents;—to file it with that officer;—and to enrol it in the office in which the specification was enrolled. The order in which these three things are done does not seem to be material, but they must

(*r*) The fees payable at the chambers of the Attorney or Solicitor-general amount to about 7*l*. 14*s*.

(*s*) 5 & 6 Will. IV. c. 83, s. 1.

all be done before the instrument can have complete effect given to it.

Mode of entering, &c. which has been adopted.

The most generally prevailing mode which has been adopted for the purpose of complying with the provisions of this Act seems to be very loose and unsatisfactory.

It has become the practice to prepare what is called an entry paper, stating the whole of the intended disclaimer or alteration as it is proposed to be made, and if the Attorney- or Solicitor-general determines to grant his *fiat*, the disclaimer or memorandum of alteration is also engrossed on parchment, and each document is signed by the patentee. The *fiat* is written under or indorsed upon the disclaimer or memorandum of alteration, and signed by the Attorney or Solicitor-general, and under the entry paper is written a certificate directed to the clerk of the patents, stating that a *fiat* has been granted, which certificate is signed in like manner. The entry paper is then taken to the clerk of the patents to be entered and filed, and the disclaimer or memorandum of alteration to the office where it is to be enrolled, after which it is returned to the patentee.

Party must at his own peril comply with the act.

It is to be observed that a party seeking to disclaim or alter his patent or specification must at his own peril comply with the provisions of the statute, and if he fails to do so, the instrument will be unavailing.

The mode in which the disclaimer ought to be completed.

It seems that the best course to be adopted in case of a disclaimer or memorandum of alteration, is to take the instrument, after it has been signed and (if necessary) acknowledged by the party, and the *fiat* signed by the attorney or solicitor, to the office where it is to be enrolled, and the enrolment having been completed (which it generally will in the course of a few days), the document ought to be taken to the Patent Office, and there left to be entered and filed by the clerk of the patents.

Enrolment of a disclaimer or memorandum of alteration.

The statute (*s*) speaks of an enrolment of the disclaimer or memorandum of alteration with the specification, but that has been construed to mean an enrolment at the office in which the specification was enrolled. As all the parts of a roll are to be deemed in law but as one roll, and as there is only one roll at any office upon which such an instrument can be en-

(*s*) 5 & 6 Will. IV. c. 83, s. 1.

rolled, an enrolment in this manner appears to be a litural compliance with the statute. The object of the legislature seems to have been that any one searching the records of any of the offices for the enrolment of a specification, should find the disclaimer or memorandum of alteration in the same office as the specification. The disclaimer or memorandum is entered upon the roll in the same way as the specification, and upon a part of the roll for the year in which it is enrolled (*t*). A reference is always made opposite the enrolment of the specification to that of the disclaimer or memorandum of alteration, and also opposite the enrolment of the disclaimer or memorandum of alteration, to that of the specification, thus, "See Disclaimer [memorandum of alteration *or* specification], 24th part, 1844."

Acknowledgment of disclaimer.

If a disclaimer or memorandum of alteration is to be enrolled in the enrolment office (as it must be if the specification was enrolled in that office), it is necessary that the instrument should first be duly acknowledged before a Master (ordinary or extraordinary) in Chancery (*u*), without which that office will not receive it, or enter it upon the roll.

Disclaimer or alteration how to be entered at Patent Office.

In order to enter a disclaimer or memorandum with the clerk of the patents, the document must be taken to the Patent Office (*x*), where a book is kept for the purpose of making such entries. The entry is made by copying the whole of the instrument in the book; and if there are any drawings, they are also inserted in the book, and the party making the entry is at liberty to furnish the necessary drawings (*y*). The object of the legislature in requiring this entry seems to have been that when the title of an invention has been altered, or any part of it disclaimed, the books of the Patent Office shall give information of the fact to the public. And in order to carry out this intention, whenever a disclaimer or memorandum of alteration is entered and filed, a reference is made opposite the entry of the patent in the

(*t*) Vide *ante*, p. 544. The fees payable for enrolling a disclaimer or memorandum of alteration, are the same as the fees for enrolling a specification.

(*u*) See the Form of Acknowledgment in the Appendix, Chap. II. s. 1.

(*x*) In Quality Court, Chancery Lane.

(*y*) The fee for filing and entering is 10*s*. if the instrument is short, but if long the fee for filing is 1*s*. and for entering it 4*d*. per folio; but of course an extra charge is made for a drawing, if a copy of it is not furnished by the party making the entry.

Disclaimer, &c. to be filed.

docket book, to the folio of the entry book in which the disclaimer or alteration is to be found, so that any person searching the docket, will have the means of ascertaining how far the effect of the patent has been varied.

The disclaimer or alteration having been entered and enrolled, it must be filed with the Clerk of the patents at the Patent Office, and the instrument will thenceforth become part of the patent and specification (*a*).

When a disclaimer or memorandum of alteration has been enrolled, and also entered and filed in pursuance of the Attorney or Solicitor-general's *fiat*, the Master of the Rolls has no jurisdiction to order it to be removed from the rolls of the Court (*b*).

Section III.

Of the Practice of the Judicial Committee of the Privy Council respecting the Confirmation and Prolongation of Patent Privileges.

Power to confirm patents.

The power of the Crown with the advice of the Privy Council to confirm a patent privilege has been stated in a former part of this work (*c*), to which the reader is referred for an explanation of the scope and object of the enactment (*d*), by which the Crown was invested with that power.

Prolongation of patents.

Before the statute 5 & 6 Will. IV. c. 83 (*e*) was passed, the term of a patent privilege in an invention could only be extended by Act of Parliament. Applications to Parliament for such extensions were of frequent occurrence notwithstanding the great expense of obtaining a private Act of Parliament.

Power vested in Queen in council.

By the Act just mentioned (the provisions of which have since been amended and enlarged (*f*)), the Queen in Council is invested with the power of prolonging such patent privileges.

If any person who has obtained a patent,

Section *four* of the statute enacts, "That if any person who now hath or shall hereafter obtain any letters patent as

(*a*) See the statute 5 & 6 Will. IV. c. 83, s. 1; and *Perry* v. *Skinner*, 2 M. & W. 471.

(*b*) *Sharpe's* case, 1 Webs. R. 641; vide *ante*, p. 226.

(*c*) Chap. VIII. s. 1, p. 199.

(*d*) 5 & 6 Will. IV. c. 83, s. 2; see the Statute in the Appendix, Chap. I. s. 1.

(*e*) See the Statute in the Appendix, Chap. I. s. 1.

(*f*) By 2 & 3 Vict. c. 67, and 7 & 8 Vict. c. 69.

aforesaid (*g*), shall advertise in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carried on any manufacture of any thing made according to his specification, or near to or in which he resides in case he carried on no such manufacture, or published in the county where he carries on such manufacture, or where he lives in case there shall not be any paper published in such town, that he intends to apply to his Majesty in Council for a prolongation of his term of sole using and vending his invention, and shall petition his Majesty in Council to that effect, it shall be lawful for any person to enter caveat at the Council Office; and if his Majesty shall refer the consideration of such petition to the Judicial Committee of the Privy Council, and notice shall first be by him given to any person or persons who shall have entered such caveats, the petitioner shall be heard by his Counsel and witnesses to prove his case, and the person entering caveats shall likewise be heard by their counsel and witnesses; whereupon, and upon hearing and inquiry upon the whole matter, the Judicial Committee may report to his Majesty that a further extension of the term in the said letters patent should be granted, not exceeding seven years (*h*); and his Majesty is hereby authorised and empowered, if he shall think fit, to grant new letters patent for the said invention for a term not exceeding seven years after the expiration of the first term, any law, custom, or usage to the contrary in anywise notwithstanding. Provided (*i*) that no such extension shall be granted if the application by petition shall not be made and prosecuted with effect before the expiration of the term originally granted in such letters patent."

for an invention shall advertise that he intends to apply for a prolongation, and shall petition to that effect, his Majesty may, upon the report of the Judicial Committee, grant a further term not exceeding seven years.

The power which this enactment and the statute 7 & 8 Vict. c. 69 (*k*), vest in the Crown being confined within definite limits as to the length of the additional terms which may be

(*g*) In section one of the act the phrase used (and to which the reference seems to be here made) is, "any person who as grantee, assignee, or otherwise, hath obtained or shall hereafter obtain letters patent for the sole making, exercising, vending, or using of any invention."

(*h*) Extended to fourteen years by stat. 7 & 8 Vict. c. 69, s. 2.

(*i*) This proviso has been repealed by the 2 & 3 Vict. c. 67, sec. 1. Vide *post* and *in re Bodmer's* patent, 2 *Moore*, P. C. C. 471; 1 Webs. R. 740.

(*k*) See sec. 2 of the statute, stated *post*, pp. 575, 576.

granted, application must be made to the legislature as heretofore (*k*), whenever the extension which the Crown is thus authorised to grant shall happen to be insufficient.

Judicial committee established by 3 & 4 W. IV. c. 41, s. 1.

By the statute 3 & 4 Will. IV. c. 41, s. 1, a committee of the Privy Council was formed with the style of "the Judicial Committee of the Privy Council," and by subsequent sections of the Act, all the judicial powers of the Privy Council were transferred to the Judicial Committee (*l*).

Registrar may be appointed.

By section eighteen it is enacted, "That it shall be lawful for his Majesty, under his Sign Manual, to appoint any person to be Registrar of the said Privy Council, as regards the purposes of this act, and to direct what duties shall be performed by the said Registrar."

Power of Crown to refer matters to judicial committee.

By section 4 it was enacted, that it should be lawful for his Majesty to refer to the Judicial Committee for hearing or consideration any such matters as his Majesty should think fit, and that such Committee should thereupon hear or consider the same and advise his Majesty thereon. It is under the power thus conferred upon the Crown that a petition to the Crown for the confirmation or prolongation of a patent privilege is referred to the Judicial Committee.

Patentee may apply for a confirmation at any time during the continuance of the patent.

A patentee may apply for a confirmation of his patent at any time during the continuance of the term it grants, and he will of course do so with as little delay as possible after he has discovered the defect in his title which he seeks to remedy.

Patentee must not apply for a prolongation until term nearly expired.

But a patentee must not apply for a prolongation of his patent until the term has nearly expired, for the amount of profit made by a patentee is generally greatest during the last two or three years of his term, and it may be sufficient to remunerate him. Thus, *in re Macintosh's* patent (*m*), the petitioner lodged his petition and applied to the Council to have a day fixed for the hearing about eighteen months before the expiration of the patent, but their Lordships were of opinion that the profits accruing during that period might

(*k*) As an application to parliament for the prolongation of a patent will rarely, if ever, become necessary, it is not deemed necessary in this work to say anything as to the practice of parliament respecting bills for that purpose.

(*l*) See Macqueen's Practice, pp. 687-724.

(*m*) 1 Webs. R. 739.

materially affect the question of extension, and therefore directed the application to stand over.

Application for prolongation to be prosecuted with effect before expiration of patent.

The 5 & 6 Will. IV. c. 83, s. 4, provided (*n*) that no extension should be granted if the application by petition should not be made and prosecuted with effect before the expiration of the term originally granted by the patent.

In re Bodmer's patent.

In re Bodmer's patent, the petitioner duly presented his petition, and obtained an appointment for a hearing on a day before the expiration of his patent; but a sufficient number of the members of the Court did not assemble on the day appointed, and consequently the patent expired before the hearing. Upon the hearing which subsequently was obtained, (after the expiration of the patent), it was objected by the Attorney-general on behalf of the Crown that their Lordships had no power to entertain the application, which had not been prosecuted with effect before the expiration of the patent. The Judicial Committee held that the objection was fatal, and that the words "prosecuted with effect" in the proviso required that something more than the application by presenting the petition and obtaining a day to be fixed for the hearing must have been done to satisfy the proviso in the statute, and the application was consequently refused (*o*). This decision led to the repeal of the proviso in the 5 & 6 Will. IV. c. 83, s. 4, by the statute now to be noticed.

Statute 2 & 3 Vict. c. 67.

By stat. 2 & 3 Vict. c. 67, s. 1, after reciting the Act 5 & 6 Will. IV. c. 83, s. 4, and reciting that it had happened since the passing of the said Act, and might happen again, that parties desirous of obtaining an extension of the term granted in letters patent of which they were possessed, and who might have presented a petition for such purposes in manner by the said recited Act directed, before the expiration of the said term, might nevertheless be prevented by causes over which they had no control from prosecuting with effect their application before the Judicial Committee of the Privy Council; and it was expedient therefore that the said Judicial Committee should have power, when under the circumstances of the case they should see fit, to entertain such application,

(*n*) Vide *ante*, p. 557.

(*o*) The petitioner afterwards obtained a prolongation under the statute 2 & 3 Vict. c. 67.

and to report thereon according to the provisions of the said recited Act, notwithstanding that before the hearing of the case before them the terms of the letters patent sought to be renewed or extended might have expired: it is enacted, "that so much of the said recited Act as provides that no extension of the term of letters patent shall be granted as therein mentioned if the application by petition for such extension be not prosecuted with effect before the expiration of the term originally granted in such letters patent, shall be and the same is hereby repealed."

Repeals proviso requiring application to be prosecuted with effect before expiration of original term.

By section 2 it was enacted, "that it shall be lawful for the Judicial Committee of the Privy Council, in all cases where it shall appear to them that any application for an extension of the term granted by any letters patent, the petition for which extension shall have been referred to them for their consideration, has not been prosecuted with effect before the expiration of the said term from any other causes than the neglect or default of the petitioner; to entertain such application, and to report thereon as by the said recited Act provided, notwithstanding the term originally granted in such letters patent may have expired before the hearing of such application; and it shall be lawful for her Majesty, if she shall think fit, on the report of the said Judicial Committee, recommending an extension of the term of such letters patent, to grant such extension, or to grant new letters patent for the invention or inventions specified in such original letters patent, for a term not exceeding seven years after the expiration of the term mentioned in the said original letters patent: Provided always, that no such extension or new letters patent shall be granted if a petition for the same shall not have been presented as by the said recited Act directed, before the expiration of the term sought to be extended, nor in case of petitions presented after the thirtieth day of November, one thousand eight hundred and thirty nine, unless such petition shall be presented six calendar months at the least before the expiration of such term, nor in any case, unless sufficient reason shall be shown to the satisfaction of the said Judicial Committee for the omission to prosecute with effect the said application by petition before the expiration of the said term."

If application for a prolongation not prosecuted with effect from any other cause than the petitioner's neglect, extension may be granted although the original term has expired.

Proper time for applying for a prolongation.

The proper time for applying for a prolongation is from twelve to six calendar months before the expiration of the patent term. But it seems that the omission to present a petition at least six months before the expiration of the patent, will only prevent the grant of a prolongation when a hearing cannot be obtained during the continuance of the original term, for the proviso only appears to extend to "any such extension or new letters patent" as mentioned in the previous part of the section, that is, extensions and new patents granted at hearings after the expiration of the original terms.

Notice to be advertised.

Whether application is intended to be made for the confirmation or prolongation of a patent, the patentee must, in the first place, give public notice by advertisement of the application which he intends to make. The necessity for giving notice by advertisement is imposed on a petitioner for the prolongation of a patent by the provisions of the Act (*k*) under which the application must be made, and upon a petitioner for a confirmation by one of the rules of practice published by the Privy Council (*l*), the provisions of the Act, and of the rule being the same in effect.

Notice must state the nature and time of application.

The notice which an applicant is thus required to give must state the nature of the intended petition or application, and the day on which he intends to apply to the Judicial Committee for a time to be fixed for hearing the matter of the petition (*m*). The day for which such notice is given must not be less than four weeks after the date of the publication of the last of the advertisements to be inserted in the *London Gazette* (*m*).

That notices of opposition must be given or caveats entered.

If the intention is to petition for a confirmation, the advertisement must state that on or before the day mentioned, notice must be given of any opposition intended to be made to the petition. But if the petition is to be for the prolongation of a patent, the notice to be advertised must state that caveats are to be entered on or before the day for which the notice is given.

In what newspapers notice is to be advertised.

The notice of application must in every case be advertised three times in the *London Gazette*, three times in a London newspaper, and three times in a country newspaper. The

(*k*) 5 & 6 Will. IV. c. 83, s. 4.
(*l*) Reg. P. C. r. 1.
(*m*) Reg. P. C. r. 1, and 2, Appendix, Chap. I. s. 2.

insertion of the advertisements once in each of three several London newspapers will be sufficient. The country newspaper must be a paper published in the town where or near to which the applicant carries on any manufacture of any thing made according to his specification, or near to or in which he resides if he carries on no such manufacture; or a paper published in the county where he carries on such manufacture or where he lives, if there be no paper published in the town in or near to which he carries on his manufacture or resides. When a patentee resides abroad and does not carry on any manufacture in this country, it will be sufficient if the notice is advertised in a newspaper published in or near to the place where licencees under the patent carry on business (*n*). But in one case (*o*), which was an application for a confirmation, the Privy Council required notice to be sent by post to a party interested who resided abroad.

Form of petition for a confirmation.

The petition for a confirmation (*p*) must be directed to her Majesty in Council, and it must state the patent, the specification, and if the applicant is an assignee, the assignment under which he derives his title. It must also state the particular defect which renders it necessary for the applicant to petition for a confirmation, that the invention had not been publicly and generally used before the date of the patent, that the petitioner has published all the necessary advertisements required by the rules of the Privy Council, and concluding with a prayer that her Majesty will be pleased to confirm the patent.

Form of petition for a prolongation.

The petition for the prolongation of a petition must also be addressed to the Queen in Council, and state the patent, and specification, and the assignment, if any, to the applicant. It must then set forth the circumstances which have prevented the petitioner from obtaining a proper amount of recompense by means of the exercise of his invention; and if the petitioner intends to apply under the 7 & 8 Vict. c. 69, s. 2 (*q*), for an extension for fourteen years, it must be stated that a further term of seven years will not suffice for his remuneration (*r*).

(*n*) *De Rosne's* case, 20 May, 1844.
(*o*) *Baron Heurteloup's* case, 1 Webs. R. 553.
(*p*) See the Form of Petition in the Appendix, Chap. II. s. 3.
(*q*) See the Statute in the Appendix, Chap. I. s. 1.
(*r*) See the Form of Petition in the Appendix, Chap. II. s. 3.

A petition, whether for a confirmation or prolongation, must be presented within one week after the insertion of the last of the advertisements required to be published in the *London Gazette* (*q*). And it must be accompanied with affidavits that advertisements have been duly inserted in the *London Gazette* and other papers in the manner already mentioned (*r*). Petition, when to be presented.

The petition, together with the affidavits of the due publication of the advertisements, must be taken to the Council Office and filed there, and her Majesty's reference of the petition to the Judicial Committee will be obtained by the Clerk of the Council. Petition and affidavits to be filed at Council Office.

Any person may oppose an application for the confirmation of a patent provided he lodges notice of his intention so to do at the Council Office on or before the day named in the applicant's notice (*s*). And a petition for the prolongation of a patent may also be opposed by any one who shall enter a caveat (*s*) against the prolongation at the Council Office, before the day mentioned in the advertisement. And parties who intend to oppose the confirmation or prolongation of a patent, may lodge caveats or notices of opposition at the Council Office, although no petition has been lodged and no advertisement published. Persons may oppose upon giving notice or entering caveats.

The Judicial Committee will in some cases give parties leave to enter caveats after the day mentioned in the advertisements (*t*). And under special circumstances, probably notice of opposition would also be allowed to be given after the day appointed. Leave to enter caveat after time expired.

The Judicial Committee of the Privy Council does not always sit on the day mentioned in the advertisements, but when the Council does not sit on that day, the application to fix a hearing is made on the first day the Council sits afterwards. Copies of the petition to be served upon parties opposing.

Before applying for a time to be fixed for hearing the matter of a petition for a confirmation, the petitioner's solicitor must serve all parties to any former suit or action respecting the patent mentioned in the petition, and all

(*q*) Reg. P. C. r. 3, Appendix, Chap. I. s. 2.
(*r*) *Ibid.* r. 4.
(*s*) See the Form in the Appendix, Chap. II. s. 3.
(*t*) Such leave was granted in *Macintosh's* case.

persons who have lodged notices of opposition to the application, with copies of the petition (*u*). And previous to an application to fix a time for hearing a petition for a prolongation, the solicitor must serve all persons who have entered caveats against the application with copies of the petition (*u*).

As parties can lodge notices of opposition and caveats, even on the day of application for a hearing, it will be necessary for the petitioner's solicitor to search the Council Office for notices and caveats up to the close of the day prior to the application, in order that he may be enabled to comply with the rules of the Privy Council, by serving the copies of petitions as already mentioned.

Service of copies of petition to be verified.

The service of parties with copies of the petitions must be verified by affidavit, without which the Privy Council will not entertain an application to fix the hearing.

Application to fix a hearing.

On the day mentioned in the advertisements, the petitioner must apply by counsel to the Judicial Committee of the Privy Council, to fix a time for hearing the matter of his petition. If the petition is opposed, the day to be fixed for the hearing must be more than four weeks from the time of the application, because the petitioner must give at least four weeks' notice of the time appointed for the hearing.

Notice of objections.

Every person who has been served with a copy of a petition, whether for a confirmation or a prolongation, must, within a fortnight after such service, lodge at the Council Office notice of the grounds of his objections to the granting of the prayer of the petition (*w*). If a party neglects to lodge such a notice he cannot be heard in opposition to the prayer of the petition; and a person who has lodged a notice, will be confined to what is contained in his notice, and will not be allowed to oppose the petition upon any ground which is not mentioned in the notice.

Notices of hearing.

Upon a petition for a confirmation, the solicitor of the applicant must give notice of the time appointed for the hearing to every person who has lodged a notice of opposition at the Council Office (*x*). And upon a petition for a prolongation a similar notice must be given to every person who has entered a caveat at the Privy Council Office (*y*).

(*u*) Reg. P. C. r. 5.
(*w*) *Ibid.* r. 6.
(*x*) *Ibid.* r. 1.
(*y*) *Ibid.* r. 2.

The notice of a hearing must be served at least four weeks before the day for which it has been appointed (*z*). When to be served.

All affidavits, notices, &c., relating to the matter of any petition which has been referred to the Judicial Committee must be intituled, "In the Judicial Committee of the Privy Council," and also in the matter of the petition to which they relate. Affidavits, &c. how to be entitled.

Parties may obtain office copies of all papers lodged at the Council Office, respecting the matter of a petition (*a*). Office copies.

The petitioner may either appear in person, or by counsel, at the hearing of the matter of the petition. And as he is bound to make out a good *primâ facie* case, independent of any objections to be raised by his opponents, he must begin at the hearing, and of course he will be entitled to the reply. Petitioner may appear in person or by counsel.

The practice of the Privy Council respecting the number of counsel to be heard is the same as in the House of Lords; *viz.* two only for each party, and two counsel only will be heard on behalf of several opposing parties, unless they have independent and distinct grounds of opposition founded on separate and independent interests (*b*). Two counsel only will be heard on each side.

The Attorney-general always attends the hearing in order to watch the case on behalf of the Crown and the public.

The petitioner must in the first place show at the hearing that he has duly advertised notice of his application, and also served copies of his petition upon all persons who are required to be served by the rules of the Judicial Committee. Proofs at the hearing. Advertisements and notices.

The petitioner must also give in evidence his patent and an office copy of the enrolment of his specification. And if he is an assignee of the patent, his title deed or title deeds must be given in evidence, the execution of them being proved by the attesting witnesses (*c*). Patent and specification. Assignment.

Any of these formal proofs may be made either by affidavit or by the examination of witnesses at the hearing.

The petitioner for a confirmation must show whether there have been any proceedings taken upon the patent, and the result of them. And if there have been any actions or suits respecting the patent, he must prove that the parties have Proofs in support of petition for confirmation.

(*z*) Reg. P. C. r. 1 and 2.

(*a*) Reg. P. C. r. 7, Appendix, Chap. I. s. 2. The cost of an office copy is 5*s.* for every side or page of the copy.

(*b*) *Woodcroft's* patent, 3 Moore's P. C. C. 172.

(*c*) *Wright's* patent, 1 Webs. R. 561; *Galloway's* patent, *Ibid.* 725.

been served with copies of the petition. The petitioner must himself, by affidavit, state that he was ignorant of the defect in his title at the time of his application for the patent; and it would be prudent to have the patentee in attendance, as the Judicial Committee might desire to examine him respecting his want of knowledge of a discovery or use of the invention by any other person prior to the grant of his patent (*e*).

The petitioner must also show the particular defect in his title, occasioned by a prior discovery or use of the invention which he is seeking to cure by a confirmation; and the Privy Council will require the fullest possible information respecting this part of the case, and the way in which the defect was discovered.

To make out the petitioner's case, evidence must also be given to show that the invention had not been publicly known or used at any time before the date of the patent.

Petitioner for a confirmation must make out a strong case.

In order to obtain the report of the Judicial Committee in favour of a confirmation, the petitioner must make out a strong case for the interposition of the Crown in his favour, and if he has any other remedy, as by a disclaimer or a memorandum of alteration, the confirmation will not be granted (*f*).

Petitioner for a prolongation must make out a *primâ facie* title to the patent privilege.

In support of a petition for a prolongation, a patentee must make out a *primâ facie* title to his patent privilege, by giving in evidence his patent and an office or examined copy of the enrolment of his specification as already mentioned (*g*); and if he is an assignee, he must complete the proof of his title by giving in evidence the assignment or assignments under which he claims a right to the privilege granted by the patent (*h*). So, if any disclaimer or memorandum of alteration has been filed and enrolled, an office or examined copy of the enrolment must be given in evidence (*i*).

Primâ facie evidence of validity of patent.

The petitioner must also, in support of his petition for an extension, make out a *primâ facie* case respecting the validity of the patent (*k*). He must therefore show that

(*e*) Vide *in re Jones's* patent, 1 Webs. R. 578.

(*f*) See *Baron Heurteloup's* case, 1 Webs. R. 553; and *Well's* case *re Westrupp and Gibbin's* patent, 1 Webs. R. 554, stated *ante*, pp. 201 and 202.

(*g*) *Ante*, p. 567.

(*h*) *In re Wright's* patent, 1 Webs. R. 561; and *in re Galloway's* patent, 1 Webs. R. 724.

(*i*) See *in re Galloway's* patent, 1 Webs. R. 724.

(*k*) See *in re Erard's* patent, 1 Webs. R. 557, n. (*a*); *in re Wright's* patent, *Ibid.* 561.

the invention was now at the date of the patent, which will be sufficient (the specification being in evidence) not only to prove the novelty of the invention, but also that the patentee was the inventor (*i*). The utility of the invention must also be proved, and (as it will be shown presently) in the most satisfactory manner. And general evidence must be given respecting the sufficiency of the specification.

Petitioner for a prolongation must make out a strong case.

The petitioner must also make out a strong case for the continuance of his patent privilege (*k*), the granting of the prayer of the petition being any thing but a matter of course in any case (*l*), and the jurisdiction of the Judicial Committee is only to be exercised on special grounds to be alleged and proved in each particular case (*m*).

What must be shown to obtain a prolongation.

In order to make out a sufficient case for the prolongation of a patent, the petitioner must show, *firstly*, great, or at least some very considerable merit on the part of the patentee and party applying,—*secondly*, that the public has derived or will derive some material benefit from the invention, and, *thirdly*, that the patentee, or his assignee, has not been sufficiently rewarded by means of the first grant, for the benefit which he has conferred upon the public. The length of the additional term which the Privy Council may recommend the Crown to grant, will in every instance depend upon the strength of the case which the petitioner makes out as to each of the three particulars which have been mentioned.

(1). *Merit of the Patentee or Assignee.*

Reason why patentee must have merit to obtain a prolongation.

Merit in the patentee is required, because the consideration for the grant of privilege contained in the patent must move from the grantee (*n*); and the object of the patent law is, that patent privileges should be granted to reward those who first give useful inventions to the public, and to encourage others, by the hope of obtaining similar rewards, to confer similar benefits upon the public (*o*). And in order to determine the amount or extent of reward which ought to be given

(*i*) See the reason of this explained, *ante*, p. 443.

(*k*) *In re Erard's* patent, 1 Webs. R. 557.

(*l*) *In re Morgan's* patent, 1 Webs. R. 737.

(*m*) Per Lord *Brougham*, *in re Jones's* patent, 1 Webs. R. 579.

(*n*) Vide *ante*, p. 23.

(*o*) Vide Chap. III. *ante*, p. 19.

in any particular case, it is essential to consider the degree of merit belonging to the patentee (*p*).

An actual inventor has more merit than an importer.

In order to ascertain the personal merits of the patentee, it is necessary to consider whether he was an actual inventor, or only imported a knowledge of the invention from abroad, an actual inventor being of course a much more meritorious person than an importer. Thus *in re Soame's* patent (*q*) in the Privy Council, Lord *Brougham* said, "The merit of an importer is less than of an inventor. We are now sitting judicially, and it is an argument against the patent, that it (the invention) was imported, and not invented. I do not say it takes away the merit, but it makes it much smaller." And in the same case, Lord *Campbell* said, "I should say, sitting here, if it (the invention) had been published in a foreign journal, considering whether the patent should be prolonged, I should be influenced by what I saw published in a foreign journal, without inquiring whether it was known in England; though when sitting in a court of justice, and considering the validity of the patent, I should require that it should be known in England."

In re Soame's patent.

Inventor's merit depends upon the skill, &c.

If the patentee is an actual inventor, his personal merit will depend upon the skill and ingenuity which he has shown in making his invention, and the labour and expense which he has bestowed in bringing it to perfection, and rendering it useful and valuable to the public.

In re Whitehouse's patent.

In the case of *Whitehouse's* patent (*r*), Lord *Brougham*, in delivering the judgment of the Privy Council in favour of a prolongation of the patent, relied much upon the great merit of the inventor. So also *in re Downton's* patent (*s*) in the Privy Council, the great ingenuity of the patentee was considered by their Lordships as one great reason for a prolongation.

In re Downton's patent.

Utility of invention a great criterion of merit.

The utility of the invention to the public, is of course one great criterion in judging of the merit of a patentee, and if his merit is not very considerable, the Privy Council will not recommend a prolongation of the patent. Thus

(*p*) See *in re Whitehouse's* patent, 1 Webs. R. 473; *re Russell's* patent, 2 Moore, P. C. C. 496; *in re Downton's* patent, 1 Webs. R. 565; and *in re Morgan's* patent, 1 Webs. R. 737.

(*q*) 1 Webs. R. 729.

(*r*) *Ibid.* 477.

(*s*) *Ibid.* 565.

in re Morgan's patent (*s*), Lord *Brougham* said, in delivering the judgment of the Privy Council, "Their Lordships do not consider that this invention is entirely without merit, but it seems of a very moderate degree, being the substitution of the chemical process of washing with sulphuric acid for the sealing process by fire, making a cheaper and somewhat better article. It is not without merit, at the same time it cannot be said to be of great merit—merit which would lead their Lordships to strain much in favour of the inventor." And a prolongation was refused (*t*). *In re* Morgan's patent.

There were doubts in the profession respecting the power to grant a prolongation to an assignee (*u*), but notwithstanding such doubts, the Privy Council, in several instances, recommended the grant of extensions to assignees (*x*), and, in one case (*y*), a prolongation was granted to an administratrix. All doubt on this subject has, however, been obviated by the statute 7 & 8 Vict. c. 69, s. 4 (*z*). Grants to assignees of inventors.

Upon a petition by the assignee of a patent, the Privy Council will consider the assignee as representing the merit of the patentee and inventor, and will recommend the grant of an extension to an assignee although Parliament would not have granted such an an extension (*a*). Assignee represents the merit of the patentee.

Thus *in re Galloway's* patent (*b*) Lord *Brougham* stated that the Judicial Committee thought it for the benefit of patentees that the assignee should represent the whole merit of the inventor. And *in re Morgan's* patent (*c*), his Lordship said, in delivering the judgment of the Privy Council, "When application is made to their Lordships for the extension of a patent term, (that is to say, of a monopoly under letters patent,) by assignees to whom the interest of the patentee has been parted with, and in whom it is vested, their Lordships *In re* Galloway's patent. *In re* Morgan's patent.

(*s*) 1 Webs. R. 737.

(*t*) See *in re Woodcroft's* patent, 3 Mo. P. C. C. 171.

(*u*) See the observations of Lord *Brougham, in re Galloway's* patent, 1 Webs. R. 725; the case of *Spilsbury* v. *Clough*, 2 Q. B. 466, and *ante*, pp. 149 and 205.

(*x*) *Whitehouse's* patent, 1 Webs. R. 473; *S. C. nom. re Russell's* patent, 2 Moore, P. C. Cases, 496; *Southworth's* patent, 1 Webs. R. 486; *Wright's* patent, *ibid.* 561; *Jones's* patent, *ibid.* 577; *Galloway's* patent, *ibid.* 724; and *Soames's* patent, *ibid.* 729.

(*y*) *Downton's* patent, 1 Webs. R. 565.

(*z*) Vide *ante*, p. 149, and see the Statute in the Appendix, Chap. I. s. 1.

(*a*) *In re Soames's* patent, 1 Webs. R. 729.

(*b*) 1 Webs. R. 724.

(*c*) *Ibid.* 737.

have always been used to consider that by taking into their view, and favourably listening to the application of an assignee; they are, though not directly, yet mediately, and consequentially, as it were, giving a benefit to the inventor, because if the assignee is not remunerated at all, it might be said that the chance of the patentee of making an advantageous conveyance to the assignee, would be materially diminished, and consequently, his interest damnified. For this reason, consideration has been given to the claims of the assignee who has an interest in the patent."

Assignee's personal merit will be considered.

And the Privy Council will not only consider an assignee as representing the patentee, but will also take into consideration the personal merit of the assignee himself, and his claim to be further rewarded. Thus *in re Whitehouse's* patent (*d*), in which Mr. Russell, the assignee, was applying for a prolongation of a patent, Lord *Brougham* said, in delivering the judgment of the Privy Council in favour of the application, "Their Lordships have taken into account Mr. Russell's merit in patronizing the ingenious and deserving author of this invention, in expending money till he was enabled to complete this invention, and in liberally supplying the funds which were requisite for the purpose of carrying the invention into execution."

If the patentee himself has no great merit or claim to be rewarded, the Privy Council will investigate the claims of the assignee, and if the assignee has not some very considerable merit or claim to be rewarded by the public, their Lordships will, of course, refuse to recommend any extension of the patent (*e*).

(2.)—*Utility of the Invention.*

Utility of an invention to support a patent.

It has been shown in former parts of this work (*f*), that it is sufficient if an invention possesses some degree of utility in order to make it the subject of a valid patent privilege, and that a patent is not void on the ground of a deficiency of public utility in the invention, unless there is a total absence of it (*g*).

(*d*) 1 Webs. R. 473.
(*e*) Vide *in re Morgan's* patent, 1 Webs. R. 737.
(*f*) Vide *ante*, pp. 3 and 133.
(*g*) *Ibid.* pp. 3 and 137.

At the time when a patent is granted it would be difficult, and in many cases it would be impossible, to ascertain the degree of benefit which an invention will confer upon the public; and, therefore it is that patents are granted without much, if any inquiry into the utility of the inventions for which they are obtained; and because (according to the language of the Attorney-general's Report) it is entirely at the hazard of the patentee whether the invention is now, or will have the desired success; and because it is reasonable for her Majesty "to encourage all arts and inventions which *may be* for the public good" (*h*).

Patent granted without inquiry as to utility of invention.

A patentee, therefore, takes a grant, knowing it to be entirely at his own risk; and if the merit of his invention is so small that the patent produces him little or no profit, he has no claim upon the public; he has had all that he bargained for, all that he had any right to expect, and the public ought not to be inconvenienced by the continuance of a monopoly of an invention, which, although itself of small utility, yet may be of some importance as a component part of some other art or invention.

Patentee takes a grant at his own risk.

It has been shown that the object of the patent law is by the grant of patent privileges to encourage ingenious persons to benefit the public by new and useful inventions; and it is the policy of the excellent statute (which the public owe to Lord *Brougham*) to hold out further encouragement, by additional rewards to the patentees of useful inventions, who have not already been sufficiently recompensed by their patents; the reward in every case being an extension of the patent term in proportion to the merit of the applicant, the utility of the invention, and the want of prior remuneration.

Object of patent law to encourage inventors, and prolongations are granted as additional rewards for useful inventions.

The grant of a patent privilege is made by the Crown on behalf of the public (*i*), the consideration for which is the public utility of the invention comprised in it (*k*), and this applies to a patent for a prolongation as well as to an original patent.

Consideration for extension, is the public utility of invention.

It is very fit and proper to grant patents in the first in-

Reason why a patent granted

(*h*) The recital in a patent also shows the intent of the Crown in making the grant to be "to encourage all arts and inventions *which may be for the public good.*" Vide *ante*, pp. 47, 48, 517, and the Forms of Report and Patent, in the Appendix, Chap. II. s. 1.

(*i*) Vide *ante*, p. 52.

(*k*) *Ibid.* p. 132, 133.

without inquiry into utility of invention.

stance at the risk of the public receiving very small consideration for some of the grants; for, if a contrary course were adopted, the community would run some risk of losing the benefit of really useful inventions, or what would be nearly as bad, delaying the publication of them to the world.

The same reason does not apply to an extension.

But when an invention has once been published, and by the inventor's own act dedicated to th public, after the expiration of a patent, there is no reason for prolonging the patent privilege, if it is not shown that the invention confers some substantial benefit upon the public; for, if such an invention really does benefit the public, the patentee can have no difficulty in proving the fact after he has had the advantage of a fourteen years' monopoly, and the opportunity of ascertaining whether he has produced any thing the public requires.

Utility of invention must be proved.

In order to obtain the prolongation of a patent, therefore, it is necessary that the petitioner should prove to the satisfaction of the Privy Council, that the invention comprised in the patent has given some considerable benefit to the public as consideration for the new grant, as an equivalent for the inconvenience which must result from the continuance of the patent privilege. And in all the cases of applications for prolongations which have been made, the Judicial Committee has required the utility of the invention to be satisfactorily proved, and has refused to grant extensions in those cases in which the public have not received some considerable benefit.

In re Erard's patent.

In *Erard's* case (*l*), Lord *Lyndhurst* said, in delivering the judgment of the Privy Council, upon an application for the prolongation of a patent, "In cases of this kind we expect a very strong case of hardship, as well as *a strong case upon the utility of the invention.*" So *in re Downton's* patent (*m*),

In re Downton's patent.

upon an application to extend a patent, it was laid down by the Privy Council that the questions were, "*is it a useful invention; is it beneficial to the public; is it an invention of that character which would lead us to interpose;* is there ingenuity in the invention, and has the party been remunerated" (*n*).

It is no objection that inven-

It is no objection to the claim of a patentee for a pro-

(*l*) 1 Webs. R. 557.
(*m*) *Ibid.* 565.
(*n*) See also *in re Wright's* patent, 1 Webs. R. 575; *in re Jones's* patent, 1 Webs. R. 577; *in re Galloway's* patent, *ibid.* 724.

longation that improvements have been made upon his invention, if the invention itself, which is comprised in the patent, was itself at the date of the patent really useful and meritorious. tion has been improved.

Thus *in re Galloway's* patent (*o*), which was an application for the prolongation of a patent for an invention of improvements in machinery for propelling vessels, Lord *Brougham* said, in delivering the judgment of the Privy Council, "Now it appears that improvements were made in the float, such manifest improvements, that no person would after these ever think of persisting in using the invention as it originally stood, but would have recourse to the improvements. That, however, is no reason against the claim of the original inventor; it is only saying that his invention, though useful, has been capable of improvement, and its having been improved, affords no reason for denying him an extension of the patent, if upon other grounds he has merit, and if upon other grounds he is shown not to have reaped a due benefit in proportion to that merit. If such an argument were to prevail, any improvement made by him upon the patent would at once take away the patentee's right to obtain, under whatever circumstances he may come before this Court, a recommendation to have, under the Act of Parliament, an enlargement of the term." *In re* Galloway's patent.

And *in re Soame's* patent (*p*), the same law was laid down by Lord *Brougham*. *In re* Soame's patent.

It is evident, indeed, that it is rather to the advantage of the public to hold out inducements to patentees to improve their inventions, and to grant more liberal extensions in cases where inventors have, by improvements, made their inventions of greater utility and value to the public. Patentees who improve their inventions more meritorious.

And no argument can or ought to prevail against the utility of an invention, by reason of the small step which the patentee made in advance of the previous state of public knowledge respecting the particular art or branch of manufactures to which the invention relates. This was laid down and most lucidly explained by Lord *Brougham*, in delivering the judgment of the Privy Council upon an application for a Smallness of step no argument against an extension.

(*o*) 1 Webs. R. 724. (*p*) *Ibid.* 734.

In re Soame's patent.

prolongation of *Soame's* patent (*q*), in which his Lordship said, "It is very fit their Lordships should guard against the inference being drawn, from the small amount of any step made in improvement, that they are disposed to undervalue that in importance; if a new process is invented, if new machinery is invented, if a new principle is found out and applied so as to become the subject of a patent right, embodied in a manufacture, then, however small it may be in advance of the state of science, or of art previous to the period of that step being made, that is no reason whatever for undervaluing the merits of the person who makes a discovery in science or an invention in art, because the whole history of science, from the greatest discoveries down to the most unimportant—from the discovery of the system of gravitation itself, and the fractional calculus itself, down to the most trifling step that ever has been made, is one continued illustration of the slow progress by which the human mind makes its advance in discovery; it is hardly perceptible, so little has been made by any one step in advance of the former state of things, because generally you find that just before there was something very nearly the same thing discovered or invented. Therefore it is no argument whatever in general, if there is a new principle, or a novel invention, a new process for instance."

(3.) *No sufficient reward.*

Patentees often fail to acquire any reward from first patent.

A patent is granted for the purpose of rewarding an inventor for the benefit which his invention confers upon the public. From many causes over which patentees have no controul, they very frequently suffer great loss, or fail to acquire such an amount of remuneration as it is just and expedient that they should receive; even when their inventions are very meritorious and most valuable to the public (*r*).

Object of stat. 5 & 6 W. IV. c. 83, s. 4, to grant extents to those not sufficiently rewarded.

The object of the statute 5 & 6 Will. IV. c. 83, s. 4, was to enable the Crown, with the advice of the Privy Council, to prolong patent rights, as rewards to patentees, in cases where they possess great merit, and have not been sufficiently recompensed by means of the grant contained in the first patent.

(*q*) 1 Webs. R. 735.

(*r*) Vide *ante*, pp. 145, 146.

The want of a sufficient amount of recompense or reward arising from the exercise of the privilege granted by the first patent, is therefore in every case essentially necessary, in order to bring an applicant for a prolongation within the meaning of the statute (*s*), and a petitioner must prove, to the satisfaction of the Privy Council, that he has not been sufficiently remunerated.

Want of recompense essential, and must be satisfactorily proved.

Every case laid before the Privy Council will be thoroughly investigated (*t*), and if a meritorious petitioner is able to satisfy their Lordships that he has not received any sufficient recompense, such an extension of the patent will be recommended—as in the judgment of their Lordships will meet the justice of the case (*u*).

Cases are well investigated.

In cases in which it has been shown that meritorious patentees have received no remuneration, or have suffered a loss, extensions have generally been recommended for the full period of seven years, authorized to be granted under the 5 & 6 Will. IV. c. 83. s. 4 (*x*).

Cases in which extensions for seven years have been granted.

In other cases their Lordships have recommended extensions for various additional terms, according to the particular degree of merit of each petitioner, and the extent to which he has already been remunerared (*y*).

Cases in which less than seven years have been granted.

But when it appears that a patentee, or his assignee, has received as much remuneration as he deserves (*z*), or that the patent has not been productive of remuneration, in consequence of the gross negligence on the part of the patentee (*a*), the Privy Council will not report in favour of a prolongation.

Cases in which extensions are refused.

The power of prolonging a patent privilege was enlarged by the statute 7 & 8 Vict. c. 69, s. 2, which recites that, "It is expedient for the further encouragement of inventions

Power of prolonging patents enlarged by stat. 7 & 8 Vict. c. 69, s. 2.

(*s*) *In re Soame's* patent, 1 Webs. R. 733; *in re Kay's* patent, *ibid.* 571.

(*t*) See *in re Swaine's* patent, 1 Webs. R. 559.

(*u*) See the various cases reported in the first vol. of Mr. Webster's Reports.

(*x*) See *in re Stafford's* patent, 1 Webs. R. 563; *in re Kollman's* patent, *ibid.* 564; *in re Robert's* patent, *ibid.* 573; *in re Wright's* patent, *ibid.* 575; *in re Jones's* patent, *ibid.* 577; and *in re Wright's* patent, *ibid.* 736.

(*y*) See *in re Southworth's* patent, 1 Webs. R. 486; *in re Downton's* patent, 1 Webs. R. 565; *in re Kay's* patent, *ibid.* 568; *S. C.* 3 Moore's P. C. C. 24; *in re Galloway's* patent, 1 Webs. R. 724; and *in re Soame's* patent, *ibid.* 729.

(*z*) See *in re Morgan's* patent, 1 Webs. R. 737; *in re Quarrill's* patent, *ibid.* 740.

(*a*) See *in re Sinister's* patent, 1 Webs. R. 721.

in the useful arts, to enable the time of monopoly in patents to be extended in cases in which it can satisfactorily be shown that the expense of the invention hath been greater than the time now limited by law will suffice to reimburse:" and enacts, "That if any person having obtained a patent for any invention, shall before the expiration thereof present a petition to her Majesty in Council, setting forth that he has been unable to obtain a due remuneration for his expense and labour in perfecting such invention, and that an exclusive right of using and vending the same for the further period of seven years, in addition to the term in such patent mentioned, will not suffice for his reimbursement and remuneration, then if the matter of such petition shall be by her Majesty referred to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same after the manner and in the usual course of its proceedings touching patents, and if the said Committee shall be of opinion and shall so report to her Majesty, that a further period greater than seven years' extension of the said patent term ought to be granted to the petitioner, it shall be lawful for her Majesty, if she shall so think fit, to grant an extension thereof for any time not exceeding fourteen years, in like manner and subject to the same rules as the extension for a term not exceeding seven years, is now granted under the powers of the said Act of the sixth year of the reign of his late Majesty" (*b*).

If patentee shows that an extension for seven years will not remunerate him, a term not exceeding fourteen years may be granted.

Lesser term may be granted than prayed for by petition.

And by section 4 of the Act it is enacted, that nothing therein contained, shall prevent the Judicial Committee from reporting that an extension for any period not exceeding seven years should be granted, or prevent her Majesty from granting an extension for such lesser term than the petition shall have prayed.

Object of stat. 7 & 8 Vict. c. 69, s. 2.

The object of this statute as shown by the recital, is to provide the means of rewarding meritorious inventors in cases where prolongations for seven years would be sufficient for that purpose.

Petition for prolongation for fourteen years.

In order to obtain a prolongation under this statute, the petition must allege that an extension for seven years would

(*b*) The stat. 5 & 6 Will. IV. c. 83, which is previously recited.

be insufficient to remunerate him, and pray for the grant of an additional term of fourteen years.

What petitioner must prove.

The petitioner must also show to the satisfaction of their Lordships, that a prolongation would not be sufficient to remunerate him for his expense and labour in perfecting his invention.

The statutes extend to cases in which Acts of Parliament would not have been obtained.

Although the proceeding before the Judicial Committee to obtain the prolongation of a patent, is substituted for an application to Parliament for an Act, yet the provisions of the statutes 5 & 6 Will. IV. c. 83, and 7 & 8 Vict. c. 69, s. 2, were intended to apply to some cases in which Acts of prolongation could not have been obtained.

In re Soame's patent.

This is clearly explained by Lord *Brougham* in giving the judgment of the Judicial Committee upon a petition for the prolongation of *Soames'* patent (*c*), in which his Lordship said, "their Lordships have always considered that it was with the view of affording a better remedy, not only cheaper and easier, but better in this respect, that there might be cases which never would have prevailed on the legislature to make a new personal law prolonging a monopoly, which, nevertheless might seem meritorious enough in respect of the individual, beneficial enough in respect of the public, and deficient enough in remuneration to justify interference; which, nevertheless, had they been presented in the form of a petition to Parliament would have failed to procure an Act,"

Opposition to an extension.

A person who has entered a caveat against the prolongation of a patent, is entitled (if he gives a sufficient notice of his objections) to dispute the petitioner's claim, and to disprove any part of the case which is laid before the Privy Council in support of the petition.

What an opposing party may show.

Thus an opposing party may give evidence to show that the patentee was destitute of merit, that the invention was of no use to the public, or that the patentee has been sufficiently rewarded, or failed to obtain a sufficient recompense only in consequence of his own gross negligence.

So also it may be shown in opposition to such an application that the patent is clearly void, either for want of novelty or utility in the invention, or for any other cause.

(*c*) 1 Webs. R. 734.

Patent will be assumed to be good unless the contrary clearly appears.

But the Privy Council will assume a patent to be good until the contrary be shown, either by the judgment of a Court of Law or Equity, or by some other proof which can leave no doubt on the subject. If a patent is clearly void, the Privy Council will not recommend Her Majesty to make another void grant, but their Lordships will not take upon themselves the office of a Court of Law or Equity to investigate the legality of a patent, and in all doubtful cases they will leave the legal objections to a patent to be determined by those Courts (*d*).

Provision for patentee when extension granted to an assignee.

The Privy Council will in some cases where an assignee is applying for an extension, grant the prayer of a petition upon the terms that some further reward be given to the patentee.

In re Whitehouse's patent.

Thus, *in re Whitehouse's* patent (*e*), the Privy Council granted an extension to Mr. Russell, the assignee of the patent, upon condition that he secured to Mr. Whitehouse the payment of 500*l.* per annum, during the further term which was granted.

Licensees.

So also the Privy Council will take care that licensees are not unfairly prejudiced by a prolongation (*f*), and if a petitioner has not made terms with a licensee, the licensee may oppose the grant of an extension.

Evidence.

The Judicial Committee adopts rules of evidence as nearly as possible resembling those which prevail in our Courts of Law (*g*), and a petitioner must prove all facts necessary to support his petition to the satisfaction of their Lordships. No admission made by a party opposing the petition will dispense with any necessary proof, for their Lordships are bound to protect the interests of the public (*h*).

Evidence of want of remuneration.

For the purpose of proving the insufficiency or want of remuneration, the petitioner's original account books must be produced, and an accountant must be called who has examined them, and can state the actual amount of profit and loss arising from the exercise of the patent. And a balance sheet ought to be produced showing the actual receipts and ex-

(*d*) See *in re Kay's* patent, 1 Webs. 568; *S. C.* 3 Moore, P. C. Cases, 24.

(*e*) 1 Webs. R. 568; *S. C. nom. re Russell's* patent, 2 Moore, P. C. Cases, 496.

(*f*) Upon this subject, vide *ante*, p. 148.

(*g*) See *in re Erard's* patent, 1 Webs. R. 557, n. (*a*).

(*h*) See *in re Soame's* patent, 1 Webs. R. 732.

penditure of the patentee as well as the balance of profit or loss. The Privy Council will require the most satisfactory evidence upon this part of a petitioner's case which is so essential to entitle him to the extension he is seeking to obtain (i).

Evidence may be taken *vivâ voce*, or upon written depositions.

By section 7 of the statute 3 & 4 Will. IV. c. 41, it is enacted, "That it shall be lawful for the said Judicial Committee in any matter which shall be referred to such Committee to examine witnesses by word of mouth (and either before or after examination by deposition), or to direct that the depositions of any witness shall be taken in writing by the Registrar of the said Privy Council, to be appointed by his Majesty as hereinafter-mentioned, or by such other person or persons, and in such manner, order, and course as his Majesty in Council, or the said Judicial Committee shall appoint and direct; and that the said Registrar, and such other person or persons so to be appointed, shall have the same powers as are now possessed by an examiner of the High Court of Chancery, or of any Court Ecclesiastical."

Witnesses to be examined on oath before Judicial Committee, Registrar, &c.

By section 9 it is enacted, "That every witness who shall be examined in pursuance of this Act, shall give his or her evidence upon oath, or if a Quaker or Moravian, upon solemn affirmation, which oath and affirmation respectively shall be administered by the said Judicial Committee and Registrar, and by such other person or persons as his Majesty in Council, or the said Judicial Committee shall appoint; and that every such witness who shall wilfully swear or affirm falsely shall be deemed guilty of perjury, and shall be punished accordingly."

Attendance of witnesses and production of papers, &c. may be compelled by *subpœna*.

By section 19 it is enacted, "That it shall be lawful for the President for the time being of the said Privy Council to require the attendance of any witnesses, and the production of any deeds, evidences, or writings, by writ to be issued by such President in such and the same form, or as nearly as may be, as that in which a writ of *subpœna ad testificandum*, or of *subpœna duces tecum*, is now issued by his Majesty's Court of King's Bench, at Westminster; and that every person disobeying any such writ so to be issued by the said President, shall be considered as in contempt of the said Judicial Com-

(i) Vide *in re Quarrill's* patent, 1 Webs. R. 740; and *in re Swaine's* patent, *ibid.* 560, n. (*a*).

mittee, and shall also be liable to such and the same penalties and consequences as if such writ had issued out of the said Court of King's Bench, and may be sued for such penalties in the said Court."

Provisions of 13 Geo. III. c. 63, and 1 Will. IV. c. 22, respecting the examination of witnesses, extended to Judicial Committee.

By section 14, after reciting that by the statutes of 13 Geo. III. c. 63, and 1 Will. IV. c. 22, certain powers are given to certain courts therein mentioned to enforce, and provisions are made for the examination of witnesses upon interrogatories and otherwise; it is enacted, "That all the powers and provisions contained in the two last-mentioned Acts, or either of them, shall extend to and be exercised by the said Judicial Committee, in all respects as if such Committee had been therein named as one of His Majesty's Courts of Law at Westminster."

Under this section of the Act the Judicial Committee may order witnesses to be examined before the Registrar, or issue commissions for the examination of witnesses, and such examinations may be upon interrogatories or otherwise (*k*).

Costs to be paid by such parties as Judicial Committee shall direct.

By section 15, it is enacted that the costs incurred in the prosecution of any appeal or matter referred to the said Judicial Committee, and of such issues as the same Committee shall under this Act direct, shall be paid by such party or parties, person or persons, and be taxed by the aforesaid Registrar, or such other person or persons to be appointed by his Majesty in Council, or the said Judicial Committee, and in such manner as the said Committee shall direct."

Under this enactment the Judicial Committee has power to compel a party petitioning or opposing a petition to pay costs to his opponent. Thus, *in re Mackintosh's* patent (*l*), the petitioner having abandoned his application for a prolongation, the Privy Council ordered him to pay the opposing parties their costs. *In re Downton's* patent (*m*), an opposing party was ordered to pay the petitioner the extra costs occasioned by the opposition. And *in re Westrupp* and *Gibbon's* patent (*n*), a petition for the confirmation of a patent being opposed, was dismissed with costs. And in the case just cited, Lord *Lyndhurst* said, "My opinion on the subject of

(*k*) See the provisions of the Act, 1 Will. IV. c. 22.

(*l*) 1 Webs. R. 739, n.

(*m*) 1 Webs. R. 567.

(*n*) *Ibid.* 556.

costs is this; if a party entitled to oppose does come and oppose, and opposes successfully, if we do not give costs, we shall discourage persons coming to protect the interests of the public. We have the power to give costs in any matter referred to us, and sitting here as a Judicial Committee, we can give costs under the general Act (*o*), not under the patent Act" (*p*). And in the same case their Lordships refused to allow evidence to be given as to costs after the close of the case.

The costs to be paid in pursuance of an order of the Privy Council are generally taxed by the clerk of appeals; but the Council may direct the costs to be taxed by any other officer.

References may be made to the Registrar or any other officer.

By section 17, it is enacted, "That it shall be lawful for the said Committee to refer any matters to be examined and reported on to the aforesaid Registrar, or to such other person or persons as shall be appointed by his Majesty in Council, or by the said Judicial Committee, in the same manner and for the like purposes as matters are referred by the Court of Chancery to a Master of the said Court; and that for the purposes of this Act, the said Registrar and the said person or persons so to be appointed, shall have the same powers and authorities as are now possessed by a Master in Chancery."

If the Privy Council refuses to report in favour of the prayer of a petition, whether for a confirmation or prolongation, a report is unnecessary, and none will be prepared.

Report in favour of petitioner.

When the Privy Council has determined to report to the Crown in favour of a confirmation or prolongation, a report is accordingly drawn up by the clerk of appeals stating that the Judicial Committee recommend the prayer of the petition to be granted; and if the petition be for a prolongation, also stating the additional term which her Majesty is advised to grant to the petitioner, and the conditions (if any) upon which the new grant is to be made (*q*).

Report to be approved of by the Queen in Council.

The report when prepared will be approved of by the Queen in Council, at the first meeting of the Privy Council after the matter of the petition has been heard; and the order

(*o*) 3 & 4 Will. IV. c. 41, s. 15.
(*p*) 5 & 6 Will. IV. c. 83.
(*q*) The cost of the report is 1*l*. 10*s*.

in Council made thereupon (*r*) will then be delivered to the petitioner's solicitor to be taken to the Office of the Secretary of State for the Home Department, to procure the Queen's warrant for a patent in pursuance of the recommendation of the Privy Council.

Warrant for a bill for new patent.

Upon a report of the Privy Council in favour of a confirmation (if by a new patent) or prolongation, a warrant will be prepared reciting the facts stated in the report, and commanding the Attorney or Solicitor-general to prepare a bill for the intended patent by which the confirmation or prolongation is to be granted. This warrant is prepared at the Home Office, and is signed by her Majesty, and countersigned by the Secretary of State, in the same way as a warrant for an ordinary patent (*s*).

The warrant will be delivered to the petitioner, his solicitor, or agent, at the Home Office, and it must then be taken to the Patent Bill Office, in order that the bill and two transcripts may be prepared.

It is unnecessary here to describe the subsequent proceedings for obtaining the patent, they are the same as the proceeding in ordinary cases which have already been detailed (*t*).

(*r*) The cost of the order in Council is 3*l*. 2*s*. 6*d*.

(*s*) The cost of the warrant is the same as in other cases.

(*t*) Vide Section 1 of this Chapter, *ante*, p. 519.

APPENDIX.

CHAPTER I.

STATUTES, RULES, AND TABLES OF FEES AND STAMPS.

CHAPTER II.

FORMS AND ENTRIES.

APPENDIX.

CHAPTER I.

STATUTES, RULES, AND TABLES OF FEES AND STAMPS.

SECT. I.—*Statutes relating to Letters Patent.*
II.—*Rules of Practice relating to Letters Patent for Inventions.*
III.—*Tables of Fees and Stamps.*

SECTION I.

Statutes relating to Letters Patent.

18 HEN. VI. c. 1. [A. D. 1439.]

"WHEREAS, by suit made to the King by divers persons, it hath been desired by their petitions to have offices, farms, and other things of the gift and grant of the King by his gracious letters patents thereof to them to be made, desiring by the same petitions the same letters patents of the King to bear date at a certain day limited in the same, the which day is often long before the King's grant to them made upon their said petitions, whereby the King's letters patent to them thereupon made have borne the same date, by reason whereof divers of the King's liege people having such offices, farms, and other things of the gift or grant of the King by his gracious letters patents thereof to them long time before duly made, by such subtle imagination of such ante dates desired by such petitions of such offices, farms, and other things, often have been put out, removed, and expelled against right, good conscience, and reason" (*a*). Our said Lord the King willing to put out such imaginations, by the advice and assent of the Lords spiritual and temporal aforesaid, and at the special

(*a*) The deed of a subject has relation to the time of delivery; but a patent, on the contrary, has relation only to the day of the date. The reason is, that a patent being a record cannot be contradicted, and it could not be allowed to be alleged against a patent, that it was made at any other time than the day it bears date, Plow. 491. Hence the mischief produced by ante-dating patents as mentioned in this preamble.

request of the said Commons, hath ordained, by authority of the same Parliament, that of every warrant hereafter sent by the same our Lord the King, or his heirs, to the Chancellor of England for the time being, the day of the delivery of the same to the Chancellor shall be entered of record in the Chancery (*b*). And that the Chancellor do cause letters patents to be made upon the same warrant bearing date the day of the said delivery in the Chancery, and not before in anywise (*c*). And if any letters patents be from henceforth made to the contrary, they shall be void, frustrate, and holden for none (*d*).

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27 HEN. VIII. c. 11. [A. D. 1535.]

An Act concerning Clerks of the Signet and Privy Seal.

"Whereas the King's clerks of his Grace's Signet and Privy Seal (*e*), giving their daily attendance for the passing and writing of his Majesty's great and weighty affairs, and the causes of this his realm, having for their entertainment and their clerks no fees, nor wages certain for those offices other than such fees as cometh and groweth of the said Signet and Privy Seal, to the intent that from henceforth they should not by any manner of means be defeated of any part or portion of the same their fees:" be it therefore ordained, established, and enacted, by the consent and assent of the Lords spiritual and temporal, and the Commons in this present Parliament assembled, and by authority of the same, that all and every gift, grant, and other writing, which shall be made or given in writing by the King's Highness, or any of his most noble posterity, to any person or persons signed with his Grace's sign, or the sign or signs

The king's grants shall be brought to the secretary or to a clerk of the signet.

(*b*) In pursuance of this enactment, an entry, usually called a *recepi*, is always entered in the margin or upon some part of a writ of privy seal, as follows:—

"Received the *first* day of *August*, one thousand eight hundred and forty-five. Signed,

"LYNDHURST, C."

And when a writ of privy seal is altered it must be re-delivered to the Lord Chancellor, and an entry made of the re-delivery. See the Practice, Chapter XII. pp. 536, 548, and the Forms, *post*, in the Appendix, Chapter II. s. 1.

(*c*) See *Daniel's* case, Dyer, 133. If the Chancellor makes a patent without any date it is not therefore void, 10 Hen. VII. f. 20, and 20 Hen. VII. 7, 8, Godb. 416.

(*d*) By means of the record, made in pursuance of the statute, a person aggrieved is enabled to show when a writ of privy seal was delivered to the Chancellor; and if it appears that the patent has been made in contravention of this statute it will be void. But if the officer of the Lord Chancellor merely omits to make an entry of record according to this statute, a patent properly made, and not dated before the day of the actual delivery of the writ, will not be void for want of such a record, Plow. 491.

(*e*) By the statute 57 Geo. III. c. 63, s. 1, it is provided that the duties of these offices are to be executed in person; and by section 2, the commissioners of the treasury are authorised to regulate the duties of the offices and establishments. By the statute 2 & 3 Will. IV. c. 49, s. 1, the commissioners of the treasury are authorised to abolish the offices of any of the clerks of the signet or privy seal as they shall become vacant, and to direct the duties of the offices abolished to be performed by the remaining clerks in the office.

manual of any of them, to be passed under any his Grace's great seals of England, Ireland, Duchy of Lancaster, or any of his Highness's counties palatines, or principality of Wales, or by other process, out of the Exchequer after the fifteenth day of April, in the twenty-seventh year of his most noble reign, and that all and every gifts, grants, and other writings of what name or names, quality or qualities soever, the same may be or hereafter shall be named, deemed, or called, which the master of the King's wards, or general surveyors of the King's lands for the time being, or any other officer or officers that now be or hereafter shall be made, shall by virtue of an Act of Parliament, or any the King's grants to them, or any of them made or hereafter to be made in that behalf, give, grant, or make after the aforesaid fifteenth day of April, to any person or persons in the King's name to be passed under any of his Majesty's seals, be in anywise first and before the same grant, or any of them, be passed under any the King's said seals or other process made of the same, brought and delivered to the King's principal secretary, or to one of the King's clerks of his Grace's signet for the time being, to be at the said office of the signet passed accordingly.

A warrant by the clerk of the signet to the lord keeper of the privy seal.

2. And be it also ordained and enacted by the authority aforesaid, that one of the clerks of the said signet to whom any of the said writings, signed with the King's most gracious hand, or the hand of any other aforesaid, or any of them fortune to be delivered, may and shall, by warrant of the same bills, and every of them within the space of eight days next after he shall have received the same, unless he have knowledge by the said secretary or otherwise of the King's pleasure to the contrary, make or cause to be made in the King's name letters of warrant subscribed with the hand of the same clerk, and sealed with the King's signet, to the Lord keeper of the King's Privy Seal for further process to be had in that behalf: and that one of the King's clerks of the said Privy Seal upon due examination had by the said Lord keeper of the said Privy Seal, of the said warrant to him addressed from the office of the said signet as afore, may and shall, within the space of eight days next after he shall have received the same, unless the Lord keeper of the Privy Seal do give them commandment to the contrary, make or cause to be made by warrant of the aforesaid warrant to the said Lord keeper of the Privy Seal address from the office of the signet aforesaid, other letters of like warranty subscribed with the name of the same clerk of the Privy Seal to the Lord Chancellor of England, Lord keeper of the Great Seal, Chancellor of the Duchy of Lancaster, Chancellor of the King's land of Ireland, treasurer and chamberlains of the Exchequer, and chamberlains of any of his counties palatines, or principality of Wales, or other officer, and to every of them, for the writing and ensealing with such seals as remain in their custody of letters patent, or closed or other process making due and requisite to be had, or made, upon any the said grants, according to the tenor of the warrant to them or any of them directed, from the officer of the Privy Seal, as is afore specified.

Warrant from the privy seal to the Lord Chancellor.

3. And also be it enacted by the authority aforesaid, that no manner of

Penalty for altering the

contrat aforesaid.

clerk or clerks, or other person or persons, do write or make any manner of writing, warrant or warrants, upon any manner of gift or grant made by the King's Highness, or by any other his Grace's officers as aforesaid, or procure the same or any of the same to be passed under the seals aforesaid after any other sort, manner or fashion, or by any other warrant or warrants than as before is specified and delivered, upon pain to forfeit for every bill, warrant or writing, passed contrary to the order before limited and prescribed, the sum of 10*l.* sterling, the one half thereof to be to our Sovereign Lord the King, and the other half to him that shall first sue for the same by action of debt, writ, bill, plaint, or information, in any of the King's Courts; in which action or suit, no essoin, protection, privilege, nor wager of law shall be admitted; any manner, act, statute, provision, proclamation, or other ordinance heretofore had or made contrary to this present Act, or any article of the same in anywise notwithstanding.

Fees for writings which pass by immediate warrant.

4. And nevertheless be it also enacted, that every of the said clerks or other person which shall pass in writing, or procure to be passed in writing, any grant or grants by immediate warrant, wherefore fees be paid at the Great Seal, shall of the parties receive for the offices of the said signet and Privy Seal, as well such fees as in this Act is taxed for writing of any such grant or other writings, as also the fees for the seal of the same; which fees and every part and portion thereof the same clerk or clerks by whom any grant shall pass in writing by immediate warrant, shall upon a bill of the hand of one of the said clerks of the said signet or Privy Seal, deliver unto one of the same clerks of the signet or Privy Seal, within the space of three months next and immediately ensuing after the passing and sealing of any of the said grant or grants, by immediate warrant, upon pain of 10*l.* sterling, to be by every such of the said clerks or other person as shall offend, forfeited, to be levied in form aforesaid, as often as he or they shall offend contrary to the meaning of this Act.

This Act not to prejudice the Lord Treasurer's warrants to the Lord Chancellor.

5. Provided also, that this Act or any thing contained in the same, be not in anywise prejudicial to the Lord Treasurer of England for the time being, concerning such warrants or precepts as he by virtue of his office, shall and may direct immediately to the Lord Chancellor of England, or to any other person or persons for making out of the King's grants or letters patents to any person or persons of any offices, farms, of lands, or tenements, or of any other thing belonging to his nomination or disposition; but that as well he may direct his said warrants or precepts for the causes above said, as also his clerk or clerks, or other person, may procure the same to be sealed under any of the seals aforesaid without any warrant to be before or after sued or obtained under the King's signet or Privy Seal for the same in as large and ample manner, and after such sort or fashion, as he or they might have done at any time before the making of this Act; any thing in the same Act mentioned to the contrary notwithstanding.

6. (This section provides that the Act shall not extend to leases granted under the seals of the Duchy of Lancaster, or the county palatine of Lancaster.)

7. (This section provides that the Act shall not extend to grants under the Duchy or county palatine seal of Lancaster of any offices the yearly fees of which do not exceed two-pence per diem).

9. Provided also, that the Lord Chancellor of England for the time being, shall and may at all times use his discretion in passing and speeding any thing by the Great Seal, and delivering the same without paying any fees for the Great Seal signet and Privy Seal, as the case of necessity shall require, and as hath been accustomed; and that the clerks for writing or procuring such writings and patents by his commandment, shall be discharged of all penalties expressed before in this Act for not receiving and paying fees to the signet and Privy Seal; any thing in this Act contained to the contrary hereof notwithstanding.

Lord Chancellor may pass instruments without payment of fees.

10, 11, and 12. [These sections of the Act do not apply to patents such as are the subject of this work].

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3 & 4 Ed. VI. c. 4. [A. D. 1549].

An Act concerning Grants and Gifts made by Patentees out of Letters Patent.

Explained and amended by 13 Eliz. c. 6, *post*.

Grants made by patentees out of patents.

Where the right noble and famous King of full worthy memory, King Henry the Eighth, father to our most dread and now natural Sovereign Liege Lord, sithence the fourth day of February, in the xxvij. year of his late reign, and also the King's most excellent Majesty by their several letters patents, have given, granted, bargained, sold, and exchanged to and with divers and sundry the subjects of this realm, bodies politick and corporate, in fee-simple, and fee-tail for term of life or years, divers honours, castles, manors, lands, tenements and other hereditaments and offices; after and since which grants, bargains, sales, and exchanges, divers of the said patentees, their heirs, successors or assigns, have bargained, sold, given, exchanged or demised divers particular parts, parcels or portions of the said honours, castles, manors, lands, tenements, hereditaments and offices, or other things thereunto appertaining, or belonging to other person or persons, bodies politick and corporate; that is to say, to some of them in fee-simple, to some others in fee-tail, for term of life or years, or otherwise; and after the same patentees, for considerations them moving, have surrendered and given up their said letters patents to the Chancery, or otherwise the same letters patents have been forfeited by attainder, lost, cancelled, imbessed, or by other ways or means have come to the hands of the King's Majesty his late father; And thereupon oft-times the enrolment of the same hath been made void and frustrate, sometime in part, and sometime in the whole, by reason whereof such persons, bodies politick or corporate, as have had interest or title in or to the same castles, manors or particular portions or parcels of the same so to them given and granted, have been in time past, and in time to come are like to be disherited, or in danger or loss of their interest in or to the same, to their no little hindrance and peril.

An exemplification of letters patent under the great seal shall be of the like force as if the letters patent were showed.

2. For remedy whereof be it ordained, established and enacted by the authority of this present Parliament, that all and every person or persons, bodies politick or corporate, which lawfully shall or may claim by force of any patent or patents made sithence the said fourth day of February, or hereafter to be made by the King's Majesty, his heirs or successors, Kings of this realm, or by any of them; and all other that now have or hereafter shall happen to have any good or lawful estate, right, title, rent, profit, interest or possession, of, in, to, or out of any honours, manors, lands, tenements, hereditaments or offices, or of other things to any of the premises appertaining or belonging, or to any part, parcel or member of them or any of them, by, from or under any such patentee or patentees, or any of them, or by, from or under the heirs, successors or assigns, of them or any of them, or by, from or under the estate of any others which had, have or hereafter shall have the estate, title or interest of any such patentee or patentees, or by any other means under the date of such letters patents, shall and may at all times hereafter, in any of the King's Courts, his heirs or successors, and elsewhere, by virtue of this present Act, make and convey unto himself title by way of declaration, plaint, avowry, title, bar, or otherwise as well against the King's Highness, his heirs and successors, and every of them, as against any other person or persons unto the said honours, castles, manors, lands, tenements, offices and other the premises, or any part or parcel of the same, unto them or any their predecessors or ancestors, or others whose estate they have in the same, by, from or under the said patentees or any of them, or the heirs, ancestors or assigns of any of them, or otherwise under the date of the said letters patents comprised and contained in any exemplification or constat thereof made or to be made, by the showing forth of the said exemplification or constat of the Roll, or of so much thereof as shall serve for the matter in variance, under the Great Seal of England: And the same exemplification or constat of the said enrolment so as is aforesaid pleaded and showed, shall be of like and the same force and effect, to all intents and constructions in the law, as the said first letters patents were and should be of, if the same were or should be pleaded or showed.

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13 ELIZ. c. 6. [A. D. 1570].

An Act that the Exemplification or Constat of Letters Patents shall be as good and available as the Letters Patents themselves.

A supply of the statute of 3 & 4 Edw. VI. c. 4.

"For the avoiding of all such doubts, questions and ambiguities as heretofore have risen and been moved, and of such as hereafter might rise and be moved, in and upon the statute made in the Parliament begun and holden at Westminster, the fofirth day of November, in the third year of the reign of our late Sovereign Lord King Edward the Sixth, intituled 'An Act concerning Grants and Gifts made by Patentees out

of Letters Patents, and for a due and full Supply of all such Wants as may be thought to be therein (*f*).'"

2. Be it enacted and declared by the authority of this present Parliament, that all and every patentee and patentees, their heirs, successors, executors and assigns, and all and every other person and persons having by or from them or any of them, or under their title, any estate or interest of, in, or to any lands, tenements, or hereditaments, or *any other thing whatsoever* (*g*), to such patentee or patentees heretofore granted, by any letters patents either of the most famous Princes King Henry the Eighth, King Edward the Sixth, Queen Mary, King Philip and Queen Mary, or by any of them, or by the Queen's most excellent Majesty that now is, at any time sithence (*h*) the fourth day of February, in the twenty-seventh year of the reign of the said late King Henry the Eighth, or else by the Queen's Majesty that now is, her heirs or successors at any time hereafter to be granted, shall and may at all times hereafter in any of the Queen's Highness's Courts, her heirs and successors, or elsewhere by the authority of this present Act, make and convey, and be allowed and suffered to make and convey to and for him, them, and every of themselves, such claim or title by way of declaration, plaint, avowry, bar, replication, or other pleading whatsoever, as well against the Queen's Highness, her heirs and successors, and every of them, as against all and every other person and persons whatsoever for or concerning the lands, tenements, hereditaments, or other things whatsoever specified or contained in any such letters patents, or of, for, or concerning any part or parcel thereof, by showing forth an *exemplification* or *constat* (*i*) under the Great Seal of England, of the enrolment of the same letters patents (*k*), or of so much thereof as shall and may serve to or for such title, claim or matter, (the same letters patents *then* being and remaining in force, not lawfully surrendered nor cancelled)(*l*), for or concerning so much and such part and parcel of such lands, tenements, hereditaments or other thing whereunto such title or claim shall be made, as if the same letters patents self were pleaded and showed forth; any law, usage or other thing whatsoever to the contrary notwithstanding.

An exemplification of letters patent to be of the same force as the letters patent themselves.

(*f*) See *Sir T. Wroth's* case, Dyer, 167, a, pl. 13.

(*g*) These words are sufficient to extend the statute to patents for inventions, see *Page's* case, 5 Co. R. 53, and Carth. 138; Co. Lit. 225, b.

(*h*) The Act does not extend to any patent made before this day, Palin. 62.

(*i*) See the difference between an *exemplification* and a *cons*[illegible]*ined*, 5 Co. R. 53, b, 54, a.

(*k*) The *exemplification* or *constat* is of the enrolment, not of the patent, Co. Lit. 225, b.

(*l*) It seems that an *exemplification* or *constat* may be granted at any time before a *vacat* is entered; but not after a *vacat* has been entered on the roll, Dyer, 167, a, pl. 13, n; 3 Leon. 165. It seems, however, that a third party, as an alienee, will not be prejudiced by a surrender made to the Crown by the patentee, and that the alienee will be entitled to a *constat* or *exemplification*, notwithstanding the entry of a *vacat* upon the roll. See the *Master and the Chaplain of the Savoy* case, 3 Leon. 163; and Bro. Abr. tit. pat. pl. 97.

31 ELIZ. c. 5, s. 5. [A. D. 1589].

Limiting the time within which Penal Actions may be commenced (m).

Within what times suits upon penal statutes shall be pursued.

5. And be it further enacted by the authority aforesaid, that all actions, suits, bills, indictments or informations, which after twenty days next after the end of this session of Parliament shall be had, brought, sued or exhibited, for any forfeiture upon any statute penal (n) made or to be made, whereby the forfeiture is or shall be limited to the Queen, her heirs or successors only, shall be had, brought, sued or exhibited within two years next after the offence committed or to be committed against such Act penal, and not after two years. And that all actions, suits, bills or informations which after the said twenty days shall be had, brought, sued or commenced for any forfeiture upon any penal statute made or to be made, (except the statute of tillage,) the benefit and suit whereof is or shall be by the said statute limited to the Queen, her heirs or successors, and to any other which shall prosecute in that behalf, shall be had, brought, sued or commenced by any person that may lawfully pursue for the same as aforesaid, within one year next after the offence committed or to be committed against the said statute. And in default of such pursuit, that then the same shall be had, sued, exhibited or brought for the Queen's Majesty, her heirs or successors, at any time within two years after that year ended. And if any action, suit, bill, indictment or information for any offence against any penal statute made or to be made, (except the statute of tillage,) shall be brought after the time in that behalf before limited, that then the same shall be void and of none effect, any Act or statute made to the contrary notwithstanding.

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21 JAC. I. c. 3. [A. D. 1623].

An Act concerning Monopolies and Dispensations of Penal Laws, and the Forfeitures thereof.

All monopolies, &c. shall be void.

"Forasmuch as your most excellent Majesty, in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did in the year of our Lord God one thousand six hundred and ten, publish in print to the whole realm, and to all posterity, that all grants of monopolies, and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant and agreeable to the ancient and fundamental laws of this your realm: And whereas your Majesty was further graciously pleased expressly to command, that no suitor should presume to move your Majesty for matters

(m) See respecting this enactment, 2 Hawk. P. Cr. c. 26, ss. 40—50.

(n) Vide *ante*, pp. 367 and 372.

of that nature; yet nevertheless upon *misinformations* and *untrue pretences of public good*, many such grants have been unduly obtained, and unlawfully put in execution, to the great grievance and inconvenience of your Majesty's subjects, contrary to the laws of this your realm, and contrary to your Majesty's most royal and blessed intention, so published as aforesaid:" For avoiding whereof, and preventing of the like in time to come, may it please your excellent Majesty, at the humble suit of the Lords Spiritual and Temporal, and the Commons, in this present Parliament assembled, That it may be declared and enacted: and be it declared and enacted by authority of this present Parliament, THAT all monopolies, and all commissions, grants, licences, charters, and letters patents heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of any thing within this realm, or the dominion of *Wales*, or of any other monopolies, OR of power, liberty, or faculty, to dispense with any others, OR to give licence or toleration to do, use, or exercise any thing against the tenor or purport of any law or statute: OR to give or make any warrant for any such dispensation, licence, or toleration to be had or made; OR to agree or compound with any others for any penalty or forfeitures limited by any statute; OR of any grant or promise of the benefit, profit, or commodity of any forfeiture, penalty, or sum of money, that is or shall be due by any statute, before judgment thereupon had: AND all proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things whatsoever, any way tending to the instituting, erecting, strengthening, furthering, or countenancing of the same or any of them; *are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in no wise to be put in ure or execution.*

Monopolies, &c. shall be tried by the common laws of this realm.

2. And be it further declared and enacted by the authority aforesaid, That all monopolies, and all such commissions, grants, licences, charters, letters patents, proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things tending as aforesaid, and the force and validity of them, and of every of them, ought to be and shall be for ever hereafter examined, heard, tried, and determined, by and according to the common laws of this realm, and not otherwise.

All persons disabled to use monopolies, &c.

3. And be it further enacted by the authority aforesaid, That all person and persons, bodies politic and corporate whatsoever, which now are or hereafter shall be, shall stand and be disabled and uncapable to have, use, exercise, or put in ure any monopoly, or any such commission, grant, licence, charter, letters patents, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, or any liberty, power, or faculty, grounded or pretended to be grounded upon them, or any of them.

The party grieved by pretext of a monopoly, &c. shall recover treble

4. And be it further enacted by the authority aforesaid, That if any person or persons at any time after the end of forty days next after the end of this present session of Parliament, shall be hindered, grieved, disturbed, or disquieted, or his or their goods or chattels any way seized,

damages and double costs.

attached, distrained, taken, carried away or detained, by occasion or pretext of any monopoly, or of any such commission, grant, licence, power, liberty, faculty, letters patents, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, and will sue to be relieved in or for any of the premises; that then and in every such case, the same person and persons shall and may have his and their remedy for the same at the common law, by any action or actions to be grounded upon this statute; the same action and actions to be heard and determined in the Courts of King's Bench, Common Pleas, and Exchequer, or in any of them, against him or them by whom he or they shall be so hindered, grieved, disturbed, or disquieted, or against him or them by whom his or their goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained; wherein all and every such person and persons which shall be so hindered, grieved, disturbed, or disquieted, or whose goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained, shall recover three times so much as the damages which he or they sustained by means or occasion of being so hindered, grieved, disturbed, or disquieted, or by means of having his or their goods or chattels seized, attached, distrained, taken, carried away, or detained, and double costs; and in such suits, or for the staying or delaying thereof, no essoin, protection, wager of law, aid-prayer, privilege, injunction, or order of restraint, shall be in any wise prayed, granted, admitted, or allowed, nor any more than one imparlance: And if any person or persons shall, after notice given, that the action depending is grounded upon this statute, cause or procure any action at the common law, grounded upon this statute, to be stayed or delayed before judgment, by colour or means of any order, warrant, power, or authority, save only of the court wherein such action as aforesaid shall be brought and depending, or after judgment had upon such action, shall cause or procure the execution of or upon any such judgment to be stayed or delayed by colour or means of any order, warrant, power, or authority, save only by writ of error or attaint; that then the said person and persons so offending shall incur and sustain the pains, penalties and forfeitures, ordained and provided by the Statute of Provision and *Præmunire* made in the sixteenth year of the reign of King Richard the Second.

He that delayeth an action grounded upon this statute incurs a *præmunire*.

16 Rich. II. c. 5.

Letters patents to use new manufactures, saved.

5. Provided nevertheless, and be it declared and enacted, That any declaration before mentioned shall not extend to any letters patents and grants of privilege for the term of one and twenty years or under, *heretofore* made, of the sole working or making of any manner of new manufacture within this realm, to the first and true inventor or inventors of such manufactures, which others at the time of the making of such letters patents and grants did not use, so they be not contrary to the law, nor mischievous to the state, by raising of the prices of commodities at home, or hurt of trade, or generally inconvenient, but that the same shall be of such force as they were or should be, if this Act had not been made, and of none other: and if the same were made for more than one and twenty

years, that then the same for the term of one and twenty years only, to be accounted from the date of the first letters patents and grants thereof made, shall be of such force as they were or should have been, if the same had been made but for term of one and twenty years only, and as if this Act had never been had or made, and of none other.

6. Provided also, and be it declared and enacted, That any declaration before mentioned shall not extend to any letters patents and *grants of privilege* for the term of fourteen years or under, hereafter to be made, *of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patents and grants shall not use*, so as also they be not contrary to the law, nor mischievous to the state, by raising prices of commodities at home, or hurt of trade, or generally inconvenient: the said fourteen years to be accounted from the date of the first letters patents, or grant of such privilege hereafter to be made, but that the same shall be of such force as they should be, if this Act had not been made, and of none other. Exception of future letters patent.

7. Provided also, and it is hereby further intended, declared, and enacted by authority aforesaid, That this Act or any thing therein contained shall not in any wise extend, or be prejudicial to any grant or privilege, power, or authority whatsoever heretofore made, granted, allowed, or confirmed by any Act of Parliament now in force, so long as the same shall so continue in force.

8. Provided also, That this Act shall not extend to any warrant or privy seal, made or directed, or to be made or directed by his Majesty, his heirs or successors, to the justices of the Courts of the King's Bench or Common Pleas, and barons of the Exchequer, justices of assize, justices of *oyer* and *terminer* and gaol delivery, justices of the peace, and other justices for the time being, having power to hear and determine offences done against any penal statute, to compound for the forfeitures of any penal statute, depending in suit and question before them, or any of them respectively, after plea pleaded by the party defendant. Warrants granted to justices saved.

9. Provided also, and it is hereby further intended, declared and enacted, That this Act or any thing therein contained shall not in any wise extend or be prejudicial unto the city of *London*, or to any city, borough, or town corporate within this realm, for or concerning any grants, charters, or letters patents, to them or any of them made or granted, or for or concerning any custom or customs used by or within them or any of them; or unto any corporations, companies or fellowships of any art, trade, occupation or mystery, or to any companies or societies of merchants within this realm, erected for the maintenance, enlargement, or ordering of any trade of merchandize; but that the same charters, customs, corporations, companies, fellowships and societies, and their liberties, privileges, powers, and immunities, shall be and continue of such force and effect as they were before the making of this Act, and of none other; any thing before in this Act contained to the contrary in any wise notwithstanding. Charters granted to corporations, saved.

Letters patent that concern printing, saltpetre, gunpowder, great ordnance, shot, or offices, saved.

10. Provided also, and be it enacted, That this Act, or any declaration, provision, disablement, penalty, forfeiture, or other thing before mentioned, shall not extend to any letters patents or grants of privilege heretofore made, or hereafter to be made, of, for, or concerning printing, nor to any commission, grant or letters patents, heretofore made, or hereafter to be made, of, for, or concerning the digging, making, or compounding of saltpetre or gunpowder, or the casting or making of ordnance, or shot for ordnance, nor to any grant or letters patents heretofore made, or hereafter to be made, of any office or offices heretofore erected, made or ordained, and now in being, and put in execution, other than such offices as have been decried by any his Majesty's proclamation or proclamations: but that all and every the same grants, commissions, and letters patents, and all other matters and things tending to the maintaining, strengthening, and furtherance of the same, or any of them, shall be and remain of the like force and effect, and no other, and as free from the declarations, provisions, penalties, and forfeitures contained in this Act, as if this Act had never been had nor made, and not otherwise.

This Act shall not extend to commissions for alum mines.

11. Provided also, and be it enacted, That this Act, or any declaration, provision, disablement, penalty, forfeiture, or other thing before mentioned, shall not extend to any commission, grant, letters patents or privilege heretofore made, or hereafter to be made, of, for, or concerning the digging, compounding, or making of alum or alum mines, but that all and every the same commissions, grants, letters patents and privileges, shall be and remain of the like force and effect, and no other, and as free from the declarations, provisions, penalties, and forfeitures contained in this Act, as if this Act had never been had nor made, and not otherwise.

12. [Nor to the liberties of Newcastle-upon-Tyne, nor to licences of keeping taverns.]

13. [Nor to letters patents granted to Sir Robert Mansel, Knt., or to James Maxwell, Esq.]

14. [Nor to those granted to Abraham Baker, or Lord Dudley.]

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21 JAC. I. C. 4. S. 4, [A. D. 1623.]

Giving the Defendant in a Penal Action the Privilege of pleading the General Issue, and giving the Special Matter in Issue.

The defendant in an information upon a penal statute may plead the general issue.

4. And be it also enacted by the authority aforesaid, That if any information, suit, or action shall be brought or exhibited against any person or persons for any offence committed or to be committed against the form of any penal law either by or on the behalf of the King or by any other, or on the behalf of the King and any other, it shall be lawful for such defendants to plead the general issue that they are not guilty, or that

they owe nothing (*a*), and to give such special matter in evidence to the jury that shall try the same, which matter being pleaded had been a good and sufficient matter in law to have discharged the said defendant or defendants against the said information, suit, or action, and the said matters shall be then as available to him or them to all intents and purposes as if he or they had sufficiently pleaded, set forth, or alleged the same matter in bar or discharge of such information, suit or action.

STATUTE 5 & 6 WILL. IV. c. 62.

An Act to repeal an Act of the present Session of Parliament, intituled "An Act for the more effectual Abolition of Oaths and Affirmations taken and made in various Departments of the State, and to substitute Declarations in lieu thereof, and for the more entire Suppression of Voluntary and Extra-judicial Oaths and Affidavits," and to make other Provisions for the Abolition of unnecessary Oaths.

[Royal Assent, 9th September, 1835.]

Declaration substituted for oaths and affidavits heretofore required on taking out a patent.

11. And be it enacted, That whenever any person or persons shall seek to obtain any patent under the Great Seal for any discovery or invention, such person or persons shall, in lieu of any oath, affirmation, or affidavit which heretofore has or might be required to be taken or made upon or before obtaining any such patent, make and subscribe in the presence of the person before whom he might but for the passing of this Act be required to take or make such oath, affirmation, or affidavit, a declaration to the same effect as such oath, affirmation, or affidavit, and such declaration, when duly made and subscribed, shall be to all intents and purposes as valid and effectual as the oath, affirmation, or affidavit, in lieu whereof it shall have been so made and subscribed.

Declaration to be in the form prescribed in the schedule.

20. And be it further enacted, That in all cases where a declaration in lieu of an oath shall have been substituted by this Act, or by virtue of any power or authority hereby given, or where a declaration is directed or authorised to be made and subscribed under the authority of this Act, or of any power hereby given, although the same be not substituted in lieu of an oath heretofore legally taken, such declaration, unless otherwise directed under the powers hereby given, shall be in the form prescribed in the schedule hereunto annexed.

Person making a false declaration guilty of a misdemeanour.

21. And be it further enacted, That in any case where a declaration is substituted for an oath under the authority of this Act, or by virtue of any power or authority hereby given, or is directed and authorised to be made and subscribed under the authority of this Act, or by virtue of any power hereby given, any person who shall wilfully and corruptly make and subscribe any such declaration, knowing the same to be untrue in any material particular, shall be deemed guilty of a misdemeanour.

(*a*) The plea must have the words, "By statute," written in the margin; vide *ante*, p. 371.

Commencement of Act.

23. And be it enacted, That this Act shall commence and take effect from and after the first day of October in this present year, the year of our Lord one thousand eight hundred and thirty-five.

Schedule referred to by the foregoing Act.

Form of declaration.

"I A. B. do solemnly and sincerely declare that and I make this solemn declaration, conscientiously believing the same to be true, and by virtue of the provisions of an Act made and passed in the year of the reign of his present Majesty, intituled 'An Act,'" (*here insert the title of this Act.*)

STATUTE 5 & 6 WILL. IV. c. 83.

An Act to amend the Law touching Letters Patent for Inventions.
[Royal Assent, 10th September, 1835.]

"Whereas it is expedient to make certain additions to and alterations in the present law touching letters patent for inventions, as well for the better protecting of patentees in the rights intended to be secured by such letters patent, as for the more ample benefit of the public from the same:" be it enacted by the King's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons in this present Parliament assembled, and by the authority of the same, That any person who, as grantee, assignee, or otherwise, hath obtained or who shall hereafter obtain letters patent, for the sole making, exercising, vending, or using of any invention, may, if he think fit, enter with the clerk of the patents of England, Scotland, or Ireland, respectively, as the case may be (having first obtained the leave of his Majesty's Attorney-general or Solicitor-general in case of an English patent, of the Lord Advocate or Solicitor-general of Scotland in the case of a Scotch patent, or of his Majesty's Attorney-general or Solicitor-general for Ireland in the case of an Irish patent, certified by his fiat and signature), a disclaimer of any part of either the title of the invention or of the specification, stating the reason for such disclaimer, or may, with such leave as aforesaid, enter a memorandum of any alteration in the said title or specification (not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent); and such disclaimer or memorandum of alteration being filed by the said clerk of the patents, and enrolled with the specification, shall be deemed and taken to be part of such letters patent or such specification in all Courts whatever: provided always, that any person may enter a caveat, in like manner as caveats are now used to be entered, against such disclaimer or alteration; which caveat being so entered shall give the party entering the same a right to have notice of the application being heard by the Attorney-general, or Solicitor-general, or Lord Advocate, respectively: provided also, that no such disclaimer or alteration shall be receivable in evidence in any action or suit (save and except in any proceeding by *scire facias*) pending at the time when such disclaimer or alteration was enrolled, but

Any person having obtained letters patent for any invention may enter a disclaimer of any part of his specification, or a memorandum of any alteration therein, which, when filed, to be deemed part of such specification.

Caveat may be entered as heretofore.

in every such action or suit the original title and specification alone shall be given in evidence, and deemed and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted: provided also, that it shall be lawful for the Attorney-general, or Solicitor-general, or Lord Advocate, before granting such fiat, to require the party applying for the same to advertise his disclaimer or alteration in such manner as to such Attorney-general, or Solicitor-general, or Lord Advocate, shall seem right, and shall, if he so require such advertisement, certify in his fiat that the same has been duly made.

Disclaimer not to affect actions pending at the time.

Attorney-general may require the party to advertise his disclaimer.

2. And be it enacted, That if in any suit or action it shall be proved, or specially found by the verdict of a jury, that any person who shall have obtained letters patent for any invention or supposed invention was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same, or some part thereof, before the date of such letters patent, or if such patentee or his assigns shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof, before the date of such letters patent, it shall and may be lawful for such patentee or his assigns to petition his Majesty in Council to confirm the said letters patent, or to grant new letters patent, the matter of which petition shall be heard before the Judicial Committee of the Privy Council: and such committee, upon examining the said matter, and being satisfied that such patentee believed himself to be the first and original inventor, and being satisfied that such invention or part thereof had not been publicly and generally used before the date of such first letters patent, may report to his Majesty their opinion that the prayer of such petition ought to be complied with; whereupon his Majesty may, if he think fit, grant such prayer, and the said letters patent shall be available in law and equity to give to such petitioner the sole right of *using*, *making*, and *vending* such invention as against all persons whatsoever, any law, usage, or custom to the contrary notwithstanding: provided that any person opposing such petition shall be entitled to be heard before the said Judicial Committee: provided also that any person, party to any former suit or action touching such first letters patent, shall be entitled to have notice of such petition before presenting the same.

Mode of proceeding where patentee is proved not to be the real inventor, though he believed himself to be so.

3. And be it enacted, That if any action at law or any suit in equity for an account shall be brought in respect of any alleged infringement of such letters patent heretofore or hereafter granted, or any *scire facias* to repeal such letters patent; and if a verdict shall pass for the patentee or his assigns, or if a final decree or decretal order shall be made for him or them upon the merits of the suit, it shall be lawful for the judge before whom such action shall be tried to certify on the record, or the judge who shall make such decree or order to give a certificate under his hand, that the validity of the patent came in question before him, which record or certificate being given in evidence in any other suit or action whatever touching such patent, if a verdict shall pass, or decree or decretal order be made, in favour of such patentee or his assigns, he or they shall re-

If in any action or suit a verdict or decree shall pass for the patentee, the Judge may grant a certificate, which being given in evidence in any other suit, shall entitle the patentee, upon a verdict in his

favour, to receive treble costs.

ceive treble costs in such suit or action, to be taxed at three times the taxed costs, unless the judge making such second or other decree or order, or trying such second or other action, shall certify that he ought not to have such treble costs.

Mode of proceeding in case of application for the prolongation of the term of a patent.

Amended by 2 & 3 Vict. c. 67.

4. And be it further enacted, That if any person who now hath, or shall hereafter obtain any letters patent as aforesaid, shall advertise in the *London Gazette* three times, and in three London papers, and three times in some country paper, published in the town where or near to which he carried on any manufacture of any thing made according to his specification, or near to or in which he resides, in case he carried on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to apply to his Majesty in Council for a prolongation of his term of sole using and vending his invention, and shall petition his Majesty in Council to that effect, it shall be lawful for any person to enter a caveat at the Council Office; and if his Majesty shall refer the consideration of such petition to the Judicial Committee of the Privy Council, and notice shall first be by him given to any person or persons who shall have entered such caveats, the petitioner shall be heard by his counsel and witnesses to prove his case, and the persons entering caveats shall likewise be heard by their counsel and witnesses; whereupon, and upon hearing and inquiring of the whole matter, the Judicial Committee may report to his Majesty that a further extension of the term in the said letters patent should be granted, not exceeding seven years; and his Majesty is hereby authorised and empowered, if he shall think fit, to grant new letters patent for the said invention for a term not exceeding seven years after the expiration of the first term, any law, custom, or usage to the contrary in anywise notwithstanding: provided that no such extension shall be granted if the application by petition shall not be made and prosecuted with effect before the expiration of the term originally granted in such letters patent.

In case of action, &c. notice of objections to be given.

5. And be it enacted, That in any action brought against any person for infringing any letters patent, the defendant on pleading thereto shall give to the plaintiff, and in any *scire facias* to repeal such letters patent the plaintiff shall file with his declaration, a notice of any objections on which he means to rely at the trial of such action, and no objection shall be allowed to be made in behalf of such defendant or plaintiff respectively at such trial, unless he prove the objections stated in such notice: provided always, that it shall and may be lawful for any judge at chambers, on summons served by such defendant or plaintiff on such plaintiff or defendant respectively, to show cause why he should not be allowed to offer other objections whereof notice shall not have been given as aforesaid, to give leave to offer such objections, on such terms as to such judge shall seem fit.

As to costs in actions for infringing letters patent.

6. And be it enacted, That in any action brought for infringing the right granted by any letters patent, in taxing the costs thereof regard shall be had to the part of such case which has been proved at the trial,

which shall be certified by the judge before whom the same shall be had, and the costs of each part of the case shall be given according as either party has succeeded or failed therein, regard being had to the notice of objections, as well as the counts in the declaration, and without regard to the general result of the trial.

Penalty for using unauthorised the name of a patentee, &c.

7. And be it enacted, That if any person shall write, paint or print, or mould, cast, or carve, or engrave or stamp, upon any thing made, used, or sold by him, for the sole making or selling of which he hath not, or shall not have, obtained letters patent; the name, or any imitation of the name, of any other person who hath or shall have obtained letters patent for the sole making and vending of such thing, without leave in writing of such patentee or his assigns: or if any person shall upon such thing, not having been purchased from the patentee, or some person who purchased it from or under such patentee, or not having had the license or consent in writing of such patentee or his assigns, write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word "Patent," the words "Letters Patent," or the words "By the King's Patent," or any words of the like kind, meaning, or import, with a view of imitating or counterfeiting the stamp, mark, or other device of the patentee: or shall in any other manner imitate or counterfeit the stamp, or mark, or other device of the patentee: he shall for every such offence be liable to a penalty of fifty pounds, to be recovered by action of debt, bill, plaint, process, or information, in any of his Majesty's Courts of Record at Westminster or in Ireland, or in the Court of Session in Scotland, one half to his Majesty, his heirs and successors, and the other to any person who shall sue for the same: provided always, that nothing herein contained shall be construed to extend to subject any person to any penalty in respect of stamping or in any way marking the word "Patent" upon any thing made, for the sole making or vending of which a patent before obtained shall have expired.

STATUTE 2 & 3 VICT. c. 67.

An Act to amend an Act of the Fifth and Sixth Years of the Reign of King William the Fourth, intituled "An Act to amend the Law touching Letters Patent for Inventions."

[Royal Assent, 24th August, 1839.]

Recital of stat. 5 & 6 Will. IV. c. 83, s. 4.

"Whereas by an Act passed in the fifth and sixth years of the reign of his Majesty, King William the Fourth, intituled 'An Act to amend the Law touching Letters Patent for Inventions,' it is amongst other things enacted, that if any person having obtained any letters patent as therein mentioned, shall give notice as thereby required of his intention to apply to his Majesty in Council for a prolongation of his term of sole using and vending his invention, and shall petition his Majesty in Council to that effect, it shall be lawful for any person to enter a caveat at the Coun-

cil Office, and if his Majesty shall refer the consideration of such petition to the Judicial Committee of the Privy Council, and notice shall be first given to any person or persons who shall have entered such caveats, the petitioner shall be heard by his counsel and witnesses to prove his case, and the persons entering caveats shall likewise be heard by their counsel and witnesses, whereupon and upon hearing and inquiry of the whole matter, the Judicial Committee may report to his Majesty that a further extension of the term in the said letters patent shall be granted not exceeding seven years. And his Majesty is thereby authorised and empowered if he shall think fit, to grant new letters patent for the said invention for a term not exceeding seven years after the expiration of the first term, any law, custom, or usage to the contrary notwithstanding, provided that no such extension shall be granted if the application by petition shall not be made and prosecuted with effect before the expiration of the term originally granted in such letters patent: And whereas it has happened since the passing of the said Act, and may again happen, that parties desirous of obtaining an extension of the term granted in letters patent of which they are possessed, and who may have presented a petition for such purposes in manner by the said recited Act directed before the expiration of the said term, may nevertheless be prevented by causes over which they have no control from prosecuting with effect their application before the Judicial Committee of the Privy Council; and it is expedient therefore that the said Judicial Committee should have power when under the circumstances of the case they shall see fit, to entertain such application, and to report thereon, according to the provisions of the said recited Act, notwithstanding that before the hearing of the case before them the terms of the letters patent sought to be renewed or extended may have expired:" Be it therefore enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal and Commons in this present Parliament assembled, and by the authority of the same, That so much of the said recited recited Act as provides that no extension of the term of letters patent shall be granted as therein mentioned, if the application by petition for such extension be not prosecuted with effect before the expiration of the term originally granted in such letters patent, shall be, and the same is hereby repealed.

Repeals so much of recited Act as requires petition to be prosecuted with effect before expiration of the term of the patent.

2. And be it further enacted, That it shall be lawful for the Judicial Committee of the Privy Council in all cases where it shall appear to them that any application for an extension of the term granted by any letters patent, the petition for which extension shall have been referred to them for their consideration, has not been prosecuted with effect before the expiration of the said term from any other causes than the neglect or default of the petitioner to entertain such application, and to report thereon as by the said recited Act provided, notwithstanding the term originally granted in such letters patent may have expired before the hearing of such application; and it shall be lawful for her Majesty, if she shall think fit, on the report of the said Judicial Committee recommending an extension of the term of such letters patent to grant such exten-

Term may be extended although it has expired before the hearing, if petitioner has not committed any default.

sion, or to grant new letters patent for the invention or inventions specified in such original letters patent for a term not exceeding seven years after the expiration of the term mentioned in the said original letters patent: Provided always, that no such extension or new letters patent shall be granted if a petition for the same shall not have been presented as by the said recited Act directed, before the expiration of the term sought to be extended, nor in case of petitions presented after the thirtieth day of November, one thousand eight hundred and thirty-nine, unless such petition shall be presented six calendar months at the least before the expiration of such term, nor in any case unless sufficient reason shall be shown to the satisfaction of the said Judicial Committee for the omission to prosecute with effect the said application by petition before the expiration of the said term.

After Nov. 30, 1839, petitions to be presented six calendar months before expiration of term.

3. And be it further enacted, That this Act may be altered, amended, or repealed by any Act to be passed in the present Session.

STATUTE 3 & 4 VICT. c. 24, ss. 1 and 2.

An Act to repeal Part of an Act of the Forty-third Year of the Reign of Queen Elizabeth, intituled "An Act to avoid trifling and frivolous Suits in Law in her Majesty's Courts in Westminster," and of an Act of the twenty-second and twenty-third Year of the Reign of King Charles the Second, intituled "An Act for laying Impositions on Proceedings at Law, and to make further Provisions in lieu thereof."

[Royal Assent, 3rd July, 1840.]

Recites statutes 43 Eliz. c. 6, and 22 & 23 Car. II. c. 9.

"Whereas an Act passed in the forty-third year of the reign of Queen Elizabeth, intituled 'An Act to avoid trifling and frivolous Suits in Law in her Majesty's Courts in Westminster,' and another Act in the twenty second and twenty third years of the reign of King Charles the Second, intituled 'An Act for laying Impositions on Proceedings at Law,' which recites, that many good subjects of this realm have been, and daily are undone by such suits contrary to the intention of the said statute of Queen Elizabeth; but the same evil notwithstanding doth still prevail and increase, and it is expedient to make further provisions for the prevention thereof:' Now be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal and Commons in this present Parliament assembled, and by the authority of the same, That the said recited Act of the forty-third of Elizabeth, so far as it relates to costs in actions of trespass or trespass on the case, and so much of the twenty-second and twenty-third of Charles the Second, as relates to costs in personal actions, be and they are hereby repealed.

Recited Act in part repealed.

2. And be it enacted, That if the plaintiff in any action of trespass or of trespass on the case brought or to be brought in any of her Majesty's Courts at Westminster, or in the Court of Common Pleas at Lancaster, or

Plaintiff not to recover costs in any action of

trespass or trespass on the case if he recovers less than 40*s.* damages, unless the Judge certifies, &c.

in the Court of Common Pleas at Durham, shall recover by the verdict of a jury less damages than forty shillings, such plaintiff shall not be entitled to recover or obtain from the defendant in respect of such verdict any costs whatever, whether it shall be given upon any issue or issues tried or judgment shall have passed by default, unless the judge or presiding officer before whom such verdict shall be obtained, shall immediately afterwards certify on the back of the record, or on the writ of trial, or writ of inquiry, that the action was really brought to try a right besides the mere right to recover damages for the trespass or grievance for which the action shall have been brought, or that the trespass or grievance in respect of which the action was brought was wilful and malicious.

3. [*This section does not relate to the subject of this work.*]

STATUTE 5 & 6 VICT. c. 97, ss. 2 & 6.

An Act to amend the Law relating to Double Costs, Notices of Action, Limitations of Actions and Pleas of the General Issue, under certain Acts of Parliament.

[Royal Assent, 10th August, 1842.]

"Whereas divers Acts of Parliament, public, local and personal, contain enactments or provisions relating to the recovery of double, treble or other costs in certain cases, and to the pleading of the general issue, and the giving any special matter in evidence at any trial to be had for any matter done in pursuance of or under the authority of the said Acts, and to the giving of notice of action before any action shall be commenced:" And whereas it is expedient that the law should be altered in such respects; Be it therefore enacted, &c.

[*This section repeals the provisions in local and personal Acts giving double and treble costs.*]

Acts giving double or treble costs repealed. Parties to recover full indemnity as to all costs.

Sect. 2.—And be it enacted, That so much of any clause, enactment or provision in any public Act or Acts not local or personal, whereby it is enacted or provided that either double or treble costs, or any other than the usual costs between party and party, shall or may be recovered, shall be and the same are hereby repealed: Provided always, that instead of such costs, the party or parties heretofore entitled under such last-mentioned Acts to such double, treble or other costs, shall receive such full and reasonable indemnity as to all costs, charges and expences incurred in and about any action, suit or other legal proceeding, as shall be taxed by the proper officer in that behalf, subject to be reviewed in like manner and by the same authority as any other taxation of costs by such officer.

Sects. 3, 4 and 5.—[*These sections do not relate to the subject of this work.*]

Not to affect actions brought

Sect. 6.—Provided always and be it enacted, That nothing herein contained shall extend or be construed to extend to any action, bill, plaint

or information, or any legal proceeding of any kind whatsoever commenced before the passing of this Act, but such proceedings may be had and taken in all respects as if this Act had not passed. before passing of Act.

STATUTE 6 & 7 VICT. c. 85.

An Act for improving the Law of Evidence.

[Royal Assent, 22 August, 1843.]

"Whereas the enquiry after truth in courts of justice is often obstructed by incapacities created by the present law, and it is desirable that full information as to the facts in issue, both in criminal and in civil cases, should be laid before the persons who are appointed to decide upon them, and that such persons should exercise their judgment on the credit of the witnesses adduced, and on the truth of their testimony:" Now therefore be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal and Commons in this present Parliament assembled, and by the authority of the same, That no person offered as a witness shall hereafter be excluded by reason of incapacity from crime or interest from giving evidence either in person or by deposition, according to the practice of the Court on the trial of any issue joined, or of any matter or question, or on any inquiry arising in any suit, action, or proceeding, civil or criminal, in any Court, or before any judge, jury, sheriff, coroner, magistrate, officer, or person having, by law or by consent of parties, authority to hear, receive and examine evidence; but that every person so offered, may and shall be admitted to give evidence on oath, or solemn affirmation, in those cases wherein affirmation is by law receivable, notwithstanding that such person may or shall have an interest in the matter in question, or in the event of the trial of any issue, matter, question, or injury, or of the suit, action or proceeding in which he is offered as a witness, and notwithstanding that such person offered as a witness may have been previously convicted of any crime or offence: Provided that this Act shall not render competent any party to any suit, action or proceeding individually named in the record, or any lessor of the plaintiff or tenant of premises, sought to be recovered in ejectment, or the landlord or other person in whose right any defendant in replevin may make cognizance, or any person in whose immediate and individual behalf any action may be brought or defended, either wholly or in part, or the husband or wife of such persons respectively; Provided also, that this Act shall not repeal any provision in a certain Act passed in the session of Parliament holden in the seventh year of the reign of his late Majesty, and in the first year of the reign of her present Majesty, intituled "*An Act for the Amendment of the laws with respect to Wills*:" Provided that in Courts of Equity, any defendant to any cause pending in any such Court, may be examined as a witness on the behalf of the plaintiff, or of any co-defendant in any such cause,

No witness to be excluded from giving evidence by incapacity from crime or interest.

Party to a suit, &c. not to be competent.

Not to repeal any provision in 7 Will. IV. and 1 Vict. c. 26.

In Court of Equity defendant may be examined on

behalf of the plaintiff or a co-defendant, &c.

saving just exceptions; and that any interest which such defendant so to be examined may have in the matters, or any of the matters in question, in the cause, shall not be deemed a just exception to the testimony of such defendant, but shall only be considered as affecting, or tending to affect, the credit of such defendant as a witness.

Not necessary to state that jurors had made affirmation.

2. And be it enacted, That wherever in any legal proceedings whatever legal proceedings may be set out, it shall not be necessary to specify that any particular persons who acted as jurors had made affirmation instead of oath, but it may be stated that they served as jurymen in the same manner as if no Act had passed for enabling persons to serve as jurymen without oath.

Not to affect previous suits.

3. And be it enacted, That nothing in this Act shall apply to, or affect any suit, action, or proceeding brought or commenced before the passing of this Act.

Not to extend to Scotland.

4. And be it enacted, That nothing in this Act shall extend to *Scotland*.

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7 & 8 VICT. c. 69, ss. 2, 3, 4, 5, 6, 7 & 8.

An Act for amending an Act passed in the Fourth Year of the Reign of his late Majesty, intituled "An Act for the better Administration of Justice in his Majesty's Privy Council," and to extend its Jurisdiction and Powers.

[Royal Assent, 6th August, 1844.]

"Whereas the Act passed in the fourth year of the reign of his late Majesty, intituled 'An Act for the better Administration of Justice in his Majesty's Privy Council,' hath been found beneficial to the due administration of justice: And whereas another Act passed in the sixth year of the said reign, intituled 'An Act to amend the Law touching Letters Patent for Inventions' hath been also found [illegible] to inventors and to the public: And whereas the [illegible] the authority of the said Acts, hath been [illegible] for which it [illegible] established by Parliament, [illegible] proceedings [illegible] for the better [illegible] of business, and expedient also to extend its jurisdiction and powers: And whereas by the laws now in force in certain of her Majesty's colonies and possessions abroad, no appeals can be brought to her Majesty in Council for the reversal of the judgments, sentences, decrees, and orders of any courts of justice within such colonies, save only of the courts of error or courts of appeal within the same, and it is expedient that her Majesty in Council should be authorised to provide for the admission of appeals from other courts of justice within such colonies or possessions:" Be it therefore enacted, &c.

[*The first section does not relate to the subject of this work.*]

If extension of a patent term

2. "And whereas it is expedient for the further encouragement of inventions in the useful arts to enable the time of monopoly in patents to

be extended in cases in which it can be satisfactorily shown that the expense of the invention hath been greater than the time now limited by law will suffice to reimburse:" be it enacted, That if any person having obtained a patent for any invention, shall before the expiration thereof present a petition to her Majesty in Council, setting forth that he has been unable to obtain a due remuneration for his expenses and labour in perfecting such invention, and that an exclusive right of using and vending the same for the further period of seven years in addition to the term in such patent mentioned will not suffice for his reimbursement and remuneration, then if the matter of such petition shall be by her Majesty referred to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same after the manner and in the usual course of its proceedings touching patents, and if the said committee shall be of opinion and shall so report to her Majesty that a further period greater than seven years' extension of the said patent term ought to be granted to the petitioner, it shall be lawful for her Majesty, if she shall so think fit, to grant an extension thereof for any time not exceeding fourteen years, in like manner, and subject to the same rules as the extension, for a term not exceeding seven years is now granted under the powers of the said Act of the sixth year of the reign of his late Majesty.

Patent may be granted for 14 years in certains cases.

3. Provided always, and be it enacted, That nothing herein contained shall prevent the said Judicial Committee from reporting that an extension for any period not exceeding seven years should be granted or prevent her Majesty from granting an extension for such lesser term than the petition shall have prayed.

Less term than prayed may be granted.

4. "And whereas doubts have arisen touching the power given by the said recited Act of the sixth year of the reign of his late Majesty in cases where the patentees have wholly or in part assigned their right;" be it enacted, That it shall be lawful for her Majesty, on the report of the Judicial Committ

Extensions of patent terms may be granted to assignees.

been assigned, to [illegible] a disclaimer and memorandum of [illegible] under the powers of the said recited Act, and such disclaimer and memorandum of such alteration having been so entered and filed as in the said recited Act mentioned shall be valid and effectual in favour of any person or persons in whom the rights under the said letters patent may then be or thereafter become legally vested; and no objection shall be made in any proceeding whatsoever, on the ground that the party making such

disclaimer or memorandum of such alteration had not sufficient authority in that behalf.

Disclaimers and memorandums of alteration by assignees before passing of Act to be valid.

6. And be it enacted, That any disclaimer or memorandum of alteration before the passing of this Act, or by virtue of the said recited Act by such patentee with such assignee, or by such assignee as aforesaid, shall be valid and effectual to bind any person or persons in whom the said letters patent might then be or have since become vested: and no objection shall be made in any proceeding whatsoever that the party making such disclaimer or memorandum of alteration had not authority in that behalf.

New patents granted under 5 & 6 Vict. c. 83, s. 4, to assignees before passing of Act to be valid.

7. And be it enacted, That any new letters patent which before the passing of this Act may have been granted, under the provisions of the above-recited Act of the sixth year of the reign of his late Majesty to an assignee or assignees, shall be as valid and effectual as if the said letters patent had been made after the passing of this Act, and the title of any party to such new letters patent shall not be invalidated by reason of the same having been granted to an assignee or assignees: Provided always, that nothing herein contained shall give any validity or effect to any letters patent heretofore granted to any assignee or assignees where any action or proceeding in *scire facias*, or suit in equity, shall have been commenced at any time before the passing of this Act, wherein the validity of such letters patent shall have been or may be questioned.

Not to affect existing *scire facias*, or suit in equity.

Judicial Committee may appoint a clerk to take formal proofs.

8. Provided always, and be it enacted, That in the case of any matter or thing being referred to the Judicial Committee, it shall be lawful for the said Committee to appoint one or other of the Clerks of the Privy Council to take any formal proofs required to be taken in dealing with the matter or thing so referred, and shall, if they so think fit, proceed upon such Clerk's report to them as if such formal proofs had been taken by and before the said Judicial Committee (*p*).

(*p*) The remainder of this statute is inapplicable to the subject of the present work.

SECTION II.

Rules of Practice relating to Letters Patents for Inventions.

1. *Rules and Practice before the Attorney and Solicitor-general respecting Disclaimers and Memorandums of Alteration.*
2. *Rules of Practice in Privy Council respecting the Confirmation and Prolongation of Patents for Inventions.*

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1. *Rules of Practice before the Attorney and Solicitor-general respecting Disclaimers and Memorandums of Alteration.*

The following Rules of Practice before the Attorney and Solicitor-general upon Petitions for leave to enter Disclaimers and Memorandums of Alteration were made shortly after the passing of the 5 & 6 Will. IV. c. 83.

UNTIL further directions are given the following is to be the mode of proceeding by a party in order to obtain leave to enter a disclaimer or alteration of any part, either of the title of his invention or of the specification pursuant to the statute 5 & 6 Will. IV. c. 83, s. 1.

1. The person applying must present a petition to the Attorney-general or Solicitor-general, stating what the proposed disclaimer or alteration is, when a time will be appointed for hearing the applicant. The petition is in general to be accompanied by a copy of the original specification, and of the proposed disclaimer or alteration.

2. If on the hearing the Attorney or Solicitor-general should think fit to disallow the proposed alteration or disclaimer, no further proceeding is necessary. If he should think fit to allow it without any advertisement, then, on being applied to for the purpose, he will put his signature to the fiat authorizing the clerk of the patents to make the required enrolment.

3. If it appears to the Attorney or Solicitor-general that any advertisement or advertisements ought to be inserted, then he will give such directions as he may think fit relative thereto, and will fix any time not sooner than ten days from the first publication of any such advertisement, for resuming the consideration of the matter.

4. Caveats may be lodged at any time before the actual issuing of the fiat; and any party lodging a caveat is to have seven days notice of the next meeting.

5. The fiat must be written or engrossed on the same parchment with the disclaimer or alteration at the foot thereof.

2. *Rules of Practice in the Judicial Committee of the Privy Council respecting the Confirmation and Prolongation of Patents for Inventions.*

Rules to be observed in Proceedings before the Judicial Committee of the Privy Council under the Act of the 5 & 6 Will. IV. c. 83, intituled "An Act to amend the Law touching Letters Patent for Inventions."

[Issued 18th November, 1835.]

1. A party intending to apply, by petition, under section 2 of the said Act, shall give public notice by advertising in the *London Gazette* three times, and in three London newspapers; and three times in some county paper published in the town where or near to which he carries on any manufacture of any thing made according to his specification, or near to or in which he resides, in case he carries on no such manufacture; or published in the county where he carries on such manufacture, or where he lives in case there shall not be any paper published in such town; that he intends to petition her Majesty under the said section, and shall in such advertisements state the object of such petition, and give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition, which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette;* and that on or before such day notice must be given of any opposition intended to be made to the petition, and any person intending to oppose the said application, shall lodge notice to that effect at the Council Office, on or before such day so named in the said advertisements, and having lodged such notice, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

2. A party intending to apply by petition under section 4 of the said Act, shall, in the advertisements directed to be published by the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day caveats must be entered; and any person intending to enter a caveat shall enter the same at the Council Office on or before such day so named in the said advertisements; and, having entered such caveat, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

3. Petitions under sections 2 and 4 of the said Act must be presented within one week from the insertion of the last advertisements required to be published in the *London Gazette*.

4. All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of section 4 of the said Act, and the first and second of these rules: and the matters in such

affidavits may be disputed by the parties opposing upon the hearing of the petitions.

5. All persons entering caveats under section 4 of the said Act, and all parties to any former suit or action touching letters patent in respect of which petitions shall have been presented under section 2 of the said Act, and all persons lodging notices of opposition under the first of these rules, shall respectively be entitled to be served with copies of petitions presented under the said sections, and no application to fix a time for hearing shall be made without affidavits of such service.

6. All parties served with petitions, shall lodge at the Council Office, within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions.

7. Parties may have copies of all papers lodged in respect of any application under the said Act at their own expense.

8. The Master of the High Court of Chancery, or other officer to whom it may be referred to tax the costs incurred in the matter of any petition presented under the said Act, shall allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

To these have been added the following Rules issued on the 21st December, 1835.

Any party applying for an extension of a patent under section 4 of the said Act, must lodge at the Council Office four printed or written copies of his specification for the use of the Judicial Committee.

If such specification shall have been printed in some publication, lodging four copies of the publication containing the same, will be sufficient.

In the event also of the applicant's specification not having been published as aforesaid, and if the expense of making four copies of any drawing therein contained or referred to would be considerable, the lodgment of one copy only of such drawing will be deemed sufficient.

All copies mentioned in this rule must be lodged not less than one week before the day fixed for hearing the application.

The Judicial Committee will hear the Attorney-general or other counsel on behalf of the Crown against granting any application made under either the second or the fourth section of the said Act, in case it shall be thought fit to oppose the same on such behalf.

SECTION III.

TABLES OF FEES AND STAMPS.

I. FEES PAYABLE BY PERSONS SOLICITING PATENTS FOR INVENTIONS.

	Ordinary Fees. £ s. d.	Extra Fees. £ s. d.
At the Attorney or Solicitor-general's Chambers.		
For entering a caveat (at each chambers)	0 5 0	
At the Public Office.		
For taking a declaration . . .	0 1 6	
At the Home Office.		
For reference of a petition by the Secretary of State to the Attorney or Solicitor-general	2 2 6	
At the Attorney or Solicitor-general's Chambers.		
For a summons for a hearing upon an opposed petition . . .	0 5 0	
For a hearing upon an application for a report upon an opposed petition .	3 5 0	
For a report in favour of petitioner .	4 4 0	
At the Home Office.		
For the Queen's warrant to the Attorney or Solicitor-general to prepare a bill for a patent	7 13 6	
If the patent is to be granted to more than one person, for each additional name		1 7 6
If the patent is to extend to the Channel Islands and Colonies, or any of them		1 7 6
At the Patent Bill Office.		
For preparing a bill and docket and procuring the Attorney or Solicitor-general's signature, and for two transcripts of the bill and stamps, and stamping the Queen's warrant	15 16 0	

	Ordinary Fees. £ s. d.	Extra Fees. £ s. d.
If the patent is to be granted to more than one person, then for each additional name . . .		1 7 6
If the patent is to extend to the Channel Islands and Colonies, or any of them		0 2 6

At the Secretary of State's Office.

For procuring the sign manual to a bill .	7 13 6	
If the patent is to be granted to more than one person, then for each additional name . . .		1 7 6
If the patent is to extend to the Channel Islands and Colonies, or any of them		1 7 6

At the Signet Office.

For signing, sealing, and passing a bill .	4 7 0	
If the patent is to be granted to more than one person, then for each additional name . . .		5 18 6
If the patent is to extend to the Channel Islands and Colonies, or any of them		0 13 6
For expedition to pass the bill the same day the Queen's bill is brought into the office . . .		1 11 6

At the Privy Seal Office.

For signing, sealing, and passing a bill .	4 2 0	
If the patent is to be granted to more than one person, then for each additional name . . .		5 18 6
If the patent is to extend to the Channel Islands and Colonies, or any of them		0 13 6
For a private seal . . .		2 0 0
For expedition . . .		1 11 6

At the Patent Office.

For preparing the recepi and docket, engrossing, sealing, and enrolling the patent and entering the docket, stamps and box	48 17 0

	Ordinary Fees. £ s. d.	Extra Fees. £ s. d.
If the patent is to be granted to more than one person, then for each additional name . . .		2 13 4

II. Fees Payable by Persons opposing the Grant of Patents for Inventions.

At the Attorney or Solicitor-general's Chambers.

For entering a caveat (at each chambers)	0	5	0
For hearing an opposition at the report .	3	5	0

At the Patent Bill Office.

For entering a caveat . . .	1	1	0
For hearing an opposition to the bill .	3	5	0

If the opposing party succeeds he must repay the petitioner the following fees.

For the report . . .	4 4 0
For the Queen's warrant . .	7 13 6

Or so much more as the fees for the warrant amount to.

For the summons for the hearing .	0 5 0
For the hearing the petitioner in support of his petition . .	3 5 0
For engrossing the bill . .	1 1 0
For agency fees . . .	2 2 0

If the opposing party does not succeed he must repay the petitioner the following fees only.

For the summons for the hearing .	0 5 0
For the hearing the petitioner in support of his petition . .	3 5 0

At the Patent Office.

For entering a caveat . . .	0	10	0

III. Fees Payable respecting Specifications, Enrolments, Office Copies, &c.

At the Public Office.

For taking the acknowledgment of a specification	0	6	0

	Ordinary Fees. £	s.	d.
At the Rolls Chapel Office.			
For enrolling a specification (*a*), per folio of 90 words .	0	0	6
For a search and inspection	0	1	0
For a copy of a patent or specification, (besides drawing and stamps,) *per folio*	0	0	6
For authenticating any copy, per folio . . .	0	0	6
At the Petty Bag Office.			
For enrolling a specification (*a*), for every skin of the enrolment (containing about 9 folios,) and for any portion of a skin more than half a skin	0	10	6
And for any portion of a skin not more than half a skin .	0	5	3
For a search	0	1	0
For an inspection	0	2	6
For an office copy of a patent or specification, (besides the stamps, 2*d.* per sheet for paper, 3*s.* 4*d.* certificate, and the search and inspection fee,) *per folio* of 90 words .	0	0	8
At the Enrolment Office.			
For enrolling a specification (*a*), for every membrane or skin of the enrolment (containing about 10 folios) .	0	10	0
And for any portion of a membrane less than the whole, for every 5 lines	0	0	6
For a search and inspection	0	1	0
For an office copy of a patent or specification, (besides the stamps, 2*d.* per sheet for the paper, 2*s.* for the certificate, and 1*s.* the search,) *per folio* of 90 words .	0	0	8

IV. Fees Payable respecting Disclaimers and Memorandums of Alteration.

At the Attorney or Solicitor-general's Chambers.			
For appointment and summons for hearing . .	0	5	0
For hearing a party or counsel in support of a petition .	3	5	0
For a fiat	4	4	0
For entering a caveat by a party opposing (at each chambers)	0	5	0
For hearing opposition	3	5	0

(*a*) There is no duty particularly charged by the Stamp Act upon disclaimers or memorandums of alteration; but as the statute 5 & 6 Will. IV. c. 83, s. 1, enacts that a disclaimer or memorandum of alteration shall be deemed to be part of the specification, it has been customary to impress those instruments with a stamp duty of 1*l.*, and a progressive duty of 1*l.*, as here stated.

	Ordinary Fees. £ s. d.
At the Enrolment Office.	
For enrolling a disclaimer or alteration (*The same fees as for enrolling a specification*).	
At the Patent Office.	
For filing	0 1 0
For entering, *per folio* of 90 words	0 0 10
If the length does not exceed 27 folios, the fee is	0 9 0

Drawings are charged extra unless furnished to the office.

V. Stamp Duties Payable upon Documents and Proceedings respecting Patents for Inventions.

Queen's warrant	1 10 0
Queen's bill	1 10 0
Signet bill	1 10 0
Privy Seal bill	1 10 0
Docket at Great Seal	0 2 0
Patent	30 0 0
Specification	5 0 0
If the specification contains 2,160 words, or upwards, then for every entire quantity of 1,080 words above the first 1,080 words, a further progressive duty	1 0 0
Disclaimer, or memorandum of alteration (*a*)	1 0 0
If the disclaimer contains 2,160 words, or upwards, then for every entire quantity of 1,080 words above the first 1,080 words, a further progressive duty of	1 0 0

(*a*) Vide *ante*, p. 615.

CHAPTER II.

FORMS AND ENTRIES.

SEC. I.—*Forms of Proceedings respecting the Obtaining and Opposing of Patents and the Specification of Patent Inventions.*

II.—*Forms of Proceedings respecting Disclaimers or Alterations under* 5 & 6 *Will. IV.* c. 83, s. 1.

III.—*Forms of Proceedings for Obtaining Confirmations or Prolongation of Patents.*

IV.—*Forms of Entries and Proceedings in Actions for Infringements of Patents.*

V.—*Forms of Proceedings in Suits in Chancery to restrain Infringements of Patents.*

VI.—*Forms of Entries and Proceedings in* qui tam *Actions for Penalties under* 5 & 6 *Will. IV.* c. 83, s. 7.

VII.—*Forms of Entries and Proceedings in Actions of* Scire Facias *for Cancelling and Repealing Letters Patents.*

VIII.—*Forms of Assignments of Patents and Licences to use Patent Inventions.*

SECTION I.

Forms of Proceedings respecting the Obtaining and Opposing of Patents, and the Specification of Patent Inventions.

(No. 1.) General caveat against a patent at the Attorney or Solicitor-general's (*a*).

CAVEAT against the grant of letters patent under the Great Seal to any person or persons for [*Here describe the nature of the invention in general terms* (*b*), *as for instance, "improvements in power looms;" "improvements in lace machinery;"*] without notice to me the undersigned [*Here insert the name and address of the party entering the caveat, as* (*c*) *William Newton, of Chancery Lane, in the county of Middlesex, Civil Engineer.*] Dated this [*tenth*] day of [*December,*] 1845.

(Signed) [WM. NEWTON.]

(*a*) See the Practice, *ante*, p. 504.

(*b*) Vide *ante*, p. 506, respecting the description of the invention.

(*c*) The correct address to which notices may be sent by post must be inserted, vide *ante*, p. 507.

[2, King's Bench Walk, Temple,
1st October, 1845.]

(No. 2.)
Notice of an application for a patent (*d*).

SIR,

I beg to inform you that [*James Johnson, of High Wycombe, in the county of Bucks,*] is applying for letters patent for an invention of [*an improved mode of sizing Paper*] (*e*). Should you consider that the grant of such a patent will interfere with your caveat, you may enter an opposition at the Chambers of the Attorney [*or* Solicitor] General here. And if no opposition is entered within seven days from the date hereof, the patent will be allowed to proceed.

I am, Sir, your obedient Servant,
[W. G. BOWYER] (*f*).

(No. 3.)
Petition by an actual inventor for a patent (*g*).

TO THE QUEEN'S MOST EXCELLENT MAJESTY.

The humble Petition of [*James Gowland, of Leathersellers Buildings, in the city of London, Chronometer Maker.*]

Sheweth,

That your petitioner ["after much labour, study, application, trouble, and expense," *any of these words may be inserted if thought desirable*] (*h*), hath invented ["*certain improvements in Chronometers and Timekeepers*"] (*i*), which invention he believes will be of great public utility.

That he is the true and first inventor thereof, and that the said invention hath not been practised or used by any person or persons whomsoever within this realm, to the best of your petitioner's knowledge and belief.

Your petitioner therefore humbly prays that your Majesty will be graciously pleased to grant unto him, his executors, administrators, and assigns, your Majesty's royal letters patent under the Great Seal of your Majesty's United Kingdom of Great Britain and Ireland, for the sole use, benefit, and advantage of his said invention, within that part of your Majesty's said United Kingdom of Great Britain and Ireland, called England, your dominion of Wales, and town of Berwick-upon-Tweed, [and (*k*) also in your Majesty's Islands of Jersey, Guernsey, Alderney, Sark, and Man, and in all your Majesty's Colonies and Plantations abroad,] for

(*d*) See the Practice, *ante*, pp. 508 and 512.

(*e*) The title must be inserted here as it is stated in the petition.

(*f*) The signature of the Attorney or Solicitor-general's chief clerk.

(*g*) See the Practice respecting the petition, *ante*, pp. 509, 510.

(*h*) Such words as these are frequently inserted in petitions; but it is always better to omit them, for the insertion of them when true produces no beneficial effect, and if there be any thing incorrect in the suggestions made to the Crown, the patent will be void.

(*i*) Respecting the choice of a title, vide *ante*, p. 508.

(*k*) These words are to be inserted when it is desired that the patent should extend to the Channel Islands and Colonies.

the term of fourteen years pursuant to the statutes in that case made and provided.

And your petitioner will ever pray, &c.

(Signed) [JAMES GOWLAND.]

LONDON, 10*th October*, 1844.

(No. 4.)
Petition for a patent for an imported invention (*l*).

TO THE QUEEN'S MOST EXCELLENT MAJESTY.

The humble Petition of [*Moses Poole, of Old Square, Lincoln's Inn, in the county of Middlesex, C. E. Patent Agent.*]

Sheweth,

That in consequence of a communication from a foreigner residing abroad, he is in possession of an invention of [*improvements in the construction of Locomotive Engines,*] which invention he believes will be of great public utility.

That the said invention is new within this realm (*m*), and hath not been practised or used therein by any person or persons whomsoever, to the best of your petitioner's knowledge and belief.

Your petitioner therefore humbly prays that your Majesty, &c. (*the prayer is the same as in the last form, referring to the invention as,* "the said invention," *instead of* "his said invention.")

(No. 5.)
Solemn declaration in support of a petition by an actual inventor for a patent (*n*).

I, [*John Coope Hadden, of No. Woburn Place, Russell Square, in the county of Middlesex, Civil Engineer,*] do solemnly and sincerely declare that (*o*) ["after much, *or* great labour, study, application, trouble, and expense," *insert such* (*if any*) *of these words as may be contained in the petition,*] I have invented ["*improvements in the mode of manufacturing Papier Maché,*"] which invention I believe will be of great public utility. That I am the true and first inventor thereof, and that the said invention hath not been practised or used by any person or persons whomsoever within this realm, to the best of my knowledge and belief. And I further declare (*p*) that it is my intention to apply for letters patent for granting me the sole use of the said invention in Scotland and Ireland respectively, and I make this declaration conscientiously, believing the same to be true, and by virtue of the provisions of an Act made and passed in the Session of Parliament held in the fifth and sixth years of the reign

(*l*) See the notes to the last Form.

(*m*) This is now the proper Form of Allegation, for the invention must be new not only in the particular parts of the kingdom to which the patent is to extend, but throughout the whole of the United Kingdom; see *Brown* v. *Annandale*, 1 Webs. R. 433, cited *ante*, pp. 63 and 468.

(*n*) See the Practice, *ante*, pp. 510, 511.

(*o*) This declaration must be framed in accordance with the petition, the allegations of which it is to verify; vide *ante*, p. 511.

(*p*) This allegation is inserted for the purpose of procuring the patentee a longer time to specify his invention; but it must, of course, be omitted if the inventor does not apply for such patents.

of his late Majesty King William the Fourth, intituled "An Act to repeal an Act of the present Session of Parliament, intituled 'An Act for the more effectual abolition of oaths and affirmations taken and made in various departments of the state, and to substitute declarations in lieu thereof, and for the more entire suppression of voluntary and extra-judicial oaths and affidavits, and to make other provisions for the abolition of unnecessary oaths.'"

(Signed) [J. C. HADDEN.]

Taken and declared at the Public Office, Southampton Buildings, in the county of Middlesex, this [*first*] day of [*October,*] one thousand eight hundred and forty [*three.*]

Before me,

(Signed) [WM. BROUGHAM] (*q*).

(No. 6.) Solemn declaration in support of a petition for an imported invention.

I, [*Alexander Prince, of No.* 14, *Lincoln's Inn Fields, in the county of Middlesex, Patent Agent,*] do solemnly declare that (*r*) in consequence of a communication from a foreigner residing abroad, I am in possession of an invention of [*an improved Wheel for railway carriages,*] which invention I believe will be of great public utility. That the said invention is new in this realm (*s*), and hath not been practised or used therein by any person or persons whomsoever to the best of my knowledge and belief. And I further declare that it is my intention, &c. (*conclude as in the last form.*)

Whitehall, [10 *September,* 1845.]

(No. 7.) Reference of a petition to the Attorney or Solicitor-general (*t*).

Her Majesty is pleased to refer this petition to Mr. Attorney or Solicitor-general to consider thereof and to report his opinion what may be properly done therein: wherefore her Majesty will declare her further pleasure.

(Signed) [J. R. G. GRAHAM] (*u*).

(No. 8.) Note of an opposition at the report (*x*).

The application of [*William Burlinson, of Sunderland, in the county of Durham, Engineer,*] for a patent for an alleged invention of [*improvements in the construction of Steam Engines,*] is opposed by [*John Thompson, of*

(*q*) The declaration, if made in town, must be made before a Master in ordinary; if in the country, it may be made before a Master extraordinary.

(*r*) This declaration must also be framed strictly in conformity with the petition it is to support.

(*s*) This is now the proper Form; vide *ante*, p. 619, n. (*m*).

(*t*) This reference ought to be written under or upon the petition before it is taken to the office of the Secretary of State, the date only being left blank; vide *ante*, pp. 511, 512.

(*u*) The reference must be signed by one of the principal Secretaries of State, and it is always signed by the Secretary for the Home Department.

(*x*) See the Practice, *ante*, p. 513.

Southwark, in the county of Surrey, Engineer.] Dated this [*seventh*] day of [*May,*] 1845.

(Signed) [JOHN THOMPSON.]
or
[William Henry Rymer, Chancery Lane,
Solicitor for the said John Thompson.]

To the Attorney [or Solicitor] General's clerk.

Attorney [*or Solicitor*] *General's Chambers,*
[*No. 2, King's Bench Walk, Temple.*]

(No. 9.) Summons to attend a hearing upon an opposition at the report.

To [MESSRS. NEWTON AND SONS] (*y*).

Her Majesty having referred to me the petition of [*Alfred Vincent Newton, of No. 66, Chancery Lane, in the county of Middlesex, Patent Agent,*] (*z*), praying letters patent for an invention of [*an improved mode of refining Sugar* (*a*)], I appoint [*Tuesday*] the [22d] day of [*July instant*] at [*Seven*] o'clock in the [*Evening,*] at my Chambers in the Temple to consider thereof: of which let all parties concerned have notice (*b*).

Opposed by [*Messrs. Poole and Carpmael, of 4, Old Square, Lincoln's Inn, Patent Agents, and Mr. Alexander Prince, of No. 44, Lincoln's Inn Fields, Patent Agent,*] (*b*).

Dated the [*eleventh*] day of [*July*] 1845.

By order of the Attorney [or Solicitor] General,
(Signed) [WM. GEORGE BOWER] (*c*).

The Attorney [or Solicitor] General expects to be immediately informed if the opposing parties do not intend to appear.

In the matter of the petition of [*James Gowland,*] for letter patent for an invention of ["*improvements in Time Keepers.*

(No. 10.)
[illegible] of [illegible] a patent has entered an opposition to a patent at the report (*d*).

I, [*Richard Wandless, of, &c.*] clerk to Robertson, of Agent [*or* Solicitor] for the above named [*James Gowland,*] do solemnly and sincerely declare that I did on the [*first*] day of [*October,*] now instant, [personally] serve [*Edward Newton, of No. 66, Chancery Lane, in the county of Middlesex, Patent Agent,*] with a true copy of the summons hereunto annexed (*e*); [*or if the service was not personal, then omit the word* "personally," *and insert the following words,* "by leaving the same copy at the office of the said *Edward Newton,* in Chancery Lane aforesaid, with his clerk there;" *or, if the service was through the medium of the post office,* "by sending the same copy, by post, addressed to the

(*y*) The name of the petitioner's solicitor or agent is stated here.

(*z*) The name and description of the petitioner is to be inserted here.

(*a*) The title of the invention is to be inserted in this place.

(*b*) Here is to be inserted the correct name and address of every person who has entered an opposition against the petition; and the petitioner must serve each of them with a copy of the summons.

(*c*) The signature of the chief clerk of the Attorney or Solicitor-general.

(*d*) See the Practice, *ante*, p. 513, n. (*z*).

(*e*) The summons must be annexed to the declaration.

said E. N., at No. 66, Chancery Lane aforesaid,] and that the same copy, so addressed, was put into the post office before [*five*] of the clock of the said [*first*] day of [*October*] instant (*f*)," and I make this declaration (*g*) conscientiously, believing the same to be true, and by virtue, &c. [*conclude as in the form No. 5, ante*, pp. 619, 620.]

(Signed) ["R. WANDLESS."]

Taken and declared at the Public Office, Southampton Buildings, in the county of Middlesex, this [*tenth*] day of [*October,*] one thousand eight hundred and forty [*five.*]

Before me,

(Signed) A. H. LYNCH (*h*).

(No. 11.)

Attorney or Solicitor-general's report upon a petition for a patent (*i*).

TO THE QUEEN'S MOST EXCELLENT MAJESTY.

May it please your Majesty.

In humble obedience to your Majesty's commands signified to me by the Right Honourable Sir James Robert George Graham, Bart., one of your Majesty's principal Secretaries of State, referring to me the annexed petition of [*James Gowland, of Leathersellers Buildings, in the city of London, Chronometer Maker,*] to consider thereof and report my opinion what may be properly done therein, which petition sets forth that the petitioner, (*the allegations of the petition are here set forth.*) The petitioner therefore humbly prays that your Majesty, (*the prayer of the petition is here to be stated.*) And I humbly beg leave to certify unto your Majesty, that in support of the allegations contained in the said petition, the solemn declaration of the said petition hath been laid before me, whereby he solemnly declares that [*here is to be stated the several allegations contained in the declaration.*] Upon consideration of all which, and as it is entirely at the hazard of the petitioner, whether the said invention is new or will have the desired success, and as it may be reasonable for your Majesty to encourage all arts and inventions which may be for the public good, I am humbly of opinion that your Majesty may, by your royal letters patent under the Great Seal of your United Kingdom, grant to the petitioner, his executors, administrators, and assigns, the sole use, benefit, and advantage of his said invention within England, Wales, and the town of Berwick upon Tweed, [and also in the islands of Jersey, Guernsey, Alderney, Sark, and Man, and in all your Majesty's colonies and plantations abroad,] for the term of fourteen years, pursuant to the statute in that case made and provided, if your Majesty shall be graciously pleased so to do with the usual proviso, requiring the petitioner within the space

(*f*) The copy summons ought to be put into the post office early enough to be delivered the same night, in order to make it a good service as of that day.

(*g*) The above form may be easily altered so as to be applicable to a case in which the summons is served upon two or more persons.

(*h*) The declaration must be made before a Master (ordinary or extraordinary) in Chancery.

(*i*) See the Practice, *ante*, p. 517.

of (*k*) [*six*] calendar months, to be computed from the date of such letters patent, to cause a particular description of the nature of his said invention, and in what manner the same is to be performed by writing under his hand and seal, to be enrolled in your High Court of Chancery, otherwise the said letters patent to be void.

All which is submitted to your royal wisdom,

(Signed) [FREDERICK THESIGER] (*l*).

"VICTORIA R." (*n*).

(No. 12.) Queen's warrant for preparing the bill (*m*).

Whereas [*James Gowland, of Leathersellers Buildings, in the parish of Allhallows in the Wall, within the city of London, Watch and Chronometer Maker,*] hath by his petition humbly represented unto us that he hath (*o*) invented ["*a certain improvement or certain improvements in the mechanism of Time-keepers,*"] which the petitioner conceives will be of great public utility, that he is the true and first inventor thereof, and that the same hath not been practised or used before in this kingdom by any other person or persons to the best of his knowledge and belief, the petitioner therefore most humbly prays that we will be graciously pleased to grant unto him, his executors, administrators, and assigns, our royal letters patent under the Great Seal of the United Kingdom of Great Britain and Ireland, for the sole use, benefit, and advantage of his said invention within that part of our said United Kingdom of Great Britain and Ireland called England, our dominion of Wales, and town of Berwick upon Tweed, [and also in our islands of Jersey, Guernsey, Alderney, Sark, and Man, and all our colonies and plantations abroad,] for the term of fourteen years, pursuant to the statute in that case made and provided.

We being willing to give encouragement to all arts and inventions which may be for the public good, are graciously pleased to condescend to the petitioner's request. Our will and pleasure therefore is, that you prepare a bill for our royal signature, to pass our Great Seal of our United Kingdom of Great Britain and Ireland, containing our grant unto him the said [*James Gowland,*] his executors, administrators, and assigns, of the sole use, benefit, and advantage of his said invention, within that part of Great Britain called England, our dominion of Wales, and town of Berwick upon Tweed, [and also in our islands of Jersey, Guernsey, Alderney, Sark, and Man, and all our colonies and plantations abroad,] for the term of fourteen years, pursuant to the statute in that case made and provided: Provided that the petitioner does within the

(*k*) Vide *ante*, p. 517, respecting the time which will be recommended to be allowed for specifying the invention.

(*l*) The report must be signed by the Attorney or Solicitor-general.

(*m*) See the Practice, *ante*, p. 518.

(*n*) Her Majesty always signs the warrant in this place.

(*o*) If the patent is to be for an imported invention, the form is varied accordingly. See the Form of a Petition for an Imported Invention, No. 4, *ante*, p. 619.

space of [*six*] calendar months, to be computed from the date of our said intended grant, cause a particular description of the nature of his said invention, and in what manner the same is to be performed, by writing, under his hand and seal to be enrolled in our High Court of Chancery, otherwise our said intended letters patent to be void: and you are to insert in the said bill all such clauses, prohibitions, and provisoes as are usual and necessary in grants of the like nature and as you shall judge requisite; and for so doing this shall be your warrant. Given at our Court at St. James's, the [*first*] day of [*October,*] 1845, in the [*ninth*] year of our reign.

By her Majesty's command,
(Signed) [J. R. G. GRAHAM] (*p*).

To our Attorney or Solicitor-general.

(No. 13.) Caveat at the Patent Bill Office (*q*).

Caveat against a bill being signed for her Majesty's letters patent to [*Moses Poole, of No.* 4, *Old Square, Lincoln's Inn, in the county of Middlesex, Patent Agent,*] for an alleged invention of [*improvements in the manufacture of Carpets,*] without notice to [*J. C. Robertson and Company, of No.* 166, *Fleet Street, London, Patent Agents.*] Dated this [*tenth*] day of [*October,*] 1845.

(Signed) [J. C. ROBERTSON AND Co.]

(No. 14.) Notice of bill for a patent having been received for signature (*r*).

Attorney [*or Solicitor*] *General's Chambers,*
[*2, Fig Tree Court, Temple,* 1 *October,* 1845.]

SIR,

I beg to inform you that the bill of [*Andrew Pritchard, of No.* 162, *Fleet Street, London,*] for letters patent for an invention of [*improvements in Telescopes,*] is now in this office, and that any opposition upon your caveat of the [*twenty-fourth*] day of [*August last,*] must be entered here within three days from the date hereof, otherwise the bill will be signed.

Your obedient Servant,
(Signed) [T. SHANKS] (*s*).

To Mr. Moses Poole (*t*).

(No. 15.) Note of opposition at the bill (*u*).

The application of [*William Edward Newton, of Chancery Lane, in the county of Middlesex, Patent Agent,*] for a bill for a patent for an alleged invention of [*improvements in Lace Machines,*] is opposed by [*Edward*

(*p*) The warrant must here be countersigned by one of the principal Secretaries of State; and it is usually signed by the Secretary for the Home Department. Vide *ante*, p. 519.

(*q*) See the Practice, *ante*, pp. 519, 520.

(*r*) Vide *ante*, p. 522.

(*s*) The signature of the Attorney or Solicitor-general's clerk.

(*t*) Clerk in the Patent Bill Office. The clerk sends a similar notice to every person who has entered a caveat. Vide *ante*, p. 522.

(*u*) This note is to be left at the Patent Bill Office for entering an opposition at the bill. See the Practice, *ante*, p. 524.

Ranson, of Loughborough, in the county of Leicester, Lace Manufacturer.]
Dated this [*twelfth*] day of [*October,*] 1845.

(Signed) [EDWARD RANSON,]
or
[NEWTON & SON, Chancery Lane,
Agents for the said Edward Ranson.]

In the matter of the application of [*J. C. Robertson,*] for a bill for letters patent for an alleged invention of ["*improvements in the manufacture of Leather.*"] (No. 16.) Declaration of the service of a summons to attend hearing.

I, [*William Tomlinson, of the borough of Sunderland, in the county of Durham,*] clerk to [*Robert Smart, of the same place, Gentleman,*] solicitor [*or* agent] for the above named [*J. C. Robertson,*] do solemnly and sincerely declare that, &c. [*The form is the same as that given, ante,* p. 621, No. 10.]

(Signed) [WM. TOMLINSON.]

Taken and declared at [*the borough of Sunderland, in the county of Durham,*]
this [*tenth*] day of [*October,*] one thousand eight hundred and forty five,
Before me,
A. J. MOORE,
A Master Extraordinary in Chancery.

VICTORIA R. (*y*.)

Victoria, by the grace of God of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith. To all to whom these presents shall come greeting. Whereas [*James Gowland, of Leathersellers Buildings, London Wall, in the city of London, Chronometer Maker,*] hath by his petition, &c. (*Here the body of the intended patent is set forth at full length, after which is added,*) In witness, &c. Witness, &c. (*z*).
Examined, [T. WILDE] (*a*). (No. 17.) Bill for letters patents (*x*).

MAY IT PLEASE YOUR MOST EXCELLENT MAJESTY.

This contains your Majesty's grant unto [*James Gowland, of Leathersellers Buildings, London Wall, in the city of London,*] of the sole use, benefit, and advantage of his invention of [*improvements in Chronometers and Time Keepers,*] to hold to him, his executors, administrators, and assigns, within England, Wales, and the town of Berwick upon Tweed, [and also in the islands of Jersey, Guernsey, Alderney, Sark, and Man, (No. 18.) Dockct (*b*).

(*x*) Vide *ante*, p. 520, 521.

(*y*) The sign manual of her Majesty.

(*z*) When the patent itself is prepared, the conclusion is added in words at length with the dates, as in the form given, *post*.

(*a*) The bill is here signed by the Attorney or Solicitor-general.

(*b*) This docket is to be written under the bill. See the Practice, *ante*, p. 522.

and in all your Majesty's colonies and plantations abroad,] for the term of fourteen years, pursuant to the statute in that case made and provided. Provided that he does within [*six*] calendar months from the date of the grant hereby intended, cause a particular description of the nature of his said invention and in what manner the same is to be performed by writing under his hand and seal, to be enrolled in your High Court of Chancery, otherwise your Majesty's said grant to be void. All such clauses, prohibitions, and provisos are therein inserted as are usual and necessary in grants of the like nature. And this bill is prepared.

By warrant under your Majesty's Sign Manual,

Countersigned by SIR JAMES ROBERT GRAHAM (*c*).

(Signed) [F. THESIGER] (*d*).

(No. 19.)
Signet bill (*e*).

BY THE QUEEN.

Right [trusty and right entirely beloved cousin and councillor (*f*)]. We greet you well. And will and command that under our Privy Seal (remaining in your custody,) you cause these our letters to be directed to our Chancellor of that part of our United Kingdom of Great Britain and Ireland called Great Britain, commanding him that under our Great Seal of our said United Kingdom (in his custody being,) he cause these our letters to be made forth patent in form following.

Victoria, by the grace of God, &c. [*Here the body of the patent is set out at full length, precisely as in the Queen's bill*, (No. 7.) *with the conclusion of it abbreviated as before, thus,*] In witness, &c. Witness, &c. [*The bill then concludes as follows.*] And these our letters shall be your sufficient warrant and discharge in this behalf. Given under our Signet at our Palace of Westminster, the [*first*] day of [*October,*] in the [*ninth*] year of our reign.

Examined [A. B.] (*g*).

Direction. To (*h*) [our right trusty and right entirely beloved cousin and councillor, Walter, Duke of Buccleuch,] Keeper of our Privy Seal.

(No. 20.)
Caveat at the Privy Seal office (*i*).

Caveat against affixing the Privy Seal to a bill for a patent to [*Alexander Prince, of Lincoln's Inn Fields, in the county of Middlesex, C. E., Patent Agent,*] for an alleged invention of [*an improved mode of construct-*

(*c*) The name of the Secretary of State, who countersigned the warrant.

(*d*) The Attorney or Solicitor-general must sign the docket as well as the bill. Vide *ante*, p. 522.

(*e*) See the Practice, *ante*, p. 526.

(*f*) This varies according to the rank and title of the Lord Privy Seal, to whom the direction is addressed. The above address is correct when the Lord Privy Seal is a duke and, (as he always is) a privy councillor.

(*g*) The bill is to be signed by one of the clerks of the Signet or his deputy; vide *ante*, 527.

(*h*) This direction is written on the outside of the bill.

(*i*) Oppositions are rarely made at the Privy Seal; but this would be a proper form for enabling a party to oppose at that stage. See the Practice, *ante*, p. 528.

ing Piano-fortes,] without notice to [*William Ranyard, of South Square, Gray's Inn, in the county of Middlesex, Gentleman.*] Dated this [*twentieth*] day of [*October,*] 1845.

(Signed) [WM. RANYARD.]

(No. 21.) Privy Seal bill (*k*).

VICTORIA, by the grace of God of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith, to our right trusty and well beloved cousin and councillor [*John Singleton, Baron Lyndhurst, of Lyndhurst, in the county of Southampton,*] our Chancellor of that part of our said United Kingdom called Great Britain, greeting. We will and command that under our Great Seal of our said United Kingdom remaining in your custody, you cause these our letters to be made forth patent in the following form.

Victoria, by the grace of God, &c. (*The intended patent is here set forth at length as in the Queen's bill, ante,* p. 626, (No. 7.), *concluding with,* "In witness, &c. Witness, &c." *and underneath is written,*)

Given under our Privy Seal at our Palace at Westminster, the [*first*] day of [*November,*] in the year of our Lord one thousand eight hundred and forty [*five,*] in the [*ninth*] year of our reign.

Examined, [R EDEN] (*l*).

(*The Privy Seal Bill or writ of Privy Seal is then folded up and sealed with the Privy Seal, and a label is attached to it upon which is written a direction to the Lord Chancellor, as follows.*)

Label.

To our right trusty and well beloved cousin and councillor [*John Singleton, Baron Lyndhurst,*] our Chancellor of that part of our United Kingdom of Great Britain and Ireland, called Great Britain.

(No. 22.) Caveat at the Great Seal (*m*).

Caveat against affixing the Great Seal of the United Kingdom to letters patent for granting to [*James Gowland, of Leathersellers Buildings, London Wall, in the city of London, Chronometer Maker,*] the sole use, benefit, or advantage of an alleged invention of ["*improvements in the construction of Chronometers,*"] without notice to [*William Henry Rymer, of Chancery Lane, in the county of Middlesex, Gentleman* (*n*), *Solicitor for Jacob Boaz, of Cornhill, in the city of London, Chronometer Maker.*]

Dated this [*fourth*] day of [*November,*] 1845.

(Signed) [W. H. RYMER.]

(No. 23.) Note of an opposition at the Great Seal (*o*).

The application of [*James Gowland, of Leathersellers Buildings, London Wall, in the city of London, Chronometer Maker,*] for letters patent for an alleged invention of ["*improvements in the construction of Time Keepers,*"]

(*k*) See the Practice, *ante,* p. 528.

(*l*) The bill is to be signed by one of the clerks of the Privy Seal. Vide *ante,* 529.

(*m*) See the Practice, pp. 530, 531.

(*n*) None but solicitors can practice in Chancery. See the Practice, *ante,* p. 532.

(*o*) See the Practice, *ante,* p. 531.

is opposed by [*Jacob Boas, of Cornhill, in the city of London, Chronometer Maker.*] Dated this [*sixth*] day of [*November,*] 1845.

(Signed) [W. H. RYMER.]
[Chancery Lane,] Solicitor for the above named [*Jacob Boas.*]

To the Clerk of the letters patent.

(No. 24.) *Recepi* (*p*).

Received the [*tenth*] day of [*November,*] 1845.

(Signed) [LYNDHURST,] C. (*q*).

(No. 25.) Docket for a patent at the Patent Office (*r*).

A grant unto [*James Gowland, of Leathersellers Buildings, London Wall, in the city of London, Watch and Chronometer Maker,*] for the sole use of his invention of ["*improvements in Time Keepers,*"] to hold to him, his executors, administrators, and assigns, within England, Wales, and the town of Berwick upon Tweed, [the islands of Guernsey, Jersey, Alderney, Sark, and Man, and in all her Majesty's colonies and plantations abroad,] for the term of fourteen years, pursuant to the statute in that case made and provided, with a clause to enrol a specification of the same within [*six*] calendar months from the date thereof.

Witness her Majesty at Westminster, the [*tenth*] day of [*November,*] 1845, in the [*ninth*] year of her reign.

By writ of Privy Seal,
(Signed) L. C. (*s*).
[EDMUNDS] (*t*).

(No. 26.) Letters patent (*u*).

Recital.

VICTORIA, by the grace of God of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith. To all to whom these presents shall come greeting. WHEREAS [*James Gowland, of Leathersellers Buildings, London Wall, in the city of London, Watch and Chronometer Maker,*] hath by his petition humbly represented unto us that (*x*) he hath invented ["*a certain improvement or certain improvements in the mechanism of Time Keepers,*"] which the petitioner conceives will be of great public utility, that he is the first and true inventor thereof, and that the same hath not been practised or used before in this kingdom,

(*p*) This *recepi* is always written in the margin of the Privy Seal Bill; see the Practice, *ante*, p. 537.

(*q*) The signature of the Lord Chancellor.

(*r*) See the Practice, *ante*, p. 538.

(*s*) Lord Chancellor's initials.

(*t*) Name of Clerk of the patents.

(*u*) Vide *ante*, Chap. IV. p. 36, respecting the Form and Construction of Letters Patent, and *ante*, Chap. XII. p. 538, respecting the Practice and Mode of Preparing a Patent, &c.

(*x*) If the patent be granted for an imported invention, the recital states the representation in the petition thus, "that, in consequence of a communication from a foreigner residing abroad, he is in possession of an invention of 'Improvements in the Construction of Locks,' which the petitioner conceives will be of great public utility, and that the same is new within this realm, and hath not been practised or used therein by any person or persons whomsoever, to the best of his knowledge and belief; the petitioner, therefore," &c.

by any other person or persons to the best of his knowledge and belief, the petitioner therefore most humbly prayed that we would be graciously pleased to grant unto him, his executors, administrators, and assigns, our royal letters patent under the Great Seal of the United Kingdom of Great Britain and Ireland, for the sole use, benefit, and advantage of his (*y*) said invention within that part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and town of Berwick upon Tweed, [and also in our islands of Jersey, Guernsey, Alderney, Sark, and Man, and all our colonies and plantations abroad,] for the term of fourteen years, pursuant to the statute in that case made and provided, and we being willing to give encouragement to all arts and inventior ; which may be for the public good, are graciously pleased to condescend to the petitioner's request. KNOW YE THEREFORE, that we of our especial grace, certain knowledge, and mere motion, have given and granted, and by these presents for us, our heirs, and successors, do give and grant unto the said [*James Gowland,*] his executors, administrators, and assigns, our *especial license, full power, sole privilege and authority,* that he the said [*James Gowland,*] his executors, administrators, and assigns, and every of them, by himself and themselves, or by his and their deputy and deputies, servants or agents, or such others as he the said [*James Gowland,*] his executors, administrators, and assigns, shall at any time agree with and no others, from time to time, and at all times hereafter during the term of years herein expressed, shall and lawfully may make, use, exercise, and vend, his (*z*) said invention within that part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and town of Berwick upon Tweed, [and also in our islands of Jersey, Guernsey, Alderney, Sark, and Man, and in all our colonies and plantations abroad,] in such manner as to him the said [*James Gowland,*] his executors, administrators, and assigns, or any of them, shall in his or their discretions seem meet. And that he the said [*James Gowland,*] his executors, administrators, and assigns, shall and lawfully may have and enjoy the whole profit, benefit, and advantage from time to time coming, growing, accruing, and arising by reason of the said invention, for and during the term of years herein mentioned. TO HAVE, HOLD, exercise, and enjoy the said licenses, powers, privileges, and advantages herein before granted or mentioned to be granted unto the said [*James Gowland,*] his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years from the date of these presents next and immediately ensuing, and fully to be complete and ended according to the statute in such case made and provided. AND to the end that the said [*James Gowland,*] his executors, administrators, and assigns, and every of them, may have and enjoy the full benefit and the sole use and exercise of the said invention according to our gracious intention herein before declared, we do

Recital in a patent for an imported invention.

Grant.

Sole privilege.

Habendum for 14 years.

Prohibition to all others.

(*y*) If invention has been imported it must be "*the* said invention."

(*z*) Or if imported "*the* said invention."

by these presents for us, our heirs, and successors, require and strictly command all and every person and persons, bodies politic and corporate, and all other our subjects whatsoever, of what estate, quality, degree, name or condition soever they be, within the said part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales and town of Berwick upon Tweed, [and also in our islands of Jersey, Guernsey, Alderney, Sark, and Man, and in all our colonies and plantations abroad,] that neither they nor any of them at any time during the continuance of the said term of fourteen years hereby granted, either directly or indirectly, do make use or put in practice the said invention, or any part of the same so attained by the said [*James Gowland,*] as aforesaid, nor in any wise counterfeit, imitate, or resemble the same, nor shall make or cause to be made any addition thereunto or subtraction from the same, whereby to pretend himself or themselves, the inventor or inventors, deviser or devisers thereof, without the consent, license, or agreement of the said [*James Gowland,*] his executors, administrators, or assigns, in writing under his or their hands and seals first had and obtained in that behalf, upon such pains and penalties as can or may be justly inflicted on such offenders for their contempt of this our royal command; and further be answerable to the said [*James Gowland,*] his executors, administrators, and assigns, according to law, for his and their damages thereby occasioned. AND MOREOVER, we do by these presents for us, our heirs and successors, will and command all and singular the justices of the peace, mayors, sheriffs, bailiffs, constables, headboroughs, and all other officers and ministers whatsoever of us, our heirs and successors for the time being, they or any of them do not nor shall at any time hereafter during the said term hereby granted, in any wise molest, trouble, or hinder the said [*James Gowland,*] his executors, administrators, or assigns, or any of them, or his or their deputies, servants, or agents, in or about the due and lawful use or exercise of the said invention or any thing relating thereto. PROVIDED ALWAYS, and these our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted it shall be made to appear to us, our heirs, or successors, or any six or more of our or their Privy Council, that this our grant is contrary to law, or prejudicial, or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof, in (*a*) that said part of our United Kingdom of Great Britain and Ireland called England, our dominion of Wales, and town of Berwick upon Tweed, [and also in our islands of Jersey, Guernsey, Alderney, Sark, and Man, and in all our colonies and plantations abroad aforesaid,] or not invented and found out (*b*) by the said [*James Gowland*] as aforesaid; then upon signification or declaration thereof to be made by us, our heirs, or successors under

Command to justices, &c. not to molest the patentee.

Proviso, that if grant contrary to law, or invention not new, &c. patent may be revoked.

(*a*) It ought to be "in this realm." See *Brown* v. *Annandale*, 1 Webs. R. 433, and *ante*, p. 63, 468.

(*b*) If the invention has been imported, instead of "not invented and found out," the words "not introduced therein" are inserted; but they ought to be "not introduced into this realm."

our or their signet or Privy Seal, or by the Lords and others of our or their Privy Council, or any six or more of them under their hands, these our letters patent shall forthwith cease, determine, and be utterly void to all intents and purposes, any thing herein before contained to the contrary thereof in anywise notwithstanding: PROVIDED ALSO, that these our letters patent or any thing herein contained, shall not extend or be construed to extend to give privilege unto the said [*James Gowland*,] his executors, administrators, or assigns, or any of them, to use or imitate any invention or work whatsoever, which hath heretofore been invented or found out by any other of our subjects whatsoever, and publicly used or exercised in that said part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and town of Berwick upon Tweed, [and also in our islands of Jersey, Guernsey, Alderney, Sark, and Man, and in all our colonies and plantations abroad aforesaid,] unto whom our like letters patent or privileges have been already granted for the sole use, exercise, and benefit thereof; it being our will and pleasure that the said [*James Gowland*,] his executors, administrators, and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practise their several inventions by them invented and found out according to the true intent and meaning of the same respective letters patent and of these presents: PROVIDED LIKEWISE nevertheless, and these our letters patent are upon this express condition, that if at any time heretofore these our letters patent, or the liberties and privileges hereby by us granted, shall become vested in or in trust for more than the number of twelve persons, or their representatives at any one time as partners dividing or entitled to divide the benefits or profits obtained by reason of these our letters patent, (reckoning executors and administrators as and for the single person whom they represent as to such interest as they shall be entitled to in right of such their testator or intestate,) that then these our letters patent and all liberties and advantages whatsoever hereby granted shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary in anywise notwithstanding: *Provided* that nothing herein contained shall prevent the granting of licenses in such manner and for such consideration as they may by law be granted: AND ALSO if the said [*James Gowland*] shall not particularly describe and ascertain the nature of his said invention (c), and in what manner the same is to be performed by an instrument in writing under his hand and seal, and cause the same to be enrolled in our High Court of Chancery within [*six*] calendar months next, and immediately after the date of these our letters patent: AND (d) ALSO if the said [*James Gowland*,] his executors, administrators, or assigns, shall not supply, or cause to be supplied for our service, all such

Patent not to give privilege to use any prior patent invention.

All patentees to use their inventions distinctly.

Proviso that if patent privilege becomes vested in more than twelve persons, patent to void.

Proviso not to prevent any granting of licences.

Proviso requiring specification of the invention.

Proviso requiring patentee to supply articles for the public service.

(c) Or if imported, "the said invention."

(d) It has recently become the practice to insert this reservation in favour of the public service in every patent, instead of that given *ante*, p. 71.

articles of the said invention as he or they shall be required to supply by the officers or commissioners administering the department of our service for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said officers or commissioners requiring the same, that then and in any of the said cases these our letters patent, and all liberties and advantages whatsoever hereby granted shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding. AND LASTLY, we *do by these presents for us, our heirs, and successors, grant* unto the said [*James Gowland,*] his executors, administrators, and assigns, that these our letters patent, or the enrolment, or exemplification thereof, shall be in and by all things good, firm, valid, sufficient, and effectual in the law according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favorable and beneficial sense for the best advantage of the said [*James Gowland,*] his executors, administrators, and assigns, as well in all our Courts of record as elsewhere, and by all and singular the officers and ministers whatsoever of us, our heirs, and successors, in that part of our said United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and town of Berwick upon Tweed, [and also in our islands of Jersey, Guernsey, Alderney, Sark, and Man, and in all our colonies and plantations abroad aforesaid,] and amongst all and every the subjects of us, our heirs, and successors whatsoever and wheresoever, notwithstanding the not, full and certain describing the nature or quality of the said invention, or of the materials thereunto conducing and belonging. IN WITNESS whereof we have caused these our letters to be made patent. WITNESS ourself at Westminster, this [*tenth*] day of [*November,*] in the ninth year of our reign.

Grant that patent shall be good notwithstanding the not full description of invention, &c.

By writ of Privy Seal,
[EDMUNDS] (*e*).

(No. 27.) Enrolment of patent (*g*).

Patents (*f*) of the [*ninth*] year of the reign of Queen Victoria.
Roll [*twenty-four.*]

["JAMES GOWLAND,] Invention."

"VICTORIA, by the grace of God, &c. To all to whom these presents shall come greeting. Whereas, *James Gowland, of, &c.*" [*Here the whole of the patent is copied verbatim, except the conclusion, which is abbreviated thus.*] "In witness, &c. witness, &c. the [*tenth*] day of [*November.*"]

"By writ of Privy Seal."

(No. 28.) Specification to be enrolled in

TO ALL TO WHOM THESE PRESENTS SHALL COME, I, [*James Gowland, of Leathersellers Buildings, London Wall, in the city of London, Chronometer Maker,*] send greeting. WHEREAS, her most

(*e*) The clerk of the patents.
(*f*) This is indorsed on the Roll; vide *ante*, p. 540.
(*g*) See the Practice, *ante*, p. 539.

excellent Majesty, Queen Victoria, by her letters patent under the Great Seal of the United Kingdom of Great Britain and Ireland, bearing date at Westminster the [*first*] day of [*January,*] in the [*eighth*] year of her reign, did give and grant unto me the said [*James Gowland,*] my executors, administrators, and assigns, her especial licence, full power, sole privilege, and authority, that I the said [*James Gowland,*] my executors, administrators, and assigns, and such others as I the said [*James Gowland,*] my executors, administrators, or assigns should at any time agree with, and no others from time to time and at all times thereafter during the term of years therein mentioned, should and lawfully might make, use, exercise, and vend within that part of the United Kingdom of Great Britain and Ireland, called England, her dominion of Wales, and town of Berwick upon Tweed, [and also in the islands of Jersey, Guernsey, Alderney, Sark, and Man, and in all her colonies and plantations abroad,] my invention of ["*improvements in the construction of Chronometers and other Time-keepers.*"] In which said letters patent there is contained a proviso requiring that I the said [*James Gowland,*] shall particularly describe and ascertain the nature of my said invention and in what manner the same is to be performed, by an instrument in writing under my hand and seal, to be enrolled in her said Majesty's High Court of Chancery within [*six*] calendar months next, and immediately after the date of the said in part recited letters patent, as reference being thereunto had will more fully and at large appear. NOW (*i*) KNOW YE, that in compliance with the said proviso, I the said [*James Gowland,*] do hereby declare the nature of my invention, and the manner in which the same is to be performed is particularly described and ascertained in and by this present instrument in writing as follows, (that is to say,) My said invention consists, &c. [*Here describe the nature of the invention, &c. so as to comply with the terms of the proviso in the letters patent. If, however, drawings are necessary, the form should be varied, thus,*] are particularly described and ascertained in and by this present instrument in writing, reference being had to the drawing [*or,* several drawings] hereunto annexed [*or,* in the margin of these presents,] and in which said drawing [*or,* several drawings,] similar parts are marked and referred to by similar letters or figures, (that is to say,) My said invention consists, &c. [*Here describe the invention, referring to the drawings so as to explain the description.*]

IN WITNESS whereof, I, the said [*James Gowland,*] have hereunto set my hand and seal the [*first*] day of [*January,*] in the year of our Lord one thousand eight hundred and forty [*four.*]

(Signed) (*l*) [JAMES GOWLAND,] L. S.

(*k*) Signed and sealed in the presence of *John Jones.*

pursuance of the proviso in a patent (*h*).

(*h*) See the Practice, *ante*, p. 541.

(*i*) Vide *ante*, Chap. VII. p. 151, respecting the Form, Requisites and Construction of Specifications.

(*k*) The instrument must be both signed and sealed, vide *ante*, pp. 151, 152.

(*l*) Although sometimes used, an attestation is not necessary.

(No. 29.) *Acknowledgment before a Master in Chancery.*

Acknowledgment of specification before a Master in Chancery (*m*).

Taken and acknowledged by the within [or above] named [*James Gowland,*] at [*the Public Office, Southampton Buildings, in the county of Middlesex,*] this [*second*] day of [*January,*] in the year of our Lord one thousand eight hundred and forty [*four,*]

Before me,

(Signed) [A. H. LYNCH] (*n*.)

(No. 30.) Form of enrolment of a specification (*o*).

Making Cables, &c. Improvements in [Smith's] Specification (*p*).

TO ALL TO WHOM THESE PRESENTS SHALL COME. I, [*Andrew Smith,*] of [*Princes Street, Leicester Square, in the county of Middlesex, Engineer,*] send greeting, &c. [*Here the whole of the specification is set out, including the signature and seal at the end, after which comes the following entry if the specification has been acknowledged.*]

Record of Acknowledgment.

Duckworth (*q*).

AND BE IT REMEMBERED that on the [*twentieth*] day of [*September,*] in the [*third*] year of the reign of her Majesty, Queen Victoria, the said [*Andrew Smith*] came before our said Lady the Queen in her Chancery, and acknowledged the instrument aforesaid, and all and every thing contained and specified in form above written: AND the instrument aforesaid was stamped according to the tenor of the statute made in the fifty-fifth year of the reign of his late Majesty King George the Third.

Date of enrolment.

Enrolled the [*twentieth*] day of [*September,*] one thousand eight hundred and thirty [*nine.*]

(No. 31.) Certificate of enrolment.

Enrolled in [the office of the Rolls Chapel, *or* the office of the Petty Bag,] in her Majesty's High Court of Chancery, the [*first*] day of [*July,*] in the year of our Lord one thousand eight hundred and forty [*five,*] being first duly stamped according to the tenor of the statute made for that purpose.

(Signed) [A. B.]

(*m*) The acknowledgment must be before a Master in Chancery, when taken in town; but when taken in the country it may be taken before a Master Extraordinary.

(*n*) It is unusual for a Master to do more than sign his name; but a Master Extraordinary must add words, such as, "Master Extraordinary," in order to show his power to take the acknowledgment.

(*o*) Vide *ante*, p. 544.

(*p*) The Form of this Marginal Abstract is not the same in all offices.

(*q*) This is the name of the Master before whom the acknowledgment was taken.

SECTION II.

Forms of Proceedings upon Obtaining Leave to Enter Disclaimers or Memorandums of Alteration under stat. 5 & 6 Will. IV. c. 83, s. 1.

(No. 1.) General caveat against any disclaimer or alteration (r).

CAVEAT against any fiat or leave being granted to [*William Newton, of Chancery Lane, in the county of Middlesex, Patent Agent,*] to enter any disclaimer or memorandum of alteration of any part of the title or specification of an alleged invention intituled ["*improvements in Printing Presses,*"] which is comprised in letters patent granted to him, [*or to Andrew Pritchard, of No.* 162, *Fleet Street, in the city of London,*] dated the [*first*] day of [*November,*] in the [*third*] year of her present Majesty's reign, without notice, to [*Messrs. Poole and Carpmael, Old Square, Lincoln's Inn, Patent Agents.*] Dated this [*first*] day of [*August,*] 1845.

(Signed) [POOLE AND CARPMAEL.]

(No. 2.) Specific caveat against a particular disclaimer or alteration (s).

CAVEAT against the grant of a fiat to [*Bryan Donkin, of the Paragon, New Kent Road, Civil Engineer, F.R.S.*] for leave to enter any disclaimer [*or* memorandum of alteration, *or* disclaimer and memorandum of alteration] of [part of] the title and [part of] the specification of the invention intituled ["*improvements in Railway Switches and Railway Carriage Wheels,*"] comprised in letters granted to [the said *Bryan Donkin, or* to A. B. of, &c.] on the [*first*] day of [*November,*] in the [*ninth*] year of the reign of her present Majesty, *without notice,* to [*Messrs. J. C. Robertson and Co. of No.* 166, *Fleet Street, London, Patent Agents.*] Dated this [*twenty-first*] day of [*December,*] 1845.

(Signed) [J. C. ROBERTSON AND Co.]

(No. 3.) Petition for leave to enter a disclaimer or memorandum of alteration (t).

To her Majesty's Attorney [or *Solicitor*] *General.*

The petition of [*James Gowland, of Leathersellers Buildings, in the city of London, Chronometer Maker.*]

SHEWETH,

THAT by letters patent under the Great Seal of the United Kingdom of Great Britain and Ireland, bearing date at Westminster the [*first*] day of [*January,*] in the [*eighth*] year of the reign of her present Majesty Queen Victoria, her said Majesty did grant unto your petitioner, [*or* unto *John Thomas, of Preston, in the county of Lancaster, Watch and Clock Maker,*] his executors, administrators, and assigns, the sole use, benefit, and advantage of his invention of [*improvements in the construction of Chrono-*

(r) See the Practice, *ante*, p. 551.

(s) See the Practice, *ante*, p. 551. Although this form is proper to be adopted when it is intended merely to oppose some particular application, which has been advertised; yet the previous form may also be used, and will answer the purpose equally well.

(t) See the Practice, *ante*, p. 550.

meters,] to have, hold, exercise, and enjoy the same unto and by your petitioner [*or* unto the said *John Thomas,*] his executors, administrators, and assigns, within England, Wales, and the town of Berwick upon Tweed, [and also in the islands of Jersey, Guernsey, Alderney, Sark, and Man, and in all her said Majesty's colonies and plantations abroad,] for the term of fourteen years.

AND WHEREAS your petitioner, [*or* the said *John Thomas,*] in pursuance of a proviso in the said letters patent contained, did by an instrument in writing under his hand and seal (commonly called a specification,) describe and ascertain the nature of his said invention and in what manner the same is to be performed, and did cause the same instrument to be enrolled in her Majesty's High Court of Chancery at Westminster, on the [*first*] day of [*February,*] in the year of our Lord, [1845] (*u*). [And whereas by indenture bearing date the [22d] day of [*January*, 1845,] and made, or expressed to be made between the said [*John Thomas*] of the one part, and of your petitioner of the other part, for the considerations therein expressed, the said letters patent and the invention, rights, privileges, profits, and premises therein comprised or thereby granted, were duly assigned unto your petitioner, his executors, administrators, and assigns.]

AND WHEREAS, since the date of the said letters patent and of the said enrolment of the said specification, your petitioner has discovered that part of the said invention as described in the said letters patent and specification was not on the day of the date of the said letters patent new as to the public knowledge, use, and exercise thereof, [*or* has discovered that your petitioner, *or* the said John Thomas was not the true and first inventor of a part of the said invention as described in the said letters patent and specification;—*or*,—has discovered that part of the said invention as described in the said letters patent and specification is of no use, benefit, or advantage to the public; *or*, is not a necessary or useful part of the said invention;—*or*,—has discovered that part of the said invention cannot be used or applied in the manner mentioned and described in the said letters patent and specification respectively; *or* has been informed that doubts are entertained whether the said specification sufficiently distinguishes between what was new and what was old,—*or state such other circumstances as may have rendered a disclaimer or memorandum of alteration necessary or expedient.*]

WHEREFORE your petitioner is desirous in pursuance of the statute in such case made and provided, to enter a disclaimer of so much of the title of the said invention, and also so much of the said specification as relates to or comprises such part of the said invention as aforesaid, [*or* to enter a memorandum of alteration of the title of the said invention and

(*u*) If the petitioner is an assignee his title ought here to be stated. The recital contained within brackets above is proper in case of a simple assignment from the patentee to the petitioner; but where the petitioner's title is more complicated the recital must be framed accordingly.

of the said specification, for the purpose of more accurately intituling, ascertaining, and describing the said invention and the nature thereof, and also the manner in which the same invention is to be performed.]

THAT the said disclaimer [*or* memorandum of alteration,] which your petitioner is so desirous to enter as aforesaid, is not such a disclaimer [*or* memorandum of alteration,] as will extend the exclusive right granted by the said letters patent;—and that your petitioner is desirous of entering with the clerk of the patents of England such disclaimer, [*or* a memorandum of such alteration] as hereinafter mentioned; (that is to say,)—YOUR PETITIONER is desirous of disclaiming the words ["and for other useful purposes,"] contained in the title of the said invention, and your petitioner is also desirous of disclaiming so much, &c. [*or* your petitioner is desirous by such a memorandum to alter the title of the said invention by intituling the same invention as "improvements in, &c." instead of "an improved mode, &c." *the parts to be disclaimed and the alterations to be made must be accurately set forth.*]

That a copy of the said specification and of the disclaimer [*or* memorandum of alteration,] which your petitioner is so desirous of entering as aforesaid, is hereunto annexed, [*or* is left herewith.]

Your petitioner therefore prays the leave of her Majesty's Attorney-general [*or* Solicitor-general,] to be certified by his fiat and signature, in pursuance of the statute in such case made and provided, to enter with the clerk of the patents of England a disclaimer, [*or* memorandum of alteration,] in the form or to the effect hereinbefore mentioned, and that your petitioner may have such further or other relief in the premises as to her Majesty's said Attorney-general [*or* Solicitor-general] shall seem meet.

(Signed) [JAMES GOWLAND.]

LONDON, 31 October, 1845.

(No. 4.) Notice of application for leave to enter a disclaimer or memorandum of alteration (*x*).

Notice is hereby given, that [*John Coope Hadden, of Woburn Place, Russell Square, in the county of Middlesex, Civil Engineer,*] to whom letters patent were granted on the [*first*] day of [*February,*] in the [*eighth*] year of the reign of her present Majesty, for ["*improvements in the construction of Railway Carriage Wheels,*"] [*or if the petitioner is an assignee of the patent,* assignee of letters patent granted to E. N. of, &c. on the [*first*] day of [*February,*] in, &c. *as before,*] has applied by petition to her Majesty's Attorney [*or* Solicitor] General, for the leave and fiat of the said Attorney [*or* Solicitor] General, to enter a disclaimer [and memorandum of alteration] for the purpose of disclaiming a certain part of the said title of the said invention as in the said petition mentioned, and also disclaiming certain parts of the specification of the said invention as in the said petition also mentioned, [in altering a certain

(*x*) See the Practice, *ante*, p. 551.

part of the title of the said invention in the said petition mentioned, and also altering certain parts of the specification of the said invention in the said petition also mentioned.] Dated this [*tenth*] day of [*October,*] 1846.

(Signed) [WILLIAM RANYARD,]
South Square, Gray's Inn,
Solicitor for the above named petitioner.

(No. 5.) Disclaimer or memorandum of alteration.

TO ALL TO WHOM these presents shall come, [*I, James Gowland of Leathersellers Buildings, London Wall, in the city of London, Chronometer Maker,*] send greeting. Whereas, by letters patent under the Great Seal of the United Kingdom of Great Britain and Ireland, bearing date at Westminster the [*first*] day of [*January,*] in the [*eighth*] year of her present Majesty Queen Victoria, her said Majesty did grant unto me, [*or* unto *John Thomas*, of *Preston*, in the county of *Lancaster*, *Watch and Clock Maker,*] my [or his] executors, administrators, and assigns, the sole use, benefit, and advantage of his invention of [improvements in the construction of Chronometers and other Time-keepers,] to have, hold, exercise, and enjoy the same unto and by me, [*or* unto the said *John Thomas,*] my [*or* his] executors, administrators, and assigns, within England, Wales, and the town of Berwick upon Tweed, [and also in the islands of Jersey, Guernsey, Alderney, Sark, and Man, and in all her Majesty's colonies and plantations abroad] for the term of fourteen years.

AND WHEREAS I, the said [*James Gowland*] [*or* the said *John Thomas*] in pursuance of a proviso in the said letters patent contained, did, by an instrument in writing, under my [*or his*] hand and seal, (commonly called a specification) describe and ascertain the nature of my [*or* his] said invention, and in what manner the same is to be performed; and did cause the same instrument to be enrolled in her Majesty's High Court of Chancery at Westminster, on the [*first*] day of [*February,*] in the year of our Lord 1845 (*y*). [And whereas by an indenture, bearing date the [*twenty-second*] day of [*January*, 1845,] and made or expressed to be made between the said [*John Thomas,*] of the one part, and me, the said [*James Gowland,*] of the other part, for the considerations therein expressed, the said letters patent and the invention, rights, privileges, profits and premises therein comprised, or thereby granted, were assigned unto me, the said [*James Gowland,*] my executors, administrators, and assigns.]

AND WHEREAS, since the date of the said letters patent and of the said enrolment of the said specification, I have discovered that part of the said invention as described in the said letters patent and specification was not on the day of the date of the said letters patent new as to the public

(*y*) If the disclaimer or memorandum of alteration is entered by an assignee his title must be stated shortly in this place. The Form of Recital given above will only be applicable to a case in which there has been merely an assignment by the patentee to a purchaser. See also the Recitals contained in the Forms of Assignments and Licences in a subsequent part of this Appendix.

knowledge, use, and exercise thereof, [or have discovered that I, [or the said *John Thomas*] was not the true and first inventor of a part of the said invention, as described in the said letters patent and specification; or have discovered that part of the said invention, as described in the said letters patent and specification, is of no use, benefit, or advantage to the public, or is not a necessary or useful part of the said invention; or have discovered that part of the said invention cannot be used or applied in the manner mentioned and described in the said letters patent and specification respectively; or *state such other circumstances as may have rendered a disclaimer or memorandum of alteration necessary or expedient.*]

And whereas, in consequence of such discovery as last aforesaid, I am desirous, with the leave of her Majesty's Attorney-general [*or* Solicitor-general], to enter with the clerk of the patents in England, such disclaimer [*or* memorandum of alteration] as hereinafter contained or expressed.

Disclaimer of part, &c.

NOW KNOW YE, THEREFORE, that I, the said [*James Gowland,*] by and with the leave of *Sir* [*Frederick Thesiger,*] *Knight*, her Majesty's Attorney-general [*or* Solicitor-general] do hereby disclaim [*the words, "and other timekeepers" contained in the title of the said invention.*] And I do hereby further disclaim [*so much of the said specification as describes, &c.*] (The several parts of the title and specification which are intended to be disclaimed must be carefully and accurately set out.)

Alteration.

NOW KNOW YE (*or* AND FURTHER KNOW YE) that I, the said [*James Gowland,*] by and with the leave and consent of *Sir* [*Frederick Thesiger,*] *Knight*, her Majesty's Attorney-general [*or* Solicitor-general] *do, by this present memorandum of alteration, by and with the like* leave and consent, to be entered with the said clerk of the patents, declare, that I do hereby make such alteration in the title of the said invention; and also in the said specifications as hereinafter mentioned or expressed (that is to say), I do hereby alter the said title [*Here state the alteration intended, as for example* by intituling the said invention, "improvements in the escapements of Chronometers," instead of "improvements in the construction of Chronometers;" and I do further declare that the title of the said invention shall accordingly be "improvements in the escapements of Chronometers," instead of the said title so expressed or mentioned in the said letters patent and specification respectively.] And I do hereby alter the said specification, &c. [*Here set forth all the intended alterations in the specification.*] And I, the said [*James Gowland,*] do hereby state and declare that my reasons for making such disclaimer and alteration as aforesaid, are that, &c. [*Here state reasons for making the disclaimer or alteration.*] And I, the said [*James Gowland,*] do further declare, that the above written disclaimer and memorandum of alteration are not, or are either of them respectively, or any part thereof respectively, intended to extend the exclusive right granted by the said letters patent, and that these presents shall not extend the said exclusive right in any way whatsoever.

IN WITNESS whereof I, the said [*James Gowland,*] have hereunto set my hand and seal this [*first*] day of [*August,*] one thousand eight hundred and forty [*five.*]

[JAMES GOWLAND,] L. S.

(No. 6.)

Fiat for leave to enter a disclaimer or memorandum of alteration.

TO THE CLERK OF THE PATENTS OF ENGLAND.

THIS IS TO CERTIFY that the above [or within] named [*Edward Newton,*] has applied to me *Sir* [*Frederick Thesiger,*] Knight, Her Majesty's Attorney [*or* Solicitor] General, for leave to enter the above [*or* within] written disclaimer [and memorandum of alteration] of part of the title and specification (*z*) of a certain invention, for which letters patent under the Great Seal of Great Britain and Ireland were duly granted to him [or to A. B. of, &c.] bearing date at Westminster, the [*sixteenth*] day of [*May,*] in the [*fifth*] year of the reign of her present Majesty, and the specification of which invention was enrolled on the [*sixteenth*] day of [*November,*] in the year of our Lord [one thousand eight hundred and forty-two.]

And on considering the said application, *[I directed the said [*Edward Newton*] to advertise his said disclaimer [and alteration] in the *London Gazette,* and in the *Times,* and *Morning Chronicle* newspapers, and in some newspaper published in the vicinity of the place where the said [*Edward Newton*] carries on manufacture according to the said invention. And such advertisements have been duly published accordingly, that is to say, in the said *Gazette* on the [*tenth*] day of [*October*] last, in the said *Times* and *Morning Chronicle* newspapers on the [*eleventh*] day of [*October*] last, and in the [*Sunderland Herald,*] being a newspaper published in the vicinity of the place where the said *Edward Newton* carries on his said manufacture, on the [*fourteenth*] day of *October* last (*a*)].

And no sufficient objection having been made to the said application, I have accordingly granted, and do hereby grant leave to the said Edward Newton to enter and file his said disclaimer and memorandum of alteration, pursuant to the statute passed in the Session of Parliament held in the fifth and sixth years of the reign of his late Majesty King William the Fourth, intituled "An Act to amend the Law touching Letters Patent for Inventions," and let the same be entered and filed accordingly. Dated this [*twelfth*] day of [*November,*] in the year of our Lord, [one thousand eight hundred and forty-five.]

(Signed) [FREDERICK THESIGER.]

(*z*) If the alteration applies to the title or specification only, the *fiat* must be altered accordingly.

(*a*) When no advertisements have been published the clause from the * to this place must be omitted.

SECTION III.

Forms of Proceedings for obtaining Confirmations and Prolongations of Patent Privileges.

(No. 1.) Notice of application for the confirmation of a patent under stat. 5 & 6 Will. IV. c. 83, s. 2.

NOTICE is hereby given, that [*Bryan Donkin, of the Paragon, New Kent Road, Esquire, Civil Engineer,*] intends to apply by petition under the second section of the statute 5 & 6 William the Fourth, chap. 83, to her Majesty in Council to confirm letters patent bearing date the [*first*] day of [*November,*] in the [*ninth*] year of her said Majesty's reign, by which her said Majesty granted to the said [*Bryan Donkin,*] [or to *C. D.* of, &c.] the sole use of an invention, entituled "An improvement, &c." [*If the application is to be made by an assignee, here insert the words,* and which said letters patent have been assigned unto the said *B. D.*]

And notice is hereby further given, that the said [*Bryan Donkin*] intends to apply by counsel to the Judicial Committee of the Privy Council on the [*first*] day of [*February*] now next, or if the said Judicial Committee shall not sit on that day, at the then next sitting of the said Judicial Committee, for a time to be fixed for hearing the matter of his said petition, and that on or before the said [*first*] day of [*February*] next, notice must be given of any opposition intended to be made to the said petition, and any person intending to oppose the said application must lodge [a caveat] notice to that effect at the Council Office on or before that day.

Dated this [*first*] day of [*January*, 1846.]

[*F. G. A.*,]
Solicitor for the above named [*Bryan Donkin.*]

(No. 2.) Notice for an application for the prolongation of a patent under 5 & 6 Will. IV. c. 83, s. 4.

Notice is hereby given, that [*Bryan Donkin, of*, &c.] intends to apply, by petition, under the fourth section of the statute 5 & 6 William the Fourth, chap. 83, to her Majesty in Council, for a prolongation of his term of sole using and vending his [*or* an] invention of ["*an improvement, &c.*"] granted to him [*or* to *C. D.* of, &c.] by letters patent bearing date the [*third*] day of [*May,*] in the [*second*] year of the reign of his late Majesty King William the Fourth. [*If the application is to be made by an assignee, here insert the words,* and which said letters patent have been assigned unto the said *B. D.*]

And notice is hereby further given, that, &c. [*conclude as in the last form.*]

In the Judicial Committee of the Privy Council.

(No. 3.) Notice of opposition to the

In the matter of the petition of [*A. B.* of, &c.] for the confirmation of letters patent granted to the said [*A. B. or* to *C. D.* of &c.] for an invention of ["*a new method of, &c.*"] and bearing

confirmation of the patent.

date the [*third*] day of [*June,*] in the [*second*] year of her present Majesty's reign.

Notice is hereby given, that [*I. K.*] of &c. intends to oppose the application of the said [*A. B.*] for a confirmation of the said letters. Dated this [*twentieth*] day of [*June,*] 1845.

[*W. H. Rymer, Chancery Lane,*]
Solicitor for the above named [*I. K.*]

(No. 4.)

Caveat against the prolongation of a patent.

In the Judicial Committee of the Privy Council.

In the matter of the petition of [*A. B.* of, &c.]

Caveat against the prolongation of the term of sole using and vending an invention of ["*a new process for, &c.*"] granted to the said [*A. B.* or to *C. D.* of, &c.] by letters patent bearing date the [*third*] day of [*May,*] in the [*second*] year of the reign of his late Majesty King William the Fourth, without notice to [*I. K.* of, &c.]

Dated this [*first*] day of [*December,*] 1845.

[*W. H. Rymer, Chancery Lane,*]
Solicitor for the above named [*I. K.*]

(No. 5.)

Petition to the Queen in Council for the confirmation of a patent (*b*).

TO THE QUEEN'S MOST EXCELLENT MAJESTY IN COUNCIL.

The humble petition of [*James Gowland, of London Wall, in the city of London, Chronometer Maker.*]

Sheweth,

That your petitioner after considerable application and cost before the date of the letters patent hereinafter mentioned, invented ["*improvements in the construction of Chronometers,*"] which said invention your petitioner then believed and still believes to be of great public utility.

That your petitioner obtained your Majesty's letters patent under the Great Seal of the United Kingdom, bearing date at Westminster the [*tenth*] day of [*October,*] in the [*first*] year of your Majesty's reign. Whereby your Majesty was graciously pleased to grant unto your petitioner, his executors, administrators, and assigns, your Majesty's especial license, full power, sole privilege, and authority, that he your petitioner, his executors, administrators, and assigns, and every of them by himself and themselves, and his or their deputy or deputies, servants, or agents, or otherwise, as in the said letters patent mentioned, at all times thereafter during the term of years thereinafter mentioned, should and lawfully might make, use, exercise, and vend his said invention within England, Wales, and Berwick upon Tweed, [and also in your Majesty's Islands of Jersey, Guernsey, Alderney, Sark, and Man, and in all your Majesty's Colonies and plantations abroad,] in such manner as to your petitioner, his executors, administrators, or assigns, should seem meet. And that your petitioner, his executors, administrators, and assigns, should and lawfully might have and enjoy the whole profit, benefit,

(*b*) Vide Chap. VIII. s. 1, *ante*, p. 199.

commodity, and advantage from time to time accruing and arising, by reason of the said invention, for and during the said term of years thereinafter mentioned. To have, hold, exercise, and enjoy the said licenses, powers, privileges, and advantages thereinbefore granted unto your petitioner, his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years from the date of the said letters patent next ensuing, according to the statute in such case made and provided.

That in pursuance of the proviso in that behalf in the said letters patent contained, your petitioner did, by a specification or instrument in writing under his hand and seal bearing date the [*tenth*] day of [*April,*] in the year of our Lord [1838,] particularly ascertain and describe the nature of his said invention, and in what manner the same is to be performed. And did also cause the said specification to be duly enrolled in your Majesty's High Court of Chancery on the said [*tenth*] day of [*April,*] in the year of our Lord [1838.]

That your petitioner at the time of his petitioning your Majesty for the said letters patent, believed that he was the true and first inventor of the said invention, and except as hereinafter stated, your petitioner still verily believes that he was, at the date of the said letters patent, the true and first inventor of the same invention.

That since the grant of the said letters patent. [*Here state facts and circumstances which render it desirable for the petitioner to obtain a confirmation of his patent*] (*c*).

Your petitioner therefore humbly prays, that your Majesty will be most graciously pleased to take the case of your petitioner into your Royal consideration, and will be pleased to refer the consideration of this petition to the Judicial Committee of your Majesty's most honourable Privy Council. And that your petitioner may be heard before the said Judicial Committee by his counsel and witnesses, and if the said Judicial Committee shall report to your Majesty that the prayer of this petition ought to be complied with, that your Majesty will be graciously pleased to confirm the said letters patent, and to grant new letters patent unto your petitioner, granting and confirming unto him, his executors, administrators, and assigns, the sole use and exercise of his said invention according to the statute in that case made and provided, and that your Majesty will be graciously pleased to give your petitioner such farther and other relief in the premises as to your Majesty shall seem meet.

And your petitioner will ever pray, &c.

(Signed) [*James Gowland.*]

[*London, 2d January,* 1844.]

(*c*) Vide *ante*, Chap. VIII. s. 1, p. 199; and the cases of *in re Heurteloup's* case, 1 Webs. R. 553, and *in re Well's* patent, *ibid.* 554.

(No. 6.)

Petition to the Queen in Council for the prolongation of a patent.

To the Queen's most Excellent Majesty in Council.

The humble petition of, &c. [*as in the last form.*]

Sheweth,

That your petitioner, &c. [*Here state the invention, the patent and the specification as in the last form.*]

(*d*) [That by indenture of assignment bearing date the [*tenth*] day of [*May*, 1844,] the said [*A. B.*] assigned the said privilege, and all rights, benefits, profits, and advantages granted by the said letters patent, together with the said letters patent unto your petitioner, his executors, administrators, and assigns.]

That, &c. [*Here state the various facts and circumstances of the case so as to show the merit of the petitioner and the utility of the invention, and to explain why the patentee has not been enabled to obtain a sufficient recompense. And if the petitioner intends to apply for an extension for fourteen years, a clause to the following effect must be inserted.*]

[That for the reasons aforesaid, your petitioner has been unable to obtain a due remuneration for his expense and labour in perfecting the said invention, and an exclusive right of using and vending the said invention for the further period of seven years, in addition to the term in the said letters patent mentioned, will not suffice for the reimbursement and remuneration of your petitioner.]

That your petitioner hath advertised three times in the *London Gazette*, three times in the [*Morning Chronicle*] newspaper published in London, three times in the [*Times*] newspaper also published in London, three times in the [*Globe*] newspaper also published in London, and three times in the [*Sunderland Herald,*] being a country newspaper published in [*Sunderland,*] the town in [*or* near to which, *or* the county of [*Durham,*] in which] which your petitioner carries on the manufacture of articles made according to his said invention and specification, [*or* in *or* near to which your petitioner resides,] that your petitioner intended to apply to your Majesty in Council for a prolongation of his said term of sole using and vending his invention.

Your petitioner therefore humbly prays, that your Majesty will be most graciously pleased to take the case of your petitioner into your Royal consideration, and will be pleased to refer the consideration of this petition to the Judicial Committee of your Majesty's most honourable Privy Council. And that your petitioner may be heard before the said Judicial Committee by his counsel and witnesses, and if the said Judicial Committee shall report to your Majesty that the prayer of this petition ought to be complied with, that your Majesty will be most graciously pleased to grant to your petitioner a prolongation of his said term of sole using and vending his said invention for the further and additional term of seven

(*d*) This clause is, of course, only to be inserted when the petitioner is an assignee.

[*or* fourteen] years, and to grant to your petitioner new letters patent for the sole use of his said invention for such further and additional term of seven [*or* fourteen] years after the expiration of your petitioner's said first term therein or originally granted to your petitioner as aforesaid, and that your Majesty will be most graciously pleased to grant your petitioner such further and other relief in the premises as to your Majesty shall seem meet.

And your petitioner will ever pray, &c.

(Signed) [*J. G.*]

[*Sunderland, 1st November*, 1845.]

In the Judicial Committee of the Privy Council. (No. 7.)

Notice of objections to the granting of the prayer of a petition for a confirmation.

In the matter of the petition of [*J. C. Hadden, of Woburn Place, Russell Square, in the county of Middlesex, Civil Engineer,*] for the confirmation of letters patent for the sole use of his invention of ["*improvements in the preparation of Railway-sleepers,*"] granted to him on the [*fourteenth*] day of [*February*] in the [*eighth*] year of the reign of her present Majesty.

Notice is hereby given of the several grounds of the objections of [*Henry Rutter, of Mile End, in the county of Middlesex, Engineer*] to the granting of the prayer of the said petition, (that is to say,) [*Here state the various grounds of objections.*]

Dated this [*first*] day of [*November*, 1845.]

[*Charles Legh, Thavies Inn,*]
Solicitor for the above-named [*R. H.*]

In the Judicial Committee of the Privy Council. (No. 8.)

Notice of objections to the granting of the prayer of a petition for a prolongation.

In the matter of the petition of [*James Gowland, of London Wall, Chronometer Maker,*] for the prolongation of the sole privilege of using and exercising an invention of ["*improvements in the manufacture of Chronometers and other Time-keepers,*"] granted to him for the term of fourteen years, by letters patent under the Great Seal of the United Kingdom, bearing date at Westminster, the [*first*] day of [*July,*] in the [*second*] year of the reign of King William the Fourth.

Notice is hereby given of the several grounds of the objection of [(e) *Andrew Pritchard, of Fleet Street, in the city of London, Optical Instrument Manufacturer,*] to the granting of the prayer of the said petition (that is to say)—

That the said letters patent, mentioned in the said petition, are null and void, and a verdict was given against the validity of the said letters patent, in a certain cause in the Court of [*Common Pleas,*] wherein the petitioner was plaintiff and [*Andrew Smith,*] defendant.

(e) The party must be described in the same way as in his caveat.

That the said letters patent were repealed by the judgment of the Court of Chancery, in an action of *scire facias*, wherein her Majesty was plaintiff and the petitioner defendant.

That the said invention was not new at the date of the said letters patent; but was then well known to the public, a description thereof having previously been published in [*The Mechanics' Magazine.*]

That the said petitioner does not possess sufficient merit to entitle him to a prolongation of the term or privilege granted by the said letters patent.

That the invention is of no use to the public, or not of so much public utility as to be a sufficient consideration for any prolongation of the term or privilege granted by the said letters patent.

That the said petitioner is not entitled to [the whole of] the privilege granted by the said letters patent [by assignment or otherwise.]

That the said petitioner has assigned the whole [*or* a portion] of the privilege granted by the said letters patent to [*Clement Gowland,*] who is no party to the said petition.

That the petitioner has been sufficiently remunerated and rewarded for all his expenses, labour, and ingenuity respecting the said invention.

That if the petitioner has failed to obtain a sufficient amount of remuneration or reward he has only failed to do so in consequence of his own gross negligence.

That the said petitioner granted licences to the said [*A. P.*] and others, to use and exercise his said invention; and that in consequence of the said licence having only been granted during the original term mentioned in the said letters patent, the said licensees would be prevented from using the said invention during any prolongation of the said term, and would consequently be very seriously injured by such a prolongation.

That the allegations contained in the said petition are not true in substance or in fact.

Dated this [*ninth*] day of [*October*, 1845.]

[*Wm. Ranyard, South Square, Gray's Inn,*]
Solicitor for the above-named [*A. P.*]

In the Judicial Committee of the Privy Council.

(No. 9.) Notice of day appointed for the hearing of a petition.

In the matter of the petition, &c. [*as in the last form.*]

Take notice that the Judicial Committee of her Majesty's Privy Council did on the [*second*] day of [*November*] instant, appoint the [*fourteenth*] day of [*December*] now next ensuing, for the hearing of the matter of the said petition.

Dated this [*third*] day of [*November*, 1845.]

[*W. H. Rymer, Chancery Lane,*]
Solicitor for the petitioner.

To Mr. [*William Ranyard,*]
Solicitor for [*Mr. A. P.*]

(No. 10.)

VICTORIA, by the grace of God of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith, To all to whom these presents shall come, greeting. Whereas his late Majesty King George the Fourth, by letters patent, under the Great Seal of our United Kingdom of Great Britain and Ireland, bearing date at Westminster, the [*first*] day of [*September*,] in the [*tenth*] year of his reign, did give and grant unto [*J. S.* of &c.,] his executors, administrators and assigns, his especial licence, full power, sole privilege and authority, that he, the said *J. S.*, his executors, administrators, and assigns, and every of them should, and lawfully might, make, use, exercise and vend a certain invention of [*"a new preparation or manufacture of, &c.,"*] within that part of our said United Kingdom of Great Britain and Ireland, called England, and dominion of Wales, and town of Berwick-upon-Tweed, in such manner as to him, the said [*J. S.*,] his executors, administrators, and assigns, or any of them, should in his or her discretions seem meet. To have, hold, exercise, and enjoy the said licence, powers, privileges, and advantages therein granted or mentioned to be granted unto the said [*J. S.* junior,] his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years from the date of the said letters patent next and immediately ensuing, and fully to be complete and ended according to the statute in such case made and provided as by the said letters patent, relation being thereunto had, will more fully and at large appear. And whereas [*W. W., J. S. B., J. C., and G. H. L.*, all of, &c.,] the assignees of the same letters patent, have by their petition humbly represented unto us, and prayed that, under the circumstances therein set forth, we would be graciously pleased to grant unto them new letters patent for the said invention for which the above-mentioned letters patent were so granted, as aforesaid, for a term of seven years, or for such other term not exceeding seven years after the expiration of the said term of fourteen years, granted to the said [*J. S.*,] as to us should seem fit. AND WHEREAS the Judicial Committee of our Privy Council have, in pursuance of the statute in such case made and provided, reported to us that a further extension of the term in the said original letters patent should be granted to the said [*W. W., J. S. B., J. C. and G. H. L.*,] in whom the legal interest in the said patent is now vested. KNOW YE THEREFORE, that we, of our especial grace, certain knowledge, and mere motion, have given and granted, and by these presents for us, our heirs and successors, do give and grant unto the said [*W. W., J. S. B., J. C., and G. H. L.*,] their executors, administrators, and assigns, our especial licence, full power, sole privilege and authority, that they, the said [*W. W., J. S. B., J. C., and G. H. L.*,] their executors, administrators, and assigns, and every of them, by themselves, or by their deputy or deputies, servants, or agents, or such others as they, the said [*W. W., J. S. B., J. C. and G. H. L.*,] their executors, administrators or assigns, shall at any time agree with and no others from time to time, and at all times hereafter, during the term of years herein expressed, shall,

Patent for granting prolongation to the assignees of a patent for seven years.

Recital of former patent.

Recital of petition for prolongation by assignees.

Recital of Report of Judicial Committee of Privy Council.

Grant to assignees of patent.

and lawfully may, make, use, exercise, and vend the said invention within that part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and Town of Berwick-upon-Tweed, in such manner as to them, the said [*W. W., J. S. B., J. C., and G. H. L.*] their executors, administrators, and assigns, or any of them, shall, in their discretion, seem meet. And that they, the said [*W. W., J. S. B., J. C., and G. H. L.*] their executors, administrators, and assigns shall and lawfully may have and enjoy the whole profit, benefit, commodity and advantage, from time to time coming, growing, accruing and arising by reason of the said invention, for and during the term of years hereby mentioned, to have, hold, exercise, and enjoy the said licence, powers, privileges, and advantages hereinbefore granted or mentioned to be granted unto the said [*W. W., J. S. B., J. C., and G. H. L.*] their executors, administrators, and assigns, for and during, and unto the full end and term of [*seven*] years, to be computed from the [*ninth*] day of [*September, one thousand eight hundred and forty-five*], being the day of the expiration of the first term of fourteen years granted by the said letters patent herein mentioned: AND to the end, that they, the said [*W. W., J. S. B., J. C., and G. H. L.*] their executors, administrators, and assigns, and every of them, may have and enjoy the full benefit and the sole use and exercise of the said invention according to our gracious intention hereinbefore declared, we do, by these presents, for us, our heirs and successors, require and strictly command all and every person and persons, bodies politic and corporate, and all other our subjects whatsoever, of what estate, quality, degree, name or condition soever, they be within that said part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and town of Berwick-upon-Tweed aforesaid, that neither they, nor any of them, at any time during the continuance of the said term of [*seven*] years hereby granted, either directly or indirectly, do make, use, or put in practice the said invention or any part of the same so attained unto by the said [*J. S.*] as aforesaid, nor in anywise counterfeit, imitate or resemble the same, nor shall make, or cause to be made any addition thereunto, or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, devisor or devisors thereof, without the licence, consent, or agreement of the said [*W. W., J. S. B., J. C., and G. H. L.*] their executors, administrators or assigns, in writing, under their hands and seals, first had and obtained in that behalf upon such pains and penalties as can or may be justly inflicted on such offenders for their contempt of this our royal command. And further, to be answerable to the said [*W. W., J. S. B., J. C., and G. H. L.*] their executors, administrators and assigns according to law for their damages thereby occasioned: AND MOREOVER, We do by these presents for us, our heirs and successors, will, and command all and singular, the justices of the peace, mayors, sheriffs, bailiffs, constables, headboroughs, and all other officers and ministers whatsoever of us, our heirs and successors for the time being, that they or any of them do not, nor shall at any time during the said

Habendum

for [seven] years from expiration of former patent.

Prohibitory clause.

Command to all justices, &c. not to hinder patentees.

term hereby granted in anywise molest, trouble, or hinder the said [*W. W., J. S. B., J. C., and G. H. L.,*] their executors, administrators or assigns, or any of them, or their deputies, servants, or agents, in or about the due and lawful use or exercise of the aforesaid invention or anything relating thereto. PROVIDED ALWAYS, and these our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted, it shall be made appear to us, our heirs, or successors, or any six or more of our or their Privy Council, that this our grant is contrary to law, or prejudicial, or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof in that said part of our said United Kingdom of Great Britain and Ireland, called *England*, our *dominion of Wales*, and *town of Berwick-upon-Tweed* aforesaid, or not invented and found out by the said *J. S.* as aforesaid. Then upon signification or declaration thereof to be made by us, our heirs or successors, under our or their signet, or Privy Seal, or by the Lords and others of our or their Privy Council, or any six or more of them under their hands, these our letters patent shall forthwith cease, determine, and be utterly void to all intents and purposes, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: PROVIDED ALSO, that these, our letters patent, or anything herein contained, shall not extend, or be construed to extend to give privilege unto the said [*W. W., J. S. B., J. C., and G. H. L.,*] their executors, administrators, or assigns, or any of them to use or imitate any invention or work whatsoever which hath heretofore been found out or invented by any other of our subjects whatsoever except the said invention so found out by the said [*J. S.*] as aforesaid, and publicly used or exercised in that part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, or town of Berwick-upon-Tweed aforesaid, unto whom, like letters patent or privileges have been already granted for the sole use, exercise, and benefit thereof, It being our will and pleasure that the said [*W. W., J. S. B., J. C., and G. H. L.*], their executors, administrators, and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practice their several inventions by them invented and found out by the said [*J. S.*] as aforesaid, according to the true intent and meaning of the same respective letters patent and of these presents: PROVIDED LIKEWISE, nevertheless, and these our letters patent are upon this express condition, that if at any time hereafter these our letters patent, or the liberties and privileges hereby by us granted, shall become vested in or in trust for the number of twelve persons or their representatives at any one time as partners dividing or entitled to divide the profits obtained by reason of these our letters patent, (reckoning executors or administrators, as and for the single person whom they represent as to such interest as they are or shall be entitled to in right of such their testator or intestate:) AND ALSO, if the said [*W. W., J. S. B., J. C. and G. H. L.*], their executors, administrators or assigns shall

Condition that if patent unlawful it may be revoked.

Proviso that patent shall no give right to use any prior patent invention.

If patent becomes vested in more than twelve persons.

Or if patentees shall not supply

Her Majesty, &c. the patent to be void.

not supply or cause to be supplied for our service all such articles of the said invention as they shall be required to supply by the officers or commissioners administering the department of our service, for the use of which the same shall be required in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said officers or commissioners so requiring the same, then then these our letters patent, and all liberties and advantages whatsoever hereby granted shall utterly cease, determine and become void anything hereinbefore contained to the contrary thereof in anywise notwithstanding. *Provided* that nothing herein contained shall prevent the granting of licences in such manner, and for such considerations as they may by law be granted: AND LASTLY, We do by these presents for us, our heirs and successors grant unto the said [*W. W., J. S. B., J. C., and G. H. L.,*] their executors, administrators and assigns, that these our letters patent, or the enrolment or exemplification thereof shall be in, and by all things, good, firm, valid, sufficient and effectual in the law, according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favourable and beneficial sense for the best advantage of the said [*W. W., J. S. B., J. C., and G. H. L.*] their executors, administrators and assigns, as well in all our Courts of Record, or elsewhere, and by all and singular the officers and ministers whatsoever of us, our heirs and successors in that part of our said United Kingdom of Great Britain and Ireland, called England, our dominion of Wales and town of Berwick-upon-Tweed aforesaid, and amongst all and every the subjects of us, our heirs and successors whatsoever and wheresoever notwithstanding the not full and certain describing the nature or quality of the said invention or of the materials thereto conducing and belonging. IN WITNESS whereof we have caused these our letters to be made patent. WITNESS ourself, at our palace at Westminster, this [*twenty-ourth*] day of [*August*] in the [*seventh*] year of our reign.

Not to affect licences.

Patent to be valid and construed favourably notwithstanding the want of description, &c.

By writ of Privy Seal,
[*Edmunds.*]

(No. 11.)

Patent for prolonging a patent privilege for more than seven years.

Recital of former patent.

VICTORIA, by the grace of God of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith, to all to whom these presents shall come, greeting. WHEREAS his late Majesty King William the Fourth did by letters patent under the Great Seal of our United Kingdom of Great Britain and Ireland, bearing date at Westminster the [*eleventh*] day of [*November,*] in the [*first*] year of his reign, give and grant unto [*Sir Thomas Cochrane, Knight, (commonly called Lord Cochrane) now Earl of Dundonald,*] his executors, administrators, and assigns, his especial license, full power, sole privilege, and authority, that he the said [*Sir Thomas Cochrane, (commonly called Lord Cochrane) now Earl of D.*] his executors, administrators, and assigns, and every of them should and lawfully might make, use, exercise, and vend a certain invention of [*"an improved Rotary Engine to be impelled by steam, and which may be also rendered applicable to other purposes,"*] within that part of our

said United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and town of Berwick upon Tweed, in such manner as to him the said [*Sir T. C. (commonly called Lord C.) now Earl of D.*] his executors, administrators, and assigns, or any of them should in his or their discretions seem meet: To have, hold, exercise, and enjoy the said license, powers, and privileges, and advantages therein granted, or mentioned to be granted, unto the said [*Sir T. C. (commonly called Lord C.) now Earl of D.*)] his executors, administrators, and assigns, for and during, and unto the full end and term of fourteen years from the date of the said letters patent next and immediately ensuing, and fully to be complete and ended according to the statute in such case made and provided as by the said letters patent, relation being thereunto had will more fully and at large appear: AND WHEREAS the said [*Sir T. C. (now Earl of D.)*] hath humbly represented unto us, that owing to various causes, principally the petitioner believes to the general impression which has prevailed of the unattainableness of the object founded on the failure of so many previous attempts, and on the alleged demonstration of its impracticability, the term of the petitioner's patent has almost expired without the subject thereof having attained the acceptation of the public, or been employed for the purposes for which he conceives it to be peculiarly applicable. That the petitioner has been indebted for proofs of the efficiency of his Rotary Engine to the liberality and discernment of the late and present Boards of Admiralty, who perceiving the probability of benefit to be derived from the compactness, lightness, celerity of movement, and other properties of such Engine, have afforded the petitioner those opportunities of making further trial of the same which his own limited means would not have enabled him to do. That it is now five years since the late Lords Commissioners of the Admiralty were pleased to make trial of one of the petitioner's Engines, by placing it on the well in our Dock-yard at Portsmouth, where by permission of the present Lords Commissioners it continues to be employed. And in consequence of the most favorable report being made of its constancy and efficiency of performance, their Lordships have further favored the petitioner by ordering a pair of his Revolving Engines of the power of two hundred and twenty horses, to be made and placed on board a steam frigate named the Janus, which vessel they were also pleased to construct on lines offered to their notice by the petitioner, from the further adoption of which lines the petitioner anticipates important advantages to the naval service. That the petitioner has not only devoted the greater part of his time for a long series of years, to the prosecution of his design of supplying the desideratum of an effective Rotary or Revolving Steam Engine, but has expended upwards of twelve thousand pounds in making the numerous costly experiments which he found necessary for the perfecting his discovery, and in defraying the variety of expenses constantly arising in connection therewith, both antecedently and subsequently to the obtaining of his said letters patent. That the petitioner has not hitherto received the slightest reward for his many years labour, nor any re-im-

Recital of petition for prolongation.

bursement whatever of any portion of his large expenditure, unless he obtains that protection which he humbly solicits from us in Council. That inasmuch as during the term of almost fourteen years, the petitioner has not been able to obtain any remuneration whatever for his expense and labour in perfecting the said invention of a Rotary or Revolving Engine. The petitioner has no reason to hope that the exclusive right of using and vending the same for the further period of seven years would suffice for his re-imbursement and remuneration, but has every reason to believe that the utmost period of extension now allowed by law, namely, another term of fourteen years, is requisite for such purposes: And the petitioner humbly prayed that we would be pleased to grant him an extension of the term of his said patent for a further period of fourteen years after the termination of his said letters patent bearing date the [*eleventh*] day of [*November, one thousand eight hundred and thirty*:]

Recital of Report of Judicial Committee of Privy Council.

AND WHEREAS the Judicial Committee of our Privy Council have, in pursuance of the statute in such case made and provided, reported to us that a further extension of the letters patent obtained by the said [*T. Earl of D.*] for England, Wales, and the town of Berwick upon Tweed, and dated the [*eleventh*] day of [*November, one thousand eight hundred and thirty,*] ought to be granted to the said petitioner, and that such extension should be of the term of [*fourteen*] years from and after the expiration of the term in the said original letters patent:

Grant.

KNOW YE THEREFORE that we of our special grace, certain knowledge, and mere motion, HAVE given and granted, and by these presents for us, our heirs, and successors, DO give and grant unto the said [*Thomas, Earl of D.*] his executors, administrators, and assigns, our especial licence, full power, sole privilege, and authority, That he the said [*T. Earl of D.*] his executors, administrators, and assigns, and every of them by himself, and themselves, or by his and their deputy or deputies, servants, or agents, or such others as he the said [*T. Earl of D.*] his executors, administrators, or assigns, shall at any time agree with, and no others, from time to time, and at all times hereafter during the term of years herein expressed, shall and lawfully may make, use, exercise, and vend the said invention of ["*an improved Rotary Engine to be impelled by steam, and which may be also rendered applicable to other purposes,*"] within that part of our said United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and town of Berwick upon Tweed, in such manner as to him the said [*T. Earl of D.*] his executors, administrators, or assigns, or any of them shall in his or their discretions seem meet.

Habendum.

And that the said [*T. Earl of D.*] his executors, administrators, and assigns, shall and lawfully may have and enjoy the whole profit, benefit, commodity, and advantage from time to time coming, growing, accruing, and arising by reason of the said invention for and during the term of years herein mentioned: TO HAVE, HOLD, exercise, and enjoy the said licence, power, privileges, and advantages hereinbefore granted or mentioned to be granted, unto the said [*T. Earl of D.*] his executors, administrators, and assigns, for and during, and unto the full end and term of

[*fourteen*] years, to be computed from the [*eleventh*] day of [*November,*] in the year of our Lord [*one thousand eight hundred and forty-four,*] being the day of the expiration of the term of fourteen years granted by the said letters patent herein mentioned: AND to the end that the said [*T. Earl of D.*] his executors, administrators, and assigns, and every of them may have and enjoy the full benefit and the sole use and exercise of the said invention according to our gracious intention hereinbefore declared, We do by these presents for us, our heirs, and successors, require and strictly command all and every person and persons, bodies politic and corporate, and all other our subjects whatsoever, of what estate, quality, degree, name, or condition soever they be within that said part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and town of Berwick upon Tweed aforesaid. That neither they nor any of them, at any time during the continuance of the said term of fourteen years hereby granted either directly or indirectly, do make, use, or put in practice the said invention, or any part of the same so attained unto by the said [*T. Earl of D.*] as aforesaid, nor in anywise counterfeit, imitate, or resemble the same, nor shall make, or cause to be made, any addition thereunto or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, devisor or devisors thereof without the licence, consent, or agreement of the said [*T. Earl of D.*] his executors, administrators, or assigns, in writing under his or their hands and seals first had and obtained in that behalf, upon such pains and penalties as can or may be justly inflicted on such offenders, for their contempt of this our royal command, and further to be answerable to the said [*T. Earl of D.*] his executors, administrators, and assigns, according to law, for his and their damages thereby occasioned: AND MOREOVER, we do by these presents for us, our heirs, and successors, will and command all and singular the justices of the peace, mayors, sheriffs, bailiffs, constables, headboroughs, and all other officers and ministers whatsoever, of us, our heirs, and successors for the time being, that they or any of them do not, nor shall at any time during the said term hereby granted, in anywise molest, trouble, or hinder the said [*T. Earl of D.*] his executors, administrators, or assigns, or any of them, or his or their deputies, servants, or agents, in or about, the due and lawful use or exercise of the aforesaid invention, or any thing relating thereto: PROVIDED ALWAYS, and these our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted, it shall be made appear to us, our heirs, or successors, or any six or more of our or their Privy Council, that this our grant is contrary to law, or prejudicial, or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof, in that said part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and town of Berwick upon Tweed aforesaid, or not invented and found out by the said Thomas, Earl of Dundonald, as aforesaid; then upon signification or declaration thereof to

Prohibitory clause.

Command to all justices, &c. not to molest the patentee.

Condition that if patent unlawful it may be avoided.

be made by us, our heirs, or successors, under our or their Signet or Privy Seal, or by the Lords and others of our or their Privy Council, or any six or more of them under their hands, these our letters patent shall forthwith cease, determine, and be utterly void, to all intents and purposes any thing hereinbefore contained to the contrary thereof in anywise notwithstanding: PROVIDED ALSO, that these our letters patent, or any thing herein contained, shall not extend, or be construed to extend, to give privilege unto the said [*T. Earl of D.*] his executors, administrators, or assigns, or any of them, to use or imitate any inventions or work whatsoever which hath heretofore been found out or invented by any other of our subjects whatsoever, and publicly used or exercised in that said part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, or town of Berwick upon Tweed aforesaid, unto whom like letters patent or privileges have been already granted for the sole use, exercise, and benefit thereof. It being our will and pleasure that the said [*T. Earl of D.*] his executors, administrators, and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practise their several inventions by them invented and found out according to the true intent and meaning of the same respective letters patent and of these presents: PROVIDED LIKEWISE NEVERTHELESS, and these our letters patent are upon this express condition, that if at any time hereafter these our letters patent, or the liberties and privileges hereby by us granted, shall become vested in or in trust for more than the number of twelve persons or their representatives at any one time, as partners dividing, or entitled to divide, the benefit or profits obtained by reason of these our letters patent (reckoning executors or administrators as and for the single person whom they represent, as to such interest as they are or shall be entitled to in right of such their testator or intestate:) AND ALSO if the said [*T. Earl of D.*] his executors, administrators, or assigns, shall not supply, or cause to be supplied for our service, all such articles of the said invention as he or they shall be required to supply, by the officers or commissioners administering the department of our service for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said officers or commissioners so requiring the same, that then these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine, and become void, any thing hereinbefore contained to the contrary thereof in anywise notwithstanding, Provided that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted: AND LASTLY, we do by these presents for us, our heirs, and successors, grant unto the said [*T. Earl of D.*] his executors, administrators, and assigns, That these our letters patent, or the inrolment or exemplification thereof, shall be in and by all things good, firm, valid, sufficient, and effectual in the law according to the true intent and mean-

Proviso that patent shall not give right to use any prior patent invention.

If patent becomes vested in more than twelve persons.

Or if patentee shall not supply articles for the service of the public.

Patent to be valid and construed favourably notwithstanding the want of description, &c.

ing thereof, and shall be taken, construed, and adjudged in the most favorable and beneficial sense for the best advantage of the said [*T. Earl of D.*] his executors, administrators, and assigns, as well in all our Courts of record as elsewhere, and by all and singular the officers and ministers whatsoever of us, our heirs, and successors, in that part of our said United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and town of Berwick upon Tweed aforesaid, and amongst all and every the subjects of us, our heirs, and successors whatsoever and wheresoever, notwithstanding the not, full, and certain describing the nature or quality of the said invention, or of the materials thereto conducing and belonging. IN WITNESS, &c. (*f*).

SECTION IV.

Forms of Entries and Proceedings in Actions for Infringements of Patents.

In the Queen's Bench [*Common Pleas*, or *Exchequer of Pleas.*] (No. 1.)

Declaration by a patentee or his assignee for the infringement of his patent (*g*).

The [*first*] day of [*November*,] in the year of our Lord [*one thousand eight hundred and forty-five.*]

MIDDLESEX (*h*) to wit. [*John Moore*,] (the plaintiff in this suit,) by [*Anthony Boucher*,] his attorney, complains of [*John Smith*,] (the defendant in this suit,) who has been summoned to answer the plaintiff in an action on the case.

For that whereas, heretofore, and before, and at the time of making of the letters patent hereinafter [in this count] mentioned, and before the time of the committing of the several grievances hereinafter mentioned, to wit, on the [*first*] day of [*January*,] in the year of our Lord, [1844,] the plaintiff [*or* one Richard Thompson,] was the true and first inventor (*i*) of [*a certain improvement or certain improvements in the mechanism of Time-keepers*,] and therefore our Lady the now Queen, [*or* his late Majesty King William the Fourth,] heretofore and before the commencement of this suit, and before the committing of the several grievances hereafter mentioned, to wit, on the said [*first*] day of [*January*,] in the year of our Lord, [1844,] [*or* on the day and year last aforesaid,] by her [*or* his] letters patent under the Great Seal of the United Kingdom of Great Britain and Ireland (*k*), bearing date at Westminster a certain day and year therein mentioned, to wit, the [*first*] day of [*January*,] in the [*seventh*] year of the reign of our said Lady the now

(*f*) The conclusion is the same as in the last form.

(*g*) Vide *ante*, Chap. X. s. 2, p. 253.

(*h*) The venue is transitory and the plaintiff may lay it in any county he pleases, and the defendant cannot change it. See *Cameron* v. *Gray*, 6 T. R. 363; Dav. P. C. 220, *S. C. Brunton* v. *White*, 7 D. & R. 103.

(*i*) If the patentee was an importer of the invention this allegation must be varied accordingly.

(*k*) Vide *ante*, p. 253; and see *R.* v. *Vandell*, 4 T. R. 521.

Queen, [*or* of his said late Majesty,] (and which said letters patent sealed with the Great Seal of the said United Kingdom, the plaintiff now brings into Court and shows to the Court here, the date whereof is a certain day and year therein mentioned, to wit, the day and year last aforesaid,) reciting (*l*) that the plaintiff [*or* the said *R. T.*] had by his petition humbly represented unto her said Majesty, [*or* his said late Majesty,] that he had invented ["*a certain improvement or certain improvements in the mechanism of Time-keepers,*"] which the petitioner conceived would be of great public utility, that he was the first and true inventor thereof, and that the same had not been practised or used before in this kingdom by any other person or persons to the best of his knowledge and belief, the petitioner therefore most humbly prayed that her said Majesty, [*or* his said late Majesty,] would be graciously pleased to grant unto him, his executors, administrators, and assigns, her said Majesty's [*or* his said late Majesty's] royal letters patent under her [*or* his] Great Seal of the United Kingdom of Great Britain and Ireland, for the sole use, benefit, and advantage of his said invention, within that part of the said United Kingdom called England, her dominion of Wales, and town of Berwick upon Tweed, [and in the islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all her said Majesty's colonies and plantations abroad,] for the term of fourteen years pursuant to the statute in that case made and provided. And that her said Majesty, [*or* his said late Majesty,] being willing to give encouragement to all arts and inventions which might be for the public good, was graciously pleased to condescend to the petitioner's request, her said Majesty, [*or* his said late Majesty,] of her [*or* his] special grace, certain knowledge and mere motion, thereby gave and granted, and by the said letters patent for herself [*or* himself,] her [*or* his] heirs and successors, did give and grant unto the plaintiff, [*or* the said *R. T.*] his executors, administrators, and assigns, her said Majesty's, [*or* his said late Majesty's] licence, full power, sole privilege, and authority, that he the plaintiff, [*or* the said *R. T.*] his executors, administrators, and assigns, and every of them by himself and themselves, or by his and their deputy, or deputies, servants, or agents, or such others as he the plaintiff [*or* the said *R. T.*] his executors, administrators, or assigns, should at any time agree with, and no others from time to time and at all times thereafter during the term of years therein expressed, should and lawfully might make, use, exercise, and vend his said invention within that part of her said Majesty's [*or* his late Majesty's] United Kingdom of Great Britain and Ireland, called England, her Majesty's [*or* his said late Majesty's] dominion of Wales, and town of Berwick upon Tweed, [and in the islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all her said Majesty's, [*or* his said late Majesty's] plantations and colonies abroad,] in such manner as to him the plaintiff, [*or* the said *R. T.*] his executors, adminis-

(*l*) This recital must, of course, be made to agree with that contained in the patent.

trators, and assigns, or any of them should in his or their discretions seem meet, and that he the plaintiff, [*or* the said *R. T.*,] his executors, administrators, and assigns, should and lawfully might have and enjoy the whole profit, benefit, commodity, and advantage from time to time coming, growing, accruing, and arising, by reason of the said invention, for and during the term of years therein mentioned, to have, hold, exercise, and enjoy the said licence, powers, privileges, and advantages thereinbefore granted, or mentioned to be granted unto the plaintiff, [*or* the said *R. T.*,] his executors, administrators, and assigns, for and during, and unto the full end and term of fourteen years from the date of the said letters patent next and immediately ensuing, and fully to be complete and ended according to the statute in such case made and provided, and to the end that he the plaintiff, [*or* the said *R. T.*,] his executors, administrators, and assigns, and every of them, might have and enjoy the full benefit and the sole use and exercise of the said invention according to her said Majesty's [*or* his said late Majesty's] gracious intention thereinbefore declared, her said Majesty, [*or* his said late Majesty] did by the said letters patent for herself [*or* himself,] her [*or* his] heirs and successors, require and strictly command all and every person and persons, bodies politic and corporate, and all other her said Majesty's [*or* his said late Majesty's] subjects whatsoever of what estate, quality, degree, manner, or condition soever they were, within that said part of her said Majesty's [*or* his said late Majesty's] United Kingdom of Great Britain and Ireland, called England, her said Majesty's [*or* his said late Majesty's] dominion of Wales, and town of Berwick upon Tweed, [and in the said islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all her said Majesty's [*or* his said late Majesty's] colonies and plantations abroad aforesaid,] that neither they nor any of them at any time during the continuation of the said term of fourteen years thereby granted, either directly or indirectly, should make, use, or put in practice the said invention, or any part of the same so attained unto by the plaintiff [*or* the said *R. T.*] as aforesaid, nor in anywise counterfeit, imitate, or resemble the same, nor should make, or cause to be made, any addition thereunto, or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, devisor or devisors thereof, without the license, consent, or agreement of the plaintiff, [or the said *R. T.*,] his executors, administrators, or assigns, in writing under his or their hands and seals, first had and obtained in that behalf upon such pains and penalties as could or might be justly inflicted on such offenders for their contempt of that her said Majesty's [*or* his said late Majesty's] royal command, and further to be answerable to the plaintiff, [*or* the said *R. T.*,] his executors, administrators, and assigns, according to law, for his and their damages thereby occasioned. And moreover, her said Majesty, [*or* his said late Majesty,] by the said letters patent for herself [*or* himself,] her [*or* his] heirs and successors, willed and commanded all and singular the justices of the peace, mayors, sheriffs, bailiffs, constables, headboroughs, and all other officers and ministers whatsoever, of herself [or himself,] her [*or*

his] heirs and successors for the time being, that they or any of them did not, nor should at any time thereafter during the said term thereby granted, in anywise molest, trouble, or hinder the plaintiff, [*or* the said *R. T.*,] his executors, administrators, or assigns, or any of them, or his or their deputies, servants, or agents, in or about the due and lawful use or exercise of the aforesaid invention, or any thing relating thereto. And in which said letters patent (amongst other things) was and is contained a certain proviso whereby it was declared that in case the plaintiff [*or* the said *R. T.*,] should not particularly describe and ascertain the nature of his said invention, and in what manner the same was to be performed, by an instrument in writing under his hand and seal, and cause the same to be enrolled in her said Majesty's [*or* his said late Majesty's] High Court of Chancery within [*six*] calendar months next and immediately after the date of those letters patent, that then and in that case the said letters patent, and all liberties and advantages whatsoever thereby granted, should utterly cease, determine, and become void, any thing thereinbefore contained to the contrary thereof in anywise notwithstanding. And lastly, her said Majesty, [*or* his said late Majesty,] did by the said letters patent, for herself [*or* himself,] her [*or* his,] heirs and successors, grant unto the plaintiff, [or the said *R. T.*,] his executors, administrators, and assigns, that the said letters patent, or the enrolment or exemplification thereof should be in and by all things good, firm, valid, sufficient, and effectual in the law according to the true intent and meaning thereof, and should be taken, construed, and adjudged in the most favorable and beneficial sense, for the best advantage of the plaintiff, [*or* the said *R. T.*,] his executors, administrators, and assigns, as well in all her said Majesty's [*or* his said late Majesty's] Courts of record as elsewhere, and by all and singular the officers and ministers whatsoever of her said Majesty, [*or* of his said late Majesty,] her [*or* his] heirs and successors, in that part of her said Majesty's [*or* his said late Majesty's] United Kingdom of Great Britain and Ireland, called England, her said Majesty's [*or* his said late Majesty's] dominion of Wales and town of Berwick upon Tweed, [and in the islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all her said Majesty's [*or* his said late Majesty's] colonies and plantations abroad aforesaid,] and amongst all and every the subjects of her said Majesty, [*or* his said late Majesty,] her [*or* his] heirs and successors whatsoever and wheresoever, notwithstanding the not full and certain describing the nature or quality of the said invention, or of the materials thereto conducing and belonging: as by the said letters patent now produced and shown forth to the Court here under the said Great Seal of the said United Kingdom, reference being thereunto had, will (amongst other things) more fully and at large appear.

Preparation and enrolment of a specification.

And the plaintiff further saith, that he, the plaintiff, [*or* the said *R. T.*,] afterwards to wit, on the [*first*] day of [*July*,] in the year of our Lord, [1844,] in pursuance of the said proviso in that behalf in the said letters patent expressed and contained, by an instrument in writing, to wit, a specification under his hand and seal, did particularly describe and ascertain

the nature of his said invention, and in what manner the same was to be performed, and did afterwards and within [*six*] calendar months next and immediately after the date of the said letters patent, (*to wit,*) on the [*first*] day of [*July*] in the year of our Lord [1844], cause the said instrument in writing, to wit, the said specification, to be enrolled in her said Majesty's, [*or* in his said late Majesty's] High Court of Chancery, as by the enrolment of the said instrument in writing, to wit, the said specification, now remaining of record in the said High Court of Chancery more fully and at large appears.

Assignment of the whole or a portion of the patent.

[And the plaintiff further saith, that the said [*R. T.*] after the making of the said letters patent, and before the committing of the several grievances by the defendants hereinafter mentioned, and before the commencement of this suit, to wit, on the [*first*] day of [*August,*] in the year of our Lord [1844], by an indenture then made between the said [*R. T.*] of the one part, and the plaintiff, [*or X. Y.*] of the other part (which said indenture, sealed with the seal of the said [*R. T.*] he, the plaintiff now brings here into Court, the date whereof is the day and year last aforesaid), for the considerations therein mentioned, he, the said [*R. T.*], did assign [(*m*) one moiety, or one-third part (*as the case may be*) of and in] the said letters patent, and the liberties and privileges thereby granted unto the plaintiff [*or* the said *X. Y.*] his executors, administrators, and assigns, for the residue of the said term of fourteen years, as and for his and their own sole and absolute property, as by the said indenture reference being thereunto had, will amongst other things more fully and at large appear].

Second or other assignment.

(*n*) [And the plaintiff further says, that after the making of the said indenture, and before the committing of the several grievances by the defendant hereinafter mentioned, and before the commencement of this suit, to wit, on the [*tenth*] day of [*October,*] in the year of our Lord [1844], by a certain other indenture then made between the said [*X. Y.*] of the one part, and the plaintiff [*or A. Z.*] of the other part, &c. (*Here state the second assignment in the same way as the first.*)]

Exercise of privilege by the patentee, &c.

And the plaintiff further says, that [(*o*) the said [*R. T.*] always from the time of the making of the said letters patent until the time of the making of the said indenture of assignment [*firstly*, hereinbefore mentioned] by himself, his servants, or agents in that behalf, and by virtue, and in exercise of the said sole privilege so granted by the said letters patent as aforesaid, worked, used, exercised, and put in practice the said inven-

(*m*) These words are to be inserted when the assignment comprises only a portion of the patent privilege.

(*n*) If there be any other assignments under which the plaintiff or any one of the plantiffs claims, they must be stated here.

(*o*) When the action is brought by an assignee it is usual to allege that the former possessors of the patent exercised the exclusive privilege to their benefit and advantage; but it seems to be sufficient to allege that the plaintiff has exercised the privilege for his own profit.

tion, and made divers large quantities and numbers of articles and things according to and by means of the said invention, and sold and vended such articles and things to his great benefit, advantage, and profit; and the said [*X. Y.*] always from the time of the making of the said indenture [*firstly*, hereinbefore mentioned] until the time of the making of the said indenture [*secondly*, hereinbefore mentioned], by himself, his servants, or agents, in that behalf, and by virtue, and in exercise of the said sole privilege so granted by the said letters patent as aforesaid, worked, used, and put in practice the said invention, and made divers large quantities and numbers of articles and things according and by means of the said invention, and sold and vended such articles and things to his great benefit, advantage, and profit; and that] he the plaintiff (*p*), hath always, from the time of the making of the said letters patent [*or* of the said indenture of assignment *lastly* hereinbefore mentioned] hitherto and to the time of the commencement of this suit, by himself, his servants, or agents in that behalf, and by virtue and in exercise of the said sole privilege so granted by the said letters patent, as aforesaid, worked, used, exercised, and put in practice the said invention, and made divers large quantities and numbers of articles and things according to and by means of the said invention, and sold and vended such articles and things to his great benefit, advantage, and profit. YET the defendant, well knowing the premises, but contriving and wrongfully and injuriously intending to injure the plaintiff, and to deprive him of the profits, benefits, and advantages which he might and otherwise would have derived, and acquired from the working, using, exercising, and putting in practice the said invention, and from the making, selling, and vending of such articles and things as aforesaid, after the making of the said letters patent [and of the said (last-mentioned) indenture of assignment] and within the said term of years in the said letters patent mentioned, and before the commencement of this suit, to wit, on the [*first*] day of [*January*,] in the year of our Lord [1845], and on divers other days and times between that day and the commencement of this suit, within that part of the United Kingdom of Great Britain and Ireland, called England, unlawfully, unjustly, and injuriously, and without the leave, licence, consent, or agreement of the plaintiff [*or* of the plaintiff or of the said *R. T.*] (*q*), and against the will of the plaintiff, did work, use, exercise, and put in practice the said invention and divers, to wit, [*fifty*] parts of the said invention, in breach of the said letters patent, and against the said sole privilege thereby granted unto the plaintiff [or the said *R. T.*] his executors, administrators, and assigns, as aforesaid, whereby the plaintiff hath been and is greatly injured, and hath lost and been deprived of divers great

1st Breach, that defendant did work, use, exercise, and put in practice the invention.

(*p*) The object of this allegation is to show that the plaintiff has been injured by the invasion of his privilege, and that the patent does not merely confer a bare right of no utility or benefit to the plaintiff.

(*q*) The declaration ought to negative a licence by any person in whom the patent right appears by the declaration to have been vested.

gains, profits, and advantages which he might and otherwise would have derived and acquired from the said invention and privilege.

2nd Breach, that defendant manufactured articles according to the invention.

And the plaintiff further says, that the defendant well knowing the several promises aforesaid, but further contriving and intending as aforesaid after the making of the said letters patent, [and of the said last-mentioned indenture,] and within the said term of years in the said letters patent mentioned, and before the commencement of this suit, to wit, on the [*first*] day of [*January*,] in the year of our Lord [1845] aforesaid, [*or* on the day and year last aforesaid,] and on divers other days and times between that day and the commencement of this suit in England aforesaid, unlawfully, unjustly, and injuriously, and without the leave, licence, consent, or agreement of the plaintiff, [*or* of the plaintiff or the said *R. T.*,] (r), and against the will of the plaintiff * made, manufactured, and fabricated divers, to wit, [*one thousand Clocks, one thousand parts of Clocks, one thousand Watches, one thousand parts of Watches, one thousand Chronometers, one thousand parts of Chronometers, one thousand Time-keepers, and one thousand parts of Time-keepers*:—*or, one thousand Steam Engines, one thousand Stocking Looms, one thousand Braiding Machines, ten thousand yards of Cloth, ten thousand pairs of Gloves, &c. according to the nature of the invention*,] according to and by means of the said invention, and in breach of the said letters patent, and against the said sole privilege thereby granted to the plaintiff, [*or* the said *R. T.*,] his executors, administrators, and assigns as aforesaid, whereby the plaintiff has been and is greatly injured, and hath lost and been deprived of divers great gains, profits, and advantages which he might and otherwise would have derived and acquired from the said invention and privilege.

3rd Breach, that defendant sold articles, &c.

And the plaintiff further says, that the defendant well knowing, &c. [*commencement as in the second breach down to the* *] sold, vended, and put off divers, to wit, [*one thousand Clocks, &c.:—describe the articles in the same manner as in the second breach, ante*,] in breach of the said letters patent, and against the said sole privilege, &c. [*Conclude as in the second breach.*]

4th Breach, that defendant counterfeited, &c.

And the plaintiff further says, &c., [*commencement as in the second breach down to the* *] did counterfeit, imitate, and resemble the said invention, and divers, to wit, [*fifty*] parts thereof, in breach of the said letters patent, &c. [*Conclude as in second breach.*]

5th Breach, that defendant made additions to and subtractions from the invention, &c.

And the plaintiff further says, &c., [*commencement as in the second breach to the* *] did make, and also cause and procure to be made, divers, to wit, [*one hundred*] additions to, and divers, to wit, [*fifty*] subtractions from the said invention, and from divers, to wit, [*one hundred and fifty*] parts thereof, whereby to pretend, and whereby the defendant did in fact pretend himself to be the inventor and devisor thereof, in breach of the said letters patent, &c. [*Conclusion as in the second breach, ante.*]

(r) Negative a licence by any former proprietor of the patent right as well as the plaintiff.

6th Breach, that defendant made and sold counterfeit articles.

And the plaintiff further says, &c., [*commencement as in the second breach to the* *] did make, manufacture, and fabricate, sell, and vend, and did cause, and procure to be made, manufactured, and fabricated, sold, and vended divers, to wit, [*one thousand Clocks, &c.*:—*describe the articles in the same way as in the second breach, ante,*] and divers, to wit, [*one thousand parts of Clocks, &c.*:—*describe the articles as before,*] which were intended to counterfeit, imitate, and resemble, and which did in fact counterfeit, imitate, and resemble the said invention, and divers, to wit, [*fifty*] parts thereof, in breach of the said letters patent, &c. [*Conclusion as in the second breach.*]

7th Breach, the like in a different form.

And the plaintiff further says, &c., [*commencement as before,*] did make, manufacture, and fabricate, sell, and vend, and did cause and procure to be made, manufactured, and fabricated, sold, and vended divers, to wit, [*one thousand Clocks, &c.*] and divers, to wit, [*one thousand parts of Clocks, &c.*] which were intended to counterfeit, imitate, and resemble, and which did in fact counterfeit, imitate, and resemble divers, to wit, [*one thousand Clocks, &c.,*] and divers, to wit, [*one thousand parts of Clocks, &c.,*] made, manufactured, and fabricated, according to, and by means of the said invention, and divers, to wit, [*one thousand*] parts thereof in breach of the said letters patent, &c. [*Conclude as in the second breach.*]

Conclusion.

To the damage of the plaintiff of [£10,000,] and thereupon he brings his suit, &c.

(No. 2.) IN THE QUEEN'S BENCH.

Short form of declaration in an action by a patentee.

The [*ninth*] day of [*December,*] &c.

DURHAM (*s*), (to wit,) [*Anthony Barber,*] the plaintiff in this suit, &c. [*Commencement as in the last form, ante,* p. 655.]

For that whereas our Lady the now Queen, before the commencement of this suit, and before the committing of the grievances by the defendant hereinafter mentioned, to wit, on the [*first*] day of [*September,*] in the [*fourth*] year of her reign, (being in the year of our Lord, 1840,) by her letters patent under her Great Seal of the United Kingdom of Great Britain and Ireland (and which said letters patent sealed with the said Great Seal, the plaintiff now brings into Court, and shows to the Court, here, the date whereof is a certain day and year therein mentioned, to wit, the day and year last aforesaid), did give and grant unto the plaintiff her said Majesty's especial licence, full power, sole privilege and authority, that he the plaintiff, his executors, administrators, and assigns, or such others as he or they should at any time agree with, and no others, from time to time, and at all times during the term of years therein expressed, to wit, the term of fourteen years, should and lawfully might make, use exercise, and vend within England, Wales, and the town of Berwick upon Tweed, [the islands of Jersey, Guernsey, Alderney, Sark, and Man, and

(*s*) The venue is transitory. Vide *ante*, p. 655. n. (*h*).

also all her said Majesty's colonies and plantations abroad,] an invention of [*improvements in machinery for manufacturing Elastic Fabrics*,] provided that the said plaintiff should cause a particular description of the nature of the said invention. and in what manner the same was to be performed, to be enrolled in her said Majesty's High Court of Chancery, within [*six*] calendar months next and immediately after the date of the said letters patent. And her said Majesty did by the said letters patent require and strictly command all and every person and persons, bodies politic and corporate, and all her subjects whatsoever within that part of the United Kingdom of Great Britain and Ireland, called England, her *dominion of Wales, and town of Berwick upon Tweed*, [*the said islands* of Jersey, Guernsey, Alderney, Sark, and Man, and also in all her said Majesty's said colonies and plantations abroad,] that neither they nor any of them at any time during the continuance of the term thereby granted, either directly or indirectly, should make, use, or put in practice the said invention, or any part of the same, nor in anywise counterfeit, imitate, or resemble the same, nor make, or cause to be made, any addition thereto or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, devisor or devisors thereof, without the licence, consent, or agreement of the plaintiff, his executors, administrators, or assigns, in writing under his or their hands and seals first had and obtained in that behalf as by the said letters patent under the said Great Seal now shown to the Court here, reference being thereunto had, will amongst other things more fully and at large appear. And the plaintiff further saith, that he did afterwards, to wit, on the [*first*] day of [*March*,] in the year of our Lord, [1841,] and within [*six*] calendar months next and immediately after the date of the said letters patent, in pursuance of the said proviso, and of the said letters patent, by an instrument in writing under his hand and seal, particularly describe the nature of the said invention, and in what manner the same was to be performed, and did also on the day and year last aforesaid, and within [*six*] calendar months next and immediately after the date of the said letters patent, cause the same instrument in writing under his hand and seal to be enrolled in her said Majesty's High Court of Chancery at Westminster, in the county of Middlesex, as by the said enrolment of the said instrument in writing, now remaining of record in the said High Court of Chancery, will amongst other things more fully and at large appear. AND the plaintiff saith that he hath always from the time of the granting of the said letters patent, and in exercise of the said privilege so thereby granted as aforesaid, worked, used, exercised, and put in practice the said invention, and made and manufactured articles and things by means of the same invention, and vended and sold such articles and things as he the plaintiff by means of the said letters patent was so entitled to do as aforesaid. YET the defendants well knowing the premises, but contriving, and wrongfully, and injuriously intending to injure the plaintiff, and to deprive him of the profits, benefits, and advantages which he might and otherwise would have derived and acquired from the working,

1st Breach.

using, exercising, and putting in practice of the said invention, and from the making and vending of such articles and things as aforesaid, after the making of the said letters patent, and within the said term of years in the said letters patent *mentioned, to wit, on the* [*twentieth*] day of [*June,*] in the year of our Lord, [1842,] and on divers other days and times between that day and the commencement of this suit, and within that part of the said United Kingdom called England, wrongfully and unjustly without the leave or licence, and against the will of the plaintiff, did work, use, exercise, and put in practice the said invention, and divers, to wit, [*one hundred*] parts thereof, in breach of the said letters patent, and of the said privilege thereby granted as aforesaid.

2nd Breach. And the plaintiff further says, that the defendant, well knowing the several premises aforesaid, but further contriving and intending, as aforesaid, after the making of the said letters patent, and within the said term of years therein mentioned, to wit, on the day and year last aforesaid, and on divers other days and times between that day and the commencement of this suit in England aforesaid, wrongfully and unjustly, and without the leave or licence of the plaintiff, and against his will,* did make, manufacture, and fabricate divers, to wit, [500 *Machines,*] and divers, to wit, [500 *parts of Machines,*] according to and by means of the said invention, and in breach of the said letters patent, and of the said privilege thereby granted as aforesaid.

3rd Breach. And the plaintiff further says, &c., [*commencement as in the second breach to the* *] did sell and vend divers, to wit, [500 *Machines,*] and divers, to wit, [500 *parts of Machines,*] in breach of the said letters patent, and of the said privilege thereby granted as aforesaid.

4th Breach. And the plaintiff further says, &c., [*commencement as before,*] did make, manufacture, and fabricate, sell, and vend divers, to wit, [500 *Machines,*] and divers, to wit, [500 *parts of Machines,*] which were intended to imitate, counterfeit, and resemble, and which did in fact imitate, counterfeit, and resemble the said invention, and divers, to wit, [*fifty*] parts thereof, in breach of the said letters patent, and of the said privilege thereby granted as aforesaid.

Commencement of a second count upon a different patent.

And whereas also heretofore, and before, and at the time, &c. [*The residue of the count will be the same as in the preceding forms describing the patent as,* certain other letters patent, &c.]

Conclusion.

To the damage of the plaintiff of [£10,000,] and therefore he brings his suit, &c.

IN THE QUEEN'S BENCH [*or* COMMON PLEAS, *or* EXCHEQUER OF PLEAS]. (No. 3.)

THE [*first*] day of [*November*] in the year of our Lord [*one thousand eight hundred and forty-five.*] Commencement of a plea.

[*Smith*] ats. [*Jones.*] } AND the defendant, by [*Richard Roe*] his attorney, [craves oyer of the said Indenture in the declaration mentioned, which is read to the defendant in these words, "This Indenture, &c." (*the deed, or so much of it as may be necessary for the defendant's purpose must be stated,*) which being read and heard, the defendant,] says that, &c. [*Here state the defence intended to be made by the plea.*] Oyer (*t*).

AND for a further plea in this behalf the defendant says that, &c. [*Here state the matter of defence intended to be made by the plea.*] (No. 4.) Commencement of a second plea.

AND, &c., [*commencement as in form No.* 3 *or No.* 4,] says, that her said Majesty [*or* his said late Majesty] did not [*by the said supposed letters patent in the declaration* (*or the said first count*) *mentioned*] give and grant unto the plaintiff, [*or* unto the said *John Harris*,] her [*or* his] said Majesty's especial licence, full power, sole privilege, and authority that he, the plaintiff, [*or* the said *R. T.*,] his executors, administrators, and assigns, or such others as he or they should at any time agree with, and no others, from time to time and at all times thereafter, during the said term of years in the declaration [*or* the said *first* count] mentioned, should, and lawfully might, make, use, exercise, and vend the said supposed invention in the declaration [*or* the said *first* count] mentioned, [and not disclaimed as in the declaration (*or* that count) mentioned,] in manner and form as in the declaration in that behalf alleged. And of this the defendant puts himself upon the country, &c. (No. 5.) Non concessit.

AND, &c. [*commencement as in form No.* 3 *or No.* 4,] says, that her said Majesty [*or* his said late Majesty] did not by her [*or* his] said supposed letters patent in the declaration [*or* the said *first* count] mentioned, make such gift and grant of licence, power, sole privilege and authority as in the declaration [*or* the said *first* count] mentioned, unto the plaintiff, [or the said *John Harris*,] his executors, administrators, and assigns, in manner and form as in the declaration [*or* the said *first* count] in that behalf above alleged. And of this the defendant puts himself upon the country, &c. (No. 6.) The like in a shorter form.

AND, &c. [*commencement as in form No.* 3 *or No.* 4,] says, that the said supposed letters patent in the declaration mentioned were and are (No. 7.) The like by special traverse

(*t*) Vide *ante*, p. 262, respecting oyer of a patent.

after setting out the patent.

certain letters patent in the words and of the tenor following, (that is to say,) Victoria, by the grace of God, of the United Kingdom, &c. [*Here set out the whole of the patent.*] Without this that her said Majesty [*or* his said late Majesty] did, by the said letters patent, give and grant unto the plaintiff, [or the said *John Harris*,] his executors, administrators, and assigns, &c. [*The remainder of the plea may be the same as in either of the last two forms.*]

(No. 8.)

Plea traversing the assignment to a plaintiff.

AND for a further plea in this behalf the defendant says, that the said [*John Harris*] did not assign [*transfer and set over*] the said supposed letters patent in the declaration [*or* in the said *first* count] mentioned, [*and all the liberties, privileges, profits, benefits, and advant'.ges thereby granted,*] unto him the plaintiff; his executors, administrators, and assigns, in manner and form as the plaintiff hath thereof above in the declaration [or the said *first* count] in that behalf alleged. And of this the defendant puts himself upon the country, &c.

(No. 9.)

Patentee not the true and first inventor (*a*).

AND for a further plea in this behalf the defendant says, that the plaintiff [*or* the said *John Harris*] was not the true and first inventor of the said supposed invention in the [*first* count of the] declaration mentioned [and not disclaimed as in the declaration (or the said *first* count) mentioned,] in manner and form as the plaintiff hath above in the declaration [*or* the said *first* count] in that behalf alleged. And of this the defendant puts himself upon the country, &c.

(No. 10.)

Another form (*b*).

AND for a further plea in this behalf the defendant says, that the plaintiff [*or* the said *John Harris*] was not the true and first inventor of the said supposed invention in the [*first* count of the] declaration mentioned, [and not disclaimed as in the declaration (*or* the said *first count*) mentioned,] whereby, and by reason, and means whereof, the said supposed letters patent in the declaration [*or* the said *first* count] mentioned, and the said supposed gift and grant of privilege in the declaration [*or* the said *first* count] alleged to be thereby made, were and are null and void and of none effect. And this the defendant is ready to verify, &c.

(No. 11.)

Invention not such an im-

AND for a further plea in this behalf the defendant says, that the said supposed invention in the declaration [*or* the said *first* count] mentioned,

(*a*) This is the proper form of plea to adopt, when it is alleged in the declaration that the patentee was the true and first inventor. But when the declaration contains no such allegation, the next form of plea must be adopted.

(*b*) When the declaration does not contain any averment that the patentee was the true and first inventor, the proper form of plea is (as here given) to allege that he was not the true and first inventor, and that by reason thereof, the patent is void, concluding with a verification.

[and not disclaimed is in the declaration (or that count) mentioned.] was not an invention of an improvement [*in the construction of steam-engines*] in manner and form as the plaintiff hath above thereof in the declaration [*or* in the said *first* count] in that behalf alleged. And of this the defendant puts himself upon the country, &c.

provement as alleged by the plaintiff (*c*).

(No. 12.)

That the patentee's suggestion respecting the invention being an improvement, is false (*d*).

AND for a further plea in this behalf the defendant says, that before the making of the said supposed letters patent in the declaration [*or* the said *first* count] mentioned, to wit, on the [*third*] day of [*May*] in the year of our Lord, [1844], the plaintiff [*or* the said *John Harris*] by his petition in writing [mentioned in the declaration (*or* the said *first* count) and] recited in the said supposed letters patent, did represent and suggest unto her said Majesty, that the said supposed invention in the declaration [*or* the said *first* count] mentioned [and not disclaimed as in the declaration (*or* that count) mentioned] was an invention of ["*improvements in, &c.*"] And the defendant further says, that her said Majesty, believing and confiding in, and also acting and proceeding upon the said representation and suggestion of the plaintiff, [*or* the said *John Harris*,] and in pursuance and in consideration thereof, did make the said supposed letters patent, and also the said supposed gift and grant of privilege in the declaration [*or* the said *first* count] alleged to have been made by the same supposed letters patent. And the defendant further says, that the said representation and suggestion so made by the plaintiff [*or* the said *John Harris*] to her said Majesty, as aforesaid, was false and untrue, and her said Majesty was thereby misinformed and deceived; and that the said supposed invention [in the declaration (*or first* count) mentioned and not disclaimed as in the declaration (*or* that count) mentioned] was not an invention of ["*improvements in, &c.*"] in manner and form as by the plaintiff [*or* the said *John Harris*] so falsely and untruly represented and suggested unto her said Majesty, as aforesaid, whereby, and by reason and means whereof the said supposed letters patent, and gift and grant of privilege, in the declaration [*or* the said *first* count] mentioned, were and are null, void and of none effect. And this the defendant is ready to verify, &c.

(*c*) When the plaintiff inserts in his declaration any allegation that he had invented improvements of a particular description for which he afterwards obtained a patent, so much of the allegation as relates to the invention being improvements of the description stated may be traversed by a plea in this form.

(*d*) If the declaration does not set out the recital contained in the patent, and if the patent is not set out upon oyer, the suggestion made to the crown will not appear upon the record, unless the defendant alleges it in his plea, and therefore the plea must be substantially in the form here given. In the case of *Morgan* v. *Seaward*, 2 M. & W. 544, the Court of Exchequer intimated an opinion that the ordinary form of plea (see the last form) would be held bad upon special demurrer, and it seems that the ordinary form ought not to be adopted, unless it happens to be a traverse of something actually alleged in the declaration.

(No. 13.)
Plea traversing an allegation in the declaration respecting the utility of the invention (*e*).

AND for a further plea in this behalf the defendant says, that the said supposed invention in the declaration [*or* in the said *first* count] mentioned [and not disclaimed as in the declaration (*or* that count) mentioned] was not [and is not] of great use, benefit, and advantage to the public in manner and form as in the declaration [*or* the said *first* count] in that behalf alleged. And of this the defendant puts himself upon the country, &c.

(No. 14.)
Plea that invention is of no use to the public (*f*).

AND for a further plea in this behalf the defendant says, that the said supposed invention in the declaration [*or* in the said *first* count] mentioned [and not disclaimed as in the declaration (*or* in that count) mentioned] was not at the time of the making of the said supposed letters patent in the declaration [*or* the said *first* count] mentioned, of any use, benefit, or advantage whatsoever to the public, whereby, and by reason and means whereof (*g*) the said supposed letters patent, and the said supposed gift and grant of privilege in the declaration [*or* the said *first* count] alleged to be made by the same supposed letters patent, were and are null and void and of none effect. And this the defendant is ready to verify, &c. (*h*)

(No. 15.)
Plea traversing an allegation in the declaration that the invention was new (*i*).

AND for a further plea in this behalf the defendant says, that the said supposed invention in the declaration [*or* in the said *first* count] mentioned [and not disclaimed as in the declaration (*or* that count) mentioned] was not, at the time of the making of the said supposed letters patent in the declaration [*or* in the said *first* count] mentioned, a new invention as to the public knowledge, use, and exercise thereof, in manner and form as in the declaration [*or* in the said *first* count] in that behalf alleged. And of this the defendant puts himself upon the country, &c.

(*e*) This form has sometimes been adopted when the declaration contained an allegation respecting the great utility of the invention. It is, however, very doubtful whether the plea in this form is not bad, unless indeed it appears upon the face of the declaration, that the patentee made a suggestion to the crown of which the plea would amount to a traverse. And the reason is, that *any* degree of utility is sufficient at law, to make an invention the proper subject of a patent privilege, but if it appears that there was any false suggestion made to the crown respecting the utility, the deceit which has been practised upon the crown will avoid the patent. See Chap. V. s. 3. *ante*, p. 132.

(*f*) This seems to be the proper form of plea in every case in which it is intended to make a defence on the ground that the invention is not of *any* use to the public; and, therefore, not the legal subject of a patent privilege.

(*g*) This allegation is frequently but improperly omitted, and when omitted it is implied.

(*h*) The express or implied allegation of the plea that the patent is void, renders a verification necessary.

(*i*) This form of plea is only proper when it is expressly alleged in the declaration that the invention was new at the date of the patent. If the declaration does not contain such an allegation, the next form of plea ought to be adopted.

(No. 16.) Plea that invention was not new (*f*).

AND for a further plea in this behalf the defendant says, that the said supposed invention in the declaration [*or* the said *first* count] mentioned [and not disclaimed as in the declaration (*or* that count) mentioned] was not, at the time of the making of the said supposed letters patent in the declaration [*or* the said *first* count] mentioned, a new invention as to the public knowledge, use, and exercise thereof, whereby, and by reason, and means whereof the said supposed letters patent, and the said supposed gift and grant of privileges in the declaration [or the said *first* count] alleged to have been made by the same supposed letters patent, were and are null and void and of none effect. And this the defendant is ready to verify, &c. (*k*)

(No. 17.) Plea that invention is not a manufacture (*l*).

AND for a further plea in this behalf the defendant says, that the said supposed invention in the declaration [*or* the said *first* count] mentioned [and not disclaimed as in the declaration (*or* in that count) mentioned] was not an invention of any manner of manufacture whereby, and by reason and means whereof the said supposed letters patent in the declaration [*or* the said *first* count] mentioned, and the said supposed gift and grant of privilege in the declaration [*or* the said *first* count] alleged to have been made by the same supposed letters patent, were and are null and void and of none effect. And this the defendant is ready to verify, &c.

(No. 18.) Plea that the privilege is not a privilege of making any manner of manufacture (*m*).

AND for a further plea in this behalf the defendant says, that the said supposed privilege in the declaration [*or* the said *first* count] mentioned [and not disclaimed as in the declaration (*or* in that count) mentioned] was not and is not a privilege of the sole working or making of any manner of manufacture whereby, and by reason and means whereof the said supposed letters patent, and the said supposed gift and grant of privilege in the declaration [*or* the said *first* count] alleged to have been made by the same supposed letters patent, were and are null and void and of none effect. And this the defendant is ready to verify, &c.

(No. 19.) Plea that the patentee did

AND for a further plea in this behalf the defendant says, that the

(*i*) This is the proper form of plea when the declaration does not contain any allegation that the invention was new at the date or making of the patent.

(*k*) Vide *ante*, p. 668. (*g*) & (*h*).

(*l*) It is usual to raise the question whether an invention is of such a description as can legally be made the subject of a patent privilege, by a plea in the form here given. The next form of plea, however, seems, to be more correct.

(*m*) This seems to be the proper form of plea for raising the defence that the privilege comprised in the patent is not such a privilege as can be granted within the meaning of the exception contained in the stat. 21 Ja. I. c. 3. s. 6. Vide *ante*, c. 5. s. 1. p. 77.

not by his specification describe his invention as alleged in the declaration (*n*).

plaintiff [*or* the said *John Harris*] did not, by the said instrument in writing under his hand and seal, commonly called a specification, and in the declaration [*or* the said *first* count] mentioned, particularly describe and ascertain the nature of the said supposed invention in the declaration [*or* the said *first* count] mentioned, [and not disclaimed as in the declaration (*or* in that count) mentioned,] and in what manner the same invention is to be performed in manner and form as in the declaration [*or* the said *first* count] in that behalf alleged. And of this the defendant puts himself upon the country, &c.

(No. 20.)
Plea that the patentee did not specify his invention, and that the patent is void (*o*).

AND for a further plea in this behalf the defendant says that (*p*) the plaintiff [*or* the said *John Harris*] did not by any instrument in writing under his hand and seal, particularly describe and ascertain the nature of the said supposed invention in the declaration [*or* the said *first* count] mentioned [and not disclaimed as in the declaration (*or* in that count) mentioned], and in what manner the same supposed invention is to be performed, whereby and by reason and means whereof, heretofore and before the commencement of this suit, and also before the committing of the said several supposed grievances in the declaration, [*or* the said *first* count] mentioned and after the expiration of [*six*] calendar months next and immediately after the date of the said supposed letters patent in the declaration [*or* in the said *first* count] mentioned, to wit, on the [*second*] day of [*April*] in the year of our Lord [1841], the said supposed letters patent, and all rights, liberties, privileges, and advantages thereby granted utterly ceased, determined, and became void. And this the defendant is ready to verify, &c.

(No. 21.)
Plea setting out, the specification and traversing the sufficiency of it (*q*).

AND for a further plea in this behalf the defendant says that the said supposed instrument in writing, under the hand and seal of the plaintiff, [*or* of the said *John Harris*,] commonly called a specification in the declaration [*or* in the said *first* count] mentioned, was, and is an instrument in writing [with certain drawings thereunto annexed, and which same instrument in writing was and is (*r*)] in the words, letters, and figures following, (that is to say,) "TO ALL TO WHOM THESE PRESENTS shall come, &c." [*Here set out the whole of the specification*]. And a

(*n*) This is the proper form of plea for merely traversing the sufficiency of the specification as alleged in the declaration.

(*o*) If the declaration should happen to contain no allegation respecting the specification which the defendant can traverse, so as to raise such an issue as desired, he ought to adopt this form, unless he intends to set out the specification in the plea.

(*p*) The declaration generally states (more or less fully) the proviso requiring the specification, but if it is not sufficiently stated in the declaration, and the patent is not set out on oyer, the defendant ought to set it out in this plea.

(*q*) This is the proper form of plea where it is intended to set out the specification, vide *ante*, p. 276.

(*r*) The words between brackets here must be omitted if there are no drawings.

true copy of which said drawings are hereunto annexed (*s*). WITHOUT THIS THAT the plaintiff [*or* the said *John Harris*] did by the said instrument in writing, under his hand and seal, commonly called a specification, and in the declaration [*or* the said *first* count] mentioned, particularly describe and ascertain the nature of the said supposed invention in the declaration [*or* in the said *first* count] mentioned [and not disclaimed as in the declaration (*or* in the said first count) mentioned,] and in what manner the same invention is to be performed in manner and form as the plaintiff hath above in the declaration [*or* the said *first* count] alleged. And of this the defendant puts himself upon the country, &c.

(No. 22.) Plea denying the enrolment of a specification as alleged in the declaration (*t*).

AND for the further plea in this behalf the defendant says that the plaintiff [*or* the said *John Harris*] did not within [*six*] calendar months next and immediately after the date of the said supposed letters patent in the declaration [*or* the said *first* count] mentioned, cause the said supposed instrument in writing, under hand and seal of plaintiff, [*or* the said *John Harris*] commonly called a specification in the declaration [*or* the said *first* count] mentioned, to be enrolled in her said Majesty's High Court of Chancery, in manner and form as the plaintiff hath above in the declaration [*or* the said *first* count] in that behalf alleged. And of this the defendant puts himself upon the country, &c.

(No. 23.) Plea that patentee has not enrolled any sufficient specification (*u*).

AND for a further plea in this behalf the defendant says that the plaintiff [*or* the said *John Harris*] did not within [*six*] calendar months next and immediately after the date of the said supposed letters patent in the declaration [*or* the said *first* count] mentioned, cause any instrument in writing, under the hand and seal of the plaintiff [*or* the said *John Harris*] particularly describing and ascertaining the nature of the said supposed invention in the declaration [*or* the said *first* count] mentioned, [and not disclaimed as in the declaration (*or* in the said *first* count) mentioned,] and in what manner the same supposed invention is to be performed, to be enrolled in her said Majesty's High Court of Chancery, whereby and by reason and means whereof, heretofore, and before the commencement of this suit, and also before the committing of the said several supposed grievances in the declaration [*or* the said *first* count] mentioned, and after the expiration of [*six*] calendar months next and immediately after the date of the supposed letters patent, to wit, on the [*second*] day

(*s*) Leave out these words if there are no drawings. But if there is a drawing, a copy must be annexed to the pleas.

(*t*) This is a proper form of plea for traversing the enrolment of the patentee's specification in the manuer alleged in the declaration. The next form is, however, that which is most beneficial for the defendant, and that which is most generally adopted.

(*u*) The effect of this plea is to show that the patent has become void because the patentee has not *enrolled* any sufficient specification. This is the form of plea usually adopted for traversing the *enrolment* of a specification.

of [*November*] in the year of our Lord [1842], the said supposed letters patent, and the said supposed licence, power, privilege, and authority in the declaration [*or* the said *first* count] mentioned, and all other rights, liberties, privileges, and advantages whatsoever granted by the same supposed letters patent, utterly ceased, determined, and became void. And this the defendant is ready to verify, &c.

(No. 24.)
Not guilty.

AND for a further plea in this behalf the defendant says, that he is not guilty of the said supposed grievances in the declaration [*or* the said *first* count] above laid to his charge, or any, or either of them, or any part thereof, in manner and form as the plaintiff hath thereof above in the declaration [*or* the said *first* count] complained against him, this defendant. And of this the defendant puts himself upon the country, &c.

IN THE QUEEN'S BENCH, [COMMON PLEAS, OR EXCHEQUER OF PLEAS.]

The [*tenth*] day of [*April,*] in the year of our Lord, [1844

REPLICATIONS.

[*Jones*] v. [*Smith.*]

(No. 25.)
Commencement.

AND the plaintiff as to the plea of the defendant by him [*firstly*] above pleaded;—and whereof he hath put himself upon the country, doth the like, [*or* saith that, *here state the matter of the replication.*]

Similiter.

(See 26.)
Commencement of second replication.

AND as to the plea of the defendant by him [*secondly*] above pleaded;—and whereof he hath put himself upon the country, the plaintiff doth the like, [*or* says that, *here state the matter of the replication.*]

(No. 27.)
Replication to a plea alleging that the patentee was not the true and first inventor (*x*).

AND as to the plea of the defendant by him [*secondly*] above pleaded, the plaintiff says that he the plaintiff, [*or* the said *John Harris,*] was at the time of the making of the said letters patent in the declaration [*or* the said *first* count] mentioned, the true and first inventor of the said invention in the declaration [*or* the said *first* count] mentioned, [and not disclaimed as in the declaration (*or* in the said *first* count) mentioned.] And this the plaintiff prays may be enquired of by the country, &c.

(No. 29.)
Replication to plea alleging that the patentee made a false suggestion to the Crown (*y*).

AND as to the plea of the defendant by him [*fourthly*] above pleaded, the plaintiff says that the said representation and suggestion so made to her said Majesty by the plaintiff, [*or* the said *John Harris,*] as in the said [*fourth*] plea mentioned, was not false and untrue, and her said Majesty was not thereby misinformed and deceived in manner and form as in the said [*fourth*] plea alleged. And this the plaintiff prays may be enquired of by the country, &c.

(*x*) See the Form of Plea, *ante*, p. 666, No. 10.
(*y*) See the Form of Plea, *ante*, p. 667, No. 12.

AND as to the plea of the defendant by him [*secondly*] above pleaded, the plaintiff says, that the said invention in the declaration, [*or* in the said *first* count] mentioned, [and not disclaimed as in the declaration (*or* the said *first* count) mentioned,] was, at the time of the making of the said letters patent in the declaration [*or* the said *first* count] mentioned, of use, benefit, and advantage to the public. And this the plaintiff prays may be enquired of by the country, &c. (No. 29.) Replication to a plea alleging that the invention is of no use and the patent void (*z*).

AND as to the plea of the defendant by him [*thirdly*] above pleaded, the plaintiff says, that the said invention in the declaration [*or* in the said *first* count] mentioned, [and not disclaimed as in the declaration (*or* the said *first* count) mentioned,] was, at the time of the making of the said letters patent in the declaration [*or* in the said *first* count] mentioned, a new invention as to the public knowledge, use, and exercise thereof. And this the plaintiff prays may be enquired of by the country, &c. (No. 30.) Replication to a plea alleging that the invention was not new and the patent void (*a*).

AND as to the plea of the defendant by him [*thirdly*] above pleaded, the plaintiff says, that the said invention in the declaration [*or* in the said *second* count] mentioned, [and not disclaimed as in the declaration (*or* that count) mentioned,] was an invention of a certain manner of manufacture, to wit, of the manufacture in the declaration [*or* in the said *second* count] mentioned. And this the plaintiff prays may be enquired of by the country, &c. (No. 31.) Replication to a plea alleging that the invention is not any manner of manufacture, and the patent therefore void (*b*).

AND as to the plea of the defendant by him [*secondly*] above pleaded, the plaintiff says, that the said invention in the declaration [*or* in the said *first* count] mentioned, [and not disclaimed as in the declaration (or the said *first* count) mentioned,] was an invention of a certain manner of manufacture, to wit, of the manufacture mentioned in the declaration, [*or* in the said *first* count,] and described by the said instrument in writing, under the hand and seal of the plaintiff, [*or* the said *John Harris*,] as in the declaration [*or* the said *first* count] also mentioned. WITHOUT THIS THAT the said invention was not an invention of any manner of manufacture whereby, and by reason and means whereof the said letters patent in the declaration [*or* the said *first* count] mentioned, were and are null, void, and of none effect in manner and form as in the said [*second*] plea in that behalf above alleged. And this the plaintiff prays may be enquired of by the country, &c. (No. 32.) Special traverse to a similar plea (*c*).

(*z*) See the Form of Plea, *ante*, p. 668, No. 14.

(*a*) See the Form of Plea, *ante*, p. 669, No. 16.

(*b*) *Ibid*, No. 17.

(*c*) See the Form of Plea, *ante*, p. 669, No. 17. This form has occasionally been used, but it is doubtful whether a special traverse is applicable. See the last form.

(No. 33.) Replication to a plea alleging that the privilege is not for making any manner of manufacture (*d*).

AND as to the plea of the defendant by him [*fourthly*] above pleaded, the plaintiff says, that the said privilege in the declaration [*or first* count] mentioned, [and not disclaimed as in the declaration (*or first* count) mentioned,] was and is a privilege of the sole working or making of a certain manner of manufacture, to wit, of the manufacture in the declaration [*or* in the said *first* count] mentioned. And this the plaintiff prays may be enquired of by the country, &c.

(No. 34.) Replication to plea alleging the want of *any* specification (*e*).

AND as to the plea of the defendant by him [*eighthly*] above pleaded, the plaintiff says, that he the plaintiff [*or* the said *John Harris*,] did, by a certain instrument in writing, under his hand and seal, to wit, the said instrument in writing under his hand and seal in the declaration mentioned, particularly describe and ascertain the nature of the said invention in the declaration [*or* in the said *third* count] mentioned, [and not disclaimed as in the declaration [*or* that count] mentioned,] and in what manner the same invention is to be performed. And this the plaintiff prays may be enquired of by the country, &c.

(No. 35.) Replication to a plea that patentee did not enrol any specification (*f*).

AND as to the plea of the defendant by him [*seventhly*] above pleaded, the plaintiff says that he the plaintiff [*or* the said *John Harris*,] did within [*six*] calendar months next and immediately after the date of the said letters patent in the declaration [*or* the said *first* count] mentioned, to wit, on the [*eighth*] day of [*October*,] in the year of our Lord, [1844,] by the said instrument in writing under his hand and seal in the declaration [*or* the said *first* count] mentioned, particularly describe and ascertain the nature of his said invention in the declaration [*or* the said *first* count] mentioned, [and not disclaimed as in the declaration (*or* in that count) mentioned,] and in what manner the same invention is to be performed. And did also afterwards and within [*six*] calendar months next and immediately after the date of the said letters patent, (to wit,) on the [*ninth*] day of [*October*,] in the year of our Lord, [1844,] [*or* on the day and year last aforesaid,] cause the said instrument, in writing, to be duly enrolled in her Majesty's High Court of Chancery at Westminster, in manner and form as in the declaration in that behalf above alleged. And this the plaintiff is ready to verify, &c.

(No. 36.) Rejoinder.

The [*first*] day of [*May*,] in the year of our Lord, [1844.]

[*Smith*] ats. [*Jones.*] } AND the defendant as to the replication of the plaintiff to the plea of the defendant by him [*fourthly*] above pleaded, and which the plaintiff hath prayed may be enquired of by the country, doth the like.

(*d*) See the Form of Plea, *ante*, p. 669, No. 18.

(*e*) See the Form of Plea, *ante*, p. 669, No. 19.

(*f*) See the Form of Plea, *ante*, p. 671, No. 23.

AND as to the replication of the plaintiff to the plea of the defendant by him [*sixthly*] above pleaded, and which the plaintiff hath prayed may be enquired of by the country, the defendant doth the like. (No. 37.) The like.

IN THE QUEEN'S BENCH, [COMMON PLEAS, OR EXCHEQUER OF PLEAS.] (No. 38.) Notice of objections.

Between [*Bryan Donkin,*] plaintiff,
and
[*Robert Anderson,*] defendant.

IN pursuance of the statute in such case made and provided, I hereby give you notice of certain objections upon which the defendant means to rely at the trial of this action. And that at the same trial the defendant, besides denying that her Majesty made any such letters patent, gift, grant, or privilege as in the declaration mentioned, and also denying that he has infringed the said supposed letters patent, or committed any of the supposed grievances in the declaration mentioned; will make and insist upon the several objections, matters, and things hereinafter respectively stated or mentioned:—And will object, contend, and insist,

That, &c. [*Here the several objections must be stated according to the circumstances of the case, after which add the following conclusion.*]

And that the defendant will also make and insist upon such other defences, and matters of defences, (other than objections to the said letters patent,) as respectively are, or shall, or may be mentioned or referred to in, or as, are, or shall, or may be admissible under all, or any one or more of the several pleas of the defendant in this action. Dated this [*first*] day of [*November,*] one thousand eight hundred and [*forty four.*]

To
Mr. [*W. H.*]
The plaintiff's attorney.

Yours, &c.
[*A. B.*]
Defendant's attorney.

[*Commencement and conclusion as in the last form.*]

(No. 39.) Various Forms of objections.

That the writ of Privy Seal, or warrant of our Lady the Queen, upon or by virtue of which, the Lord High Chancellor caused to be made the said supposed letters patent, was delivered to the said Lord High Chancellor in Chancery on the [*nineteenth*] day of [*January,*] in the year of our Lord [*one thousand eight hundred and forty-four,*] and was entered of record in Chancery of the said day of the said delivery thereof to the said Chancellor. That the said Chancellor caused letters patent to be made upon the said writ or warrant, dated the [*twenty-first*] day of [*April,*] which was in the [*first*] year of the reign of her said Majesty, and long before the day of the said delivery of the said writ or warrant as aforesaid, contrary to the form of the statute in such case made and provided. By reason whereof the said supposed letters patent are void.

That the said supposed letters patent are void by reason of the petition of the plaintiff, [*or* of *A. B.*,] recited in the same letters patent, or by reason of the recital of the said petition in the same letters patent being false in the several particulars respectively mentioned in this notice, or some of them.

That the plaintiff, [*or* the said *A. B.*,] did not invent the said supposed invention in the said supposed letters patent mentioned.

That the said supposed invention was not communicated to the plaintiff, [*or* the said *A. B.*,] by a foreigner resident abroad.

That the plaintiff, [*or* the said *A. B.*,] was not at the time of the making of the said supposed letters patent the true and first inventor of the said supposed invention.

That the said supposed invention was not invented or found out by the plaintiff, [*or* the said *A. B.*]

That the said supposed invention was not an invention of improvements in, &c. [*Here use the other words of the title or such of them as with the word improvements form the false representation.*]

That the said supposed invention was not applicable, &c. [*Here use such of the words of the title as may be necessary to show the false representation, as* "in the manufacture of Ribbons."]

That the said privilege was not a privilege of working or making any manner of manufacture.

That the said supposed invention was not an invention of any manner of manufacture.

That the said supposed invention was not at the time of the making of the said supposed letters patent an invention of a new manufacture.

That the said supposed invention was not at the time of the making of the said supposed letters patent a new invention as to the public knowledge, use, and exercise thereof.

That the said supposed invention at the time of the making of the said supposed letters patent was of no use, benefit, or advantage to the public.

That the said supposed invention was and is so trifling, worthless, or immaterial, that it was not, and is not proper or sufficient to be made the subject of such a gift or grant of privilege as in the declaration mentioned.

That the plaintiff, [*or* the said *A. B.*,] did not by the said specification or instrument in writing under his hand and seal in the declaration mentioned, particularly and sufficiently describe and ascertain the nature of the said supposed invention, and in what manner the same supposed invention was and is to be performed.

That the plaintiff, [*or* the said *A. B.*,] did not by the said specification sufficiently distinguish and point out which of the [*machinery parts and things*] therein mentioned, he claimed to have invented, and which of the said [*machinery parts and things*,] he did not claim to have invented or admitted to be old.

That the plaintiff, [*or* the said *A. B.*,] has not, in pursuance of the proviso or condition in that behalf contained in the said supposed letters patent, caused any specification or instrument in writing under the hand

and seal of the plaintiff, [*or* the said *A. B.*,] particularly and sufficiently describing and ascertaining the nature of the said supposed invention, and in what manner the same was and is to be performed, to be duly enrolled in Chancery.

CERTIFICATES.

(No. 40.) Certificate that action was brought to try a right (*g*).

I hereby certify, that this action was really brought to try a right besides the mere right to recover damages for the grievances for which the action has been brought. Dated this [*fifth*] day of [*December*, 1845.]

(Signed) [*Denman.*]

(No. 41.) Certificate under 5 & 6 W. IV. c. 83, s. 3, that validity of patent came in question (*h*).

I hereby certify, that the validity of the within-mentioned letters patent came in question before me at the trial of this action. Dated this [*nineteenth*] day of [*December*, 1845.]

(Signed) [*N. C. Tindal.*]

(No. 42.) The two last forms in one (*i*).

I hereby certify, that this action was really brought to try a right, besides the mere right to recover damages for the grievances for which the action has been brought. And that the validity of the within-mentioned letters patent came in question before me at the trial of this action. Dated this [*eleventh*] day of [*July*, 1845.]

(Signed) [*F. Pollock.*]

(No. 43.) Certificate that record in former action was given in evidence (*k*).

I hereby certify, that the record in a certain action wherein [*A. B.*] was plaintiff and [*C. D.*] was defendant, and also the certificate of the Right Honorable [*Lord Denman,*] Chief Justice of our Lady the Queen, thereon indorsed and bearing date the [*first*] day of [*July*, 1842] was this day given in evidence at the trial of this action, between the within-named parties before me. Dated this [*twentieth*] day of [*May*, 1845.]

(Signed) [*J. Parke.*]

(No. 44.) Certificate that plaintiff ought only to have ordinary costs (*l*).

I hereby certify, that the plaintiff in this action ought not to have [treble costs, or] any more or other costs than the usual costs taxed as between party and party. Dated this [*third*] day of [*December*, 1845.]

(Signed) [*Denman.*]

(*g*) This certificate must, under the stat. 3 & 4 Vict. c. 24, s. 1, be applied for immediately after the conclusion of the trial, for unless then obtained, the judge has no power to grant it afterwards. It must be indorsed on the back of the *nisi prius* record. Vide *ante*, p. 298.

(*h*) This certificate must be indorsed on the *nisi prius* record. Vide *ante*, p. 300.

(*i*) This will be found to be the form of certificate most generally useful, for a judge will rarely grant a certificate under one of the statutes and refuse it under the other.

(*k*) The statute 5 & 6 W. IV. c. 83, s. 3, does not expressly require such a certificate as this, but without such a certificate there would be nothing to show that the record and certificate in the former action had been given in evidence so as to entitle the plaintiff to full costs. Vide *ante*, p. 300.

(*l*) This form of certificate is framed under the 5 & 6 W. IV. c. 83, sec. 3, as altered by the 5 & 6 Vict. c. 97, s. 1. By the first-mentioned enactment, a

(No. 45.) Certificate that defendant has proved certain objections but failed in proving the others (*m*).

I hereby certify, that the defendant proved at the trial of this action before the (*second, fourth, seventh, and eighth,*) objections mentioned in his notice, and that he failed in proving the other objections mentioned in the said notice. Dated this [*eighth*] day of [*December*, 1845.]

(Signed) [*J. Patteson.*]

SECTION V.

Forms of Proceedings in Suits in Chancery, to restrain Infringements of Patents, and for Accounts of Profits lost by means of such Infringements.

(No. 1.) Bill in Chancery to restrain the infringement of a patent, and for an account of profits made by the infringement (*n*).

IN CHANCERY.

Master of the Rolls,
[or Vice Chancellor of Eng d,
——————— *Knight Bruce*,
or ——————— *Wigram*.]

To the Right Honorable [*John Singleton, Baron Lyndhurst, of Lyndhurst, in the County of Southampton,*] Lord High Chancellor of Great Britain.

Humbly complaining, sheweth unto your Lordship, your orators [*John Brown, of Nottingham, Lace Manufacturer, and Thomas Black, of the same place, Lace Manufacturer.*] That before the making of the letters patent hereinafter mentioned, your orators [*or A. B. of, &c., and C. D. of &c.*] had invented [*improvements in the manufacture of Lace,*] which your orators [*or the said A. B. and C. D.*] then believed, and still believe to be, of great public utility. That your orators [*or the said A. B. and C. D.*] were the true and first inventors thereof, and the same invention had not before or at the time of the making of the said letters patent been publicly known, made, or used, by any other person or persons whomsoever, within this realm, [*or was at the time of the making of the said letters patent a new invention, as to the public knowledge and use thereof within this realm.*] That by letters patent under the Great Seal of the United Kingdom of Great Britain and Ireland, bearing date at Westminster, the [*twenty-first*] day of [*June,*] in the [*third*] year of the reign of her present Majesty. After reciting that your orators [*or the said A. B. and C. D.*] had, by their petition, humbly represented unto her said Majesty, (as the fact was,) that they had invented (*o*) ["*improvements in the manufacture of Lace*"] which

judge trying a second action respecting a patent is enabled to certify that the plaintiff ought not to have treble costs. But the Act secondly mentioned takes away treble costs, and gives instead "full and reasonable indemnity as to all costs, charges, and expenses, incurred in or about any action, suit, &c." Vide *ante*, 300, 304.

(*m*) Under 5 & 6 W. IV. c 83, s. 6.

(*n*) Vide *ante*, p. 309.

(*o*) This allegation must state the recital as it is contained in the patent.

they believed to be of great public utility, that they were the first and true inventors thereof, and that the same invention had not been made or used by any other person or persons whomsoever, to their knowledge or belief, and that the petitioners therefore most humbly prayed that her said Majesty would be graciously pleased to grant unto them, their executors, administrators, and assigns, her said Majesty's letters patent, under the Great Seal of the said United Kingdom, for the sole use, benefit, and advantage, of their said invention, within that part of the said United Kingdom called England, the dominion of Wales, and town of Berwick upon Tweed, [and the islands of Jersey, Guernsey, Alderney, Sark, and Man, and also all her said Majesty's Colonies and Plantations abroad] for the term of fourteen years, pursuant to the statute in such case made and provided, and that her said Majesty being willing to give encouragement to all arts and inventions which might be for the public good, was graciously pleased to condescend to the petitioner's request,] her said Majesty did by her said letters patent [of her especial grace, certain knowledge, and mere motion,] for herself, her heirs, and successors, give and grant unto your orators, their executors, administrators, and assigns, her said Majesty's especial licence, sole privilege, and authority, that your orators, [*or* the said *A. B. and C. D.*] their executors, administrators, and assigns, and every of them, by themselves or by their deputy or deputies, servants, or agents, or such others as your orators, [*or* the said *A. B. and C. D.*] their executors, administrators, or assigns, should at any time agree with and no others, from time to time and at all times thereafter, during the term of years therein expressed, should, and lawfully might make, use, exercise, and vend, their said invention within England, Wales, and Berwick upon Tweed, [and the islands of Jersey, Guernsey, Alderney, Sark, and Man, and also all her said Majesty's Colonies and Plantations abroad] in such manner as to your orators, [*or* the said *A. B. and C. D.*,] their executors, administrators, and assigns, or any of them, should in their or any of their discretions seem meet. And that your orators should and lawfully might have and enjoy the whole profit, benefit, commodity, and advantage from time to time, coming growing, accruing, and arising by reason of the said invention, for and during the term of years therein mentioned. To have, hold, exercise and enjoy the said licence, powers, privileges and advantages, thereinbefore granted or mentioned to be granted unto your orators, [*or* the said *A. B. and C. D.*,] their executors, administrators, and assigns for and during, and unto the full end and term of fourteen years from the date of the said letters patent, then next and immediately ensuing, and fully to be complete and ended according to the statute in such case made and provided. And to the end that your orators, [*or* the said *A. B. and C. D.*,] their executors, administrators, and assigns, and every of them might have and enjoy the full benefit, and the sole use and exercise of the said invention, according to her said Majesty's gracious intention thereinbefore declared, her said Majesty did by the said letters patent for herself, her heirs, and successors, require and strictly command all and

every person and persons, bodies politic and corporate, and all other her subjects whatsoever of what estate, quality, degree, name or condition soever they be within England, Wales, [the islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all her said Majesty's Colonies and Plantations abroad] that neither they nor any of them at any time during the continuance of the said term of fourteen years, thereby granted either directly or indirectly, do make, use, or put in practice the said invention or any part of the same so attained unto by your orators, [*or* the said *A. B. and C. D.*,] as aforesaid, nor in anywise counterfeit, imitate, or resemble the same, nor should make or cause to be made any addition, thereunto or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, devisor or devisors thereof, without the consent, licence, or agreement of your orators, [*or* the said *A. B. and C. D.*,] their executors, administrators, or assigns in writing under their hands and seals first had and obtained in that behalf. And in which said letters patent was contained amongst other things, a condition or proviso whereby it was declared, that if your orators, [*or* the said *A. B. and C. D.*,] or the one of them, should not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed by an instrument in writing under the hands and seals of your orators, [*or* of the said *A. B. and C. D.*,] or the hand and seal of the one of them, and cause the same to be enrolled in her said Majesty's High Court of Chancery within [*six*] calendar months next, and immediately after the date of the said letters patent, then the said letters patent and all liberties and advantages whatsoever thereby granted, should utterly cease, determine and become void, any thing thereinbefore contained to the contrary thereof in anywise notwithstanding, as by the said letters patent, and the enrolment thereof (now remaining of record in this honourable Court) when produced, will more fully and at large appear; and for greater certainty as to the language, contents, purport, and effect of the said letters patent, your orators crave leave to refer thereto, or to the said enrolment thereof, or to such copy or copies of the same letters patent, and enrolment respectively, as can be received in evidence when the same are respectively produced to this honourable Court, and to the same extent as if the same letters patent had been herein set forth fully and verbatim. [*If brevity is desirable the patent grant may be stated thus*,] her said Majesty did by her said letters patent give and grant the sole privilege of using exercising and vending the said invention within England, Wales, and Berwick upon Tweed [and in the islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all her Majesty's Colonies and Plantations abroad] and the whole profit, benefit and advantage of the said invention unto your orators, [*or* the said *A. B. and C. D.*,] their executors, administrators, and assigns for and during the term of fourteen years, then next ensuing, subject [amongst other things] to a proviso that if your orators [*or* the said *A. B. and C. D.*,] or the one of them should not particularly describe and ascertain the nature of the said invention, and in what

manner the same is to be performed by an instrument in writing under the hands and seals of your orators, [*or* the said *A. B. and C. D.*,] or the hand and seal of the one of them, and cause the same to be enrolled in Chancery within [*six*] calendar months next after the date of the said letters patent, then the said letters patent and all liberties and advantages thereby granted should cease, determine and become void, as by the said letters patent, and the enrolment thereof, &c.] And your orators further show that in compliance with the said [last-mentioned] proviso, your orators [*or* the said *A. B. and C. D.*,] did by a specification or instrument in writing under the hands and seals of your orators, [or of the said *A. B. and C. D.*, or under the hand and seal of the said *J. B. or C. D., as the case may be*] dated the [*twenty-first*] day of [*December*,] A. D., [1839,] particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, and did also cause the said specification or instrument in writing to be enrolled in the said High Court of Chancery on the said [*twenty-first*] day of [*December*,] A. D., [1839,] and within [*six*] calendar months next, [and immediately] after the date of the said letters patent, [(*p*), and in which said specification or instrument in writing the said invention is described and ascertained in and by the [drawing *or* drawings therein mentioned or contained, and the] words, letters and figures following, (that is to say,) ["Now know ye that in compliance, &c." [*Here insert the description of the invention contained in the specification from those words down to the end verbatim.*] And a true copy of which said drawing (*or* drawings) is (*or* are) hereunto annexed] as by the said specification or instrument in writing, and the enrolment thereof now remaining of record in this honourable Court, when produced will more fully and at large appear, and for greater certainty as to the words, letters and figures, purport and effect of the said specification or instrument in writing, and the said enrolment thereof, your orators crave leave to refer to the said specification, and the enrolment thereof, and to such copy or copies of the same specification or instrument in writing and enrolment, respectively, as can or may be received in evidence, and to the same extent as if the same specification or instrument in writing and enrolment had been herein set out fully and verbatim. And your orators further show that by a disclaimer and memorandum of alteration under the hands and seals of your orators, [*or* of the said *A. B. and C. D.*,] bearing date the [*ninth*] day of [*August*,] A. D., [1841,] your orators, [*or* the said *A. B. and C. D.*,] did disclaim, &c., [*here set out the disclaimer*,] and your orators [*or* the said *A. B. and C. D.*,] did alter, &c. [*Here in like manner state the alteration.*] And your orators further show that your orators, [*or* the said *A. B. and C. D.*,] having first obtained the leave of Sir [*William Webb Follett*,] Knight, her said Majesty's Solicitor-general certified by his

(*p*) It is not necessary to set out the specification, but it is generally advisable to do so, particularly if the specification is not long. Vide *ante*, p. 309.

fiat, dated the [*seventh*] day of [*August*,] A. D., [1841,] and his signature to the said *fiat*, did afterwards, that is to say, on the [*tenth*] day of [*August*,] A. D., [1841,] enter the said disclaimer and memorandum of alteration with the clerk of the patents of England, and the same disclaimer and memorandum of alteration, was then filed by the said clerk of the patents, and was also enrolled with the said specification in this honourable Court, as by the said disclaimer and memorandum of alteration, and entry thereof and also the said *fiat* now remaining in the custody of the said clerk of the patents, and by the enrolment of the said disclaimer and memorandum of alteration now remaining of record in this honourable Court, when produced, will more fully and at large appear, and for greater certainty as to the words, letters and figures, purport and effect of the said disclaimer and memorandum of alteration, and the said *fiat* and the said entry, and enrolment thereof respectively, your orators crave leave to refer to the said disclaimer and memorandum of alteration, and *fiat* respectively, and the said entry and enrolment respectively, and to such copy or copies thereof respectively, as can or may be received in evidence, and to the same extent as if the same respectively had been herein set out fully and verbatim. And your orators further show that the said disclaimer and memorandum of alteration were not, nor was either of them or any part thereof, such disclaimer and memorandum of alteration, disclaimer or memorandum of alteration, as could or should extend the exclusive right granted by the said letters patent, and that the said disclaimer and memorandum having by and with such leave as aforesaid, certified as aforesaid been so entered, filed and enrolled as aforesaid, the same disclaimer and memorandum thereupon and by virtue of the statute in such case made and provided, respectively became and were, and were respectively from thenceforth to be deemed and taken to be part of the said letters patent, and specification respectively in all Courts whatsoever, [And your orators further show that by an indenture of assignment dated the [14*th*] day of [*March*,] A. D., [1843,] and made or expressed to be made between the said [*A. B. and C. D.*,] of the one part, and your orators of the other part, for the consideration therein expressed, the said especial licence, privileges, profits, benefits and advantages, granted by the said letters patent, and also the said letters patent were assigned unto your orators, their executors, administrators, and assigns, for all the then residue of the said term of fourteen years, granted by the said letters patent, and all other the term and interest of them the said [*A. B. and C. D.*,] therein as by the said indenture of assignment, when produced, will more fully and at large, appear, and for greater certainty as to the language, words, purport, and effect, of the same indenture, your orators crave leave to refer to the same indenture, and to such copy or copies thereof as can or may be received in evidence, and to the same extent as if the same indenture had been herein set forth, fully and verbatim.] And your orators further show unto your Lordship, that after the making of the said letters patent, and from thence [until the making of the said indenture of assign-

ment, the [said *A. B. and C. D.*] by themselves or their agents, worked, used, exercised, and put in practice the said invention, and that after the making of the said indenture of assignment, and from thence] until the present time, your orators [by themselves or their agents] have worked, used, exercised, and put in practice, the said invention, and vended and sold divers articles and things made according to the same invention, and your orators have thereby made considerable profits; and your orators expected that they should have continued in the uninterrupted enjoyment of the said patent rights and privileges, and of the profits, benefits, and emoluments, derivable therefrom, during the residue of the said term of fourteen years. BUT NOW SO IT IS, may it please your Lordship that [*John Dobson, of Foyle Street, Derby, in the County of Derby, Lace Maker*] defendant, hereto combining and confederating with divers other persons, at present to your orators unknown, to defeat your orators' said patent rights and privileges; and to injure and prejudice your orators in the exercise of their said patent rights and privileges, and to hinder and prevent them from having and receiving the profits, emoluments, benefits, and advantages, which they might, and otherwise, and but for the misconduct of the defendant, and the committing of the grievances and injuries by the said defendant, hereinafter named, your orators would have made by the exercising of their said patent rights and privileges; and also otherwise to injure your orators; after the making of the said letters patent [and after the making of the said indenture of assignment] within the said term of fourteen years, granted by the said letters patent, and within that part of the said United Kingdom, called England, wrongfully and injuriously, and without the leave, licence, consent, or agreement of your orators [or of the said *A. B. and C. D.*] on divers days and times since the making of the said letters patent [and indenture of assignment respectively] (that is to say) on [or since] the [31*st*] day of [*March*] A. D. [1843] and on divers days and times thereafter and continually until and up to the present time, has worked, used, exercised, and put in practice, and is now working, using, exercising, and putting in practice the said invention, and has made, manufactured, and fabricated, and still, and now is making, manufacturing, and fabricating, large numbers and quantities of [*here describe the various articles made by the defendant*] according to, and by means of the said invention, and also large numbers and quantities of [*here again mention the articles made by the defendant*] which were and are intended to counterfeit, imitate, or resemble, or which do, in fact, counterfeit, imitate, or resemble the said invention, and also [*here again mention the names of the articles*] made according to, or by means of the said invention, in breach of the said letters patent, and the said sole privilege so granted thereby as aforesaid. And your orators further show that the said defendant wrongfully and injuriously, and without any such leave, licence, consent, or agreement, as aforesaid, and in breach of the said letters patent, and against the said sole privilege so granted thereby as aforesaid, hath also vended, and sold, and still and now is vending and selling large quantities and numbers of the said several [*again mention*

the names of the several articles] so made, manufactured, and fabricated as aforesaid, and by means of such working, using, exercising, and putting in practice the said invention, and by making, manufacturing, fabricating, vending, and selling the said several [*again mention the names of the several articles*] the said defendant has made and still is making great gains and profits; and the defendant, by the means aforesaid, and otherwise, has greatly injured, and still is greatly injuring your orators, and hath deprived, and still is depriving your orators of, and hath prevented and still is preventing your orators from making, obtaining, and receiving divers great gains and profits, which your orators otherwise, and but for the said wrongful acts of the said defendant would have made, obtained, and received: And your orators charge that they your orators [*or* the said *A. B. and C. D.*] were the true and first inventors of the said invention, and that at the respective times of such discovery, and of their application for, and also of the making of the said letters patent, the said invention was new as to the public knowledge and use thereof in this realm, and was then, and is now, highly useful and beneficial to the public. And your orators further show to your Lordship that the said defendant sometimes pretends that the said letters patent at the time of the making thereof, and the said grant of privilege thereby made, were, and still are, null and void, whereas your orators' charge that the said letters patent and grant of privilege were and still are, good, valid, and sufficient in law. And the said defendant also sometimes pretends that the said several [*here mention the various articles as before*] so made, manufactured, fabricated, vended, and sold by the defendant as aforesaid, were entirely different from articles made or manufactured according to, or by means of the said invention; whereas, your orators charge the contrary to be true, and that the several [*here again mention the various articles*] so made, manufactured, fabricated, vended, and sold by the defendant, as aforesaid, were so made, manufactured, fabricated, vended, and sold in violation of your orators' said patent rights and privileges, and that the said defendant did thereby infringe and evade, and that he is still infringing and evading your orators' said patent rights and privileges; and although your orators have by themselves, their solicitors, and agents, frequently applied to the said defendant to desist from such proceedings as aforesaid, and to account with your orators for the profits which he has made thereby, yet the said defendant wholly refuses so to do: And your orators further charge that by divers other ways and means, at present unknown to your orators, the said defendant has been, and is infringing and evading your orators' said patent rights and privileges: And your orators further charge that by all and every of the acts, ways, means, infringements, and evasions, aforesaid, your orators have sustained, and are still sustaining heavy loss and injury: And your orators further charge that the said defendant ought to discover and set forth a full, true, and particular list, schedule, account, and history of all and every of the aforesaid various ways, means, infringements, and evasions aforesaid, and particularly of all and every of the various [*here again mention the various articles as before*] articles and

things by, for, or on the behalf of the said defendant, directly or indirectly made, manufactured, fabricated, counterfeited, imitated, vended, and sold, in breach of the said letters patent, or against the said sole privilege so granted thereby, as aforesaid, and also of all and every of the monies, gains and profits by the defendant directly or indirectly, made, received, or obtained by such making, manufacturing, fabricating, vending, selling, counterfeiting, imitating, resembling, vending, and selling, as aforesaid, and by all and every or any of the infringements, evasions, ways, means, matters, and things hereinbefore mentioned, particularly specifying all and every of the full particulars relating to all and every of the matters and things aforesaid. And your orators further charge that the said defendant ought to be restrained by the order and injunction of this Honourable Court from working, using, exercising, and putting in practice the said invention, and from making, manufacturing, fabricating, vending, and selling such [*enumerate the articles as before*] articles and things as aforesaid; and from counterfeiting, imitating, and resembling the said invention, and from adding to, and subtracting from the said invention, and also from violating, infringing, or evading your orators' patent rights and privileges, or any of them, in anywise howsoever. And that the said defendant ought also to be compelled to render an account of all and every of the aforesaid various [*enumerate the articles*] articles and things made, manufactured, fabricated, vended, and sold by the said defendant from and after the making of the said indenture of assignment up to the present time, and of all and every of the monies, gains, and profits by the said defendant directly or indirectly made, received, or obtained thereby. And your orators further charge that the said defendant has now, or lately had, in his possession, custody, or power, divers books, accounts, letters, papers, documents, and writings, wherefrom such accounts as aforesaid may be obtained, and whereby, if produced, the truth of the matters aforesaid, or of some of them, will appear, and that the said defendant ought to discover and produce the same, and deposit the same with his Clerk in Court or otherwise, for the purpose of this suit, and your orators further charge that your orators did not until the [*thirty-first*] day of [*October*] now last past, obtain or receive any conclusive or certain evidence or information of the said conduct of the said defendant, or of his infringement of your orators' said patent rights and privileges, since which said last-mentioned time your orators have used due diligence in bringing the matters hereinbefore mentioned to the cognizance of this Honourable Court. And your orators although greatly injured, can have relief in a Court of Equity alone.

TO THE END THEREFORE, that the said defendant may, if he can, show [illegible] your orators should not have the relief hereby prayed, and may, upon [illegible] corporal oath, and according to the best and utmost of his knowledge, remembrance, information, and belief, full, true, direct, and perfect answer make to such of the several interrogatories hereinafter numbered and set forth, as by the note hereunder written, he is required to answer, (that is to say),

1. Whether before and at the time before, or at the time of the making of the said letters patent, or some other and what letters patent, or before, or at some other, and what time, your orators, [*or the said A. B. and C. D.,*] had not invented the said [*improvements in the manufacture of Lace,*] or some other, and what [*improvement or improvements in the manufacture of Lace,*] and if not, how is the contrary made out or how otherwise, and who invented the said improvements.

2. Whether the said invention, or some, and what part or parts thereof was not, or were not, at the time of the making of the said letters patent, or some other, and what letters patent, or at some other and what time of great or some, and what public utility, and if not, how is the contrary made out, or how otherwise.

3. Whether your orators, [*or the said A. B. and C. D.,*] were not at the time of the making of the said letters patent, or some other, and what letters patent, or at some other, and what time the true and first, true or first inventors within this realm, of the said [*improvements in the manufacture of Lace,*] or of some other, and what [*improvements or improvement in the manufacture of Lace,*] and if not, how is the contrary made out, or how otherwise, and who was or were the true and first inventor or inventors thereof.

4. Whether the said invention, or some, and what part or parts thereof was not, or were not, at the time of the making of the said letters patent, or some other, and what letters patent, or at some other, and what time, a new invention within this realm, as to the public knowledge, use, and exercise, public knowledge, use, or exercise thereof, and if not, how is the contrary made out, or how otherwise.

5. Whether such letters patent of such date, and to such purport and effect as aforesaid, were not duly made and granted to your orators, [*or the said A. B. and C. D.,*] or if not, how is the contrary made out, or how otherwise.

6. Whether in compliance with the said proviso or condition, in that behalf, or whether in fact your orators, [*or the said A. B. and C. D.,*] did not by such specification, or instrument in writing, as aforesaid, or by some and what other specification or instrument in writing under their hands and seals, or under the hand and seal of one, and which of them, particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, or if not, how is the contrary made out, or how otherwise.

7. Whether your orators, [or the said *A. B. and C. D.,*] or the one, and which of them, did not at the time aforesaid, and within [*six*] calendar months next and immediately after the date of the said letters patent, cause the said specification or instrument in writing under their hands and seals, or under the hand and seal of the one, and which of them, or some other, and what specification or instrument in writing under their hands and seals, or under the hand and seal of one, and which of them to duly be enrolled in the said High Court of Chancery, or when else or if not, how is the contrary made out, or how otherwise.

8. Whether in the said specification or instrument in writing, or some other, and what specification or instrument in writing there were not expressed or contained the words, letters, and figures hereinbefore set forth, or some other, and what words, letters, and figures, or if not, how is the contrary made out, or how otherwise.

9. Whether in the said disclaimer and memorandum of alteration under the hands and seals of your orators, [*or* the said *A. B. and C. D.*,] or in some other, and what disclaimer and memorandum of alteration, disclaimer or memorandum of alteration, it was not expressed or mentioned, that your orators, [*or* the said *A. B. and C. D.*,] did thereby disclaim, and whether your orators, [*or* the said *A. B. and C. D.*,] did not in fact thereby disclaim such parts of the said title and specification, title or specification respectively as aforesaid, or some other, and what part or parts of the said title and specification respectively, and if not, how is the contrary made out, or how otherwise. And whether in or by the said disclaimer and memorandum of alteration, under the hands of your orators, [or the said *A. B. and C. D.*,] or in some other, and what disclaimer and memorandum of alteration, disclaimer or memorandum of alteration or instrument, it is not expressed or mentioned that your orators, [*or* the said *A. B. and C. D.*] did thereby, and whether your orators, [*or* the said *A. B. and C. D.*] did not in fact thereby alter the said title of the said invention and specification, title or specification in such manner as hereinbefore mentioned, or in some other and what manner, and if not, how is the contrary made out, or how otherwise. And whether your orators, [*or* the said *A. B. and C. D.*] did not obtain such leave as aforesaid, or some other, and what leave of or from her said Majesty's said Attorney [*or* Solicitor] General, or some other, and what leave and whether such leave as aforesaid, or some other, and what leave was not certified by such fiat and signature as aforesaid, or by some other, and what fiat and signature, fiat or signature, of such date as aforesaid, or of some other, and what date, and if not, how is the contrary made out, or how otherwise. And whether your orators, [*or* the said *A. B. and C. D.*,] did not, after having first obtained such leave as aforesaid, or some other, and what leave, and on, or at such day and time as aforesaid, or on, or at some other, and what day and time, day or time, enter the said disclaimer and memorandum of alteration, or some other, and what disclaimer and memorandum of alteration, disclaimer or memorandum of alteration, with the clerk of the patents of England, or some other, and what clerks or clerk, persons or person. And whether the said disclaimer and memorandum of alteration, or some other, and what disclaimer and memorandum of alteration, disclaimer or memorandum of alteration, was not entered, filed, and enrolled, entered, filed, or enrolled in manner aforesaid, or in some other, and what manner, at such time as aforesaid, or at some other, and what time or times, and if not, how is the contrary made out, or how otherwise.

10. [Whether such Indenture, dated the [*fourteenth*] day of [*March*] A. D. [1843] made between such parties, and to such purport and effect as

aforesaid, or some other and what Indenture, or deed, or instrument of assignment, or transfer was not duly made and executed between such parties as aforesaid, or some other and what parties, and to such purport and effect as aforesaid, or some other and what purport and effect, purport or effect, [and whether the said *A. B. and C. D.*] did not by the said Indenture of the [*fourteenth*] day of [*March,*] A. D. [1843,] or by some other and what Indenture, or deed, or instrument, assign the said especial licence, privileges, and letters patent, especial licence, privilege, or letters patent, or some and what parts or part, shares or share thereof, unto your orators, or one and which of them. And whether your orators, or one and which of them, did not on the said [*fourteenth*] day of [*March*] A. D. [1843,] or at some other and what time become possessed of and entitled unto possessed of or entitled unto the said especial licence, privilege, and letters patent, licence, privilege, or letters patent, or some and what parts or part thereof respectively, and if not how is the contrary made, or how otherwise.]

11. [Whether the said [*A. B. and C. D.*] or some and what person or persons for or on behalf of, or in trust for, or as agent or agents for the said [*A. B. and C. D.*] or one and which of them, or how otherwise, have not or has not, and from the time of the making of the said letters patent, or from some other and what time, and until the making of the said Indenture, or until some other and what time worked, used, exercised, put in practice, and vended, or worked, or used, or exercised, or put in practice, or vended, the said invention, or divers, or some and what part or parts thereof, or if not how is the contrary made out, or how otherwise.]

12. Whether your orators, or some and what person or persons for or on the behalf of, or in trust for, or as agent or agents for your orators, or how otherwise, have not or has not, and from what time, and until and up to what time, and when last worked, used, exercised, put in practice, and vended, or worked, or used, or exercised, or put in practice, or vended, and are not or is not now working, using, exercising, putting in practice, and vending, or working, or using, or exercising, or putting in practice, or vending the said invention, or divers or some and what part or parts thereof, or if not, how is the contrary made out, or how otherwise.

13. Whether your orators, or some and what person or persons for, or on behalf of, or in trust for, or as agent or agents, for your orators, or how otherwise, have not or has not, made, manufactured, fabricated, vended, and sold, or made, or manufactured, or fabricated, or vended, or sold, and are not or is not, still making, manufacturing, fabricating, vending, and selling, or making, or manufacturing, or fabricating, or vending, or selling, divers, or some and what quantities or quantity, numbers or number, or divers, or some or what [*enumerate the articles*] articles and things, [*again mention each of the articles*] article or thing, according to, and by means of, or according to or by means of the said invention, in the said specification described or mentioned, or according to, or by means of some and what parts or part of the said invention, or if not, how is the contrary made out or how otherwise.

14. Whether your orators have not made considerable, or some and what profits or profit, by such manufacture and sale, or by such manufacture or sale as aforesaid, and if not, how is the contrary made out, or how otherwise.

15. Whether the said defendant, or some and what person or persons on his behalf, without any leave, licence, consent, or agreement of your orators, [*or* of the said *A. B. and C. D.*] has not or have not, since the making of the said letters patent, [and since the entering, filing, and enrolling of the said disclaimer and memorandum of alteration, and since the making of the said Indenture of assignment] and during the said term granted by the said letters patent (that is to say) ever since the [*thirty-first*] day of [*March,*] A. D. [1843,] and up to the present time, or since and up to and during what time or respective times, within England, Wales, and Berwick upon Tweed, or some and what parts or part thereof wrongfully and injuriously, or in fact worked, used, exercised, and put in practice, or worked, or used, or exercised, or put in practice, and is not and are not, or is not or are not still working, using, exercising, and putting in practice, or working, or using, or exercising, or putting in practice the said invention, or some and what part or parts of the same invention, and how he justifies such conduct, or if not, how is the contrary made out, or how otherwise.

16. Whether by so working, using, exercising, and putting in practice, or working, or using, or exercising, or putting in practice, the said invention, or some and what part or parts thereof, the said defendant or some and what person or persons on his behalf, has not, or have not, made, obtained, and received, or made, or obtained, or received, considerable or some and what monies, gains, and profits, monies, or gains, or profits, and to what amount in the whole, and how he justifies such conduct, and if not, how is the contrary made out, or how otherwise.

17. Whether the said defendant or some and what person or persons on his behalf, without any such leave, licence, consent, or agreement as aforesaid, has not, or have not, since and up to, and during, or since or up to, or during the times last aforesaid, or since some and what other time or times, and until and up to, or until or up to the present time, or until, during, and up to, what other time or times, made, manufactured, and fabricated, or made, or manufactured, or fabricated, and is not still making, manufacturing, and fabricating, or is not still making, or manufacturing, or fabricating, divers great or some and what numbers or number, quantities or quantity of, or some and what [*here describe the various articles made, or supposed to be made, by the defendant*] articles or article, things or thing, according to, and by means of, or according to, or by means of, some and what part or parts of the said invention, and how he justifies such conduct, or if not, how is the contrary made out, or how otherwise.

18. Whether the said defendant, or some and what person or persons on his behalf, has not, or have not, without any such leave, licence, consent, or agreement, as aforesaid, since, and from, and up to what

time or respective times, and when last made, manufactured, and fabricated, or made, or manufactured, or fabricated, and are not, or is not now making, manufacturing, and fabricating, or making, or manufacturing, or fabricating great, or some and what numbers or number, quantities or quantity of, or some and what [*again enumerate the various articles as before*] articles or article, things or thing, which were or was intended to counterfeit, imitate, and resemble, counterfeit, imitate, or resemble, or which did, or do, or does, in fact, counterfeit, imitate, and resemble, counterfeit, imitate, or resemble, the said invention, or some and what parts or part of the same invention, and which were or was intended to counterfeit, imitate, and resemble, counterfeit, imitate, or resemble, or did, or do, or does, in fact, counterfeit, imitate, and resemble, counterfeit, imitate, or resemble, some and what [*here again mention the various articles as before*] articles or article, things or thing, made, manufactured, and fabricated, made, manufactured, or fabricated, according to, and by means of, according to or by means of the said invention, or some and what part or parts thereof, and how he justifies such conduct, or if not, how is the contrary made out, or how otherwise.

19. Whether the said defendant, or some and what person or persons on his behalf, has not, or have not, without any such licence, consent, or agreement, as aforesaid, since, and from, and during, and up to what time or respective times, and when last vended and sold, vended or sold, and are not, or is not, now vending and selling great or some and what quantities or quantity, numbers or number, of some and what [*here mention the various articles as before*] so made, manufactured, and fabricated, made, manufactured or fabricated, as aforesaid, and how he justifies such conduct, or if not, how is the contrary made out, or how otherwise.

20. Whether by so making, manufacturing, fabricating, vending, and selling, or making, or manufacturing, or fabricating, or vending, or selling such [*here enumerate the various articles as before*] articles and things as aforesaid, or some and which thereof, and what quantities or quantity, numbers or number, of some and which of such [*again enumerate the various articles as before*] articles and things, the said defendant or some and what person or persons on his behalf, has not, or have not made, obtained, and received, or made, or obtained, or received, considerable, or some and what monies, gains, and profits, monies, or gains, or profits, and to what amount in the whole, and how he justifies such conduct, and if not, how is the contrary made out, or how otherwise.

21. Whether the defendant has not now, or had not, and when last in his shop, house, warehouse, and premises in [*Derby* aforesaid] and in various, or some, or one, and what shops or shop, houses or house, warehouses or warehouse, manufactories or manufactory, or premises, or in some and what place or places, or has not directly or indirectly in his possession, custody, or power, very large or some and what quantities or quantity, numbers or number, of such various articles and things, articles or things, as aforesaid, other than the said articles and things so made, manufactured, and sold by your orators as aforesaid, or

of some, or one, and which of such articles or things, and to a very considerable, or to some and what value or amount in the whole, and how he justifies such conduct, and if not, how is the contrary made out, or how otherwise.

22. Whether the said defendant or some and what person or persons on his behalf, has not, or have not, without any such licence, consent, or agreement as aforesaid, by the ways and means aforesaid, ways or means aforesaid, or some, or one, and which of such ways and means, ways or means, or by some and what other ways and means, ways or means violated, infringed, and evaded, or violated, infringed, or evaded, the said letters patent and privilege thereby granted, or some and what part thereof respectively, and how he justifies such conduct, or if not, how is the contrary made out, or how otherwise.

23. Whether it is not the fact that by divers or by some or one and what other ways or means known or unknown to your orators, the said defendant has been or is now or was lately, and at what times or time, and when last infringing and evading, infringing or evading your orator's patent rights, or some and which of such rights, and how he justifies such conduct, or if not, how is the contrary made out, or how otherwise.

24. Whether it is not the fact that, by all and every or by some or one and which of the ways, means, counterfeits, infringements, and evasions aforesaid, your orators have sustained or are now sustaining very heavy or some and what loss and injury, loss or injury, or if not, how is the contrary made out, or how otherwise.

25. Whether your orators or one and which of them have not or has not frequently and or how otherwise and when, by themselves or himself, or their or his solicitors or solicitor, agents or agent, applied to the said defendant to desist and refrain, desist or refrain from such infringements, evasions and proceedings, infringements or evasions or proceedings as aforesaid, or some and which of them, and whether he has not refused so to do, or how otherwise, and whether your orators have not frequently or how otherwise and when, by themselves or their solicitors or solicitor, agents or agent, applied to the said defendant to account with your orators for the profits which he has made by means of such infringements, evasions and proceedings, infringements or evasions or proceedings as aforesaid, or some and which of them, and whether the defendant has not refused so to do, or how otherwise, and how he justifies such conduct.

26. Whether the said defendant ought not to be so restrained, and to render such accounts as aforesaid, or if not, why not.

27. Whether the said defendant has not now or had not lately, and when last in his possession, custody or power, divers or some or one and what books or book, accounts or account, letters or letter, copies or copy, extracts or extract of letters or letter, papers or paper, documents or document, writings or writing, whereby the accounts enquired after by this bill, or some and what part or parts of such accounts may be obtained, or whereby the truth of the matter aforesaid or some or one and which of such matters will appear, or if not, how is the contrary made out, or how

otherwise. And whether the said defendant ought not to be compelled to produce and leave the same as aforesaid, or if not, why not, and whether any or any one or more, and which thereof have or has been lost, destroyed, or removed; and if so, whether since or before the commencement of this suit, and why, and whether such loss, removal, or destruction was not fraudulent, or if not, how is the contrary made out, or how otherwise. And that the said defendant may set forth a full, true, and particular list or schedule of all and every of such books, accounts, letters, copies or extracts of letters, papers, documents and writings whatsoever, specifying particularly where the same and every of them now are or is to be found, and in whose custody or power the same and every of them now are or is or last were or was, and all particulars relating thereto. And that the said defendant may also in manner aforesaid further answer and set forth.

28. Whether it is not the fact that, your orators did not receive or obtain until the time aforesaid any certain and conclusive information or evidence of the aforesaid conduct, dealings, transactions and doings of the said defendant, or of some and which of them, and whether your orators have not used due diligence in complaining to this honourable Court, or if not, why not, and how is the contrary made out or how otherwise.

And that the said defendant may be decreed to account for and pay to your orators all such gains and profits as have accrued, arisen, been got in, or received by the said defendant, or which may accrue, arise, be got in, or be received by the said defendant, or by any person or persons in trust for, or for the use of, or on behalf of the said defendant by making, working, using, exercising, vending, counterfeiting, imitating and resembling, or making, or working, or using, or exercising, or vending, or counterfeiting, or imitating, or resembling the said invention, and the various articles and things aforesaid, or any of them, or any part thereof.

And that the said defendant, his agents, servants, and workmen, may be restrained by the order and injunction of this honourable Court from directly or indirectly making, working, using, putting in practice, buying, selling, and vending, or making, or working, or using, or putting in practice, or buying, or selling, or vending the said invention, or any part thereof, or in anywise counterfeiting, imitating, or resembling the same invention, or any part thereof, and from directly or indirectly making, manufacturing, fabricating, buying, selling, and vending, or making, or manufacturing, or fabricating, or buying, or selling, or vending such articles and things as aforesaid, or any of them.

And that the said defendant may be decreed to pay the costs of this suit, and that your orators may have such further and other relief as to your Lordship shall seem meet.

May it please your Lordship to grant unto your orators, not only her Majesty's most gracious writ of injunction, issuing out of and under the seal of this honourable Court, to be directed to the said defendant to restrain him, his agents, servants, and workmen, from directly or indirectly

making, working, &c., [*as before*] but also her Majesty's most gracious writ of subpœna, &c.

IN CHANCERY.

(No. 2.) Defendant's answer to a bill for an injunction and account.

The answer of [*John Thompson*] defendant to the bill of complaint of [*John C. Hadden*] complainant.

This defendant [*John Thompson*] reserving to himself all right and benefit of exception to the said bill of complaint, for answer thereto, says, &c. [*Here let a statement be made of all the circumstances of the case, so as to show the nature of the defendant's case and defence to the suit, and also to enable him, by reference, to explain his answers to the various interrogatories; after which may be introduced the following objections to the patent, or such of them as may be applicable to the case.*] And this defendant further saith, that the said plaintiff did not invent the said supposed invention, [*or* the said plaintiff was not, in pursuance of any communication from a foreigner residing abroad, in possession of the said supposed invention] in the said plaintiff's said bill of complaint mentioned, and the said plaintiff was not at the date of the said letters patent in the said bill of complaint mentioned, the true and first inventor within this realm of the said supposed invention, and by reason thereof the said supposed letters patent and grant of privilege in the said bill mentioned, were and are null and void and of none effect. And this defendant further saith, that the said supposed invention was not, nor was any part thereof, at the date of the said letters patent, improvements, or any improvement in the making or manufacturing of [*Bricks and Tiles*] as by the said plaintiff represented or suggested unto her Majesty, and by reason of such representation or suggestion being false and untrue, and her said Majesty thereby deceived, the said supposed letters patent and grant of privilege were and are null and void and of none effect. And this defendant further saith, that the said supposed invention was not at the time of the making of the said letters patent a new invention, as to the public knowledge, use, and exercise thereof in this realm, or a new manufacture within this realm, and that the said invention was publicly known and used in this realm before and at the date of the said letters patent, by reason whereof the said supposed letters patent and grant of privilege were and are null and void and of none effect. And this defendant further saith, that the said supposed invention was not at the date of the said letters patent of any benefit, utility, or advantage whatsoever to the public, by reason whereof the said supposed letters patent and grant of privilege were and are null and void and of none effect. And the defendant further saith, that the said supposed invention was not an invention of any manner of manufacture, and that the privilege supposed to be granted by the said letters patent, was not a privilege of the sole working or making of any manner of manufacture, by reason whereof the said supposed letters patent and grant of privilege were and are null and void and of none effect. And the defendant further saith, that the said plaintiff did not within [*six*] calendar months, next and immediately after the date of the said letters patent, by any instrument in writing under his hand and seal, particularly

ascertain and describe the nature of the said supposed invention, and in what manner the said supposed invention is to be performed, by reason whereof the said supposed letters patent and grant of privilege at the expiration of [*six*] calendar months, next and immediately after the date of the same letters patent, ceased, determined, and became, and were, and are, null and void and of none effect. And the defendant further saith, that the plaintiff did not within [*six*] calendar months, next and immediately after the date of the said letters patent, cause any instrument in writing under his hand and seal, particularly ascertaining and describing the said supposed invention, and in what manner the same is to be performed, to be enrolled in her Majesty's High Court of Chancery, by reason whereof the said supposed letters patent and grant of privilege at the expiration of [*six*] calendar months, next and immediately after the date of the same letters patent, ceased, determined, and became, and were, and are null, void, and of none effect. And the defendant further answering says, that the plaintiff had not before or at the time of the making of the said letters patent or before or at the time of the making of any other letters patent, or before or at any other time, invented the said supposed invention in the said bill of complaint mentioned, or any other such improvements or improvement as in the said bill mentioned, and the defendant makes out this his denial by the statement hereinbefore contained; but this defendant is unable to state as to his knowledge, information, or belief, who invented the said improvements in the said bill mentioned. And the defendant further answering says, that the said supposed invention was not, nor was, nor were, any part or parts thereof, at the time of the making of the said letters patent in the said bill mentioned, or of any other letters patent, or at any other time, of any public utility, and this defendant makes out the contrary of the statement in the said bill in that behalf contained by the denial hereinbefore contained. And this defendant further answering says, that the said plaintiff was not at the time of the making of the said letters patent, or at any other time, the true and first inventor within this realm of the said [*improvements in &c.*] or of any other [*improvements in &c.*] and this defendant makes out this his denial by the statement hereinbefore contained. And this defendant further answering says, that the said invention was not, nor was any part thereof at the time of the making of the said letters patent in the said bill mentioned, or of any other letters patent, a new invention within this realm, as to the public knowledge, use, or exercise thereof, and this defendant makes out this his denial by the statement hereinbefore contained, but save and except as aforesaid, this defendant is unable to state as to his knowledge, information, or belief, at what time the said supposed invention was a new invention within this realm, as to the public knowledge, use, or exercise thereof. And this defendant further answering says, that he has been informed and believes that some letters patent of such date as in the said bill mentioned, were made and granted to the said plaintiff, but whether the same letters patent are to such purport and effect as in the said bill mentioned is a question which this defendant submits to the consideration and deter-

Answers to the interrogatories.

mination of this honourable Court. And this defendant further answering says, that the plaintiff did not in compliance with the said proviso or condition in that behalf, or, in fact, by the said specification or instrument in writing in the said bill mentioned, or by any other specification or instrument in writing under his hand and seal, particularly ascertain and describe the nature of the said supposed invention, or in what manner the same was to be performed, and this defendant makes out this his denial by the statement hereinbefore contained. And the defendant further answering, says, that he has been informed, and believes, that the said plaintiff did at the time, in the said bill mentioned, and within [*six*] calendar months, next and immediately after the date of the said letters patent, cause the said specification or instrument in writing in the said bill mentioned, to be duly enrolled in the High Court of Chancery; and that in the said specification or instrument in writing, is contained the words, letters, and figures, in the said bill set forth; and that in the said disclaimer and memorandum of alteration it was expressed or mentioned, that the plaintiff did thereby disclaim; and that the plaintiff did in fact, thereby disclaim such parts of the said title and specification in the said bill mentioned, as in the same bill also mentioned; and also, that in or by the said disclaimer and memorandum of alteration, it is expressed or mentioned that the said plaintiff did thereby, and that the said plaintiff did in fact thereby alter the said title of the said invention and specification, in such manner as in the said bill in that behalf mentioned; and that the plaintiff did obtain such leave as in the said bill mentioned, and that such leave was certified by such *fiat* and signature, and of such date as in the said bill mentioned; and that the plaintiff did after having obtained such leave, and on or at such day or time, enter the said disclaimer and memorandum of alteration, as in the said bill mentioned; and that the said disclaimer and memorandum of alteration was entered, filed, and enrolled in the manner and at the time in the said bill also mentioned. And this defendant further answering, says that he doth not know, and save by the said bill hath not been informed, and is unable to state as to his knowledge or otherwise, whether the said plaintiff or any person or persons, for or on the behalf of, or in trust for, or as agent or agents for the plaintiff or otherwise, hath or have at any time worked, used, exercised, put in practice or vended, or are, or is now working, using, exercising, putting in practice or vending the said invention, or any part thereof, or have not, or has not made, manufactured, fabricated, vended or sold, or is not, or are not still making, manufacturing, fabricating, vending or selling such articles and things as in the said bill mentioned, or any of such articles or things, or whether the plaintiff hath made such profits or profit as in the said bill mentioned. And this defendant puts the plaintiff to the proof of the several allegations of the plaintiff in that behalf in his said bill contained. And the defendant further answering, says, that (save and except as aforesaid) (*q*), he the defendant hath not nor hath nor have any person or persons on his behalf at any time since the making

(*q*) This exception refers to a previous explanatory statement of the defendant's acts which he there contends are no violation of the patent.

of the said letters patent within England, Wales, or Berwick-upon-Tweed, or any part or parts thereof worked, used, or put in practice, and is not and are not still working, using, exercising, or putting in practice the said invention or any part or parts thereof; and the defendant makes out this his denial by the statement hereinbefore contained. And this defendant further answering says, that (save and except as aforesaid), he the defendant hath not, nor hath, nor have any person or persons on his behalf, by working, using, exercising, or putting in practice the said supposed invention, or any part thereof, made, obtained, or received, any monies, gains, or profits; and this defendant makes out this his denial, by the statement hereinbefore contained. And this defendant further answering says, that (save and except as aforesaid,) he the defendant hath not, nor hath, nor have any person or persons on his behalf, since the making of the said letters patent, made, manufactured, or fabricated, and is not, and are not, still making, manufacturing, or fabricating, any numbers or number, quantities or quantity, of such articles or article, things or thing, as in the said bill of complaint mentioned; and hath not nor have vended or sold, and is not and are not now vending or selling any quantities or quantity, numbers or number of such articles or things as in the said bill mentioned, and this defendant makes out this his denial by the statement hereinbefore contained; and this defendant further answering says, that, (save and except as aforesaid,) that by so making, manufacturing, fabricating, vending, or selling, such articles and things, articles or things as in the said bill mentioned, or any of them, he this defendant has not, nor has, nor have any person or persons on his behalf, made, obtained, or received any monies, gains, or profits; and he the defendant makes out this his denial thereof, by the statement hereinbefore contained. And this defendant further answering says, that, (save and except as aforesaid,) he the defendant has not now, and had not at any time at his shop, house, warehouse, or premises, or any other shops or shop, houses or house, warehouses or warehouse, or premises, in any place or places, and has not directly or indirectly in his possession, custody, or power, any quantities or quantity, numbers or number, of such articles or things as in the said bill mentioned or any of them; and this defendant makes out this his denial thereof, by the statement hereinbefore contained. And this defendant further answering says, that, (save and except as aforesaid,) he this defendant hath not had, nor have any person or persons on his behalf, by the ways or means in the said bill mentioned, or any of them, or by any other ways or means, violated, infringed, or evaded the said letters patent, or the said privilege thereby granted, or any part thereof; and this defendant makes out this his denial thereof by the statement hereinbefore contained. And this defendant further answering says, that, (save and except as aforesaid,) it is not the fact that by divers or any of such ways or means, as in the said bill mentioned, or by any other ways or means, he this defendant has been, or is now, or was lately, or at any time infringing or evading your orator's patent rights, or any of them; and this defendant makes out this denial, by the state-

ment hereinbefore contained. And this defendant further answering says, that, (save and except as aforesaid,) he this defendant denies that by all or any of the ways, means, counterfeits, infringements, or evasions in the said bill mentioned, the plaintiff has sustained, or is still sustaining any loss or injury; and this defendant makes out this denial by the statement hereinbefore contained. And this defendant further answering says, that, (save and except as aforesaid,) he this defendant denies that the plaintiff has by himself, or his solicitor or solicitors, agent or agents, or otherwise, made such application to this defendant as in the said bill of complaint mentioned. And this defendant further answering says and insists, that for the reasons aforesaid, he this defendant ought not to be restrained or to render such accounts as in the said bill mentioned. And this defendant further answering says, that, (save and except the said books, letters, and documents, hereinbefore mentioned (*a*)) he this defendant has not now, and had not lately in his possession, custody, or power, divers, or any books or book accounts, or account letters or letter, copies or copy, extracts or extract of letters or letter, papers or paper, documents or document, writings or writing, whereby the accounts or account inquired after by the said bill or any of them, or any part or parts thereof might be obtained, or whereby the truth of the matters in the said bill mentioned, or any of them would appear, and this defendant makes out the truth of this denial by the statement hereinbefore contained. And this defendant further answering says and insists, that for the reasons aforesaid, he is not bound, and ought not to be compelled to produce or leave the said books, letters, and documents, hereinbefore mentioned, or any of them as in the said bill mentioned. And this defendant further answering says, that no such books or book, accounts or account, letters or letter, copies or copy, extracts or extract of letters or letter, papers or paper, documents or document, writings or writing, as in the said bill mentioned, has been lost, removed or destroyed. And this defendant further answering says and insists, that under the circumstances, and for the reasons hereinbefore stated, he this defendant is not bound, and ought not to be compelled to set forth any further or other list or schedule of the said books, letters, and documents in this answer hereinbefore described or mentioned, or where the same or any of them now are, or is to be found, or in whose custody or power the same or any of them now are or is, or last were or was, or any further particulars relating thereto. And this defendant further answering, says, that he does not know, has not been informed, (save by the said bill,) and cannot set forth as to his belief or otherwise, whether the plaintiff did receive or obtain any information or evidence of such alleged conduct, dealings, transactions, and doings as in the said bill mentioned, or any of them; and this defendant puts the plaintiff to prove the allegations of his said bill as to the matters aforesaid. And this defendant submits to the judgment of this honourable Court, the question whether the said plaintiff hath used due diligence in complaining to this honourable Court. And this defendant submits

(*a*) Books, &c., mentioned in the introductory part of the Answer.

and insists that he ought not to be decreed to account for or pay to the plaintiff any gains or profits by the defendant made or acquired by the manufacture and sale by this defendant of such articles and things, as hereinbefore mentioned, or any other gains or profits, as in the said bill alleged. And that under the circumstances and for the reasons aforesaid, this defendant, his agents, servants, and workmen, ought not, nor ought any of them to be restrained as in the said bill mentioned. And this defendant submits and insists, that under the circumstances, for the reasons hereinbefore stated, the said letters patent and privilege supposed to be thereby granted were and are null and void; and that the plaintiff is not entitled to any discovery from, or relief against this defendant. And this defendant claims the full benefit of this objection, and to the same extent as he if had demurred or pleaded to the said bill WITHOUT THIS THAT there is any other matter, cause or thing in the said complainant's said bill of complaint contained material or effectual in the law for this defendant to make answer unto, and not herein and hereby well and sufficiently answered, avoided, traversed, or denied, is true to the knowledge and belief of this defendant. All which matters and things this defendant is ready and willing to aver, maintain, and prove, as this honourable Court shall direct. And the defendant humbly prays to be hence dismissed with his reasonable costs and charges in the law in this behalf most wrongfully sustained, &c.

(No. 3.) Form of Affidavit by a patentee plaintiff in support of his bill in order to obtain an interlocutory injunction.

IN CHANCERY.

Between [*A. B.*] plaintiff,
and
[*C. D.*] defendant.

[*Aaron Benson the above named plaintiff,*] maketh oath and saith that by her Majesty's letters patent, under the Great Seal of the United Kingdom, bearing date at Westminster, the [*first*] day of [*January,*] in the [*fourth*] year of her reign, reciting that he this deponent, had by his petition, humbly represented (as the fact was,) that, &c. [*Here state the grant of the patent in the same way, or to the same effect as in the bill.*] And this deponent further saith, that he did in pursuance of the proviso or condition in that behalf in the said letters patent contained, and within [*six*] calendar months next, and immediately after the date of the said letters patent, by a certain specification or instrument in writing under this deponent's hand and seal, dated the [*first*] day of [*July,*] [1841,] particularly describe and ascertain the nature of the said invention, and in what manner the same invention was and is to be performed, and that the said specification is to the tenor and effect stated in this deponent's bill of complaint, filed in this cause [*or* is to the tenor and effect following, that is to say, "To all to whom, &c., (*setting out the specification at length,*) *or* a true copy of which said specification is hereunto annexed marked with the letter A., (*r*)]. And this deponent further

(*r*) When the specification is not set out in the bill, it must be brought before the Court by affidavit in this way, in support of an interlocutory motion for an injunction.

saith that he did also in pursuance of the said proviso, on the said [*first*] day of [*July*, 1841,] and within [*six*] calendar months, next and immediately after date of the said letters patent, cause the said specification or instrument in writing under this deponent's hand and seal, to be duly enrolled in this honourable Court; and this deponent further saith that at the time of this deponent's applying for the said letters patent, he this deponent, verily believed that the said invention was a new invention as to the public knowledge, use and exercise thereof within this realm, and that he this deponent was the true and first inventor of the said invention. And this deponent still and now at the time of the swearing this affidavit verily believes that the said invention was on the day of the date of the said letters patent, a new invention as to the public knowledge, use and exercise thereof within this realm, and also that he, this deponent, was on the said day of the date of the same letters patent, the true and first inventor within this realm of the said invention, and this deponent, at the time of his said application, believed and still believes that the same invention was and is of great public utility. And this deponent further saith, that after the grant of the said letters patent, he this deponent, &c. [*Here let the plaintiff verify the several allegations in the bill, as far as they come within his knowledge.*] And this deponent further saith, that, &c. [*Here state the result of any former action (if any) upon the patent, the number of licences (if any) which have been taken, or such other circumstances as are likely to induce the Court to grant an interlocutory injunction.*] And this deponent further saith that, &c. [*Here let the plaintiff swear that the alleged piracy is an infringement of his patent.*]

[*A. B.*] Sworn, &c.

(No. 4.)

Affidavits respecting the novelty and utility of the invention in support of a motion for an interlocutory injunction.

IN CHANCERY.

Between [*A. B.*] plaintiff,
and
[*C. D.*] defendant.

[*Francis Jamieson, of Ludgate Street in the City of London, dealer in Chronometers and other Time-keepers,*] maketh oath and saith, that he has been a dealer in [*chronometers and other time keepers*] for the space of [*twenty*] years now last past, and during that period intimately acquainted with all descriptions of [*chronometers, watches, and time-keepers*] known to the public; and this deponent further saith that he has read the specification of the plaintiff's invention mentioned in his bill of complaint in this cause, and has seen and examined a [*chronometer*] made according to the said invention as described in the said specification; and this deponent further saith, that he verily believes that the said invention was a new invention, as to the public knowledge and use thereof, at the date of the letters patent mentioned in the said bill of complaint, and that this deponent was entirely ignorant thereof, until he read the said specification, [*or saw a chronometer manufactured by the said plaintiff,*] in or about [the month of *August*, now last past.] And this deponent further

saith, that he verily believes that the said [*A. B.*], was the first person who communicated a knowledge of the said invention to the public, and that he was the true and first inventor thereof; and this deponent further saith, that the said invention of the said [*A. B.*], is, in the judgment and opinion of this deponent, highly useful and beneficial to the public. And this deponent further saith, that he hath seen and examined a [*chronometer*] with a certificate thereto annexed, stating that the same was exhibited to, [*James Tongs,*] at the time of the swearing of his affidavit, sworn in this cause on the [*twentieth*] day of [*October*] now last, and this deponent saith, that the said [*chronometer*] is made and constructed precisely according to the said invention of the said plaintiff, and in the precise manner described in the said specification.

[*F. Jamieson.*] Sworn, &c.

(No. 5.) Affidavit respecting an infringement by the defendant in support of an application for an interlocutory injunction.

IN CHANCERY.

Between [*A. B.*] plaintiff,
and
[*C. D.*] defendant.

[*James Tongs, of Blackfriars Road, in the County of Surrey, Broker,*] maketh oath and saith that he did on the [*thirtieth*] day of [*September*] now last, purchase a [*marine chronometer*] of the above-named defendant at his shop in [*Leadenhall Street, in the City of London,*] and paid the sum of [*forty-six*] pounds for the same; and this deponent further saith, that the [*chronometer*] now produced and shown to this deponent at the time of the swearing of this his affidavit is the said [*chronometer*] so purchased of the defendant as aforesaid, and this deponent further saith at the time of the purchase of the said [*chronometer,*] the said defendant delivered to this deponent an invoice of this deponent's said purchase, together with a receipt for the said sum of money so paid, as aforesaid, in words, letters, and figures following, (that is to say) [*here set out the invoice*]

[*J. T.*] Sworn, &c.

Affidavit by plaintiff [illegible] judgment in default of appearance for an infringment in order to obtain an interlocutory injunction.

[*Wil[illegible] named plaintiff,*] [illegible] granted to the above-named [illegible] Court, made in this cause on the [*fifteenth*] day of [*August*, 1844,] an action was on the [*ninth*] day of [*October*, 1844,] commenced by the said plaintiff against the above named defendant in the Court of [*Common Pleas,*] for an infringment of the plaintiff's letters patent, mentioned in the pleadings of this cause, and of the privilege thereby granted; and this deponent further saith that the said plaintiff having declared in the

said action, the defendant pleaded several pleas thereto, (that is to say,) *firstly, non concessit; secondly*, that the said plaintiff was not the true and first inventor of the invention, comprised in the said letters patent; *thirdly*, that the said invention was not a new invention at the date of the said letters patent; *fourthly*, that the said invention was of no use to the public; *fifthly*, that the said plaintiff did not by any instrument in writing under his hand and seal, ascertain and describe the nature of the said invention, and in what manner the same is to be performed; and, *sixthly*, that he the said defendant was not guilty of the grievances alleged in the said declaration; and this deponent further saith, that the said plaintiff having replied to the said several pleas, and issue having been joined in the said action, the said action came on to be tried at the sittings after [*Hilary*] term, [1844,] before [*the Lord Chief Justice of the said Court and a special Jury*,] when after a trial which lasted [*two days*] the said jury gave a verdict for the plaintiff, upon each of the issues joined in the said action; and this defendant further saith that in [*Easter*] term last past, the said defendant moved the said Court of [*Common Pleas*,] for and obtained a rule *nisi*, [*for a new trial in the said action*,] which said rule was after argument in [*Michaelmas*] term last, discharged; and this deponent further saith, that final judgment was on the [*third*] day of [*December*,] now instant, signed for the said plaintiff in the said action.

[*W. R.*] Sworn, &c.

(No. 7.)

Affidavit that defendant has obtained a verdict and judgment in an action for an infringement in support of a motion to dissolve an inter-

IN CHANCERY.

Between [*A. B.*] plaintiff,
and
[*C. D.*] defendant.

[*Anthony John Moore, of &c., Solicitor for the above-named defendant*] maketh oath and saith, that on the [*ninth*] day of [*October*, 1844,] the above-named plaintiff commenced an action against the said defendant in the Court of [*Exchequer of Pleas*] for an alleged infringement of the letters patent mentioned in the pleadings of this cause, and of the privi-

privilege of, or [illegible]
fifthly, that the said plaintiff [illegible] his hand and seal, ascertain [illegible] of the said supposed invention, and in what manner the same is to be performed; and, *sixthly*, that he, the defendant, was not guilty of any of the supposed grievances

(being certain alleged infringements of the said letters patent) in the said declaration mentioned; and this deponent further saith, that the said plaintiff replied to the said several pleas of the said defendant, and as to the said [*first*] plea, the said plaintiff joined issue; as to the said [*second*] plea, the said plaintiff replied that he, the plaintiff, was the true and first inventor of the said supposed invention; as to the said [*third*] plea, the said plaintiff replied that the said supposed invention was, at the date of the said letters patent, a new invention as to the public knowledge, use, and exercise thereof within this realm; and as to the said [*fourth*] plea, the said plaintiff replied that the said supposed privilege was a privilege of, or for the working of a certain manufacture, to wit, the manufacture in the said declaration mentioned; and as to the said [*fifth*] plea that the said plaintiff did, by a certain specification or instrument in writing in the said declaration mentioned, ascertain and describe the nature of the said supposed invention, and in what manner the same is to be performed; as to the said [*sixth*] plea, the said plaintiff joined issue thereon; and this deponent further saith that the said defendant thereupon rejoined, and joined issue upon each of the said several replications to the said [*second, third, fourth, and fifth*] pleas respectively: and this deponent further saith, that the said action came on to be tried at the sittings after [*Hilary*] term [1844] before [*the Lord Chief Baron of the said Court and a special jury*] when the said jury as to the said issue, joined upon the said [*first*] plea, gave a verdict for the said defendant; as to the said issue joined upon the said replication to the said [*second*] plea, the said jury gave a verdict for the said defendant, and upon their oaths said that the said plaintiff was not the true and first inventor within this realm, of the said supposed invention; and as to the said issue joined upon the said replication to the said [*third*] plea, the said jury gave a verdict for the said defendant, and upon their oaths said that the said supposed invention was not at the date of the said letters patent, a new invention as to the public knowledge, use, and exercise thereof, within this realm; and as to the said other issues joined in the said action, the said jury gave a verdict for the said plaintiff. And this deponent further saith, that in [*Easter*] term, now last past, the said plaintiff moved the said Court of [*Exchequer of Pleas*] for, and obtained a rule *nisi* [*for a new trial in the said action*], which said rule, after argument in [*Trinity*] term last, and after the said Court had taken time to consider of their judgment, was in [*Michaelmas*] term last discharged. And this deponent further saith, that final judgment was on the [*first*] day of [*December*] now instant, signed for the said defendant in the said action; [and that the paper writing hereunto annexed, and marked with the letter [K,] is a true copy of the record of the said judgment].

Sworn, &c.

[*A. J. M.*]

IN CHANCERY.

Between [*A. B.*] complainant,
and
[*C. D.*] defendant.

(No. 8.)
Certificate that the validity of the patent came in question in the cause (*s*).

I hereby certify that a final decree [*or* decretal order] was made by me for the complainant in this suit on the [*first*] day of [*July*, 1840,] and that upon the making of the said decree [*or* decretal order] the validity of the letters patent in the pleadings in this suit mentioned, came in question before me. Dated this [*fourth*] day of [*July*, 1840.]

(Signed) [*Langdale,*] *M. R.*

IN CHANCERY.

Between [*A. B.*] complainant,
and
[*C. D.*] defendant.

(No. 9.)
Certificate under 5 & 6 W. IV. c. 83, s. 3, and 5 & 6 Vict. c. 97, s. 2, that plaintiff ought not have more than the usual costs.

I hereby certify that a final decree, [*or* decretal order,] was made by me for the complainant in this suit on the [*fourth*] day of [*March*, 1845,] and that the said complainant ought not to have [treble costs, or] any more, or other costs than the usual costs taxed as between party and party. Dated this [*tenth*] day of [*March*, 1845.]

(Signed) [*Langdale,*] *M. R.*

SECTION VI.

Forms and Entries in qui tam *Actions of Debt for Penalties under 5 & 6 Will. IV. c. 83, s. 7.*

IN THE [EXCHEQUER OF PLEAS.]

(No. 1.)
Declaration.

The [*fourth*] day of [*January*], in the year of our Lord, [*one thousand eight hundred and forty-six.*]

[Middlesex] to wit. [*John Smith,*] (the plaintiff in this suit,) who sues as well for our sovereign lady the now Queen, as for himself in this behalf, by [*Richard Roe*] his attorney, complains of [*Job Doe,*] (the defendant in this suit,) who has been summoned to answer the plaintiff in an action of debt. And the plaintiff demands of the defendant the sum of 50*l.*, [*or if more than one penalty is sued for, here insert the total amount of all the penalties,*] which the defendant owes to, and unjustly detains from the plaintiff, and our said lady the Queen.

For that whereas our lady the now Queen, before the commencing of the offence by the defendant hereinafter (*t*) [*in this count*] mentioned, *For writing, &c. the name of patentee upon*

(*s*) This certificate is necessary to enable the plaintiff to obtain full costs in subsequent proceedings upon the patent. Vide *ante*, p. 366.

(*t*) The words "in this count" must only be inserted when there is more than one count in the declaration.

an article made by the defendant.

and before the commencement of this suit, to wit, on the [*first*] day of [*May,*] in the [*second*] year of her reign, (being in the year of our Lord *one thousand eight hundred and thirty-eight,*) by her letters patent under her Great Seal of the United Kingdom of Great Britain and Ireland, bearing date at Westminster the day and year last aforesaid, (and which said letters patent the plaintiff now brings into Court here,) did give and grant unto the plaintiff, [*or* unto one *A. B.*,] her said Majesty's especial licence, full power, sole privilege, and authority, that he the plaintiff, [*or* the said *A. B.*,] his executors, administrators, and assigns, or such others as he or they should at any time agree with, and no others, from time to time, and at all times, during the term of years therein expressed, to wit, the term of fourteen years, should and lawfully might make, use, exercise, and vend within England, Wales, and the town of Berwick upon Tweed, [the islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all her said Majesty's colonies and plantations abroad,] an invention of, [*here insert the title of the invention,*] subject to a proviso requiring that the plaintiff, [*or* the said *A. B.*,] should cause a particular description of the nature of the said invention, and in what manner the same was to be performed, under his hand and seal, to be enrolled in her said Majesty's High Court of Chancery, within [*six*] calendar months next and immediately after the date of the said letters patent, as by the said letters patent under the said Great Seal now shown to the Court here, reference being thereunto had, will, amongst other things, more fully and at large appear. And the plaintiff further saith, that he did afterwards, to wit, on the [*first*] day of [*November,*] in the year of our Lord [*one thousand eight hundred and thirty-eight,*] and within [*six*] calendar months next and immediately after the date of the said letters patent, in pursuance of the said proviso and of the said letters patent, by a certain specification or instrument in writing under his hand and seal, particularly describe the nature of the said invention, and in what manner the same was to be performed, and did also on [*the day and year last aforesaid,*] and within [*six*] calendar months next and immediately after the date of the said letters patent, cause the same specification or instrument in writing under his hand and seal, to be enrolled in her said Majesty's High Court of Chancery, at Westminster, in the said county of Middlesex, as by the enrolment of the said instrument in writing now remaining of record in the said High Court of Chancery, will, amongst other things more fully and at large appear. And the plaintiff further says, that the said letters patent were before the committing of the said offence by the defendant hereinafter [*in this count*] mentioned, and before the commencement of this suit, to wit, on the said day of the date of the same letters patent granted to, and obtained by, the plaintiff, [*or* the said *A. B.*,] for the sole making and vending, and by force and virtue of the same letters patent, the plaintiff, [*or* the said *A. B.*,] then obtained and acquired the sole right and privilege of making and vending of certain things, to wit, certain [*Lamps*] to be made and manufactured according to, and by means of, the said invention in the

said letters patent mentioned. Yet the plaintiff in fact says, that the defendant, well knowing the premises, afterwards and after the making of a certain statute passed in the sixth year of the reign of his late Majesty King William the Fourth, intituled "An Act to amend the Law touching Letters Patent for Inventions," and also after the making of the said letters patent [*firstly*] hereinbefore mentioned, within the said term of fourteen years, by the same letters patent granted, and before the commencement of this suit, to wit, on the [*ninth*] day of [*October*,] in the year of our Lord, [*one thousand eight hundred and forty-five*,] within that part of the said United Kingdom called England, against the will and without any leave, licence, or consent of the plaintiff, [or the said *A. B.*,] or any assigns or assign of the plaintiff, [or the said *A. B.*,] unlawfully, knowingly, injuriously, falsely, deceitfully, and fraudulently, and against the form of the statute in such case made and provided upon a certain thing, to wit, a certain [*Lamp*,] then wrongfully made by the defendant according to, and by means of, the said invention, and against the said sole privilege so granted to the plaintiff, [*or* the said *A. B.*,] by the said letters patent as aforesaid, the said thing, to wit, the said [*Lamp*,] then being a thing, to wit, a [*Lamp*,] for the sole making and vending of which the plaintiff, [*or* the said *A. B.*,] had theretofore, to wit, on the day and year aforesaid, obtained the said letters patent, and then also being a thing, to wit, a [*Lamp*,] for the sole making or selling of which the defendant had not obtained any letters patent whatsoever; wrote, [painted, printed, moulded, cast, carved, engraved, *or* stamped,] the name of the plaintiff, [*or* the said *A. B.*,] to wit, the name ["*J. Smith*,"] contrary to the form of the statute in such case made and provided, whereby, and by force of the said statute the defendant forfeited for his said offence the sum of 50*l.*, and thereby and by force of the said statute an action hath accrued to the plaintiff, who sues as aforesaid, to demand and have of and from the defendant, as well for our said Lady the Queen, as for himself in this behalf, the said sum of 50*l.* so forfeited, as aforesaid parcel of the said sum above demanded.

2nd Count. *For writing, &c. the name of patentee upon an article sold or used by defendant.*

And whereas also before the committing of the offence by the defendant hereinafter in this count hereinafter mentioned, and before the commencement of this suit, the said letters patent in the said first count firstly mentioned, having been so made as aforesaid, and the said specification or instrument in writing under the hand and seal of the plaintiff, [*or* the said *A. B.*,] having been so made and enrolled as aforesaid. And the said letters patent having been so granted to, and obtained by, the plaintiff, [*or* the said *A. B.*,] for the sole making and vending, and the plaintiff having by force and virtue of the same letters patent obtained and acquired the sole right and privilege of making and vending, of certain things, to wit, certain [*Lamps*,] to be made and manufactured according to, and by means of, the said invention in the said letters patent mentioned as aforesaid, the defendant well knowing the premises, afterwards, and after the making of the said statute in the said first count mentioned, and also after the making of the said letters patent as afore-

said, within the said term of fourteen years by the same letters patent granted, and before the commencement of this suit, (to wit,) on the [*tenth*] day of [*October*,] in the year of our Lord [*one thousand eight hundred and forty-five*, within England aforesaid, against the will and without any leave, licence, or consent in writing of the plaintiff, [*or* the said *A. B.*,] or any assigns or assign of the plaintiff, [or of the said *A. B.*,] wrongfully, knowingly, injuriously, deceitfully, and fraudulently, and against the form of the statute in such case made and provided * upon a certain thing, to wit, a certain [*Lamp*,] then used [*or* sold] by the defendant, the said thing, to wit, the said [*Lamp*,] then being a thing, to wit, a [*Lamp*,] which had been wrongfully made according to, and by means of the said invention, and against the said privilege granted by the said letters patent as aforesaid, and then being a thing, to wit, a [*Lamp*,] for the sole making and vending of which the plaintiff, [*or* the said *A. B.*,] had theretofore, to wit, on the day and year in that behalf hereinbefore mentioned, obtained the said letters patent, and then also being a thing, to wit, a [*Lamp*,] for the sole making or selling of which the defendant had not obtained any letters patent whatsoever, wrote, &c. [*The residue of this count will be the same as in the first.*]

3rd Count.

For writing, &c. the word "patent," "letters patent," or "by the Queen's patent," upon an article made, used, or sold by defendant with the intent to imitate patentee's mark.

And whereas also before the committing of the offence, &c. [*proceed as in the second count down to the * and then as follows.*] Upon a certain thing, to wit, a certain [*Lamp*,] then made, [used, *or* sold] by the defendant, the said thing, to wit, the said [*Lamp*,] then being a thing, to wit, a [*Lamp*,] which had not been purchased from the plaintiff, [*or* the said *A. B.*,] or any person who purchased it from or under the plaintiff, [*or* the said *A. B.*,] and then being a thing, to wit, a [*Lamp*,] which had been and was wrongfully made according to, and by means of, the said invention, and against the said sole privilege granted by the said letters patent as aforesaid, and then being a thing, to wit, a [*Lamp*,] for the sole making and vending of which the plaintiff, [*or* the said *A. B.*,] had theretofore, to wit, on the day and year in that behalf hereinbefore mentioned, obtained the said letters patent, and then also being a thing, to wit, a [*Lamp*,] for the sole making or selling of which the defendant had not obtained any letters patent whatsoever, * wrote, [painted, printed, moulded, cast, carved, engraved, stamped, *or* marked] the word "patent," [*or* the words "letters patent," *or* the words "by the Queen's patent," *or any words of the like kind, meaning, or import*,] with the view and with the intent of thereby imitating and counterfeiting a certain stamp, mark, and device of the plaintiff, [*or* the said *A. B.*,] to wit, the stamp, mark, and device "patent," [*or* "letters patent," &c. *as the case may be*,] of the plaintiff, [*or* the said *A. B.*,] by him theretofore used and employed to stamp, mark, and distinguish certain things, to wit, [*Lamps*,] made and sold by the plaintiff, [*or* the said *A. B.*,] and for the sole making and vending of which the plaintiff, [*or* the said *A. B.*,] had so obtained the said letters patent as aforesaid, contrary to the form of the statute in such case made and provided, &c. [*Conclude as in the first count.*]

4th Count. And whereas also before the committing of the offence, &c. (*this count*

*will be the same as the third count down to the *, after which proceed as follows,*) imitated and counterfeited a certain stamp, mark and device of the plaintiff, [*or* the said *A. B.*,] to wit, a certain stamp, mark and device by the plaintiff, [*or* the said *A. B.*,] theretofore used and employed to stamp, mark, distinguish, and denote certain things, to wit, [*Lamps,*] made and sold by the plaintiff, [*or* the said *A. B.*] and for the sole making and vending of which the plaintiff, [*or* the said *A. B.*,] had so, to wit, on the day and year in that behalf hereinbefore mentioned, obtained the said letters patent as aforesaid, contrary to the form of the statute in such case made and provided, &c. [*Conclude as in the first count*] (*u*). *For counterfeiting patentee's stamp, mark, or device.*

And thereupon as well for our said Lady the Queen as for himself in this behalf the plaintiff brings suit, &c. Conclusion (*x*).

IN THE [EXCHEQUER OF PLEAS.]

The [*sixth*] day of [*January,*] in the year of our Lord [*one thousand eight hundred and forty-six.*] PLEAS. (No. 2.)

[*Doe*] ats. [*Smith.*] } The defendant by [*Charles Holt*] his attorney, [by virtue of the statute in such case made and provided,] says that he does not owe to our said Lady the Queen, and to the plaintiff who sues as aforesaid, or to either of them, the said sum of money in the declaration above demanded, or any part thereof, in manner and form as the plaintiff who sues as aforesaid hath above thereof complained against him this defendant. And of this the defendant puts himself upon the country, &c. Plea of not guilty (*y*). By statute (*z*).

AND for a further plea in this behalf, the defendant says that the said supposed causes of action in the declaration mentioned, did not nor did any of them arise or accrue at any time within one year next before the commencement of this suit, in manner and form as the plaintiff hath thereof complained against him the defendant (*b*). Wherefore the defendant prays judgment if the plaintiff ought to have or maintain his aforesaid action thereof against him the defendant, &c. (No. 3.) Plea of the statute of limitations (*a*).

(*u*) There will be no difficulty from the forms here given in framing a count for any offence committed against the statute.

(*x*) The declaration must not conclude to the damage of the plaintiff.

(*y*) This plea is given by the statute 21 Ja. I. c. 4, s. 4 — and is not taken away by the new pleading rules of H. T. 4 W. IV. See the stat. 3 & 4 W. IV. c. 42, s. 1, under which those rules were made.

(*z*) These words must be inserted in the margin of the plea in pursuance of Reg. Gen. T. T. 1 Vict. 1838.

(*a*) This plea is given by the statute 31 Eliz. c. 5, s. 5, which see in the Appendix.

(*b*) This plea does not need a verification; and it is doubtful whether it is necessary to have the conclusion here added, or indeed any other conclusion. See *Bodenham* v. *Hill*, 7 M. & W. 274.

SECTION VII.

(No. 1.) Particulars respecting a patent against which a *scire facias* is intended to be sued out.

Form of Entries and Proceedings in Actions of scire facias *for Cancelling and Repealing Letters Patent.*

IN THE PETTY BAG, IN CHANCERY.

[*William Winterton,*] of [*Birmingham, in the County of Warwick, Pin Manufacturer,*] is desirous, for certain good and sufficient reasons, of suing out her Majesty's writ of *scire facias* for the purpose of cancelling and repealing letters patent dated the [*nineteenth*] day of [*May,*] in the [*sixth*] year of the reign of her present Majesty, granted to [*Godfrey Watson, of Birmingham aforesaid, Pin Maker,*] for the sole use of an alleged invention of ["*improvements in the manufacture of Pins.*"]

The said [*Godfrey Watson hath filed a bill in Chancery against the said William Winterton, to restrain him from committing certain supposed infringements of the said letters patent,*] but no other legal proceedings have to the knowledge of the said [*W. Winterton*] been taken upon or respecting the said letters patent.

Dated the [*twenty-first*] day of [*October*, 1845.]

(Signed) [*W. H. Rymer,*]
[Chancery Lane,]
Solicitor for the said [*W. Winterton.*]

(No. 2.) Attorney-general's *fiat* for the issuing of a *scire facias.*

(*c*) Upon the usual bond [*or* a bond for 2,000*l.*] (*d*) being given, let the writ issue.

(Signed) [*F. Thesiger*] (*e*).

[*Temple, 1st November*, 1845.]

(No. 3.) *Bond to the* senior clerk of the Petty Bag for payment of costs to the defendant if the patent is not repealed.

KNOW ALL MEN by these presents that we [*W. W. of &c., F. M. of &c., and W. L. of &c.*] are jointly and severally held and firmly bound to [*John Benthall, Esq.*] senior clerk of the Petty Bag in her Majesty's High Court of Chancery, in the penal sum of [1,000*l.*] of good and lawful money of Great Britain, to be paid to the said [*John Benthall,*] or his certain attorney, executors, administrators, or assigns, for which payment to be well and truly made, we bind ourselves and each of us doth bind himself, our several and respective heirs, executors, and administrators, and every of them, for ever by these presents sealed with our seals, dated the [*third*] day of [*November*] in the [*ninth*] year of the reign of our sovereign Lady Victoria, by the grace of God of the United Kingdom of Great

(*c*) The *fiat* is always indorsed upon the draught of the intended writ.

(*d*) Under extraordinary circumstances the Attorney-general will sometimes require a bond to be given for more than the usual amount, which is 1000*l.*; vide *ante*, pr. 387.

(*e*) The Attorney-general's signature.

Britain and Ireland Queen, Defender of the Faith, and in the year of our Lord [1845.]

WHEREAS by certain letters patent of her present Majesty, Queen Victoria, under the Great Seal of the United Kingdom of Great Britain and Ireland, bearing date at Westminster the [*second*] day of [*April*] in the [*first*] year of her reign, reciting that, whereas [*Charles Norton, of the city of Westminster, tallow-chandler,*] had by his petition humbly represented unto her said Majesty that in consequence of a communication made to him by a certain foreigner resident abroad he was in possession of an invention of [*improvements in the manufacture of Candles*]; that the same was new in England, Wales, and the town of Berwick-upon-Tweed, and had not been practised therein by any other person or persons whomsoever to his knowledge or belief; the petitioner therefore most humbly prayed that her said Majesty would be graciously pleased to grant unto him, his executors, administrators, and assigns, her said Majesty's royal letters patent, under the Great Seal of Great Britain, for the sole use, benefit, and advantage of the said invention within England and Wales, and the town of Berwick-upon-Tweed, for the term of fourteen years, pursuant to the statute in that case made and provided; and that her said Majesty, being willing to give encouragement to all arts and inventions which might be for the public good, was graciously pleased to condescend to the petitioner's request; and therefore her said Majesty, of her especial grace, certain knowledge, and mere motion, did, by the said letters patent, for herself, her heirs, and successors, give and grant unto the said [*C. N.*] his executors, administrators, and assigns, her said Majesty's especial licence, full power, sole privilege, and authority, that he, the said [*C. N.,*] his executors, administrators, and assigns, and every of them, by himself and themselves, or by his and their deputy or deputies, servants, or agents, or such others as he, the said [*C. N.,*] his executors, administrators, and assigns should at any time agree with, and no others, from time to time, and at all times thereafter during the term of years therein expressed, should, and lawfully might, make, use, exercise, and vend the said invention within that part of her said Majesty's United Kingdom of Great Britain and Ireland, called England, her dominion of Wales, and town of Berwick-upon-Tweed, in such manner as to him, the said [*C. N.,*] his executors, administrators, and assigns, or any of them should, in his or their discretions seem meet; and that he, the said [*C. N.,*] his executors, administrators, and assigns should, and lawfully might, have and enjoy the whole profit, benefit, commodity, and advantage from time to time coming, growing, accruing, and arising by reason of the said invention, for and during the term of years therein mentioned; to have, hold, exercise, and enjoy the said licence, powers, privileges, and advantages thereinbefore granted, or mentioned to be granted unto the said [*C. N.,*] his executors, administrators, and assigns, for and during, and unto the full end and term of fourteen years from the date of the said letters patent next and immediately ensuing and fully to be complete and ended, according to the statute in such case made and provided.

AND WHEREAS a certain writ of our said Lady the Queen, called a *scire facias*, bearing date at Westminster the [*second*] day of [*November,*] in the [*ninth*] year of the reign of her said Majesty, at the instance and request of the said [*W. W.,*] for certain reasons in the said writ of *scire facias* specified, lately issued out of her said Majesty's High Court of Chancery, directed to the sheriff of Middlesex, whereby our said Lady the Queen commanded the said sheriff that, by good and lawful men of his bailiwick, he should give notice to the said [*C. N.,*] that he, before her said Majesty, in her said Majesty's Chancery, on [*the twenty-fifth*] day of [*November, now instant,*] wheresoever it should then be, to shew if he, the said [*C. N.,*] had or knew anything to say for himself why the said letters patent, so as aforesaid granted to him, the said [*C. N.,*] and the enrolment of the same for the reasons aforesaid, ought not to be cancelled, vacated, and disallowed, and these letters patent restored unto her said Majesty's Chancery, there to be cancelled. And further, to do and receive those things which her said Majesty's Chancery should consider in that behalf.

NOW THE CONDITION of the above-written obligation is such, that if the said letters patent so obtained by, and granted to the said [*C. N.,*] as aforesaid, shall not be cancelled, vacated, or disallowed by means of the said writ of *scire facias*, or of any issue or issues, verdict or verdicts, judgment or judgments, or other proceeding or proceedings to be had, taken, or given, thereupon, or by virtue thereof, then if the said [*W. W., F. M., and W. L.,*] their executors or administrators, or any or either of them do, and shall, upon lawful demand being made of them or any of them for that purpose, well and truly pay, or cause to be paid unto the said [*C. N.,*] his executors, administrators, or assigns, all sum or sums of money, costs, charges, damages, and expenses whatsoever which he, the said [*C. N.,*] his executors, administrators, or assigns shall, or may bear, pay, sustain, or be subject, or put unto, by means, or on account of the said writ of *scire facias*, or of any such issue or issues, verdict or verdicts, or other proceeding or proceedings, to be had, taken, or given, thereupon, or by virtue thereof as aforesaid, or in anywise howsoever relating thereto, (such costs and charges to be taxed and regulated as between attorney and client and not as between party and party,) then the above written obligation to be void or else to remain in full force and effect.

(No. 4.)

Writ of *scire facias* to cancel and repeal a patent.

VICTORIA, by the grace of God of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith, to the sheriff of Middlesex, greeting: Whereas we, [*or* his late Majesty King William the Fourth,] lately by our [*or* his] letters patent under our [*or* his] Great Seal of the said United Kingdom of Great Britain and Ireland, bearing date at Westminster the [*twenty-fourth*] day of [*May,*] in the [*fourth*] year of our [*or* his] reign, reciting that whereas [*Charles Nicholson, of, &c.,*] had by his petition humbly represented unto us, [*or* his said late Majesty,] that in consequence of a communication made to him by a certain foreigner resident abroad, he was in possession of an invention of [*improvements in*

machinery for, &c.]; That the same was new in England, Wales, and the town of Berwick upon Tweed, and had not been practised therein by any other person or persons whomsoever to his knowledge and belief; The petitioner therefore most humbly prayed that we [or his said late Majesty] would be graciously pleased to grant unto him, his executors, administrators, and assigns, our royal letters patent under the Great Seal of Great Britain for the sole use, benefit, and advantage of the said invention within England, Wales, and the town of Berwick upon Tweed, for the term of fourteen years, pursuant to the statute in that case made and provided: And we [or his said late Majesty] having been willing to give encouragement to all arts and inventions which might be for the public good, were [*or* was] graciously pleased to condescend to the petitioner's request: Therefore we [*or* his said late Majesty] of our [*or* his] especial grace, certain knowledge, and mere motion, did by our [*or* his] said letters patent for us, [*or* himself] our [*or* his] heirs, and successors, give and grant unto the said [*C. N.*,] his executors, administrators, and assigns, our [*or* his said late Majesty's] especial licence, full power, sole privilege, and authority, that he the said [*C. N.*,] his executors, administrators, and assigns, and every of them by himself and themselves, or by his and their deputy or deputies, servants or agents, or such others as he the said [*C. N.*,] his executors, administrators, or assigns, should at any time agree with and no others, from time to time, and at all times thereafter during the term of years therein expressed, should and lawfully might make, use, exercise, and vend the said invention within that part of our [*or* his said late Majesty's] United Kingdom of Great Britain and Ireland, called England, our [*or* his] dominion of Wales, and town of Berwick upon Tweed, in such manner as to him the said [*C. N.*,] his executors, administrators, and assigns, or any of them should in his or their discretions seem meet: And that he the said [*C. N.*,] his executors, administrators, and assigns, should and lawfully might have and enjoy the whole profit, benefit, commodity, and advantage from time to time coming, growing, accruing, and arising by reason of the said invention for and during the term of years therein mentioned. To have, hold, exercise, and enjoy the said licences, powers, privileges, and advantages thereinbefore granted or mentioned to be granted unto the said [*C. N.*,] his executors, administrators, and assigns, for and during, and unto the full end and term of fourteen years from the date of our [*or* the] said letters patent next and immediately ensuing, and fully to be complete and ended according to the statute in such case made and provided. And to the end that he the said [*C. N.*,] his executors, administrators, and assigns, and every of them might have and enjoy the full benefit and the sole use and exercise of the said invention according to our [*or* his said late Majesty's] gracious intention thereinbefore declared, we [*or* his said late Majesty] did by our [*or* his] said letters patent for us, [*or* himself] our [*or* his] heirs, and successors, require and strictly command all and every person and persons, bodies politic, corporate, and all other our [*or* his] subjects whatsoever, of what estate, quality, or degree, name, or condition soever they were within that said part

of our [*or* his] United Kingdom of Great Britain and Ireland, called England, our [*or* his] dominion of Wales, and town of Berwick upon Tweed aforesaid, that neither they nor any of them, at any time during the continuance of the said term of fourteen years thereby granted, either directly or indirectly do make, use, or put in practice the said invention, or any part of the same so attained unto by the said [*C. N.*,] as aforesaid, or in anywise counterfeit, imitate, or resemble the same, nor should make, or cause to be made any addition thereunto, or subtraction from the same, whereby to pretend himself, or themselves the inventor or inventors, devisor or devisors thereof, without the licence, consent, or agreement of the said [*C. N.*,] his executors, administrators or assigns, in writing under his or their hands and seals first had and obtained in that behalf, upon such pains and penalties as could or might be justly inflicted on such offenders for their contempt of that our [*or* his said late Majesty's] royal command, and further to be answerable to the said [*C. N.*,] his executors, administrators, and assigns, according to law for his and their damages thereby occasioned: And in which said letters patent, amongst other provisoes and things therein expressed, were and are contained provisoes to the purport and effect following, (that is to say,) provided always, and those our [*or* his said late Majesty's] said letters patent were therein declared to be upon this condition, that if at any time during the said term thereby granted, it should be made appear to us, [*or* his said late Majesty] our [*or* his] heirs, or successors, or any one or more of our [*or* his] or their Privy Council, that that our said grant was contrary to law, or prejudicial, or inconvenient to our [*or* his] subjects in general, or that the said invention was not a new invention as to the public use and exercise thereof, in that said part of our [*or* his] United Kingdom of Great Britain and Ireland, called England, our [*or* his] dominion of Wales, and town of Berwick upon Tweed aforesaid, or not first introduced therein by the said [*C. N.*] as aforesaid; then upon signification or declaration thereof to be made by us, [*or* his said late Majesty] our [*or* his] heirs, or successors, under our [*or* his] or their signet or Privy Seal, or by the Lords and others of our [*or* his] or their Privy Council, or any six or more of them under their hands, our [*or* his said late Majesty's] said letters patent should forthwith cease, determine, and be utterly void to all intents and purposes, any thing thereinbefore contained to the contrary thereof in anywise notwithstanding: Provided always, that if the said [*C. N.*] should not particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, by an instrument in writing under his hand and seal, and cause the same to be enrolled in our [*or* his said late Majesty's] High Court of Chancery within [*six*] calendar months next and immediately after the date of our [*or* his] said letters patent, that then our [*or* his] said letters patent, and all liberties and advantages whatsoever thereby granted, should utterly cease, determine, and become void, any thing thereinbefore contained, to the contrary thereof in anywise notwithstanding, as by the said letters patent enrolled in our [*or* his said late Majesty's] said Chancery, (amongst other things,) more fully and at

large appears. And whereas we are given to understand that although the said [*C. N.*] did cause a certain specification or instrument in writing under his hand and seal, bearing date the [*eleventh*] day of [*October,*] in the year of our Lord [1840,] [*together with certain drawings thereunto annexed,*] to be enrolled in our [*or* his said late Majesty's] said High Court of Chancery at Westminster, in the county of Middlesex, within [*six*] calendar months next and immediately after the date of our [*or* his] said letters patent, to wit, on the day and year last aforesaid. And which said specification or instrument in writing was, and is in the words, letters, and figures following, (that is to say,) "TO ALL TO WHOM THESE PRESENTS," &c. [*Here set out the whole of the specification,*] as by the enrolment of the said specification or instrument in writing in our [said] High Court of Chancery, at Westminster aforesaid, fully and at large appears. [*And true copies of which said several drawings, and of the said figures and letters thereon, are hereunto annexed,*] the said [*C. N.*] by the said instrument in writing, [*and the said drawings thereunto annexed,*] pretending that he did thereby, in compliance with the said proviso, particularly ascertain and describe the nature of the said supposed invention, and in what manner the same is to be performed:

1. YET we are also given to understand and be informed, THAT (*f*) the said [*C. N.*] did not invent the said supposed invention in the said petition and letters patent mentioned. *Suggestions.*

2. AND ALSO that the said [*C. N.*] was not the true and first inventor within this realm of the said supposed invention.

3. AND ALSO that the said supposed invention was not communicated to the said [*C. N.*] by any foreigner resident abroad, in manner and form as by the said petition of the said [*C. N.*] was falsely suggested and represented unto us.

4. AND ALSO that the said supposed invention was not attained unto as by the said [*C. N.*] as in the said letters patent mentioned.

5. AND ALSO that the said supposed invention in the said petition and letters patent mentioned was not any improvement whatever [*in machinery for, &c.*] as by the said petition of the said [*C. N.*] falsely suggested and represented unto us.

6. AND ALSO that the said supposed invention in the said petition and letters patent mentioned was not new in England, Wales, and Berwick upon Tweed, [*or* in this realm,] as by the said petition of the said [*C. N.*] falsely suggested and represented unto us.

7. AND ALSO that it was false and untrue that the said alleged and pretended invention had not been practised in England, Wales, and Berwick upon Tweed, [*or* in this realm,] by any other person or persons whomsoever to his the said [*C. N's.*] knowledge, information, or belief, as by the said petition of the said [*C. N.*] falsely suggested and represented unto us.

(*f*) Such of the suggestions here given must be selected as are applicable to the circumstances of the case. Although the suggestions are numbered in the above form, they are not to be so in the writ.

8. AND ALSO that the said petition and the several suggestions and representations therein made and contained are wholly and entirely false and untrue.

9. AND ALSO that the said supposed invention at the time of the making of the said letters patent was not a new invention as to the public knowledge, use, and exercise thereof in this realm.

10. AND FURTHER that the said alleged and pretended invention was not first introduced therein by the said [*C. N.*]

11. AND ALSO that the said supposed invention was not at the time of the making of the said letters patent an invention of a new manufacture within this realm.

12. AND ALSO that the said supposed invention was not an invention of any manner of manufacture.

13. AND ALSO that the said privilege which the said letters patent purport to grant was not a privilege of working or making any manner of manufacture.

14. AND ALSO that the said supposed invention was not at the time of the making of the said letters patent, of any use, benefit, or advantage whatsoever to the public.

15. AND ALSO that the said [*C. N.*] did not by the said specification or instrument in writing under his hand and seal, or by any other instrument in writing under his hand and seal; particularly ascertain and describe the nature of the said supposed invention, and in what manner the same supposed invention is to be performed.

16. AND MOREOVER, that the said [*C. N.*] did not within [*six*] calendar months next, and immediately after the date of the said letters patent, cause any instrument in writing under his hand and seal, particularly ascertaining and describing the nature of the said supposed invention; and in what manner the same is to be performed, to be inrolled in our said High Court of Chancery; but hath neglected so to do, contrary to the form and effect of the said letters patent and of the said last-mentioned proviso in that behalf.

BY MEANS of which said several premises the said letters patent, so as aforesaid granted to the said [*C. N.,*] were and are, and ought to be void, and of no force or effect in law.

[(*g*) And whereas we are given to understand and be informed that the said letters patent, and the said liberties, privileges, and advantages, supposed to be thereby granted, or some part or parts thereof, has or have been assigned unto [*A. B.*] *of, &c.*, and [*C. D.*] *of, &c.*]*

AND we being willing that what is just should be done in the premises, command you, that by good and lawful men of your bailiwick, you give notice to [*each of them,*] the said [*C. N.,*] [*A. B. and C. D.,*] that he be before us in our Chancery, on the [*twenty-first*] day of this present month of [*November,*] wheresoever it shall then be, to show if he hath or knoweth anything to say for himself why the said letters patent, so as aforesaid granted to the said [*C. N.,*] and the enrolment of the same,

(*g*) This allegation will, of course, only be inserted when it is known that the patent has been assigned.

for the reasons aforesaid, ought not to be cancelled, vacated, and disallowed, and those letters patent restored unto our said Chancery, there to be cancelled, and further to do and receive those things which our said Chancery shall consider in this behalf; And have you there the names of those by whom you shall so give him [*or each of them the said C. N., A. B. and C. D.*] notice, and this writ. WITNESS ourself at Westminster the [*second*] day of [*November,*] in the [*eighth*] year of our reign.

[*Langdale*] (*h*).
[*Allen*] (*i*).

(No. 5.) Testatum *scire facias* to repeal and cancel a patent.

VICTORIA, by the grace of God of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith. To the sheriff of [*Surrey,*] greeting: Whereas we lately by our letters patent, &c. [*proceed precisely as in the first writ, No. 4, ante, p. 710, down to the *, ante, p. 714, after which proceed as follows.*] AND we being willing that what is just should be done in the premises, lately commanded our sheriff of Middlesex that by good and lawful men of his bailiwick he should give notice to [*each of them*] the said [*C. N.,*] [*A. B. and C. D.,*] that he should be before us in our Chancery, at a certain day now past, wheresoever it should then be, to show if he had or knew any thing to say for himself why the said letters patent so as aforesaid granted to him, the said [*C. N.,*] and the enrolment of the same letters patent, for the reasons aforesaid, ought not to be cancelled, vacated, and disallowed, and those letters patent restored into our said Chancery, there to be cancelled. And further to do and receive those things which our said Chancery should consider in this behalf. And that the said sheriff should have there then the names of those by whom he should so give the said [*C. N.,*] [*A. B. and C. D.,*] notice, and our said writ.

At which day, in our said writ contained, our sheriff of Middlesex, to wit, [*M. G.*, Esquire, and *G. F.*, Esquire,] returned to us in our Chancery aforesaid that the said [*C. N.,*] [*A. B. and C. D.,*] had not [*nor had any of them*] anything in his bailiwick whereby he could give him the said [*C. N.*] notice, as by the said writ he the said sheriff was commanded, nor was the said [*C. N.,*] [*A. B. and C. D. or any of them,*] found in the same.

And whereas it is testified before us in our Chancery aforesaid that the said [*C. N.,*] [*A. B. and C. D.,*] has [*or* have] sufficient in your bailiwick whereby you may give him [*or* each of them] notice.

Therefore we command you that by good and lawful men of your bailiwick you give notice to [*each of them*] the said [*C. N.,*] [*A. B. and C. D.,*] that he be before us in our Chancery, on the [*eleventh*] day of [*January*] now next ensuing, wheresoever it shall then be, to show if he hath or knoweth anything to say for himself why the said letters patent, so as aforesaid granted to him the said [*C. N.,*] and the enrolment of the same for the reasons aforesaid, ought not to be cancelled, vacated and

(*h*) The name of the Master of the Rolls.

(*i*) The name of one of the clerks of the Petty Bag who is prosecutor's nominal attorney.

disallowed, and these letters patent restored unto our said Chancery, there to be cancelled. And further to do and receive those things which our said Chancery shall consider in this behalf. And have you there the names of those by whom you shall so give him [*or* each of them] notice, and this writ. WITNESS ourself at Westminster the [*twenty-fifth*] day of [*November,*] in the [*eighth*] year of our reign.

[*Langdale*] (*k*).
[*Allen*] (*l*).

(No. 6.) Sheriff's warrant to two of his bailiffs to summons the defendant.

[MIDDLESEX] (to wit). To [*A. B. and C. D.,*] my bailiffs.

BY VIRTUE of her Majesty's writ to me directed, and which said writ is in the words and figures, or to the purport and effect following (that is to say) (*m*), "Victoria by the grace," &c. [*Here copy the whole of the writ of scire facias.*] I command that you give notice to [*each of them*] the said [*C. N.,*] [*A. B. and C. D.,*] in the said writ named, that he be in the Chancery of our said Lady the Queen, at the time in the said writ mentioned, to show cause, as by the said writ he is required; as by the said writ I am commanded.

Dated this [*fourth*] day of [*November,* 1845.]

[*J. K.*]
[*L. M.*] } Sheriff.

(No. 7.) Another form of warrant.

[YOKKSHIRE] (to wit), [*Abraham King,*] Esquire, sheriff of [*Yorkshire,*] to [*A. B.*] and [*C. D.,*] his bailiffs.

By virtue of the writ of our Lady the Queen to me directed, (a copy whereof is hereunto annexed,) whereby I am commanded that, by good and lawful men of my bailiwick, I shall make known to [*R. S., of, &c.*] in the said writ named, that he be in the Chancery of our said Lady the Queen, on the [*eleventh*] day of [*January*] next coming, wheresoever it (*n*) shall then be in England, to show if he hath or knoweth anything to say for himself why certain letters patent, granted to him for the sole use of an invention of ["*improvements,*" *&c. Here insert the title of the invention,*] as in the said writ mentioned, and the enrolment of the same letters patent, for certain reasons in the said writ mentioned, ought not to be cancelled, vacated, and disallowed, and those letters patent restored into the said Chancery of our said Lady the Queen, there to be cancelled. And further to do and receive those things which the said Chancery of our said Lady the Queen should consider in that behalf. NOW I the said sheriff command you that you make known and give notice to the said [*R. S.*] that he be and appear in the said Chancery of our said Lady

(*k*) The name of the Master of the Rolls.

(*l*) The name of the clerk of the Petty Bag who is the nominal-attorney for the prosecutor.

(*m*) This form of warrant is unnecessarily long, (the whole writ being set out,) and when the writ has drawings annexed to it, the form is inapplicable. The next form seems to be the best for all general purposes.

(*n*) That is, the Chancery.

the Queen, at the time in the said writ mentioned, to show cause and to do and receive such things, as by the said writ he is required; As by the said writ I am commanded.

Dated this [*first*] day of [*December*, 1845.]

By the Sheriff,
or
[*Abraham King*,] Sheriff.

IN THE PETTY BAG, IN CHANCERY. (No. 8.)

Rule to return a writ of *scire facias*.

[*Hilary*] Term, in the [*eighth*] year of the reign of Queen Victoria.

[*Second*] rule day.

The Queen
v.
[*Clark & another.*]

It is ordered that the sheriff of the county of [*Stafford*] shall within [*six*] (*o*) days next after notice of this rule to be given to his under-sheriff, peremptorily return the writ of [*testatum*] *scire facias* issued in this cause.

[*Bentall*] (*p*).

IN THE PETTY BAG, IN CHANCERY. (No. 9.)

Declaration.

[*Hilary*] Term, in the [*eighth*] year of the reign of Queen Victoria.

ENGLAND (to wit). Our Lady the Queen sent to her sheriff of Middlesex, [*or if there was a testatum scire facias, name the county to the sheriff of which it was directed,*] her writ closed in these words, "Victoria by the grace of God," &c. [*Here the whole of writ of scire facias, or testatum scire facias, as the case may be, is to be inserted, after which proceed as follows.*] At which day, that is to say, on the said [*eleventh*] day of [*January*,] the said sheriff, to wit, [*L. K.*] Esquire, and [*N. M.*] Esquire, sheriff of Middlesex, [*or the county into which the testatum writ was directed,*] returned to our said Lady the Queen, in her Chancery at Westminster aforesaid, that by [*G. S.*] and [*R. C.*,] good and lawful men of his bailiwick, he had given notice to the said [*C. N.*,] as he the said sheriff was by the said writ commanded. And thereupon the said [*C. N.*,] by [*William Gawler*,] Esquire, his attorney comes *. Whereupon Sir [*William Webb Follett*,] Knight, Attorney-general of our said Lady the Queen, who for our said Lady the Queen prosecutes in this behalf, being present here in Court in his own proper person, prays that the said letters patent, and the enrolment of the same, may be cancelled, vacated, and disallowed, and the said letters patent restored into her said Majesty's Chancery, here to be cancelled.

(*o*) The rule will be returnable in four days, if the writ is directed to the sheriffs of London or Middlesex.

(*p*) The name of the clerk in the Petty Bag to whose division the case belongs.

(No. 10.) IN THE PETTY BAG, IN CHANCERY.

Declaration concluding with a nolle prosequi to some of the suggestions in the writ.

[*Hilary*] Term, in, &c.

ENGLAND (to wit). Our Lady the Queen, &c. [*Proceed as in the last form down to the* *, *and then as follows.*] Whereupon Sir [*William Webb Follett,*] Knight, Attorney-General of our said Lady the Queen, who for our said Lady the Queen prosecutes in this behalf, being present here in Court in his own proper person, as to the [*first*] suggestion above contained, whereby it is alleged that [*here state the suggestion,*] saith, that he will not further prosecute this suit against the said [*C. N.*] in respect of the matters and reasons in the said [*first*] suggestion mentioned. And therefore as to the said [*first*] suggestion above contained let the said [*C. N.*] go thereof without day, &c. And as to the [*fourth*] suggestion contained, whereby it is alleged that, &c. [*state the suggestion,*] the said Sir [*William Webb Follett,*] Knight, who prosecutes as aforesaid, says that he will not further prosecute, &c. [*proceed as before, and after the nolle prosequi conclude as follows,*] And the said Sir [*William Webb Follett,*] Knight, who prosecutes as aforesaid, prays that for the residue of the matters and reasons aforesaid, the said letters patent, and the enrolment of the same, may be cancelled, vacated, and disallowed, and the said letters patent restored into her said Majesty's Chancery, here to be cancelled.

(No. 11.) IN THE PETTY BAG, IN CHANCERY.

Rule to answer.

[*Hilary*] Term, in the [*eighth*] year of the reign of Queen Victoria.

(*a*) [*First*] rule day.

The Queen
v.
[*Clark & another.*]

Unless the defendants answer in eight days let judgment be entered.

[*Plumer*] (*r*).

(No. 12.) Nolle prosequi after declaration, and before plea to some of the suggestions in a *scire facias.*

AND the said Sir [*W. W. F.,*] Knight, who prosecutes as aforesaid, as to the [*third*] suggestion above contained, whereby it is alleged that [*the said C. N. was not in possession of the said supposed invention, as by the said petition of the said C. N. suggested and represented unto her said Majesty,*] saith, that he will not further prosecute this suit against the said [*C. N.*] in respect of the matters and reasons in the said [*third*] suggestion mentioned. And therefore as to the said [*third*] suggestion above contained let the said [*C. N.*] go thereof without day, &c. And as to the [*seventh*] suggestion above contained, whereby it is alleged that, &c. [*here state the suggestion,*] the said Sir [*W. W. F.,*]

(*q*) Or the second, or other rule day of the term.

(*r*) The name of the clerk to whose division the action belongs.

Knight, who prosecutes as aforesaid says, that he will not further prosecute, &c. [*conclude as before.*]

IN THE PETTY BAG, IN CHANCERY. (No. 13.)

[*Trinity*] Term, in the [*eighth*] year of the reign of Queen Victoria.

Plea in abatement that defendant has assigned the patent (s).

[*H. W. C.*] ats. The Queen. } AND the said [*H. W. C.*] prays judgment of the said writ, because he says that before the day of suing out the said [*first*] mentioned writ (*t*), and before the commencement of this suit, to wit, on the [*fifth*] day of [*March,*] in the [*third*] year of the reign of our Lady the now Queen, and in the year of our Lord, [1840,] he, the said [*H. W. C.,*] by a certain indenture then made between the said [*H. W. C.*] of the one part, and [*C. L. C. C. of, &c.*] of the other part, and which said indenture, sealed with the seals of the said [*H. W. C.*] and [*C. L. C. C.*] respectively, having been delivered to the said [*C. L. C. C.*] before the commencement of this suit; and there being no counterpart thereof, and neither the said indenture, nor any counterpart thereof being in the custody or possession of the said [*H. W. C.,*] he, the said [*H. W. C.,*] cannot produce the said indenture to the Court here; he, the said [*H. W. C.,*] for the considerations in the same indenture mentioned, did assign, transfer, and set over unto the said [*C. L. C. C.,*] his executors, administrators, and assigns the said letters patent in the said writ mentioned; and all the exclusive right, exercise, and enjoyment of the said invention to be derived from the said letters patent, and thereby granted to the said [*H. W. C.,*] his executors, administrators, and assigns, as in the said letters patent mentioned; and all and singular the liberties, privileges, profits, and emoluments, and advantages whatsoever thereunto belonging, and in anywise to be had therefrom. To have, hold, exercise, and enjoy the said letters patent, and premises, privileges, and authorities thereunto belonging, and all other the premises thereinbefore expressed, to be thereby assigned unto the said [*C. L. C. C.,*] his executors, administrators, and assigns thenceforth during all the residue of the said term in and by the said letters patent granted, and for all other the term and interest of the said [*H. W. C.,*] therein, in as full and beneficial a manner to all intents and purposes as he, the said [*H. W. C.,*] by virtue of the said letters patent, might or could have held or enjoyed the same if the said indenture had not been made. And the said [*H. W. C.*] further says that he, the said [*H. W. C.,*]

(*s*) Vide *ante*, p. 398, respecting this plea. Until recently there was no established practice in the Petty Bag, as to the time within which a plea in abatement is to be pleaded. The Lord Chancellor has however ordered that in future the practice is to be the same as in the other Common Law Courts, and therefore, the plea must now be pleaded within four days.

(*t*) The defendant appeared to the second writ, the first having been returned *nihil*.

afterwards, and after the making of the said indenture, and before the day of the suing out of the said writ, and before the commencement of this suit, to wit, on the day and year last aforesaid, delivered the said letters patent and indenture to the said [*C. L. C. C.*,] who then accepted the said assignment of the said letters patent and privilege by the said indenture assigned, and who then received, and had of and from him, the said [*H. W. C.*,] the said letters patent and indenture: By virtue of which said indenture and assignment, and of the said acceptance thereof, and of the said delivery of the said letters patent and indenture to the said [*C. L. C. C.*,] as aforesaid, he, the said [*C. L. C. C.*,] then and thenceforth became and was possessed of and interested in the said letters patent, and the said licence, power, privilege, and authority thereby granted, as in the said writ mentioned, for the sole and exclusive use and benefit of him, the said [*C. L. C. C.*] And the said [*H. W. C.*] further says, that by virtue of the said indenture and assignment, and acceptance thereof, and of the said delivery of the said letters patent to the said [*C. L. C. C.*] as aforesaid, he, the said [*H. W. C.*,] immediately after the making of the said indenture, and the delivery of the said letters patent and indenture to the said [*C. L. C. C.*] as aforesaid, to wit, on the day and year last aforesaid, became, and was divested of, and ceased to have or possess any right, title, or interest whatsoever to or in the said letters patent, licence, power, privilege, and authority, or any part thereof, and hath not at any time afterwards or since had, and hath not now any right, title, or interest whatsoever to or in the said letters patent, licence, power, privilege, and authority, or any part thereof. And the said letters patent have not at any time since the making of the said indenture, and the delivery of the said letters patent and indenture to the said [*C. L. C. C.*] as aforesaid, and are not now in the custody, power, or control of him the said [*H. W. C.*] And this the said [*H. W. C.*] is ready to verify. Wherefore he prays judgment of the said writ, and that the same may be quashed, &c. (*u*).

(No. 14.) IN THE PETTY BAG, IN CHANCERY.

Demurrer to the whole declaration.

[*Hilary*] Term, in the [*eighth*] year of the reign of Queen Victoria (*x*).

[*Smith*] ats. The Queen. } AND the said defendant [*John Smith*] says, that our said Lady the Queen ought not to impeach the said letters patent by reason of the several matters in the said writ (*y*) mentioned and contained, because he, the said defendant [*J. S.*,] says, that the said writ and declaration, and the said several matters therein

(*u*) The plea must be verified by affidavit in the usual way.

(*x*) If the demurrer is filed in vacation it must be entituled as of the preceding term.

(*y*) A defendant answers upon the *writ* in *scire facias*.

mentioned and contained are not sufficient in law to impeach the said letters patent, or to cause the said letters patent to be cancelled or vacated, or to compel him the said [*J. S.*] to answer thereto; and that he the said defendant [*J. S.*] is not bound by law to answer the same; And this the said defendant [*J. S.*] is ready to verify, &c. Wherefore by reason of the insufficiency of the said writ and declaration, and the said several matters therein mentioned and contained, the said defendant [*J. S.*] *prays judgment*, and that he *may* be dismissed and discharged by the Court here of the premises in the said writ and declaration mentioned and contained, and from answering the said writ and declaration, and the said several matters therein mentioned and contained, &c. (*z*).

IN THE PETTY BAG, IN CHANCERY.

(No. 15.)

Demurrer to one of the suggestions in a *scire facias*.

[*Michaelmas*] Term in the [*seventh*] year of the reign of Queen Victoria.

[*Smith*] ats. The Queen. } AND the said defendant [*J. S.*] as to the [*fifth*] suggestion in the said writ contained, whereby it is alleged that, &c., [*here insert the suggestion to which the demurrer is intended to apply,*] says that our said Lady the Queen ought not to impeach the said letters patent by reason of the matters in the said [*fifth*] suggestion mentioned and contained, because he the said defendant [*J. S.*] says that the said suggestion and the said matters therein mentioned and contained, are not sufficient in law to impeach the said letters patent, or to compel him the said [*J. S.*] to answer thereto, and that he the said defendant [*J. S.*] is not bound by law to answer the same. And this he the said defendant [*J. S.*] is ready to verify, &c. Wherefore by reason of the insufficiency of the said [*fifth*] suggestion, and the said matters therein mentioned and contained, the said defendant [*J. S.*] prays judgment, and that he may be dismissed and discharged by the Court here of the premises in the said [*fifth*] suggestion contained, and from answering the said [*fifth*] suggestion and the said matters therein mentioned and contained, &c. (*a*).

IN THE PETTY BAG, IN CHANCERY.

(No. 16.)

Special demurrer.

[*Easter*] Term in the [*fourth*] year of the reign of Queen Victoria.

[*Smith*] ats. The Queen. } AND the said defendant [*J. S.*] &c. [*Here insert the demurrer in one of the two last forms according to circumstances, and then proceed as follows.*] And the said defendant [*J. S.*] according to the form of the statute in such case made

(*z*) If the defendant demurs on the ground of defects in form, he must state such causes of demurrer specially. See the Form, *post*. The demurrer must be signed by counsel.

(*a*) If there are any causes of special demurrer they must be stated. See the next Form.

and provided, states and shows to the Court here the following causes of demurrer to the said writ and declaration, (that is to say,) that, &c. [*Here state the particular causes of special demurrer, and then conclude thus.*] And also that the said writ and declaration are [*or* the said [*fifth*] suggestion is] in other respects uncertain, informal, and insufficient.

(No. 17.) IN THE PETTY BAG, IN CHANCERY.

Joinder in demurrer by the Attorney-general.

[*Trinity*] Term in the [*third*] year of the reign of Queen Victoria.

The Queen *v.* [*Smith.*] } AND the said Sir [*F. P.*] who prosecutes as aforesaid, [*or* Sir *T. W.*, Knt. the now Attorney-general of our said Lady the Queen, who for our said Lady the Queen now prosecutes in this behalf (*b*),] for our said Lady the Queen says, that the said writ and declaration, and the said several matters therein mentioned and contained, [*or* the said [*fifth*] suggestion, and the said matters therein mentioned and contained,] are good and sufficient in law to cause the said letters patent to be cancelled and vacated, and to compel the said defendant [*J. S.*] to answer the said matters. Wherefore for want of a sufficient answer in this behalf, the said [Sir *F. P.*,] who prosecutes as aforesaid, for our said Lady the Queen prays judgment, and that the said letters patent, and the said enrolment of the same letters patent, may be cancelled, vacated, and disallowed; and the said letters patent restored into her said Majesty's Chancery here to be cancelled.

(No. 18.) IN THE PETTY BAG, IN CHANCERY.

Pleas in bar to the suggestions in a writ of scire facias.

[*Michaelmas*] Term in the [*sixth*] year of the reign of Queen Victoria (*c*).

[*Smith*] ats. The Queen. } AND the said [*Jacob Smith,*] as to the said [*first*] suggestion in the said writ contained, whereby it is suggested and alleged that the said [*J. S.*] did not invent the said invention in the said writ mentioned; says that he the said [*J. S.*] did invent the said invention: And of this the said [*J. S.*] puts himself upon the country, &c.

2. And as to the said [*second*] suggestion in the said writ contained, whereby it is suggested and alleged that the said [*J. S.*] was not the true and first inventor within this realm of the said invention; the defendant [*J. S.*] says that he the said [*J. S.*] was the true and first inventor within this realm of the said invention: And of this the defendant puts himself upon the country, &c.

(*b*) If there has been any change in the office of Attorney-general since the last pleading, the words within brackets must be used.

(*c*) The pleas must be entituled as of the term in which they are filed if filed in term time; but if filed in vacation then as of the preceding term.

3. And as to the said [*third*] suggestion in the said writ contained, whereby it is suggested and alleged that the said invention was not communicated to the said [*J. S.*] by a foreigner resident abroad, as by the said petition of the said [*J. S.*] in the said writ mentioned, suggested, and represented to her said Majesty; the defendant [*J. S.*] says that the said invention was communicated to the said [*J. S.*] by a certain foreigner, to wit, [*A. B.*] resident abroad as by the said petition of the said [*J. S.*] in the said writ mentioned, was suggested and represented unto her said Majesty: And of this the defendant puts himself upon the country, &c.

4. And as to the said [*fourth*] suggestion in the said writ contained, whereby it is suggested and alleged that the said invention was *not* attained unto by the said [*J. S.*] as in the said letters patent mentioned; the defendant [*J. S.*] saith that the said invention was attained unto by him the said [*J. S.*] as in the said letters patent mentioned: And of this the defendant puts himself upon the country, &c.

5. And as to the said [*fifth*] suggestion in the said writ contained, whereby it is suggested and alleged that the said invention in the said petition and letters patent mentioned, was not any improvement whatsoever [*in machinery for, &c.*] as by the said petition of the said [*J. S.*] suggested and represented to her said Majesty; the defendant [*J. S.*] saith that the said invention was an improvement [*in machinery for, &c.*] in manner and form as in the said petition alleged: And of this the defendant [*J. S.*] puts himself upon the country, &c.

6. And as to the said [*sixth*] suggestion in the said writ contained, whereby it is suggested and alleged that the said invention in the said petition and letters patent mentioned, was not new in England, Wales, and Berwick upon Tweed (*d*), [or in this realm,] as by the said petition of the said [*J. S.*] suggested and represented unto her said Majesty; the defendant [*J. S.*] saith that the said invention in the said petition, and letters patent mentioned, was new in England, Wales, and Berwick upon Tweed, [or in this realm,] in manner and form as by his said petition suggested and represented unto her said Majesty: And of this the defendant puts himself upon the country, &c.

7. And as to the said [*seventh*] suggestion in the said writ contained, whereby it is suggested and alleged that it was false and untrue that the said invention had not been practised in England, Wales, and Berwick upon Tweed, [or in this realm,] by any other person or persons whomsoever to his the said [*J. S.'s*] knowledge or belief; the defendant [*J. S.*] saith that the said invention had not been practised in England, Wales, or Berwick upon Tweed, [*or* in this realm,] by any other person or persons whomsoever, to his the said [*J. S.'s*] knowledge, information, or belief, in manner and form as by his said petition suggested and represented: And of this the defendant puts himself upon the country, &c.

8. And as to the said [*eighth*] suggestion in the said writ contained, whereby it is suggested and alleged that the said petition and the several suggestions and representations therein made and contained, are wholly

(*d*) The allegation ought to be "new in this realm."

and entirely false and untrue; the said defendant [*J. S.*] saith that the said suggestions and representations in the said petition made and contained, are not, nor is either, or any of them false or untrue: And of this the defendant [*J. S.*] puts himself upon the country, &c.

9. And as to the said [*ninth*] suggestion in the said writ contained, whereby it is suggested and alleged that the said invention, at the time of the making of the said letters patent, was not a new invention as to the public knowledge, use, and exercise thereof in this realm; the said defendant [*J. S.*] saith that the said invention at the time of the making of the said letters patent was a new invention as to the public knowledge, use, and exercise thereof in this realm: And of this the said defendant [*J. S.*] puts himself upon the country, &c.

10. And as to the said [*tenth*] suggestion in the said writ contained, whereby it is suggested and alleged that the said invention was not first introduced into this realm by the said [*J. S.*]; the said defendant [*J. S.*] saith that the said invention was first introduced into this realm by him the said [*J. S.*]: And of this the said defendant [*J. S.*] puts himself upon the country, &c.

11. And as to the said [*eleventh*] suggestion in the said writ contained, whereby it is suggested and alleged that the said inveption was not at the time of the making of the said letters patent an invention of a new manufacture within this realm; the said defendant [*J. S.*] saith that the said invention was at the time of the making the said letters patent an invention of a new manufacture within this realm, to wit, of the new manufacture in the said letters patent mentioned: And of this the said defendant [*J. S.*] puts himself upon the country, &c.

12. And as to the said [*twelfth*] suggestion in the said writ contained, whereby it is suggested and alleged that the said invention was not an invention of any manner of manufacture; the defendant [*J. S.*] says that the said invention was an invention of a certain manufacture, to wit, the manufacture in the said letters patent [and specification] mentioned: And of this the said defendant [*J. S.*] puts himself upon the country, &c.

13. And as to the said [*thirteenth*] suggestion in the said writ contained, whereby it is suggested and alleged that the said privilege which the said letters patent purport to grant, was not a privilege of working or making any manner of manufacture; the said defendant [*J. S.*] says that the said privilege was a privilege of working and making a certain manufacture, to wit, the said manufacture in the said writ [andspecification] mentioned: And of this the said defendant [*J. S.*] puts himself upon the country, &c.

14. And as to the said [*fourteenth*] suggestion in the said writ contained, whereby it is suggested and alleged that the said invention was not, at the time of the making of the said letters patent, of any use, benefit, or advantage whatsoever to the public; the said defendant [*J. S.*] says, that the said invention was, at the time of the making of the said letters patent, of use, benefit, and advantage to the public: And of this the said defendant [*J. S.*] puts himself upon the country, &c.

15. And as to the said [*fifteenth*] suggestion in the said writ contained, whereby it is suggested and alleged that the said [*J. S.*] did not by the said specification or instrument in writing under his hand and seal in the said writ mentioned, or by any other instrument in writing under his hand and seal, particularly describe and ascertain the nature of the said invention, and in what manner the same invention is to be performed; the said defendant [*J. S.*] saith that he did, by the said specification or instrument in writing and drawing in the said writ mentioned and enrolled as therein mentioned, particularly describe and ascertain the nature of his said invention, and in what manner the same was and is to be performed: And of this the said defendant [*J. S.*] puts himself upon the country, &c.

16. And as to the said [*sixteenth*] suggestion in the said writ contained, whereby it is suggested and alleged that the said [*J. S.*] did not within [*six*] calendar months next and immediately after the date of the said letters patent, cause any instrument in writing under his hand and seal, particularly ascertaining and describing the nature of the said invention, and in what manner the same is to be performed, to be enrolled in her said Majesty's High Court of Chancery, but hath neglected so to do contrary to the form and effect of the said letters patent, and of the said proviso in that behalf; the said defendant [*J. S.*] says that he did within [*six*] calendar months next and immediately after the date of the said letters patent, to wit, on the [*twenty-fourth*] day of [*November,*] in the year of our Lord, [1841,] cause a certain instrument in writing under his hand and seal, [to wit, the said specification and instrument in writing under the hand and seal of the said [*J. S.*] in the said writ mentioned,] particularly ascertaining and describing the nature of the said invention, and in what manner the same is to be performed, to be enrolled in her said Majesty's said High Court of Chancery, according to the form and effect of the said letters patent, and the said proviso in that behalf, as by the enrolment of the said specification and instrument in writing now remaining of record in her said Majesty's same Court, fully and at large appears: And this the said defendant [*J. S.*] is ready to verify, &c. (*e*).

IN THE PETTY BAG, IN CHANCERY. (No. 19.)

[*Trinity*] Term, in &c.

Common joinder by the Attorney-general to a plea in bar.

The Queen *v.* [*Smith.*] } AND the said Sir [*F. P.,*] who for our said Lady the Queen, prosecutes as aforesaid for our said Lady the Queen, doth the like.

(*e*) When a plea concludes with a verification it must be signed by counsel.

(No. 20.) The like when there has been a change in the office of Attorney-general.

IN THE PETTY BAG, IN CHANCERY.

[*Trinity*] Term, in &c.

The Queen v. [*Smith.*] } AND Sir [*Frederick Thesiger,*] Knight, the now Attorney-general for our said Lady the Queen, who for our said Lady the Queen prosecutes, for our said Lady the Queen doth the like.

(No. 21.) A second joinder.

AND the said Sir [*F. T.*] who prosecutes as aforesaid, for our said Lady the Queen doth the like.

(No. 22.) Replication to a plea alleging the sufficiency of a specification.

IN THE PETTY BAG, IN CHANCERY.

[*Trinity*] Term, in the [*eighth*] year of the reign of Queen Victoria.

The Queen v. [*Smith.*] } AND the said Sir [*F. Thesiger,*] who prosecutes as aforesaid for our said Lady the Queen, as to the plea of the said defendant [*J. S.*] by him [*lastly*] above pleaded; says that the said [*J. S.*] did not by the said [specification and] instrument in writing under the hand and seal of the said [*J. S.*] in that plea mentioned, particularly ascertain and describe the nature of the said supposed invention, and in what manner the same is to be performed, in manner and form as in the said last plea in that behalf alleged: And this the said Sir [*F. T.,*] who prosecutes as aforesaid, prays may be inquired of by the country, &c.

(No. 23.) Demurrer to a plea in *scire facias.*

IN THE PETTY BAG, IN CHANCERY.

[*Hilary*] Term, in the [*seventh*] year of the reign of Queen Victoria.

The Queen v. [*Smith.*] } AND the said Sir [*F. P.*] who prosecutes as aforesaid, [or Sir [*T. W.*] Knight, the now Attorney-general of our said Lady the Queen, who for our said Lady the Queen now prosecutes in this behalf (*f*),] for our said Lady the Queen says, that the said plea of the said defendant [*J. S.*] by him [*fourthly*] above pleaded, and the matters therein contained are not sufficient in law to bar our said Lady the Queen from impeaching the said letters patent, or prosecuting her said action against the said defendant [*J. S.*] by reason or in respect of the said [*fourth*] suggestion, and the said matters therein mentioned and contained, and to which the said [*fourth*] plea is pleaded; To which said plea in manner aforesaid, by the said defendant [*J. S.*] [*fourthly*] above pleaded, the said Sir [*F. P.,*] who prosecutes as aforesaid for our said Lady the Queen, is under no necessity nor in anywise bound to answer, and this he is ready to verify: Wherefore, for default of a sufficient plea in this behalf the said Sir [*F. P.,*] who prosecutes as aforesaid for our said Lady the Queen, prays judgment, and that the said letters patent, and the

(*f*) These words must be inserted when there has been a change in the office of Attorney-general since declaration.

said enrolment of the same letters patent, may be repealed, cancelled, vacated and disallowed, and the said letters patent restored into her said Majesty's Chancery, here to be cancelled, &c.

IN THE PETTY BAG, IN CHANCERY. (No. 24.)

Rule to join in demurrer.

[*Hilary*] Term in the [*seventh*] year of the reign of Queen Victoria.

[*Third*] rule day.

The Queen v. [*A. B.*] } Unless the defendant joins in demurrer in eight days let judgment be entered.

[*Allen.*]

IN THE PETTY BAG, IN CHANCERY. (No. 25.)

Rejoinder.

[*Hilary*] Term, in the [*ninth*] year of the reign of Queen Victoria.

[*Crawford*] ats. The Queen } AND the said defendant [*John Crawford,*] as to the said replication of the said Sir [*F. T.*] to the said plea of the said [*J. C.*] by him [*thirdly*] above pleaded, [and which the said Sir [*F. T.*] hath prayed, may be enquired of by the country, doth the like.]

IN THE PETTY BAG, IN CHANCERY. (No. 26.)

Joinder to a demurrer to a plea.

[*Hilary*] Term, in the [*seventh*] year of the reign of Queen Victoria.

[*Smith*] ats. The Queen } AND the said defendant [*J. S.*] says that the said plea by him [*fourthly*] above pleaded, and the matters therein contained, are sufficient in law to bar our said sovereign Lady the Queen from prosecuting her said action against him the said defendant [*J. S.*] by reason or in respect of the said [*fourth*] suggestion, and the said matters therein mentioned and contained, and to which the said [*fourth*] plea is pleaded; which said plea and the matters therein contained the said defendant [*J. S.*] is ready to verify as the Court shall award: Wherefore, the said defendant [*J. S.*] prays judgment, and that he may be dismissed and discharged by the Court here, of the premises in the said [*fourth*] suggestion contained, &c.

PLEAS before our Lady the Queen, in her Chancery at Westminster, in the county of Middlesex, of the Term of [*Saint Michael*] (*g*), in the [*sixth*] year of the reign of our Sovereign Lady Victoria, by the grace of God of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith. (No. 27.)

Issue.

ENGLAND (to wit). Our Lady the Queen sent to her sheriff of, &c.

[*Here copy the whole of the declaration* (*h*), *and if there has been a nolle*

(*g*) This must be the term in or as of which issue was joined.

(*h*) See Form, *ante*, p. 717, No. 9.

prosequi entered as to any of the suggestions, it should be inserted at the end of the declaration (i)]. And the said defendant [*J. S.*,] as to the said [*first*] suggestion in the said writ contained whereby it is suggested and alleged, &c., [*here insert the pleas, and all the other pleadings in proper order down to the joining of issue, including demurrers and joinders in demurrer, but without stating the dates of any of the pleadings; after which proceed as follows.*]

THEREFORE to try the several issues above joined, the sheriff of Middlesex is commanded, that he cause to come before our Lady the Queen forthwith, wheresoever she shall then be in England, twelve free and lawful men of the body of the county of Middlesex, qualified as by law is required, by whom the truth of the matters may be the better known, and who are not of the kindred of the said [*J. S.*], to try upon their oath the said issues so above joined; because as well the said Attorney-general, who for our said Lady the Queen in this behalf prosecuteth, as the said [*J. S.*] have thereupon put themselves upon the said jury: The same day is given to the parties aforesaid there, &c.

(No. 28.) *Venire facias* out of Chancery returnable in the Queen's Bench.

VICTORIA, by the Grace of God of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith, to the sheriff of Middlesex, greeting: We command you, that you do not forbear by reason of any liberty in your bailiwick, but that you cause to come before us forthwith wheresoever we shall then be in England, twelve good and lawful men of the body of your county, qualified as by law is required, by whom the truth of the matter may be better known, and inquired into, and who to [*J. S.*] are in nowise related, to take cognizance on their oaths, in a plea upon a *scire facias* between us, and the said [*J. S.*]; because as well Sir [*W. W. F.*] Knight, our Attorney-general who prosecutes for us in this behalf, as the said [*J. S.*] have put themselves upon that jury: And have you there the names of the jurors and this writ. Witness ourself at Westminster, the [*second*] day of [*November*,] in the [*sixth*] year of our reign.

[*Allen*] (*k*).

(No. 29.) Chancery record.

PLEAS before our Lady the Queen, in her Chancery at Westminster, &c., [*as in the form, No. 27, ante*, p. 727]

ENGLAND (to wit). Our Lady the Queen, &c. [*This record is merely a transcript on parchment of the issue, ante*, p. 727, No. 27, *and a copy of this record is afterwards transmitted to the Court of Queen's Bench, if there are any issues in fact to be tried; in which case the following words are to be added.*] And thereupon, that is to say, on the said (*l*), [*second*] day of [*November*,] in [*Michaelmas*] Term aforesaid, in the [*sixth*] year of the reign of our said Lady the Queen, the tenor of the aforesaid record had before our said Lady the Queen in her Chancery here, is by the Right

(*i*) See Forms, *ante*, p. 718, Nos. 10 and 12.

(*k*) One of the clerks of the Petty Bag.

(*l*) This must be the first day of the term in which the record is taken into the Queen's Bench for the trial of the issues.

Honourable [*John Singleton, Lord Lyndhurst, Baron Lyndhurst of Lyndhurst, in the county of Southampton,*] Lord High Chancellor of Great Britain, taken and delivered with his own proper hands into the Court of our said Lady the Queen, before the Queen herself at Westminster, in the said county of Middlesex, to the end that the several issues above joined may be tried by the said jurors, which the said sheriff of Middlesex is above commanded that he cause to come before our said Lady the Queen as aforesaid according to the law and custom of England.

(No. 30.) Record in Queen's Bench of the bringing in the transcript of the Chancery record in order to have the issues in fact tried.

PLEAS before our Lady the Queen at Westminster, in the county of Middlesex, of [*Michaelmas*] Term, in the [*sixth*] year of the reign of our Sovereign Lady Victoria, by the grace of God of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith.

Amongst the pleas of the Queen-Roll [xii.]

MIDDLESEX (to wit). BE IT REMEMBERED that the Right Honourable [*John Singleton, Baron Lyndhurst,*] Lord High Chancellor of Great Britain, on the [*second*] day of [*November*] in this same term, before our present Sovereign Lady the Queen at Westminster, in the county of Middlesex, hath delivered here into Court with his own proper hands the tenor of a certain record had before our said Lady the Queen in her Chancery, [(*m*) to the end that certain issues therein joined between our said Lady the Queen and [*J. S.*] may be duly tried by the country, according to the law and custom of England, and the tenor of which said record is] in these words, (that is to say,)

Copy of Chancery record.

"PLEAS before our Lady the Queen, in her Chancery at Westminster, in the county of Middlesex, of the Term of [*Saint Michael,*] in the [*sixth*] year of the reign of our Sovereign Lady Victoria, by the grace of God of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith."

"ENGLAND (to wit). Our Lady the Queen sent to her sheriff of, &c."

[*Here the whole of the Chancery record, (No. 29, ante, p. 728,) after which proceed as follows.*]

Appearance of the parties in Queen's Bench.

*AND hereupon, forthwith, to wit, on the said [*second*] day of [*November,*] before our said Lady the Queen at Westminster aforesaid, come, as well the said Attorney-general, who for our said Lady the Queen in this behalf prosecuteth, as the said [*J. S.,*] by [*William Henry Rymer,*] his attorney, [or in his own proper person] (*n*). And the said sheriff of the said county of Middlesex hath not returned the said last-mentioned writ so to him directed, nor hath he done anything thereupon (*o*). Therefore as before the said sheriff of the said county of

Continuance.

(*m*) The words within brackets here are not always inserted, but when not inserted they are implied. See the conclusion of the Chancery Record, No. 29, above.

(*n*) The Form here given is only applicable when the action is tried at *Nisi Prius*, if the issues are tried at bar the form will, of course, be different.

(*o*) If a special jury has been nominated and reduced, and a continuance afterwards becomes necessary, it must not be entered as above, but by way of *vice comes non misit breve* after the award of the first *distringas juratores*, and the award of an *alias distringas*, as at the end of this Form.

Middlesex is commanded that he do not forbear by reason of any liberty in his bailiwick, but that he cause to come before our said Lady the Queen, on the [*eighth*] day of [*January*,] next at Westminster, twelve good and lawful men of the body of the said county of Middlesex, qualified as by law is required, by whom the truth of the matters may be better known, and who are not of the kindred of the said [*J. S.*] At which day, to wit, on the [*eighth*] day of [*January*] aforesaid, before our said Lady the Queen at Westminster, come, as well the said Attorney-general, who for our said Lady the Queen in this behalf prosecuteth, as the said [*J. S.*,] by his attorney aforesaid; and the sheriff of the said county of Middlesex hath returned the names of twelve jurors, none of whom come to try in form aforesaid: Therefore the sheriff of the said county of Middlesex is commanded that he do not forbear by reason of any liberty in his bailiwick, but that he distrain the bodies of the jurors aforesaid by all their lands and chattels in his bailiwick, so that neither they, nor any one for them, do put their hands to the same, until he shall have another command from our said Lady the Queen for that purpose; and that he answer to our said Lady the Queen for the issues thereof, so that he may have their bodies before our said Lady the Queen at Westminster, on [*Wednesday*] the [*fifteenth*] day of [*April*] next coming, or before the right trusty and well-beloved of our said Lady the Queen, [*Thomas, Lord Denman,*] Chief Justice of our said Lady the Queen, assigned to hold pleas before the Queen herself, or other justice assigned as aforesaid, if he shall come before that time, (that is to say,) on [*Tuesday*] next after the end of the term at Westminster, in the said county of Middlesex, in the Great Hall of Pleas there, according to the form of the statute in such case made and provided, to try upon their oath the said issues so above joined as aforesaid; in default of the jurors aforesaid, who came not to try in form aforesaid: Therefore let the sheriff of the said county of Middlesex have the bodies of the jurors aforesaid accordingly, to try in form aforesaid: The same day is given as well to the said Attorney-general, who for our said Lady the Queen in this behalf prosecuteth, as to the said [*J. S.*]: [(*p*) At which time (to wit), on the [*fifteenth*] day of [*April*,] in [*Easter*] Term, in the [*eighth*] year of the reign of our said Lady the Queen, before our said Lady the Queen at Westminster aforesaid, come, as well the said Sir [*F. T.*,] Knight, Attorney-general of our said Lady the Queen, who for our said Lady the Queen prosecuteth as aforesaid, as also the said [*W. N.*,] by his attorney aforesaid; And the said sheriff of Middlesex hath not returned the said last-mentioned writ so to him directed, nor the aforesaid Chief Justice the record: Therefore as before the sheriff of the said county of Middlesex is commanded that he do not forbear by reason of any liberty in his bailiwick, but that he distrain the bodies of the jurors aforesaid by all their lands and chattels in his bailiwick, *so that neither* they, nor any one for them, do put their hands to the same until he shall

Return of venire.

Award of distringas juratores.

Continuance after award of distringas.

(*p*) This continuance only becomes necessary when the trial does not take place at the sittings after a special jury has been nominated and reduced for the trial of the action. Vide *ante*, p. 408.

have another command from our said Lady the Queen for that purpose; and that he answer to our said Lady the Queen for the issues thereof, so that he may have their bodies before our said Lady the Queen at Westminster aforesaid, on [*Thursday*] the [*twenty-second*] day of [*May*] next coming, or before the said right trusty and well-beloved of our said Lady the Queen [*Thomas, Lord Denman,*] Chief Justice of our said Lady the Queen, assigned to hold pleas before the Queen herself, or other justice assigned as aforesaid, if he shall come before that time, (that is to say,) on [*Friday*] next after the end of the term at Westminster, in the county of Middlesex, in the Great Hall of Pleas there, according to the form of the statute in such case made and provided, to try upon their oath the said issues so above joined as aforesaid; in default of the jurors aforesaid, who came not to try in form aforesaid: Therefore let the sheriff of the said county of Middlesex have the bodies of the jurors aforesaid accordingly to try in form aforesaid: The same day is given as well to the said Attorney-general, who for our said Lady the Queen in this behalf prosecuteth, as to the said (*J. S.*)]

(No. 31.) Attorney-general's warrant for a *nisi prius*.

MIDDLESEX. Let a record of *nisi prius* be made up between our Sovereign Lady the Queen and [*Here insert the name and addition of the defendant from the writ of scire facias, as, "William Newton, of the Office for Patents, 66, Chancery Lane, in the county of Middlesex, Civil Engineer,"*] for the trial of certain issues joined upon the pleas of the said [*W. N.,*] to a writ of *scire facias* issued out of the High Court of Chancery for the purpose of cancelling and repealing certain letters patent granted to the said [*W. N.,*] for an invention of ["*improvements,*" &c. *Here insert the title of the invention,*] and cancelling the enrolment thereof.

By the controlment of [*Michaelmas*] (*q*) Term, [*sixth*] Victoria, [1842.]

(Signed) [*W. W. Follett*] (*r*).

(No. 32.) *Nisi prius* record.

PLEAS before our Lady the Queen, at Westminster, in the county of Middlesex, of [*Michaelmas*] Term, &c. [*This record is merely a transcript of the Queen's Bench record, No.* 30, *ante*, p. 729.]

(No. 33.) Alias *Venire facias out of the Queen's Bench* (*s*).

VICTORIA, by the grace of God of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith, to the sheriff of Middlesex, greeting: We command you, as before we have commanded

(*q*) The term in which the record is brought into the Queen's Bench for trial.

(*r*) The warrant must be engrossed on parchment, signed by the Attorney-general, and annexed to the *nisi prius* record.

(*s*) This writ only becomes necessary when the cause is not tried at the sittings immediately after the record is brought into the Queen's Bench and a continuance is entered by a *vice comes non misit breve*.

you, that you do not forbear by reason of any liberty in your bailiwick, but that you cause to come before us forthwith [*or* on the [*nineteenth*] day of [*April*] next in the *present* term,] at Westminster, twelve good and lawful men of the body of your county, qualified as by law is required, by whom the truth of the matter may be better known and inquired into, and who to [*W. N.*] are in nowise related, to take cognizance on their oaths in a plea upon a *scire facias* between us and the said [*W. N.*,] because as well Sir [*W. W. F.*,] Knight, our Attorney-general, who prosecutes for us in this behalf, as the said [*W. N.*,] have put themselves upon that jury; and have you there the names of the jurors and this writ. WITNESS [*Thomas, Lord Denman,*] at Westminster, the [*fifteenth*] day of [*April,*] in the [*sixth*] year of our reign.

By the Court,
[*Robinson.*]

(No. 34.) *Distringas juratores.*

VICTORIA, by the grace of God of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith, to the sheriff of Middlesex, greeting: We command you, [(*t*)as before we have commanded you,] that you do not forbear by reason of any liberty in your bailiwick, but that you distrain the bodies of the several persons named in the panel annexed to this writ, [*or if the action is to be tried by a special jury, say, "Caleb Richardson, of, &c.," inserting the names and additions of the twenty-four special jurors as contained in the reduced list,*] being the jurors summoned in our Court before us between us and [*W. N.*,] by all their lands and chattels in your bailiwick, so that neither they nor any one for them do put their hands to the same until you shall have another command from us for that purpose; and that you answer for the issues thereof, so that you may have their bodies before us at Westminster, on the [*fifteenth*] day of [*April*] next, or before our right trusty and well-beloved [*Thomas, Lord Denman,*] our Chief Justice, assigned to hold pleas before us, or other justice assigned as aforesaid, if he shall come before that time, (that is to say,) on [*Tuesday*] next, after the end of the term at Westminster, in our county of Middlesex, in the Great Hall of Pleas, there according to the form of the statute in such case made and provided, to try upon their oath certain issues joined between us and the said [*W. N.*] on our writ of *scire facias* out of our Court of Chancery, to cancel certain letters patent granted to the said [*W. N.*] for the supposed invention of certain [*improvements in machinery for*, &c.,] and to hear their judgments for their many defaults: And have you there then this writ. WITNESS [*Thomas, Lord Denman,*] at Westminster, the [*eleventh*] day of [*January,*] in the [*sixth*] year of our reign (*u*).

By the Court,
[*Robinson.*]

(*t*) The words within brackets are only to be inserted in an *alias distringas*.

(*u*) This writ must be tested as of the return day of the *Venire facias juratores*, and made returnable on a day certain in term.

By the controlment of [*Easter*] Term,
Roll.

This writ is delivered of record before our Lady the Queen, at Westminster, the term and roll within written. *To be indorsed.*

(No. 35.)
Subpœna ad testificandum.

VICTORIA, by the grace of God of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith, To and to every of them, greeting: We command you, and every of you, that laying aside all excuses and pretences whatsoever, you and every of you personally be and appear before our right trusty and well-beloved [*Thomas, Lord Denman,*] our Chief Justice, assigned to hold pleas before us, on [*Tuesday*] the [*first*] day of [*February next,*] by nine of the clock in the forenoon of the same day, at Westminster, in our county of Middlesex, in the Great Hall of Pleas, there to testify the truth on our behalf against [*W. N.,*] [*or when the writ is obtained on behalf of the defendant,* to testify the truth between us and *W. N.,*] upon the trial of certain issues joined between us and the said [*W. N.,*] upon the plea of the said [*W. N.,*] to our writ of *scire facias* issued out of our High Court of Chancery for the purpose of cancelling certain letters patent granted by us to the said [*W. N.*] for an invention of [*improvements in the manufacture of,* &c. *as the case may be, and if the writ is obtained for the defendant add,*] on behalf of the said [*W. N.*] * And this you or any of you are not to omit under the penalty of one hundred pounds, to be levied on the goods and chattels, lands and tenements of such of you as shall fail herein. WITNESS [*Thomas, Lord Denman,*] at Westminster, the [*eleventh*] day of [*January,*] in the [*sixth*] year of our reign (*x*).

By the Court,
[*Robinson.*]

(No. 36.)
Subpœna duces tecum.

VICTORIA, &c. [*Here proceed as in the last form down to the *, and then as follows,*] and that you or such of you in whose custody or power the same be, do bring with you and produce at the time and place aforesaid, [*here describe the documents to be produced,*] in order that the same may be produced and given in evidence [on our behalf] before our said Chief Justice [on behalf of the defendant:] And this you or any of you are not to omit under the penalty of one hundred pounds, to be levied on the goods and chattels, lands and tenements of such of you as shall fail herein. WITNESS [*Thomas, Lord Denman,*] at Westminster, the [*eleventh*] day of [*January,*] in the [*sixth*] year of our reign (*x*).

By the Court,
[*Robinson.*]

(No. 37.)
Postea.

AFTERWARDS, that is to say, on the day and at the place lastly within mentioned, before the within named [*Thomas, Lord Denman,*]

(*x*) This writ must be tested as of a day in term time.

Chief Justice of our said Lady the Queen, assigned to hold pleas before the Queen herself, [*The Honourable Thomas Denman*] being associated unto the said Chief Justice, according to the form of the statute in such case made and provided come, as well the within named Sir [*F. P.,*] Knight, Attorney-general of our said Lady the Queen, who for our said Lady the Queen in this behalf prosecuteth, as the within named [*W. N.,*] by his attorney within mentioned, and the jurors of the jury within mentioned being called over, (to wit,) [*Caleb Richardson, &c. The names and additions of the jurors are here to be inserted,*] come, and are sworn upon the said jury, whereupon public proclamation is made here in Court for our said Lady the Queen, as the custom is, that if there be any one who will inform the aforesaid Chief Justice, the Queen's Attorney-general, the Queen's Serjeant-at-Law, or the jurors of the jury aforesaid, concerning the matters within contained, he should come forth and should be heard, and hereupon Sir [*William Webb Follett,*] Knight, Solicitor-general of our said Lady the Queen, offereth himself on behalf of our said Lady the Queen to do this, whereupon the Court here proceedeth to the taking of the inquest aforesaid, by the jurors aforesaid, now here appearing for the purpose aforesaid, who being chosen, tried, and sworn to speak the truth touching and concerning the matters within contained, as to the first issue within joined, say upon their oath that, &c. [*Here set out the findings of the jury upon each of the issues, as for example* that the said (*W. N.*) did not by the said instrument in writing and drawing within mentioned, particularly describe and ascertain the nature of his said invention within mentioned, and in what manner the same was or is to be performed in manner and form as by the within plea of the said (*W. N.*) by him (*firstly*) within pleaded is alleged; *and if the jury is discharged from giving verdicts upon any of the issues, then after entering the verdicts upon the issues as to which there were findings by the jury, the following words must be added.*] And as to the several other issues within joined by the consent of the said Sir [*F. P.,*] who prosecuteth as aforesaid on behalf of our said Lady the Queen, and by consent of the said [*W. N.,*] the jurors aforesaid are now here in Court discharged from giving verdicts severally thereupon. And the said jurors are thereupon by the Court here discharged accordingly.

Jury discharged as to the residue of the issues.

(No. 38.) Record of the *postea* or verdict in Queen's Bench, and remand of the record into Chancery for judgment after verdict for the crown.

(*y*) AT which time, to wit, on the [*fifteenth*] day of [*April*] aforesaid, [*the first day of the term after the verdict,*] before our said lady the Queen, at Westminster, come as well the said Attorney-general, who for our said Lady the Queen in this behalf prosecuteth, as the said [*W. N.*] by his attorney aforesaid: And the said Chief Justice of our said Lady the Queen, before whom the said jurors came to try in form aforesaid, sent here his record had before him in these words, to wit, Afterwards, (that is to say,) &c. [*Here insert the whole of the postea, after which if there has*

(*y*) This entry is to be made upon the Queen's Bench record, No. 30, *ante*, p. 729.

been a verdict for the Crown, proceed as follows.] And because the giving of judgment upon the verdict aforesaid, and execution of the said judgment, belong to the office of Chancellor, therefore day is given as well to the said Sir [*William Webb Follett,*] Knight, who for our Lady the Queen prosecutes as aforesaid, as also to the said [*W. N.,*] to be before our said Lady the Queen in her Chancery wheresoever it be, on the [*nineteenth*] day of [*January,*] in this said term, to wit, [*Hilary*] Term, in the [*seventh*] year of the reign of our said Lady the Queen, to do and receive whatsoever shall be just in the premises: And the tenor of the said record, so had before our said Lady the Queen, in her Chancery, together with the record of all things by the said Court of our said Lady the Queen, before the Queen herself, done thereon, are afterwards, to wit, on the said [*nineteenth*] day of [*January,*] in this said term remanded, and by the same Court of our said Lady the Queen, before the Queen herself, sent and delivered into the said Chancery of our said Lady the Queen, that the said Chancery may cause further to be done in the premises, what of right and according to the law and custom of England, ought to be done.

[*Hilary*] Term [*eighth*] Victoria. (No. 39.)

The Queen *v.* [*Norton.*] } Verdict recorded, and record remanded into Chancery for judgment. [19 *January*, 1845.]

[RYDER, *Chancery Lane.*]

Indorsement upon *nisi prius* record after verdict for the Crown (*z*).

AND AFTERWARDS, that is to say, on the [*nineteenth*] day of [*January,*] in [*Hilary*] Term, in the [*eighth*] year of the reign of our said Lady the Queen, the tenor of the said record so delivered by the said Lord High Chancellor, into the said Court of our said Lady the Queen, before the Queen herself, together with the record of all things by the said Court of our said Lady the Queen, before the Queen herself, done thereon, are remanded into the said Chancery of our said Lady the Queen. (No. 40.) Judgment for the Crown in Chancery (*a*). *Remand of record of verdict.*

AND AFTERWARDS, to wit, on the said [*nineteenth*] day of [*January,*] in [*Hilary*] Term aforesaid, before our said Lady the Queen in her Chancery, come here, to wit, at Westminster, in the said county of Middlesex, as well the said Sir [*W. W. F.,*] Knight, Attorney-general of our said Lady the Queen, who for our said Lady the Queen, in this behalf prosecuteth, as also the said [*W. N.*] by the said [*H. G.,*] his said attorney; AND the Right Honourable [*Thomas, Lord Denman,*] Chief Justice of our said Lady the Queen, assigned to hold pleas before the Queen herself, at the same time and place delivers into the said Chancery of our said Lady the Queen here, the tenor of the said record so delivered by the said Lord High Chancellor into the said Court of our said Lady the. *Re-appearance of parties in Chancery.* *Record of verdict brought into Chancery.*

(*z*) Vide *ante*, p. 422, respecting this endorsement.

(*a*) This entry is to be made upon the Chancery record, No. 29, *ante*, p. 728.

Queen, before the Queen herself, as aforesaid, and also the record of all things by the said Court of our said Lady the Queen, before the Queen herself, done thereon, as aforesaid; And which said last-mentioned record is in these words, (that is to say,)

Queen's Bench record of verdict, &c.

AND HEREUPON forthwith, to wit, on the said [*second*] day of [*November,*] in the same term, before our said Lady the Queen herself, at Westminster, come as well, &c. [*Here copy the Queen's Bench record, No. 30, ante, p. 729, from the * ante, p. 729, to the end, and also the Queen's Bench record of the postea or verdict, No. 38, ante, p. 734, to the end, after which proceed as follows.*]

Judgment.

WHEREUPON all and singular, the premises being seen and fully understood by the Court of our said Lady the Queen, in her Chancery here, and mature deliberation being thereupon had,

Judgment signed [10th January, 1846.]

IT IS CONSIDERED by the same Court here, that the said letters patent of our said Lady the Queen, so as aforesaid, granted to the said [*W. N.*] be revoked, cancelled, vacated, and disallowed, annulled, void, and invalid, and be altogether had and held for nothing, and that these letters patent be restored into the Chancery of our said Lady the Queen, here to be cancelled; And also that the enrolment thereof be cancelled, quashed, and annulled, &c.

(No. 41.)

Continuance to be entered when judgment is not signed in the same term as the record is remanded into Chancery.

AND because the Court of our Lady the Queen in her Chancery here, of giving judgment thereof, is not yet advised, &c. Therefore day thereof is given as well to the said Sir [*W. W. F.,*] Knt., who prosecutes as aforesaid, as to the said [*W. N.,*] until the [*fifteenth*] day of [*April,*] in [*Easter*] Term next coming, before our said Lady the Queen, in her Chancery wheresoever it shall then be, &c., to hear judgment of and upon the premises, because the Court of our Lady the Queen, in her Chancery here thereof are not yet, &c.

At which said day, to wit, on the [*fifteenth*] day of [*April,*] in [*Easter*] Term, in the [*eighth*] year of the reign of our said Lady the Queen, in her Chancery at Westminster aforesaid, come as well the said Sir [*W. W. F.,*] Knt. who for our said Lady the Queen prosecutes, as aforesaid, as also the said [*W. N.*] by the said [*J. B.,*] his attorney aforesaid (*b*): Upon which all and singular the premises, &c. [*Proceed as in the last form to the end.*]

(No. 42.)

Entry of a day given to defendant to bring in the patent to be cancelled.

AND HEREUPON a day is given to the said [*W. N.*] until the [*tenth*] day of [*June,*] in this present Term, to deliver into the said Chancery of our said Lady the Queen, the said letters patent so to the said [*W. N.*] granted as aforesaid, to the end that the said letters patent may be cancelled and vacated, or otherwise dealt with as by law and the custom of England ought to be done: And let the said [*W. N.*] on that day have the said letters patent before our said Lady the Queen, in her

(*b*) Continuances must be inserted from term to term until the term in or as of which judgment is signed.

Chancery wheresoever it shall then be, &c. And let the said [*W. N.*] then deliver the same letters patent into the said Chancery, there to be cancelled and vacated, or otherwise dealt with as by law and the custom of England ought to be done: And his the said [*W. N.*] is in no wise to omit: And to the said Sir [*W. F. F.*,] Knt. who for our said Lady the Queen prosecutes as aforesaid, is given the same day before our said Lady the Queen in her said Chancery wheresoever it shall then be, &c.

IN THE PETTY BAG, IN CHANCERY. (No. 43.)

Between, The Queen, plaintiff,
and
[*W. N.*] defendant.

Notice to the defendant of the day appointed for bringing in the patent to be cancelled.

TAKE NOTICE, that judgment has been signed against you in this action in the Office of the Petty Bag in Chancery, to repeal, vacate, and cancel the letters patent in the writ of *scire facias* in this action mentioned, and that in the said judgment a day has been given to you, namely, the [*first*] day of [*May*] next, to deliver the said letters patent into Chancery, there to be cancelled in pursuance of the said judgment. And you are hereby required accordingly to deliver the said letters patent to the Right Honourable [*John Singleton, Baron Lyndhurst,*] Lord High Chancellor of Great Britain, in his Lordship's Court at Westminster, at [*ten*] of the clock in the morning of the said [*first*] day of [*May*] next, at which time, or as soon afterwards as counsel can be heard, a motion will be made by Mr. [*A. B.*] of counsel for the prosecution, that the said letters patent, and the enrolment thereof, may be cancelled and vacated in pursuance of the said judgment. And further take notice, that in case you neglect to deliver the said letters patent in pursuance of the command to you given by the said judgment, a motion will be made by Mr. [*A. B.*] as such counsel for the prosecution, before the said Lord High Chancellor, in his said Court, on the said [*first*] day of [*May*] next, at the hour of [*ten*] of the clock in the morning, or as soon afterwards as counsel can be heard, that you stand committed to prison for contempt of this honourable Court, and that such further proceedings be had and taken against you, and in this action, as to the Court shall seem fit. Dated this [*twenty-fifth*] day of [*April*, 1845.]

To
Mr. [*W. N.*]
the above named defendant, *and to*
[*Mr. J. A.*] his solicitor.

Yours, &c.
[*R. W.*]
Solicitor for the prosecution.

The Queen
v.
[*Wm. Norton.*]

UPON READING the notice of motion dated the [*twenty-sixth*] day of [*April*, 1845,] and served by the prosecutor upon the defendant, and the affidavit of the defendant, sworn on the [*twenty-seventh*] day of [*May*, 1845,] and upon (No. 44.) Order that enrolment be cancelled in pur-

sumnce of a judgment, the patentee being unable to bring in the patent.

hearing what was alleged by counsel for the prosecution, and the defendant respectively; and his Lordship having called to his assistance, the Right Honourable the Master of the Rolls; and it appearing that the said defendant [*W. N.*] is at present unable to restore his letters patent into Chancery, in pursuance of the judgment given for the Crown in this action; and upon the undertaking of the said defendant [*W. N.*] in Court here, that he will not sue out any writ of error to reverse the said judgment in this action, or do any act to defeat the same judgment:

IT IS HEREBY ORDERED, that the enrolment of the said letters patent be cancelled, quashed, and annulled in pursuance of the said judgment, and that a vacatur of the said letters patent and enrolment be entered upon the roll upon which the said letters patent were enrolled: And that the proper officer do attend the Master of the Rolls with the enrolment for that purpose.

(Signed) [*Lyndhurst,*] *C.*
[*Langdale,*] *M. R.*

(No. 45.)
Vacatur of a patent and enrolment.

[*Langdale,*] *M. R.*

(*c*) CANCELLED this enrolment by order of the Lord Chancellor, dated the [*twenty-eighth*] day of [*May,*] in the year of our Lord, [*one thousand eight hundred and forty-five,*] in pursuance of the judgment,—Our Sovereign Lady the Queen against [*W. N.*] in the Petty Bag: THEREFORE on the [*twenty-ninth*] day of [*May,*] in the year of our Lord, [1845,] and in pursuance of the said judgment, the letters patent, gift, and grant of privilege here enrolled, and this enrolment thereof, are vacated.

(No. 46.)
Writ of error returnable in Parliament to reverse a judgment for the crown in *scire facias* for errors in law.

VICTORIA, by the grace of God of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith; To our right trusty and well beloved Counsellor [*Henry, Lord Langdale,*] Master of the Rolls of our Chancery, greeting: Forasmuch as in the record, process, and proceedings, and also of giving of judgment upon our writ of *scire facias* awarded out of our Court, before us, in our Chancery at our suit against [*W. N.*] touching the cancelling, vacating, and disallowing certain letters patent under the Great Seal of our said United Kingdom, granted by us to the said [*W. N.*] as it is said, manifest error hath intervened for the great damage of the said [*W. N.*] as by his complaint we are informed. We willing that the said error, (if any be,) be duly amended, and full and speedy justice done to the said [*W. N.*] in this behalf, do command you that if judgment be thereupon given then, that you send to us distinctly and plainly, without delay, under your seal, unto our present Parliament, the record, process, and proceedings aforesaid, with all things touching

(*c*) The vacatur is to be entered in the margin of the patent roll, opposite the commencement of the enrolment of the patent. The Master of the Rolls signs his name at the top of the entry as above.

the same, and this writ. That inspecting the record, process, and proceedings aforesaid, we may cause further to be done thereupon by the assent of the Lords Spiritual and Temporal, in the same Parliament assembled, *for amending the said error as of right, and according to the law and* custom of England, shall be meet to be done. WITNESS ourself at Westminster, the [*thirtieth*] day of [*April,*] in the [*eighth*] year of our reign.

Allowed [30*th April*, 1845.] [*Bentall*] (*d*).

(Signed) [*Langdale,*] *M. R.*

(No. 47.)
Rule to transcribe the record.

IN THE PETTY BAG, IN CHANCERY.

[*Trinity*] Term, in the [*eighth*] year of the reign of Queen Victoria.

[*First*] Rule day.

[*W. N.,*] plaintiff in error, *v.* The Queen. } Unless the plaintiff in error shall cause the record to be transcribed, in order to be delivered into the House of Lords within eight days after notice of this rule given him, let a *non pros* be entered.

[*Allen*] (*d*).

BY OUR LAD YTHE QUEEN.

(No. 48.)
Return by the Master of the Rolls to a writ of error.

The record, process, and proceedings within mentioned, with all things touching the same, I do humbly certify to our Sovereign Lady the Queen, in her Parliament, in a certain record to this writ annexed, as I am within commanded.

The answer of [*the Right Honourable Henry, Lord Langdale,*] Master of the Rolls of the Chancery within mentioned.

(Signed) [*Langdale,*] *M. R.* L. S.

Note. *A transcript of the whole of the Chancery record is to be taken by the Master of the Rolls, with the writ and return to the House of Lords.*

SECTION VIII.

Forms of Assignments of Patents, and Licences to use Patent Inventions (*e*).

(No. 1.)
Assignment of a patent to a purchaser.

THIS INDENTURE, made the [*first*] day of [*January,*] A. D. [1846,] BETWEEN [*Caleb Richardson,*] of, &c. [*the patentee or his assignee,*] of the one part, and [*Arthur Williamson,*] of, &c. [*the purchaser,*] of the other part.

(*d*) One of the clerks of the Petty Bag to whose division the action belongs.

(*e*) It is only intended here to give a few specimens of the form of assignments and licences; a complete collection of such forms would fill a large volume.

Recital of the patent.

WHEREAS by letters patent under the Great Seal of the United Kingdom of Great Britain and Ireland, bearing date at Westminster, the [*twenty-first*] day of [*March,*] in the [*eighth*] year of the reign of her present Majesty Queen Victoria, after reciting, amongst other things, that the said [*C. R., or* one *J. N.* therein described,] had by his petition humbly represented unto her said Majesty, that he had invented ["*an improved method of, &c.*"] her said Majesty did give and grant unto the said [*C. R., or J. N.,*] his executors, administrators, and assigns, her said Majesty's especial licence, full power, sole privilege, and authority, that he the said [*C. R., or J. N.,*] his executors, administrators, and assigns, and every of them during the term therein expressed, should and lawfully might make, use, exercise, and vend his said invention within England, Wales, and Berwick upon Tweed, [and the islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all her said Majesty's colonies and plantations abroad,] and the whole profit, benefit, commodity, and advantage of the said invention for and during the term of years therein mentioned, to have hold, exercise, and enjoy the said licence, power, privileges, and advantages thereinbefore granted unto the said [*C. R., or J. N.,*] his executors, administrators, and assigns, for and during, and unto the full end and term of fourteen years from the date of the now reciting letters patent next ensuing, and fully to be complete and ended, subject, amongst other things, to a condition or proviso therein contained, that if the said [*C. R., or J. N.,*] should not particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, by an instrument in writing under his hand and seal, and cause the same to be enrolled in her said Majesty's High Court of Chancery, within [*six*] calendar months next and immediately after the date of the now reciting letters patent, the said letters patent, and the said liberties and advantages thereby granted, should utterly cease, determine, and become void.

Recital that a specification has been enrolled.

AND WHEREAS by a specification, or instrument in writing, under the hand and seal of the said [*C. R., or J. N.,*] bearing date, and also duly enrolled in her said Majesty's High Court of Chancery, on or about the [*twenty-first*] day of [*September,*] in the year of our Lord, [1845,] the said [*C. R., or J. N.*] did declare that he did thereby, in pursuance and compliance with the said condition or proviso in that behalf, in the said hereinbefore recited letters patent contained, describe and ascertain the nature of his said invention, and in what manner the same was to be performed as in the same specification is mentioned or expressed.

Recital of assignment of patent to the vendor.

[(*a*) AND WHEREAS by an indenture of assignment bearing date on or about the [*first*] day of [*October,*] A. D. [1845,] and made or expressed to be made between the said [*J. N.,*] of the one part, and the said [*C. R.,*] of the other part, for the considerations therein mentioned, the said [*J. N.*] did assign the said licence, sole privilege and authority,

(*a*) This recital is only applicable when the assignment is made by the *first* and *sole* assignee of the patent; the form may however be easily modified according to the circumstances of the case.

and also all and every of the rights, powers, privileges, and authorities, profits, benefits, and advantages granted, or mentioned to be granted by the said letters patent of the [*first*] day of [*January,*] in the [*eighth*] year of her said Majesty's reign, unto the said [*J. N.,*] his executors, administrators, and assigns; Together with the same letters patent, and also all claim, right, and title of him, the said [*J. N.,*] his executors and administrators, or any of them, to procure a prolongation or prolongations, extension or extensions of the said licence, privilege, and authority, and the said term of fourteen years granted by the said letters patent; To hold, receive, take, and enjoy the said licence, sole privilege and authority, letters patent, and premises thereby assigned or intended so to be unto the said [*C. R.,*] his executors, administrators, and assigns, for all the residue of the said term of fourteen years therein granted by the said letters patent, and *for and during* all other the *term, right,* and interest therein of him the said [*J. N.*]

AND WHEREAS the said [*C. R.*] hath contracted and agreed with the said [*A. W.*] for the sale to him of the said letters patent, and the said *licence, privileges,* and advantages thereby granted at or for the price or sum of [1000*l.*]

NOW THIS INDENTURE WITNESSETH, that in pursuance of the said agreement, and in consideration of the sum of [1000*l.*] of lawful British money to the said [*C. R.*] paid by the said [*A. W.,*] upon or before the sealing and delivering of these presents, the receipt of which said sum of [1000*l.*] the said [*C. R.*] doth hereby acknowledge, and of and from the same sum, and every part thereof, doth release and discharge the said [*A. W.,*] his heirs, executors, administrators, and assigns, and every of them for ever by these presents: *He* the said [*C. R.*] HATH granted, bargained, sold, assigned, assured, transferred, and set over, *And* by these presents DOTH grant, bargain, sell, assign, assure, transfer, and set over unto the said [*A. W.,*] his executors, administrators, and assigns; TESTATUM, *in consideration of 1000l. vendor assigns,*

ALL that the said especial licence, full power, sole privilege and authority, and the said invention, and all and every of the rights, privileges, profits, benefits, commodities, and advantages, in and by the said hereinbefore recited letters patent, of the [*first*] day of [*January,*] in the said [*eighth*] year of the reign of her present Majesty, granted unto the said [*C. R., or J. N.,*] his executors, administrators, and assigns; Together with the said hereinbefore recited letters patent; And also all the right, title, interest, claim, and demand whatsoever of him the said [*C. R.,*] his executors, and administrators, or any of them, to apply and petition for, obtain, and procure a prolongation or prolongations, extension or extensions of the said licence, privilege, and authority, and of the said term of fourteen years granted by the said hereinbefore recited letters patent, and to apply and petition for, obtain, and procure any new or other letters patent to be granted, or any Act of Parliament to be made or passed for giving or granting the sole right, power, privilege, or authority to make, use, exercise, or vend the said invention or discovery within England; Wales, Berwick-upon-Tweed, [the islands of Jersey, *The whole of the patent privilege.*

Guernsey, Alderney, Sark, and Man, and also in all her Majesty's Colonies and Plantations abroad,] for any term or terms of years, or any new or additional term or terms of years, Together with all the right, title, interest, profits, benefits, advantages, property, possibility, claim, and demand, as well legal as equitable, of him the said [*C. R.*,] in, to, from, out of, or upon the said licence, privilege, authority, letters patent, rights and premises hereby assigned or intended so to be:

Habendum to the purchaser for the residue of the term.

TO HAVE, HOLD, AND RECEIVE, take, exercise, and enjoy the said especial licence, sole privilege and authority, invention, letters patent, rights, privileges, and all and singular the premises hereby assigned or intended so to be, unto and by the said [*A. W.*,] his executors, administrators, and assigns, for and during all the rest, residue, and remainder, which is now to come and unexpired of the said term of fourteen years, granted and created by the said hereinbefore recited letters patent, and for and during all other the term, right, and interest therein of him the said [*C. R.*,] under or by virtue of the said hereinbefore recited letters patent, or otherwise howsoever; To, and for the sole use, benefit, and advantage of the said [*A. W.*,] his executors, administrators, and assigns.

Vendor's covenants for title.

AND the said [*C. R.*,] for himself, his heirs, executors, and administrators, doth covenant, promise, declare, and agree with and to the said [*A. W.*,] his executors, administrators, and assigns, by these presents, in manner following, (that is to say,) That notwithstanding any act, deed, matter or thing by the said [*C. R.*] done, executed, or permitted, the said hereinbefore recited letters patent of the [*first*] day of [*January*,] in the [*eighth*] year of the reign of her present Majesty, are, at the time of the sealing and delivery of these presents, good, valid, and sufficient in the law for all and every of the purposes therein mentioned or expressed, and that the same letters patent, or the grant therein expressed or contained, have not been, and are not surrendered, forfeited, or become void or voidable in anywise howsoever:

That the patent is valid.

That the specification is sufficient.

AND that the said hereinbefore recited specification or instrument in writing, of the [*twenty-first*] day of [*September*, 1845,] well and sufficiently describes and ascertains the nature of the said invention, mentioned in the said hereinbefore recited letters patent, and in what manner the same invention is to be performed; and that the same specification or instrument in writing has been, and was truly and duly made and enrolled according to, and well, truly, fully, and sufficiently performed, and complied with the condition in that behalf in the same hereinbefore recited letters patent expressed or contained:

That the vendor has good right to assign.

AND that, notwithstanding any such act, deed, matter, or thing as aforesaid, he, the said [*C. R.*,] now hath in himself good right, full power, and lawful and absolute authority to assign the said licence, privilege, letters patent, and premises hereby assigned or intended so to be, unto the said [*A. W.*,] his executors, administrators, and assigns, for and during all the residue and remainder of the said term of fourteen years, and in manner aforesaid, according to the true intent and meaning of these presents:

That he will not do any act

AND ALSO that he, the said [*C. R.*,] his executors, administrators,

or assigns, or any of them, shall not, nor will at any time or times hereafter during the residue and remainder of the said term of fourteen years, or for or during any other term or interest hereby assigned or intended so to be, make, do, or execute, or knowingly or willingly permit or suffer any act, deed, matter, or thing whatsoever, whereby, or by reason or means whereof the said letters patent and privileges, or any part thereof can, shall, or may be revoked, repealed, cancelled, avoided, determined, or prejudicially affected in any manner howsoever; or whereby, or by reason or means whereof the said [*A. W.*,] his executors, administrators, or assigns may, can, or shall be in anywise prevented or hindered from, or impeded in or about the having, receiving, taking, exercising, or enjoying the said licence, privileges, letters patent, and premises hereby assigned or intended so to be, or any part thereof, to and for his own use and benefit for and during all the residue and remainder of the said term of fourteen years, and for and during all other the term, right, and interest therein hereby granted or assigned, or intended so to be, and every part thereof: *to affect the patent.*

AND FURTHER, that he the said [*C. R.*,] his executors and administrators, and all and every other persons and person having, or lawfully claiming any right, title, part, share, or interest whatsoever, to or in the said licence, privileges, letters patent, and premises hereby granted or assigned, any of them, or any part thereof, shall and will at any time or times hereafter during the residue and remainder of the said term of fourteen years, and also during all and every other term, right, and interest hereby granted or assigned, or intended so to be; upon every reasonable request, and at the costs and charges of the said [*A. W.*,] his executors, administrators, or assigns, make, do, and execute, or cause or procure to be made, done, and executed all such further and other lawful and reasonable assignments, assurances, acts, deeds, matters, and things for the further, better, and more effectually assigning, assuring, granting, and confirming of the said licence, privileges, letters patent, and premises hereby assigned and granted, or intended so to be, unto the said [*A. W.*,] his executors, administrators, and assigns, for and during all the residue and remainder of the said term of fourteen years, and for and during all and every other the term right and interest therein hereby granted and assigned, or intended so to be; and also for enabling him, them, and every of them to have, receive, take, exercise, and enjoy the same to and for his and their own proper and peculiar use and benefit, according to the true intent and meaning of these presents; as by the said [*A. W.*,] his executors, administrators, or assigns, his, their, or any of their counsel in the law shall be reasonably devised, or advised and required. *And for further assurance.*

IN WITNESS, &c.

(No. 2.)

Assignment by a patentee to a *Company in* pursuance of an Act of Parliament.

THIS INDENTURE, made the [*fourth*] day of [*October,*] A. D. [1839,] BETWEEN [*R. W. S.,*] of, &c., (the patentee,) of the one part, and [The Company, established and regulated by an Act of Parliament, passed in the year of the reign of her present Majesty, intituled "An Act for forming and regulating the Company, and to enable the said Company to purchase certain Letters Patent,"] of the other part.

Recital of patent.

WHEREAS by letters patent under the Great Seal of the United Kingdom of Great Britain and Ireland, bearing date at Westminster the [*first*] day of [*February,*] in the [*first*] year of the reign of her present Majesty, After reciting amongst other things that the said [*R. W. S.*] had by his petition represented unto her said Majesty that he had invented ["*improvements in, &c.,*"] her said Majesty did give and grant unto the said [*R. W. S.,*] his executors, administrators, and assigns, her said Majesty's especial licence, full power, sole privilege and authority, that he, the said [*R. W. S.,*] his executors, administrators, and assigns, and every of them during the term therein expressed should and lawfully might make, use, exercise, and vend his said invention within England, Wales, and Berwick-upon-Tweed, [and the islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all her said Majesty's colonies and plantations abroad,] and should have and enjoy the whole profit, benefit, commodity, and advantage of the said invention for and during the term of years therein mentioned; To have, hold, exercise, and enjoy the said licence, power, privileges, and advantages thereinbefore granted unto the said [*R. W. S.,*] his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years from the date of the now reciting letters patent next ensuing and fully to be complete, and ended: Subject amongst other things to a condition or proviso therein contained, that if the now reciting letters patent, or the liberties and privileges thereby granted, should become vested in or in trust for more than the number of twelve persons, then the now reciting letters patent should be void; and also to a condition or proviso also therein contained, that if the said [*R. W. S.*] should not particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, by an instrument in writing under his hand and seal, and cause the same to be enrolled in her said Majesty's High Court of Chancery within [*six*] calendar months next and immediately after the date of the now reciting letters patent, the said letters patent, and all liberties and advantages thereby granted should utterly cease, determine, and become void.

Recital of the specification.

AND WHEREAS by a specification or instrument in writing under the hand and seal of the said [*R. W. S.*] &c., [*recital of the specification and enrolment as in the last form, ante,* p. 740.]

Recital of Act of Parliament.

AND WHEREAS by the said Act of Parliament, after reciting [amongst other things] the said letters patent, of the [*first*] day of [*February,*] in the [*first*] year of her said Majesty's reign, it was (amongst other things) enacted, that it should be lawful for the said

[*R. W. S.*] at any time after the passing of that Act, to sell, transfer, grant, and assign, the said letters patent and invention therein mentioned; and all the rights, benefits, and advantages, of the said [*R. W. S.*] therein, unto, or to the use of the said Company; and that every such sale, transfer, grant, or assignment, of the said letters patent, or of any of the rights, privileges, benefits, or advantages, granted by the said letters patent or assignment, should be good, valid, and effectual, to all intents and purposes whatsoever; and should not render the said letters patent in any manner void or voidable, any condition, proviso, or restriction in the said letters patent expressed or contained to the contrary thereof notwithstanding; And it was further enacted, that after any such sale, transfer, grant, or assignment, as aforesaid, of the said letters patent, the said letters patent should be, and the same were thereby declared to be fully, absolutely, and effectually vested in the said Company thereby constituted; and that the said letters patent should thenceforth be construed and considered in such and the same manner, to all intents and purposes whatsoever, as if no such condition, proviso, or restriction as thereinbefore mentioned or referred to, or any other condition, proviso, or restriction against any such sale, transfer, grant, or assignment, as aforesaid, had been inserted, expressed, or contained in the said letters patent.

AND WHEREAS the said [*R. W. S.*] hath contracted and agreed with the said Company for the sale to the said Company of the said privilege and letters patent, at or for the price or sum of [15,000*l.*] *Recital of contract of sale.*

NOW THIS INDENTURE WITNESSETH, that in pursuance of the said agreement, and in consideration of the sum of [15,000*l.*] of good and lawful money, of the United Kingdom of Great Britain and Ireland, to the said [*R. W. S.*,] well and truly paid by the said Company on or before the sealing and delivery of these presents, the receipt of which said sum of [15,000*l.*,] he the said [*R. W. S*] doth hereby acknowledge; and of and from the same sum, and every part thereof, doth acquit, release, and discharge the said Company, and all and every of the proprietors thereof, their and every of their successors, heirs, executors, administrators, and assigns, and every of them for ever by these presents; He the said [*R. W. S.*,] by force and virtue, and in exercise of the said power and authority, in and by the said in part recited Act of Parliament, to him the said [*R. W. S.*] given or granted in this behalf, and of every other lawful power and authority, to him the said [*R. W. S.*] given in this behalf, HATH granted, bargained, sold, transferred, and assigned, And by these presents DOTH grant, bargain, sell, transfer, and assign, unto the said Company, their successors, and assigns: TESTATUM, *in consideration of* 15,000*l. patentee assigns to the Company.*

ALL that, &c., [*describe the patent privilege to be assigned as in the last form, ante,* p. 741.] *All the patent right, &c.*

Together with all the right, &c. [*As ante,* p. 742.]

TO HAVE, HOLD, AND RECEIVE, take, exercise, and enjoy the said privilege, letters patent, and all and singular the premises hereby *Habendum to the Company,*

their successors and assigns.

assigned, or intended so to be, unto and by the said Company, their successors and assigns, for and during all the residue and remainder which is now to come and unexpired of the said term of fourteen years, and for and during all other, the term, right, and interest therein, of him the said [*R. W. S.*] To and for their own sole and proper use, benefit, and advantage.

Covenants for title by patentee.

AND the said [*R. W. S.*] for himself, his heirs, executors, and administrators, doth covenant, promise, and agree with and to the said Company, their successors and assigns, in manner following; (that is to say), That notwithstanding any act, deed, matter, or thing, by him the said [*R. W. S.*] at any time heretofore made, done, or knowingly suffered, he the said [*R. W. S.*] at the time of the sealing and delivery of these presents, hath in himself, good right, full power, and lawful and absolute authority, to assign the said privilege, letters patent, and premises hereby assigned or intended so to be unto the said Company, their successors and assigns, for and during all the residue and remainder which is now to come and unexpired of the said term of fourteen years, and in manner aforesaid, according to the true intent and meaning of these presents:

That vendor has good right to assign.

That he will not do any act to affect the patent.

AND ALSO the said [*R. W. S.*,] his executors or administrators shall not nor will at any time or times hereafter, make, do, or execute, or knowingly or willingly permit or suffer any act, deed, matter, or thing, whatsoever, whereby or by reason or means whereof the said letters patent, or the privileges and benefits thereby granted, or any of them, or any part thereof can or may be, or become forfeited, cancelled, repealed, void or voidable, or prejudicially affected in anywise howsoever, or whereby or by reason or means whereof the said Company or their assigns may, can, or shall be, in anywise prevented, hindered, or impeded, from, in, or about the having, receiving, taking, exercising and enjoying, the said privilege, letters patent, and premises, or any of them, or any part thereof, to and for their own use and benefit, for and during all the said residue and remainder of the said term of fourteen years:

And for further assurance.

AND FURTHER, that he the said [*R. W. S.*,] his executors or administrators, shall and will at any time or times hereafter, during the residue or remainder of the said term of fourteen years, upon every reasonable request, and at the costs and charges of the said Company, their successors or assigns, make, do, and execute, or cause or procure to be made, done, and excuted, all such further and other lawful and reasonable assignments, acts, deeds, matters, and things, for the better and more effectually assigning, assuring, and confirming the said privilege, letters patent, and premises hereby assigned or intended so to be, unto the said Company, their successors and assigns, for and during all the residue and remainder of the said term of fourteen years, and for and during all other the term and interest hereby granted and assigned, or intended so to be; and also for enabling them and every of them, to receive, take, exercise, and enjoy the same, to and for their own use and benefit, according to the true intent and meaning of these

presents; as by the said Company, their successors or assigns, their or any of their counsel in the law, shall be reasonably devised, or advised and required; So as such further and other assignments, acts, deeds, matters and things do not contain or imply any other or more general covenant, than against the acts, deed, and defaults of the persons who shall be required to make, do, or execute, the same, and so as the person or persons who shall be required to make or execute such further and other assignments, acts, deeds, matters, or things shall not for that purpose be compelled or compellable to go from his or their usual place or respective places of abode.

Proviso that vendor's covenants shall not extend to the original validity of the patent, &c.

PROVIDED ALWAYS, and it is hereby declared and agreed between and by the said parties to these presents, that neither these presents nor any assignment, assurance, covenant, clause, provision, matter, or thing herein expressed or contained, shall be construed, deemed, taken, or held, to be or operate as or for or by way of warranty or covenant, by the said [*R. W. S.*,] for or respecting the novelty or utility of the said invention, the original validity of the said letters patent, or the sufficiency of the said specification, or of the enrolment thereof.

IN WITNESS, &c.

(No. 3.) Assignment of a patent by way of mortgage, for securing the repayment of a sum of money and interest.

THIS INDENTURE, made the [*ninth*] day of [*April*, 1840,] BETWEEN [*J. J. P.* of, &c.] of the one part, and [*A. K.*] of, &c. of the other part.

Recital of the patent for an imported invention.

WHEREAS by letters patent under the Great Seal of the United Kingdom of Great Britain and Ireland, bearing date at Westminster the [*first*] day of [*June*,] in the [*seventh*] year of the reign of his late Majesty King William the Fourth, after reciting amongst other things that [*Andrew Pritchard, of No.* 162, *Fleet Street, in the city of London, Patent Agent*,] had by his petition humbly represented to his said late Majesty, that in consequence of a communication made to him by a foreigner resident abroad, the said [*Andrew Pritchard*] was in possession of an invention of ["*improvements in the manufacture of Ribbons and other Silken Fabrics*,"] his said late Majesty did give and grant unto the said [*Andrew Pritchard*,] his executors, administrators, and assigns, his said late Majesty's especial licence, full power, sole privilege, and authority, that he the said [*Andrew Pritchard*,] his executors, administrators, and assigns, and every of them, during the term of years therein expressed, should and lawfully might make, use, exercise, and vend the said invention within England, Wales, and Berwick upon Tweed, [and in the islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all his said late Majesty's colonies and plantations abroad,] and the whole profit, benefit, commodity, and advantage of the said invention, for and during the term of years therein mentioned; To have, hold, exercise, and enjoy the said licence, powers, privileges, and advantages thereinbefore granted unto the said [*Andrew Pritchard*,] his executors, administrators, and assigns, for, and during and unto the full end and term of fourteen years from the date of the

now reciting letters patent next ensuing, and fully to be complete and ended; Subject, amongst other things, to a proviso, that if the said [*Andrew Pritchard*] should not particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, by an instrument in writing under his hand and seal, and cause the same to be enrolled in his said late Majesty's High Court of Chancery, within [*six*] calendar months next after the date of the now reciting letters patent, the said letters patent, and all liberties and advantages whatsoever thereby granted, should utterly cease, determine, and become void. And also subject to the several other provisoes, conditions, and stipulations in the now reciting letters patent expressed or contained.

Recital of specification. AND WHEREAS by a specification under the hand and seal of the said [*Andrew Pritchard,*] bearing date and enrolled in Chancery on or about the [*first*] day of [*December,*] A. D. [1837,] the said [*Andrew Pritchard*] did declare that the nature of the said invention, and the manner in which the same is to be performed, was thereby described and ascertained in manner therein mentioned or expressed.

Recital of assignment. AND WHEREAS by an indenture of assignment bearing date, &c. [*Recital of an assignment from Andrew Pritchard to J. J. P. as in the form, ante,* p. 740.]

Recital of contract for loan. AND WHEREAS the said [*J. J. P.*] lately applied to and requested the said [*A. K.*] to advance and lend him the said [*J. J. P.*] the sum of [2000*l.*,] which the said [*A. K.*] consented to do upon having the repayment thereof, with interest, in the mean time for the same secured in manner hereinafter mentioned or expressed.

TESTATUM, *in consideration of* 2000*l*, NOW THIS INDENTURE WITNESSETH, that in pursuance of the said agreement, and in consideration of the sum of [2000*l.*] sterling to the said [*J. J. P.*,] paid by the said [*A. K.*] upon or before the execution of these presents, the receipt of which same sum the said [*J. J. P.*] doth hereby acknowledge, and of and from the same sum, and every part thereof, doth release and discharge the said [*A. K.*,] his heirs, executors, administrators, and assigns, for ever by these presents; *He,* the said [*J. J. P.*] HATH granted, bargained, sold, assigned, assured, transferred, and set over, *And* by these presents, DOTH grant, bargain, sell, assign, assure, transfer, and set over unto the said [*A. K.*,] his executors, administrators, and assigns,

Mortgagor assigns to mortgagee,

All the patent licence and privilege, &c. ALL that the said especial licence, full power, sole privilege, and authority, and the said invention, and all and every of the rights, privileges, profits, benefits, commodities, and advantages in and by the said hereinbefore recited letters patent of the [*first*] day of [*June,*] in the said [*seventh*] year of the reign of his late Majesty granted unto the said [*A. P.*,] his executors, administrators, and assigns, Together with the said hereinbefore recited letters patent; And also all the right, title, interest, claim, and demand whatsoever of him the said [*J. J. P.*,] his executors and administrators, or any of them, to apply and petition for, obtain, and procure a prolongation or prolongations, extension or extensions of the said licence, privilege, and authority, and of the said term of fourteen years granted

by the said hereinbefore recited letters patent, and to apply and petition for, obtain, and procure any new or other letters patent to be granted, or any Act of Parliament to be made or passed, for giving or granting the sole right, power, privilege, or authority, to make, use, exercise, or vend the said invention or discovery, within England, Wales, Berwick upon Tweed, [the islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all her Majesty's colonies and plantations abroad,] for any term or terms of years, or any new or additional term or terms of years. Together with all the right, title, interest, profit, benefit, advantages, property, possibility, claim and demand, as well legal as equitable of him the said [*J. J. P.*,] in, to, from, out of, or upon the said licence, privilege, authority, letters patent, rights and premises, hereby assigned or intended so to be:

Habendum to the mortgagee, his executor, &c. subject to a proviso for redemption.

TO HAVE, HOLD, AND RECEIVE, take, exercise, and enjoy the said especial licence, sole privilege and authority, invention, letters patent, rights, privileges, and all and singular the premises hereby assigned or intended so to be unto and by the said [*A. K.*], his executors, administrators and assigns for and during all the rest, residue, and remainder which is now to come and unexpired of the said term of fourteen years, granted and created by the said hereinbefore in part recited letters patent; and for and during all other, the term, right and interest therein, of him the said [*J. J. P.*,] under or by virtue of the said hereinbefore in part recited letters patent, and the said hereinbefore in part recited indenture of assignment, or otherwise howsoever, to and for the sole use, benefit, and advantage of him the said [*A. K.*,] his executors, administrators, and assigns; But, nevertheless, subject to the proviso or agreement hereinafter expressed or contained, for redemption of the same licence, privileges, letters patent and premises, (that is to say,)

Proviso for redemption of the patent privilege upon payment of 2000l. and interest, in pursuance of the covenant after contained.

PROVIDED ALWAYS, and it is hereby agreed and declared between and by the said parties to these presents, that if the said [*J. J. P.*,] his executors, administrators, or assigns do and shall well and truly pay or cause to be paid to the said [*A. K.*,] his executors, administrators, or assigns the sum of [2100*l.*] of lawful British money, hereinafter mentioned in the parts, shares, and proportions, on or at the days or times, and in the manner mentioned or appointed for the payment thereof in the covenant or agreement of the said [*J. J. P.*,] hereinafter in that behalf expressed or contained, without any deduction or abatement whatsoever, according to the true intent and meaning of these presents; [*or* do and shall on the [*ninth*] day of [*October*] now next ensuing, pay or cause to be paid unto the said [*A. K.*,] his executors, administrators, or assigns, the principal and interest monies hereinafter mentioned in pursuance of the covenant of the said [*J. J. P.*] nextly hereinafter contained without any deduction whatsoever;] THEN and in such case the said [*A. K.*,] his executors, administrators, or assigns shall and will at any time after such payment upon the request and at the costs and charges of the said [*J. J. P.*,] his executors, administrators, or assigns, re-assign or re-assure

the said patent, licence, privileges, letters patent, and premises hereinbefore assigned or intended so to be unto the said [*J. J. P.*,] his executors, administrators, and assigns, or as he or they shall in that behalf order or direct, free from all incumbrances, forfeitures (*f*), and causes of forfeiture whatsoever, made, done, committed, occasioned, or permitted by the said [*A. K.*,] his executors, administrators, or assigns, or any of them, so as for the doing thereof the said [*A. K.*,] his executors, administrators, or assigns, or any of them, be not compelled or obliged to travel or go from the place or places of his, their, or any of their usual abode or dwelling.

Covenant for payment of mortgage money and interest.

AND the said [*J. J. P.*] doth hereby for himself, his heirs, executors, and administrators, covenant, promise, and agree with and to the said [*A. K.*,] his executors, administrators, and assigns that he, the said [*J. J. P.*,] his heirs, executors, or administrators shall and will well and truly pay or cause to be paid unto the said [*A. K.*,] his executors, administrators, or assigns, the sum of [2000*l.*] of lawful British money, and the sum of [100*l.*] of like lawful money as and for one year's interest for the said sum of [2000*l.*,] at the rate of [5*l.*] for 100*l.* for a year, making together the sum of [2100*l.*,] in the parts, shares, and proportions, and on or at the days or times hereinafter mentioned; (that is to say,) the sum of [50*l.*] part thereof (being half-a-year's interest for the said sum of [2000*l.*] at the rate aforesaid) on the [*ninth*] day of [*October*] now next ensuing the day of the date of these presents, which will be in the year of our Lord, [1840,] and the sum of [2050*l.*] residue thereof, (being the whole of the said principal sum of [2000*l.*,] and another half year's interest for the same at the rate aforesaid) on the [*ninth*] day of [*April*] then next following, which will be in the year of our Lord, [1841,] without any deduction or abatement whatsoever out of the same, or any part thereof, for, or in respect, or on account of any present or future taxes, charges, payments, or impositions, or any matter, cause, or thing whatsoever (save and except income tax); [*or the covenant for payment of the principal and interest may be as follows:*]

[(*g*) AND the said [*J. J. P.*] doth hereby for himself, his heirs, executors, and administrators, covenant and agree with the said [*A. K.*,] his executors, administrators, and assigns that he, the said [*J. J. P.*,] his heirs, executors, or administrators shall and will on the [*ninth*] day of [*October*] now next well and truly pay [or cause to be paid unto the said [*A. K.*,] his executors, administrators, or assigns the sum of [2000*l.*] sterling, together with interest for the same sum, after the rate of [5*l.*] for 100*l.*, for a year from the day of the date hereof, until such payment, without any deduction or abatement whatsoever out of the same principal and interest monies, or any part thereof respectively, for or in respect of any present or future taxes, impositions, matters, or things whatsoever.]

(*f*) The mortgagee must, of course, be bound not to do any act to occasion a forfeiture of the patent.

(*g*) This short form of covenant will be applicable in case the whole mortgage money is to be made payable at the end of six calendar months.

AND FURTHER, that in case the said principal sum of [2000*l.*] shall not be paid on the said [*ninth*] day of [*April,*] [1841,] he, the said [*J. J. P.,*] his heirs, executors, or administrators shall and will pay or cause to be paid unto the said [*A. K.,*] his executors, administrators, or assigns, interest for the same sum of [2000*l.*,] after the rate aforesaid, on the [*ninth*] day of [*October*] and the [*ninth*] day of [*April*] in every year until the said principal sum of [2000*l.*] shall be paid, together with a proportionate part of the like interest up to the time when the said principal sum of [2000*l.*] shall be paid, without any deduction or abatement whatsoever out of the same or any part thereof for or on account of any present or future taxes, charges, payments, or impositions, or any matter, cause, or thing whatsoever, save and except as aforesaid. *And for payment of further interest until principal paid off.*

AND the said [*J. J. P.*] for himself, his heirs, executors, and administrators, doth covenant, promise, declare, and agree with, and to the said [*A. K.*] by these presents in manner following; (that is to say), That the said hereinbefore recited letters patent of the [*first*] day of [*June,*] in the [*seventh*] year of the reign of his said late Majesty, King William the Fourth, are at the time of the sealing and delivery of these presents, good, valid, and sufficient in the law, for all and every of the purposes therein mentioned or expressed; And that the same letters patent or the grant therein expressed or contained, have not been, and are not surrendered, forfeited, or become void or voidable, in any wise howsoever: *Covenants for title.* *That the patent is valid.*

AND ALSO, that the said hereinbefore recited specification or instrument in writing of the [*first*] day of [*December,*] 1837, well and sufficiently describes and ascertains the nature of the said invention mentioned in the said hereinbefore recited letters patent; and in what manner the same invention is to be performed; And that the same specification or instrument in writing has been, and was truly and duly made and enrolled according to, and well, truly, fully, and sufficiently performed, and complied with the condition in that behalf in the same hereinbefore recited letters patent, expressed or contained: *Specification sufficient and duly enrolled.*

AND FURTHER, that he the said [*J. J. P.,*] now hath in himself good right, full power, and lawful and absolute authority, to assign the said licence, privilege, letters patent, and premises, hereby assigned or intended to be, unto the said [*A. K.*] his executors, administrators, and assigns, for and during all the residue and remainder of the said term of fourteen years, and in manner aforesaid, according to the true intent and meaning of these presents: *Mortgagor has good right to assign.*

AND ALSO, that in case default shall be made in payment of the said principal sum of [2000*l.*,] or any part thereof on the said [*ninth*] day of [*April,* 1841,] contrary to the covenant of the said [*J. J. P.,*] for payment thereof, hereinbefore expressed or contained, then and in that case, and from and immediately after such default in payment, it shall be lawful for the said [*A. K.,*] his executors, administrators, and assigns, to have, use, exercise, and enjoy the said licence, invention, privileges, letters patent, and premises, hereinbefore assigned, and to receive and take all the profits, benefits, and advantages thereof, to and for his and *In case of default in payment of mortgage money, mortgagee may enjoy, &c.*

their own use and benefit, for and during the then residue of the said term of fourteen years, for and during all such right, term, and interest therein as aforesaid, without any interruption, hinderance, or disturbance of, from or by the said [*Andrew Pritchard,*] his executors or administrators, or the said [*J. J. P.,*] his executors or administrators, or any person or persons whomsoever, having, or lawfully or equitably claiming any right, title, or interest, in or to the said patent, licence, privileges, letters patent, and premises, or any part or parts thereof:

That mortgagor will not do any act to avoid the patent.

AND ALSO, that the said [*J. J. P.,*] his executors, administrators, and assigns, or any of them, or the said [*A. Pritchard,*] his executors, administrators, and assigns, or any of them, shall not, nor will, at any time or times hereafter, during the residue or remainder of the said term of fourteen years, or for or during any other term or interest hereby assigned or intended so to be, make, do, or execute, or knowingly or willingly permit or suffer any act, deed, matter, or thing, whatsoever, whereby, or by reason, or means whereof, the said [*A. K.,*] his executors, administrators, or assigns, may, can, or shall, be in any wise prevented or hindered from, or impeded in or about the having, receiving, taking, exercising, or enjoying, the said licence, privileges, letters patent, and premises hereby assigned or intended so to be, or any part thereof, to and for his and their own proper use and benefit, for and during all the rest, residue, and remainder of the said term of fourteen years, and for and during all other, the term, right, and interest, therein hereby granted or assigned, or intended so to be, and every part thereof.

And for further assurance.

AND MOREOVER that in case default shall be made in payment of the said principal sum of [2000*l.*] or any part thereof, on the said [*ninth*] day of [*April,*] contrary to the aforesaid covenant of the said [*J. J. P.*] for payment thereof; then and in such case he the said [*J. J. P.,*] his executors and administrators, and all and every other persons and person having or lawfully or equitably claiming any right, title, part, share or interest to or in the said licence, privileges, letters patent, and premises hereby granted or assigned, or any of them or any part thereof, shall and will at any time or times after such default in payment as aforesaid, and during the residue and remainder of the said term of fourteen years, and also during all and every other term, right, and interest hereby granted or assigned, or intended so to be, upon every reasonable request of the said [*A. K.,*] his executors, administrators, or assigns; and, before any sale by virtue of the power for that purpose hereinafter expressed or contained, at the costs and charges of the said [*J. J. P.,*] his executors, or administrators, and after such sale at the costs and charges of the person or persons requiring the same; make, do, and execute, or cause and procure to be made, done, and executed, all such further and other lawful and reasonable assignments, assurances, acts, deeds, matters, and things for the further, better, and more effectually and absolutely assigning, assuring, granting, and confirming of the said licence, privileges, letters patent, and premises hereby assigned and granted, or intended so to be, unto the said [*A. K.*] for and during all the rest, residue and remainder

of the said term of fourteen years, and for and during all and every other term, right and interest therein, hereby granted and assigned, or intended so to be; and also for enabling him, them, and every of them to have, receive, take, exercise, and enjoy the same, to and for his and their own proper use and benefit, according to the true intent and meaning of these presents; as by the said [*A. K.*,] his executors, administrators, or assigns, his, their, or any of their counsel in the law, shall be reasonably devised, or advised and required:

PROVIDED ALWAYS, and it is hereby declared and agreed, that unless and until default shall be made in payment of the said principal and interest monies hereinbefore covenanted to be paid, contrary to the covenant of the said [*J. J. P.*] in that behalf hereinbefore contained, it shall be lawful for the said [*J. J. P.*,] his executors, administrators, and assigns, to work, use, put in practice, exercise, and enjoy, the said invention, especial licence, privileges, and authorities hereby assigned or mentioned so to be, and to have, receive, take, and enjoy, all and every of the profits, emoluments, benefits and advantages of and arising from the said invention, especial licence, liberties, privileges, letters patent, and premises, hereinbefore mentioned to be hereby assigned, to and for his and their own proper use and benefit, without any hinderance, interruption, or disturbance whatsoever of, from, or by the said [*A. K.*,] his executors or administrators, or any person or persons whomsoever, rightfully or lawfully claiming, through, under, or in trust for him, them, or any of them, any thing herein contained to the contrary thereof, in anywise notwithstanding: *Proviso that mortgagor shall enjoy until default.*

PROVIDED ALSO, and it is hereby further declared and agreed, that if default shall be made in payment by the said [*J. J. P.*,] his heirs, executors, administrators, or assigns unto the said [*A. K.*,] his executors, administrators, or assigns of the aforesaid principal and interest monies, or any part thereof respectively, on or at the days or times hereinbefore mentioned and appointed for the payment thereof, [*or* on the [*ninth*] day of [*October*,] now next ensuing] contrary to the covenant of the said [*J. J. P.*] in that behalf hereinbefore contained; and the said [*A. K.*,] his executors, administrators, or assigns, shall thereupon or at any time thereafter by any writing under his or their hand or hands, give notice to the said [*J. J. P.*,] his executors, administrators, or assigns, to pay the said sum of [2000*l.*] or so much thereof as shall be then due and owing on the security of these presents, or leave such notice at the last known place of abode or business of the said [*J. J. P.*] in England; and the said [*J. J. P.*,] his executors, administrators, or assigns, shall not within the space of [*two*] calendar months next, after such notice shall have been so given or left, well and truly pay or cause to be paid to the said [*A. K.*,] his executors, administrators, or assigns, the said sum of [2000*l.*,] or so much thereof as shall be then due and owing on the security of these presents; and all interest for the said sum of [2000*l.*,] OR if any half yearly payment of interest for the said sum of [2000*l.*] or any part thereof, shall at any time *Power of sale.*

hereafter be in arrear and unpaid by the space of three calendar months next after the half yearly day of payment, upon which the same shall become due and payable, THEN, and in either of the said cases, it shall and may be lawful to and for the said [*A. K.*] his executors, administrators, or assigns, at any time or times after the expiration of the said [*two*] calendar months, for which such notice shall have been so given or left as aforesaid, or after such default in payment of interest as aforesaid (*as the case may be*), and either with or without the consent of the said [*J. J. P.*,] his executors, administrators, or assigns, to make sale and dispose of the said especial licence, privileges, powers, and authorities, granted by the said letters; and also the said letters patent, and all other the profits, benefits, advantages, and premises, hereby assigned or expressed, and intended so to be, either by public or private sale or contract, unto any person or persons, who shall be willing to become and be the purchaser or purchasers thereof for the most money that can be reasonably had or gotten for the same; and that for the purposes aforesaid or any of them, it shall and may be lawful to and for the said [*A. K.*,] his heirs, executors, administrators, or assigns, to enter into, make, and execute, all such agreements, assignments, and assurances, as he the said [*A. K.*,] his executors, administrators, or assigns, shall think fit: And it is hereby agreed and declared between and by the parties to these presents, and the true intent and meaning of them and of these presents is, that all such agreements, assignments, and assurances, as shall be entered into, made, or executed, by the said [*A. K.*,] his executors, administrators, or assigns, with, to, or in trust for the purchaser or purchasers of the said especial licence, privileges, letters patent, and premises hereby assigned or expressed and intended so to be, or any part or parts thereof, shall to all intents and purposes whatsoever, although the said [*J. J. P.*,] his heirs, executors, administrators, or assigns, shall not join or concur therein or consent thereto, be valid and effectual in the law; and shall bind him the said [*J. J. P.*,] his executors, administrators, and assigns, and all and every persons and person claiming or to claim by, from, through, or under, or in trust for him, them, or any of them; and also that the receipt or receipts of the said [*A. K.*,] his executors, administrators, or assigns, signed with his or their hand or hands, shall be a good and effectual discharge, or good and effectual discharges to the purchaser or purchasers of the said especial licence, privilege, letters patent, and premises, for the money therein mentioned to be received; and such purchaser or purchasers paying the same money to the said [*A. K.*,] his executors, administrators, or assigns, shall not be answerable or accountable for the loss, misapplication, or non-application of the money which in and by such receipt or receipts shall be mentioned or expressed to be received; and that no such purchaser or purchasers shall be obliged or concerned to see or enquire whether either of the said cases shall have happened in which the said especial licence, privileges, letters patent, and premises are hereby made saleable: And it is hereby agreed and declared between and by the

parties to these presents, that the said [*A. K.*,] his executors, administrators, and assigns, shall stand and be possessed of, and interested in all and every sums and sum of money, to arise by any sale or sales which shall be made of the said especial licence, privileges, letters patent, and premises, in pursuance of, or under the power hereinbefore in that behalf contained, upon the trusts, and to and for the intents and purposes hereinafter mentioned, (that is to say) Upon trust in the first place, by, with, and out of the same, to reimburse himself or themselves, or pay, discharge, and satisfy all the costs, charges and expenses, attending such sale or sales, or which he or they shall or may otherwise incur or be put unto, in or about the exercise of the said power of sale, or in any wise relating thereto; and in the next place to retain and reimburse himself or themselves, or pay and satisfy the said principal sum of [2000*l.*] intended to be hereby secured, and all interest which shall be then due for the same, and to render and pay the surplus if any, of the said sum or sums of money unto the said [*J. J. P.*,] his executors, administrators, or assigns: And it is hereby further declared, that previously to any sale of the said especial licence, privileges, letters patent, and premises, under the aforesaid power, it shall be lawful for the person or persons exercising the same, to make such stipulations and conditions in the contract or particular of sale thereof, as to the title to be required by the purchaser or purchasers, or the evidence to be produced in support of the same as such person or persons only in his or their own absolute discretion shall think fit; and further, that on any such sale as aforesaid, the same privileges, letters patent, and premises, if put up to sale by any public auction, may be bought in from time to time and resold or not at the discretion of such person or persons who shall not be accountable for any loss which may have been incurred in respect thereof; and all losses and expenses attending any such sales, buyings in, and resales, shall be considered as the costs attending the sale hereby authorized.

IN WITNESS, &c.

(No. 4.)
Licence by deed poll in consideration of a sum of money.

TO ALL TO WHOM THESE PRESENTS SHALL COME or be made known, [*James Gowland, of Leathersellers' Buildings, London Wall, in the City of London, Chronometer Manufacturer,*] Sends Greeting: WHEREAS by letters patent under the Great Seal of the United Kingdom of Great Britain and Ireland, bearing date at Westminster the [*fifteenth*] day of [*July,*] in the [*seventh*] year of the reign of Queen Victoria, her said Majesty did give and grant unto the said [*J. G., or* unto one *E. P.*,] his executors, administrators, and assigns, and such others as he or they should agree with and no others, the sole privilege of making, using, exercising, and vending his, the said [*J. G.'s or E. P.'s*] invention of ["*improvements, &c.*"] in England, Wales, and Berwick upon Tweed, for and during the term of fourteen years from the date of the said letters patent: And her said Majesty did by her said letters patent command

Recital of patent.

all other persons within England, Wales, and Berwick upon Tweed, that neither they or any of them at any time during the said term of fourteen years, should either directly or indirectly make, use, or put in practice the said invention or any part thereof without the licence, consent, or agreement of the said [*J. G. or E. P.*,] his executors, administrators, or assigns, in writing, under his or their hands and seals, first had and obtained in that behalf:

Recital of specification. AND WHEREAS the said [*J. G. or E. P.*] caused a specification of the said invention, under his hand and seal, to be duly enrolled in Chancery on or about the [*fifteenth*] day of [*January*, 1844]:

Recital of assignment. [AND WHEREAS by an indenture of assignment, bearing date on or about the [*twentieth*] day of [*June*, 1844,] and made or expressed to be made between the said [*E. P.*] of the one part, and the said [*J. G.*] of the other part, for the considerations therein mentioned, the said sole privilege, and all rights, powers, authorities, profits, benefits, and advantages granted by the said letters patent unto the said [*E. P.*,] his executors, administrators, and assigns, together with the same letters patent, were assigned unto the said [*J. G.*,] his executors, administrators, and assigns for his and their own proper use and benefit]:

Recital of contract for sale of a licence. AND WHEREAS the said [*J. G.*] hath contracted and agreed with [RICHARD DENTON, *of Preston, in the county of Lancaster, Watch Manufacturer*,] for the sale to him of a licence to use [such part of] the said invention and patent privilege [as hereinafter mentioned] [within the said county of Lancaster,] at or for the price or sum of [250*l*]:

Testatum, in consideration of 250*l*. *Patentee grants licence to the purchaser.* NOW KNOW YE, and THESE PRESENTS WITNESS, that in consideration of the sum of [250*l*.] sterling to the said [*J. G.*,] paid by the said [*R. D.*,] upon or before the execution of these presents, the receipt whereof the said [*J. G.*] doth hereby acknowledge, and from the same sum and every part thereof doth hereby release and discharge the said [*R. D.*,] his heirs, executors, administrators, and assigns. *He*, the said [*J. G.*,] HATH given and granted, *And by these presents* DOTH *give* and grant unto the said [*R. D.*,] [his executors, administrators, and assigns (*h*)] Full and free liberty, licence, and authority during the residue of the said term of fourteen years, to make, use, exercise, and vend the said ["*improvements, &c.*" *Here insert the title of the invention,*] mentioned in the said letters patent according to and in manner described or mentioned in the said specification, [*or* make, use, exercise, and vend that part of the said improvements mentioned in the said letters patent, and in the said specification described as the [*second*] part of the said invention, according to and in manner described or mentioned in the said specification]:

Proviso for avoiding the licence if licensee assigns it, becomes bankrupt, &c. [PROVIDED ALWAYS, and these presents are upon this express condition, that in case the said [*R. D.*] shall depart this life at any time during the residue of the said term of fourteen years, or in case the said

(*h*) If the licence is not to be assignable these words must, of course, be omitted.

[*R. D.*,] or any person claiming under him, shall at any time during the said residue of the said term become bankrupt, or take the benefit of any statute or statutes for the relief of insolvent debtors, or without the consent in writing of the said [*J. G.*,] his executors, administrators, or assigns, first had or obtained, make or execute any assignment, assurance, deed, or instrument, or do or permit any act, matter, or thing whatsoever, whereby or by means whereof the said liberty, licence, or authority hereby granted, or the benefit thereof, or any part thereof, shall or may be, or otherwise (and but for this present proviso or condition) should or might have been, assigned or assured to or vested in or in trust for any person or persons whomsoever other than and except the said [*R. D.*,] then and in any such case these presents and every thing herein expressed and contained shall cease, determine, and become and be utterly void to all intents and purposes whatsoever]:

Condition against the licence being vested in more than one person at a time.

[PROVIDED ALWAYS that these presents are upon this express condition, that in case the liberty, licence, or authority hereby granted or the benefit thereof shall at any time hereafter during the residue of the said term of fourteen years be assigned to, or in trust for, or become vested in, or be disposed of for the use or benefit of more than one person at any one time, then and in any such case these presents and the said liberty, licence, and authority hereby granted, and every thing hereinbefore expressed and contained shall cease, determine, and become and be utterly null and void to all intents and purposes whatsoever, anything hereinbefore contained to the contrary thereof in anywise notwithstanding.]

IN WITNESS whereof the said [*J. G.*] hath hereunto set his hand and seal the [*thirteenth*] day of [*November*,] A. D. [1845].

(No. 5.)

Licence by a patentee and assignees of parts of the patent right to a Company formed by Act of Parliament.

THIS INDENTURE, made the [*second*] day of [*October*,] A.D. [1843,] BETWEEN [*A. B.*] of, &c., [*C. D.*] of, &c., and [*E. F.*] of, &c., of the one part, and [The Company,] established by an Act of Parliament passed in the [*eighth*] year of the reign of her present Majesty, intituled [" An Act, &c.,"] of the other part, WHEREAS by letters patent under the Great Seal of the United Kingdom of Great Britain and Ireland, bearing date at Westminster the [*twenty-fourth*] day of [*August*,] in the [*sixth*] year of the reign of Queen Victoria, (being in the year of our Lord, [1842,]) after reciting (among other things) that the said [*A. B.*] had by his petition represented unto her said Majesty that in consequence of a communication made to him by a certain foreigner resident abroad, he was in possession of an invention of ["*improvements in machinery, &c.*,"] her said Majesty did by her said letters patent grant unto the said [*A. B.*,] his executors, administrators, and assigns, her said Majesty's especial licence, full power, sole privilege, and authority, that he the said [*A. B.*,] his executors, administrators, and assigns, and every of them, by himself and themselves, or by his or their deputy or deputies, servants or agents, or such others as he the said [*A. B.*,] his executors, administrators, or assigns, should at any time

Recital of patent.

agree with, and no others, from time to time and at all times thereafter, during the term of years therein unexpired, should and lawfully might make, use, exercise, and vend the said invention within England, Wales, and Berwick upon Tweed, [and the islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all her said Majesty's Colonies and Plantations abroad,] in such manner as to him the said [*A. B.*,] his executors, administrators, and assigns, or any of them, should in his or their discretion seem meet; and that he the said [*A. B.*,] his executors, administrators, and assigns, should and lawfully might have and enjoy the whole profit, benefit, commodity, and advantage from time to time coming, growing, and arising by means of the said invention, for and during the term of years therein mentioned; To have, hold, exercise, and enjoy the said licence, powers, privileges, and advantages thereinbefore granted, or mentioned to be granted, unto the said [*A. B.*,] his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years from the date of the said letters patent next and immediately ensuing, and fully to be complete and ended according to the statute in such case made and provided: And to the end that the said [*A. B.*,] his executors, administrators, and assigns might have and enjoy the full benefit, and the sole use and exercise of the said invention, her said Majesty did by the said letters patent command all and every persons and person, bodies politic and corporate, and all other her subjects whatsoever, that neither they nor any of them at any time during the continuance of the said term of fourteen years, should make, use, or put in practice the said invention without the licence, consent, or agreement of the said [*A. B.*,] his executors, administrators, or assigns, in writing, under his or their hands and seals, first had and obtained:

Recital of enrolment of a specification.

AND WHEREAS a specification or instrument in writing, under the hand and seal of the said [*A. B.*,] ascertaining and describing the nature of the said invention, and the manner in which the same invention is to be performed, was duly enrolled in Chancery on the [*twenty-fourth*] day of [*February*, 1843]:

Recital of assignment of one-third of patent to C. D.

AND WHEREAS by indenture of assignment, bearing date on or about the [*twenty-eighth*] day of [*May*, 1843,] and made or expressed to be made between the said [*A. B.*,] of the one part, and the said [*C. D.*,] of the other part, for the consideration in the now reciting indenture expressed, one [*third*] part or share of and in the said privilege, benefits, and profits granted by the said letters patent, was assigned by the said [*A. B.*] unto the said [*C. D.*,] his executors, administrators, and assigns, for his and their own proper use and benefit:

Recital of assignment of another third to E. F.

AND WHEREAS by indenture of assignment, bearing date on or about the [*fifteenth*] day of [*December*, 1843,] and made or expressed to be made between the said [*A. B.*,] of the first part, the said [*E. F.*,] of the second part, and the said [*C. D.* (*i*)] of the third part, for the con-

(*i*) *C. D.* was made a party to this deed in order that he might be privy to the assignment.

sideration, &c. [*A similar recital as the last, of the assignment of another third part of the patent privilege to E. F.*]:

Recital of contract for licence.

AND WHEREAS the said [*A. B., C. D., and E. F.,*] have contracted and agreed with the said Company to grant to them a licence to use the said invention in consideration of the sum of [1000*l.*,] and upon the terms and in manner hereinafter expressed or mentioned:

Testatum, in consideration of 1000*l. and the reservation patentee and assignees grant the licence.*

NOW THIS INDENTURE WITNESSETH, that in pursuance of the said agreement, and in consideration of the sum of [1000*l.*] sterling to the said [*A. B., C. D., and E. F.,*] paid by the said Company on or before the execution of these presents, the receipt of which said sum of [1000*l.*] the said [*A. B., C. D., and E. F.*] do hereby acknowledge, and of and from the same sum and every part thereof, do and each of them doth acquit, release, and discharge the said Company, their successors, and assigns for ever by these presents; and also, in consideration of the reservations and covenants hereinafter contained, and on the part of the said Company to be paid and performed, They, the said [*A. B., C. D., and E. F.,*] HAVE and each and every of them HATH given and granted, And by these presents Do, and each of them DOTH give and Grant unto the said Company their successors and assigns, Full and free liberty, licence, and authority by themselves, their agents, servants, and workmen, to make, work, use, exercise, and put in practice the said invention and sole privilege granted by the said letters patent, together with all and every of the profits, gains, and advantages of or arising from the said licence and authority hereinbefore granted;

Habendum to Company, their successors and assigns during the residue of fourteen years.

TO HAVE, HOLD, RECEIVE, take, exercise, and enjoy the said licence, authority, and premises hereinbefore given and granted, or intended so to be unto and by the said Company, their successors, and assigns, for and during all the rest, residue, and remainder now to come and unexpired of the said term of fourteen years, granted by the said letters patent, and also for and during all and every such further and other terms and term as shall or may at any time or times hereafter be given or granted, of or in the said invention, or the use thereof, by any new or other letters patent, or otherwise howsoever, To and for the sole and proper use and benefit of the said Company, their successors and assigns;

Redendum of 10s. per week for each of 20 machines, &c.

NEVERTHELESS YIELDING, rendering, and paying therefore unto the said [*A. B., C. D., and E. F.,*] their executors, administrators, and assigns, the sum of [*ten shillings*] per week for each machine made or manufactured, and used according to the said invention, which the said Company, their successors, or assigns shall or may from time to time have in use, up to and not exceeding [*twenty*] of such machines in the whole; AND ALSO the further sum of [7*s.* 6*d.*] per week for every further and other of such machines as aforesaid which the said Company, their successors, or assigns shall or may from time to time have in use over and above the first [*twenty*] of such machines, up to and not exceeding [*ten*] of such further and other machines; AND ALSO the

further sum of [5*s.*] per week for every further and other of such machines as aforesaid, which the said Company, their successors, or assigns shall or may have in use over and above the first [*thirty*] of such machines, all such weekly renders or sums to be paid by monthly payments in advance, and the payments for such machine to commence from the time when such machine shall first be used according to the said invention (subject nevertheless to the proviso for suspension or cessor of the same payments hereinafter contained):

Covenant by Company to pay the sum reserved.

AND the said Company, for themselves, their successors, and assigns, do hereby covenant, promise, and agree with, and to the said [*A. B., C. D., & E. F.,*] their executors, administrators, and assigns, in manner following (that is to say), that the said Company, their successors, and assigns, shall and will at all times during the continuance of the licence and authority hereby granted, well and truly pay, or cause to be paid, unto the said [*A. B., C. D., & E. F.,*] their executors, administrators, and assigns, in and by such monthly payments as aforesaid, all and every of the weekly renders or sums, which shall or may at any time or times hereafter become due or payable under, by virtue, or in pursuance of these presents (subject nevertheless as aforesaid):

Power of distress.

AND FURTHER, that in case any or either of the said monthly payments so to be made as aforesaid, shall be in arrear and unpaid for the space of [*twenty-eight*] days after the same shall have become payable (in case the same shall have been lawfully demanded), then and in every such case, and as often as the same shall happen, it shall and may be lawful to and for the said [*A. B., C. D., & E. F.,*] their executors, administrators, and assigns, to enter into and upon the place or places where such machines as aforesaid, or any of them shall be kept, and then and there to seize and distrain the goods, chattels, and things, then being in and upon such place or places belonging to the said Company, their successors, or assigns, or any part of such goods, chattels, and things; and in due time to sell and dispose thereof, and out of the produce of such sale or sales, after paying the expenses attending the same distress and sale, to retain and pay to themselves all such monies for which such distress shall have been made; and also all further and other renders, monies, and payments (if any), which shall or may in the meantime have become due or payable under, or by virtue of these presents, and generally to act in and about every such distress in the same manner, to all intents and purposes as landlords are entitled to act in cases of distress for rent in arrear:

To deliver inventories of machines.

AND ALSO that the said Company shall and will forthwith and immediately after the execution hereof, deliver unto each of them the said [*A. B., C. D., & E. F.,*] his executors, administrators, or assigns, an inventory or list of all and every of such machines as aforesaid which the said Company are now using or intend to use, according to the said invention specifying the place or places where the same machines respectively are situated or placed.

AND FURTHER that in case the said Company, their successors, or assigns, shall at any time or times hereafter intend to remove such machines, or any of them, then and in every such case the said Company, their successors, or assigns, shall and will give to each of them, the said [*A. B., C. D., & E. F.*] his executors, administrators, and assigns, [*three*] days' notice of such intention of the said Company, their successors, or assigns; and in every case of a removal, specifying to what place or places the machine or machines are intended to be removed; and every or any such notice shall or may be delivered to the party to whom it is to be given, or shall or may be left at his, her, or their, last known counting-house, office, place of business, or dwelling-house: *To give notice of removals of machines.*

AND ALSO that it shall and may be lawful to and for the said [*A. B., C. D., & E. F.,*] their respective executors, administrators, and assigns, and every of them by themselves or their agents, at all reasonable times in the day time, to enter into any place or places where the said Company, their successors, or assigns, shall or may keep, or use, any such machine or machines, as aforesaid, for the purpose of ascertaining whether such machine or machines, or any of them, are used according to the said invention: *That grantors may enter buildings to inspect machines.*

AND it is hereby agreed between the said parties hereto, that each of such machines so to be used as aforesaid, shall be marked with the words [" *B.'s patent,*"] and numbered in consecutive order; and that in case the said Company, their successors, or assigns, shall, or do use, employ, or work, or cause, or procure, to be used, employed, or worked, any such machine or machines, as aforesaid, according to the said invention and specification, which shall not have the words [" *B.'s patent*"] marked thereon, the said Company, their successors, or assigns, shall pay unto the said [*A. B., C. D., & E. F.,*] their executors, administrators, or assigns, the penalty or sum of [100*l.*] for every such machine which shall or may be so used, employed, or worked, as last aforesaid; and every such penalty shall be paid and recovered as and for liquidated damages: *Machines to be marked.*

PROVIDED ALWAYS, and it is hereby expressly declared and agreed by and between the said parties hereto, that it shall be lawful for the said Company, their successors, and assigns, at any time or times hereafter, and from time to time as they may think fit, to cease the using or working, or to suspend the using or working of all or any one or more of such machines as aforesaid; and at any time or times thereafter, and from time to time again to resume the use and working thereof, when they may think proper; [*seven*] days' notice at the least, being given by the said Company, their successors, or assigns, to each of the said licensors, or left at each of their respective, usual, or last known places of abode or business, or put into the Post Office, addressed to each of them, at their respective, usual, or last known places of abode or business, of the intention of the said Company, their successors, or assigns, to cease or suspend the working of the same; and [*three*] days' notice being in like manner given or left as aforesaid, of the intention of the said Company to resume working of the same; it *Use of machines may be discontinued and resumed after notice.*

being hereby agreed, that for the period or periods during which the said machines or any of them shall not have been worked agreeably to any such notice to that effect as aforesaid, no sum or sums of money shall be payable to the said [*A. B.*, *C. D.*, & *E. F.*,] their executors, administrators, or assigns, or any of them, by virtue of these presents in respect of such machines, any thing herein contained to the contrary thereof, in anywise notwithstanding; It being understood, and hereby agreed, that in stopping the working of any such machine or machines as aforesaid, that those paying the smaller rents or sums are to be stopped first, and then the next smaller, and so on:

Covenants by grantors with the Company.

AND each of them, the said [*A. B.*, *C. D.*, & *E. F.*] so far as relates to his own part, share, and interest in the premises; and to the acts, deeds, and defaults of himself, his executors, administrators, or assigns, but not further or otherwise, doth hereby for himself, his heirs, executors, administrators, and assigns, covenant, promise, and agree with, and to the said Company, their successors, and assigns, in manner following (that is to say), That they the said [*A. B.*, *C. D.*, & *E. F.*,] or some or one of them, have or hath good right, full power, and lawful and absolute authority, to give and grant unto the said Company, their successors and assigns, such licence, liberty, and authority, as aforesaid:

That they have good right to grant the licence.

For quiet enjoyment.

AND that the said Company, their successors and assigns, paying the said sums of money hereby reserved and made payable, and observing the covenants herein contained and on their part to be observed, the said licence, liberty, and authority hereby granted, shall and may be quietly and peaceably exercised, used, and enjoyed, by the said Company and their successors, without any suit, denial, interruption, hinderance or disturbance whatsoever, by or from any person or persons whomsoever:

For confirmation of licence.

AND ALSO that they the said [*A. B.*, *C. D.*, & *E. F.*,] their executors, and administrators, and all and every other persons and person, having or lawfully claiming any right or interest to or in the said letters patent, and privileges, or any part thereof, shall and will, from time to time, and at all times hereafter, during the said term and before any forfeiture of the licence hereinbefore granted or intended so to be, at the request, costs, and charges, of the said Company, their successors, and assigns, make, do, execute, and perfect, every such further and other act, deed, matter, and thing as shall or may be necessary or desirable for the confirming to and vesting in the said Company, their successors and assigns, the full and absolute licence and authority to make, work, use, exercise, and put in practice the said invention and sole privilege, in manner and form and subject to the renders or payment, covenants, conditions, and restrictions aforesaid:

That grantors will proceed against parties infringing.

AND ALSO that in case of any infringement of the said letters patent and privileges, or any part thereof by any person or persons whomsoever, which shall obstruct, lessen, or interfere with the licence or authority hereinbefore granted to the said Company, their successors and assigns, they the said [*A. B.*, *C. D.*, & *E. F.*,] their executors, administrators, or assigns, will at their own costs and charges, commence

and prosecute all necessary and proper actions, suits, and proceedings, whether at Law or in Equity, or otherwise howsoever, against such person or persons, and carry on and prosecute to effect, such certain suits and proceedings, so as to obtain damages for such infringement, and prevent the continuance thereof:

That Company shall be entitled to use any improvements made by grantors.

AND FURTHER, that if at any time or times hereafter during the continuance of this licence and authority, the said [*A. B., C. D., & E. F.,*] or any of them, shall invent, discover, or make any improvement or improvements in the said invention comprised in the said letters patent, or in the using of the same, or shall become the owners or owner of, or become or be possessed of any such improvements (whether such improvement or any of such improvements shall be the subject matter of letters patent or not,) then and in every such case, the said Company, their successors or assigns, shall be entitled to use such improvement or improvements during the continuance of the said licence and authority, without paying or making any further or other sums or sum of money, renders or render in respect thereof:

Power to revoke the licence in case of non-payment of reservations.

PROVIDED ALWAYS, and it is hereby further covenanted and agreed by and between the said parties hereto, that in case any or either of the said monthly payments hereinbefore made payable or any part thereof shall be in arrear for the space of [*twenty-eight*] days next after the same shall become due and ought to be paid, or if the said Company, their successors or assigns, shall fail in performance of all or any of the covenants herein contained on their parts and behalf to be performed, or if the said Company shall for the space of [*forty*] days cease to work [*ten*] at least of such machines as aforesaid, then and in any such case it shall and may be lawful for the said [*A. B., C. D., & E. F.,*] their executors, administrators, or assigns, or any of them, to revoke and annul these presents, and the licence and authority hereby granted, by giving [*fourteen*] days' notice in writing to the said Company, their successors or assigns to that effect, or by leaving such last-mentioned notice at the principal office of the said Company:

Apportionment of reservations amongst the grantors.

PROVIDED ALSO, and it is hereby further agreed and declared between and by the said parties to these presents, that all monies whatsoever payable to the said [*A. B., C. D., & E. F.,*] their executors, administrators, and assigns by the said Company, their successors and assigns, or any of them, in pursuance of these presents, shall be apportioned and paid as follows, (that is to say,) [*one third*] part or share of the same monies unto the said [*A. B.,*] to and for his and their own separate use and benefit, [*one other third*] part of the same monies unto the said [*C. D.,*] his executors, administrators, or assigns, to and for his and their own separate use and benefit, and the other [*one third*] part of the same monies unto the said [*E. F.,*] his executors, administrators or assigns, to and for his and their own separate use and benefit; and that each [*third*] part or share of the same monies shall or may from time to time be recovered accordingly by action, suit, or otherwise, by the person or persons entitled to receive the same, separate and apart from the

other parts or shares of the same monies, and that without joining or making the person or persons entitled to such other parts or shares a party or parties to any such action, suit, or proceeding:

Notice by Company sufficient if signed by solicitor, &c.

AND FURTHER, that any notice in writing given by the said Company, their successors or assigns, in pursuance of these presents, shall be sufficient if signed by any solicitor, secretary, officer, or other person for or on the behalf of the said Company.

IN WITNESS, &c.

(No. 6.)
Exclusive licence.

THIS INDENTURE made the [*sixth*] day of [*June*, 1844,] BETWEEN [*J. P. W.*] of, &c. of the one part, and [*L. C.*] of, &c. of the other part:

Recital of patent.

WHEREAS by letters patent under the Great Seal, &c., [*recital of letters patent granting the sole use of an invention to R. S.*] (*k*):

Recital of specification.

AND WHEREAS by a specification or instrument in writing under the hand and seal of the said [*R. S.*] &c. [*recital of specification and the enrolment of it*] (*l*):

Recital of assignment.

AND WHEREAS by an indenture of assignment bearing date, &c. [*recital of an assignment from R. S. to J. P. W.*] (*m*):

Recital of contract.

AND WHEREAS the said [*J. P. W.*] hath contracted with the said [*L. C.,*] to grant him a sole and exclusive licence to use the said invention within the town and borough of [*Leicester, and within ten miles thereof,*] during the residue of the said term of fourteen years, in consideration of the payments upon the terms, in the manner, and under and subject to the stipulations hereinafter expressed or contained:

Testatum in consideration of reservations patentee grants an exclusive licence within a town and a district of ten miles round it.

NOW THIS INDENTURE WITNESSETH, that in pursuance of the said agreement, and in consideration of the reservations and covenants hereinafter expressed or contained, and on the part of the said [*L. C.*] to be paid, observed, and performed, *He* the said [*J. P. W.*] HATH given and granted, AND by these presents DOTH give and grant unto the said [*L. C.,*] his executors, administrators, and assigns, Full and free, and also the sole and exclusive licence, permission, liberty, right, power, and authority to work, use, exercise, and put in practice the said invention of the said [*R. S.,*] and the said licence, privilege, and authority granted by the said letters patent at all places within [the town and borough of [*Leicester*] aforesaid, or within [*ten*] miles thereof;] And also to receive, have, and take all the profits, benefits, and advantages arising or accruing from, or by reason or means of the said invention, and patent privilege, licence, and authority within [*the town and borough of Leicester*] aforesaid, and within [*ten*] miles thereof, for his and their own use and benefit:

TO HAVE, HOLD, &c. [*See the Form, ante*, p. 759.]

Reservation of 2d. per yard upon all cloth

YIELDING AND PAYING therefore, by quarterly [*or monthly*] payments unto the said [*J. P. W.,*] his executors, administrators, or

(*k*) See forms, *ante*, p. 755, 757. 755, 758.
(*l*) See the forms, *ante*, p. 740, 748, (*m*) See the forms, *ante*, p. 740, 756.

assigns the sum of [*two-pence*] for every yard of [*cloth or webbing*] which he the said [*L. C.*,] his executors, administrators, or assigns shall, during the continuance of the said term, manufacture or make according to the said invention as described in the said specification, or resembling the said invention, or in imitation thereof, or any part thereof in anywise howsoever; such quarterly [*or monthly*] payments to be made on the [*sixth*] day of [*September*,] the [*sixth*] day of [*December*,] the [*sixth*] day of [*March*,] and the [*sixth*] day of [*June*] in every year, [*or on the sixth day of every calendar month*] during the residue of the said term of fourteen years, the first of such payments to be made on the [*sixth*] day of [*September*] now next ensuing, and the last payment to be made on the day next after the expiration of the said term, for such quantity of [*cloth or webbing*] as the said [*L. C.*] shall then have so manufactured or made since the last of such quarterly [*or monthly*] days of payment: *made by licensee.*

AND ALSO YIELDING AND PAYING therefore unto the said [*J. P. W.*,] his executors, administrators, or assigns, on each and every of the said quarterly [*or monthly*] days of payment, the like sum of [*two-pence*] for every yard of [*such cloth or webbing as aforesaid*,] which the quantity of [*cloth or webbing*] so manufactured or made by the said [*L. C.*,] his executors, administrators, or assigns as aforesaid, during the [*three*] calendar months [*or* calendar month] next preceding such day of payment, shall fall short and be deficient in the quantity of [1000] yards at the least; And also on the day next after the expiration of the said term of fourteen years, the like sum of [*two-pence*] for every yard of [*such cloth or webbing as aforesaid*,] which the quantity of [*cloth or webbing*] so manufactured or made by the said [*L. C.*,] his executors, administrators, and assigns since the then last of such quarterly [*or* monthly] days of payment, shall fall short or be deficient in the quantity of [750] yards at the least: *Further reservation of so much as may be necessary to make up the payments upon a certain quantity of cloth.*

AND the said [*L. C.*] for himself, &c. [*covenants by L. C., with J. P. W. to render accounts and for payment of the reservations as in the form No. 5, ante,* p. 760]:

AND the said [*J. P. W.*] for himself, his heirs, executors, administrators, and assigns, doth hereby covenant, promise, and agree with and to the said [*L. C.*,] his executors, administrators, and assigns, that he and they the said [*L. C.*,] paying the said sums of money hereby reserved, and made payable as aforesaid, and performing the covenants hereinbefore on his and their parts contained, shall and may quietly possess and enjoy the said exclusive licence, privilege, and authority hereinbefore granted for the said residue of the said term of fourteen years, without any interruption or hinderance from the said [*J. P. W.*,] his executors, administrators, or assigns, or any person or persons whomsoever, lawfully claiming by from or under him, them, or any of them: *Covenant by patentee that licensee paying the reservations, &c. shall quietly enjoy the licence.*

AND ALSO, that he the said [*J. P. W.*,] his executors, administrators, or assigns, or any of them shall not nor will at any time or times hereafter during the continuance of the said exclusive licence hereby granted, work, use, exercise or put in practice the said invention *That patentee will not work the invention within the*

limits of the licence.

or patent, privilege or any part thereof respectively, or sell or vend any goods, articles or things whatsoever, made according to or in imitation of the said invention, or any part thereof, within the said [*town and borough of Leicester*,] or any part thereof, or within [*ten*] miles thereof, or any part thereof:

That patentee will not grant any other licence for the same district.

AND FURTHER, that he the said [*J. P. W.*,] his executors, administrators, or assigns, or any of them, shall not nor will at any time during the continuance of the said exclusive licence hereby granted, without the consent in writing of the said [*L. C.*,] his executors, administrators, or assigns, first had and obtained, grant unto any person or persons whomsoever, any leave, licence, power, privilege, or authority whatsoever to work, use, exercise or put in practice, the said invention or any part thereof, or to sell or vend any goods, articles, or things whatsoever, made according to or in imitation of the said invention or any part thereof, within the said [*town and borough of Leicester*] or any part thereof, or within [*ten*] miles thereof, or any part thereof:

That patentee will, at the cost of licensee, proceed against parties infringing within the district.

AND MOREOVER, that in case any person or persons whomsoever shall or do at any time during the continuance of the said exclusive licence hereby granted within the said [*town and borough of Leicester*,] or any part thereof, or within [*ten*] miles thereof, or any part thereof, wrongfully work, use, exercise or put in practice the said invention, or sell or vend any goods, articles or things made according to, or in imitation of, the said invention or any part thereof, or do any other act against or in violation of the said patent privilege, or in any other manner infringe the same privilege, then and in every such case, and from time to time, so often as the same shall happen, he the said [*J. P. W.*] shall and will at the request, costs, and charges of the said [*L. C.*,] his executors, administrators, and assigns, and upon being well and sufficiently exonerated and indemnified from and against all loss, costs, charges, damages, and expenses for, upon account, or in respect thereof, take all such proceedings whether at Law, in Equity, or otherwise, as shall or may be necessary or expedient for recovering damages against all and every persons and person so violating or infringing the said patent, privilege, or any part thereof, and for restraining all and every such persons and person from so violating or infringing the said patent, privilege, or any part thereof:

That patentee will produce the patent and specification in evidence.

AND ALSO that the said [*J. P. W.*,] his executors, administrators, or assigns shall and will from time to time during the continuance of the said exclusive licence hereby granted, at the request, costs, and charges of the said [*L. C.*,] his executors, administrators, or assigns, produce, or cause and procure to be produced in evidence, the said letters patent and specification respectively hereinbefore recited, in any action, suit, or other proceeding, to or in which the said [*L. C.*,] his executors, or assigns shall or may be party or parties, or interested in any manner howsoever:

PROVIDED ALWAYS, and it is hereby declared and agreed, &c., [*power to avoid the licence in case of non-payment of the reservations as in the form, No. 5, ante*, p. 763.]

IN WITNESS, &c.

(No. 7.)
Exclusive and irrevocable licence.

THIS INDENTURE made the [*twenty-ninth*] day of [*November,*] A. D., [1845,]

BETWEEN [*James Gowland*] of, &c., of the one part, and [*Aaron Jacob*] of, &c., of the other part:

Recital of patent.

WHEREAS by letters patent, &c., [*recital of a patent granted to J. G.* (*n*)]:

Recital of specification.

AND WHEREAS by the specification, &c., [*recital of the specification and enrolment of it* (*o*)]:

Recital of contract for sale of licence.

AND WHEREAS the said [*J. G.*] hath contracted and agreed with the said [*A. J.,*] for the sale to him of the exclusive and irrevocable licence for using the said invention, [*in the counties of York and Lancaster*] as hereinafter expressed, at or for the price or sum of [100*l.*]:

Testatum, in consideration of [1000*l.*] *patentee grants an exclusive and irrevocable licence for the counties of York and Lancaster.*

NOW THIS INDENTURE WITNESSETH, that in pursuance of the said agreement, and in consideration of the sum of [1000*l.*] of, &c., [*payment of the purchase-money and discharge as in the form No. 4, ante*, p. 756,] He the said [*J. G.*] HATH given and granted, and by these presents DOTH give and grant unto the said [*A. J.,*] his executors, administrators, and assigns, the sole, exclusive, and irrevocable licence, power, privilege, and authority, that he the said [*A. J.,*] his executors, administrators, and assigns, and every of them, by himself and themselves, or by his and their deputies, servants and agents or such others as he the said [*A. J.,*] his executors, administrators, and assigns, shall at any time agree with and no others, from time to time and at all times hereafter during the residue of the said term of years in the said letters patent mentioned, shall and lawfully may make, use, exercise, and vend the said invention, [*within the said counties of York and Lancaster,*] in such manner as to him the said [*A. J.,*] his executors, administrators, and assigns, or any of them shall in his or their discretions, seem meet; And that he the said [*A. J.,*] his executors, administrators, and assigns shall and lawfully may have and enjoy the whole profits, benefits, and advantages from time to time, coming, growing, accruing and arising by reason of the said invention, [*within the said counties of York and Lancaster;*] for and during the residue of the said term;

Habendum to the licensee, his executors, &c. during all the residue of the term of the patent.

TO HAVE, HOLD, AND RECEIVE, take, exercise and enjoy the said licence, powers, privileges and advantages hereinbefore granted, or mentioned and intended to be granted, unto the said [*A. J.,*] his executors, administrators, and assigns, for and during all the rest, residue and remainder now to come and unexpired of the said term of fourteen years, granted by the said letters patent, and for and during all and every other, the term, right, and interest therein of him the said [*J. G.*]

Covenant by grantor with licensee.

AND the said [*J. G.*] for himself, his heirs, executors, administrators, and assigns, both hereby covenant, grant, and agree with and to the said [*A. J.,*] his executors, administrators, and assigns in manner following (that is to say,) THAT (notwithstanding any act or thing by him the

(*n*) See the forms of recitals, *ante*, p. 755 & 757.

(*o*) See forms of recitals, *ante*, p. 740, 748, 755, 758.

That he has good right to grant the licence.

said [*J. G.*,] done or suffered) he hath good right, full power and lawful and absolute authority to give and grant unto the said [*A. J.*,] his executors, administrators, and assigns, such sole, exclusive, and irrevocable licence, power, privilege, and authority as aforesaid:

For quiet enjoyment.

AND that notwithstanding any such act or thing as aforesaid, the same licence, power, privilege, and authority, shall and may be quietly and peaceably exercised and enjoyed, and the said profits and advantages shall and may be obtained, taken and received by the said [*A. J.*,] his executors, administrators, and assigns, without any suit, hinderance or disturbance whatsoever of or from him the said [*J. G.*,] his executors or administrators, or any person or persons claiming under or in trust for him or them:

For confirmation of licence.

AND MOREOVER, that the said [*J. G.*,] his executors and administrators, and all and every other persons and person having or lawfully claiming any right, title, or interest to or in the said letters patent, privileges and premises, or any part thereof, shall and will, from time to time, and at all times hereafter during the said term, at the request, costs and charges of the said [*A. J.*,] his executors, administrators, or assigns, make, do, and execute every such further and other gift, grant, act, deed, matter and thing as shall or may be necessary or desirable for the further or more perfectly, entirely, or satisfactorily giving, granting, or confirming the said sole, exclusive, and irrevocable licence, power, privilege and authority, profits, advantages and premises unto the said [*A. J.*,] his executors, administrators, and assigns, to and for his and their own proper use and benefit, in manner aforesaid:

That patentee will not work the invention within the district.

AND ALSO that he the said [*J. G.*,] his executors, administrators, or assigns, or any of them, shall not, nor will at any time hereafter, during the residue of the said term of fourteen years, work, use, exercise, or put in practice, &c. [*as in the form, ante*, p. 765.]

And will not grant any other licence for the district.

AND FURTHER that he the said [*J. G.*,] his executors, administrators, or assigns, or any of them, shall not nor will at any time hereafter during the residue of the said term, give or grant unto any person or persons whomsoever, other than and except the said [*A. J.*,] his executors, administrators, or assigns, any leave, licence, &c. [*as in the Form, ante*, p. 766.]

IN WITNESS, &c.

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THE END.

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