A TREATISE

ON THE

LAW AND PRACTICE

RELATING TO

LETTERS PATENT FOR INVENTIONS.

BY

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OF THE INNER TEMPLE, BARRISTER-AT-LAW.

"The end of our foundation is the enlarging of the bounds of human empire to the effecting of all things possible."—LORD BACON, *New Atlantis.*

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TO

THE RIGHT HONOURABLE

ROBERT MONSEY BARON CRANWORTH,

LORD HIGH CHANCELLOR OF GREAT BRITAIN, ETC. ETC.

ONE OF HER MAJESTY'S COMMISSIONERS OF PATENTS FOR INVENTIONS,

THIS LITTLE WORK

IS

RESPECTFULLY DEDICATED.

INTRODUCTION.

THE great system of rewards to inventors, popularly known as the Law of Patents, was originally instituted in England. It has been adopted into the legislation of almost all civilized countries.

Society, grateful to him who adds to its stock of practical knowledge, confers on him a reward which is measured by the substantial benefit it receives, by allowing him for a limited time the sole right to exercise the art he has taught it. It secures to the man of genius a share of the benefits derived from his conquest in the world of art,—conquests made not for himself alone, but for all mankind.

In a long course of years many abuses had grown up, which recent legislation has removed. The prizes held out have been brought more within the reach of the poorer class of inventors.

One cannot but be sanguine in hoping that the community is likely to derive great benefit from the new objects and motives presented to the minds of our artisans. A sense of its tangible, intelligible advantages will urge them to the education of themselves and their children. They will feel and understand that he who brings to the performance of his work an informed mind and an observant spirit, who strives earnestly to study and comprehend the principles as well as the details of the operations which are his daily task, will assuredly be rewarded. The triumphs of Watt and Arkwright will teach them that there is no elevation to which the humblest man of genius may not aspire, if to activity and intelligence he joins prudence and good judgment. Let it not be urged that many fail;—a system of promotion is not bad because honours cannot fall to the lot of every meritorious soldier in our industrial army.

Great as has been the advance made in science and art within the present century, yet greater advancement of the moral and material interests of mankind may be looked for when the energies of a fresh and more numerous class of eminently practical thinkers shall have been fully developed and enlisted in the great cause of human progress.

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LAW OF PATENTS.

CHAPTER I.

THE NATURE OF LETTERS PATENT FOR AN INVENTION.

1. A MONOPOLY is defined to be 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 anything whereby any person or persons, bodies politic or corporate, are sought to be restrained of any freedom or liberty that they had before, or are hindered in their lawful trade.(*a*)

2. Statute 21 Jac. 1, cap. 3, sect. 1—6, declared grants of monopolies to be contrary to law, and enacted, that all monopolies for the sole buying selling, working, or using of anything should be void and of none effect, except "letters patent and grants of privilege for the term of fourteen years or under, for the sole working or making of any manner of new manufactures within this realm to the true and first inventer or inventors of such manufactures, which others at the time of making such letters patent and inventions shall not use; so that they be not contrary to law or mischievous to trade, by raising the price of commodities at home, or hurt of trade, or generally inconvenient."(*b*)

3. Monopolies are said to be against the policy of the law *and contrary to Magna Charta.(*c*) It is said, that "all trades, as well [*2] mechanical as otherwise, which prevent idleness, and exercise men and youth in labour for the maintenance of themselves and their families, and for the increase of their substance, to serve the queen when occasion shall require, are profitable to the commonwealth, and therefore any grant to have the sole right to exercise a trade is against the common law, and the benefit and liberty of the subject. Such a restriction is not only injurious to those who exercise the same trade, but to all other subjects, be-

(*a*) 3 Inst. 181. (*b*) See Appendix.

(*c*) See 2 Inst. pp. 47, 61; Mitchel v. Reynolds, 1 P. Williams, 181; Rot. Parl. 50 Ed. 3, Nu. 17, 28, 33; stat. 50 Ed. 3, cap. 2; stat. 9 Ed. 3, cap. 1; 2 R. 2, cap. 1; Davenant v. Hurdis, 2 Inst. 47; East India Company v. Sandys, 10 How. Stat. Trials, 371; 3 Inst. 181.

cause from want of competition the price of the commodity is kept high, and it is produced of inferior quality."(*d*)

The evils of monopolies were very strongly felt at the time of the passing of the statute.(*e*)

4. Independently of an express restriction by the sovereign authority in a state, there is no such thing as exclusive property in an invention. The subject-matters of human inquiry are free to all men. An addition once made to the stock of knowledge is common property for ever, nor is it less the property of the discoverer because others possess it as well as himself. It is in its nature infinite and incapable of appropriation. The first builder of a house could claim as his own the substantial and tangible materials, the logs and wood of which he constructed it; but the idea of such an erection became instantly the property of all mankind. The abstract natural right of the inventor is only to exercise his own invention freely.

In the case of the monopoly of an invention, it is the idea and principle of the invention that is appropriated, and not the mere formal expression of it, as in case of copyright.

5. At common law, all restraints of trade, where nothing more appears, are bad; but if the circumstances show that the restraint is upon fair consideration, it ought to be maintained.(*f*) [*3] *The statute of James, enacts that the grant shall be of such force as it would have been before the statute, and of none other. The invention must therefore be useful as well as new.(*g*)

6 An exclusive privilege can only be justifiable as a reward to him who adds to the general stock of knowledge, and a purchase of his invention. It is therefore a condition of such a grant that the grantee shall fully disclose his invention.

The practice of specifying seems first hinted at in Darcy v. Allen, as reported in Noy. It is said, that monopolies are lawful when any man, by his own charge or industry, or wit and 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, in such cases the king may grant to him a monopoly for some reasonable time, until the subjects may learn the same, in consideration of the good he does the commonwealth.(*h*) An Act of 1651, granting a patent for fourteen years, to one Buck, for melting iron by coal, contained a proviso, that Buck should take apprentices after seven years of the term, and teach them the knowledge of his new invention.

7. This object is now attained by the condition requiring the enrolment of a specification. The earliest patent into which this clause appears to have been introduced, was one granted the 1st of April, 11th Anne. Its introduction, was not on the authority of Parliament, but on that of the law officers of the Crown.(*i*)

(*d*) The case of monopolies, 11 Rep. 84; S. C. nom. Darcy v. Allin, Noy, 178.
(*e*) See Hansard, Feb. 19, 18 Jac. 1, 1192, 1200, 1205; Sir G. Mompesson's case, 2 State Trials, 111; Sir H. Yelverton's case, ib. 1143.
(*f*) Mitchell v. Reynolds, 1 P. Williams, 181. (*g*) 3 Inst. 184.
(*h*) Darcy v. Allin, Noy, Rep. 178. (*i*) Webst. P. C. 8.

8. The king cannot grant or take but by matter of record.(*k*) No grant of the king is available or pleadable except it be under the great seal.(*l*)

9. At common law, the letters patent must have been enrolled, otherwise they are void. They could not have been vacated except by matter of record; thus, it is said, that if a man surrender his patent, and it be cancelled, and a *note of it indorsed, and afterwards the surrender enrolled, the patent shall be vacated. After the vacatur is entered on the roll, a constat of the patent shall not be granted. But a surrender and cancelling with an indorsement on it is not sufficient if the surrender be not enrolled.(*m*) If a deed be delivered to be enrolled it is sufficient, though it be not enrolled, but put into a chest, for it may be enrolled at any time.(*n*) [*4]

10. Letters patent granted under the provisions of stat. 15 & 16 Vict. c. 83, will not require enrolment.(*o*)

11. If a patent be granted in respect of a new invention, the king cannot grant a second patent, for the charter is granted as an encouragement to invention and industry, and secure the patentee in the profits for a reasonable time; but when that is expired, the public is to have the benefit of the discovery. If a second patent is granted to a stranger, the first patentee shall have a scire facias to repeal the second patent.(*p*)

12. The construction of the patent is for the court. It appears that the construction of the granting part of the patent must depend on different principles from that by which the construction of the specification is to be governed. It is laid down that the king's letters patent are records of a high nature; they have in all times been construed most favourably for the king, contrary to the grants of common persons, which are construed in favour of the grantee, and most strongly against the grantor. If they can be taken to enure to a double intent, they shall be taken to the intent that makes most to the king's benefit.(*q*)

13. The grant shall be construed strictly. But where it is capable of two constructions, by the one of which it will be valid, and by the other void, that construction shall be put on it which shall make it valid, for that will be more for the benefit of the subject and the honour of the king, which ought to be more regarded than his profit, for it was not the king's intent to make a void grant.(*r*) [*5]

A bad grant is void not against the Crown merely, but in a suit between the patentee and a third person. A patent for two or more inventions, when one is not new, is void altogether. The statute invalidates a patent for want of novelty, and consequently, by force of the statute,

(*k*) Com. Dig. Patent, A. Viner's Ab. Prerogative, M. *b.* 7; Lane's case, 2 Rep. 16 *b.*

(*l*) Com. Dig. Patent, C. 2 Viner's Abridgment, Prerogative, C. *b.*

(*m*) Com. Dig. Patent, G. Dyer, 167, 195 *a.*

(*n*) Com. Dig. Patent, E. Viner's Abridgment, Prerogative, A. *d.* Abraham v. Wilcocks.

(*o*) Stat. 15 & 16 Vict. c. 83, s. 27.

(*p*) Bacon's Abridgment, Prerogative, F. 4, citing Lucas, 131.

(*q*) Bacon's Abridgment, Prerogative, F. pt. Com. Dig. Grant, G. 12.

(*r*) Case of The Churchwardens of St. Saviours in Southwark, 10 Rep. 67; Bewley's case, 9 Rep. 131 *a.*

the patent is void so far as relates to that which is old. But further, 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 is maintainable upon it.(*s*) If any part, being a material part of the alleged invention, fail, the discovery in its entirety forming one entire consideration, the patent is altogether void.(*t*)

14. Grants of letters patent are intended for the public weal; and if it appears that that the Crown has been deceived by the party obtaining the grant, the grant will be void.(*u*) The consideration, or motive, expressed on the face of a grant will often be sufficient to determine its validity or invalidity. It is laid down, that if the king grant a greater estate than he can lawfully do, as if the king seized in tail or for life grant in fee, it will be void for the whole, for the king was deceived.(*x*)

15. A false recital in a thing not material will not vitiate the grant, if the king's intention is manifest and apparent.

If the king is not deceived in his grant by the false suggestion of the party, but from his own mistake upon the surmise and information of the party, it shall not vitiate the grant.

[*6] Thus, where an invention was new, and useful on the *whole, but not useful in some cases, a patent for it was held good. The Court, in Morgan v. Seaward, said that they did not mean to intimate any doubt as to the validity of a patent for an entire machine or subject, which if taken altogether, is useful though some parts of it might be useless, where there is no false suggestion.(*y*)

In future no warrant will be granted for the sealing of any letters patent which contain two or more distinct sustantive inventions.(*z*) This rule seems not to apply to the case where one invention is applicable to the improvement of several manufactures, or where several inventions conduce to the same common purpose or object, and are applicable to the improvement of the same manufacture.

(*s*) Morgan v. Seaward, 2 M. & W. 544; ib. 562, Parke, B. citing Travell v. Carteret; 3 Lev. 135; 1 Rep. 53, case of Alton Woods; 2 Rep. 54, Cholmeley's case; 5 Rep. 94 *a*, Barwick's case; Alcock v. Cooke, 5 Bing. 346; Hill v. Thompson, 8 Taunt. 375; Brunton v. Hawkes, 4 B. & Ald. 542.

(*t*) Hill v. Thompson, 8 Taunt. 375.

(*u*) Case of monopolies, Darcy v. Allin, 11 Rep. 86; Noy, 178, S. C.; Webst. P. C. 1, 5.

(*x*) Com. Dig. Grant, G. 8, citing 1 Rep. 44 *a*, the case of Alton Woods.

(*y*) Rex v. Mussary, Bull. N. P. 76, *a*; Haworth v. Hardcastle, 1 B. N. C. 189; Morgan v. Seaward, 2 M. & W. 544.

(*z*) Second set of Rules, 1852.

*CHAPTER II. [*7]

THE SUBJECT-MATTER.

A Manufacture.

1. THE Crown has no power to grant letters patent for the sole buying, selling, making, working, or using of anything, except for the sole making or working of any new manufacture within this realm.

Writers upon patent law have felt considerable difficulty in classifying the inventions in respect of which letters patent may be obtained, not so much on account of the difficulty of defining the principles which determine what is and what is not a patentable subject, as because most inventions are capable of being ranged under several of such classes.

Any positive definable change in a manufacture, producing a new and definable result, and being an improvement, seems to be patentable. (See Webster's Subject-matter, pp. 24, 29.)

2. According to the best authorities, the manufacture spoken of in the statute may be either a mode of manufacturing, or a vendible substance produced, as distinguished from a mere principle or the use or disposition of anything, without reference to any product resulting from such use.(*a*)

3. Under the head of new vendible substances may be classed all new compositions of things produced, such as new manufactures in the ordinary sense of the term; secondly, all mechanical inventions made to produce old effects. A new piece of mechanism is a thing made.(*b*) A patent for a method of doing a thing is generally a patent for the thing *produced. Thus, a method of lessening the consumption of [*8] steam and fuel in fire-engines, by means set forth in the specification, is an invention of fire-engines of a newly-invented construction. Patents for chemical processes may be patents for the vendible substance produced.(*c*)

4. Under modes of manufacturing may be classed any process or practical manner of doing a thing, any new method of working, any artificial manner of operating with the hand or known machinery, or by new processes, in any art, producing effects already known, but at less expense, or otherwise with advantage.(*d*)

Passing lace between a surface of gas and a narrow chimney, which draws the flame through the lace, so as to burn and destroy the minute fibres in the interstices of the fabric, is a good subject of a patent, though the flame of charcoal and other substances had previously been

(*a*) Per Eyre, C. J., 2 H. Black. 492; L. J. C. Hope, The Household Company v. Neilson, Webst. Pat. Ca. 683.

(*b*) 2 H. Black. 492, Boulton v. Bull.

(*c*) Per Heath, J., 2 H. Black. 482, Boulton v. Bull.

(*d*) Crane v. Price, Webst. P. C. 409, Tindal; Rex v. Wheeler, 2 B. & Ald. 349, Abbott, C. J. Per Eyre, C. J., 2 H. Black. 492, 494.

used to singe the fibres from silk, cotton, or lace goods placed on a board, the flame being driven against them by bellows.(*e*)

In Daniell's patent for improvements in dressing cloth, after the surface of a piece of cloth had been properly dressed, and the nap on the surface laid even and smooth, the piece was rolled up very smoothly and evenly in a close and compact roll, which being immersed in hot water, the fibres of the wool became softened, and acquired a tendency to retain the same direction, and thus the effect of the dressing was rendered permanent.(*f*)

5. It generally happens that the result of the new mode of manufacturing is a better, or at any rate a different article from that before produced. As in Crane's patent, a better iron was the result of the new combination. So that the invention was the subject-matter of a patent, as being either of a better article or of a new combination.

6. A patent cannot be obtained for an abstract philosophical principle. The statement of what a principle is proves it not to be the subject-matter of a patent. It is the first ground and rule of arts and sciences. A patent must be for some *new production from such [*9] elements, and not for the elements themselves.(*g*) Without the application of the principle to a practical object and end, without the application of it to human industry or to the purposes of human enjoyment, a person cannot appropriate a principle to himself. Something of a corporeal or substantial nature, something that can be made by man from the matters subjected to his art, or, at the least some new mode of employing practically his art and skill, is requisite to satisfy the word manufacture.(*h*)

It is impossible to support a patent for a mere method, without having carried it into effect, or produced some substance.(*i*) In Neilson's case, Alderson, B. said that the difficulty which pressed upon his mind was, that Neilson had taken out a patent in substance like Watt's, for a principle,—the application of hot air to furnaces; but he thought he had not practically described any mode of carrying it into effect. The principle must be embodied in some practical mode, and the patent is taken out not for the principle, but for the mode of carrying the principle into effect.(*k*) In an American case, the plaintiff claimed "to cut ice of a uniform size by means of an apparatus worked by any other power than human. The invention of the art, as well as the particular method of the application of the principle, are claimed by the subscriber." The Judge said the patentee claimed a title to the art of cutting ice by means of any power other than human power. Such a claim is not maintainable in point of law. It is a claim for an art or principle in the abstract, and not for any particular method or machinery by which ice is to be cut. No man can have a sole right to cut ice by all means or methods,

(*e*) Hall v. Jarvis and Boot, Webst. P. C. 97.
(*f*) Daniell's patent. Godson on Patents, 274.
(*g*) The Househill Company v. Neilson, L. J. C. Hope, Webst. P. C. 683; 2 H. Black. 487, Boulton and Watt v. Bull, per Buller, J.
(*h*) Rex v. Wheeler, 2 B. & Ald. 350, Abbott, C. J.
(*i*) Per Heath and Buller, JJ. Boulton v. Bull, 2 H. Black. 468, 486.
(*k*) Neilson v. Harford, Webst. P. C. 342; Jupe v. Pratt, Webst. P. C. 144.

or by all or any sort of apparatus, though he is not inventor of any or of all such means, methods, or apparatus.(*l*)

7. The mere use or effect of the employment of a known *thing, not having reference to trade and manufacture, is not sufficient, as if the effect be merely negative, or where no product is the result.(*m*) [*10]

8. If a man of science devises the means of making a new use of a think known before, he cannot have a patent for that. Buller, J. said, "Supposing an ingenious physician should find out that Dr. James's fever-powder was a specific cure for consumptions if given in particular quantities, could he have a patent for the sole use of James's powder in consumptions or given in particular quantities? I think it must be conceded that such a patent would be void. Yet the use of the medicine would be new, and the effect of it as materially different from what is now known, as life is from death. Could a patent be supported for the sole use of arsenic in curing agues? The medicine is the manufacture, and the only object of a patent, and as the medicine is not new, a patent for it, or for the use of it, would be void."(*n*)

9. The arrangement of merchandise in a particular form is not the subject of a patent. There must be a manufacture, a production of something, or a development of some new property by the operation of the invention.

In an American case, a contrivance for folding thread and floss cotton in a wrapper, in which form the goods sold more quickly and for a better price, the cotton itself undergoing no change, has been held not to be the subject of a patent.(*o*) A device similar in principle, a mode of packing lace in boxes, has been registered here under the Useful Designs Act.(*p*)

10. The external form or shape of an article manufactured is not the subject-matter of a patent where the use of such form does not involve the application of a principle, and a real and essential improvement of the manufacture.(*q*) But a paving-block bevilled both inwards and outwards on the same side of the block, so that the blocks as laid would *mutually support each other, is a good subject-matter of a patent.(*r*) [*11]

11. A patent will be good though the subject of the patent consists in the discovery of a great general and most comprehensive principle in science, a law of nature, if that principle is by the specification applied to any special purpose, so as thereby to produce a practical result not previously attained, however extensive in the resulting claim.(*s*)

(*l*) Wyeth v. Stone, 1 Story's Rep. 273, 285, cited Curtis on Patents, 64.
(*m*) Per Eyre, C. J., 2 H. Black. 494.
(*n*) Per Buller, J., Boulton and Watt v. Bull, 2 H. Black. 486.
(*o*) Langdon v. De Groot, 1 Paine, C. C. R. 203, cited Curtis on Patents, 18 n.; Kemper's case, stowing ice, Curtis Pat. 500.
(*p*) Webb v. Hughes, see Mechanics' Magazine, vol. xlvi. 383.
(*q*) See the argument of Mr. Leach, Walker v. Congreve, Godson on Patents, 56.
(*r*) McNamara v. Hulse, 1 Car. & Mar. 471; per Bayley, J., Brunton v. Hawkes, 4 B. & A. 553.
(*s*) Neilson v. The Househill Company, L. J. C. Hope, Webst. P. C. 683.

Neilson's invention of the hot blast for forges and smelting-furnaces, consisted in heating the air to a red heat, or nearly so, between the blowing apparatus and the furnace in a close vessel, by the application of heat outside the vessel, so as to prevent any loss of oxygen. It was said, if a specific shape of heating-vessel was claimed, then the patent might be good, but if every shape was claimed, then it was a claim of a principle; and that there was no difference between claiming a principle to be carried into effect in any way whatever, and claiming the principle itself. But the Court thought that the patentee did not merely claim a principle, but a machine embodying a principle.(*t*) A principle reduced into practice can only mean a practice founded on principle, and that practice is the thing done or made; in other words, the manufacture which is invented. Watt's patent recited that he had invented a method of lessening the consumption of steam and fuel in fire-engines. By his specification he described the principles of the method, and the method by which these principles were to be carried into effect. The method was founded on the principle of keeping the steam-vessel the whole time the engine was at work as hot as the steam that entered it: this was done by a case of wood, or some other material that transmits heat slowly, and by surrounding it with steam or other heated bodies. Secoundly, he pointed out a mode of condensing the steam apart from the cylinders, in condensers which were to be kept cold. Thirdly, the vapour not condensed by the cold of the condenser was to be drawn out.

[*12] *It was objected, that the patent was for principles; but the jury having found that the directions given were sufficient to enable workmen to carry the invention into practice, the Court of King's Bench determined that the patent was not for principles only, as the specification showed the manufacture by which those principles were to take effect.(*u*) The Court of Common Pleas had previously been equally divided in opinion as to the valididy of the patent.(*x*)

The invention of the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counterbalance to the pressure against the back of the chair, by means described, is not a claim to the principle of the lever, but an application of the principle to a certain purpose by certain means, for which a patent may be had.(*y*)

It would seem that the proper mode of raising the question whether a patent is void for being for a principle, is to plead that the patent is not for a manufacture within the meaning of the statute.(*z*)

(*t*) Neilson v. Harford, Webst. P. C. 342 ; S. C. 8 M. & W. 806.
(*u*) Hornblower v. Boulton, 8 T. R. 95; see the judgments of Grose and Lawrence, JJ.
(*x*) Boulton and Watt v. Bull, 2 H. Black. 496.
(*y*) Minter v. Wells, 1 C. M. & R. 505; Webst. P. C. 134, S. C.
(*z*) See a form of plea. Nickels v. Ross, 8 C. B. 686; see Spilsbury v. Clough, 2 Q. B. 466; S. C. Webst. P. C. 255; see forms of suggestion in sci. fa. Reg v. Cutler, 3 Car. & Kir. 215.

*CHAPTER III. [*13]

THE MANUFACTURE MUST BE NEW, THAT IS, DISTINCT FROM EXISTING AND KNOWN MANUFACTURES.

THE manufacture must be new, that is, the knowledge and right of using it not public property. It must differ specifically, and not merely in accidental circumstances, from existing and known manufactures.

1. A patent cannot be had for applying an old contrivance to a new object, as scissors to cut silk. The questions are, whether the new purpose is perfectly analogous to that to which the old contrivance had been applied, and whether its capability of adaptation to such new purpose, without the necessity of modification, is obvious or not? The application of a wheel previously invented for carriages running on common roads, to railroad carriages, is not a good subject-matter of a patent.(*a*) So the application of a nipping lever which was an old mechanical contrivance to a new purpose, was held not to be the subject of a patent, unless the means by which it was applied were new and essential.(*b*) A patent was taken out for improved machinery for spinning flax; the improvement in spinning-machinery consisted merely in placing the drawing-rollers nearer to the retaining-rollers than they had before been placed in flax-spinning; namely within two inches and a half. It appeared that in spinning cotton they had been placed at distances varying from seven-eights of an inch to an inch and a quarter, in flax-spinning from fourteen to thirty-six inches, and in worsted-spinning from four to fourteen inches. The patent was held bad, as being *merely for the application of [*14] a piece of machinery already known.(c)

2. A mode of uniting the shank to the flukes of anchors had been in use for adze anchors and mushroom anchors, which were used in mooring vessels. A patent was taken out for uniting the parts of ships' anchors in the same way. The Court thought that if the union of the parts had been effected in a manner unknown before, as applied in any degree to similar purposes, it would have been a good ground for a patent, but not where the object gained, namely the avoidance of welding, had been well known and practised before in similar cases.(*d*)

3. The value of the result is more important than the amount of invention or the skill of the discoverer.(*e*) The method of making water-tabbies was discovered by mere accident. Watt stated that his discovery of parallel motion was not the result of any experiment, but was conceived by him at once as a complete invention, and that he felt the same

(*a*) Losh v. Hague, Webst. Pat. Ca. 208, Lord Abinger.

(*b*) Pow v. Taunton, 9 Jurist, 1056, Q. B.; see Reg. v. Cutler, 3 Car. & Kir. 230; Cochrane v. Waterman, Crouch, J. Curtis on Patents, 541.

(c) Kay v. Marshall, 5 Bing. N. C. 492; 1 Beav. 535; 8 Clark & Finn. 245.

(*d*) Brunton v. Hawkes, 4 B. & Ald. 541; Saunders v. Aston, 3 B. & Ald. 881; Hotchkiss v. Greenwood, 11 Howard, S. C. R. 266.

(*e*) Crane v. Price, Webst. P. C. 411, Tindal, C. J.; Liardet v. Johnson, Bull. N. P. 76, Lord Mansfield; Carpmael on Patents, 65.

sort of surprise and pleasure in contemplating it, that a man might feel in having brought to his notice an ingenious invention of another person. The simplicity of an invention so far from being an objection to it, may constitute its great excellence and value.

4. When a material is once known, it may be applied in any manner. Therefore tubes coated with brass being known, and tubes welded by a mandrel and die being known, a patent for their use as the tubular flues of a boiler is not good.(*f*)

The application of bone hafts and lattin plates for the handles of knives has been held not to be a good subject-matter of a patent.(*g*)

5. But where the application involves a new discovery of a property the in thing applied, or a new result is attained, a patent may be good; thus, though the adaptation of caoutchouc as a fillet for cards was a very simple matter, *yet as it was a substance whose properties and [*15] fitness for that purpose had never been known before, the adaptation was held to be a good subject-matter of a patent.(*h*)

Vaucher had invented a new method of packing parts of hydraulic machines and steam-engines, so as to render them fluid-tight, by the use of soft metal instead of elastic substances. After the date of this patent, it was discovered that by the use of soft metal in parts of machines subject to friction occasioned by pressure and rapid motion, the friction and evolution of heat were greatly diminished. A patent was obtained for the lining with soft metal of those parts of machines subject to pressure while in rapid motion, and a mode of keeping the soft metal in its place. It was held that it was a new principle embodied in a new machine.(*i*)

6. It is sufficient if the application of the old contrivance involve any new invention. Where, at the time of the patent, it is not actually known amongst scientific men or otherwise whether or not the old contrivance is applicable to the new purpose, a patent for the application may be had. Thus, the use of duplicate apparatus for transmitting signals by the electric telegraph, at the intermediate stations was held to be a good subject of a patent; for though it was highly probable, *à priori*, that a circuit having distant coils and apparatus for giving signals might be applied at the intermediate stations, it was a matter of experiment whether it could be carried out in practice, and the invention, though a simple one, was therefore considered sufficient to entitle the discoverer to a patent.(*k*)

7. So if such application is any new combination, or new or improved mode of operation, chemical or otherwise, a patent may be sustained.

Before the date of a patent, part of the garancine had been obtained from madder by boiling, and the refuse or spent madder had been thrown away as useless. It was known that the spent madder contained garancine, but no one had extracted it from the spent madder. The whole of the garancine had, however, been obtained from fresh madder by a

(*f*) Reg. v. Cutler, 3 Car. & Kir. 215.
(*g*) Matthey's patent, Noy. 178.
(*h*) Walton v. Potter Coltman, J. 3 M. & G. 438.
(*i*) Newton v. Vaucher, 6 Exch. Rep. 859.
(*k*) The Electric Telegraph Company v. Brett and Little, 20 L. J. N. S. C. P. 123.

*certain process. A patent having been granted for extracting the garancine from spent madder by this process, it was held by Pollock, C. B., at Nisi Prius, not to be a new manufacture.(*l*) But the Court of Exchequer Chamber held that it was a question for the jury. Spent madder might be a very different thing from fresh madder in its properties, chemical or otherwise, or it might be in effect the same thing, with this difference only, that part of its colouring matter had been already extracted. Again, the properties chemical and otherwise of both, might or might not have been known to chemists and other scientific persons. Whether fresh madder and spent madder are different things, or substantially the same things, were matters of fact, and material to affect the validity or invalidity of the patent.(*m*) [*16]

8. So if any properties or valuable qualities of the substances employed not known before, are developed by the application, or a new or cheaper manufacture is the result.

Crane's patent was for the application of anthracite as combined with the hot-air blast in the smelting of iron.

Neilson's patent was for the hot blast in general terms. It was urged that Crane had done nothing but apply Neilson's patent to known articles by known means, and to effect a known object. Except in a small experimental furnace, iron had never been smelted by the use of anthracite, and not profitably in that, and the attempt to use it had been abandoned. It was not obvious that anthracite could be used beneficially with the hot blast. It was not obvious that the iron would be better from the use of the hot blast in conjunction with anthracite. It was proved that the yield of iron was greater, the quality better, and the expense of producing it less. Taking the use of the hot-air blast and of anthracite to be known, the Court thought that a patent for their combination was good; the result of the combination being the production of a better article, and a cheaper article, and the combination being new.(*n*)

9. It is no objection to patents for mechanical or chemical discoveries, that the articles of which they are composed were *known, and were in use before, provided the compound article which is the object of the invention is new.(*o*) [*17]

10. It is sufficient if the invention is a new combination of materials previously in use for the same purpose, as of new proportions of the materials used for charging blast-furnaces.

If the result produced is a new article, a better article, or a cheaper article to the public than that produced before, it may well become the subject of a patent.(*p*)

11. A patent for a new mode of arranging old materials may be good, if the result is a new article, as a plush surface produced by employing

(*l*) Steiner v. Heald, 2 Car. & K. 1022.
(*m*) Steiner v. Heald, 6 Exch. 607; S. C. 20 L. J, N. S. Exch. 410.
(*n*) Crane v. Price, Webst. P. C. 377, 409.
(*o*) Boulton and Watt v. Bull, 2 H. Black. 487, per Buller J.
(*p*) Hill v. Thompson, Webst. P. C. 237; 3 Mer. 626, S. C.; Lukie v. Robson, 2 Jurist, 201; Macintosh v. Everington, Webst. Dig. 121.

as weft cut stripes of silk folded, and with the cut edges brought together.(q)

Elastic and non-elastic threads were combined in weaving cloth by placing them alternately side by side in the warp, while the elastic threads were in a state of tension, and deprived of their elasticity, which was subsequently restored by another process. The cloth made was elastic, but such elasticity was limited by the length of the non-elastic threads. The manufacture was held to be the subject of a patent, though the separate materials had been used before.(r)

But where a button and a flexible shank were both old, the putting them together was held not a new manufacture, because the mode of uniting the two was known and obvious, and no result followed from the combination, except what was known and obvious to anybody without experiment.(s)

12. Where the invention is a mere process, any change in the order of the process may constitute a new manufacture. Soap and water were known in the process of felting as a substitute for the use of acidulated water. Rollers were also in use. The application of soap and water in the felting process combined with a set of rollers was held a good subject for a patent, a sufficient novelty in combination.(t)

Waterproof fabrics pervious to air were made by immersing cloths in a solution of alum and soap, but the waterproof surface wore off. The [*18] plaintiff's invention consisted in *immersing the fabric in a solution of alum with some carbonate of lime, and then in a solution of soap. The effect is, that by the first immersion every fibre becomes impregnated with the alum, the sulphuric acid of the alum being neutralized by the carbonate of lime. By the second immersion, the oily quality rendering it repellent of water is given to every fibre, so that each fibre is rendered waterproof.(u)

13. The combination of two known processes may be a good subject-matter, if the result is new.

The shearing of cloth from list to list was known, and the shearing it from end to end by means of rotary cutters was also known. A person constructed a machine by which cloth was shorn from list to list by rotary cutters. This was held to be a new invention, entitling the inventor to obtain a patent for it; the two things not having been combined before, and the combination having been found useful.(x)

14. If the invention, or that which is substantially the same thing, be already in use, or known, a patent for it cannot be supported. In a case before the statute, of a patent for frisadoes, very like baize previously manufactured, the Court refused to restrain people from making baize similar to Hastings's frisadoes.(y)

(q) Templeton v. Macfarlane, 1 H. L. C. 604.
(r) Cornish v. Keene, 3 Bing. N. C. 586; Webst. P. C. 516.
(s) Saunders v. Aston, 3 B. & Ald. 881.
(t) Allen v. Rawson, 1 C. B. 574.
(u) Helliwell v. Dearman, Webst. P. C. 401 n.
(x) Lewis v. Davis, 3 C. & P. 502; Webst. P. C. 488; see Report on Patents, 1829, 111.
(y) Hastings's case, cited Darcy v. Allin, Noy's Rep. 182; Humphrey's Patent, ib.

Fussell's patent for dressing woollen cloths by relaxing the fibres by steam was held bad, Daniell having previously done the same thing by hot water.(*z*) Lister's patent for heating wool in spinning by steam within hollow rollers was held bad, Hadden having previously done the same thing by iron heaters.(*a*)

15. In determining whether two modes of working are substantially distinct, the principles and effects of their operation must be looked to. The substitution of a tube for a ring or circle of metal for the purpose of compressing and keeping compressed the yarns in the strands of ropes, during the *process of manufacturing rope, is a distinct substantive invention, because it keeps the strands in a degree of confinement for a greater time, and obtains the end of keeping each yarn in its situation with more certainty.(*b*) [*19]

A method of manufacturing iron tubes for gas-pipes and other similar purposes, consisted in drawing them through fixed dies, omitting the use of a mandrel, previously employed. This was held a good subject-matter of a patent, the result being that the tubes could be manufactured of much greater length and of better quality.(*c*)

The principle of the above invention was the welding iron pipes by circumferential pressure, and without a mandrel or any internal support, by drawing a narrow sheet of iron, bent into a cylindrical form, and heated to a welding heat, through a fixed die, in which the edges of the cylindrical tube were pinched or pressed together and welded. This was held to be a good subject for a patent, though such pipes had previously been welded by placing them in a semicylindrical recess in an anvil, and beating them together by a succession of blows, by means of a tilt-hammer, having a similar recess. The Court thought that the principle of the two inventions was not the same, for the tilt-hammer did not operate by continuous equal circumferential pressure, as fixed dies did, but by the repetition of violent contact of short duration.(*d*)

16. The simplification of existing machinery may be a good subject-matter for a patent. Minter's patent was for a self-adjusting leverage applied to the back of a chair. The Court said, if the principle might have been deduced from the machinery of an old chair, but it was so complicated and connected with other machinery that nobody did make that discovery, or ever find out that he could have a chair with a self-adjusting leverage, the discovery by the plaintiff, that, throwing aside everything but the self-adjusting leverage itself, a beneficial effect will be produced, is a new invention.(*e*)

17. An addition to or improvement of an existing machine *is a good subject of a patent.(*f*) In Morris v. Branson, the patent [*20]

(*z*) Rex v. Fussell, Godson on Patents, 275; S. C. Rep. 1829, 211.
(*a*) Rex v. Lister, Rep. 1829, 211; see Rex v. Hadden, ib.; Barton v. Hall, ib.; Rex v. Lodge, ib. 208.
(*b*) Huddart v. Grimshaw, Webst. P. C. 85, 95.
(*c*) Russell v. Cowley, 1 C. M. & R. 871; Webst. P. C. 468.
(*d*) 14 M. & W. 579, Russell v. Ledsam.
(*e*) Minter v. Mower, Webst. P. C. 140.
(*f*) Boulton and Watt v. Bull, 2 H. Black. 463; Hornblower v. Boulton, 8 T. R. 99.

was for making oilet-holes or net-work in silk, cotton, thread, or worsted; and it was held good.(*g*) A patent may be good for an improvement on an invention protected by existing letters patent. The new patent, after the expiration of the old one, will be free from every objection; and while the old one exists, can be legally used by persons having licenses from the prior patentee.(*h*) In Arkwright's case it was said, many parts of a machine may have been known before, yet, if there be anything material and new which is an improvement in the trade, it will be sufficient to sustain a patent; whether it must be for the new addition only, or for the whole machine, is another question.(*i*)

18. The patent for an improvement will be bad if it does not distinguish the new part from the old, or lays claim to that which has been invented before.(*k*) Thus, Jessop's patent for a watch, because the claim extended to the whole watch, and the invention was of a particular movement only.(*l*)

19. The specification must distinctly show that the patent is for the improvement only. The public have a right to purchase the improvement only, without being cumbered with other things.(*m*) A patent for a new manufacture of lace was generally, for a new invention of mixing silk and cotton thread upon the frame. It was shown that silk and cotton had been used together prior to the patent. The patentee offered to prove that the former method was imperfect, and that he alone had succeeded in combining strength with fineness: the patent was held bad, as claiming the exclusive liberty of combining silk and cotton thread.(*n*) A [*21] patent for "an improved method of making sail-cloth without *any starch whatever," as explained by the specification, claimed the exclusion of starch. The invention, if any, consisted in a new mode of weaving the cloth: the patent was held void, as claiming what was old.(*o*)

20. It was formerly said that a patent cannot be had for an entire machine, where that which is newly invented is only a part of it; if the substance was in use before, and a new addition is made thereto, though that addition make the former more profitable, yet it is not a new manufacture in law.(*p*) In Bircot's case, an improvement in the mode of preparing and smelting lead was compared to putting a new button on an old coat. At the present day, if the novelty or addition consists in something not material to the useful effect, a patent cannot be had.(*q*) In Arkwright's case, the question was, did the stripe on the filleted cylinder make a material alteration? for it appeared to do without stripes as

(*g*) Morris v. Branson, cited 2 H. Black. 489.
(*h*) Harmar v. Playne, 11 East, 101; Crane v. Price, Webst. P. C. 412; Ex parte Fox, 1 Vesey & B. 67.
(*i*) Rex v. Arkwright, Webst. P. C. 71, Buller, J.
(*k*) Minter v. Mower, 6 A. & E. 735; S. C. Webst. P. C. 142.
(*l*) Jessop's case, 2 H. Black. 476, 489.
(*m*) Hill v. Thompson, 8 Taunt. 398; Webst. P. C. 247; per Buller, J.; 2 H. Black. 489.
(*n*) Rex v. Else, 11 East, 109 n.
(*o*) Campion v. Benyon, 3 Brod. & Bing. 6.
(*p*) 3 Inst. 184, citing Bircot's case, in the Exch. Chamb. Easter, 15 Eliz.
(*q*) Dobbs v. Penn, 3 Exch. 427, 434; Rex v. Arkwright, Webst. P. C. 72.

well as with them. If so, even if the stripes were not used before, that was not such an alteration as would support a patent.

21. But a very large class of inventions in modern times consist of some new modification of existing machinery. If the machine is a perfectly new combination of parts from the beginning, though all the parts may have been used before, a patent for the entire machine will be good.(*r*) In considering whether the invention is new, the proper mode is to take the specification altogether, and see whether the matter claimed as a whole is new.

In the case of an invention of the lining of boxes for the axles of railway-cars and locomotive engines, with an alloy of tin, having certain provisions, partly mechanical, as by fillets, and partly chemical, as by tinning the inside of the boxes, for keeping the lining in its place, the jury must take the whole of that for which the patent was granted, the form of the interior of the axle-boxes, the coating with tin, and the soft metal lining, and say whether the *invention is new.(*s*) The question of novelty depends on whether the whole taken together [*22] is new, though it may in part consist of old parts, provided the patentee does not claim the old parts, but only the combination of them and the new.

22. If the machinery by which the principle is carried out is different, there may be several patents for distinct modes of carrying out the same principle. . An invention of improvements in making sugar, consisted in forcing hot or cold air, by means of bellows or other blowing apparatus, through a large pipe at the upper part of the vessel, communicating with a series of tubes descending through the liquid to be evaporated, equally distributed through the vessel, and having their mouths exactly on a level and parallel with the surface of the liquid. By this means, air, in a highly divided state, was forced in small streams equally through every part of the liquid. This was held a good subject of a patent as an improved apparatus, though such liquids had, under a former patent, been evaporated by means of air forced through a coil of pipes, or a shallow cullander placed at the bottom of the vessel. Probably the apparatus could not have been used without a license from the prior patentee.(*t*)

23. A patent may be had for a mode of manufacturing an article, which is known in this country as an imported article, if the mode of manufacture is not known here; but, in that case, the specification must claim the mode of manufacturing, and not the manufactured article.(*u*)

(*r*) Bovill v. Moore, 2 Marsh. 211, Gibbs, C. J.
(*s*) Newton v. Grand Junction Railway Company, 5 Exch. 331, Jan. 20, 1846.
(*t*) Hullett v. Hague, 2 B. & Ad. 370.
(*u*) See the Smalt and Glass Patents, Webst. Pat. Ca. 8, 27 n.; Hancock v. Somervell, Newton's London Journal, vol. 39, p. 158.

[*23] *CHAPTER IV.

THE UTILITY OF THE INVENTION.

1. We have seen that utility is a condition of a right to a patent for an invention at Common Law.(a) If the invention is useless, the patent is void, as obtained upon a false suggestion, which is either express, as where the patent is granted for the improvements which turn out not to be so;(b) or implied, as where no recital that the invention is an improvement appears on the face of the patent; but the grant is void, because it cannot enure according to the intent of the Crown, and the Crown is decided in the law.(c)

2. If the invention is useless, not only is there no consideration for the restraint of trade, but the monopoly is mischievous, inasmuch as it prevents other people from adding to the invention, so as to make it useful.

3. If a man puts several inventions into one patent, one of which is not useful, he loses the benefit of his patent(d) till the Attorney-General allows him to disclaim that part, and gives him the protection of the patent for the rest. It is essential that a process should in all its parts be successful; the patentee undertakes to guarantee to the community the use of all that he claims as his invention.

The invention must be useful for all the purposes suggested in the specification. If a patent is taken out for an improvement in the manufacture [*24] of elastic cloth for bandages, and *such articles of dress as the same may be applicable to, it is not enough to show that it is an improvement in surgical bandages.(e)

4. It is not necessary that the utility should be great, it is sufficient if the invention is an improvement at all. If it is of a different construction from former articles of the same kind, and of any use, that is sufficient. If a new description of steam-engine could be used where other engines would not answer, that would be sufficient; it need not be likely to come into general use.(f) It will not avoid the patent because some cases may occur in which the invention may not be useful, if it is found to be useful on the whole.(g) It is a question for the jury, whether the improvement is something trifling and insignificant, or whether it was worth a patent.(h) In the case of Watt's patent, it was said, that in order to make the patent good, the method must be capable of lessening the consumption of steam to such a degree as to make the invention useful. A patent for an invention which enacts its purpose of utility will not be

(a) See 3 Inst. 184; Edgeberry v. Stephens, 2 Salk. 447; ante, p. 2; Rex v. Arkwright, Webst. P. C. 72; S. C. Dav. Pat. Ca. 129, Buller, J.
(b) Morgan v. Seaward, Webst. P. C. 197; 2 M. & W. 544; Manton v. Parker, Dav. Pat. Ca. 327.
(c) See case of Alton Woods, 1 Co. Rep. 53.
(d) Morgan v. Seward, Webst. Pat. Ca. 188; 2 M. & W. 562.
(e) Cornish v. Keene, N. P. Tindal, C. J. Webst. P. C. 506.
(f) Alderson B. Morgan v. Seaward, at Nisi Prius, Webst. P. C. 186.
(g) Haworth v. Hardcastle, 1 Bing. N. C. 182; S. C. Webst. Pat. Ca. 480.
(h) Losh v. Hague, Webst. P. C. 205; Boulton and Watt v. Bull, 2 H. Black. 498.

void because, from the want of improvements afterwards made, it has a tendency to destroy the apparatus by which it is applied.(*i*)

5. The questions of utility were thus stated by Lord Brougham in argument. An invention may fail in two ways: a man may describe a machine, and say it does so much; if, when it comes into actual practice, it fails to produce that result, there is an end of the patent. It may fail in another way. It may produce a movement; but a movement, like gold may be bought too dear. It may be of no advantage whatever when it comes to be used. It may be such, that though possibly the effect may be produced which the inventor pretends to produce by it, yet it may be produced at such cost, with such loss of time and interruption of business, and other inconveniences, not taken into account when he originally stated it to be a new and valuable invention, that *these are not sufficiently counterbalanced by the actual good resulting from it; and [*25] if, upon the trial, it is found that the old way is better, with all its disadvantages, then the patent fails, because the invention is not useful.(*k*)

6. A patent for an entire complicated machine, which is useful, will not be avoided by proof that one of the parts of it has been discovered to be useless, and may be dispensed with without impairing the useful effect.(*l*)

7. Persons in the habit of using the thing patented may be called to prove its value and utility.(*m*) The extensive sale of an invention is good evidence of its utility, but not cheapness alone; an article may be too cheap to be good.(*n*) It may be proved by the evidence of scientific men, that any part of an invention which has not been actually tried would answer its purpose.(*o*)

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*CHAPTER V. [*26]

PRIOR USER.

1. THE use of a process in the ordinary course of trade by any other person, though such use is kept a secret from all but his partners and confidential servants, will vitiate a patent for such process.(*a*) The words, "public use and exercise," in the condition of a patent, are used in opposition to private and secret use. Public use is use in a public manner, not necessarily general use.(*b*) Where an improved lock, for which the plaintiff had a patent, had previously been used by an indivi-

(*i*) The Household Company v. Neilson, Webst. Pat. Ca. 696.
(*k*) Per Brougham, arg. Crossley v. Beverley, Nisi Prius, Webst. Pat. Ca. 109.
(*l*) Lewis v. Marling, 10 B. & C. 22; Morgan v. Seaward, 2 M. & W. 562.
(*m*) Webster v. Uther, Godson on Patents, 232.
(*n*) Cornish v. Keene, Webst. Pat. Ca. 506, Tindal, C. J. N. P.
(*o*) Neilson v. Hartford, Webst. Pat Ca. 316, N. P.
(*a*) Tennant's case, Webst. Pat. Ca. 125; Dav. Pat. Ca. 429.
(*b*) Carpenter v. Smith, N. P. Lord Abinger, Webst. P. C. 535; Tenant's case, Davies Pat. Ca. 429.

dual on a gate adjoining a public road for several years, and several dozen of a similar kind had been made in Birmingham from a pattern received from America, a patent for the invention was held void.(c)

2. If a machine has been publicly made and sold to any one individual, no patent can be had, though the invention was no further used, not being peculiarly adapted to any use at the time of such first sale.(d) The question is, whether the invention ever existed at all before.(e) Assuming it to have been a perfect invention, the abandonment of it becomes wholly immaterial. (f)

In Neilson against the Househill Company, it was ruled by the Lord Justice-Clerk Hope, that if the machinery had *been made, and [* 27] had been put on trial, unless those trials had gone on, and the machines had been used up to the time of the granting of the letters patent it would not be evidence of prior use, so as to invalidate the letters patent. But that decision was reversed in the House of Lords, where it was decided, that if it is proved that a machine of the same kind as the invention patented was previously in existence and in public use, it is not necessary that the use should come down to the time when the patent was granted.(g)

3. The originality of an invention is not destroyed by proof, that in the history of the arts and trades of this country, some persons may apparently have had some glimpse of the same conception in occasional and insulated experiments, which were not prosecuted or made known, and from which, so far as the rest of the world were concerned, no result or change followed in former practice.(h) It often becomes a question of great difficulty and importance, where an invention apparently similar has been in use before, and has been disused, whether the old invention is identical with that subsequently patented;(i) or whether the old invention was merely an unsuccessful experiment. It must never be forgotten how slight are the differences between success and failure, and how easily people may persuade themselves into the belief of having done the very same thing, though failing to attain the same degree of success.(k) Lord Justice-Clerk Hope says, if the process is of great, manifest, and immediate utility, the abandonment is of the utmost importance, in considering the question of novelty. Could such an invention have been previously in public use without abundant proof?(l) Lord Brougham said, the abandonment of such an invention is a very strong presumption, almost decisive, to show that it was not a real invention.(m) Even if the former

(c) Carpenter v. Smith, 9 M. & W. 300; S. C. Webst. P. C. 540.
(d) Losh v. Hague, N. P. Webst. P. C. 203.
(e) Minter v. Wells and Hart, N. P. Alderson, B. Webst. P. C. 127.
(f) The Househill Company v. Neilson, in House of Lords, Webst. P. C. 716.
(g) The Househill Company v. Neilson, Webst. P. C. 709.
(h) The Househill Company v. Neilson, Webst. P. C. 690.
(i) See Bickford v. Skewes, Webst. P. C. 214.
(k) Webst. P. C. 245, note c.
(l) Lord Justice-Clerk Hope, The Househill Company v. Neilson, 1 Webst. P. C. 690.
(m) Per Lord Brougham, The Househill Company v. Neilson, Webst. P. C. 713; ib. 673, 692.

invention did in fact embody the principle of the subsequent patent, if the *use was limited and abandoned, the question is, whether it was not rather an experiment than a public use.(*n*) [*28]

4. A mere experiment which is not brought to completion, but ends in uncertain experiments, not producing any definite practical results, is not such an invention as will prevent another person who is more successful or industrious from perfecting the discovery if he is able to do so. Mr. Field had made a drawing and model of a paddle-wheel, with divided floats arranged in a cycloidal curve, and exhibited it at the Admiralty, and to any person who wished to see it at the manufactory. He afterwards applied it in a vessel, the Endeavour, and used the wheel for some weeks. He then restored the former wheel, because, as he said, the boiler did not make steam fast enough for it. He entered a caveat at the Patent Office. He went on making many experiments for two years. He said he had examined the specification and models, and that Galloway's invention was the same in principle as his own. He said the wheel was a very valuable wheel, and a valid patent for it would be very valuable to the patentees. Chief Justice Tindal said, the question for the jury was, whether, under the circumstances, Mr. Field was to be depended on as to the exact identity of the discovery. The experiments had tended almost, if not entirely, to the same result. If they had rested in experiment only, and had not attained the object for which the patent was taken out, mere experiments, supposed by the parties to be fruitless, and abandoned, because they had not attained a complete result, would not affect the patent of one who carried the invention to perfection.(*o*)

In Jones v. Pearce, wheels similar in principle to, but differing in detail from that patented, had been put into a cart by Mr. Strutt, and used for carrying heavy loads of stones. The spokes occasionally got bent, and the nave becoming broken, the cart was laid by. A milk-cart upon the same principle had also been used. The rods were frequently straightened, and the wheel was worked till the iron tire was wore thin at the edges. Patteson, J. said, that on the whole of the evidence it appeared that the wheel constructed according *to Mr. Strutt's order was an experiment, and that he found it did not answer and ceased to use it, and abandoned it as useless, and that the plaintiff's wheel, remedying the defects of Mr. Strutt's wheel, was his own invention; the plaintiff's patent was good.(*p*) [*29]

Lord Campbell, in the House of Lords, in Neilson's case, said the effect of Mr. Justice Patteson's direction in Jones v. Pearce, and of that of Lord Chief Justice Tindal in Cornish v. Keene, amounts to this, that the abandonment of a machine may be material for the assistance of a jury in considering whether it was a perfect invention or not. But as-

(*n*) Walton v. Bateman, Webst. P. C. 619, Cresswell J.

(*o*) Galloway v. Bleadon, Webst. P. C. 521, 527; Gibson v. Brand, Webst. P. C. 627.

(*p*) Jones v. Pearce, Webst. P. C. 122, Patteson, J. at Nisi Prius. The Court afterwards granted a rule nisi for a new trial, but the case was eventually compromised. It would probably not be followed since the decision of The Househill Company v. Neilson, Webst. Pat. Ca. 709.

suming it to be a perfect invention, the abandonment becomes wholly immaterial.(q)

5. If the patentee has been the first person to introduce the invention into public use, that is primâ facie evidence that he was the first inventor.(r) Evidence is generally given by persons in the trade, that they never heard of the invention before the patented articles were brought into the market, and that is enough for a primâ facie case; but the general ignorance of witnesses of the improvements is no contradiction, and can avail nothing against evidence of previous knowledge and use by others. Fifty witnesses proving they had never seen the invention will be of no avail if one is called who has seen and practised it.(s)

6. To vitiate a patent on the ground of prior use, the practice of the invention must not have been secret or confined to the breast of the party making the discovery. In order to set aside the patent, the use must have been notorious.(t) There is no case in which a patentee has been [*30] deprived of the benefit of his invention, because another has *invented it, if he has not also brought it into use.(u) In Dollond's case, Dr. Hall made the same discovery before him, but Dr. Hall had confined it to his closet, and the public were not acquainted with it.(x) There may be several discoverers, many rivals running on the same road, and making an invention simultaneously: the first who comes to the Crown and takes out a patent has a right to clothe himself with the authority and enjoy the benefits of it.

7. But the mere existence of a machine in any place accessible to the public has been held to be sufficient to avoid the patent. Thus, where a man invented a lock and put it on his own gate, and used it for a dozen years, that was held a public use of it. Perhaps the true question is, whether the use in public is such that the public know, or might have the means of knowing, the construction of the machine. If from an inspection of the machine its construction can be learnt at once, or if, as is supposed in the principal case, the inventor did not make the lock so used with his own hands, but employed strangers to make and repair it, the invention may be published by such use.(y)

In a recent case, the patentee had seen a piece of vulcanized India rubber imported from abroad. In determining whether he was the inventor, the question was, could he have known or learnt, from a mere inspection of the article, the secret of its manufacture, or did he invent independently the mode of manufacture, in consequence of the idea suggested to him by the sight of the article?(z) It seems to be a question for the

(q) Per Lord Campbell, The Household Company v. Neilson, Webst. P. C. 713; Cornish v. Keene, Webst. P. C. 508.

(r) Minter v. Wells, Webst. P. C. 131, Alderson, B.; Elliott v. Aston, Webst. P. C. 222, Coltman, J. N. P.

(s) Rex v. Arkwright, Webst. P. C. 72; per Buller, J.; Hill v. Thompson, 8 Taunt. 382; S. C. Webst. P. C. 245; Manton v. Manton, Davies Pat. Ca. 350; Galloway v. Bleadon, Webst. P. C. 526.

(t) See Cornish v. Keene, Webst. P. C. 512, Tindal, C. J.; The Household Company v. Neilson, Webst. P. C. 709, Lord Lyndhurst.

(u) Lewis v. Marling, 10 B. & C. 22; S. C. Webst. P. C. 493, Parke, B.

(x) Dollond's case, cited by Buller, J. 2 H. Bl. 470, 487; Webst. P. C. 43.

(y) Webst. P. C. 530, 535, 539, Lord Abinger, Carpenter v. Smith.

(z) Hancock v. Somervill, Newton's London Journal, vol. 39, p. 158.

jury, whether, from the facts proved, they will infer that the invention was known.(*a*)

8. It is said to be enough if the machine is new in use, though the principle was known. The mere existence of a model of the machine may not avoid a patent. A model and specification of a machine similar to that for which the patent was granted had been brought over from America and shown to several persons, but no machine had been manufactured *and brought into use (see however, Mr. Godson's note of this case). The patent was held not to be avoided.(*b*) This [*31] case has been said to go to the extreme point of the law.(*c*) In Crane's case, the use of anthracite coal in smelting iron was proved to have been carried on in a small model experimental furnace for a considerable period, with some degree of success, though not profitably, and only inferior iron was produced; but it had failed when applied in a large ordinary furnace. It had been the great object before the date of the patent to smelt iron by means of such coal. The Court held that there was evidence that it had never been done before.(*d*) Both these cases have been doubted.(*e*) They may, perhaps, be rested on the ground, that before the plaintiff's patents there was no perfected knowledge of the thing discovered.(*f*)

9. It is a most important question what communication of an invention by an inventor to others is to be deemed a publication of the invention. If, before the grant of the patent, the patentee has carried his invention into practice, and made articles according to it in the way of commerce for gain to himself, and has been in the practice of selling them publicly to any one who would buy of him, the patent will be void. A single instance of such a sale might be deemed a public use of the invention, so as to defeat the patent.(*g*)

10. The use of the invention by the patentee for the purpose of experiment, and of satisfying himself of the practicability of his conception, will not avoid a patent. In Bramah v. Hardcastle, it appeared in evidence that the plaintiff had made two or three improved water-closets before he obtained his patent; but Bearcroft, the defendant's counsel, admitted that this circumstance would not invalidate the patent, unless the invention had likewise been used by others.(*h*) A *machine [*32] does not cease to be the subject-matter of a patent, because it has been completed as a working machine for a long time, if it had been kept shut up, and has not been used by the patentee except for the purpose of experiments.(*i*)

(*a*) See per Maule, J. 8 C. B. 719.
(*b*) Lewis v. Marling, 10 B. & C. 22.
(*c*) Carpenter v. Smith, 9 M. & W. 303, Alderson, B.
(*d*) Crane v. Price, Webst. P. C. 389, 411.
(*e*) See Godson on Patents, 432; Morgan v. Seaward, 2 M. & W. 553; 3 Exch. 433, Sir F. Pollock, C. B. and Parke, B.
(*f*) See per Lord Abinger, 9 M. & W. 304.
(*g*) Wood v. Zimmer, Holt, N. P. C. 58; Morgan v. Seaward, 2 M. & W. 544, 559; Carpenter v. Smith, N. P. Webst. P. C. 526, Lord Abinger.
(*h*) Webst. Pat. Ca. 194 n.; Bramah v. Hardcastle, Holroyd on Patents, 82 n.
(*i*) Bentley v. Fleming, 1 Car. & K. 589.

11. If the inventor incautiously communicates his invention, without any conditions of secrecy, to a stranger, who, without intending any fraud, either himself causes articles to be made upon the principle, or suggests the idea to another, who does so, the patent will be lost.(*k*)

12. The private communication of the invention by the inventor to any persons under such circumstances that the publication of the invention by such persons would be a breach of trust, will not make an invention public property, so as to prevent an inventor obtaining a patent. If a man employs an agent to see if he can get an article manufactured by a particular model, and chooses to take out a patent for it, he is not to be considered as not entitled to the invention because he has employed a workman to assist him in it.(*l*) If, after the machine is completed, the inventor lends it to a person to have its qualities tested, and that other uses it for some weeks in his workroom in a mill, where people frequently come in and out, this seems not to be giving the invention such a publicity as to deprive the inventor of his right to take out a patent for it.(*m*) A disclosure to a person, with whom the patentee is in treaty for a partnership in a sale of the patent, is not a publication.(*n*)

13. Nor will it be a publication of the patent, if a person with whom the patentee is in treaty for a sale of, or partnership in the patent in conjunction with the patentee, employs an engineer to manufacture a machine according to the patent, and pays him for his work and materials, the engineer being employed confidentially, and the manufacture carried on *under the injunction of secrecy, for the purpose of testing the invention. [*33]

A few months before the date of a patent for an improvement in paddle-wheels, two pair of the wheels were made for Morgan, who at that time was in treaty with the patentee for a sale or partnership in the patent, by an engineer at his manufactory, under the directions of the patentee, and under an injunction of secrecy. The engineer was paid for his work and the materials by Morgan. When finished, the wheels were completed, and put together at the factory, but not shown to any one who might come there. They were then taken to pieces, packed up, and shipped for a foreign port, where, after the date of the patent, according to Morgan's directions, they were put together and used in steamboats belonging to a company of which Morgan was manager and a principal shareholder, and on behalf of whom he paid the engineer for the machines. It did not appear that either Morgan or the patentee, derived any profit from the sale of the wheels. It was held, that the jury would have been justified in inferring that there had been no use or publication of the invention. There had been no public use or exhibition of the machine,

(*k*) Earl of Yarmouth v. Darrell, 3 Mod. 77; Rep. 1829, 82, citing an opinion of Lord Eldon when Attorney-General; see also Godson on Patents, 41, referring, apparently, to the same case.

(*l*) Carpenter v. Smith, per Lord Abinger, Webst. P. C. 536, N. P.; Morgan v. Seaward, 2 M. & W. 558; see also Prince Albert v. Strange, 1 MacNaghten & Gordon, 25, 43; 1 Hall & Twells, S. C.

(*m*) Bentley v. Fleming, 1 C. & K. 587.

(*n*) Morgan v. Seaward, 2 M. & W. 558.

or of the mode of its construction, in England, and no evidence that the patentee had exercised the invention for gain.(*o*)

14. It is unsettled how far the fraudulent publication of an invention by persons who have been employed by the inventor, would affect a patent. Where a person has a secret in trade, and employs others under contract, express or implied, those persons cannot gain the knowledge of that secret and then set it up against their employer.

The use of the secret of an unpatented invention, communicated in breach of confidence, will be restrained by injunction.(*p*) The case of an attempt to obtain a patent under such circumstances, is expressly provided for by stat. 15 & 16 Vict. cap. 83, s. 10, which enacts, that in case of any application for letters patent, and the obtaining upon such application of provisional protection, or protection in *fraud of the true inventor, any letters patent granted to the true inventor shall not be invalidated by such application or such protection, or by any use or publication of the invention subsequent to such protection. [*34]

15. The Act says nothing as to fraudulent publication in any other manner. Probably, the object of the framers of the Act was to induce an inventor to bring forward his invention at the earliest possible period. In one case, an attempt to appropriate an invention by a workman failed. He registered it under the Useful Designs Act.(*q*) In another, the invention had partly got into use before the date of the patent, by a piece of stuff surreptitiously obtained from the plaintiff's works. In this case the patent was held void.(*r*) Anything like neglect or delay under such circumstances, might show an abandonment of his invention by the patentee to the public.(*s*) But if the question ever does arise here of the right of a patentee, guilty of no default, robbed of his invention, one cannot but hope that the law here will be construed to be the same as it is in the United States. Mr. Justice Story says, "It is clear by our law, whatever may be the law of England, that the public use or sale of an invention, in order to deprive the inventor of his right to a patent, must be a public use or sale by others with his knowledge or consent. If the use or sale is without such knowledge or consent, that is not such a use as will deprive the inventor of his title."(*t*) So in Pearson v. The Eagle Screw Company, he says, "It has been the uniform doctrine of the courts of the United States, that no fraudulent or wrongful use of an invention, or public use without the consent or knowledge or sanction of the inventor, would deprive him of his right to a patent."(*u*)

The law of France seems similar:—"L'exécution *fraudulese qu'aurait faut un ouvrier de l'invention découverte par son maître, [*35]

(*o*) Morgan v. Seaward, 2 M. & W. 544; S. C. Webst. Pat. Ca. 187.

(*p*) Morison v. Moat, 15 Jur. 787; 9 Hare, 241; on appeal, 16 Jur. 321; see Smith v. Dickenson, 3 Bos. & Pull. 630.

(*q*) Wigram v. Brown, before Pollock, C. B. at Nisi Prius, cited Turner on Patents, 22.

(*r*) Templeton v. Macfarlane, 1 H. L. C. 595.

(*s*) Brown v. Kidstone and Waters, 1 S. M. & P. 769, Court of Sessions, Scotland.

(*t*) Ryan v. Goodwin, 3 Sumner's Rep. 514, 518, cited Curtis on Patents, 46.

(*u*) Pearson v. The Eagle Screw Company, 3 Story's Rep. 402; Curtis on Patents, 151.

antérieurement à la prise du brévet, ne peut être invoquée pour repousser le délit de contrefaçon imputé, après la prise du brévet, par le maître à l'ouvrier."—*Journal du Palais*, Paris, July 5, 1845.(*x*)

16. The public use of an invention in any part of the United Kingdom, or the colonies, will be fatal. In Roebuck and Garbett's case, a Scotch patent provided that letters patent should be void, if it were found that the subject-matter of them was not new as to use and exercise in Scotland; the House of Lords, affirming the judgments of the Lords of Session and the Lord Ordinary, determined, that the appellants were entitled to prove that the invention had been used in England before the date of the patent.(*y*)

If an invention is found not to be new in the colonies, a patent for it here would be void, for they are part of the realm. The enrolment of the specification or any publication of the invention in one part of the realm, before the patent is sealed for another, seems to have the same effect.(*z*)

17. The recent statute has effected a most important alteration in the law with respect to the time during which the use of an invention would vitiate a patent. Until the passing of that Act, the patentee was never secure until his patent was sealed; nor even then absolutely. Now he is safe as soon as he has obtained provisional protection.(*a*) Inventors laboured under great difficulties in being compelled to use the utmost secrecy in any experiments they might think it desirable to make before the sealing of the patent. The time limited for specifying was often found insufficient to enable the patentee to make proper trials of his invention before enrolling his specification, especially where the patent was for complicated machinery new in principle. Now, however, should a [*36] *workman or other person steal the idea of the inventor, and apply for a patent in his own name, the right of the true inventor to his patent will not be affected, if he applies for it before the expiration of the term of the provisional or other protection. And the advertisement of the protection granted, directed by the Commissioners of Patents, will give the true inventor notice that his patent is in danger. The question of prior use is for the jury.

[*37] *CHAPTER VI.

IMPORTED INVENTIONS.

1. BEFORE the coming into operation of the recent statute, persons

(*x*) Codes Annotés, tome ii. table générale 11. Teulet. D'Auvilliers et Sulpicy, Paris, 1850.

(*y*) Roebuck and Garbett, appellants, Stirling, respondent, Webst. P. C. 45, 451 n.; Brown v. Annandale, Webst. Pat. Ca. 433.

(*z*) Robinson's patent, 5 Moo. P. C. 65; Samuda's patent, Hindmarch on Patents, 534.

(*a*) See stat. 15 & 16 Vict. cap. 83, ss. 8, 9.

who had learned the invention abroad, and imported it into this country, where it was not used or known previously, were able to obtain patents, as the first and true inventors within the meaning of the statute: it was enough if the invention was new within the kingdom.(*a*) In The Clothworkers of Ipswich case, in 12 Jac. 1, it was resolved, that if a man hath brought in a new manufacture and new trade within this kingdom, in peril of his life and consumption of his estate or stock, in such case 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 traffic for a certain time, because at first the people of this kingdom are ignorant, and have not the knowledge or skill to use it.(*b*) The Act intended to encourage new devices useful to the kingdom, and whether learned by travel or study it is the same thing.(*c*)

2. The Act leaves the case of inventions which have never been protected by letters patent abroad, precisely as it was before the statute, and therefore any person may still import and obtain a valid patent for the full term for any such invention. But it was probably considered, that from the increased habits of inter-communication amongst nations, such an invention, if valuable, would probably have either become known in this country, or would have been kept so secret as to *warrant the grant of a privilege to any one introducing it here. [*38]

3. The Patent Law Amendment Bill of 1852, originally contained a clause, which provided that the use or publication in any foreign country, or in any of the Channel Islands, or in any of her Majesty's colonies, dominions, or possessions abroad, of any invention before the date of any letters patent to be granted for such invention, under the provisions thereinbefore contained, should have the like effect with respect to such letters patent as if such use or publication had taken place in the united kingdom of Great Britain and Ireland. This provision was, however, struck out by the select committee in the House of Commons. The clause, as it stands in the Act, provides "that no letters patent for any invention, for which a patent or the like privilege shall have been obtained in any foreign country, and which shall be granted in the United Kingdom upon any application made after the passing of that Act, and after the expiration of the term granted by the foreign patent, shall be of any validity."(*d*)

4. The practical difficulties in the working of this clause may turn out to be considerable. It will be probably necessary to issue a commission to the foreign country in which the invention is said to have been patented, and a plaintiff may be delayed a long time under pretence of that commission.(*e*) In some countries, as in Prussia, where the specifications registered are not accessible to the public, unforeseen obstacles may arise in the proof of their contents,

5. Where, upon any application made after the passing of that Act,

(*a*) Beard v. Egerton, 3 C. B. 97, 128; see Stead v. Williams, 7 M. & G. 818.
(*b*) The Clothworkers of Ipswich case, Godbolt, 252.
(*c*) Edgeberry v. Stephens, 2 Salk. 447.
(*d*) Stat. 15 & 16 Vict. cap. 83, s. 25.
(*e*) See Report on Patents, 1851, p. 376.

letters patent are granted in the United Kingdom, for or in respect of any invention first invented in any foreign country, or by the subject of any foreign power or state, and a patent or like privilege for the monopoly or exclusive use or exercise of such invention in any foreign country is there obtained before the grant of such letters patent in the United Kingdom, all rights and privileges under such letters patent shall, notwithstanding any term in such letters patent limited, cease and be void immediately upon the expiration or other determination of the term during which the patent or like *privilege obtained in such foreign country shall continue in force; or where more than one such patent or like privilege is obtained abroad, immediately upon the expiration of the term which shall first determine of such several patents or like privileges.(*f*)

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*CHAPTER VII.

PRIOR PUBLICATION.

1. THE specification of a prior British patent, substantially describing the same machine, has always been considered fatal to a patent without any evidence that the invention has been used.(*a*) A specification is a public document open to every body, and of which everybody must take notice at his peril. Evidence is necessary to show that the invention described in such specification is identical with that newly patented; and

(*f*) Stat. 15 & 16 Vict. cap. 83, s. 25. Where several patents are to be taken out in different countries, it is desirable that the applications should be as nearly as possible cotemporaneous. Since 1844, no one can obtain a patent in France for an invention previously patented in another country, except he be the original patentee, or his assignee. The original patentee, or his assignee, may obtain his patent at any time before the expiration of the patent in his own country; but the patent in France will only last as long as the patent in his own country continues. The right of patenting an invention does not extend to that inventor whose invention has been described and published in a foreign country, by printing the specification and making it open to all the public.* If the patent is first taken out in France, the French patent may be avoided by non-user, or non-payment of the annual sum of 100f., or if the patentee imports the patented articles from abroad. In America, the patentee must be strictly the original and first inventor. An alien may take out a patent. By the Act of Congress of 1839, cap. 88, s. 6, no person shall be debarred from receiving a patent by reason of the invention having been patented in a foreign country more than six months before the date of his application, provided the same shall not have been introduced into public and common use in the United States prior to the application for the patent. It seems that an alien has six months from the grant of his patent in a foreign country, and more, if in the mean time the invention does not get into use in America.—Curtis on Patents, ss. 114-116.

(*a*) The Household Company v. Neilson, Webst. P. C. 718 n. Lord Campbell; Huddart v. Grimshaw, Webst. P. C. 86.

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* Report on the Patent Law Amendment Bills, 1851, p. 331. Wolowski. Truffaut, Guide Pratique des Inventeurs, pp. 72-86. Paris, 1844.

if it is a description of a machine, that the machine is intelligibly described, so as really to enable people to construct the machine from it.(*b*)

A very slight difference in the details is occasionally of great importance. Muntz's patent for sheathing, composed of a mixture of the best-selected copper and foreign zinc, was not affected by a previous patent, of which he knew nothing, for a composition of copper and zinc, it being shown that useful sheathing could not be made from such materials.(*c*)

2. The specification of a prior patent, enrolled after the date and sealing of a subsequent patent, and before the enrolment of the specification of such subsequent patent, but after the manufacture protected by it has become known in the market, does not of itself afford any proof whatever of the want of novelty in the invention protected by such second patent.(*d*)

3. If an invention is distinctly and clearly described in a *book, and such description corresponds with the description in [*41] the specification of the patent, though the invention has never been actually worked, the patent is avoided. It is continually the practice to read out of printed books, without reference to anything that has been done.(*e*) But it must be the account of a perfected invention. The mere speculations of ingenious men, if not brought into use, ought not to stand in the way of other men equally ingenious, who make the same inventions and apply them.(*f*)

A description of a mode of paving with blocks had been published in a scientific work in England. The Court decided, that if the invention had already been made public in England, by a description contained in a work which had been publicly circulated, the patentee was not the first inventor within the meaning of the statute, whether he himself borrowed his invention from such work or not, because the public cannot be precluded from the right of using such information as they were already possessed of at the time of the granting of the patent.(*g*)

4. "The application of the principles as to publication in a book, must depend upon the particular circumstances which are brought to bear in each particular. The existence of a single copy of a work, though printed, brought from a depository where it has long been kept in a state of obscurity, would afford a very different inference from the production of an encyclopædia or other work in general circulation. The question will be, whether, upon the whole evidence there was any such publication as to make the description a part of the public stock of information."(*h*)

5. Publication in a foreign book will not destroy a patent, unless the invention is shown to have become known in England by such

(*b*) See Lewis v. Marling, 4 C. & P. 52.
(*c*) Muntz v. Foster, 2 Law Times, 325; Carpmael on Patents, 25.
(*d*) Cornish v. Keene, 3 Bing. N. C. 589; Webst. P. C. 519, S. C.
(*e*) Per Lord Lyndhurst, Webst. Pat. Ca. 718, note to the Household Company v. Neilson; see Hill v. Thompson and Foreman, 8 Taunt. 386; Webst. P. C. 247.
(*f*) Per Lord Abinger, Carpenter v. Smith, Webst. Pat. Ca. 534, N. P.
(*g*) Stead v. Williams, 7 M. & G. 842.
(*h*) Stead v. Williams, 7 M. & G. 843, Tindal, C. J.

[*42] publication.(i) In a scire facias to repeal *a patent, it was proved that a foreign work, "Manuel du Fabricant d'Indiennes" which was alleged to contain a description of the defendant's process, had been sold to several persons in Manchester many years before the date of the defendant's patent. But it appeared that the work was but little understood or appreciated by those most interested in it. A chemist proved that he had made garancine according to the process the redescribed. Lord Campbell left the question to the jury, whether they believed that the process there described had become known and practised in this country before the date of the patent.(k)

6. It may be a question of some difficulty under what circumstances a patent is obtainable for a forgotten invention. Hero's invention, and those of the marquis of Worcester, are well-known instances of ancient engines not brought into use, reinvented in modern days independently, having become most important additions to the wealth of the country. Of such, Lord Brougham said, "They become like new discoveries."(l) The true rule probably is, that where the invention exists, or is described in such a manner that it could be manufactured from a mere inspection or an existing description, a patent obtained by a modern inventor would require confirmation.

Where an old process has been rediscovered, a good patent may be had for the process invented; for if the process is not in fact actually new, it seems at any rate impossible to prove it otherwise. Mr. Webster puts it thus: "Suppose an article of manufacture—an encaustic tile or painted glass—such as was known in the middle ages to have been manufactured at a certain period in this country in secret, or so that the whole knowledge of the art is lost, but such tiles and glass are known and in use before the eyes of the public to the present time, and an ingenious man should discern a mode whereby tiles and painted glass, apparently the same, could be produced, and publish that mode to the world under letters-patent, would the knowledge of the tiles vitiate the [*43] patent, no knowledge of the invention as an art existing at *the time of the grant?"(m) It seems impossible to doubt that a patent for the process of manufacturing them would be good, if the article were not such as to show the mode of its manufacture.(n) In Campion v. Benyon, it was actually given in evidence, that the wrapper of an Egyptian mummy, which had been examined by one of the defendant's witnesses was woven in the same manner as the plaintiff's improved sail-cloth.(o)

(i) Lord Brougham, The Household Company v. Neilson, Webst. Pat. Ca. 718 n.; Soames's patent, Pri. C. Webst. P. C. 733, cited 7 M. & G. 840.
(k) Reg. v. Steiner, Lord Campbell, N. P. Times, Dec. 6, 1851.
(l) The Household Company v. Neilson. Webst. Pat. Ca. 717; S. C. per Lord Lyndhurst, ib. 710, 717; per Lord Abinger, Carpenter v. Smith, Webst. Pat. Ca. 534.
(m) Webst. Pat. Ca. 720 n.
(n) See Wright's patent, Webst. Pat. Ca. 736.
(o) Campion v. Benyon, 3 Brod. & Bing. 8.

*CHAPTER VIII. [*44]

TO WHOM A PATENT MAY BE GRANTED.—THE FIRST AND TRUE INVENTOR.

1. THE Crown may grant a patent to any person, whether a subject or an alien.(a) A subject, or foreigner, may hold a patent in trust for an alien amy.(b) The point whether a patent was absolutely void by reason of its being held in trust for an alien enemy was raised, but not decided, in the case of Bloxam v. Elsee. The decision of the Court ultimately turned on another point. It would seem, however, to be a good defence to any action brought in the name of the trustee for infringements.(c) If obtained in time of war, in trust for the alien enemy, the patent would probably be held void in all future times, as obtained by fraud on the Crown. If obtained by or in trust for the alien before the breaking out of war, his rights would be only suspended during the continuance of hostilities.(d)

2. The person to whom letters patent are granted must be the first person to make the invention known here.(e)

The object of the saving in the statute was not so much for the purpose of securing to inventors a reward for their ingenuity, as to stimulate the trade and manufactures of the kingdom. It mattered little for this purpose whence an improvement *came; and in the very [*45] first case after the passing of the Act, it was held, in accordance with cases before the statute, that the Act was intended to encourage new devices within the kingdom; and whether learned by study or travel, it is the same thing.(f) This doctrine has been confirmed in recent cases.(g) No question is made here as to the title of an importer, whether he is the assignee of the original foreign inventor, or whether the invention is made public, and given to all the world in such foreign country.(h) He may be a mere clerk or servant of the foreign inventor, to whom the communication may be made for the sole purpose of enabling him to take the patent in trust for the benefit of the foreigner, or one who steals the invention from the foreign inventor.(i) The new Act makes no provision against the latter case, except by enabling the true

(a) 3 C. B. 97, Beard v. Egerton; Chappell v. Purday, 14 M. & W. 318; Edgeberry v. Stephens, 2 Salk. 447.

(b) Beard v. Egerton, 3 C. B. 97; see stat. 7 & 8 Vict. cap. 66, s. 4; Jevens v. Harridge, 1 Wms. Saund. 8, note 1; Calvin's case, 7 Rep. 17.

(c) Bloxam v. Elsee, 1 C. & P. 558; S. C. Ry. & Moo. 187; Brandon v. Nesbitt, 6 T. R. 23.

(d) See Antoine v. Morshead, 6 Taunt. 237; Flindt v. Waters, 16 East, 260.

(e) Stat. 21 Jac. 1, cap. 3, s. 6.

(f) Edgeberry v. Stephens, 2 Salk. 447; The Clothworkers of Ipswich case, Godbolt, 252; The case of monopolies, Darcy v. Allin, Noy, 178; 11 Co. 84.

(g) Beard v. Egerton, 3 Com. Bench, 97, 129.

(h) Per Pollock, C. B. Chappell v. Purday, 13 M. & W. 318; Beard v. Egerton, 3 C. B. 97.

(i) See an instance cited, Rep. on Patents, 1851, p. 100.

inventor to obtain his patent if he applies before the provisional or other protection of a person obtaining protection by fraud shall have expired. This, however, will probably be sufficient for the safety of the foreign inventor, if he is not guilty of laches, by neglecting to take steps to obtain his patent here.

3. It seems not to be important whether the person making the communication from abroad is a foreigner or not; the importing a new manufacture and giving the public in this country the benefit of it is the basis of the grant of the monopoly.(*k*)

4. The invention must be that of the patentee himself: if he has borrowed it from some other person, if he has taken it from a book, or learnt it from a specification, or any other source, in this country, he will not be entitled to a patent, for the Legislature never intended that a person who had taken all his knowledge from the labours of another, should receive the benefit of another's skill.(*l*) If the machine has been [*46] *suggested to the patentee by the sight of a model, or foreign specification accessible to others in this country, that might show that the patentee was not the true inventor.(*m*) Patents are granted as a reward to the first inventor, for the benefit that is conferred upon the public by the discovery. If anybody is able to show that the man who first got the patent is not the man whose ingenuity first made the invention in England, there is an end of the patent. A patent was held void, a witness having stated that he had made the improvement while employed in the workshop of the patentee.(*n*)

An English patent founded on a communication made to the patentee, of an indispensable part of the patent, which was the basis of the improvement, was held to be void.(*o*) But the discovery must be communicated to the patentee in such a state that he could put it in practice without further invention. He is the first inventor who first makes the invention capable of useful application.(*p*)

5. If a person has discovered an improved principle, and employs engineers, or agents, or other persons to assist him in carrying out that principle, and they in the course of the experiments arising from that employment, make valuable discoveries accessary to the main principle, and tending to carry out that in a better manner, such improvements are the property of the inventor of the original improved principle, and may be embodied in his patent; and if so embodied, the patent is not avoided by evidence that the agent, or servant, made the suggestions of that subordinate improvement of the primary and improved principle.(*q*) It would be difficult to define how far the suggestions of a workman employed in the construction of a machine are to be considered as dis-

(*k*) Nickels v. Ross, 8 C. B. 710, per Wilde, C. J., and Coltman, J.
(*l*) Gibson v. Brand, N. P. Tindal, C. J., Webst. P. C. 628.
(*m*) Cornish v. Keene, Webst. P. C. 507, Tindal, C. J.; Lewis v. Marling, 10 B. & C. 22; Jones v. Pearce, Webst. Pat. Ca. 124.
(*n*) Barker v. Harris and Shaw, Webst. P. C. 126; Barber v. Walduck, 1 C. & P. 567.
(*o*) Tennant's case, Webst. P. C. 125; Dav. Pat. Ca. 429.
(*p*) Alden v. Dewey, 1 Story Rep. 336; Curtis on Patents, 41.
(*q*) Allen v. Rawson, 1 C. B. 567, Erle, J.

tinct inventions by him, so as to avoid a patent incorporating them taken out by his employer. Where the principle and object of the invention are complete without it, the adoption of a suggestion by a workman of something calculated more easily *to carry into effect the conceptions of the inventor, will not render the whole patent void. If [*47] a servant while in the employment of his master makes an invention, the invention belongs to the servant, and not to the master, though if the master employs a skilful person for the express purpose of inventing, the inventions made by him will belong to the master, so as to enable him to take out a patent for them.(r)

The person who suggests the principle is the true and first inventor. Alderson, B., said, "If Sutton suggested the principle to Minter, then he would be the inventor; if, on the other hand, Minter suggested the principle to Sutton, and Sutton was assisting him, then Minter would be the inventor, and Sutton a machine which Minter uses for the purpose of enabling him to carry his original conception into effect. They were together at the time of the invention, and it is for the jury to decide which of the two suggested the invention, and which carried it into effect. Mr. Minter makes out the primâ facie case,—he is the person who took out the patent."(s)

6. If there be several rivals or simultaneous inventors, the first who comes and takes a patent, the invention not being generally known to the public, has a right to clothe himself with the authority of a patent.(t) In case of concurrent applications for a patent for the same object, Lord Eldon said, that that which obtained the great seal first would have the sole right at law. He could see no other means of deciding than by awarding the patent to him who went quickest through the process. An application for a patent had been commenced previously to another application for the same object, but owing to circumstances, the progress of the first application had been delayed, and the second patent was in advance, so as to be likely to be sealed first.(u)

In a subsequent case, where two persons severally applied for patents for the same invention, the Solicitor-General reported in favour of both of them. Caveats having been *entered at the great seal, the [*48] Lord Chancellor referred it back to the Solicitor-General, to report whether the patents clashed, and if so, who was the first inventor, not who first presented the petition. The Lord Chancellor said, he would put any date to the patent which the justice of the case required.(x) No person, except on proof of fraud, could obtain a patent after the deposit of a complete specification of the same invention.

7. It is no objection that some one else has made a similar discovery in his mind. The patentee must be an inventor, not necessarily *the* inventor; because another may have invented and concealed it; there must have been a publication by the prior inventor, in order to prevent a sub-

(r) Bloxam v. Elsee, 1 C. P. 558; Makepeace v. Jackson, 4 Taunt. 770.
(s) Minter v. Wells and Hart, Alderson, B. at Nisi Prius, Webst. Pat. Ca. 132.
(t) Cornish v. Keene, Webst. P. C. 508; Forsyth v. Riviere, Webst. Pat. Ca. 97.
(u) Ex parte Dyer, Report, 1829, 197.
(x) Re Griffiths' patent, Re Samuda's patent, 5 Law Times, 141.

sequent inventor patenting the same thing.(y) But if the invention has been already made public in the United Kingdom by a work either written or printed, which has been publicly circulated, the patentee is not the first and true inventor within the meaning of the statute, whether he has himself borrowed his ideas from such publication or not.(z)

[*49] *CHAPTER IX.

THE COMMISSIONERS OF PATENTS AND THEIR OFFICES.

1. By statute 15 & 16 Vict. cap. 83, s. 1, it is enacted that the Lord Chancellor, the Master of the Rolls, the Attorney-General for England, the Solicitor-General for England, the Lord Advocate, the Solicitor-General for Scotland, the Attorney-General for Ireland, and the Solicitor-General for Ireland, for the time being respectively, together with such person or persons as may be from time to time appointed by her Majesty, by warrant under her sign manual, are to be the Commissioners of Patents for Inventions. Every person so appointed by her Majesty is to continue a Commissioner during her Majesty's pleasure. And all powers by the Act vested in the Commissioners may be exercised by any three or more of them, the Lord Chancellor or the Master of the Rolls being one.

2. By section 2, It shall be lawful for the Commissioners to cause a seal to be made for the purposes of the Act, and from time to time to vary such seal; and to cause to be sealed therewith all the warrants for letters patent under this Act, and all instruments and copies proceeding from the office of the Commissioners; and all courts, judges, and other persons whomsoever, shall take notice of such seal, and receive impressions thereof in evidence, in like manner as impressions of the great seal are received in evidence, and shall also take notice of and receive in evidence, without further proof or production of the originals, all copies or extracts certified under the seal of the said office of or from documents deposited in the said office.

3. By section 3, It shall be lawful for the Commissioners, from time [*50] to time, to make such rules and regulations (not inconsistent *with the provisions of this Act) respecting the business of their office, and all matters and things which, under the provisions herein contained, are to be under their control and direction, as may appear to them necessary and expedient for the purposes of this Act; and all such rules shall be laid before both Houses of Parliament within fourteen days after the making thereof, if Parliament be sitting; and if Parliament be not sitting, then within fourteen days after the meeting of Parliament:

(y) Dollond's case, 2 H. Black. 487; Gibson v. Brand, 4 M. & G. 205, per Erskine, J.; Lord Lyndhurst, The Household Company v. Neilson, Webst. P. C. 719; Brett v. Electric Telegraph Company, Norman on Designs, 7.

(z) Stead v. Williams, 7 M. & G. 818.

and the Commissioners shall cause a report to be laid annually before Parliament of all the proceedings under and in pursuance of this Act.

4. The Commissioners of her Majesty's Treasury may provide and appoint, from time to time, proper places or buildings for an office or offices for the purposes of this Act.(*a*) The Great Seal Patent Office has been appointed as the office for the purposes of this Act. The Commissioners of the Treasury are to allow the necessary sums for providing offices, and for the current expenses of the office.(*b*)

5. The Commissioners, with the consent of the Commissioners of the Treasury, may, from time to time, appoint, for the purposes of this Act, such clerks and officers as the Commissioners may think proper, and from time to time remove any of the clerks and officers so appointed.(*c*) The Commissioners of her Majesty's Treasury are to allow such salaries and payments to the clerks and officers as they may think fit.(*d*)

6. The Lord Chancellor having appointed the Great Seal Patent Office to be the office of the Court of Chancery for the filing of specifications, the Great Seal Patent Office and the office of the Commissioners have been combined. The clerk of the Patents for the time being is appointed clerk of the Commissioners for the purpose of the Act.(*e*)

The office is open to the public every day, Christmas-day and Good Friday excepted, from ten till four.

7. Office copies of documents in the Great Seal Patent Office are subject to a stamp of twopence for every ninety words.(*f*)

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*CHAPTER X. [*51]

MODE OF PROCEEDING TO OBTAIN LETTERS PATENT.

SECTION I.—PETITION AND DECLARATION.

1. THE mode of applying for letters patent for an invention is by petition to the Crown, to be left at the office of the Commissioners of Patents.(*a*)

2. The petition is to be accompanied by a declaration made before a master in Chancery or justice of the peace, and by the provisional specification. See forms in Appendix.

As to the title of the invention in the petition, see post, chap. XI. As the title of the invention is to be the sole information to the public of its nature, it is very important that it should truly describe the invention and its extent.

3. The petition for the grant of letters patent, and all declarations and

(*a*) Stat. 15 & 16 Vict. cap. 83, s. 4.
(*b*) Stat. 15 & 16 Vict. cap. 83, s. 49.
(*c*) Stat. 15 & 16 Vict. cap. 83, s. 5.
(*d*) Stat. 15 & 16 Vict. cap. 83, s. 48.
(*e*) First set of Rules, 1852, 6.
(*f*) Stat. 16 Vict.
(*g*) Stat. 15 & 16 Vict. cap. 83, s. 6.

provisional specifications, shall be respectively written upon sheets of paper, twelve inches in length by eight inches and a half in breadth, leaving a margin of one inch and a half on each side of each page, in order that they may be bound in the books to be kept in the office.(*b*) The petition must be impressed with a stamp of £5.(*c*)

4. No caveat against a patent can be entered at the chambers of the law officers. Inventors desirous of watching applications for patents likely to interfere with them, must, therefore, keep a careful eye on the notices in the *Gazette*.

[*52] *SECTION II.—PROVISIONAL PROTECTION.

5. With the petition and declaration shall be left a statement in writing, called the Provisional Specification, signed by or on behalf of the applicant for letters patent, describing the nature of the invention.(*d*)

6. The provisional specification must state distinctly and intelligibly the whole nature of the invention, so that the law officer may be apprised of the improvement, and of the means by which it is to be carried into effect.(*e*)

7. The drawings accompanying provisional specifications are to be made upon a sheet or sheets of parchment, paper, or cloth, each of the size of twelve inches in length by eight and a half in breadth, or of the size of twelve inches in breadth by seventeen inches in length, leaving a margin of one inch on every side of each sheet.(*f*)

It having been found impossible in some instances to comply with this requisition, drawings of a large size, made to fold into the dimensions above mentioned, are now admitted at the office of the Commissioners.

8. In order that the petitions, declarations, and provisional specifications may be examined and recorded in the office of the Commissioners, it is necessary that they should be left at the office two clear days. Should the title of the invention not agree in each document, the papers will be returned to the parties for correction, and no record of them will be taken till they are left properly corrected.

9. No amendment or alteration at the instance of the applicant will be allowed in a provisional specification after the same has been recorded, except for the correction of clerical errors or of omissions made per incuriam.(*g*)

10. The day of the delivery of every petition, declaration, and provisional specification, is to be recorded at the office, and indorsed on such petition, declaration, and provisional specification, and a certificate thereof given to the applicant or his agent.(*h*)

[*53] *All such petitions, declarations, and provisional specifications, shall be preserved in such manner as the Commissioners may

(*b*) First set of Rules for the passing of Letters Patent for Inventions after the 1st of October, 1852, rule 1. (*c*) 16 Vict.
(*d*) Stat. 15 & 16 Vict. cap. 86, s. 6. See form in Appendix.
(*e*) Second set of Rules, 1852, rule 10. (*f*) First set of Rules, 1852, rule 2.
(*g*) Second set of Rules, 1852, rule 9. (*h*) Stat. 15 & 16 Vict. cap. 83, s. 6.

direct; and a registry thereof, and of all proceedings thereon, kept at the office of the Commissioners.(*i*)

11. Every application for letters patent under this Act must be referred by the Commissioners, according to such regulations as they may think fit to make, to one of the law officers.(*k*)

The reference will be indorsed on the petition, and signed by the clerk to the Commissioners of Patents.

12. The provisional specification shall be referred to the law officer, who shall be at liberty to call to his aid such scientific or other person as he may think fit, and to cause to be paid to such person by the applicant such remuneration as the law officer shall appoint; and if such law officer be satisfied that the provisional specification describes the nature of the invention, he shall allow the same, and give a certificate of his allowance; and such certificate shall be filed in the office of the Commissioners. And, thereupon, the invention therein referred to may, during the term of six months from the date of the application for letters patent, be used and published without prejudice to any letters patent to be granted for the same. Such protection from the consequences of use and publication, is called provisional protection.

In case the title of the invention, or the provisional specification, be too large or insufficient, it shall be lawful for the law officer to whom the same is referred, to allow or require the same to be amended.(*l*)

13. The papers will be sent from the office of the Commissioners to one of the law officers, with the reference indorsed upon them. If the law officer is satisfied that the provisional specification truly describes the nature of the invention, he will return the papers to the office of the Commissioners, with the certificate of his allowance. If he considers the provisional specification insufficient, his clerk will write to the applicant, fixing a time for his attendance, when, on the applicant consenting to amend the title or provisional *specification to his satis- [*54] faction, he will give a certificate of his allowance of the amendment, and return the same, with the papers, to the office. See forms in Appendix.

14. The provisional specification will be a check on the patentee. If the complete specification is not strictly in accordance with it, people will be entitled to say, that something is specified which would have been opposed, but which could not be opposed, because the provisional specification gave no notice of what was intended to be specified. That information, if given to the Attorney-General, might have induced him to withhold the patent.(*m*)

If an inventor desires to abandon anything contained in his provisional specification, in order to guard against the objection that he represented himself to have invented more than he has actually specified, he should enter a disclaimer with the specification.(*n*)

According to the practice before the passing of this Act, a person could withdraw any portion of his deposit-paper up to the time of enrolling his

(*i*) Stat. 15 & 16 Vict. cap. 83, s. 6.
(*k*) Stat. 15 & 16 Vict. cap. 83, s. 7.
(*l*) Stat. 15 & 16 Vict. cap. 83, s. 8.
(*m*) See Rep. 1851, 379, the Master of the Rolls.
(*n*) See Report on Patents, 1851, 60.

specification. If, at the time of enrolling his specification, he found it advisable to abandon one of several things mentioned in the title of his patent, he obtained leave before the entry of the specification to disclaim so much of the title as related to that which he abandoned, and described the rest in his specification.(*o*)

15. If the first outline description would not be sufficient to embrace all the improvements in the invention, or in the mode of working it out, the proper course would seem to be to abandon the proceedings taken on the first provisional specification, and commence afresh with a new application, before the invention, comprised in the first provisional specification, is made public.(*p*)

16. It will be observed that actions cannot be maintained for infringements, during the period of provisional protection. (See s. 24.) The grant of protection under such circumstances that the inventor will be [*55] able safely to test the practicability and value of his invention before proceeding to *complete his patent, is one of the most important boons conferred on inventors by the new Act. Stat. 14 Vict. cap. 8, did not enable persons registering under it, to put their inventions in practice before the grant of the patent.

17. Every provisional protection of an invention allowed by the law officer, shall be forthwith advertised in the London Gazette, and the advertisement shall set forth the name and address of the petitioner, the title of his invention, and the date of the application.(*q*)

SECTION III.—PROTECTION BY DEPOSIT OF COMPLETE SPECIFICATION.

18. By section 9, the applicant for letters patent for an invention, instead of leaving with the petition and declaration a provisional specification, may file with the said petition and declaration, a complete specification under his hand and seal, particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed, which complete specification shall be mentioned in such declaration.

The day of the delivery of every such petition, declaration, and complete specification, shall be recorded at the office of the Commissioners, and indorsed on such petition, declaration, and specification, and a certificate thereof given to such applicant or his agent; and thereupon, subject to the provisions in the Act contained, the invention shall be protected for the term of six months from the date of the application, and the applicant shall have during such term of six months the like powers, rights, and privileges, as might have been conferred upon him by letters patent for such invention, issued under this Act, and duly sealed as of the day of the date of such application; and during the continuance of such powers, rights, and privileges, under this provision, such invention

(*o*) Report on Patents, 1851, 79.
(*p*) Report on Patents, 1851, 384. See Hancock v. Somervill, 39 Newt. Lond. Journ. C. S. 158.
(*q*) First set of Rules, 1852, rule 3.

may be used and published without prejudice to any letters patent to be granted for the same.

19. Where letters patent are granted in respect of such invention, then, in lieu of a condition for making void such letters patent, in case such invention be not described and *ascertained by a subsequent specification, such letters patent shall be conditioned to become void if such complete specification, filed as aforesaid, does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed. [*56]

A copy of every such complete specification shall be open to the inspection of the public from the time of depositing the same, subject to such regulation as the Commissioners may make.

20. When the invention is complete at the time of the application, and is such that in framing the specification, examination of the history of the manufacture is not necessary, it may often be desirable to file a complete specification in the first instance.

21. All complete specifications accompanying petitions and declarations, before the grant of letters patent, are to be filed in the Great Seal Patent Office.(*r*)

All such specifications are to be written bookwise upon a sheet or sheets of parchment, each of the size of twenty-one inches and a half in length by fourteen inches and three-fourths of an inch in breadth; the same may be written upon both sides of the sheet, but a margin must be left of one inch and a half on every side of each sheet.(*s*)

22. The petitioner is required by the Act to leave an extra copy of any drawings to which reference is made in the specification.(*t*)

The drawings accompanying the specification are to be made upon a sheet or sheets of parchment, each of the size of twenty-one inches and a half in length, by fourteen inches and three-fourths of an inch in breadth; or upon a sheet or sheets of parchment each of the size of twenty-one inches and a half in breadth, by twenty-nine inches and a half in length, leaving a margin of one inch and a half on every side of each sheet.(*u*)

The Commissioners recommend applicants and patentees to make their elevation drawings according to the scale of one inch to a foot.

*23. Every invention protected by reason of the deposit of a complete specification, shall be forthwith advertised in the London Gazette; and the advertisement shall set forth the name and address of the petitioner, the title of the invention, the date of the application, and that a complete specification has been deposited.(*x*) [*57]

SECTION IV.—REFERENCE TO THE LAW OFFICER, NOTICE OF OBJECTION, HEARING, ETC.

24. The applicant for letters patent, so soon as he may think fit after the

(*r*) Order of Lord St. Leonards, 1852, 1.
(*s*) Order of Lord St. Leonards, 1852, 2.
(*t*) Stat. 15 & 16 Vic. cap. 83, s. 28.
(*u*) Order of Lord St. Leonards, 1852, 3.
(*x*) First set of Rules, 1852.

invention shall have been provisionally protected under this Act, or where a complete specification has been deposited with his petition and declaration, then, so soon as he may think fit after such deposit, may give notice, in writing, at the office of the Commissioners, of his intention of proceeding with his application for letters patent for the said invention.(*y*) The certificate of notice to proceed is subject to a stamp-duty of £5.(*z*)

25. The application shall then forthwith be advertised in the London Gazette; and the advertisement shall set forth the name and address of the petitioner, and the title of his invention, and that any person having an interest in opposing the application are to be at liberty to leave particulars, in writing, of their objections to the application, at the office of the Commissioners, within twenty-one days after the date of the Gazette in which such notice is issued.(*a*)

26. As soon as the time for the delivery of objections shall have expired, the provisional specification, or complete specification, as the case may be, and particulars of objection, shall be referred to the law officer to whom the application has been referred.(*b*) This is termed the second reference.

The following fees are payable to the law officers and their clerks in cases of opposition :(*c*)—

[*58] *By the person opposing the grant of letters patent.

	£.	s.	d.
To the law officer, ...	2	12	6
To his clerk, ...	0	12	6
To his clerk for summons, . . .	0	5	0

The foregoing fees are paid at the office of the law officer, *at the time of the hearing* of the case of opposition.

By the petitioner on hearing the case of opposition.

	£.	s.	d.
To the law officer, ...	2	12	6
To his clerk, ...	0	12	6
To his clerk for summons, . . .	0	5	0

The fees above mentioned must be paid by the petitioner at the time of taking out the summons for hearing the objection to the patent.

27. The petitioner, or his agent, then sends a copy of the summons by post to the party opposing, or to his agent. Sending the summons by post to the address given by the party opposing, in his particulars of objections, is sufficient service. If the party opposing does not appear at the time appointed by the law officer, the applicant will be heard in his absence.

28. Up to the present time, January, 1852, it has been the custom in all cases to hear each party in private; but as the petitioner is now protected from the date of the deposit of a sufficient specification, it may

(*y*) Stat. 15 & 16 Vict. cap. 83, s. 12; first set of Rules, 1852, No. 5.
(*z*) Stat. 16 Vict.
(*a*) Stat. 15 & 16 Vict. cap. 83, s. 12; first set of Rules, 1852, No. 5.
(*b*) Stat. 15 & 16 Vict. cap. 83, s. 13.
(*c*) Order of the Lord Chancellor and M. R. 1852.

sometimes be convenient to depart from this practice, in case of concurrent applications, where both parties have deposited specifications.

29. As the provisional specification is not open to inspection till the expiration of the period of protection, there will be probably but few effectual oppositions, when the invention is only provisionally protected. In case of applications by rival inventors, it does not seem clear whether, under the new Act, the first inventor or the first applicant is to have the patent.(*d*) No patent, however, could be had, except in case of fraud, on an application first made after the deposit of a complete specification by a rival inventor.

The law officer will not go into any questions of utility. If there is any considerable doubt as to whether two inventions *are distinct [*59] the law officer will not decline to issue his warrant, but leave the matter to be afterwards determined by a court of law.(*e*)

No warrant will be granted for the stealing of any patent which contains two or more distinct substantive inventions.(*f*)

30. In case of any application for letters patent for any invention, and the obtaining upon such application of provisional protection for such invention, or of protection for the same, by reason of the deposit of a complete specification in fraud of the true and first inventor, any letters patent granted to the true and first inventor of such invention shall not be invalidated by reason of such application, or of such provisional or other protection, or of any use or publication of the invention subsequent to such application, and before the expiration of the term of such provisional or other protection.(*g*)

31. In some cases it may be necessary to get rid of the temporary privilege obtained by the deposit of a complete specification in fraud of the true inventor. Her Majesty, by warrant under her royal sign manual, may direct any complete specification, filed under the provisions of the Act, and in respect of the invention described, in which no letters patent may have been granted, to be cancelled, and thereupon the protection obtained by the filing of such complete specification shall cease.(*h*) The Act does not say how these warrants, under the sign manual, are to be obtained by an opposing petitioner, whether on the certificate of the Attorney-General, or by petition to the Lord Chancellor. As what is to be done is not merely a refusal to grant something, but involves the destruction of an existing right, it would seem that the sentence of a Court is necessary.

32. It shall be lawful for the law officer to whom any application for such letters patent is referred, if he sees fit, by *certificate under [*60] his hand, to order by or to whom the costs of any hearing, or inquiry upon any objection, or otherwise in relation to the grant of such letters patent, or in relation to the provisional or other protection acquired

(*d*) See Samuda's patent, 5 Law Times, 141.

(*e*) See Report on Patents, 1851, 386, M. R. and Solicitor-General; see in the matter of Cutler's patent, Webst. P. C. 426; ex parte Fox, Webst. P. C. 431; 1 Vesey & Beames, 67, S. C; see the recital in the warrant, post, Appendix.

(*f*) Second set of Rules, 1852, rule 7, *ante*, p. 6.

(*g*) Stat. 15 & 16 Vict. cap. 83, s. 10. (*h*) Stat. 15 & 16 Vict. cap. 83, s. 16.

by the application under this Act, shall be paid, and in what manner, and by whom such costs are to be ascertained; and if any costs so ordered to be paid, be not paid within four days after the amount thereof shall be so ascertained, it shall be lawful for such law officer to make an order for the payment of the same; and any such order may be made a rule of one of Her Majesty's Superior Courts in Westminster or Dublin, and may be recorded in the books of Council and Sessions in Scotland, to the effect that execution may pass thereon in common form.(*i*)

33. It would seem that an order for making the order of the law officer for costs, a rule of court may be obtained from a judge at chambers. A rule for such purpose would be absolute in the first instance.(*k*) Probably the costs of making the order a rule of court may be included, if an affidavit is made that the order has been served on the party and disobeyed.(*l*)

SECTION V.—WARRANT OF LAW OFFICER FOR SEALING PATENT.

34. It shall be lawful for the law officer after such hearing, if any, as he may think fit, to cause a warrant to be made for the sealing of letters patent for the said invention, and such warrant shall be sealed with the seal of the commissioners, and shall set forth the tenor and effect of the letters patent thereby authorized to be granted; and such law officer shall direct the insertion in such letters patent of all such restrictions, conditions, and provisions as he may deem usual and expedient in such grants, or necessary in pursuance of the provisions of this Act, and that the said warrant shall be for the making and sealing of letters patent under this Act, according to the tenor of the said warrant.(*m*)

[*61] *There is no appeal from a decision of the Attorney-General refusing to grant his warrant for a patent.(*n*)

A stamp-duty of £5 must be paid upon the warrant.

SECTION VI.—OPPOSITION AT GREAT SEAL.—PREROGATIVE OF THE CROWN.

35. By stat. 15 & 16 Vict. cap. 83, s. 15, the Lord Chancellor shall exercise such powers, authority, and discretion in respect to the said warrant, and the letters patent therein directed to be made under this Act, as he now has and might now exercise with respect to the warrant for the issue under the great seal of letters patent for any invention, and with respect to the making and issuing of such letters patent.

36. By stat. 15 & 16 Vict. cap. 83, s. 16, it is provided, that nothing therein contained shall extend to abridge or affect the prerogative of the Crown in relation to the granting or withholding the grant of any letters patent; and it shall be lawful for her Majesty, by warrant under her royal sign manual, to direct the law officer to withhold such warrant as

(*i*) Stat. 15 & 16 Vict. cap. 83, s. 14.
(*k*) See Wilson v. Northrop, 2 C. M. & R. 326.
(*l*) See Chitty's Archb. 1441. (*m*) Stat. 15 & 16 Vict. cap. 83, s. 15.
(*n*) In the matter of Cutler's patent, Webst. P. C. 424.

aforesaid, or that any letters patent for the issuing whereof he may have issued a warrant as aforesaid shall not issue, or to direct the insertion in any letters patent to be issued in manner therein provided of any restrictions, conditions, or provisoes which her Majesty may think fit, in addition to, or in substitution for any restrictions, conditions, or provisoes which could otherwise be inserted therein under this Act; and it shall also be lawful for her Majesty by like warrant to direct any complete specification which may have been filed under the provision hereinbefore contained, and in respect of the invention described, in which no letters patent may have been granted to be cancelled, and thereupon the protection obtained by the filing of such complete specification shall cease.

37. The Lord Chancellor may at any time refuse to affix the great seal. Persons interested in opposing the grant of a patent have a right to oppose; but opposition at this stage is discouraged, on account of the expense.

*38. Every application to the Lord Chancellor against, or in relation to the sealing of letters patent, shall be by notice; and such notice shall be left at the Commissioner's office, and shall contain particulars in writing of the objections to the sealing of such letters patent.(*o*) [*62]

When the warrant for the patent, according to the old practice, came to the Great Seal Office, notice was sent to the party who had entered the caveat. As he had already had an opportunity of opposing the patent, no more time was allowed him to give notice of opposition than was reasonably necessary to enable him to do so. Two clear days were considered sufficient for a person living at a distance from London. If in answer to the notice he stated his intention to oppose, the applicant for the patent presented a petition to the Lord Chancellor, praying that the caveat might be discharged and the patent sealed.

The allegations in the petition were verified by affidavit. The petition and affidavits were lodged in the Great Seal Patent Office. The petition was put in the paper for the next petition-day. Two clear days' notice of the hearing was given to the party opposing, who might lodge affidavits in answer to those of the applicant.

Office copies of affidavits may be obtained by either party at the Great Seal Patent Office. They will be charged for at the rate of twopence, to be paid by stamps, for every ninety words.(*p*)

39. It seems to have been the practice, where the objector has not been previously heard before the Attorney or Solicitor-General, for the Lord Chancellor, for his own information, to refer it to the Attorney-General, to inquire and report whether the letters patent ought to issue.(*q*) When a hearing before the Attorney or Solicitor-General has taken place, the Lord Chancellor will refer it to him for information as to how the matter stood when it left his office.(*r*)

Two persons severally applied for patents for the same invention; the

(*o*) Order of Lord St. Leonards, 1852. (*p*) Rules, 1852; stat. 16 Vict.
(*q*) Cutler's patent, Webst. Pat. C. 418; Favocett's case, 19 Law Times, 237.
(*r*) Ex parte Henson, re Alcock, Webst. P. C. 432. Re Prosser's patent; re Pinkus's patent, 4 Law Times, 409.

Solicitor-General reported in favour of both of them. The Lord Chancellor referred it back to the Solicitor-General, *to report whether [*63] the patents clashed, and if so, who was the first inventor, not who first presented the petition.(s)

40. The question before the Lord Chancellor is, whether there is sufficient reason for not affixing the great seal, whether he can see that the Crown has been deceived. He will not enter into any very particular inquiry whether the invention is useless. If he thinks it, or any part of it, new and the subject of a patent, he will not refuse to affix the great seal.(t) If there is any clause in the patent which the Lord Chancellor thinks improper, he will not seal it.(u)

41. When the report of the law officer, to whom the matter is referred is unfavourable to the petitioner, a second petition may be presented, supported by affidavits setting out the facts, and excepting to the report of the law officer, and upon that the Chancellor will adjudicate.(x)

Where the evidence, as to who was the original inventor, was very conflicting, the Solicitor-General reported, that the whole of the questions between the parties had better be considered in a court of law, and recommended that both patents should be sealed. The Lord Chancellor said, there must be a very strong case after that to prevent either patent passing the great seal.(y)

42. Costs may be given for or against the parties opposing at the discretion of the Court. In one case where he thought the opposition not unreasonable, Lord Eldon refused to give costs.(z) Since it has been the practice to give them, oppositions at the great seal have been much less frequent.

It has been considered not a reasonable ground of opposition, that the party entering a caveat thinks that the applicant cannot carry out his invention without using some patent of the party opposing.(a)

The taxation of costs in the absence of any special *directions [*64] will be conducted in the ordinary manner, and upon the same principles on which the taxation of costs in a chancery suit, between party and party proceeds.(b)

The Lord Chancellor has only jurisdiction to give the costs. An order for the costs, charges, and expenses of and occasioned by the caveat and opposition, is erroneous.(c)

(s) Re Griffiths' patent, re Samuda's patent, 5 Law Times, 141.
(t) Cutler's patent, Webst. P. C. 518. Ex parte Daly, Vern. & Scriven, 499; S. C. Webst. P. C. 432.
(u) Ex parte Heathcote, in re Lacy, Webst. Pat. Ca. 431; S. C. Rep. 1829, 202. Ex parte O'Reilly, 1 Vesey, 112.
(x) Cutler's patent, Webst. P. C. 410.
(y) Re Prosser's patent, re Pinkus's patent, 5 Law Times, 189.
(z) Cutler's patent, Webst. Pat. Ca. 430; S. C. 4 Mylne & Craig, 510. In re Alcock, 4 M. & C. 511. Ex parte Fox, 1 V. & B. 67.
(a) Prosser's patent, 5 Law Times, 189.
(b) Cutler's patent, 4 Mylne & Craig, 510.
(c) Coates's patent, 10 L. J. N. S. Chy. 248.

SECTION VII.—THE LETTERS PATENT.

43. By stat. 16 Vict., which repeals stat. 15 & 16 Vict. cap. 83, s. 17. all letters patent for inventions granted under the provisions of the Patent Law Amendment Act, 1852, except in the cases provided for in the fourth section, shall be made subject to the condition that the same shall be void, and that the powers and privileges thereby granted shall cease and determine at the expiration of three years and seven years respectively from the date thereof, unless there be paid before the expiration of the said three and seven years respectively, the stamp-duties in the schedule to that Act annexed, expressed to be payable before the expiration of the third year and seventh year respectively; and such letters patent, or a duplicate thereof, shall be stamped with proper stamps, showing the payment of such respective stamp-duties, and shall, when stamped, be produced before the expiration of such three years and seven years respectively, at the office of the Commissioners, and a certificate of the production of such letters patent, or a duplicate stamped, shall be indorsed by the clerk of the Commissioners on the letters patent or duplicate, and a like certificate shall be indorsed upon the warrant for such letters patent filed in the said office.

44. By the 15 & 16 Vict. cap. 83, s. 18, the Commissioners, so soon after the sealing of the said warrant as required by the applicant for the letters patent, shall cause to be prepared letters patent for the invention according to the tenor of the said warrant, and it shall be lawful for the Lord Chancellor to cause such letters patent to be sealed with the great seal of the United Kingdom; and such letters patent so sealed shall extend to the whole of the United Kingdom of Great Britain and Ireland, *the Channel Islands, and the Isle of Man; and in case such warrant so direct, such letters patent shall be made applicable to her [*65] Majesty's colonies and plantations abroad, or such of them as may be mentioned in such warrant, and such letters patent shall be valid and effectual as to the whole of such United Kingdom, and the said islands and isle, and the said colonies or plantations, or such of them as aforesaid; and shall confer the like powers, rights, and privileges, as might, in case this Act had not been passed, have been conferred by several letters patent of the like purport and effect, passed under the great seal of the United Kingdom, under the seal appointed to be used instead of the great seal of Scotland, and under the great seal of Ireland respectively; and made applicable to England, the dominion of Wales, the town of Berwick-upon-Tweed, the Channel Islands, and Isle of Man, and the said colonies and plantations, or such of them as aforesaid, to Scotland and to Ireland respectively, save as herein otherwise provided. Provided always, that nothing in this Act contained, shall be deemed or taken to give any effect or operation to any letters patent to be granted under the authority of this Act in any colony in which such, or the like letters patent, would be invalid by the law in force in the same colony for the time being.

SCOTLAND.

45. By stat. 15 & 16 Vict. cap. 83, s. 18, it is provided, that a transcript of the letters patent shall, so soon after the sealing of the same, and in such manner as the Commissioners shall direct, be transmitted to the Director of Chancery in Scotland, and be recorded in the records of Chancery in Scotland, upon payment of such fees as the Commissioners shall appoint, in the same manner, and to the same effect in all respects as letters patent passing under the seal appointed by the treaty of Union to be used in place of the great seal of Scotland, have heretofore been recorded; and extracts from the said records shall be furnished to all parties requiring the same, on payment of such fees as the Commissioners shall direct, and shall be received in evidence in all courts in Scotland, to the like effect as the letters patent themselves.

See rules for the regulation of the office in Appendix.

[*66] *IRELAND.

46. By section 29, the Commissioners shall cause a transcript of the said letters patent to be transmitted for enrolment in the Court of Chancery, Dublin, and shall cause the same to be enrolled therein; and the transcript or exemplification thenceforward shall have the like effect to all intents and purposes as if the original letters patent had been enrolled in the Court of Chancery in Dublin.

See rules in Appendix.

The effect of the above provisions is to make the patent for each kingdom distinct from that for either of the others, so that a judgment given against the English patent will not affect the Scotch or Irish record of it, but each must stand or fall by itself. See sections 29, 35.

THE COLONIES.

47. At present no patent are granted for the colonies. Patents for the colonies have hitherto passed as English patents under the great seal. They have been granted either by including them in the English patent or by an order in council extending the grant to certain colonies.(*d*) The custom has been to grant a privilege through the Privy Council, enabling patentees in the Crown colonies to deposit official copies, or authenticated copies, of the patent and specification, which are thereby made as good evidence in the colonies as the production of the originals.(*e*) This is necessary to enable the patentee to try questions of infringement in the colonial courts.

Patents may also be granted by acts of the colonial legislatures. In Canada the cost is about £7. (*f*)

(*d*) Webst. Pat. Ca. 444, 448. (*e*) Report on Patents, 1851, 65, Carpmael.
(*f*) Report on Patents, 1851, 98.

It does not appear that there is any protection of patent property in the East-India possessions.(*g*)

*SECTION VIII.—MISCELLANEOUS PROVISIONS. [*67]

Time of applying for Seal—Proceedings in case of the Death of Applicant—New Letters Patent in case of loss—Antedating Letters Patent.

48. By section 19 it is provided, that no letters patent, save as hereinafter mentioned in the case of letters patent destroyed or lost, shall issue on any warrant granted as aforesaid, unless application be made to seal such letters patent within three months after the date of the said warrant.

49. By section 20 it is provided, that no letters patent (*save* letters patent issued in lieu of others destroyed or lost) shall be issued, or be of any force or effect, unless the same be granted during the continuance of the provisional protection under this Act; or where a complete specification has been deposited under this Act, then unless such letters patent be granted during the continuance of the protection conferred under this Act by reason of such deposit, save that where the application to seal such letters patent has been made during the continuance of such provisional or other protection as aforesaid, and the sealing of such letters patent has been delayed by reason of a caveat or an application to the Lord Chancellor against or in relation to the sealing of such letters patent, then such letters patent may be sealed at such time as the Lord Chancellor shall direct.

50. By section 21, where the applicant for letters patent dies during the continuance of the provisional protection, or the protection by reason of the deposit of a complete specification (as the case may be), letters patent may be granted to the executors or administrators of the applicant during the continuance of the provisional or other protection, or at any time within three months after the death of the applicant, notwithstanding the expiration of the term of the provisional or other protection; and the letters patent so granted shall be of the like force and effect as if they had been granted to the applicant during the continuance of the provisional or other protection.

51. If the patentee dies after the sealing of the patent, the executor cannot file the specification. In most cases the *patent [*68] will be irretrievably lost. Before the passing of the Act, if an inventor died, his executor might have taken out the patent; and in some cases, on special application, an extended period appears to have been allowed for enrolling the specification,—in one case eighteen months.(*h*)

If the patentee died after the sealing of his patent, but before he had signed and acknowledged his specification, the patent was lost, but the executor might have taken out a new one if the secret had not got abroad.

(*g*) Report on Patents, 1829, 102.
(*h*) Darcy's case, Nov. 1828; Report on Patents, 1829, 24, 26, 37, 86.

52. By section 22, in case any letters patent shall be destroyed or lost, other letters patent of the like tenor and effect, and sealed, and dated of the same day, may, subject to such regulations as the Commissioners may direct, be issued under the authority of the warrant in pursuance of which the original letters patent were issued.

This provision is rendered necessary by sect. 27, which provides that no enrolment shall be necessary. With regard to patents under the new Act, there is no record in the Court of Chancery of which a constat or exemplification could be given, under the provisions of 13 Eliz. cap. 6, to prove the grant in case of the loss or destruction of the original letters patent.(*i*)

53. By section 23, any letters patent to be issued in pursuance of this Act may be sealed and bear date as of the day of the application for the same; and in case of such letters patent for any invention provisionally registered under the "Protection of Inventions Act, 1851," as of the day of such provisional registration, or, where the law officer to whom the application was referred, or the Lord Chancellor, thinks fit and directs, any letters patent may be sealed and bear date as of the day of the sealing of such letters patent, or of any other day between the day of such application or provisional registration and the day of such sealing.

Before this enactment, letters patent could not have been sealed as of a day before the date of the delivery of the warrant for the patent to the Lord Chancellor.(*k*) Hitherto, *where by reason of a caveat at the great seal delay has taken place in the sealing of letters patent, they have been generally sealed as of the day of the receipt of the privy seal bill.

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54. By section 24, any letters patent issued under this Act, sealed and bearing date as of any day prior to the day of the actual sealing thereof, shall be of the same force and validity as if they had been sealed on the day as of which the same are expressed to be sealed and bear date: provided always, that save where such letters patent are granted for any invention in respect whereof a complete specification has been deposited upon the application for the same under this Act, no proceeding at law or in equity shall be had upon such letters patent in respect of any infringement committed before the same were actually granted.

55. By section 52, letters patent may be granted in respect of applications made before the passing of this Act, in like manner and subject to the same provisions as if this Act had not been passed.

56. Stat. 15 & 16 Vict. cap. 83, s. 53, and stat. 16 Vict. cap. , s. 4, provide for the granting of letters patent for England, or Ireland, or Scotland, where patents have been granted for one or more of the three kingdoms before the passing of the first-mentioned Act. No such letters patent can be granted if the patent is already specified, or the invention used or made public in either of the three kingdoms.

57. By stat. 16 Vict. cap. , s. 7, the conditions contained in let-

(*i*) As to a constat or exemplification of a record, see 5 Co. Rep. 53 *b*, 54 *a*, Page's case.

(*k*) Stat. 18 H. 6, cap. 1; see Cutler's patent, Webst. P. C. 430; and cases in note.

tors patent granted under the Patent Law Amendment Act, 1852, and before the passing of that Act, are to be deemed complied with on payment of the stamp-duties which would have been required had the letters patent been granted after the passing of that Act. The provision requiring indorsement on the letters patent or a duplicate, and on the warrant of a certificate of the production of the letters patent, properly stamped, is to be applicable in the case of such letters patent granted before the passing of the Act.

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*CHAPTER XI. [*70]

TITLE OF PATENT.

1. THE title of the invention in the patent must agree with the invention as claimed in the specification; the language of the patent may be explained and reduced to a certainty by the specification, but the patent must not claim one thing, and the specification another.(*a*)

2. It was stated to the Committee of 1829, that few things were more difficult than to prepare a title to a patent so that it might not be so clear as to call the attention of rivals, and enable them to discover the subject, and not so obscure as to endanger the existence of the patent in a court of justice, as containing an imperfect definition of the invention described in the specification.(*b*) The grant of protection from the date of application, has now in a great measure removed this difficulty.(*c*) Still, however, an inventor is obliged to prepare the title of his patent before he can safely venture on trial of his invention. Material improvements may suggest themselves after the patentee has secured his right. The patentee may include such improvements in his specification if they are merely improved means of carrying the invention into effect. If they are distinct inventions, an attempt to include them will avoid the patent.

3. If the title is for one thing, and the specification describes another,(*d*) as a patent "for making white lead," the substance made being a white substance, like white lead, the patent is void, because there is no specification enrolled of *the invention protected by [*71] the patent. Where the title necessarily embraces more than the specification describes, the entire patent is void, because the entire discovery of all the things for which the patent is taken out, is the consideration for which the patent is granted by the Crown.(*e*)

(*a*) Epitome of the Law relating to Patents, by J. W. Smith, 19.
(*b*) Rep. on Patents, 1829, 19; per Tindal, C. J. 8 Q. B. 1065.
(*c*) Stat. 15 & 16 Vict. cap. 83, s. 8, &c.
(*d*) Turner v. Winter, Dav. Pat. Ca. 145, 155; Webst. P. C. 77.
(*e*) Bloxam v. Elsee, 6 B. & C. 169; Cook v. Pearce, 8 Q. B. 1063, Tindal, C. J.; Jessop's case, 2 H. Black. 476, 489; Rex v. Wheeler, 2 B. & A. 345; Morgan v. Seaward, 2 M. & W. 544.

4. A patent is not void simply on the ground that its title is conceived in such terms as to be capable of comprising some other invention besides that described in the specification, in the absence of any proof of fraud upon the Crown. Accordingly, the title of a patent being "for improvements in carriages," where the invention was an improvement in German shutters, which are used in some kinds of carriages only, the Court held that the title might be taken to mean improvements in some kinds of carriages, and that the patent was valid.(*f*)

The title should give some idea, and, as far as it goes, a true idea, of the invention; it is sufficient if it be consistent with it. A title for "an improved application of air to furnaces," is a good title of an invention for the use of heated air.(*g*) An invention of a means of giving paper, by the application of a certain composition, such a surface as renders the lines of copper-plate printing more distinct, is properly described as "an improvement in copper-plate printing."(*h*)

The title of a patent was "for improvements in making bobbin-net lace." The invention was a mode of making spots in it. Held good.(*i*)

Patent for "improvements in the manufacture of plaited fabrics." The invention was of a single improvement, by a combination of processes in the mode of manufacturing them. Held not to be an inconsistency invalidating the patent.(*k*)

5. The judgment of the Court of Queen's Bench, that a patent might [*72] be void, if the vagueness of the title was such as *not to disclose or point out the particular improvements for which the patent was obtained, was overruled in the Exchequer Chamber.(*l*)

The title appears to have been formerly looked at with considerable strictness. Metcalfe's patent was repealed, because a hair-brush, made with clusters of bristles of unequal length, was described in the title as "a tapering brush."(*m*)

Lord Cochrane's patent for "an improved method of lighting cities, towns, and villages," the invention being an improved lamp, particularly applicable to lighting streets, was held bad.(*n*)

So Wheeler's patent for "a new method of drying and preparing malt;" the invention being a method of roasting it after it was made, for the purpose of colouring beer.(*o*)

6. The title need not suggest the purpose of the improvements; but if a purpose is suggested, to which the invention proves not to be applicable, the patent is void.(*p*)

(*f*) Cook v. Pearce, 8 Q. B. 1044; see Macalpine v. Mangnall, 3 C. B. 512.
(*g*) Neilson v. Harford, Webst. Pat. Ca. 333, Lord Abinger.
(*h*) Sturtz v. De la Rue, 5 Russ. 322.
(*i*) Fisher v. Dewick, 8 Q. B. 1036, stated by Sir F. Pollock.
(*k*) Nickels v. Haslam, 7 M. & G. 378; see also Beard v. Egerton, 3 C. B. 122; Reg. v. Mill, 10 C. B. 379.
(*l*) Cook v. Pearce, 8 Q. B. 1044.
(*m*) Rex v. Metcalfe, 2 Stark. N. P. C. 249.
(*n*) Lord Cochrane v. Smethurst, 1 Stark. N. P. C. 205.
(*o*) Rex v. Wheeler, 2 B. & Ald. 245; see 8 Q. B. 1060.
(*p*) Felton v. Greaves, 3 Car. & Pay. 611.

Mr. Sweet, referring to the judgment of Mr. Baron Parke in Morgan v. Seaward, recommends the avoidance of the word "improvement," both in the title and specification, by way of caution; stating at the same time, that its absence would probably not save a patent, if the invention claimed in it was useless.(*q*)

7. Vagueness of title is an objection that may be taken on the part of the Crown before it grants the patent.(*r*) Should the title of a patent, applied for under the recent Act, appear too large or insufficient, the law officer to whom the application for the patent is referred, may allow or require the same to be amended.(*s*)

8. The patentee is bound in his specification to describe all the improvements in his invention which he may have made up to the time of filing his specification; but in doing so, he must be very cautious not to include any invention which cannot be comprised under the title of his patent. Should he *attempt to include a claim for such an invention in his specification, the patent will be void. In Croll v. Edge, the title of the patent was "for improvements in the manufacture of gas, and in the apparatus used when measuring and transmitting gas." The specification enrolled, recited a patent with a title "for improvements in the manufacture of gas, and in the apparatus used *therein, and* when transmitting and measuring gas." The invention, in addition to improvements in the mode of manufacturing and measuring gas, claimed a new mode of setting and manufacturing clay retorts. The patent was held void. The Court said, no one could doubt that the main claim of the specification was an improvement in the apparatus for manufacturing gas. No patent had been granted for that. They considered the enrolment of the specification as an attempt, either to remedy an oversight, or to extend the patent; and that the patentee had not specified the restricted patent which he had obtained.(*t*) [*73]

9. Evidence of a design on the part of the inventor to choose a vague and general title, in order to avail himself at the time of filing his specification of an invention not discovered at the date of his patent, such invention being different from that for which the patent was really taken out, would be evidence of fraud upon the Crown, and avoid his patent.(*u*)

10. Defects in the title may in some cases be cured by a disclaimer.(*x*) It seems that a disclaimer need not be expressly applied to the title. A disclaimer of certain parts of an invention seems to be a disclaimer of the title, so far as it is applicable to such parts.(*y*)

11. Pleas, that the patentee did not particularly describe the nature of his invention; and that the invention described is different from that for which the patent is granted, are proper to raise the question of the

(*q*) 7 Jarman, by Sweet, 503, 579.
(*r*) Cook v. Pearce, 8 Q. B. 1064.
(*s*) Stat. 15 & 16 Vict. cap. 83, s. 8.
(*t*) Croll v. Edge, 19 Law J. C. P. 261; S. C. 9 C. B. 465.
(*u*) See Cook v. Pearce, 8 Q. B. 1064.
(*x*) Stat. 5 & 6 Wm. 4, cap. 83, s. 1. See post.
(*y*) Per Jervis, C. J., and Maule, J., 10 C. B. 390, 396, Reg. v. Mill.

sufficiency of the title.(z) If the title is set out in the plea, it must be set out accurately.

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*CHAPTER XII.

SPECIFICATION.

SECTION I.—GENERAL RULES.

The Language and Construction of the Specification.

1. EVERY patent contains a condition that it shall be void, if the patentee does not particularly describe and ascertain the nature of his invention, and the manner in which the same is to be performed, by an instrument in writing under his hand and seal, within a certain time named in the patent. This period is allowed to give him opportunities of perfecting his invention by experiments, and calling to his assistance the knowledge and experience of others, in order that he may make his specification as clear, correct, and comprehensive as possible. The object of the specification is to put the public in full possession of the invention, to the end that it may be generally exercised after the expiration of the period of protection granted by the patent.(a)

2. In preparing a specification, it is necessary to examine thoroughly the existing state of the art in which the invention is made, and all improvements and inventions which have from time to time been patented, either here or abroad, or otherwise made public in the United Kingdom or colonies; to compare the new invention with all past knowledge on the subject, and to ascertain exactly in what the improvement consists. The patentee must then consider whether the invention is new in principle, that the claim may be made as large as possible, so as to prevent any adaptations of the principle by different machinery. If it is merely an old principle, carried out by new and improved machinery, the claim

[*75] *must be restricted to that which is really new in the mode of working. The invention must be defined in the clearest and plainest terms which the subject admits of; care being taken to avoid claiming principles which the patent does not show how to carry out into practice. The title of the patent must be looked to, that nothing may be claimed which does not fall within the terms of it. Nothing is to be claimed which is not new and useful. Vague generality must be avoided, lest something not new and useful should be embraced. The object and purpose of the patent should be stated, and care taken that purposes are

(z) Croll v. Edge, 19 Law J., C. P. 261; 9 C. B. 465; see Stead v. Carey, 1 C. B. 496.

(a) Per Lord Mansfield, Liardet v. Johnson, Webst. Pat. Ca. 54, n.

not stated to which the invention is not applicable. No claim should be made for any invention not indicated by the provisional specification.

3. The mode in which the invention is to be carried into practice is to be stated fully and fairly, in plain language, avoiding the use of terms which, even if scientifically correct, are not well understood in the trade to which the invention has reference. The best manner known to the patentee, of carrying out his invention at the date of filing his specification, should be stated; any improvements made by him after the time of obtaining his patent, and before specifying, should be included. Processes, and the proportions of the ingredients of any composition, must be described with the greatest certainty which the subject may admit of. The uses of all, and any part of any machinery, should be stated, and all ambiguity should be sedulously avoided.

4. No technical words are necessary to explain the subject of a patent. Objections merely formal do not affect the substantial merit of the patentee. The mere terms are not to be considered, but the real nature of the thing described.(*b*)

The language of the specification is necessarily that of the factory; the technical terms and expressions of the workshop must be used, in order that workmen may understand the description of the invention.(*c*) Mr. Spence says, "Where perversions of the natural meaning of words exist in the particular trade at the date of the patent, it is not wise to manifest any fastidious disregard of them. It may be necessary some-
*times to guard against any peculiar difficulties that may arise [*76]
in ascertaining the true nature or character of the invention, owing to the use in the trade of terms or expressions in a peculiar technical sense, widely removed from that which is their ordinary and natural meaning."(*d*)

A specification may be correct, scientifically speaking, and yet fail to inform a workman, if the terms used are such as are not commonly known in trade. A specification stated, that there was to be added to size certain proportions of the finest and purest chemical white lead. It was proved that if a workman had gone to a chemist's shop, and asked for the finest and purest chemical white lead, the answer he would have received would have been that there was no such substance known in the trade. He would then have been compelled to ask for the purest and finest white lead. The purest and finest white lead that could have been procured in London, would not have answered the purpose. The Court said, "The purest and finest chemical white lead must be taken to mean the purest and finest white lead usually gotten in the general market for that commodity. The public should have been warned, that what would be called very fine white lead, would not answer, but only white lead of a superlatively fine character."(*e*)

(*b*) Lord Kenyon, Hornblower v. Boulton and Watt, 8 T. R. 98; Boulton and Watt v. Bull, 2 H. Black. 475, 477; see Minter v. Mower, Webst. Pat. Ca. 141.

(*c*) Carpmael's Law Reports on Patent Cases, Preface.

(*d*) Spence on Specifications, 137.

(*e*) Sturtz v. De la Rue, 5 Russ. 327. This seems to have been a case of fraudulent concealment. See Report on Patents, 1829, 106.

5. A specification is not bad which is unintelligible to ordinary workmen, if it is only unintelligible because it uses scientific terms not understood by them. Lord Abinger said, "Where a specification uses scientific terms which are not understood, except by a person acquainted with the nature of the business, the specification is not bad because an ordinary man does not understand it, provided a scientific man does; but where it does not profess to use scientific terms, and an ordinary man reading the specification is misled by it, it is not good."(*f*)

6. Well-known machinery need not be described where the specification directs it to be used in carrying out the object of the patent.(*g*) In [*77] a patent for the hot blast, it *was held that the specification need not describe any precise mode of heating air. Persons who are in the habit of constructing heating apparatus, know the ordinary rules and common conditions to be attended to in heating air. It was, therefore, properly left to every one to do it in the way he might think best.(*h*)

7. A specification need not contain everything at length relating to the subject-matter, but may refer to other public instruments, or to general sources of knowledge, which any person of reasonable skill or information on the subject may be fairly presumed to know. But it should not refer to particular works, which a man may, or may not, possess.

A patent and specification being recorded, are instruments of a public nature, of which every one is bound to take notice at his peril. Where a patent recited a former patent, and stated that the patentee had invented certain improvements in the former machine, for which improvements another patent was prayed, and the specification described and figured the whole machine as improved, it was held that the recital in the letters patent of the prior patent incorporated it, and that the insufficiency of the specification of the second patent, which without such reference did not distinguish the old parts of the invention, was cured by reference to the first patent and specification.(*i*)

8. It is said to be settled that a drawing alone may be a sufficient specification.(*k*) But it is more convenient and usual to accompany the drawings by a description. Drawings are not necessary if the patentee so describes his invention as to enable artists to adopt it when the monopoly expires. If the specification can be made intelligible without them, there is no rule of law which requires models or drawings to accompany it.(*l*) If there are drawings, they are to be considered a part of the specification. The meaning of terms used may be narrowed and restricted by reference to the drawings.(*m*)

9. The letters patent and specification are to be taken together as one

(*f*) Lord Abinger, Neilson v. Harford, Webst. Pat. Ca. 341.
(*g*) Webst. Pat. Ca. 110, Crossley v. Beverley.
(*h*) The Househill Company v. Neilson, Webst. Pat. Ca. 687, 713.
(*i*) Harmar v. Playne, 11 East, 105.
(*k*) Brunton v. Hawkes, N. P. 1 Carp. R. 410, Abbott, C. J.
(*l*) Boulton and Watt v. Bull, 2 H. Black. 480.
(*m*) Barber v. Grace, 1 Exch. 339. See further, Bloxam v. Elsee, 1 Car. & Payne, 558.

instrument. The specification is always *taken to be a declaration and explanation of the title, ascertaining the nature of the grant to the patentee. By stating the object of the invention, the title may confine and limit the specification. The presumption is, that the claim is not larger than the title.(*n*) The construction of the patent to the extent of saying what the patent truly claims, is a matter of law. The Court, and not the jury, must say whether or not a patent is defective, from the patentee attempting to cover too much by his specification. [*78]

The specification may be explained by evidence of the meaning of technical words. The meaning of the words of art, and phrases used in commerce, and any facts and circumstances material to be considered for the purpose of explaining the specification, must be left to the jury.(*o*) Then it is to be left to the jury, whether, according to their judgment, there is or is not a sufficient description of the invention which the Court thinks is claimed.(*p*) It is the duty of the jury to take the construction of the instrument from the Court. All questions arising on the face of the patent and specification, except those which relate to the explanation of the terms of art employed, such as questions arising on a comparison of different parts of the specification together, or of the patent and specification, are for the Court.(*q*)

10. Patents are to be considered as bargains between the inventor and the public, to be judged of on the principle of keeping good faith, and to be construed as other bargains.(*r*) The Courts endeavour to deal fairly between the patentee and the public, reading the patent and specification so as to ascertain the meaning of the patentee, taking the whole together in a fair and candid spirit. They will not willingly deprive inventors of the advantages which their own ingenuity and talents entitle them to receive, and certainly will not be by any means astute to pick holes in specifications, though *they will take care that the discovery of the invention is fairly secured to the public.(*s*) [*79]

11. Words are to be taken as used in their ordinary and popular sense, unless the usage of the trade has fixed a peculiar meaning on the terms, or the context necessarily gives another sense than the ordinary and popular sense.(*t*) Terms of art may be explained by evidence, and it is for the jury to say in what sense they are understood in the trade.(*u*) The question is how they would have been understood at the time of completing the specification.(*x*) The facts may be such, that, applying

(*n*) Crossley v. Beverley, Webst. Pat. Ca. 117; The Household Company v. Neilson, Webst Pat. Ca. 678; Newton v. Vaucher, 6 Exch. 866.

(*o*) The Household Company v. Neilson, Webst. Pat. Ca. 678; Hill v. Thompson and Forman, 3 Mer. 626; Webst. Pat. Ca. 237, S. C.

(*p*) Neilson v. Harford, Webst. Pat. Ca. 350; ib. 370.

(*q*) Derosne v. Fairie, Lord Abinger, N. P. Webst. Pat. Ca. 156.

(*r*) Cartwright v. Arnott, Easter Term, 1800, Lord Eldon, cited 11 East, 107; Rep. on Patents, 1829, 192.

(*s*) Russell v. Cowley, Webst. Pat. Ca. 470; Neilson v. Harford, Webst. P. C. 310; Wedlake v. Gardner, 7 Law Times, 283.

(*t*) The Household Company v. Neilson, Webst. Pat. Ca. 679.

(*u*) Derosne v. Fairie, Webst. Pat. Ca. 156, Lord Abinger, N. P.

(*x*) Heath v. Unwin, 13 M. & W. 593; Crossley v. Beverley, Webst. Pat. Ca. 107; per Alderson, Heath v. Unwin, 19 L. T. 275; 16 Jur. 996.

the specification to them, the words may be construed in some secondary sense. The specification of a patent for buttons claimed the use of "soft or organzine silk, such as is used in the weaving of satin." Coltman, J. having directed the jury, in answer to a question how they are to understand the word "or," that unless the silk was organzine it was not within the patent, the Court of Exchequer Chamber held, that he should have told the jury that "or" might be construed in the sense of "otherwise," instead of disjunctively, if organzine was the only silk used in the weaving of satin.(*y*)

12. The inaccurate use of a word, if what is intended is clear, will not vitiate a specification; as the word "self-adjusting," in Minter's patent. So "baking" for "boiling," and "discoloration" for discharge of colour. So the use of a French word having another meaning in English, as "vice" for screw. It would be otherwise if the meaning was not explained by the context, or if the inaccurate expression could mislead.(*z*)

SECTION II.—THE CLAIM.

13. The object and purpose to which the patentee means to apply his patent should be kept distinct from that which is *more properly [*80] the process by which the object is meant to be attained. The mixing them together, and not keeping them separate and distinct, tends very much to obscurity in the specification.(*a*)

The plan adopted in the specification in the Electric Telegraph Company's patent for transmitting signals, was to give an account of the whole method of transmitting electric currents for the purpose of giving signals, and the modes of giving those signals, specifying afterwards the parts claimed as improvements, and either expressly disclaiming or leaving unclaimed the rest. In such a specification, the part which describes the matter claimed, is construed much more strictly than that which, though necessarily mentioned, is not spoken of as a new matter, or as the subject of the patent, but only as something known, and necessary to be referred to for the purpose of explaining the claim. The words "metallic circuits" were construed to mean all circuits metallic, as far as it was material to the improvements claimed that they should be so. The Court would not construe the expression with more strictness and precision than was necessary to enable it to fulfil the purpose of explanation for which it was introduced, not so as to narrow the claim of the patentees to signals applied to circuits exclusively metallic.(*b*)

14. The patentee must not claim anything not covered by the title of his patent. A patent was granted for certain improvements in the manufacture of gas, for the purpose of illumination, and in the apparatus used for measuring and transmitting gas. The patent having claimed a

(*y*) Elliott v. Turner, 2 C. B. 446.
(*z*) Minter v. Mower, Webst. Pat. Ca. 141; Neilson v. Harford, Webst. P. C. 369; Bloxam v. Elsee, 1 C. & P. 558.
(*a*) Gibson and Campbell v. Brand, Webst. Pat. Ca. 629, Tindal, C. J.
(*b*) The Electric Telegraph Company v. Brett and Little, 20 L. J. C. P. n. s. 123.

new mode of manufacturing and setting clay retorts, the patent was held void.(c)

15. The specification must state truly the nature of the invention. A patentee having invented a new mode of combining cotton and silk in the making of lace, by his specification claimed the exclusive liberty of making lace composed of silk and cotton mixed, the same materials having been, previously to the date of the patent, used together. The patent was held void.(d) Where the invention is of a new *combination [*81] of materials previously in use, the specification must clearly express that the patent is in respect of such new combination or application merely, and not lay claim to an original invention of the use of the materials. Supposing a previous use to have existed in the case, the specification should recite, that the materials had been in part but improperly made use of, and claim the new mode of application and use.(e)

Bramah's invention of conducting a wire through a hollow tube in a water-closet, was very ingenious and perfectly new; but the patentee having claimed the whole, and not the peculiar improvement, the patent was held void.(f) One Williams added a pipe to supply air to an old stove: the specification having embraced the whole stove, the patent was held bad.(g)

In Saunders v. Aston, the invention was an improved button, in which the flexible shank was substituted for the metal shank, by the aid of a toothed metal collet. Neither the button nor the flexible shank was new, and the operation of the collet was not claimed as the invention.(h)

16. If a person who discovers the application of a principle, and also some mode of carrying that principle out in practice, so as to attain a useful effect, claims the application of the principle, he is entitled to protection against all other modes of carrying the same principle into practice for obtaining the same result. He is not bound to narrow his claim for the purpose of defeating his privilege. Forsyth, having invented and specified the means of exploding gunpowder by detonating-powder, and pointed out certain means by which the invention might be applied, was held entitled to the exclusive application of the detonating mixture as priming, whatever the construction of the lock by which it was discharged.(i)

So Neilson, having discovered the principle, that air heated *to [*82] a high temperature was very effective in blast-furnaces, embodied his principle, by directing that it should be heated in a separate vessel, intermediately between the blowing apparatus and the point where the air entered the furnace.(k) It was held not necessary that he should claim any particular form of vessel.

(c) Croll v. Edge, 19 Law J. C. P. 261; S. C. 9 C. B. 465.
(d) Rex v. Else, Webst. Pat. Ca., 76; 11 East, 109, S. C.
(e) Hill v. Thompson, Webst. P. C. 247.
(f) Bramah v. Hardcastle, Holroyd on Patents, 81; Webst. P. C. 76.
(g) Williams v. Brodie, Webst. P. C. 75.
(h) Saunders v. Aston, 3 B. & Ad. 881.
(i) Forsyth v. Rivière, Webst. P. C. 97; per Lord Cottenham, Neilson v. Thompson, Webst. Pat. Ca. 283; Cochrane v. Braithwait, 1 Carp. R. 493, N. P.; Neilson v. Baird, Decisions of the Court of Session, 2d series, vol. vi. 51.
(k) Neilson v. Harford, Webst. P. C. 331, 372; S. C. 8 M. & W. 806; Russell v. Cowley, Webst. P. C. 463.

Watt's patent merely claimed, in general terms, that the steam was to be condensed in vessels distinct from the cylinders, though occasionally communicating with them, without particularizing the size, shape, or mode of communication with the cylinder. The patent was held good by the Court of Queen's Bench, the Court of Common Pleas having been previously equally divided upon it.(*l*)

17. But the patentee must be careful not to make his claim larger than his invention. A patent for a combination of materials and processes to form artificial stone, stated a method of making it, in the course of which alkali (American pearl-ash) was used, to be neutralized by acid (sulphuric acid). It stated that other alkalies and acids would answer, but none that that the patentee had tried, so well as those named; and claimed as the invention the processes of mixing the powdered materials, alkalies and acids, as described. It was proved, that some acids and alkalies would not answer the purpose; the Court said, if it was a claim of all alkalies and acids, it was bad, because some would not answer; if it was a claim of those only which would produce the desired effect, it was bad, for not ascertaining them.(*m*) If the claim is too general, [*83] *it precludes persons from working out inventions which have not been really made by the patentee.(*n*)

A patentee claimed specific machinery for giving a vibratory motion to the selvages of cloth, and went on to say, that it was not possible to state every method practicable in detail, but that it must be understood, that any mode of moving even one side or selvage of the cloth whilst the other remained stationary, would be considered an evasion, if for the purpose of drawing the threads into diagonal positions by mechanical means, instead of manual labour. It was urged that this claim was too large.(*o*) The test would seem to be,—Is the *principle* to be applied new? If new, then the claim may be general, and will cover any mechanical means of producing the effect. If not new, if the same thing has previously been done by manual labour, then a claim to do it by any machinery, being a claim for the machinery only, is bad.

18. If a specification speaks of the future intentions of the patentee, that part of it is not necessarily to be treated as a claim, but may be considered, according to the language of the specification, as merely theoretical. Watt's specification stated his intention, in some cases, to apply a degree of cold, not capable of reducing the steam to water, but

(*l*) Hornblower v. Boulton and Watt, 8 T. R. 95; Boulton and Watt v. Bull, 2 H. Black. 463. This case is of the highest importance, as first establishing that the wide application of a great principle may be the subject of a patent; but the specification must by no means be taken as a model, notwithstanding the verdicts in the two cases here referred to. It is said that a latitude was given to Mr. Watt in favour of his great services, which the courts have never allowed in any other case, because they took it for granted, on very insufficient evidence, that the directions were such as to enable other persons to practise the invention; but they were not so in fact. Those who wanted to practise the invention could not do it by that specification. It told them what they were forbidden to do during the term of the patent, but did not tell them how to do it. See Report on Patents, 1829, 31.

(*m*) Stevens v. Keating, 2 Exch. 772. (*n*) Rep. 1851, 96.

(*o*) MacAlpine v. Mangnall, 3 C. B. 517. See Wyeth v. Stone, ante, 9.

of contracting it considerably, so that the engines should be worked by the alternate expansion and contraction of the steam, but stated no means by which the intention could be carried into effect. Rooke, J. thought that no action could be maintained in respect of that, for he could not anticipate the protection before he was entitled to it by practical accomplishment.(*p*)

19. Where 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 substance or composition, without regard to the mechanism or process by which it has been produced, which is subordinate to the main invention, viz. the new substance.(*q*)

20. If the patentee claim a principle, while his invention is nothing more than an application of the principle by new *machinery, his patent is bad. A patentee claimed the principle of introducing [*84] fuel at the lower part of the grate, in a perpendicular or oblique direction. The principle was not new. The patent was held bad, though the application of the principle, as described and invented, was new and useful, and might have been well claimed.(*r*)

An inventor of a peculiar mode of connecting two retorts, used in the manufacture of sulphate of soda, muriatic acid, and chlorine, with each other, and with the whole apparatus for condensing, claimed "the invention of two retorts worked in connection with each other." The use of two chambers with separate furnaces not being new, the Court held that the claim embraced too much.(*s*)

A claim that the invention is the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counterbalance to the pressure on the back, is a claim of the principle. The claim was held bad, because it appeared that a chair, on the same principle, had been made and sold before; although the operation of it was encumbered by additional machinery. Had the patentee rightly described his invention, and confined his claim to an improvement on such former mode of applying the principle, his patent might have been good.(*t*)

21. If the invention is of a new combination of old parts, or a new process by means of such combination, the specification will be bad if the parts are claimed separately.

Where an invention did not consist of two distinct parts, but of a combination of old and new processes, and had in fact one entire single object only, namely, macerating flax, and spinning it, when macerated, by a machine, in which the drawing and retaining rollers were placed at a certain distance from each other, the specification having claimed the processes separately, the patent was held void.(*u*)

22. When a person obtains a patent for a machine, consisting of an

(*p*) Rooke, J. Boulton & Watt v. Bull, 2 H. Bl. 480.
(*q*) Per Eyre, C. J. Boulton and Watt v. Bull, 2 H. Black. 492.
(*r*) Rex v. Cutler, 1 Starkie, 354. (*s*) Gamble v. Kurtz, 3 C. B. 425.
(*t*) Minter v. Mower, 6 A. & E. 735; S. C. Webst. P. C. 142; see Reg. v. Bynner, 2 Law Times, 420.
(*u*) Kay v. Marshall, 5 Bing. N. C. 492; Kay v. Marshall, M. R. 1 Beav. 535; see Gibson v. Brand, 4 M. & G. 179, 199.

[*85] entirely new combination of parts, though all *the parts may have been used separately in former machines, the specification is correct in setting out and claiming the whole combination as the invention; but if a combination of a certain number of the parts of a machine has previously existed in former machines, the patentee merely adding other combinations, the specification should only claim such improvements, though the effect produced be different throughout. The combination of the parts before used should be disclaimed, and the claim restricted to the improvements invented.(*x*)

23. The invention must be described in such a manner as to lead people clearly to know in what the invention consists.(*y*) The specification must point out correctly what the invention is, in order that the public may know what is the prohibited manufacture. They are entitled to this knowledge, in order that they may be saved inconvenience. If it is left ambiguous in respect of what the privilege is claimed, the patent is bad.(*z*) Unlearned men look at the specification, and suppose everything they find there is new. If the whole is not new, it is hanging terrors over them.(*a*)

24. The specification should clearly define the limits of the new invention, and strictly confine the claim to that which is really novel; for if the patentee by his specification states simply the whole machinery which he uses, and claims the whole as new, and does not expressly or intelligibly restrict his claim to some particular part, or to the combination of the whole, his patent must be taken to be a patent for the whole and for each particular part, and will be void if any particular part turns out to be old, or the combination itself not new.(*b*)

25. But it is not necessary that it should do so in express terms. In ascertaining whether a specification claims a combination, or the whole [*86] and every part of a machine, the whole *specification must be read together with candour and indulgence, to see what really is claimed and described as the invention; it must be read as a person of ordinary understanding would read it, and not scanned, word by word, as a plea would be.(*c*) If, taking the whole specification together, and giving its words a fair and reasonable interpretation, the Court can see that the specification only claims the improvement on the old machine, it will be sufficient.(*d*)

Thus, if known machinery is referred to as such, is not described with particularity, and is spoken of or treated as well understood, while the new machinery is described in great detail, and from the object of the patent as stated, or any other expressions in the patent, the Court can

(*x*) Bovill v. Moore, 2 Marsh, 211; see Allen v. Rawson, 1 C. B. 551.

(*y*) Morgan v. Seward, Webst. Pat. Ca. 173; Jupe v. Pratt, Webst. P. C. 145; Holmes v. London and North-Western Railway Company; 20 Law Times, 112, C. P.

(*z*) Per Lord Cottenham, Neilson v. Thompson and Forman, Webst. P. C. 283; Macfarlane v. Price, 1 Starkie, 199.

(*a*) Bramah v. Hardcastle, Webst. P. C. 76, n.

(*b*) Bovill v. Moore, Dav. P. C. 361; per Lord Abinger, Carpenter v. Smith, Webst. P. C. 532; cited 5 Exch. 322.

(*c*) Sellers v. Dickinson, 5 Exch. 312.

(*d*) MacAlpine v. Mangnall, 3 C. B. 515.

see that the new machinery is distinguished from the old, the patent will be upheld.(*e*)

26. Evidence is not admissible to explain and support the patent, by showing what the specification claims as new. The nature of the claim must be determined by the specification alone.(*f*)

SECTION III.—DESCRIPTION OF THE MANNER IN WHICH THE INVENTION IS TO BE PERFORMED.

27. The invention must be specified in such a way as 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. It must put the public in possession of the secret, in as ample and beneficial a way as the patentee himself uses it. The patent is the reward for the patentee's disclosure of his invention. Unless, therefore, the discovery be true and fair, or if the specification be in any material point false or defective, the patent cannot be supported.(*g*)

28. If two or more inventions be comprised in one patent, [*87] *and either be insufficiently specified, the whole patent fails. 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.(*h*)

29. The description of the manner in which the invention is to be performed is to be such that if fairly followed out by a competent workman, without invention or addition, would produce the manufacture for which the patent is taken out.(*i*) In Arkwright's case, the specification described the several parts of improved machines for preparing silk, cotton and wool for spinning. It did not describe the entire machines as put together. It was impossible to say how they were to be made. There were no sufficient directions to enable a workman to put the parts together. Witnesses prove that it could not be done from the written specification; that the machine in a complete state was easy to describe, but that if they had hit upon the same machine as that invented, they should not have known it to be such from the written description.(*k*)

30. If a specification contain an untrue statement in a material circumstance, of such a nature that, if literally acted upon by a competent workman, it would mislead him, and cause the experiment to fail, the specification is bad and the patent is invalidated.(*l*)

(*e*) Haworth v. Hardcastle, Webst. Pat. Ca. 484; 1 B. N. C. 182; Nickells v. Ross, 8 C. B. 679; see, as to the latter case, Reg. v. Nickles, Hindmarch on Patents, 186.

(*f*) Nickels v. Ross, 8 C. B. 702, 722; Reg. v. Nickels, Hindmarch on Patents, 188; Macfarlane v. Price, 1 Starkie, 179.

(*g*) Rex v. Arkwright, Dav. Pat. Ca. 106. Buller, J.

(*h*) Morgan v. Seaward, Webst. P. C. 173.

(*i*) Neilson v. Harford, Webst. P. C. 371.

(*k*) Rex v. Arkwright, Dav. P. C. 106, 114.

(*l*) Neilson v. Harford, Webst. P. C. 371; see Beard v. Egerton, 2 C. & K.; S. C. 8 C. B. 201, 212, per Wilde, C. J.; Turner v. Winter, Dav. Pat. Ca. 154; S. C. 1 T. R. 602.

Thus, if a whole class of substances are stated as fit to be employed as carrying out the invention, and one of the class will not answer, the patent will be avoided. A safety-fuze was to be made with a centre of gunpowder, or other proper combustible matter, prepared in the usual pyrotechnical manner of fireworks, for the discharge of ordnance. Had it been proved that port-fire would not have answered, the patent would have failed.(*m*)

If several modes of operation are described as a mode of welding [*88] tubes, by passing them between rollers over a mandrel, *and also through dies and over a mandrel, and either does not answer, the whole patent is bad, because a person reading the specification might be led to use machinery which would fail of its purpose.(*n*)

31. Where the use of any substance in a particular state is directed, if an ordinary practical man cannot obtain it in that state, the specification must show him how to do so. The specification of a patent for refining sugar by filtration of the syrup of cane-juice through charcoal, made by the carbonization of bituminous schistus, stated that it was convenient, before the carbonization, to separate the sulphurets of iron which which were mixed with it. It was proved that sulphurets of iron were found combined mechanically with the ordinary bituminous schistus found in this country, and evidence was given to show that its presence was injurious. It was held to be incumbent on the patentee, either to show that the presence of iron was not injurious, or that the schistus known in England could be used with advantage, or that the method of extracting the iron was so simple that a person ordinarily acquainted with the subject might remove it with ease.(*o*)

32. It must enable a person reading it to construct a machine fitted for all the useful purposes suggested. A specification of a machine for sharpening knives and scissors, directed the edges should be passed backwards and forwards, in an angle formed by the intersection of two circular files. It stated that other materials might be used, according to the delicacy of the edge. It was proved that for scissors there ought to be one circular file, and a smooth surface, but two Turkey-stones might also succeed: the specification was held bad, as it neither directed the machine for scissors to be made with Turkey-stones, nor a circular file and a smooth surface.(*p*)

33. If the information communicated by the specification would be sufficient in all ordinary cases, or such cases as are likely to occur, that is sufficient. The possibility of suggesting theoretically a case in which it would be impracticable to carry out the direction in the specifi- [*89] cation, if no such case *would be likely to occur in practice.(*q*) The question left to the jury by Baron Alderson in Morgan v. Seaward, was, "If a man ordered a paddle-wheel with floats to be set *at*

(*m*) Bickford v. Skewes, Webst. P. C. 214; 1 Q. B. 938; Stevens v. Keating, 2 Exch. 778.

(*n*) Reg. v. Cutler, 3 C. & M. 215.

(*o*) Derosne v. Fairie, 1 C. M & R. 476; Webst. P. C. 168.

(*p*) Felton v. Greaves, 3 C. & P. 611.

(*q*) Morgan v. Seaward, Webst. P. C. 180, Alderson, B.; Neilson v. Baird, Decisions of the Court of Session, 2nd series, vol. vi. 51.

any angle likely to be required on entering and going out of the water, and vertical at the bottom, could an ordinary workman of competent skill execute the order by following the directions in the specification?"

34. A defect in the specification will not be cured, though a man ordinarily acquainted with the particular trade, applying his general knowledge to the description in the specification, would not be misled. This would be to support the specification by a fresh invention.(*r*) A patent for dressing cloth directed the use of a hollow roller so contrived as to inclose the list, or forrel (the draughtsman having apparently confounded forrel, or end, with the list, or selvage). Scientific witnesses having proved that they did not know how such a roller could be contrived, the patent was cancelled.(*s*)

35. Mere inaccuracy in a drawing may not be fatal. The whole specification must be read together, and such a construction put upon it as will support a patent, if it can be fairly done. An ambiguous direction, which if followed literally, would render the whole experiment fruitless, will not vitiate the patent, if taking the whole specification together, it is capable of another sense, and a person of fair intelligence would not be misled by it.(*t*)

36. Every specification must describe the invention in the clearest and most unequivocal terms of which the subject admits; and if it appears that there is any unnecessary ambiguity affectedly introduced, or anything which tends to mislead the public, the patent is void. James's patent stated, that a yellow colour would be produced by calcining the lead after the alkali had been separated from it, till it should acquire the colour wanted. It was proved to be necessary that the lead should be fused. It was said that the specification directed the heat to be continued till the effect was *produced. The Court said, it should have shown by what degree of heat the effect was to be produced. [*90] Fusion was not mentioned; indeed, by mentioning calcination, it seemed that fusion was to be avoided.(*u*) The patent was held bad.

The specification of a patent for making seidlitz powders gave three distinct recipes for preparing the ingredients being three common processes for preparing well-known substances, which might have been procured in any chemist's shop. Abbott, C. J., said, people were led to suppose a laborious process necessary to the production of common things. The public were misled by the specification.(*v*)

37. The patentee is bound to give to the public the most improved state of his invention. If he can make the article with cheaper or better materials than those specified, his patent is void because he does not enable the public to derive the same benefit that he himself does.(*w*) If he withholds any information that is of importance, his patent is avoided.

(*r*) Neilson v. Harford, Webst. P. C. 371. Parke, B.; see Morgan v. Seaward Alderson, B. N. P. Webst. P. C. 176.

(*s*) Rex v. Fussell, 1 Carp. R. 449. (*t*) Beard v. Egerton, 8 C. B. 165.

(*u*) Turner v. Winter, Dav. P. C. 145; Galloway v. Bleadon, Webst. P. C. 524, Tindal, C. J.

(*v*) Savory v. Price, Ryan & Moody, 1.

(*w*) Turner v. Winter, Dav. P. C. 154; S. C. Webst. P. C. 81.

Zinck had a patent for making verdigris. He was accustomed to put aquafortis into his boiler, but did not mention it in his specification. The aquafortis enabled him to make the verdigris with less labour. Gibbs, C. J., said it was a prejudicial concealment.(*x*)

If in the description of the mode of carrying out the invention, things are mentioned which are unnecessary, if they are thrown in for the purpose of puzzling people who read the specification, the patent is void.(*y*)

In making steel trusses, the patentee was in the habit of using tallow in tempering the steel. Having omitted to state it in the specification, his patent was held void.(*z*)

The omitting to mention anything which the patentee knows to be useful, though it relates only to the degree of utility, as partitions in a cylinder for heating air for a hot-blast furnace, will be fatal to a patent.(*a*)

[*91] 38. If the application of a principle is claimed, the specification *must point out at least one mode in which the invention can be carried into effect. If that is done, and the patentee honestly discloses the best mode with which he is acquainted, and the apparatus so constructed is of some value, the specification is sufficient. The greatest improvements subsequently made will not affect its validity. The specification of a patent for the application of the hot blast to furnaces, the air under blast being heated at a particular stage of the process, not claiming any as the best contrivance for heating the air, but merely pointing out one which was stated not to be material to the useful effect, was held to be good, though it turned out afterwards, that this form was very inferior to those which persons in the trade, using the invention, ultimately adopted. The only question for the jury was held to be—will any contrivance which heats the blast produce that beneficial effect? Supposing the mode described not to be perfect in its details (in the case above mentioned the hot blast had a tendency to destroy the furnace, and the old dry twires in use at the time of its adoption), the question is, does the evidence show that without improvement the invention, as described, is of no practical utility?(*b*)

39. If the patentee knows that any particular substance will not answer, he should say so, and not leave it to be inferred that it may be used. A patentee stated, that a cloth for conducting paper might be made of any suitable material, but that he preferred it made of linen warp and woollen weft, knowing at the time that no other cloth would answer. The patent was held void.(*c*)

40. The specification must embrace all the patentee's discoveries and improvements in the mode of carrying the invention into effect, up to the day of completing the specification.(*d*).

(*x*) Wood v. Zimmer, Holt's N. P. C. 60; Webst. P. C. 83.

(*y*) Rex v. Arkwright, Davie's Pat. C. 118; Webst. P. C. 69.

(*z*) Liardet v. Johnson, Bull. N. P. 76. See Morgan v. Seaward, per Alderson, B. Webst. P. C. 174.

(*a*) Neilson v. Harford, Webst. P. C. 337.

(*b*) The Househill Company v. Neilson, L. J. C. Hope, Webst. P. C. 694, 696.

(*c*) Crompton v. Ibbotson, Danson & Lloyd, 33; Webst. P. C. 83.

(*d*) Jones v. Heaton, Webst. P. L. 13.; Webst. P. C. 404, n. per Lord Mansfield. See Webst. P. C. 54, note *c*.

Time is allowed that the patentee may make experiments, and have an opportunity of calling to his assistance the knowledge of others on points where his learning or practice falls short.

If a person, at the time of applying for a patent, has in his [*92] *mind an invention capable of producing the proposed effect, and has brought it to a degree of perfection, and afterwards, within the time allowed by the specification, renders it more complete by the introduction of improved mechanical contrivances for carrying into effect the same principle in parts of his machine, that will not make the patent void. Not only is he at liberty to introduce these improvements into his specification, but it his bounden duty to do so. A patent was obtained for a gas-meter. After the grant of the patent, and during the interval allowed for specifying, the patentee made an improvement in the manner of sealing the ends of the induction and eduction pipes, by buckets and hoods. The meter was merely rendered more complete by the introduction of improved machinery. It was held that the patentee was right in specifying this improvement. No deception was practised on the Crown because the inventor had discovered, and the intention of the Crown was to grant a patent for an improved gas apparatus.(*e*) We have already seen that no distinct substantive invention, made subsequently to the grant of the patent, can be included.

41. The mode of operation must be ascertained with the greatest degree of precision that the subject reasonably admits of. A specification for the composition of a medicine, must state the proportions of the drugs employed. That of Dr. James's powder, for fevers, mentioned only the articles of which the powders were composed, and omitted to mention the relative proportions and quantity. No patent could stand on such a specification.(*f*)

If a patent is for a particular combination of ingredients already in use, the relative proportions and quantities should be ascertained.(*g*)

42. If the patent is for a process, a certain and precise process must be described. It will be bad if it does not state for what length of time the process is to be continued, or give some other criterion for ascertaining when, or by what intensity of operation, the effect intended will be produced.(*h*)

*But it is sufficient if the process be described with as much [*93] accuracy as the subject reasonably admits of, and if a criterion, the best according to the knowledge of the inventor, is pointed out. In the patent for the daguerreotype process, in describing the second operation, the specification alleged that the time necessary for the operation could not be stated, because it depended upon several circumstances; but there was a direction that the plate should be kept in the iodine box till it assumed a golden-yellow tint. The Court thought the direction sufficiently plain to be understood by an operator of fair intelligence.(*i*)

(*e*) Crossley v. Beverley, Webst. P. C. 118, at Nisi Prius.
(*f*) James's patent, per Lord Mansfield, cited Webst. P. C. 54, note *e*.
(*g*) Hill v. Thompson, 8 Taunt. 382; S. C. Webst. P. C. 243, citing Turner v. Winter, Webst. P. C. 77.
(*h*) 2 B. & Ald. 353. Rex v. Wheeler. (*i*) Beard v. Egerton. 8 C. B. 206, 216.

43. Where a general rule is given for the proportions of the ingredients in a composition of matter, it has been held, in the Supreme Court of the United States, that the specification may direct the use of other and variable proportions in exceptional cases, according to the quality of the ingredients employed, though the proportions can only be exactly known after the particular qualities of the ingredients have been ascertained. If the qualities of the ingredients generally differ so widely that the rule given is of no value, or if the improvement cannot be used without ascertaining in every case by experiment the proportions to be employed, the invention is not patentable; if otherwise, the specification is sufficiently certain.(*k*)

44. The relative proportions of the parts of machinery should be pointed out. In Arkwright's patent, one pair of rollers appeared to be something smaller than the other, but how much, or what were to be the relative dimensions, the specification did not state.(*l*) There should be a scale or something to enable the workman to form an idea of the relative dimensions of the parts. So it seems that in the specification of a patent for a screw propeller, consisting of sections of a complete screw, the specification should define what section, as whether half or a sixteenth of an entire turn of the screw, is proper to be used.(*m*)

[*94] 45. If ingredients are directed to be used in a composition, *and the articles which would probably be supplied to a purchaser at a shop in this country, as being those mentioned, are inferior for the purpose of the patent, to others which are only ordinarily procurable abroad, the patentee in the specification should state where they are to be procured of the best description for the purposes of the patent.(*n*)

46. A patent which casts upon the public the expense and labour of experiments and trial, is undoubtedly bad.(*o*) Artists of the same trade must be enabled to do the thing for which the patent is granted, without any new inventions or additions of their own.(*p*) If it be said that the mode of carrying out the process, though not ascertained, will be well and easily known to a person of competent skill, the inventor will not in reality have given any useful information to the public.

The specification of a patent for paving-blocks in the form of two solid rhombs, placed one in front of each other in opposite directions, so that each side of one of the blocks was levelled both outwards and inwards. The angle of the bevel was not stated. Lord Abinger said, unless the jury thought any angle less than a right angle be sufficient, the specification was bad, as experiments would be rendered necessary.(*q*)

47. The specification ought to be framed so as not to call on a person to have recourse to more than the ordinary means of knowledge (not invention), which a workman of competent skill in his art and trade may be presumed to have. It may call upon him to exercise all existing

(*k*) Wood v. Underhill, 5 Howard's S. C. R. 1, cited Curtis on Patents, 169.
(*l*) Rex v. Arkwright, Dav. P. C. 108, 112, 122.
(*m*) See Lowe v. Penn, 7 Law Times, 203, Q. B.
(*n*) Sturtz v. De la Rue, 5 Russ. 327; Derosne v. Fairie, Webst. P. C. 157.
(*o*) Rex v. Wheeler, 2 B. & Ald. 349, 353.
(*p*) Rex v. Arkwright, Dav. P. C. 106; Webst. P. C. 66.
(*q*) Macnamara v. Hulse, 1 Car. & Mar. 471.

knowledge common to the trade, but nothing more.(r) It need not be so circumstantial or so explanatory, that persons entirely ignorant of the elements of the science to which the subject belongs, may thereby alone be able to learn and use the invention, nor, on the other hand, should the description be so concise as to become obscure. It must be intelligible and useful to persons of moderate knowledge of the art to which it relates. If a person having *a little knowledge of the [*95] science which led to the invention, can immediately see the method pointed out, and easily apprehend it without study, without any invention of his own, and without experiments, the disclosure is fully and fairly made.(s) In the case of Watt's patent, the jury found that the specification was of itself sufficient to enable a mechanic acquainted with the fire-engines previously in use, to construct fire-engines producing the effect of lessening the consumption of fire and steam, upon the principle invented by Watt.(t) In Arkwright's case it was held, that it was sufficient if persons conversant with machinery, having the machine in its unimproved state described to them, could construct the newly-invented machine from the description in the specification.(u)

48. The specification is addressed to those employed in making the apparatus to which it refers, but not to common labourers, or workmen employed under those who furnish and construct such apparatus, or any person, not a person of skill, conversant with the trade.(x) No sort of specification would enable a ploughman, utterly ignorant of the whole art, to make a watch.

Speaking of the specification of the hot-blast apparatus, Lord Justice Clerk Hope said,—"The condition is not satisfied if men of the greatest science, first-rate engineers even, understand it, and would know what to do or what instructions to give. The specification is for the benefit of trade when the patent is out,—it is addressed to those engaged in particular departments of trade, and who are to be employed in the trade when the patent is out; those who are competent to make similar apparatus for similar purposes. But the question is not as to common labourers or workmen employed under those who construct such apparatus. Such is the subdivision of labour, that in many trades, the most skilful [*96] *workmen, one conversant only with parts and portions of machines, could not put together an entire machine."(y)

49. It is not sufficient if, after several trials and conversation with persons employed by the patentee, or having seen the patentee's machine, a mechanic is able to construct the machine from the specification, so as to

(r) Morgan v. Seaward, Webst. P. C. 174, Alderson, B.; Galloway v. Bleadon, Webst. P. C. 524.

(s) Per Sir J. Campbell, arg. Neilson v. Harford, Webst. P. C. 306; per Parke, B. ib. 314. The Houschill Company v. Neilson, Webst. P. C. 692.

(t) Boulton v. Bull, 2 H. Black. 463.

(u) Arkwright v. Nightingale, Webst. P. C. 60; Dav. P. C. 37. See Harmar v. Playne, 11 East, 107.

(x) Alderson, B. Webst. P. C. 174, Morgan v. Seaward; Elliot v. Aston, Webst. P. C. 224, Coltman, J.; Harmar v. Playne, 11 East, 108.

(y) The Houschill Company v. Neilson, Webst. P. C. 692.

produce the useful effect.(z) An engineer who has been employed by the patentee in making models, should be asked, could he, with his ordinary knowledge and skill, without the peculiar knowledge he has attained on the subject, construct the engine from the specification?(a)

50. The intelligibility of the specification is a question for the jury: so also is its fairness and sufficiency.(b) It is not necessary that a process described in the specification should have been actually tested. The evidence of scientific persons, that in their opinion it would or would not answer, is sufficient, and the jury may, if they please, rest on that evidence; but it is more satisfactory, that the invention, if alleged to be imperfect, should be tested by experiment; and if the experiment is not made, it may lead to the suggestion or belief, that the party impugning it abstains from causing the experiment to be made, because he knows it will answer too well.(c)

SECTION IV.—FILING. ENROLMENT.

51. All letters patent to be granted under the Patent Law Amendment Act, 1852, require the specification to be filed in the High Court of Chancery. No enrolment is to be necessary.(d)

Before the 1st of January, 1849, specifications were enrolled in the Petty Bag Office, the Rolls Chapel Office, or the Enrolment Office. Since
[*97] that time, by stat. 11 & 12 Vict. cap. 94, s. 14, which was re-enacted by stat. 12 & 13 *Vict. cap. 109, s. 15, specifications have been enrolled in the Enrolment Office in Chancery. The original specifications were returned to the patentee, a copy, with the date of the enrolment, being made on the roll. A certificate of the date of the enrolment was written on the specification returned to the party. The expense of making the copy on the roll, which was considerable, will now be saved.

All specifications to be filed in pursuance of the conditions of letters patent, and all complete specifications accompanying petitions and declarations, before grant of letters patent, shall be filed in the Great Seal Patent Office.(e)

52. Under the Patent Law Amendment Act, all specifications in pursuance of the conditions of letters patent, and all complete specifications accompanying petitions for the grant of letters patent, shall be respectively written bookwise upon a sheet or sheets of parchment, each of the size of twenty-one inches and a half in length, by fourteen inches and three-fourths of an inch in breadth; the same may be written upon both sides of the sheet, but a margin must be left of one inch and a half on every side of each sheet.(f)

(z) Rex v. Arkwright, Webst. P. C. 67.
(a) Morgan v. Seaward, Webst. P. C. 180.
(b) Hill v. Thompson and Forman, Lord Eldon, Webst. P. C. 237; 3 Mer. 626, S. C. Galloway v. Bleadon, Webst. P. C. 524.
(c) Neilson v. Harford, Webst. P. C. 316, Parke, B.: Reg. v. Steiner, Lord Campbell, Times, Dec. 6, 1851.
(d) Stat. 15 & 16 Vict. cap. 83, s. 27.
(e) Stat. 15 & 16 Vict. cap. 83, s. 28. Order of Lord St. Leonards, 1852, 1.
(f) Order of Lord St. Leonards, 1852, 2.

In case reference is made to drawings in any specification deposited or filed under the Act, an extra copy of such drawings shall be left with the specification.(*g*)

The drawings accompanying such specifications shall be made upon a sheet or sheets of parchment, each of the size of twenty-one inches and a half in length, by fourteen inches and three-fourths of an inch in breadth; or upon a sheet or sheets of parchment, each of the size of twenty-one inches and a half in breadth, by twenty-nine inches and a half in length, leaving a margin of one inch and a half on every side of such sheet.(*h*) The Lord Chancellor recommends applicants and patentees to make their elevation drawings according to the scale of one inch to a foot.

Specifications enrolled in Chancery are subject to a stamp-duty of £5. and a progressive duty of 10s. upon every entire quantity of 1,080 words over and above the first 1,080 *words:(*i*) but as this duty only applies to specifications to be enrolled or recorded, it will not be payable on specifications to be filed under the Patent Law Amendment Act. A stamp-duty of £5 is, however, payable on filing the specification.(*k*) [*98]

53. After the sealing of letters patent, the time for specifying mentioned therein cannot be enlarged except by Act of Parliament.(*l*) The time is to be reckoned exclusively of the first day, and inclusively of the last.(*m*) The specification may be left at the office at twelve o'clock at night on the last day. It was held sufficient if the specification was delivered to be enrolled, though it was not actually enrolled till a subsequent day.(*n*) Once deposited in the office, the specification becomes a public document. The clerk of the enrolments cannot receive it conditionally. Accordingly, the late Master of the Rolls refused to vacate or cancel the enrolment of a specification left at the office and enrolled by the clerk, contrary to directions not to enrol it till further order.(*o*)

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*CHAPTER XIII. [*99]

DISCLAIMER AND AMENDMENT.

SECTION I.—BY STATUTE.—MODE OF ENTERING

1. We have seen that if an objection is sustained against any one of

(*g*) 15 & 16 Vict. cap. 83, s. 28.

(*h*) Order of Lord St. Leonards, 1852, 3. See ante, p. 52.

(*i*) Stat. 55 Geo. 3, cap. 184, schedule, tit. "Specification." Stat. 13 & 14 Vict. cap. 97, schedule, tit. "Progressive Duty."

(*k*) Stat. 16 Vict. cap. , schedule.

(*l*) Ex parte Hoops, 6 Vesey, 598; S. C. nom. Ex parte Koops, Rep. 1829, p. 192.

(*m*) Watson v. Pears, 2 Camp. 294; Derosne v. Fairie, Webst. P. C. 154, Lord Abinger; 14 M. & W. 582, Russell v. Ledsam.

(*n*) Com. Dig. Patent, E.

(*o*) Ex parte Brough, 7 Beav. 104.

many important inventions, included in the same patent, the whole patent is avoided. In such cases, amendments may now be made by a disclaimer of the part of the invention to which such objections apply.

Statute 5 & 6 Wm. 4, cap. 83, s. 1, amended by 12 & 13 Viet. cap. 109, s. 15, and extended to patents granted under the Patent Law Amendment Act, by statute 15 & 16 Viet. cap. 83, s. 39, for the better protecting the rights of patentees, and the more ample benefit of the public from letters patent, enacts, that any person who, as grantee, assignee, or otherwise, hath obtained, or shall obtain, letters patent, may, if he think fit, having first obtained the leave of the Attorney-General or Solicitor-General, in case of an English patent, or the Lord Advocate or Solicitor-General of Scotland in case of a Scotch patent, or of the Attorney-General or Solicitor-General for Ireland, in case of an Irish patent, certified by his fiat and signature, enter a disclaimer of any part either of the title of the invention, or of the specification, stating the reason for such disclaimer. The patentee may, with such leave as aforesaid enter a memorandum of any alteration in the said title or specification.

It is provided that the disclaimer, or memorandum of alteration, must not be such as to extend the exclusive right granted by the letters patent.

On the disclaimer, or memorandum of alteration, being duly entered as prescribed by the several statutes, it is to be *deemed and taken [*100] to be part of the letters patent and specification in all courts whatever.

2. Disclaimer and memorandums of alteration were by the first-mentioned statute, to be entered with the clerk of the patents of England, Scotland, or Ireland respectively, and enrolled with the specification. A reference to the enrolment of the disclaimer was made upon the enrolment of the specification.

3. As to disclaimers and memorandums of alteration enrolled after the 1st of January, 1849, by statute 11 & 12 Viet. cap. 94, s. 14, which was re-enacted by 12 & 13 Viet. cap. 109, s. 15, disclaimers and memorandums of alteration are to be enrolled in the Enrolment Office, whether the specification of the invention to which such disclaimer or memorandum of alteration relates has, or has not, been enrolled in the said Enrolment Office.

4. As to disclaimers and memorandums of alteration of patents granted under the Patent Law Amendment Act, 1852, statute 15 & 16 Viet. cap. 83, s. 39, enacts that every disclaimer or memorandum of alteration shall be filed in the office appointed for filing specifications in Chancery under that Act, with the specification to which the same relates, in lieu of being entered or filed, and enrolled as required by the Act of 5 & 6 Wm. 4, cap. 83, or 12 & 13 Viet. cap. 109. This section appears to apply only to disclaimers relating to specifications filed under the Patent Law Amendment Act.

5. The Attorney-General, or Solicitor-General, or Lord Advocate, before granting his fiat for the entry of a disclaimer or memorandum of alteration, may 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 re-

quire such advertisement, certify in his fiat that the same has been duly made.(*a*)

6. As to patents, before the Patent Law Amendment Act, 1852, any person may enter a caveat against a disclaimer or alteration, in like manner as caveats are now used to be entered; 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.(*b*) The fee is five shillings on each caveat.

*Caveats should be entered at the chambers of each of the law officers. [*101]

7. By rules made shortly after the passing of the Act 5 & 6 Wm. 4, cap. 83, 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 should be accompanied by a copy of the original specification, and of the proposed disclaimer or alteration.

If on the hearing, the Attorney-General 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 that purpose, he will put his signature to the fiat authorizing the clerk of the patents to make the required enrolment.

If it appear to the Attorney or Solicitor General that any 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. 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.

The fiat must be written or engrossed on the same parchment with the disclaimer or alteration at the foot thereof.

8. With regard to disclaimers and memoranda of alteration under the Patent Law Amendment Act, 1852, section 39 provides, that applications for leave to enter a disclaimer or memorandum of alteration shall be made, and all caveats relating thereto shall be lodged at the office of the Commissioners, and shall be referred to the law officers mentioned in 5 & 6 Wm. 4, cap. 83, s. 1.

The application for leave to disclaim must be impressed with a stamp of £5; a caveat with a stamp of £2.(*c*)

9. The practice has hitherto been to have two copies of the disclaimer, one on parchment and the other on paper, both of which were signed by the Attorney or Solicitor General. The one on paper was deposited with the clerk of the patents; *the one on parchment was usually acknowledged before the proper officer in Chancery, and then enrolled. [*102]

It seems that the person entering the disclaimer is not bound to enter

(*a*) Stat. 5 & 6 Wm. 4, cap. 83, s. 1. (*b*) 5 & 6 Wm. 4, cap. 83, s. 1.
(*c*) Stat. 16 Vict. cap. , schedule.

the original document, signed by the Attorney-General: the entry of a copy is sufficient.(*d*)

10. No appeal lies to the Master of the Rolls from the decision of the Attorney-General in allowing a disclaimer or memorandum of alteration.(*e*) The law officers are liberal in permitting the entry of disclaimers and memorandums of alteration. If the disclaimer or memorandum of alteration entered in pursuance of such leave is not such as is warranted by the statute, it is simply void.

11. If a disclaimer is entered in fact, in order to raise the point that such disclaimer is not in accordance with the statute, the facts must be brought before the Court, by a plea confessing the entry of the disclaimer in fact and alleging the circumstances, showing that it is not an entry made in accordance with the statute. Under a plea setting out the facts and concluding with a special traverse of the entry of the disclaimer, according to the statute, nothing is put in issue except the entry of the disclaimer in point of fact.(*f*)

12. It has been questioned, but apparently without good reason, whether, after the entry of one disclaimer, the patentee can further amend his specification by a second. Such entries have been permitted by the law officers.(*g*)

13. A disclaimer or memorandum of alteration may be entered after the verdict for the Crown, on a scire facias. In such case the patentee should apply to the Court to suspend its judgment, or to the Attorney-General to stay the proceedings, in order to give him time to disclaim.(*h*) See post, "Scire Facias."

14. It was urged in The Queen on the prosecution of Davis v. Mill, that if the title of a patent is too large for the inventions specified, when those disclaimed have been struck out, the patent would be avoided.(*i*) The Court thought that the *title was not too large, and therefore [*103] did not decide the point; but Jervis, C. J. said, "It is doubtful whether in truth the disclaimer, when properly read, is a disclaimer of the specification only. It adverts to an infirmity which may apply to the title as well as to the specification, and proceeds to disclaim those parts of the invention described in the specification as being the fifth, sixth, seventh, and eighth parts of the said invention. That may be a disclaimer of the title so far as it is applicable to those parts."

15. The question who is the proper person to enter a disclaimer in cases where the patent has been assigned, has been much debated. In the first case on the subject, it was said that the person authorized to disclaim was the original grantee, though he might have parted with all his interest, if the Attorney and Solicitor General consented.(*k*)

16. In order to obviate such difficulties, statute 7 & 8 Vict. cap. 69,

(*d*) Wallington v. Dale, 6 Exch. 285.
(*e*) Sharp's patent, Ex parte Wordsworth, Webst. P. C. 641.
(*f*) Wallington v. Dale, 6 Exch. 285.
(*g*) See Rubery v. Barrs, cited Carpmael on Patents, 94.
(*h*) Bynner v. Reg. 9 Q. B. 547; Reg. v. Bynner, note to Smith v. Upton, 6 M. & G. 260.
(*i*) Reg. v. Mill, 20 L. J. N. S. C. P. 16; 10 C. B. 379.
(*k*) Spilsbury v. Clough, 2 Q. B. 466; Webst. P. C. 255.

s. 5, enacted that, in case the original patentee had parted with the whole or any part of his interest by assignment to any other person, it should be lawful for such patentee, together with such assignee, if part only had been assigned, and for the assignee, if the whole had been assigned, to enter a disclaimer and memorandum of alteration, and that such disclaimer and memorandum of alteration having been entered and filed, should be valid and effectual in favour of any person in whom the rights under the letters patent might be vested, and that no objection should 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. Section 6 contains similar provisions with respect to disclaimers and memorandums of alterations entered before the passing of the Act.

In a case after the passing of this Act, on a motion in arrest of judgment, on the ground that it appeared on the record that the disclaimer had been entered by the original patentee after he had assigned all his interest, and that he had therefore no power to do so, the Court of Exchequer determined that the defendant could not take the objection, because the proviso of the statute 7 & 8 Vict. cap. 69, s. 6, prevented him from saying that the patentee had no authority to enter it.(*l*)

*17. By stat. 15 & 16 Vict. cap. 83, s. 39, the filing of a disclaimer or memorandum of alteration under that Act, in pursuance of the leave of the law officer duly certified, shall, except in cases of fraud, be conclusive as to the right of the party to enter such disclaimer or memorandum of alteration under the Act; and no objection shall be allowed to be made in any proceeding upon or touching such letters patent, specification, disclaimer, or memorandum of alteration, on the ground that the party entering such disclaimer or memorandum of alteration had not sufficient authority in that behalf. [*104]

SECTION II.—EFFECT OF DISCLAIMER OR AMENDMENT BY STATUTE.

18. By stat. 5 & 6 Wm. 4, cap. 83, s. 1, the disclaimer and memorandum of alteration are to be deemed and taken to be part of such letters patent, or such specification, in all courts whatever, provided 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 memorandum of alteration was enrolled; but in every such action or suit the original title or specification alone shall be given in evidence, and deemed, or taken to be, the title and specification of the invention for which the letters patent have been, or shall be granted.

A memorandum of alteration is part of the specification, and must be dealt with in the same manner as the specification.(*m*)

19. It seems that where a disclaimer is entered to part of a patent, the amended patent has all the incidents of a valid patent from the time of the original grant. Where, however, a patent was originally void,

(*l*) Wallington v. Dale, Exch. 19 Law Times, 187.
(*m*) Reg. v. Mill, 20 L. J. N. S. C. P. 16; 10 C. B. 379.

but amended by filing a disclaimer of part of the invention, it has been held that the disclaimer has not a retrospective operation, so as to make a party liable for an infringement of that part of the patent which is not disclaimed prior to the time of entering such disclaimer. The Court said the act would be unjust to make a man who was acting consistently with the law at a certain time, a wrong-doer by relation.(*n*)

[*105] *20. The Court of Exchequer said they would engraft a modification on the words of the Act, and read it as if it had been "part of the letters patent from thenceforth."(*o*)

In a subsequent case, in the Common Pleas, Jervis, C. J., said, if it had not been for the case of Perry v. Skinner, he should have thought it plain, upon reading the Act of Parliament, that the intention of the Legislature was to allow a specification to be amended at any time by a disclaimer; and that the disclaimer having been perfected after proper precautions taken, and terms imposed by the law officers, should be deemed part of the original specification in all courts whatever, except in actions pending at the time of its enrolment. He said he regretted that he was obliged, even indirectly, to question the decision in Perry v. Skinner.

Maule, J., thought that the inconvenience apprehended by the Court of Exchequer in Perry v. Skinner did not arise. The Act gives not an absolute power to any one to enter a disclaimer, but only a power to apply to the discretion of the Attorney or Solicitor General, who may grant or refuse leave to enter such disclaimer as he, acting judicially on behalf of the public, shall deem best for the public interest. That must be taken to be a provision made by the Legislature for the prevention of inconvenience as regards the public. In the case before the Court, he thought himself bound by the Act of Parliament to take the disclaimer to be part of the specification as from the date of the specification.(*p*)

It would seem that a second patent for the same invention, or an improvement upon it, taken out between the time of the filing the original specification and the date of the disclaimer of part of the invention described, can confer no rights on the second against the original patentee.(*q*)

21. The entry of a disclaimer to part of a specification does not necessarily admit that the patent is bad. The object of the disclaimer is not merely to set right the description of the alleged invention where it is known to be wrong, but to obviate any doubt that may arise on the specification; therefore the mere statement of a disclaimer upon the record

[*106] does *not show that the patent, as originally granted, was void before the disclaimer.(*r*)

22. With regard to disclaimers entered after the 1st of October, 1852, by stat. 15 & 16 Vict. cap. 83, s. 39, no action shall be brought upon

(*n*) Perry v. Skinner, 2 M. & W. 471. See per Cresswell, J. 1 C. B. 167; Stead v. Carey, 1 C. B. 520, Erle, J.
(*o*) Perry v. Skinner, 2 M. & W. 471.
(*p*) Reg. v. Mill, 20 L. J. N. S. C. P. 16; 10 C. B. 379.
(*q*) Stocker v. Warner, 1 C. B. 148, 166. See Stead v. Carey, 1 C. B. 521.
(*r*) Stocker v. Warner, 1 C. B. 148.

any letters patent in which, or on the specification of which, any disclaimer or memorandum of alteration shall have been filed in respect of any infringement committed prior to the filing of such disclaimer or memorandum of alteration, unless the law officer shall certify in his fiat that any such action may be brought notwithstanding the entry or filing of such disclaimer or memorandum of alteration. Sir John Romilly was never in the habit of allowing a disclaimer without imposing a condition that the patentee should bring no action for infringements prior to the disclaimer.(*s*)

23. The entry of a disclaimer need not be replied to a pleading alleging the want of novelty, or the like, on part of the invention. In a proceeding by scire facias to repeal a patent after issue joined, the defendant procured to be enrolled a disclaimer of some of the claims in the specification. The Court held that the disclaimer, though enrolled after issue joined, was admissible for the defendant, and was to be read as part of the original specification put in by the prosecutor.(*t*)

24. The following case has occurred as to the costs in case of a disclaimer pending a scire facias. Pending a scire facias to repeal a patent, the patentee disclaimed a part of his invention under 5 & 6 Wm. 4, cap. 83, s. 1; the prosecutor still proceeded, and ultimately failed. Sir John Romilly said, that a patentee who disclaimed must take the consequence of having it assumed, in the absence of evidence, that the patent was invalid previous to the disclaimer. But he thought that after the disclaimer the prosecutor was bound to know that the patent was good, and ought then to have discontinued the action. By con[illegible] he would so order the taxation, otherwise he could only give leave to the patentee to put the bond in suit, to enable him to recover the subsequent costs.(*u*)

SECTION III.—AMENDMENT AT COMMON LAW. [*107]

25. The Lord Chancellor has no power to alter the date of a patent which had been dated as of the day of the delivery of the privy seal bill, and not, as the patentee supposed, as of the day when the order for sealing was made and the seal affixed, though, in consequence of such mistake, the patentee did not enrol his specification until the four months limited in the patent for that purpose had expired.(*x*)

26. But clerical errors may be amended at common law. Where a a clerical error was made, the word "recovering" having been written instead of the word "covering" fi[illegible]res in the Queen's warrant, and the error was copied in the Queen's bill, the Signet bill, the Privy Seal bill, and the letters patent and enrolment, the error having been corrected in the Queen's warrant and the Privy Seal bill, the Lord Chancellor and Master of the Rolls, by a joint order, directed the letters patent to be altered and rescaled, and the enrolment altered to correspond with the amended letters patent, on the terms that the patentee should aban[illegible]on

(*s*) See 14 Beav. 314; Report on Patents, 1851.
(*t*) Reg. v. Mill, 20 L. J. N. S. C. P. 16; 10 C. B. 379.
(*u*) Reg. v. Mill, 14 Beav. 372.
(*x*) Ex parte Beck, 1 Bro. [illegible]. 578; Webst. P. C. 430, n.

and pay the costs of all actions then pending, and that no action should be brought for any infringement before the resealing.(*y*) The date of the patent was not altered.

27. With regard to erroneous enrolments, the Master of the Rolls has no authority to make any alteration in the enrolment of a patent or specification, except for the purpose of correcting mere verbal or clerical errors, proved to have arisen from mistake or inadvertence. The enrolment must correspond strictly with the patent. The title of the party derived from the Crown rests on the letters patent only, and the enrolment only permitted to be used for the purpose of showing what the grant is. He has no jurisdiction to remove an erroneous claim.(*z*)

28. Clerical errors and errors of mistake appear to have been always amendable at common law.(*a*) In Whitehouse's *patent the word [*108] "wire" having, by a clerical error, been written in the enrolment instead of "fire," the enrolment was amended by Lord Gifford.(*b*)

29. In every case that 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; and not only has strict evidence of error been required, but 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.(*c*)

30. No alteration of an enrolment of letters patent will be permitted which could make the enrolment differ from the original letters patent.

[*109] *CHAPTER XIV.

CONFIRMATION AND EXTENSION OF PATENTS.

SECTION I.—CONFIRMATION.

1. It sometimes happens that the patentee is a true inventor, and believed himself to be the first inventor, yet, by reason of some other person having invented or used the same thing before the date of his patent, without his knowledge, his patent could not have been supported, though he has been the first person to bring the invention into use in this country. This led to hardships. A man who had brought to perfection an invention of great public utility, was liable to have his patent defeated, by evidence of former forgotten discoveries which had never led to any practical result.

(*y*) Nickels's patent, Webst. P. C. 656, 664. See also Anon. Webst. P. C. 663, cited by Lord Cottenham. See Nickels v. Ross, 8 C. B. 673.

(*z*) Sharp's patent, Ex parte Wordsworth, Webst. P. C. 641.

(*a*) Webst. P. C. 657, n.

(*b*) Whitehouse's patent, Webst. P. C. 648, 649, note *m*. See also Redmund's case, 5 Russ. 44, cited by Lord Langdale; Sharp's case, Webst. P. C. 649; Rubery's patent, Webst. P. C. 649, note *m*.

(*c*) Nickel's patent, Webst. P. C. 655, 656; Turn. & Phil. 48.

2. By stat. 5 & 6 Wm. 4, cap. 83, s. 2, 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 and 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 [*110] invention, or part thereof, had not been publicly and generally used before the date of such 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 the said invention, as against all persons whatsoever, any law, usage, or custom to the contrary notwithstanding; 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 the presenting of the same.

3. A party intending to apply by petition for the confirmation of a patent, shall give public notice thereof 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 anything 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. The advertisements must state that he intends to petition her Majesty under the said section; the object of such petition; and give notice of the day on which he intends to apply for a time to be fixed for the hearing of the matter of his said 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.(*a*)

4. Any person intending to oppose the said application, has a right to be heard before the Judicial Committee. He must lodge notice to that effect at the Council Office on or before the days so named in the said advertisements; and having lodged such notice, shall be entitled to have from the petitioners four weeks' notice of the time appointed for the hearing.(*a*)

(*a*) Rules of the Privy Council respecting the confirmation of Patents, rule 1, 5 and 6 Wm. 4, cap. 83, s. 1.

*5. Petitions must be presented within one week from the in-
[*111] sertion of the last of the advertisements required to be published in the London Gazette.(*b*)

All petitions must be accompanied by affidavits of advertisements having been inserted according to the provisions of the rules of the Privy Council above mentioned; and the matters in the affidavits may be disputed by the parties opposing, upon the hearing of the petitions.(*c*)

6. All parties to any former action or suit touching letters patent in respect of which petitions shall have been presented, and all persons lodging notices of opposition, shall be entitled to be served with copies of petitions presented; and no application to fix a time for hearing shall be made without affidavits of such service.(*d*)

Parties served with petitions shall lodge at the Council Office notice of the grounds of their objection to the granting the prayer of such petitions.(*e*)

The Judicial Committee will hear the Attorney-General or other counsel on behalf of the Crown, against granting any application for the confirmation of a patent, in case it shall be thought fit to oppose the same on such behalf.(*f*)

7. The power of recommending the confirmation of a patent is exercised with great caution, and a strong case must be made out by the applicant. The petitioner must show that he considered himself the inventor, by proving the experiments which led to his discovery.

The Judicial Committee refused to recommend a confirmation where a manufacture, substantially identical with the invention of the patentee, had been carried on beneficially prior to the patent, and had never been abandoned, though the invention had not been publicly and generally known, and the petitioner offered to grant licenses to the two persons who had alone used it.(*g*) So where the right of a prior patentee might have been affected, though the first patent was thirty years old.(*h*) So
[*112] in the case of a Scotch patent, where the *invention had been in use in England before the date of the Scotch patent.(*i*)

But where there was no evidence of user in England, France, or elsewhere; but the invention was described in the specification of an expired French patent, a copy of which was in the British Museum, the Judicial Committee, after directing notice of the day of hearing to be given to the French patentee, confirmed the patent.(*k*) Probably, where there has been a user against the consent, and in fraud of the patentee, the patent would be confirmed.

If the patent is for several things, and one is old, the proper course is for the patentee to disclaim, not to apply on a confirmation.(*l*) Costs will be given against an unsuccessful applicant.

(*b*) Rules Pri. C. rule 3.
(*c*) Rules Pri. C. rule 4.
(*d*) Rules Pri. C. rule 5.
(*e*) Rules Pri. C. rule 6.
(*f*) Rules Pri. C. December, 1835.
(*g*) Card's patent, 12 Jurist, Pri. C. 507; S. C. 6 E. F. Moo. 207.
(*h*) Westrupp and Gibbins's patent, Webst. P. C. 554.
(*i*) Robinson's patent, 5 E. F. Moore, 65.
(*k*) Baron Heurteloup's patent, Webst. P. C. 553.
(*l*) Westrupp and Gibbin's patent, Webst. P. C. 554.

SECTION II.—CONFIRMATION BY ACT OF PARLIAMENT.

8. Patents are sometimes confirmed and extended by Acts of Parliament. The following case has occurred as to the effect of such confirmation.

Stead's patent for wooden pavement having become void, by reason of the patentee not enrolling his specification within the time limited by the patent (four months), the non-enrolment having been caused by inadvertence and misinformation, was confirmed by Act of Parliament 4 & 5 Vict. cap. 91, s. 31, without any saving of the rights of strangers. The specification having beeen enrolled within six months, the Act provided that the letters patent should be as valid and effectual as if the specification had been enrolled within four months. One Carey, in the interval between the expiration of the time originally limited for the enrolment and the passing of the Act, while Stead's patent was void, obtained a patent for an improvement on Stead's patent. It was held that the statute effected a complete confirmation, and that Carey could not use Stead's invention.(*m*)

*SECTION III.—EXTENSION OF TERM. [*113]

9. If any person who now hath or shall hereafter obtain any letters patent shall petition his Majesty in council for a prolongation of his patent, and his Majesty shall refer the consideration of the petition to the Judicial Committee of the Privy Council; upon hearing the applicant, and any person who shall oppose the grant, and inquiring into the whole matter, the Judicial Committee of the Privy Cooncil 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 empowered, if he 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.(*n*)

10. Statute 7 & 8 Vict. cap. 69, s. 2, provides for cases in which it can be satisfactorily shown, that the expense of the invention has been greater than an extension for seven years would suffice to reimburse. It 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 of, and in the usual course of its proceedings touching patents; and if the said committee shall be of opinion, and

(*m*) Stead v. Carey, 1 C. B. 496.

(*n*) Stat. 5 & 6 Wm. 4, cap. 83, s. 4.

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.

11. The third section of this Act provides, that nothing in *the [*114] Act 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.(*o*)

12. The powers of the above Acts are declared to extend to letters patent to be granted under the Patent Law Amendment Act, 1852.

13. The new letters patent may be made subject to any restrictions, conditions, and provisions. They are to extend to, and be available in and for such places as the original letters patent extended to and were available in. They are to be sealed and bear date as of the day after the expiration of the term of the original letters patent which may first expire.(*p*)

14. In granting extension of patents to assignees of patent rights, the Legislature indirectly remunerate patentees by increasing the value of patent rights.

The power of obtaining renewals of patents was not confined to grantees, but extended to assignees, under the stat. 5 & 6 Wm. 4, cap. 83, s. 4.

The Legislature intended to compensate the assignee as well as the patentee for labour bestowed and capital expended without adequate remuneration, in bringing a useful invention to perfection.(*q*)

Stat. 7 & 8 Vict. cap. 69, s. 4, reciting that doubts had arisen touching the power of granting an extension of the term of letters patent, in cases where the patentees have assigned their right, enacts, that it shall be lawful for her Majesty, on the report of the Judicial Committee, to grant such extension, either to an assignee or to the original patentee, or to an assignee and the original patentee conjointly.

Section 7 makes valid new letters patent granted to assignees before the passing of the Act, except in cases where actions, proceedings in sci. fa., or suits in equity, were pending at the time of the passing of the Act.

*15. The Privy Council makes no distinction between legal [*115] and equitable titles. There seems no reason why an equitable assignee should not be the sole petitioner.(*r*) But it seems that the renewed letters patent will be granted to the person who has the legal interest in the original patent at the time of the application.(*s*)

16. In order to obtain a prolongation of the term, by stat. 5 & 6 Wm. 4, cap. 83, s. 4, the petitioner must advertise in the London Gazette

(*o*) Stat. 7 & 8 Vict. cap. 69, s. 3. (*p*) Stat. 15 & 16 Vict. cap. 83, s. 40.
(*q*) Russell v. Ledsam, 14 M. & W. 574; in error, Ledsam v. Russell, 16 M. & W. 633. In Dom. Proc. 1 H. L. C. 687.
(*r*) Noble's patent, 15 Law Times, 1.
(*s*) Wright's patent, Webst. P. C. 563; Southworth's patent. Webst. P. C. 488.

three times, and in three London papers, and three times in some country paper, published in the town where or near to which he has carried on any manufacture of anything made according to his specification, or near to or in which he resides, in case he has 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 her Majesty in council for a prolongation of his term of sole using and vending his invention. He must petition her Majesty in council to that effect. Any person may enter a caveat at the Council Office. Notice shall be given by the petitioner 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.

17. Where the party applying for an extension of his patent is resident abroad, and carries on no manufacuture of articles made according to his specification in England, advertising in the papers published in the town or county where the persons to whom he has granted licenses are resident, is a sufficient compliance with the requisitions of the Act.(*t*)

18. The advertisements must give notice of the day on which the applicant 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 in the London Gazette, and that on *or before such day caveats must be entered.(*u*) [*116] It is now the practice to include in one advertisement the notice of the intention to apply for an extension, and the notice of the day on which application will be made to fix a day for the hearing of the petition.(*x*)

The names of all the persons petitioning for an extension must appear in the advertisements. If the name of a person who is an equitable assignee of the letters patent is not mentioned as applying, as well as those of the persons having the legal interest in the letters patent, he will not be heard as a petitioner.(*y*)

19. Any person intending to enter a caveat shall enter the same at the Council Office, on or before the day named for that purpose in the advertisements; and having entered such caveat, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.(*z*)

Special permission will sometimes be given to a party to enter a caveat at a later period:(*a*) but an application by the Lords of the Admiralty to enter a caveat, and be heard against a petition for an extension of a patent, such caveat not having been filed within the time required by the

(*t*) In re Derosne's patent, 4 E. F. Moo. 416.

(*u*) Rules of the Privy Council respecting the Confirmation and Prolongation of Patents, rule 2.

(*x*) Webst. P. C. 559, n.

(*y*) Noble's patent, 15 Law Times, 1.

(*z*) Rules Pri. C. rule 2.

(*a*) Macintosh's patent, Webst. P. C. 739.

rules of the Privy Council, was refused, as the Attorney-General was present to watch the interests of the Government.(*b*)

20. Every petition must be presented six calendar months before the expiration of the term. Stat. 5 & 6 Wm. 4, cap. 83, s. 4, provided that the application for renewed letters patent must be prosecuted with effect before the expiration of the term originally granted. In consequence of a case of peculiar hardship which occurred under it,(*c*) the clause was repealed. Stat. 2 & 3 Vict. cap. 67, enacts, that if an application for an extension has not been prosecuted with effect from any other causes than the neglect or default of the petitioner, the Judicial Committee may entertain the application and report *thereon, though the term may [*117] have expired before the hearing of the application; and her Majesty may grant such extension, provided that no such extension or new letters patent shall be granted, if a petition shall not 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 Judicial Committee, for the omission to prosecute with effect the said application by petition before the expiration of the said term.

21. Prosecuting with effect, means the obtaining the report of the Judicial Committee, or the approbation of it by the Crown. It seems that there is no necessity for the new letters patent to be actually issued before the expiration of the original term. A plea that the renewed letters patent were granted after the expiration of the term in the first letters patent is bad.(*d*) Compliance with the condition need not be averred by a party in pleading the renewed letters patent.

22. Petitions must be presented within one week from the insertion of the last of the advertisements in the Gazette.(*e*)

All petitions must be accompanied by affidavits of advertisements having been inserted according to the provisions (section 4) of the statute, and the first and second of the rules of the Privy Council; and the matters in such affidavits may be disputed by the parties opposing, upon the hearing of the petitions.(*f*)

The party applying for an extension of a patent must lodge at the Council Office four written or printed copies of his specification. Four copies of a publication containing the same will be sufficient. If the specification has not been published, and if the expense of making four copies of the drawings would be considerable, the lodgment of one copy only of such drawings 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.(*g*)

All persons entering caveats shall be entitled to be served with copies *of the petition presented; and no application to fix a time for [*118] hearing shall be made without affidavits of such service.(*h*)

(*b*) Pettit Smith's patent, 7 E. F. Moore, 133.
(*c*) Bodmer's patent, Webst. P. C. 740.
(*d*) Russell v. Ledsam, 14 M. & W. 574; Ledsam v. Russell, in error, 16 M. & W. 633; Ledsam v. Russell, 1 Ho. Lords Ca. 698.
(*e*) Rules Pri. C. rule 3.
(*f*) Rules Pri. C. rule 4.
(*g*) Rules Pri. C. December 21, 1835.
(*h*) Rules Pri. C. rule 5.

23. All persons 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 prayer of the petition.(*i*)

24. In questions as to the prolongation of patents, what is usually taken into consideration as the ground of the grant is,—first, the merit of the inventor; secondly, the value and utility of the invention; thirdly, whether the patentee has received a sufficient remuneration.

25. The Court does not in any very direct way consider whether the patent is valid, or not, at law. If it is palpably bad, the patent will not be extended; but unless this is clear, the Court is usually inclined to assume that it may be a good patent, and leave the question of its validity to be determined at law. If the specification is vague and imperfect, that defect may influence the Privy Council in determining whether or not it is expedient to recommend an extension.(*k*) Questions of novelty and utility will not be minutely entered into, particularly after a decision in favour of a patent in a court of law; for the new letters patent are subject to all the objections which might have been made to the original letters patent. In the case of Kay's patent, at the time of the application for a prolongation, proceedings were pending in which the validity of the patent was in question. The Judicial Committee said they would have adjourned the petition, had it been possible to obtain the decision of a court of law on the validity of the patent before it would have expired. For the purposes of prolongation they assumed the patent to be valid.(*l*)

26. The ingenuity of the inventor will be considered.(*m*)

Swaine's invention of producing mineral waters was considered by the Judicial Committee very meritorious, the result of much care, [*119] labour, and science, and very useful in its effects. On evidence that the patentee had sustained a loss, the Court granted an extension of the term for seven years.(*n*)

So where the petitioner had been occupied for four years in experiments in carrying out his invention, and had subsequently made improvements which he had patented, the Court extended the first patent for seven years.(*o*) The merit of an importer is much less than that of an inventor.

The fact that, subsequently to the date of a patent for an invention, great improvements have been made upon it, affords no reason for denying the inventor an extension of his patent, if he has great merit, and is shown not to have reaped a due benefit in proportion to his merit. The improvement may be evidence of the value of the invention.(*p*) It is

(*i*) Rules Pri. C. rule 6.

(*k*) In re Pinkus's patent, 12 Jur. 233; Pri. C. Erard's patent, Webst. P. C. 557, note; Lowe's patent, Mechanics' Magazine, Feb. 28, 1852, 174; Woodcroft's patent, 10 Jurist, 363, Pri. C.

(*l*) In re Kay's patent, Webst. P. C. 568; 3 E. F. Moo. 24.

(*m*) Whitehouse's patent, Webst. P. C. 477; Roberts's patent, Webst. P. C. 575; Downton's patent, Webst. P. C. 566.

(*n*) Swaine's patent, Webst. P. C. 559.

(*o*) Wright's patent, Webst. P. C. 575.

(*p*) Galloway's patent, Webst. P. C. 725; Soames's patent, Webst. P. C. 734.

otherwise if the main benefit arising from such invention is derived from improvements subsequently introduced by others than the inventor.(*q*) It will be prudent for the inventor to prove his expenditure of money and time in perfecting the invention.

27. The small amount of any step made in improvement, will not dispose the Lords of the Privy Council to undervalue the importance of a discovery, if the patent involve a new principle or a new process; but where the invention consisted of merely a new application of a known process, which might readily suggest itself to anybody, as the principle of the separation of oils into stearine and elaine by pressure, applied to cocoa-nut oil, though the benefit resulting to the public was shown to be great, the term was only extended for three years.(*r*)

28. The Court will consider how far the invention has been of any benefit to the public.(s)

[*120] Where great benefit to the public was produced by the *invention, as where the cost of the article (sugar), to the production of which the invention related, was diminished 20 per cent., the term was extended, though the amount of discovery was small, and considerable profits had been realized by the patentee.(*t*) Where the invention is of small commercial value, an extension will be refused.(*u*)

29. The spirit and activity of the patentee in expending capital and using efforts to bring forward his invention, are material to be considered.(*x*) Where the invention had not got into use in consequence of disputes between the patentee and persons who had agreed to join him as partners in carrying out his invention, and the invention was not brought into operation till a short time before the expiration of the term, the committee refused to recommend an extension.(*y*) So where it had not got into use in consequence of a defect not cured till the tenth year of the term.(*z*)

It is strong evidence against the utility of an invention, if from the time when the patent was granted until the time for applying for a prolongation of the term, the thing invented has never been brought into practical operation in any way calculated to promote the public service. The fact that the invention had been previously published in a foreign work, and that a knowledge of it might have been acquired by persons here, will be considered as diminishing the benefit reaped by the public from the invention.(*a*)

30. It is a general rule, that some explanation must be given if the invention has not been brought into use.

As where a man has shown great ingenuity in an invention, but from

(*q*) Woodcroft's patent, Webst. P. C. 740; Lowe's patent, Mechanics' Magazine, Feb. 28, 1852, 174.
(*r*) Soames's patent, Webst. P. C. 729.
(*s*) Simister's patent, Webst. P. C. 721.
(*t*) Derosne's patent, 4 E. F. Moore, 418. See Morgan's patent, Webst. P. C. 737.
(*u*) Soames's patent, Webst. P. C. 735.
(*x*) Patterson's patent, 13 Jur. 593; S. C. 6 E. F. Moore, 469.
(*y*) Bell's patent, 10 Jur. 363. (*z*) Pinkus's patent, 12 Jur. 233, Pri. C.
(*a*) Per Lords Campbell and Brougham, Soames's patent, Webst. P. C. 729.

want of adequate capital and means, has been unable to obtain a sufficient return. So if these difficulties have been increased by disputes with persons in partnership with the inventor in his patents.(*b*)

*The difficulties of introducing the manufacture into public use in consequence of its novelty, are important to be considered.(*c*) [*121]

As if the prejudices of workmen, or a combination of the trade against him, have impeded the patentee.(*d*) So if from its nature the invention is one not likely to come into immediate use, or if the explanation of its not being brought into use is, that it is intended for a particular class of persons, as government officers, who have not yet adopted it.(*e*)

31. Though, on account of combinations against the patentee, there seems no reasonable ground for supposing the extension will be beneficial, the Court will not refuse to extend the patent.(*f*)

32. It must be shown that the inventor has not been duly rewarded in proportion to his merit. The patentee having made about £7,000 by an invention, proved to be of great value in flax-spinning, the patent was extended for three years.(*g*)

A patent for a self-acting mule was extended for seven years, it having been proved that there was a loss on the whole, though the profits for the last three or four years of the patent had been at the rate of £5,000 a year.(*h*)

Proof that nothing was made for seven or eight years is generally required.(*i*)

33. In estimating the profits of a monopoly, a fair manufacturer's profit on the capital employed must be deducted.(*k*) The expense incurred in litigation may be deducted.(*k*)

Losses by a fire, supposed to have been caused by incendiaries, have been taken into consideration in determining a question as to the extension of a patent for self-acting machinery.(*l*)

*Profits realized by the sale of articles for exportation must be included.(*m*) [*122]

34. Since the passing of stat. 14 & 15 Vict. cap. 99, s. 2, the patentee will be able to prove his own case in this respect, which he should do by the production of his books and accounts. Before the passing of this Act, it was decided that where the patentee had not sold any of his patent machines, and therefore had not kept any book, but had allowed a gas company to use his invention for the purpose of making it known, and the manager stated that the company had never paid anything for the use

(*b*) Wright's patent, Webst. P. C. 576; Swaine's patent, Webst. P. C. 559; Downton's patent, Webst. P. C. 565.
(*c*) Stafford's patent, Webst. P. C. 563; Kollman's patent, Webst. P. C. 564.
(*d*) Erard's patent, Webst. P. C. 557; Jones's patent, Webst. P. C. 577.
(*e*) Southworth's patent, Webst. P. C. 486; Bates's patent, Webst. P. C. 739.
(*f*) Jones's patent, Webst. P. C. 577. (*g*) Kay's patent, Webst. P. C. 572.
(*h*) Roberts's patent, Webst. P. C. 575.
(*i*) Downton's patent, Webst. P. C. 565.
(*k*) Galloway's patent, Webst. P. C. 729.
(*l*) Roberts's patent, Webst. P. C. 573.
(*m*) Hardy's patent, 13 Jur. 177; 6 E. F. Moo. 441, S. C.

of it, the Court thought it sufficient primâ facie evidence that no profits had been made.(*n*)

35. The Court will take into consideration the annoyance that the patentee has suffered from litigation.(*o*)

36. The Judicial Committee will not recommend an extension if the patentee has not enforced his rights, but has allowed infringements of his patent, and never effectually asserted his title at law.(*p*)

Where a patentee, having obtained a patent for several inventions, some of which were not new, omitted to disclaim, and permitted persons to infringe the part of his invention which was new, till near the conclusion of the term of the patent, persons who had erected machinery, relying on his acquiescence, opposed the extension; and the Court, taking his remissness into consideration, refused it.(*q*)

37. The extension of the term of a patent for an improved method of printing in colours, by the combination of copperplate printing and wood engraving, was opposed by the apprentices of the patentee, on the ground that they had served their time upon the expectation that on the expiration of the original patent, they would be able to exercise the trade taught them by the patentee; but as it appeared that they had been instructed, and could earn fair wages as wood-engravers, the Judicial Committee recommended the extension of the patent without any condition.(*r*)

[*123] *38. Since the coming into operation of the Patent Law Amendment Act, 1852, her Majesty's order in council is sufficient warrant for the insertion, in new letters patent, of any restrictions, conditions, and provisions mentioned in the order.(*s*) Before the passing of this Act, it had been frequently the practice for the Judicial Committee to impose terms as conditions of the renewal of a patent, but the discretion of the Crown was not in any manner fettered by such recommendation. The Judicial Committee, under stat. 5 & 6 Wm. 4, cap. 83, had to report merely as to matters between the public and the party applying.(*t*)

The patentee of an invention, an improved railway axle, which was of great merit and great importance to the public, after having made great efforts to bring his invention into use, had lost money by it. He afterwards assigned his patent, and the assignees spent a considerable sum in establishing a plant and works, but had lately made large profits. The patentee and the assignees having applied for an extension, the Judicial Committee postponed recommending an extension till one-half of the profit of the patent, during the extended term, should have been secured to the patentee. They then recommended an extension subject to a condition, that the price of the axles should not be raised.(*u*)

In Whitehouse's patent an extension was granted to the assignee; the Judicial Committee recommended, that the term should be extended, on

(*n*) Lowe's patent, 10 Jur. 363. (*o*) Whitehouse's patent, Webst. P. C. 477.
(*p*) Pinkus's patent, 12 Jur. 233, Pri. C.
(*q*) Simister's patent, Webst. P. C. 721.
(*r*) Baxter's patent, 13 Jur. 593, Pri. C.
(*s*) Stat. 15 & 16 Vict. cap. 83, s. 40. (*t*) Ledsam v. Russell, 1 H. L. C. 687.
(*u*) Hardy's patent, 13 Jurist, 177, Pri. C.; 6 E. F. Moo. 441, S. C.

the assignee securing an annuity to the patentee during such extended term. The new patent contained a proviso, that the patent should be void if the annuity was not secured.(*x*)

In the case of Pettit Smith's patent, an extension of letters patent was granted upon condition that the commissioners for executing the office of Lord High Admiral should have the right of using the invention for the service of her Majesty without any license from the patentee.(*y*)

Though a person who has obtained a patent cannot be put under any terms as to the manner in which he shall exercise *his invention, in Whytock's case, a patentee having refused to grant a license to a particular person, the Judicial Committee made it a condition of the prolongation, that a license should be granted.(*z*) [*124]

SECTION IV.—PRACTICE ON HEARING BEFORE THE JUDICIAL COMMITTEE, ETC.—NEW PATENT.

39. The Judicial Committee have power to examine witnesses, or direct depositions to be taken in writing by the registrar.(*a*) The attendance of witnesses, and the production of deeds, evidences, and writings, may be compelled by a subpœna, to be issued by the president for the time being.(*b*) The Judicial Committee may appoint one or other of the clerks of the Privy Council to take any formal proofs.(*c*) They may direct the examination of witnesses on interrogatories either at home or abroad, under the powers of 13 Geo. 3, cap. 63, and 1 Wm. 4, cap. 22.(*d*)

Parties may have copies of all papers lodged in respect of any application for the confirmation or prolongation of a patent at their own expense.(*e*)

40. The Judical Committee will hear the Attorney-General or other counsel on behalf of the Crown against granting any application for the confirmation or prolongation of a patent, in case it shall be thought fit to oppose the same on such behalf.(*f*)

In cases of unopposed applications, the Attorney-General attends and watches the case of the petitioners. He represents the Government, and the public generally.(*g*) The rule respecting the number of counsel entitled to be heard, is the same in the Privy Council as in the House of Lords, —two only on either side. Two counsel only will be heard to oppose the petition, unless the parties have independent and *distinct grounds of opposition, founded on separate and independent interests.(*h*) [*125]

(*x*) Whitehouse's patent, Webst. P. C. 473.
(*y*) In re Pittit Smith's patent, 7 E. F. Moo. 133.
(*z*) Whytock's patent, 28 Newt. Lond. Journ. 449.
(*a*) Stat. 3 & 4 Wm. 4, cap. 41, ss. 7, 9.
(*b*) Stat. 3 & 4 Wm. 4, cap. 41, s. 9. (*c*) Stat. 7 & 8 Vict. cap. 69, s. 8.
(*d*) Stat. 3 & 4 Wm. 4, cap. 41, s. 14. (*e*) Rules Pri. C. rule 7.
(*f*) Rules Pri. C. December, 1835 n.
(*g*) Webst. P. C. 557, n.; Pettit Smith's patent, 7 E. F. Moo. 133; Downton's patent, Webst. P. C. 567.
(*h*) Woodcroft's patent, 3 E. F. Moo. 171; Lord Brougham, in re Downie and Arrindell, 3 E. F. Moo. 419.

41. The rules of evidence are as nearly as possible the same as those in a court of law. The papers containing the requisite advertisements must be put in and proved. Service of notice on the parties who have entered caveats must be proved. Defects in proof cannot be cured by any admission of an opposing counsel.(*i*)

If the petitioners are assignees, their title must be proved, though no notice has been given of an intention to dispute the title.(*k*)

42. The Court has the power to give costs by statute 3 & 4 Wm. 4, cap. 31. Costs will generally be given in case of successful opposition. The Court acts upon the principal, that if a party entitled to oppose does come and oppose successfully, if costs are not given, it would discourage people coming forward for the benefit of the public.(*l*) The Court will refer it to a master to tax all such extraordinary costs as may have been incurred on behalf of the applicant in consequence of the caveat and opposition, where they think that there was no ground for the opposition.(*m*) Probably no costs would be allowed except costs incurred in the matter of the petition.

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.(*n*)

43. Before the passing of the recent Act, it was said that the Crown might grant renewed letters patent at any interval after the end of the term, so that the new term did not exceed seven years from the end of the old one, but that persons who might use the invention in the interval between the *expiration of the old term and the sealing of the new letters patent were not responsible.(*o*)

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The proceedings by the patentee to obtain a new patent after a report of the Judical Committee in favour of an extension, have hitherto been the same as those necessary in order to obtain a patent in the first instance.

Now, however, by stat. 15 & 16 Vict. cap. 83, s. 40, in the granting of any new letters patent her Majesty's order in council shall be a sufficient warrant and authority for the sealing of any new letters patent and for the insertion in such new letters patent of any restrictions, conditions, and provisions in the said order mentioned; and the Lord Chancellor, on the receipt of the said order in council, shall cause letters patent, according to the tenor and effect of such order, to be made and sealed in the manner herein directed for letters patent issued under the warrant of the law officer: provided always, that such new letters patent shall extend to, and be available in and for such places as the original letter patent extended to and were available in:

(*i*) Galloway's patent, Webst. P. C. 725.

(*k*) Wright's patent, Webst. P. C. 561.

(*l*) Westrupp and Gibbins's case, Webst. P. C. 556; Macintosh's patent, Webst. P. C. 739.

(*m*) Webst. P. C. 567, Downton's case. (*n*) Rules Pri. C. rule 8.

(*o*) Ledsam v. Russell, 1 H. L. C. 698; Russell v. Ledsam, 14 M. & W. 574; Ledsam v. Russell, 16 M. & W. 641.

Provided also, that such new letters patent shall be sealed and bear date as of the day after the expiration of the term of the original letters patent which may first expire.

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*CHAPTER XV. [*127]

THE RIGHTS CONFERRED BY LETTERS PATENT.—INFRINGEMENT.

SECTION I.—WHAT ACTS ARE FORBIDDEN.

1. LETTERS patent grant to the inventor and his assigns the Queen's especial license, full power, sole privilege, and authority, that he and his assigns, and such others as he shall agree with, and no others, shall, during the term, "make, use, exercise, and vend his said invention within the kingdom," &c.; and that he and they "shall have the whole profit accruing by reason of his invention" during the term; and to the end that he may have the full benefit and sole use of his invention, that no person within the United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, &c., during the continuance of the term, shall, "either directly or indirectly, make, use, or put in practice the invention, or any part of the same, or in any wise counterfeit, imitate, or resemble the same, or make, or cause to be made, any addition thereto or subtraction from the same, whereby to pretend himself the inventor or devisor thereof, without the consent, license, or agreement of the patentee, his executors, &c., in writing under his hand and seal, first obtained."

2. By stat. 21 Jac. 1, cap. 1, s. 1, it is enacted, that all letters patent for the sole buying, selling, making, working, or using anything within this realm, are altogether contrary to the laws of the realm, and so are utterly void and of none effect. Section 6 excepts grants of privilege of the sole *working or making* of any manner of new manufactures within the realm to the true and first inventor of such manufactures, which others, at the time of making such letters patent, shall not use.

*3. The privilege granted appears, therefore, to be only for the sole making and working of the new manufacture, as distinguished from a privilege for buying, selling, or using anything. [*128]

Mr. Hindmarch says, "The only thing 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.(*a*) The subject of the grant is the sole right or exclusive privilege to use the invention, which must be a new art of manufacturing vendible articles or commodities.(*b*)

4. If a man employ others to make articles according to the patentee's process, and sells such articles himself, that is a use of the invention by

(*a*) Hindmarch on Patents, 92.
(*b*) Ib. 230. See Boulton v. Bull, 2 H. Black. 486, Heath, J.

him, upon the principle that he who does a thing by the hands of another does it himself.(c)

5. If a person sells articles made according to the patent, such a sale is a breach of the patentee's right, and within the prohibitory clause of the patent. Proof that articles essentially similar to those patented were purchased at the shop of the defendant, is sufficient.(d) The right to exercise the invention would be fruitless if goods made according to the patent, either here or elsewhere, in places to which the patent does not extend, could be sold in the ordinary course of trade in this country.

6. It has been questioned whether, if an article patented here, purchased abroad, or in a part of the kingdom to which a patent does not extend, for the private use of the purchaser, is sold here as part of his effects, it would be an infringement of the patent. To that Lord Eldon said he did not know an answer.(e) Probably vending means selling and offering for sale in the way of trade.(f) The exposing of an article intended to imitate, and which does imitate, the invention of the patentee for sale, is not an infringement.(g)

[*129] 7. If a machine patented is merely made by a person for *the purpose of an experiment for his amusement, or as a model, it has been said not to be an infringement.(h) The same law has been laid down in the United States by Mr. Justice Story.(i) Coleridge, J. in Minter v. Williams, observed that there might be an innocent using and exercising of the invention.(k) It is suggested by Mr. Curtis, referring to a decision of Mr. Justice Washington, that the motive of testing the practical utility of an invention is no answer to the charge of having "used" it; that it is not quite clear that in prohibiting the making or using of a patent article, the legislature of the United States intended to recognise the distinction above mentioned.(l)

8. It appears to be a matter worthy of consideration, whether, taking the language of the patent and the statute together, the mere possession and use of a patented article otherwise than in the process of manufacturing is an infringement of the patentee's right.(m) In other words, where the patent is for the thing made, whether the mere use of it without license is an infringement. If so, no one can safely buy the smallest patented article without inquiring into the title of the dealer of whom he buys it. A man may be bound to know of the existence of a patent. If he makes, or causes to be made, or sells in the way of his trade, articles in contravention of it, he may be liable. But he cannot be bound to know whether an article which he buys in a shop was made by the license of the patentee or not.

(c) Gibson and Campbell v. Brand, 4 M. & G. 189.
(d) The University of Oxford and Cambridge v. Richardson, 6 Vesey, 709; Gibson and Campbell v. Brand, Webst. P. C. 630, Tindal, C. J., N. P.; Cornish v. Keene, Webst. P. C. 502, Tindal, C. J., N. P. (e) Per Lord Eldon, 6 Vesey, 709.
(f) Per Coleridge, J., 4 A. & E. 255, Minter v. Williams.
(g) Minter v. Williams, 4 A. & E. 251.
(h) See Jones v. Pearce, Webst. P. C. 125.
(i) Swain v. Guild, 1 Gallison's Rep. 485, 487; Curtis, 249. So in France, Perpigna, Manuel des Inventeurs, 277. (k) Minter v. Williams, 4 A. & E. 256.
(l) Watson v. Bladen, 4 Washington's Rep. 583; Curtis on Patents, 248.
(m) See notes Webst. P. C. 259, 543: Hindmarch on Patents, 492.

In a recent case in the Court of Exchequer, it was urged that no one could buy a patent article without a license under seal. Alderson, B. answered this by saying, the object of the grant of the Crown is to prevent others than the patentee from making the patented article for sale, not from the use of it.(*n*) Letters patent say no one shall make, use, or put in practice the invention; which does not apply to the case of a *party buying a patent article in a shop, and using it. He [*130] seemed to consider that the words, "whereby to pretend himself the devisor," overrode the whole clause.(*o*)

In Stocking v. Llewellyn, the bill alleged that the defendant had built and used patent cabs; an injunction was asked to restrain him from using them. The Vice-Chancellor stated that the relief was asked in respect of building; it did not appear that the defendant had built, but only that he had bought and repaired the cabs. The injunction was dissolved with costs.(*p*) However, in Gillett v. Wilby, an action against the owner of a cabriolet for infringing a patent, Coltman, J. left the question to the jury whether the cabriolet alleged to have been an infringement was used or let out for hire by the defendant. No objection was taken by the defendant's counsel to this ruling.(*q*)

9. An architect is not liable to an action for an infringement, where a contractor building a house and using the materials under his directions, employs in the construction of it, without license, articles which infringe a patent right.(*r*)

10. In a case before Vice-Chancellor Turner, the foreign owners of a ship, without fraud, and in ignorance of the patent, caused to be made and attached to their vessel, not being a British ship, in their own country, a screw propeller, on a principle which was covered by an English patent. The vessel came to England with a cargo for the purposes of trade. The Vice-Chancellor restrained by injunction the use of the screw propeller while the vessel should be within the waters over which the English patent extended.(*s*) In addition to the question whether the mere innocent use of a patented invention is an infringement, it may well be doubted whether in this case there was any *use* or *exercise within the kingdom* within the meaning of these words in the granting part of the patent. The coming of the vessel into our waters seems to have been merely incidental to the use and exercise of the invention in the ordinary course of the foreign *employment of the vessel on the high [*131] seas. The fact that, in coming to the shores of this country, the screw was used in English waters was merely accidental. The use seems to have been, in reality, no more a use in this country than would have been the use of a railway engine patented here in bringing trains from Scotland to a depot on the border, not coming further into this country than would be necessary to enable an engine licensed here to take out the

(*n*) See Holmes v. London and North-Western Railway Company, C. P. 20 Law Times, 112.

(*o*) Chanter v. Dewhurst, 12 M. & W. 825.

(*p*) Stocking v. Llewellyn, 3 Law Times, 33.

(*q*) Gillett v. Wilby, 9 C. & P. 336; Webst. P. C. 270; more fully reported 2 Carp. R. 540.

(*r*) Denley v. Blore, 38 Newt. Lond. Jour. C. S. 224.

(*s*) Caldwell v. Van Vlissingen, 9 Hare, 415; S. C. 16 Jurist, 115.

train. The arguments, from inconvenience, against the soundness of the decision seem very forcible.

11. The Dutch government having remonstrated against the decision in the principal case, it was by stat. 15 & 16 Viet. cap. 83, s. 25, enacted, that no letters patent for any invention granted after the passing of that Act should extend to prevent the use of such invention in any foreign ship or vessel which may be in any part of her Majesty's dominions, or in any of the waters within the jurisdiction of any of her Majesty's Courts, where such patent invention is not so used for the manufacture of any goods or commodities to be vended within, or exported from her Majesty's dominions. Provided always, that this enactment shall not extend to the ships or vessels of any foreign state of which the laws authorize subjects of such foreign state having patents, or like privileges, for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British ships or vessels, or in or about the navigation of British ships or vessels while in the port of such foreign state, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture of goods or commodities to be vended within or exported from the territories of such foreign state.

12. The French law says, "Ceux qui auront sciemment recélé, vendu, ou exposé en vente, ou introduit sur le territoire Français, un ou plusieurs objets contrefaits, seront punis des mêmes peines que les contrefacteurs.(*t*)

Persons who in good faith have bought for their own use and not for purposes of trade, articles infringing the right of the patentee, may not be liable to the payment of damages, but the articles will be confiscated.

[*132] *The following cases have been decided:—"Il faut quo les produits étrangers aient été introduits avec une intention évidente de faire fraude à la roi Française. Celui qui a fait l'importation est excusable s'il a agi de bonne foi."—Douai, 11 Juillet, 1846.

"Celui qui a acheté une machine réputée contrefaite ne peut être poursuivi à cause de l'usage qu'il en fait pour ses besoins personnels."—Rouen, 22 Mai, 1846.(*u*)

"Bonne foi ne peut être invoquée par celui trové en possession d'objets contrefaits destiés à être débités. Elle peut l'être par celui qui a acheté pour son usage un instrument qu'il ne savait pas être breveté."—Cour Royale de Paris, 3 Juillet, 1839; Cour de Cassation, 28 Juin, 1844.(*x*)

13. The American statute gives a right of action for damages in case of "making, using, or selling, the thing patented.(*y*) The act of 1793 was repealed by the Legislature, and the present statute enacted, in consequence of a doubt whether the language of the former Act did not couple making and using together, so that making without using, or using without making was not an offence.(*z*) In America the mere use

(*t*) Loi du 5 Juillet, 1844, sur les brevets d'invention, art. 41. See Guide Pratique des Inventeurs. Truffaut, Paris, 1844.

(*u*) Codes Annotés (Teulet, D'Auvilliers, et Sulpicy, Paris, 1850), tome ii. table générale 11. Perpigna, Manuel, &c. 364.

(*x*) Manual des Inventeurs (Perpigna), 318, 354, 357.

(*y*) Act of July, 1836, ss. 5, 14, cited Curtis on Patents, 245.

(*z*) Per Story, J. Whittemore v. Cutter, 1 Gallison Rep. 429, 433; Curtis on Patents, 247.

of a patented composition, as the making of a patent pill, seems to have been considered as an infringement of the patent.(*a*) Mr. Curtis questions this so far as regards the use of things that perish in the using. But innocent persons will not be restrained from the use of the product of a patent machine, as the sale and use of bedsteads of a particular construction made by a patented machine, where the person selling or using them is not privy to the use of the patented machine.(*b*)

*SECTION II.—WHAT IMITATION OR RESEMBLANCE IS AN INFRINGEMENT. [*133]

14. The questions of infringement may be stated in these terms: Is the defendant's machine a copy made after and agreeing with that described in the plaintiff's specification ?(*c*) Is the change, if any, colourable and formal, or substantial and essential? Is the effect the same, and is it produced substantially in the same manner and by the same means? Are the parts essential to the production of the useful result obtained by the plaintiff's invention adopted or imitated by the defendant?

15. If a defendant uses that which is virtually and substantially the invention described in the specification, a slight departure from the specification, for the purpose of evasion only, would be a fraud on the patent. The question is, whether the mode of working by the defendant has or has not been substantially different.(*d*) It is not in the power of any person, simply by departing in form, or in immaterial circumstances, from the mode of carrying out the invention mentioned in the specification, to use it without the leave of the patentee. The question is, whether there is such a variation in substance as to make the defendant's mode of operation a distinct thing.

16. The essence of the invention must be looked to. Gamble's patent was for the use of iron retorts worked in connection with each other, and heated by separate furnaces for the two stages of the process of manufacturing sulphate of soda, so that both might be kept in action at the same time. The material of which the chambers was composed not being of the essence of the invention, the patent right was held to be invaded by the use of chambers of other materials than those mentioned in the specification.(*e*)

17. In determining the question of the identity of two *mechanical contrivances, the jury must consider whether the defendant's machine is only colourably different,—that is, whether it differs [*134]

(*a*) Per Story, J. Whittemore v. Cutter, 1 Gallison Rep. 433; Curtis on Patents, 258, 259; Curtis, Inventor's Manual, 109, Boston, 1851.

(*b*) Boyd v. Brown, 3 McLean, Rep. 295; Boyd v. McAlpin, 3 McLean Rep. 427; Keplinger v. De Yonug, 10 Wheaton Rep. 358; Curtis on Patents, 250, 257.

(*c*) Galloway v. Bleadon, Tindal, C. J. N. P. Webst. P. C. 523.

(*d*) Hill v. Thompson and Forman, Webst. P. C. 239; 8 Taunt. 382, S. C.; Walton v. Potter, Webst. P. C. 587, Tindal, N. P.; Walton v. Potter, 3 M. & G. 411; per Gibbs, C. J. Bovill v. Moore, Dav. P. C. 405; S. C. 2 Marsh. 311; Stead v. Anderson, 4 C. B. 806.

(*e*) Gamble v. Kurtz, 3 C. B. 435; Bramah v. Hardcastle, 1 Carp. R. 168.

merely in the substitution of what are called mechanical equivalents for the contrivances which are resorted to by the patentee. If the differences which exist between one machine and the other are such as do not affect the principle of the invention, the two machines are alike in substance. One man has invented the principle and another has adopted it, and though he may have carried it into effect by substituting one mechanical equivalent for another, still the jury should look to the substance, and not the mere form; and if it is in substance an infringement, they ought to find it to be so. If its principle is not the same, but really different, then the defendants cannot be said to have infringed the patent.(*f*) Mechanics may be called as witnesses to prove the identity in principle of two contrivances.(*g*)

18. Mr. Justice Story says it is often a point of intrinsic difficulty to decide whether one machine operates upon the same principles as another. In the present improved state of mechanics, the same elements of motion and the same powers must be employed in all machines. The material question is not whether the same elements of motion or the same component parts are used, but whether the given effect is produced substantially by the same mode of operation and the same combination of powers in both machines.(*h*) Coleridge, J. said, "If the defendant has taken the same principle as the plaintiff, and has used it so as to work in the same way on the same subject-matters, so as to produce the same result, the only difference being that he has varied the mechanical agent by which he has done it, then I think it is merely a colourable imitation, and amounts to an infringement. It was stated by the witnesses on both sides, that it is often a matter of perfect indifference what mechanical agent they use to effect the result. The plaintiff has as much right to be protected against an infringement by the use of mechanical equivalents, as he would if exactly the same
[*135] *means had been made use of. If this were not so, there could be no means by which a patentee's title could be at all protected, unless he specified every possible mode by which the result could be arrived at."(*i*)

19. There may be an infringement by the use of so much of a combination as is material. If a portion of a new arrangement of machinery is in itself new and useful, and another person, for the sake of producing the same effect, uses that portion of the arrangement, and substitutes for the other matters combined with it a mechanical contrivance, that would be an infringment of the patent. In a patent for a mode of stopping looms when the shuttle stops in the shed, the principle of the invention was to transfer the momentum of the slay to a brake acting on the fly-wheel. This was effected by an arrangement by which, if the slay beat up when the shuttle was absent from both boxes, the stop-rod finger not being elevated by the weight of the shuttle in either box, came into con-

(*f*) Morgan v. Seaward, Webst. P. C. 171, Alderson, B.; Morgan v. Seaward, Webst. P. C. 168, Sir L. Shadwell.
(*g*) Webster v. Uther, Godson on Patents, 232.
(*h*) Odiorne v. Winkley, 2 Gallison Rep. 51, 53, cited Curtis on Patents, 263.
(*i*) Mangnall v. Benecke, N. P. 24 Newt. Lond. Journ. C. S. 294.

tact with one end of a lever acting on the brake, and an apparatus by which a clutch-box was thrown out of gear, and the driving-strap shifted from the driving-pulley to a loose pulley at the same instant. This was held to be infringed by a contrivance by which the stop-rod finger, under such circumstances, was brought into contact with a lever, different in construction but similar in its mode of operation, pressing a brake on the fly-wheel, and throwing the driving-strap off of the driving-shaft.(*k*)

20. In cases of this kind it is important to consider whether the useful effect of the patented invention and what is protected by the patent, consists in the combined effect of the whole. If the patent is for the entire combination, and that alone, the doing the same thing by a contrivance similar to part of the patented machine would seem not to be an infringement.(*l*)

21. When the principle of operation is public, a patent for a particular machine is not necessarily infringed by the adoption of instruments operating on the same principal, but varying in detail from those employed in the patent machine. In such case the similarity of effect produced does not *necessarily show that one instrument is merely an equivalent for the other.(*m*) [*136]

22. The fact that the defendant has made a great improvement on the patentee's invention, will not enable him to adopt the principle of the patentee's invention.(*n*) In Cochrane v. Braithwait, owing to imperfections in the original invention, it had never been brought into use, and many engineers gave evidence that they did not believe it would work; but Mr. Brunel and some others having proved that they had actually seen it work, the plaintiff was held entitled to recover against the defendant, who adopting the principle of the plaintiff's invention, had greatly improved the machinery by which it was applied, and had brought the improved invention into use.(*o*) In Macnamara v. Hulse, the plaintiff's invention for the form of paving-blocks had been patented for many years but had not got into use till applied to a new material not mentioned in the patent, or apparently thought of at the time by the patentee.(*p*)

23. The improvement may, however, be taken into consideration in determining whether his invention is distinct from that of the patentee.(*q*) 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 patent, or by borrowing the idea from the former patent, a new and superior mode of attaining the same end, there can be no objection to his taking out a patent for that purpose. But he must not avail himself of that which had before been granted exclusively to another. The jury will say whether the second invention is virtually bottomed on

(*k*) Sellers v. Dickinson, 5 Exch. 312.
(*l*) See Sellers v. Dickinson, N. P. 35 Newt. Lond. Journ. 135.
(*m*) The Electric Telegraph Company v. Brett and Little, 26 Newt. Lond. Journ. C. S. 134.
(*n*) Neilson v. Harford, Webst. P. C. 310.
(*o*) Lord Cochrane v. Braithwaite, 1 Carp. R. 493. See Walton v. Potter, Webst. P. C. 591.
(*p*) Macnamara v. Hulse, Car. & Mar. 471.
(*q*) Neilson v. Harford, Webst. P. C. 310.

the first varying only in circumstances not material to the principle and substance of the invention.(*r*)

A patent for improvements in the process of finishing hosiery, by placing the goods in a press between metallic boxes heated by steam, was held not to be infringed by *passing them between rollers similarly [*137] heated; the Court, considering that the claim was for the particular machine described, and not for a process to apply to any sort of surface. So far as it was a machine, the principle was different, the pressure in the one case being continued, and in the other momentary.(*s*)

24. If the patent be for a principle, it will extend to every mode in which the principle can be carried into operation.(*t*) If a man invents and adapts a principle, it is a question for the jury whether any other mode of doing the same thing is or is not a piracy of that which he has invented. It is said that there never were two things to the eye more different than the plaintiff's invention and what the defendant had done in contravention of the patent right, in Crossley v. Beverley. The plaintiff's invention was different in form, different in construction; it agreed with the invention alleged to be an infringement in one thing only. By moving in the water, a certain point was made to open so as to shut up another; the gas passing through a wheel made it revolve, and the quantity which passed through was measured by the number of revolutions made by the wheel. Scientific men all said, that the moment a practical scientific man had that principle in his head, he could multiply without end the forms in which it could be made to operate.(*u*) In Neilson's case, the claim was for the use of heated air for blast-furnaces; it was held that the use of the hot blast was an infringement, by whatever apparatus it was applied.(*x*)

In a case of a patent for welding tubes without a mandrel, by circumferential pressure at a welding heat, the apparatus mentioned as used by the patentee consisted of dies or tongs with conical holes, through which the tube was drawn. Welding tubes by passing them through grooved rollers placed one above another, was held by Lord Lyndhurst, C. B. to be an infringement, on the evidence of Mr. Donkin and *Mr. [*138] Brunel, that the mode of operation of the two contrivances was the same in principle.(*y*)

25. If the principle is applied in the same way, the want of two or three circumstances in the defendant's application, which are contained in the plaintiff's specification, will not affect the question.(*z*)

26. If any one of several improvements mentioned in a patent is imitated, that is a use of the invention. A declaration in case, for the

(*r*) Walton v. Potter, Webst. P. C. 591, Tindal, C. J. See ante, p. 18.
(*s*) Barber v. Grace, 1 Exch. 339.
(*t*) Per Lord Cottenham, Neilson v. Thompson, Webst. P. C. 283; Morgan v. Seaward, Webst. P. C. 171; Cochrane v. Braithwait and Ericsson, 1 Carp. R. 493; ante, p. 81.
(*u*) Jupe v. Pratt, per Alderson, B. Webst. P. C. 146; Crossley v. Beverley. Webst. P. C. 106.
(*x*) The Houschill Company v. Neilson, Webst. P. C. 688.
(*y*) Russell v. Cowley, Webst. P. C. 462; Russell v. Ledsam, 14 M. & W. 580.
(*z*) Jones v. Pearce, Webst. P. C. 124.

infringement of a patent for giving signals and sounding alarms in distant places by means of electric currents transmitted through metallic circuits, alleged that the defendant had used the invention. The jury having found that there had been an infringement in respect of one of the improvements, it was held to be a sufficient finding of the infringement alleged in the declaration.(*a*)

27. It is an infringement if the defendant has pirated a material part of that to which the patent applies. If he has used that part for the purposes to which the patentee applied his invention, and for which he has taken his patent, and the jury find that the substitute used by the defendant is substantially the same thing, it is an infringement. An invention consisted in lining the boxes for axletrees with metallic compositions and alloys, as pewter, of which tin is the basis, and retaining the lining in its place by means of rims and fillets. Friction was avoided by the use of the soft metal. The defendant having lined his boxes with tin, worked upon their interior surface by means of a soldering-iron, without any rims or projections, the judge left it to the jury to say whether the part which the defendant had infringed was a new part of the invention, and whether the two contrivances were substantially the same. The jury having found for the plaintiff, the Court thought the direction correct.(*b*.)

28. The question of infringement by chemical equivalents involves matter of consideration materially different from the *question of [*139] infringement by mechanical equivalents.(c) Mechanics is a deductive science, naturally growing from the observation of common phenomena. The separate action of two mechanical forces being known, the result of their combined action can be predicated. In chemistry it is very different. Two bodies, such as muriatic acid gas and ammoniacal gas, being brought together, no previous reasoning could tell us that from these two gases a solid would be produced; and nothing inherent in themselves could enable us to say that the acid character of the one and the alkaline character of the other would wholly disappear in the resultant. Chemistry, therefore, in its present state, is not so much a deductive as an experimental science.(*d*)

The knowledge of the results of a particular combination of two elements in chemistry does not in general involve a knowledge of the results of the combination of one with what is in fact, but has not been actually ascertained by experiment to be, for the purposes of the invention, a chemical equivalent for the other. Two substances may be nominally identical, and, for all ordinary purposes, the same thing, and yet slight differences in their quality may cause one to be incapable of producing the useful effect attained by the employment of the other. The cases of

(*a*) The Electric Telegraph Company v. Brett and Little, 20 L. J. C. P. N. S. 123; S. C. 10 C. B. 838; Gillett v. Wilby, 9 C. & P. 334; Crosskill v. Tuxford, Cresswell, J. N. P. 28 Newt. Lond. Journ. 141.

(*b*) Newton v. Grand Junction Railway. 5 Exch. 331. See Hancock v. Somervell, 39 Newt. Lond. Journ. 158.

(*c*) Per Pollock, C. B. 5 Exch. 326.

(*d*) Dr. Lyon Playfair's Lecture on the Chemical Principles involved in the Results of the Great Exhibition.

Muntz's patent for sheathing, Christ's patent for the production of white enamelled surfaces for copperplate printing, and Derosne's patent for filtering cane juice, are instances in which this fact has been brought to the notice of the Courts.(*e*)

29. A very slight difference in a process may be of the highest importance.(*f*)

30. If for a part of the patentee's invention any well-known chemical equivalent is substituted, there can be no doubt but that this would be an infringement.(*g*)

31. It is doubtful whether a patent for a chemical composition is infringed by the use of an equivalent for one of *the substances [*140] employed, which was not known to be such by ordinary chemists at the date of, or described as such in, the specification.(*h*) The subject was much discussed in a recent case in the Exchequer Chamber. Erle, J. thought that a patent for the use of a substance in a process was infringed by the use of a chemical equivalent for that substance, known to be such at the time of the use, if used for the purpose of taking the benefit of the patent, and of making a colourable variation from it.(*i*) Coleridge, J. and Alderson, B. in accordance with the view of the Court of Exchequer, considered that if the equivalent was not known to be such at the time of the patent, nor by the defendant at the time of his using it, its application constituted a new discovery, and was not within the patent.

Alderson, B. put the question of equivalents thus:—"The equivalent being known as a part of the general knowledge of the world, he who by his specification describes the ingredients which he uses, describes also all those known equivalents, and so does, in fact, communicate to the world, by his specification, the knowledge of the equivalent, and on this knowledge, thus impliedly communicated, he who afterwards uses the equivalent really acts. If the equivalent be not known before, he who discovers the equivalent, if it can be used more advantageously than the substance for which it is the equivalent, has, by the use of the equivalent, improved on, and not infringed the original invention." The same view of the case was taken by Coleridge, J. and it does not seem to be inconsistent with the decision of the Court of Exchequer Chamber in the case.(*k*)

32. The fact that the defendant did not intend to imitate the patent process seems not material to be considered.(*l*) The question is what the defendant has done, not what he intended.

33. If a patent is obtained for the use of a composite substance in

(*e*) Muntz v. Foster, 2 Law Times, 325; S. C. Carpmael on Patents, 25, Tindal. C. J., N. P.; Sturtz v. De la Rue, 5 Russ. 325; Derosne v. Fairie, Webst. P. C. 158.

(*f*) Edwards v. Da Costa, 36 Newt. Lond. Journ. C. S. 130; ante, 17.

(*g*) Heath v. Unwin, 13 M. & W. 593.

(*h*) See Heath v. Unwin, 13 M. & W. 583, per Coleridge, J. and Alderson, B.; Heath v. Unwin, 22 L. J. C. P. 7; 16 Jurist, 996, S. C.

(*i*) Heath v. Unwin, 22 L. J., C. P. 7; 16 Jurist, 996.

(*k*) Heath v. Unwin, 22 L. J., C. P. 7; S. C. 16 Jurist, 996.

(*l*) Heath v. Unwin, 16 L. J. N. S. Chy. 283; Stevens v. Keating, L. C. there cited; Stead v. Anderson, 4 C. B. 806, 833.

combination with other things, the use of the *elements of that substance under such circumstances that the composite substance will be formed in the course of the process, seems to be an infringement of the patent for the use of the composite substance.(*m*) It is merely a different mode of employing the same thing. So it seems that a patent for the use of the elements of a substance may be infringed by their use in a compounded state. A patent was obtained for the use of acid and alkali in the formation of artificial stone. It was urged that it was infringed by the use of borax, which is a salt; in other words, an acid and an alkali in combination.(*n*) When the case was before Lord Cottenham, on a motion to dissolve an injunction, he said that the defendant did in fact profess to make a cement of the same materials as the plaintiff used, though in a different combination, and that there could hardly be a question of the plaintiff's right to an injunction.(*o*) The point was not finally decided, as the patent was held bad at law. [*141]

34. The case of Heath v. Unwin is a very important one upon this subject. Heath took out a patent for certain improvements in the manufacture of iron and steel, and declared the nature of his invention to be the use of carburet of manganese in any process in which iron is converted into cast-steel. He described the process thus:—"I propose to make an improved quality of cast-steel, by introducing into a crucible bars of common blistered steel, broken as usual into fragments, or mixtures of cast and malleable iron, or malleable iron and carbonaceous matter, along with from one to three per cent. of their weight of carburet of manganese, and exposing the crucible to the proper heat for melting the materials, which are, when fluid, to be poured into an ingot-mould in the usual manner. I do not claim any mixture of cast and malleable iron, or malleable iron and carbonaceous matter, but only the use of carburet of manganese in any process for the conversion of iron into steel." Before his discovery it was practically impossible to produce cast-steel capable of being welded with iron, except Swedish, and some other iron of the best quality. Unsuccessful attempts had been made to alloy the steel with oxide of manganese. Mr. Heath discovered, *that when carburet of manganese (which is the product of oxide of manganese and coal tar, or carbonaceous matter, exposed to an intense heat in a pot lined with charcoal), was put into a pot with blistered steel, a steel was formed capable of being welded, and a very superior quality to any before produced. Mr. Heath manufactured carburet of manganese at great expense, for the purpose of employing it in producing such cast-steel. It was afterwards discovered that if the oxide of manganese and coal-tar, or carbonaceous matter, were put together with the bar steel into the pot, the same result would take place. The defendant availed himself of this, and at a much less cost produced the same quality of steel. [*142]

On the trial before Mr. Baron Parke, in 1844, the jury found that the black oxide of manganese put with carbon into a crucible containing blistered steel would form carburate of manganese in a fused state before

(*m*) Heath v. Unwin, 22 L. J., C. P. 7; 16 Jurist, 996, S. C.
(*n*) Stevens v. Keating, 2 Exch. 776.
(*o*) Stevens v. Keating, 30 Newt. Lond. Journ. C. S. 62.

any combination with the steel; but that the quality of carburet so formed would be less than one per cent. of the weight of the steel in the crucible. They stated also, that the merit of the plaintiff's invention consisted in putting into the crucible a sufficient quantity of carbonaceous matter to neutralise the oxide, and form carburet of manganese without depending upon the carbon contained in the materials of the crucible, or existing in the blistered steel. They found, that carbon and black oxide of manganese had never before the date of the patent been used practically in making steel. Upon these facts, Baron Parke, in delivering the judgment of the Court, said, "In order to decide whether the defendant is guilty of an infringement, we must determine for what invention the patent, as explained by the specification, is taken out. It is not for the use of oxide of manganese in the melting of cast-steel, for the carburet is mentioned and distinguished from the oxide, nor could a patent for the use of the oxide be supported, as the substance had been used long before in the process of melting steel. Nor is it for the use of oxide of manganese in any mode of combination with carbon generally. If it had been, it would have been liable to a similar objection, as oxide of manganese had been used in crucibles containing in their construction a quantity of carbonaceous matter, with a portion of which it would necessarily combine during the process. The patent was obtained for the [*143] use of *one peculiar combination of carbon and manganese, the metallic substance called carburet of manganese, and for the use of it in that state. The defendant has not directly infringed the patent, nor indirectly; because that which was used was not a well-known equivalent. There is no reason to think that before the inquiry, the defendant, or any one else, knew that the carburet would be formed in a state of fusion."(*p*) On a second trial, Mr. Justice Cresswell, considering himself bound by the judgment of the Court of Exchequer, directed the jury, that there was no evidence of an infringement. On this trial it appears to have been in evidence, that the carburet of manganese formed an alloy with the steel. Taking that alloy to be the invention, the majority of the judges in the Court of Exchequer Chamber thought that any mode of forming it by bringing the two substances together was a direct infringement, and that the defendant's mode of working was merely a neater way of combining them.(*q*)

In accordance with the view of the Court of Exchequer Chamber, Knight Bruce, V. C., in the case of Muntz's patent for sheathing, made of a mixture of the purest zinc and copper, said, "That if, in the course of the defendant's process, the zinc and copper were purified so as to be of the same pure character as directed to be used by Muntz's specification, he should consider this a colourable evasion."(*r*)

35. In the case of a patent for the combination and use of materials, known and used before for the same purpose, in a particular combination

(*p*) Heath v. Unwin, 13 M. & W. 583.
(*q*) Heath v. Unwin, 22 L. J., C. P. 7; 16 Jurist, 996, S. C.
(*r*) Muntz v. Foster, 24 Newt. Lond. Journ. C. S. 299, V. C. B.

and proportion, if the specific proportions be materially departed from, it is no infringement.(*s*)

36. In order to show to the Court what is really the subject of the patent, the patentee must put in and prove his patent and specification, and if the patent purports to be for an improvement on a former patent, then the former specification must also be proved.(*t*)

37. The similarity of structure in two specimens of manufactured *goods may afford presumptive evidence of their having [*144] been made in the same way.(*u*) In other cases the large consumption by the defendant, of the materials employed in the patent process unaccounted for, except on the supposition that they were employed as in the pa ent process, coupled with the similarity of defendant's goods to those made by the patent process, has been relied on.(*x*) (See post, *Inspection.*)

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*CHAPTER XVI. [*145]

PROPERTY IN PATENTS.—ASSIGNMENTS.—LICENSES.

1. THE right to a patent is assignable and devisable; it is personalty, and goes to the executor. If obtained by an uncertificated bankrupt, the patent vests in his assignees. The schemes which a man may have in his own head before he obtains his certificate,(*a*) do not pass; nor can the assignees require him to assign them, provided he does not carry his schemes into effect till after he has obtained his certificate. But if he has availed himself of his knowledge and skill, and thereby acquired a beneficial interest which may be the subject of assignment, that interest will pass to the assignees.(*b*) It seems doubtful whether an invention provisionally protected would pass.

2. Patents granted before the passing of the recent statute, contain a condition for making void the patent if it becomes vested in more than twelve persons. Originally the condition taken from the Bubble Act, which before its repeal in 1826 used to be recited, limited the liberty of holding a patent to five persons. In May, 1832, Sir Thomas Denman, then Attorney-General, with the consent of the Board of Trade, sub-

(*s*) Hill v. Thompson and Forman, Webst. P. C. 239; 8 Taunt. 382. Stevens v. Keating, 2 Exch. 777.

(*t*) Lewis v. Davis, 3 C. & P. 502; Webst. P. C. 488.

(*u*) Huddart v. Grimshaw, Webst. P. C. 92.

(*x*) Hall v. Jarvis, Webst. P. C. 100.

(*a*) As to a secret, see in re Feaver, Court of Bankruptcy, Times, Feb. 20, 1843.

(*b*) Hesse v. Stevenson, 3 Bos. & Pull. 565. See Bloxham v. Elsee, 6 B. & C. 169.

stituted the provision, that no more than twelve persons should be interested.(c)

3. Stat. 15 & 16 Vict. cap. 83, s. 37, enacts, that notwithstanding any proviso in former letters patent, it shall be *lawful for a larger [*146] number than twelve persons hereafter to have a legal or beneficial interest in such letters patent.

With regard to assignments made before the passing of this Act, it may be noticed that assignments to trustees for the benefit of creditors, though more than twelve, do not avoid a patent.(d) And that it is wholly immaterial in how many persons licenses to use a patent, whether exclusive or not, may have become vested.(e)

4. By stat. 15 & 16 Vict. cap. 83, s. 35, the grantee or grantees of letters patent to be hereafter granted may assign the letters patent for England, Scotland, or Ireland respectively, as effectually as if the letters patent had been originally granted for England, or Scotland, or Ireland only; and the assignee or assignees shall have the same rights of action and remedies, and shall be subject to the like actions and suits, as he or they should and would have been subject to upon the assignment of letters patent granted to England, Ireland, or Scotland, before the passing of this Act.

5. The assignment may be by deed or will. A monopoly privilege cannot be assigned at all, unless a power to do so is given by the Crown. As licenses must be under the hand and seal of the patentee, so also must assignments.(f) Under a grant of letters patent reserving the legal interest to the patentee until the determination of a pending suit, on the happening of that event, the legal interest passes to the grantee.(g)

6. The assignor may covenant that the patentee is the true inventor; that the specification is sufficient; that the patent is valid; that he has a right to assign, for quiet enjoyment, for further assurance; that the patentee will do all things necessary to enable the assignee to obtain patents in foreign countries, either in his own name or in the name of the original inventor; and that he will aid in procuring confirmation or extension. A power of attorney to receive and *sue for royal- [*147] ties under existing licenses, in the name of the patentee, may, in some cases, be convenient. If the assignment is of a partial interest, it should contain covenants by the patentee to allow his name to be used in actions and suits for infringements, and to produce the patent in evidence.

7. The assignment must be perfected by an entry in the register of proprietors.

Letters patent have hitherto been the most unmarketable of all titles.

(c) Holroyd on Patents, 137.
(d) MacAlpine v. Magnall, 3 C. B. 496; Bloxam v. Elsee, 1 C. & P. 558, 6 B. & C. 169.
(e) Protheroe v. May, 5 M. & W. 675.
(f) See Sheppard's Touchstone, 231; Duvergier v. Fellows, 10 B. & C. 829. See Power v. Walker, 3 M. & S. 7; Davidson v. Bohn, 5 C. B. 460; Leader v. Purday, 7 C. B. 12.
(g) Cartwright v. Annatt, 2 Bos. & Pull. 43.

It has been said, "An objection to the title acquired by a patentee arises out of the nondescript nature of the grant, and the almost total impossibility of ascertaining whether it is encumbered, so that on the sale of a patent, the purchaser must take his chance of the sufficiency of the title, and rely almost entirely on the covenants of the vendor. As it is quite unsettled whether the letters patent pass any legal estate,(*h*) and what is the effect of the bodily possession of the letters patent, it follows, that if a patentee mortgages or grants licenses without delivering up the letters patent, and there is no notice of the charge indorsed, and the patentee then sells, and the purchaser takes possession of the letters patent, it is uncertain whether he takes subject to the mortgage or license, or not.(*i*) —14 Jurist, 462.

8. These difficulties will be remedied for the future by the enactment that until an entry shall have been made in the register of proprietors, the grantee or grantees shall be deemed and taken to be the sole and exclusive proprietor or proprietors of such letters patent, and of all the licenses or privileges thereby given and granted.(*j*) The certificate of the entry of an assignment or license is subject to a stamp-duty of five shillings, and the certificate of the assignment or license, five shillings.

From a perusal of the rest of the section, it would appear that, in enacting this clause, the Legislature had rather in view the facilitating proceedings by scire facias, than the rendering the titles to letters patent secure and marketable.(*k*) *But is to be hoped that convenience, as well as the analogy of the construction put upon stat. 5 & 6 Wm. 4, cap. 83, s. 4, will induce the courts to construe the word grantee as meaning the person appearing on the register to be the grantee either of the Crown or the original patentee.(*l*) [*148]

9. Erroneous or improper entries in the register of proprietors may be expunged by an order of the Master of the Rolls, or of any of the courts of common law in term time, or any judge thereof in vacation. It is enacted, that if any person shall deem himself aggrieved by any entry made in the registry of proprietors, it shall be lawful for such person to appply by motion to the Master of the Rolls, or to any of the courts of common law at Westminster in term time, or by summons to a judge of any of the said courts in vacation for an order that such entry may be expunged, vacated, or varied; and upon any such application the Master of the Rolls, or such court or judge, respectively, may make such order for expunging, vacating, or varying such entry, and as to the costs of such application to the said Master of the Rolls, as to such court or judge may seem fit; and the officer having the care and custody of such register, on the production to him of any such order for expunging,

(*h*) Another writer in the Jurist, vol. vii. pt. 2, p. 242, says, "Letters patent do not profess to vest in the grantee any estate; they merely grant him a power." See 7 Jarm. by Sweet, 536.

(*i*) See Jones v. Jones, 8 Sim. 633; Wilmot v. Pike, 5 Hare, 14.

(*j*) Stat. 15 & 16 Vict. cap. 83, s. 35.

(*k*) See Report on the Patent Law Amendment Bills, 1851, p. 376.

(*l*) See Russell v. Ledsam, 14 M. & W. 574; Ledsam v. Russell, 16 M. & W. 633.

vacating, or varying any such entry, shall expunge, vacate, or vary the same according to the requisitions of such order.(*m*)

10. A mere licensee cannot maintain any action against any one else for the piracy of the invention.(*n*) But perhaps the proprietor of any partial interest, or a person having an exclusive license from the patentee, might do so in respect of any injury to his separate interest.(*o*) Or he might join with all the other persons interested in the patent in any action or suit relating to the matter affecting their common interests.(*p*) But the better opinion would seem to be, that a licensee, or a person who has only a grant from the patentee, of the sole right in a particular locality, or to exercise some only of the inventions in respect of which a [*149] sole right is conferred by the *patent,(*q*) has no such interest as will enable him to maintain a separate action in his own name.(*r*) Until a recent alteration of the law enabling him, it was held in the United States that the grantee for a particular district was not an assignee of the patent and could not sue.(*s*)

11. A license appears to be a personal privilege which cannot be granted over to another by the licensee. At any rate, it cannot be divided and assigned in part.(*t*)

12. A license should be under the hand and seal of the patentee; but it will not be void though it is by parol only. To grant a license not under seal may be a contempt of the Crown, but the man to whom it is granted, and who has derived a benefit from it, must pay the price of it.

If a person to whom a license to use a patent is granted by an instrument not under seal, keeps it, and acts upon it, he will be taken to have waived all objection on the score of the want of a seal.(*u*)

13. A license to use a patented invention, though under seal, need not be by deed. If it does not appear to have been delivered as a deed, it does not require a stamp, as a deed not otherwise charged within the meaning of 55 Geo. 3, cap. 189, sched. part 1, tit. Deed.(*x*)

14. It will be convenient that licenses should contain provisoes against alienation.

A stipulation may be introduced, that the inventor, on being indemnified, shall commence and prosecute actions or suits, or allow his name to be used by the licensee in proceedings against persons pirating the invention.

(*m*) Stat. 15 & 16 Vict. cap. 83, s. 38.

(*n*) Derosne v. Fairie, per Lord Abinger. N. P. Webst. P. C. 154.

(*o*) See George v. Wackerback, Godson on Patents, 226.

(*p*) Coryton v. Lithebye, 2 Saund. 115, 116; Weller v. Baker, 2 Wils. 423.

(*q*) See American cases, Blanchard v. Eldridge, J. W. Wallace Rep. 337, cited in Putnam's Digest for 1850, tit. Patent, 3; Gayler v. Wilder, 10 Howard's Supreme Court Reports, 477, 494.

(*r*) See Co. Litt. 164, 165; Lord Mountjoy's case, Godbolt, 17; Boosey v. Davidson, 13 Q. B. 259; Protheroe v. May, 5 M. & W. 675.

(*s*) Tyler v. Tuel, 6 Cranch, R. 324, cited Curtis on Patents, 310.

(*t*) Brooks v. Byam, 2 Story Rep. 544; Com. Dig. Grant, 9. See Protheroe v. May, 5 M. & W. 675, 684; Pidding v. Franks, 1 Macnaght. & Gord. 593.

(*u*) Chanter v. Dewhurst, 12 M. & W. 823. See in this case the form of a count *in assumpsit*, for money due for the grant of a license.

(*x*) Chanter v. Johnson, 14 M. & W. 408.

The right to damages to be awarded in such actions, may be reserved to the patentee.

15. By granting or accepting an interest or license as *against such person, a man may be estopped from disputing the validity of a patent. In an action by the assignee of a patentee against the patentee, for infringing the patent-right assigned by him, the patentee will not be permitted to set up that his invention was not a new one.(*y*) [*150]

If, acting under a license, a man has actually used the invention by the permission of the patentee, he cannot afterwards set up that the patent is void in answer to an action for rent during the time he had the enjoyment; nor can he recover back the rent he had paid for the use of the invention,(*z*) unless he can also show that he was induced to take the license by the fraud of the patentee.(*a*)

In covenant on an indenture for the non-payment of rent due for license, the licensee will be estopped by a recital in the indenture from alleging that the patentee was not the first inventor, if he has had enjoyment under the license.(*b*)

By the acceptance of rent accruing due subsequent to a breach of covenant, involving a forfeiture of a license, the patentee will be estopped from insisting on the breach of covenant as a forfeiture.(*c*)

16. In Hayne v. Maltby, by articles of agreement under seal, reciting that the plaintiffs were assignees of one Taylor, of a patent for a machine for making net, they gave license to the defendant freely to use a machine in a particular manner, and the defendant covenanted not to use any other machine.

It was held that the defendant was at liberty, in answer to an action for using other machinery, to allege that the patentee was not the first inventor, and that no specification was enrolled.(*d*) The case has been often doubted,(*e*) but is, perhaps, sustainable on the ground that the covenant, being in restraint of trade, required a consideration to support it.(*f*)

*17. Although a party has dealt with the patentee for a license at a rent, yet he may stop; and if he can show that the grantee has no title to the patent, he may do so in answer to an action for subsequent rent. He is not estopped by the acceptance of the grant of the license, except during the continuance of actual enjoyment under it.(*g*) When a court of equity directs an action against a person having an equitable [*151]

(*y*) Oldham v. Langmead, Lord Kenyon, 3 T. R. 441.
(*z*) Taylor v. Hare, 1 N. R. 260; May v. Trye, Freem. 447.
(*a*) Lovell v. Hicks, 2 Younge & Collyer, 46; ib. 484.
(*b*) Bowman v. Taylor, 2 A. & E. 278. See Cutler v. Bower, 11 Q. B. 973.
(*c*) Warwick v. Hooper, 3 MacNaght. & Gord. 60.
(*d*) Hayne v. Maltby, 3 T. R. 438. See Baird v. Neilson, 8 Clark & Finnelly, 726.
(*e*) See 8 C. B. 712. Per Maule, J. 2 A. & E. 292.
(*f*) See Mitchell v. Reynolds, 1 P. Wms. 181, cited 3 T. R. 440.
(*g*) Neilson v. Fothergill and Thompson, Webst. P. C. 289, 290, Lord Cottenham; Stocking v. Llewellyn, 3 Law Times, 33; Hayne v. Maltby, 3 T. R. 441. See Stroughill v. Buck, 19 L. J. N. S. Q. B. 209.

assignment of a license, it will not restrain him from trying the validity of the patent.(*h*)

As to a contract not under seal for license to manufacture and sell several patented inventions, where one of the inventions was not new, see the case of Chanter v. Leese.(*i*)

18. It has been determined in the United States, that a grant of a patentee of an exclusive right to use a machine, and vend the same to others for use within a specified district, authorizes the grantee to vend the products of the machinery elsewhere out of the district.(*k*)

19. A curious discussion has taken place in the American courts, as to the right of a person entitled to use a particular patented machine, to repair it, not making it a new machine.(*l*)

[*152] *CHAPTER XVII.

EVIDENCE.—SEARCHES, AND INSPECTIONS.—REGISTERS.

1. EVERY patentee is bound to know the existing records, but hitherto he has had no means of access to them. He could not go through all the offices except at a very great expense; and if he did, he could not be secure that he had not missed something. Patentees did not attempt it. Practically speaking, old specifications were of no use. Mr. Webster said, "they ought to be burned, rather than left as they were."

2. By stat. 15 & 16 Vict. cap. 83, s. 28, every provisional specification and complete specification, left or filed at the office of the Commissioners on the application for any letters patent, shall forthwith, after the grant of the letters patent, or, if no letters patent be granted, then immediately on the expiration of six months from the time of such application, be transferred to and kept in the office appointed for filing specifications in Chancery.

3. True copies of all specifications, disclaimers, and memoranda of alterations filed under or in pursuance of the Patent Law Amendment Act, 1852, are to be open to the inspection of the public at the office of the Commissioners, and at an office in Edinburgh and Dublin respectively, at all reasonable times, subject to such regulations as the Commissioners may direct.

Provisional specifications are to be open for inspection after the provisional protection has expired.(*a*)

4. Specifications, disclaimers, and memoranda of alterations deposited or filed under the Act (not being provisional specifications), *are [*153] to be printed and published as soon as conveniently may be after the filing thereof. Provisional specifications are to be printed and pub-

(*h*) Pidding v. Franks, 13 Jur. 593, Chy.; 1 MacNaght. & Gord. 56.
(*i*) Chanter v. Leese, 4 M. & W. 295. In Cam. Scacc. 5 M. & W. 698.
(*k*) See Simpson v. Wilson, 4 Howard Rep. 709, cited Curtis, 257.
(*l*) Simpson v. Wilson, 9 Howard Rep. 109. (*a*) 15 & 16 Vict. cap. 83, s. 29.

lished as soon as convcniently may be after the expiration of the provisional protection.(*b*) They are to be sold at such prices as the Commissioners shall think fit.

The Commissioners may present copies of all such publications to such public libraries and museums as they may think fit, and allow the person depositing or filing any such specification, disclaimer, or memorandum of alteration, to have such number, not exceeding twenty-five, of the copies thereof so printed and published, without any payment for the same, as they may think fit.(*c*)

5. With regard to the specifications of existing patents, the Lord Chancellor and the Master of the Rolls may direct the enrolment of specifications, disclaimers, and memoranda of alterations heretofore or hereafter enrolled or deposited at the Rolls Chapel Office, or at the Petty Bag Office, or at the Enrolment Office of the Court of Chancery, or in the custody of the Master of the Rolls as keeper of the Public Records, to be transferred to and kept in the office appointed for filing specifications in Chancery under this Act.(*d*)

6. The Commissioners shall cause indexes to all specifications, disclaimers, and memoranda of alterations heretofore or to be hereafter enrolled or deposited as last aforesaid, to be prepared in such form as they may think fit; and such indexes shall be open to the inspection of the public at such place or places as the Commissioners shall appoint, and subject to the regulations to be made by the Commissioners; and the Commissioners may cause all or any of such indexes, specifications, disclaimers, and memoranda of alterations, to be printed, published, and sold in such manner and at such prices as the Commissioners may think fit.(*e*)

Stat. 16 Vict. cap. , s. , empowered the Commissioners to purchase certain indexes prepared by Mr. Bennett Woodcroft.

*7. The fee for searches and inspections of specifications filed under the new Act, is one shilling.(*f*) For searches in the Enrolment, Petty Bag, and Rolls Chapel Offices, the fee is one shilling. At the Enrolment and Rolls Chapel Offices, the fee for a search includes an inspection. At the Petty Bag Office, the fee for an inspection is two shillings and sixpence, besides the fee for the search.(*g*) [*154]

At the Rolls Chapel Office persons may, in pencil, take extracts from or copies of any part of the enrolment of a specification.

The charge for office or other copies of documents in the Great Seal Patent Office, is twopence for every ninety words, which is collected by stamps. An additional charge will be made for copies of drawings.(*h*)

As to the cost of office copies in the other offices, see the table of fees in the Appendix.

(*b*) 15 & 16 Vict. cap. 83, s. 30.
(*c*) 15 & 16 Vict. cap. 83, s. 30.
(*d*) 15 & 16 Vict. cap. 83, s. 31.
(*e*) 15 & 16 Vict. cap. 83, s. 32.
(*f*) Stat. 15 & 16 Vict. cap. 83, schedule.
(*g*) Rules of the Petty Bag Office, 1848.
(*h*) Order of Lord St. Leonards, 1852.

8. Hitherto it has been the practice to enter from the docket the titles and particulars of all letters patent, in a book at the Great Seal Office. From this book, which is accessible to the public, the extracts were made, which were published in various books. This book, and the enrolment of the patent and specification, were the only authentic evidences of the patent and specification accessible to the public.(*i*)

9. There shall be kept at the office appointed for filing specifications in Chancery a book or books, to be called "The Register of Patents," wherein shall be entered and recorded in chronological order all letters patent granted under this Act, the deposit or filing of specifications, disclaimers, and memoranda of alterations filed in respect of such letters patent, all amendments in such letters patent and specifications, all confirmations and extensions of such letters patent, the expiry, vacating, or cancelling such letters patent, with the dates thereof respectively, and all other matters and things affecting the validity of such letters patent as the Commissioners may direct; and such register, or a copy thereof, [*155] shall be open at all convenient times to the inspection *of the public, subject to such regulations as the Commissioners may make.(*k*)

10. As an official register, this book will be evidence of the filing of specifications, disclaimers, and memorandums of alterations filed under the Patent Law Amendment Act, 1852, and of the date of such filing or deposit. And as it is of a public nature, its contents may be proved by copy or extract, provided it be proved to be an examined copy or extract, or provided it purport to be signed and certified as a true copy or extract by the officer to whose custody the original is intrusted.(*l*)

11. The patent may be proved by production of the instrument itself: the Great Seal proves itself. A patent passed before October 1, 1852, may be proved by an exemplification of the enrolment of it in Chancery under the Great Seal.(*m*)

But as there will be no record in Chancery of patents passed after October 1, 1852, in the event of loss, the patentee must prove his patent by a new patent obtained under the provisions of the 22d section of the new Act.

12. With regard to specifications of patents passed after the 1st of October, 1852, by stat. 15 & 16 Vict. cap. 83, s. 33, copies printed by the Queen's printer of specifications, disclaimers, and memoranda of alterations, shall be admissible in evidence, and deemed and taken to be primâ facie evidence of the existence and contents of the documents to which they purport to relate, in all courts, and in all proceedings relating to letters patent.

13. The proof of the due enrolment of specifications in the Petty Bag Office, is provided for by stat. 12 & 13 Vict. cap. 109, s. 12, which enacts, that the clerk of the Petty Bag Office shall indorse upon any specification which at any time heretofore has been enrolled in the Petty

(*i*) See Webst. P. C. 659, Lord Cottenham.
(*k*) 15 & 16 Vict. cap. 83, s. 34.
(*l*) Stat. 14 & 15 Vict. cap. 99, s. 14.
(*m*) See stat. 13 Eliz. cap. 6. See Page's case, 5 Rep. 53, *b*.

Bag Office, provided the enrolment shall be then in his custody, a certificate, stating that such specification was enrolled and the day of its enrolment; and such certificate, sealed with the Chancery common-law seal, is to be evidence of its enrolment on that day.

*Section 13 makes office copies, sealed with the Chancery common-law seal, evidence of the contents of such records, and that they are records of the Court of Chancery. [*156]

14. The due enrolment of specifications, disclaimers, and memoranda of alterations enrolled in the Enrolment Office in Chancery, may be proved by the certificate of the clerk of the Enrolment Office, indorsed on the specification, stating that the specification has been enrolled in the office, and the day of the enrolment; such certificate being stamped with the seal of the Chancery Enrolment Office.(*n*)

All documents or writings stamped with the seal of the Chancery Enrolment Office, including drawings thereunto annexed, are to be deemed true copies of such enrolments, and of such drawings; and shall be received in evidence as proving the contents of such enrolments, and that they are records of the court, and of the date of filing or entering them.(*o*)

15. Copies of enrolments in the Rolls Chapel Office, certified by the deputy keeper of records, or one of the assistant record-keepers, and purporting to be sealed or stamped with the seal of the Record Office, are by stat. 1 & 2 Vict. cap. 96, ss. 12, 13, made evidence without further or other proof.

16. Should the enrolments be removed from these offices to the office for filing specifications in Chancery, the time and fact of the enrolment may be proved by an examined copy of the enrolment of the specification, and of the certificate of enrolment, written at the foot of it, signed by the officer in whose custody it is.(*p*)

Until the making of the several statutory provisions for facilitating the proof of specifications, the only mode of proving them was by producing the original specifications from the offices.

17. The entry of a disclaimer with the clerk of the patent seems to be only proveable by the production of the original copy entered.

18. There shall be kept at the office appointed for filing specifications in Chancery under this Act, a book or books, entitled, "The Register of Proprietors," wherein shall be entered, in such manner as the Commissioners shall direct, *the assignment of any letters patent, or of any share or interest therein; any license under letters patent, and the district to which such license relates, with the name or names of any person having any share or interest in such letters patent or license; the date of his or their acquiring such letters patent, share, and interest; and any other matter or thing relating to or affecting the proprietorship in such letters patent or license. "And such register, or a copy, shall be open to the inspection of the public at the office of the Commissioners of Patent, subject to such regulations as the Commissioners shall make."(*q*) [*157]

(*n*) Stat. 12 & 13 Vict. cap. 109, s. 18.
(*o*) Stat. 12 & 13 Vict. cap. 109, s. 19.
(*p*) See 14 & 15 Vict. cap. 99, s. 14.
(*q*) 15 & 16 Vict. cap. 83, s. 35.

On the entry of an assignment or license, a stamp-duty of ten shillings is payable; for every search and inspection, one shilling. Certified duplicates of all entries made in the register of proprietors, are to be forthwith transmitted to the office of the Commissioners in Edinburgh and Dublin, where the same shall also be open to the inspection of the public.(*r*)

19. A copy of any entry in the "Register of Proprietors," certified under such seal as may have been appointed, or may be directed by the Lord Chancellor to be used in the office for filing specifications in Chancery, shall be given to any person requiring the same, on payment of the fees in the Act provided. And such copies so certified, shall be received in evidence in all courts and in all proceedings, and shall be primâ facie proofs of the assignment of such letters patent, or share or interest therein, or of the license or proprietorship as therein expressed.(*s*)

Every certificate of assignment or license is subject to a stamp-duty of five shillings.(*t*)

20. Until an entry is made in this book, the grantee or grantees of the letters patent shall be deemed to be the sole and exclusive proprietors of such letters patent, and of all licenses and privileges thereby given and granted.(*u*) It would therefore appear, that the production of a deed of conveyance or of a license, would not be sufficient evidence of the title of the person named therein.

[*158] 21. *The falsification of entries in the "Register of Proprietors," is a misdemeanor. If any person shall wilfully make, or cause to be made, any false entry in the "Register of Proprietors," or shall wilfully make or forge, or cause to be made or forged, any writing falsely purporting to be a copy of any entry in the said book, or shall produce or tender, or cause to be produced or tendered in evidence, any such writing, knowing the same to be false or forged, he shall be guilty of a misdemeanor, and shall be punished by fine and imprisonment accordingly.(*x*)

We have seen that erroneous entries in this book may be expunged by an order of the Master of the Rolls, or a Court, or judge of a superior court of common law.(*y*)

[*159] *CHAPTER XVIII.

REMEDIES OF PATENTEE.—ACTION AGAINST INFRINGER.

SECTION I.—NATURE OF REMEDY.

1. THE remedies available to the patentee are by action to recover

(*r*) 16 Vict. cap. , schedule; 15 & 16 Vict. cap. 83, s. 35.
(*s*) 15 & 16 Vict. cap. 83, s. 35. (*t*) Stat. 16 Vict. cap. , schedule.
(*u*) 15 & 16 Vict. cap. 83, s. 35, ante p. 147.
(*x*) Stat. 15 & 16 Vict. cap. 83, s. 37.
(*y*) Stat. 15 & 16 Vict. cap. 83, s. 38, ante, p. 148.

damages for any injury he may have sustained by the invasion of his privilege, by injunction to restrain infringements for the future, and by suit or order for an account of the profits which have been made by the offending parties by the wrongful use of the invention.

2. Until the passing of 15 & 16 Vict. cap. 83, s. 42, courts of law had no power to issue injunctions, or order an account of profits. Before 14 & 15 Vict. cap. 99, they could not compel the disclosure of evidence exclusively within the knowledge of the defendant. Now, in any action in any of her Majesty's superior courts of record at Westminster and in Dublin for the infringement of letters patent, it shall be lawful for the Court in which such action is pending, or for any judge of such court, on the application of the plaintiff or defendant respectively, to make such order for an injunction, inspection, and account, and to give such direction respecting such action, inspection, and account, and the proceedings therein respectively, as to such Court or judge may seem fit.

3. For the future, it is probable that the greater part of patent litigation will commence and be determined in the superior courts of common law. The above-cited enactment, in conjunction with the provisions of stat. 14 & 15 Vict. cap. 99, will, in almost all cases, supersede the necessity of proceeding in Chancery.(*a*)

*4. The right conferred by letters patent appears to be a franchise within the meaning of that word in stat. 9 & 10 Vict. cap. 95, s. 58, and therefore, if a plaint for the infringement of a patent is entered in the County Court, the jurisdiction of the court would be ousted by any defence putting the title of the patentee, or the validity of the patent, in question. [*160]

5. Hitherto, patentees relying chiefly on their remedies in the Court of Chancery, have seldom obtained or asked for more than nominal damages in actions for the infringement of a patent. There is often considerable difficulty in laying down rules as to the principle on which the damages should be assessed. In Neilson v. The Househill Company, tried before Lord Justice-Clerk Hope, it was proved that the saving by the use of the plaintiff's patent apparatus was £2. 2s. per ton of iron manufacture. The answer was, that profit was not made. The judge said, "That is no answer in point of law. It is for the jury to say whether that saving amounted to £3,400, the sum calculated. I am bound to tell you that in point of law the pursuer is entitled to claim the benefit of the saving made by the use of his apparatus. But it is said, it does not follow that he is entitled to obtain in law the whole of that saving. It is impossible to take it as a legal estimate, from which you are not to depart in deliberating on the claim. If you find for the pursuer, you are entitled to weigh the whole matter in your minds.(*b*)

"Then there is another branch of damage,—compensation for the invasion of the patent. Now, the invasion of a patent is just as much an invasion of a man's rights as if you were to make an inroad into his

(*a*) As to a bill of discovery in aid of a defence, see Few v. Guppy, 1 M. & Cr. 487.

(*b*) Neilson v. The Househill Company, Webst. P. C. 697, n. See Crossley v. Derby Gas Company, 3 M. & Cr. 428.

house, or if you were to trespass on his property. It is an injury done to him, and therefore he is entitled to compensation."(*b*) In Neilson v. Baird, it was said that damages ought to be given against the infringer for the injury to the sale of licences.(*c*)

6. A person whose patent right is infringed and denied, and attempted to be destroyed, is not to receive as damages merely the price for which he would peaceably and willingly have sold the use of it to any person coming to ask him for a *license. The defendant can found nothing on the terms on which the plaintiff is in the habit of granting licenses. They are the terms of a contract which he has expressly repudiated.(*d*)

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7. When improvements accessory to the patented invention have been made while the patent was being invaded, if by the improvements the invention protected by the patent has been used to greater advantage, the profit made by means of the improvements is part of the profit made by the unlawful use of the patented invention. Neilson's hot blast was applied with greater advantage by means of Condie's pipes and improved water-twires. No deduction from the amount of profits was allowed, on the ground that part of the profits was derived from the use of these improvements.(*e*)

8. In Newton v. Grand Junction Railway Company, it appeared, that, about six months after the patent was taken out in 1843, the defendants began to line some of the brasses of their axles with tin. They had gone on by degrees increasing their employment of the invention till the commencement of the action in 1845. Cresswell, J. said, that as the defendants had the account, and had not shown to what extent they had used the patent, the jury must make the best guess they could as to what compensation the defendants ought to make to the plaintiff for violating his patent right. The damages were assessed at £1,000.(*f*)

In Russell v. Cowley, the plaintiff, in a bill in Chancery, charged the defendant with selling pipes at prices greatly under their real value, and prayed that the defendants might account for the profits which might or ought to have been made. The case was compromised.(*g*)

9. Now that a court of common law has the power of ordering an account, it would seem a proper and convenient course to obtain an order for an account, and to take a verdict for a large nominal sum, to be reduced to such sum as a *master of the court, or an arbitrator, should find due on the account of profits, added to such damages, if any, as the plaintiff has sustained by the infringement. It would seem to be a proper mode of taking the account, to ascertain the profits which might have been made by the patentee on the articles made, used, or sold by the infringer, had they been made, used, or sold by the patentee; or

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(*b*) Ibid.

(*c*) Neilson v. Baird, Decisions of the Court of Session, 2d ser. vol. vi. 51.

(*d*) Neilson v. Baird, Decisions of the Court of Session, 2d ser. vol. vi. 51.

(*e*) Neilson v. Baird, Decisions of the Court of Session, 2nd series, vol. vi. 51, see per Lord Jeffrey.

(*f*) Newton v. Grand Junction Railway, N. P. 27 Newt. Lond. Journ. C. S. 220.

(*g*) Russell v. Cowley, Webst. P. C. 471, n. See Bacon v. Spottiswoode, 1 Beav. 387.

the profits or saving made by the infringer by his use of the patent right may be claimed.

10. According to the old practice, in the action of account, if the defendant refused to account, or gave an imperfect account, the judgment was that the plaintiff should recover according to the value mentioned in the declaration.(*h*)

11. It has been said, that the fact that the plaintiff had acquiesced in infringements, by neglecting to take proceedings, may be considered by the jury as a ground of mitigating the damages. In Arkwright v. Nightingale, Lord Loughborough said, if the question had been what damages Mr. Arkwright should have received for invading his right, he should have allowed the parties to go into evidence to show to what extent persons had acted on a former verdict against the patentee, he having acquiesced in the result of that decision for three years.(*i*)

SECTION II.—PARTIES, PLEADINGS, ETC.

12. The action should be brought in the names of the persons for the time being legally interested in the patent, who may join as co-plaintiffs.(*k*) If the action is brought in the name of an assignee, it is proper to state the assignment and its nature in the declaration.(*l*)

13. In actions in the case for the infringement of patents, the parties will not be allowed to annex copies of drawings to pleadings setting out the specification. A plea setting out the specification and drawings, and concluding with a *statement that the plaintiff did not particularly describe the nature of the invention, will be set aside.(*m*) [*163]

Drawings were, however, annexed to the pleas in Minter v. Mower, 6 A. & E. 737; and in Bickford v. Skewes, Webst. P. C. 214. The case of a scire facias is said to be peculiar; it contains the whole history of the proceedings.

14. Stat. 15 & 16 Vict. cap. 76, schedule B, No. 31, gives a form of declaration at the suit of a patentee. Forms of declaration and breaches may be seen 2 Chitty on Pleading, 7th ed. 576; Jones v. Pearce, Webst. P. C. 122; Allen v. Rawson, 1 C. B. 552; Stocker v. Warner, 1 C. B. 148; Minter v. Mower, 6 A. & E. 735. By assignee, Bentley v. Keighley, 6 M. & G. 1040. As to breaches by selling, &c., see Minter v. Williams, 4 A. & E. 251; Webst. P. C. 135. Forms stating disclaimer, Stocker v. Warner, 1 C. B. 148; 2 Chitty on Pleading, 7th ed. 578; Perry v. Skinner, 2 M. & W. 471; S. C. Webst. P. C. 350. As to the evidence of a disclaimer, ante, 99, 100, 155, 156. In an action for infringing the undisclaimed part of the invention, the defendant will not

(*h*) Williams v. White, Cro. Eliz. 806, Winch. 5, S. C. See Com. Dig. Accompt, E. 15.

(*i*) Arkwright v. Nightingale, Webst. P. C. 61; Dav. P. C. 37.

(*k*) See Birch v. Wood and Another, 2 Law Times, 2 Cresswell, J.; as to the right of assignees of partial interests and licensees to sue, see ante, p. 148.

(*l*) See Stephen on Pleading, 340; 1 Wms. Saund. 276, E, note 2; Cornish v. Keene, Webst. P. C. 512.

(*m*) Betts v. Walker, 14 Jurist, 647, Q. B. See also Sealy v. Browne, 14 L. J. Q. B. N. S. 169.

be allowed to plead together, as several pleas, that the whole invention was not new, and also that the undisclaimed part was not new.(*n*)

See a form stating a prolongation of the term under the provisions of 5 & 6 Wm. 4, cap. 83, s. 4, and compliance with the conditions on which it was granted.—Russell v. Ledsam, 14 M. & W. 574.

The venue may be laid in any county. It could not have been changed on the common affidavit.(*o*)

15. The plaintiff must deliver with his declaration, particulars of the infringements complained of in the action.

By stat. 15 & 16 Vict. cap. 83, s. 41, it is enacted, that in any action in any of her Majesty's superior courts of record at Westminster or in Dublin, the plaintiff shall deliver with his declaration particulars of the breaches complained of in the said action, and no evidence shall be given of any alleged infringement not contained in the particulars.

[*164] *16. Courts of common law have an inherent jurisdiction to order particulars in writing of the infringements in respect of which the action is brought;(*p*) and it has been the practice to make such orders. By the statute, any judge may allow the plaintiff to amend his particulars on such terms as he may think fit, or he may make an order for better particulars.

In Perry v. Mitchell, the plaintiff had obtained letters patent for the manufacture of improved pens. His specification described thirteen different kinds of improvements, referring to them by numbers. The defendant prayed that he might be informed what particular numbers he was charged with having infringed. The Court granted an order for such particulars.(*q*)

Where particulars can be given without any great difficulty or embarrassment to the plaintiffs, the Court will compel the plaintiff to furnish them.

But when separate actions were brought for alleged infringements of three several patents, and the plaintiffs complained of an infringement by means of an apparatus combining the principles of the three patents, and the matter of the infringement had been fully discussed by affidavits, on a motion for an injunction in the Court of Chancery, the Court considered that the circumstances were not such as to warrant their making the order. The Court in refusing the application said, it might be impossible for the plaintiffs to point out which of the several heads of invention they charged the defendant with having imitated. What was required must necessarily very greatly embarrass the plaintiffs, and they were not satisfied that there was any probability of surprise on the defendant from the want of it; or that he did not possess an adequate amount of information on the subject.(*r*)

17. The burden of proof of the existence of the conditions of the

(*n*) Clark v. Kenrick, 12 M. & W. 219; S. C. 2 D. & L. 392.
(*o*) Brunton v. White, 7 D. & R. 103. See Cameron v. Gray, 6 T. R. 363. See Rules, H. T. 1853, 18.
(*p*) The Electric Telegraph Company v. Nott, 4 C. B. 462.
(*q*) Perry v. Mitchell, Webst. P. C. 269, cited 4 C. B. 467, 469.
(*r*) The Electric Telegraph v. Nott, 4 C. B. 462.

validity of the patent, lies upon the patentee. In the absence of all evidence, the presumption in an action on the patent is against the patent, because an exclusive privilege is against common right. In the American courts, the patent is considered primâ facie evidence of the novelty of the invention; but in America the patent is not granted without inquiry. *In one case, the Court of Session in Scotland adopted the same doctrine,(s) but it is contrary to the uniform course of English decisions. The patentee has therefore a right to begin and prove his case. The courts will not allow a defendant to put his pleas, denying the existence of these conditions, into an affirmative form, for the purpose of depriving the plaintiff of this advantage.(t) [*165]

18. The plea of not guilty puts in issue the fact of the infringement only. The plaintiff may be entitled to a verdict upon this issue, notwithstanding the invalidity of his patent.(u) Unless the patent and specification are set out on the record, and admitted by the pleadings, the plaintiff must prove them though there is no plea denying them, in order to show what is the nature of the right infringed. A plea that the defendant has used an invention protected by a former patent setting out the saving in the plaintiff's patent, amounts to not guilty, and will not be allowed.(x)

It has been suggested by Tindal, C. J., and Dallas, C. J., that if a person had previously done that for which a patent is subsequently taken out, he could not be prevented by the subsequent patent from doing that which he had done before, though his operations were known to no one but himself.(y) A plea in confession and avoidance, would appear to be the proper mode of raising the point, if there is anything in it. The authority of Dolland's case, though not acted upon in the United States,(z) has been too often recognised here to be questioned at the present day.

19. See forms of the plea of non concessit, 8 C. B. 680, Nickels v. Ross; 7 M. & G. 630, Bedells v. Massey; 13 M. & W. 552, Bunnett and Corpo v. Smith. This appears to be the proper plea to raise the question whether the grant includes the plaintiff's claim. It puts in issue, not only the *existence of the letters patent, but the legal effect of them as stated by the plaintiff. [*166]

Non concessit is the proper form of pleading, to enable the defendant to object that the title in the patent does not correctly describe the invention. This plea puts in issue all the surrounding circumstances of the grant.(a) Maule, J. thought that it seemed to be against the spirit of the new rules, that the fact of the Queen having been deceived in her grant, should be given in evidence under non concessit, but that the case had not been provided for. But it will not put in issue that the plain-

(s) Russell v. Crichton, Decisions of the Court of Session, vol. xvi. 1157.
(t) See Bentley v. Keighley, 6 M. & G. 1041; Muntz v. Foster, 6 M. & G. 734.
(u) Sandiford v. Neild, Webst. P. C. 311, n.
(x) Holmes v. London and North-Western Railway Company, 19 Law Times, 158, C. P.
(y) See per Dallas, C. J., Hill v. Thompson, Webst. P. C. 240, 8 Taunt. 382; per Tindal, C. J. Cornish v. Keene, N. P. Webst. P. C. 511.
(z) See Reed v. Cutter, 1 Story Rep. 590; Curtis on Patents, 33.
(a) Bunnett v. Smith, 13 M. & W. 553; Platt v. Elce, 20 L. T. 226.

tiff was the first inventor, if that fact is averred in the declaration independently.(*b*)

20. Nul tiel record is the proper plea where the existence of the patent is denied altogether.—Co. Litt. 260, a.

21. That the letters patent originally granted were cancelled, and new letters patent granted, which were antedated. Replication to the same—Nickels v. Ross, 8 C. B. 680, 688.

22. That the letters patent were obtained upon a false suggestion, that the invention was communicated to the patentee by a foreigner.—Nickels v. Ross, 8 C. B. 684.

23. That the letters patent were obtained upon a false suggestion, that the invention was an improvement.—Nickels v. Ross. 8 C. B. 684; Bedells v. Massey, 7 M. & G. 630. This will be allowed as a distinct plea, from a plea that the invention was of no use. It is said that the invention may be an improvement, and yet detrimental to the public.

24. That the invention was not new.—Nickels v. Ross, 8 C. B. 686. A plea that the invention was not, at the time of making the patent, a new manufacture within this realm, within the true intent and meaning of the Act, was held bad for ambiguity. It is left doubtful whether the plaintiff means to deny that the matter to which the patent related, was a manufacture within the statute, or that it had the quality of being new. A person advising the plaintiff as to proofs in answer to such a plea, would not know to what point they should be applied.(*c*) A plea that the in-
[*167] vention is not a *new manufacture, admits that it is a manufacture within the statute. To sustain the plea, prior user must be proved.(*d*)

25. That the invention is not a manufacture within the statute.—Walton v. Bateman, 3 M. & G. 773; Nickels v. Ross, 8 C. B. 686. This seems the proper plea to raise the objection so often made unsuccessfully, that the patent is for a principle. A patent is the better, rather than the worse, that it involves the discovery of an important principle. No doubt it must contain the invention of a practical mode of the application of the principle. It is necessary that the invention should conduce to certain economical purposes, for increasing the wealth or comforts of the community.(*e*)

26. That the invention is of no use.—Nickels v. Ross, 8 C. B. 687. The plea in this form will not be proved by evidence that one of the articles comprised in the patent was of no use, or that the patented articles were of no use for one of the purposes suggested.(*f*)

The defence in such case is, that the patent was obtained upon a false representation, and it should be so pleaded. A plea that the invention was not of such use as to make it a sufficient consideration for the grant

(*b*) Nickels v. Ross, 8 C. B. 679, 722. See also Baddley v. Leppingwell, 3 Burr. 1544; Hinde's case, 4 Rep. 70, b; Eden's case, 6 Rep. 15.

(*c*) Spilsbury v. Clough, 2 Q. B. 466; S. C. 2 G. & D. 17. See Millingen v. Picken, 1 C. B. 799.

(*d*) Walton v. Potter, 3 M. & G. 434; Neilson v. Harford, 8 M. & W. 806; Elliott v. Aston, Webst. P. C. 223; Stead v. Anderson, 4 C. B. 806.

(*e*) Neilson v. Baird, Decisions of the Court of Session, 2d series, vol. vi. 51.

(*f*) Walton v. Bateman, Webst. P. C. 624.

of letters patent, is bad.(*g*) It leaves that which is properly a question of law, to the jury.

The jury may, if they please, rely on the opinions of scientific men who have not tested the invention. But if the trial has not been actually made, it leads to the suggestion or belief, that the defendant has abstained from causing the experiment to be made, because he knew it would answer too well.(*h*)

27. That the specification does not duly describe the invention.—3 Chitty on Pleading, 268; Nickels v. Ross, 8 C. B. 687; Derosne v. Fairie, 2 C. M. & R. 478. The affirmative lies on the plaintiff.(*i*) The issue is, whether the specification is sufficient to enable competent workmen to *make the patented invention. That the specification is [*168] defective in other particulars, as that it does not disclose the subject-matter of a patent, is not in issue.(*k*)

28. That no specification was enrolled in Chancery, and replication to the same.—Nickels v. Ross, 8 C. B. 687, 691; see also Minter v. Mower, 6 A. & E. 736; Derosne v. Fairie, 2 C. M. & R. 478; 3 Chitty on Pleading, 269. As to the evidence, ante, chap. xii. sect. 4, chap. xvii. p. 154, 156.

29. Insufficiency of title.—Croll v. Edge, 9 C. B. 465; Cooke v. Pearce, 8 Q. B. 1044.

30. That the plaintiff was not the first inventor.—3 Chitty on Pleading, 269; Minter v. Mower, 6 A. & E. 736; Derosne v. Fairie, 2 C. M. & R. 477. The affirmative of the issue lies on the plaintiff; but if the plaintiff gives general evidence of the novelty of the invention, the defendant must prove the negative. The plaintiff need not show how he acquired the invention.—Nickels v. Ross, 8 C. B. 711. As to the evidence in support of the plea, ante, 40—48. See Stead v. Williams, 7 M. & G. 842; Stead v. Anderson, 4 C. B. 806.

31. The illegality of an invention must be specially pleaded. If the invention is said to be generally inconvenient, the plea must show how it is inconvenient.(*l*)

32. That the letters patent were assigned in trust for more than twelve persons.—MacAlpine v. Mangnall, 3 C. B. 503; now see 15 & 16 Vict. cap. 83, s. 36.

33. That a disclaimer was not entered until after the committing of the grievances, and that the patent was void until after the entry of the disclaimer.—Perry v. Skinner, 2 M. & W. 471. See 15 & 16 Vict. cap. 83, s. 39.

As to a traverse of the entry of the disclaimer; pleas that the disclaimer was invalid, as being not authorized by the statute, see Wallington v. Dale, 6 Exch. 284; see further, Wallington v. Dale, 19 Law

(*g*) Betts v. Walker, 14 Jur. 647, Q. B.

(*h*) Neilson v. Harford, Webst. P. C. 316, Parke, B.; Reg. v. Steiner, Lord Campbell, N. P. Times, Dec. 6, 1851.

(*i*) Bentley v. Goldthorp, 1 C. B. 368.

(*k*) Gibson v. Brand, 4 M. & G. 179; The Household Company v. Neilson, Webst. P. C. 677; Wallington v. Dale, 19 Law Times, 187.

(*l*) Rex v. Arkwright, Dav. P. C. 79; Gillett v. Wilby, 9 C. & P. 334; Millingen v. Picken, 1 C. B. 814.

Times, 187. Evidence is not admissible under a traverse of the disclaimer, that the disclaimer is invalid as being not authorized by the statute.

34. With regard to the allowance of pleas, it may be observed, that if in any action brought by order of the Court *of Chancery, [*169] the defendant by his pleas, attempts to raise questions which have not been raised in the Court of Chancery, the pleas, if fair and good on the face of them, will not be disallowed by a court of common law. Thus, where in the Court of Chancery the dispute had been as to the infringement by the defendant, but in the action the defendant put in issue the title of the patentee, and the fact of the grant of the patent, pleas, raising these questions, were allowed.(*m*)

If, however, the pleas are pleaded contrary to an order of the Court of Chancery, the court of common law would probably disallow them.(*n*)

SECTION III.—PARTICULARS OF OBJECTIONS.

35. Particulars of objections must be delivered with the declaration. Stat. 5 & 6 Wm. 4, cap. 83, s. 5, relating to the notice of objections, is superseded by stat. 15 & 16 Vict. cap. 83, s. 41, which enacts, that in any action in any of her Majesty's superior courts of record at Westminster or in Dublin, for the infringement of letters patent, the defendant, on pleading thereto, shall deliver with his pleas, particulars of any objections on which he means to rely at the trial in support of the pleas in the said action; and at the trial of such action, no evidence shall be allowed to be given in support of any alleged infringement, or of any objection impeaching the validity of such letters patent, which shall not be contained in the particulars delivered as aforesaid; provided always, that the place or places at or in which, and in what manner, the invention is alleged to have been used or published prior to the date of the letters patent, shall be stated in such particulars. Provided also, that it shall and may be lawful for any judge at chambers to allow such plaintiff or defendant, or prosecutor respectively, to amend the particulars delivered as aforesaid, upon such terms as to such judge shall seem fit.

36. It is incumbent on the Court to see that the objections are stated in a definite and intelligible form, before the parties go down to trial, that the patentee may not be taken by surprise.(*o*)

In general, a mere copy of the pleas will not be sufficient [*170] *notice of objections. The objections, however, may be so fully expanded upon the record, that a mere transcript of the pleas may be enough. What degree of particularity is required, it is difficult to define.(*p*) Each case must depend on its own circumstances. The Le-

(*m*) Bunnett and Corpo v. Smith, 13 M. & W. 552.
(*n*) See 15 & 16 Vict. cap. 76, s. 226.
(*o*) Coltman, J., Fisher v. Dewick, 4 Bing. N. C. 706.
(*p*) Tindal, C. J., Jones v. Berger, 5 M. & G. 215; Neilson v. Harford, 8 M. & W. 806, 882; S. C. 1 Webst. P. C. 370.

gislature, however, never intended that the defendant should argue his case in the objections delivered.(*q*)

37. Particulars of objections delivered by the defendant, must be precise and definite. It is not sufficient to say, that the improvements, or some of them, have been used before; the defendant must point out which. An objection that if any part be new, the same is useless and unnecessary, should point out what part.(*r*)

In a recent case, Creswell, J. intimated a strong opinion, that the notice should specify the pleas to which the objections were intended to apply.(*s*)

Perhaps it is enough if they disclose fairly the case of the defendant, and convey such information as a plaintiff in a bill of discovery in Chancery would be entitled to; that is to say, if they disclose the case of the defendant, without showing the evidence by which he means to support it.(*t*)

Parke, B., in Leaf v. Topham, said, "It is not necessary that the notice of objection should set forth the evidence on which the defendant relies."(*u*)

In another case, Alderson, B. said, "In asking for the names of the persons who have used the invention, are you not requiring to be furnished with a statement of the evidence in the briefs?"(*x*)

38. Considerable difference of opinion formerly existed amongst the judges, as to whether the names of persons alleged to have used the invention could be required.

In Bulnois v. Mackenzie, Vaughan, B., at chambers, made an order, that the defendant's attorney should furnish *to the plaintiff's attorney the names, descriptions, and places of abode, of the persons by whom, and also the dates when the invention was used. The Court rescinded so much of it as required the defendant to furnish names and descriptions.(*y*) [*171]

So in Galloway v. Bleaden, Coltman, J. ordered names, addresses, and descriptions of persons who were alleged to have used the invention, to be given, and the words "other persons" to be struck out.(*z*)

Where the particulars stated that the invention was known to and used by A. B. and others before the grant of the letters patent, the Court refused to require the defendant to strike out the words "and others," or to make an order that the names and descriptions of the others should be stated. "It is difficult," said Maule, J., "to define the exact degree of particularity which ought to be required, but it should not be greater than the knowledge of the party making the objection may be presumed to enable him to give."(*a*)

(*q*) Heath v. Unwin, 10 M. & W. 684.
(*r*) Fisher v. Dewick, 4 B. N. C. 706; S. C. Webst. P. C. 264.
(*s*) Walton v. Bateman, Webst. P. C. 286, n.
(*t*) See Attorney-General v. Corporation of London, 2 McNaght. & Gord. 247.
(*u*) Per Parke, B., Leaf v. Topham, 14 M. & W. 146.
(*x*) Russell v. Ledsam, 11 M. & W. 649.
(*y*) Bulnois v. Mackenzie, Webst. P. C. 260.
(*z*) Galloway v. Bleaden, Webst. P. C. 268, n.
(*a*) Bentley v. Keighley, 7 M. & G. 652; Carpenter v. Walker, 7 M. & G. 657, note *a*.

On a scire facias to repeal a patent, the prosecutor having filed a notice of objections, that other persons than the patentee had used the invention in England before the grant of the patent, the Court refused to order the delivery of a particular stating the names of such persons.(*b*)

39. Where it was objected that the alleged invention had been published in the specifications of two previous patents, particularizing them, and also by other persons in other books and writings, it was held that the *books* should be specified.(*c*) Per Tindal, C. J., "The defendant might keep back his evidence, and then start upon the plaintiff at the trial with some article in a foreign cyclopædia. No hardship is imposed on the defendant, as he can add the name of other publications to his notice at any time before the trial."

40. A notice of objections stated, that the invention was in use by many persons before the patent; and particularly, that the use of [*172] rice-starch in clear-starching lace, &c., was *known and practised at Nottingham and elsewhere. It was held, that upon striking out the words "and elsewhere," the objection was sufficiently precise. The objection being narrowed to the use of rice-starch in the dressing of lace, there was a sufficient particularity.(*d*)

41. A particular, that the specification does not sufficiently describe the nature of the invention, need not state in what manner the specification is deficient in its description of the invention;(*e*) but a notice of objection, that the patentee has not caused any specification sufficiently describing the invention to be enrolled, is not sufficiently certain. It may mean, either that there is no specification existing on the rolls of the Court of Chancery, or that the one enrolled is defective in not sufficiently describing the invention.(*f*)

42. The notice of objections need not state who the first inventor was. To require the defendant to afford this information, would be throwing the burden of proof on the wrong party.(*g*)

But it should be such as not to leave the plaintiff in doubt what are the objections really intended to be made to the patent upon the trial. If he means to deny that the plaintiff invented any part of the supposed invention, he should say so, and not that the plaintiff did not invent the invention.(*h*) If it is doubtful what the defendant means to object to, there would be a difficulty thrown upon the plaintiff in getting the costs occasioned by ojections not sustained.

43. The defendant must 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 proposes to object to part, then he must state what part.(*i*)

A notice stating that defendant would object that the invention was

(*b*) Reg. v. Walton, 2 Q. B. 969.
(*c*) Jones v. Berger, 5 M. & G. 208.
(*d*) Jones v. Berger, 5 M. & G. 208.
(*e*) Heath v. Unwin, 10 M. & W. 684.
(*f*) Leaf v. Topham, 14 M. & W. 146; Betts v. Walker, 14 Jur. 647. Q. B.
(*g*) Russell v. Ledsam, 11 M. & W. 647.
(*h*) Betts v. Walker, 14 Jur. 647, Q. B.
(*i*) Bodmer v. Butterworth, 2 Law Times, 368, Q. B.

not new, and had been wholly, or in part, used and made public before the obtaining of the letters patent, held insufficient.(*j*)

*An objection that the plaintiff's specification did not sufficiently distinguish between what was old and what was new, [*173] was held sufficiently precise, as the objection was to an omission in the specification.(*k*)

That the plaintiff did not state in his specification the most beneficial method with which he was then acquainted of practising the invention, held sufficiently precise.(*l*)

44. If he insists that the patent was obtained by fraud and misrepresentation, he should state in what the fraud consisted, and was the species of misrepresentation by which the patent was obtained.(*m*)

45. If the particulars are insufficient, the plaintiff should take out a summons, or move for a rule to show cause why better particulars should not be delivered. A rule to set aside the particulars is improper.(*n*)

When at the time of pleading, the defendant had omitted to deliver a notice of objections with the pleas, a summons was subsequently taken out before a judge at chambers by the defendant, to show cause why he should not be at liberty to deliver such notice. The Court made an order, that the plea already pleaded should be considered as pleaded de novo, and the objections added considered as delivered with the pleas.(*o*)

46. The defendant cannot avail himself of his notice of objections to raise any defence at the trial, on which no issue is joined by the pleadings.(*p*)

A declaration in scire facias to repeal a patent contained suggestions, alleging want of novelty and utility, in a certain part of the said invention."(*q*) The pleas denied all the suggestions in the declaration. Objections were filed with the declaration, pointing out claim No. 6 as bad, for want of novelty and utility. After issue joined, the defendant entered a disclaimer of claim No. 6. It was held, that the objections filed with the declaration were not part of the record, so as *to be incorporated with the issues, and to add to or explain the sugges- [*174] tions.

47. At Nisi Prius, the only question for the judge is, whether the language of the notice fairly includes the objection.(*r*)

The notice of objections must be considered as a kind of notice appended to the pleas as notice of the set-off; the attention of the Court should be called to it as part of the plaintiff's case. The objections should be read at the time of the pleadings being opened.(*s*) Reading them at a subsequent period after the conclusion of the speech of the

(*j*) Heath v. Unwin, 10 M. & W. 685.
(*k*) Jones v. Berger, 5 M. & G. 208.
(*l*) Jones v. Berger, 5 M. & G. 208. See Neilson v. Harford, Webst. P. C. 324, n.
(*m*) Russell v. Ledsam, 11 M. & W. 647.
(*n*) Hancock v. Moulton, Exch. 20 Law Times, 102.
(*o*) Losh v. Hague, Webst. P. C. note, *a*.
(*p*) Gillett v. Wilby, 9 C. P. 334; S. C. Webst. P. C. 270.
(*q*) Reg. v. Mill, 20 L. J. C. P. N. S. 16; 10 C. B. 379, S. C.
(*r*) Neilson v. Harford, Webst. P. C. 324, n.
(*s*) Neilson v. Harford, Webst. P. C. 309, n.

defendant's counsel will not give the plaintiff's counsel a right of reply.

SECTION IV.—INSPECTION.

48. It has been doubted, but apparently without good reason, whether a court of equity will make an order for an inspection of the defendant's machinery in aid of a trial at law except by consent.(*t*)

Such an order will not be made unless there is good cause for suspecting an infringement, for the defendant might be prejudiced by the disclosure of his process.(*u*)

49. An order for the inspection of the defendant's process cannot be executed by force. It operates only on the person as a foundation for process for contempt, and to take the bill pro confesso, if necessary.(*x*)

50. By stat. 15 & 16 Vict. cap. 83, s. 42, courts of common law, or a judge may make such order as they or he may think fit, for an injunction, inspection, or account.

An application for an order for inspection under this statute, may be made at any time, either before declaration or afterwards. It will not be granted unless the party applying for it shows by affidavit that it is material, and really wanted for the purposes of the cause.(*y*)

[*175] *51. As to the form of such orders, it may be observed, that it has been made a condition of the dissolution or refusal to grant an injunction, that defendant shall keep an account; that the plaintiff and his witnesses may, at all reasonable times, giving reasonable notice, inspect the defendant's works and the articles alleged to have been made in contravention of the patent; and that all books and papers relating to the matters in question shall be produced at the trial.(*z*) Where the question to be tried was, whether certain lace was made by a machine similar to that patented, Lord Eldon, in directing an action to be brought, made an order that the plaintiff's witnesses should be at liberty to inspect the defendant's machine, and see it work.(*a*)

In Russell v. Cowley, an order was made by consent that defendants should permit the solicitor of the plaintiff, with men of science, to go over the manufactory of the defendants, and inspect the machinery set up there for making iron tubes, and observe the methods of manufacturing such tubes, for which purpose the defendants were ordered to put their machinery to work; the plaintiff to suffer defendant's solicitors, with scientific persons, to go over the plaintiff's manufactory, and inspect their machinery, which was to be put to work. The viewers were to be at liberty to carry away the tubes operated upon.(*b*)

(*t*) 7 Jarman, by Sweet, 550. See Brown v. Moore, 3 Swanst. 264; Earl of Lonsdale v. Curwen, 3 Bligh, 168; Walker v. Fletcher, 3 Bligh, 172.

(*u*) Huddart v. Grimshaw, Webst. P. C. 92. See post.

(*x*) East-India Company v. Kynaston, 3 Bligh, 153.

(*y*) Amies v. Kelsey, 16 Jur. 1047, B. C.; Shaw v. The Bank of England, 22 L. J. N. S. Exch. 26. See 20 Law Times, Exch. 70. 227.

(*z*) Morgan v. Seaward, Webst. P. C. 167.

(*a*) Bovill v. Moore, 2 Coop. C. C. 56, n. See Huddart v. Grimshaw, Webst. P. C. 92.

(*b*) Russell v. Cowley, Webst. P. C. 457.

52. In Russell v. Crichton, a patentee moved in the Court of Sessions in Scotland, for an order for the inspection of the defender's works by persons of skill; the defender alleged that his manufacture involved a secret process, the value of which would be lost if inspection was allowed. It was held, that some inspection must be allowed, otherwise any patent might be infringed with impunity; and an order was pronounced for giving inspection of the works and manufactories of both parties to certain viewers, other than the plaintiff or manufacturers in the same trade, who were to see the works in actual operation; with power to them to adjourn and continue the inspection, so that they might be able to give evidence at the trial.(*c*)

*In Brown v. Brown and Somerville an order was made, under similar circumstances, on an affidavit by the pursuer that an inspection was necessary to enable him to establish his case.(*d*) [*176]

53. A court of common law in England will not make an order that the plaintiff should permit the defendant to inspect the mode of manufacture under the patent, to enable him to judge if his own manufacture is an infringement.(*e*) He has the opportunity of examining the plaintiff's specification.

SECTION V.—NEW TRIAL, COSTS, ETC.

54. After a verdict for the plaintiff in an action for the infringement of a patent, the courts will not readily grant a new trial on affidavits showing that a witness who was disbelieved by the jury spoke the truth, because the proceedings are not final and conclusive; it being open to those who wish to question the validity of the patent, to do so by suing out a writ of scire facias. Nor on the ground that the verdict was against evidence, unless they are thoroughly satisfied that the verdict was wrong.(*f*) For the same reason, the Court of Common Pleas has refused to allow a point, that the patent was for machinery, while the invention was of the application of a machine, where the point had not been made at the trial, to be argued in Banco, on a motion to enter a nonsuit.(*g*) Probably the decision might have been otherwise if substantial damages had been awarded in the action.

55. Proceedings in actions for infringement will not in general be stayed, because a scire facias to repeal the patent is pending.(*h*)

56. If the verdict is for nominal damages only, it will be proper to apply for certificates, that the action was properly *brought in the superior court,(*i*)—to enable the plaintiff to get his costs under [*177]

(*c*) Russell v. Crichton, Decisions of the Court of Session, vol. xv. 1271.

(*d*) Brown v. Brown and Somerville, Decisions of the Court of Session, 2d series, vol. ii. 1356.

(*e*) Crofts v. Peach, Webst. P. C. 268; 2 Hodges, 110; Hamilton v. Cochrane, 33 Newt. Lond. Journ. 148. See Russell v. Cowley, ante, 175.

(*f*) Wallington v. Dale, 19 Law Times, 187; Lewis v. Marling, 10 B. & C. 22.

(*g*) Haworth v. Hardcastle, Webst. P. C. 483.

(*h*) See Smith v. Upton, 6 M. & G. 259; Bentley v. Goldthorp, ib. note b; Muntz v. Foster, ib. note e; Patteson v. Holland, Hindmarch on Patents, 293.

(*i*) See In re Adey v. The Deputy Master of the Trinity House, 22 L. J. N. S. Q. B. 3; Davis v. Walton, 8 Exch. 153.

3 & 4 Vict. cap. 24, s. 2,—and if such was the case, that the title to the patent came in question. See post. The judge must also certify as to the particulars proved.

57. By stat. 15 & 16 Vict. cap. 83, s. 43, in taxing the costs in any action in any of her Majesty's superior courts at Westminster or in Dublin, commenced after the passing of this Act, for infringing letters patent, regard shall be had to the particulars delivered in such action; and the plaintiff and defendant respectively shall *not* be allowed any costs in respect of any particular, unless certified by the judge before whom the trial was had, to have been proved by such plaintiff or defendant respectively, without regard to the general costs of the cause.

58. By stat. 5 & 6 Wm. 4, cap. 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 the case which has been proved at the trial, which shall be certified by the judge before whom the same shall be heard, and the costs of each part of the case *shall be given* accordingly as either party has succeeded or failed therein, regard being had to the notice of objections, as well as the counts of the declaration, and without regard to the general result of the trial.

59. The effect of these two provisions is important with respect to particulars of breaches delivered by the plaintiff with his declaration, and to particulars delivered with a plea, pointing out several branches of evidence. For instance, in support of a plea denying the novelty of the hot-blast, if a particular is delivered, stating user at the Dowlais and the Ynisedwin works, though the defendant should succeed in proving user at the Ynisedwin works, if he did not also prove a user at the Dowlais works, he would not only not get his costs of the witnesses on that branch of the evidence, but would have to pay any costs of the plaintiff relating to it.

60. The judge must certify as to the determination of each question upon the particulars of breaches, and the particulars of objection, and not merely as to the issues under stat. 5 & 6 *Wm. 4, cap. 83. Before the passing of 15 & 16 Vict. cap. 83, it was considered that the costs of the issues must be taxed according to the ordinary rule, and that the Act made no difference, except as to the costs of copying and transcribing the objections. Where a defendant succeeded on a plea, which went to the whole cause of action, he was held to be entitled to the general costs of the cause, deducting the costs of the objections on which the plaintiff had succeeded, and of the issues found for him.(*j*)

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61. By stat. 15 & 16 Vict. cap. 83, s. 43, it shall be lawful for the judge before whom any action for infringing letters patent, commenced after the passing of that Act, shall be tried, to certify on the record that the validity of the letters patent in the declaration mentioned came in question; and the record with such certificate, being given in evidence in any suit or action for infringing the said letters patent, or in any proceeding by scire facias to repeal the said letters patent, shall entitle the plaintiff in any suit or action, or the defendant in such proceeding by

(*j*) Losh v. Hague, 5 M. & W. 387; S. C. Webst. P. C. 209, n.

scire facias, on obtaining a decree, decretal order, or final judgment, to his full costs, charges, and expenses, taxed as between attorney and client, unless the judge making such decree or order, or the judge trying such action or proceeding, shall certify that the plaintiff or defendant respectively ought not to have such full costs.

62. To enable a judge to certify in actions commenced before the passing of that Act, in a court of equity, or in a scire facias, recourse must be had to stat. 5 & 6 Wm. 4, cap. 83, s. 3, which enacts, that if any action at law, or any suit in equity for an account, shall be brought in respect of an alleged infringement of such letters patent, 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 action or suit whatever touching such patent, if a *verdict shall pass, or a decree or decretal order be made in favour of such patentee or his assigns, he or they shall receive full costs (5 & 6 Vict. cap. 97) in such suit or action, unless the judge making such record or other decree, or order, or trying such record or other action, shall certify that he ought not to have such costs. [*179]

63. Under a plea that the invention is not new, the validity of the patent is brought into question; and the judge has therefore power to certify such fact under the statute.(*k*) But Mr. Justice Erskine has refused to certify in a case where the defendant consented to a verdict, saying, "That his certificate would affect third parties, and it would be possible for the parties to collude for the purpose of injuring another party, who was really contesting the validity of the patent."(*l*)

64. When the record of a former verdict, with a certificate of the judge indorsed upon it, is produced for the purpose of enabling the patentee to receive his full costs, it appears to be the proper course to put it in after the verdict is given. The defendant's case ought not to be prejudiced by the putting it in evidence during the trial.(*m*)

It would seem that the costs may be obtained, on proof of the production of the certificate, either by the judge's indorsement, or by a suggestion on the record.(*n*)

65. Notwithstanding that a certificate has been granted under 5 & 6 Wm. 4, cap. 83, s. 3, and has been produced and proved on the trial of an action on the case for the infringement of a patent, if the plaintiff recovers only nominal damages in such action, he cannot have full costs under that Act and 5 & 6 Vict. cap. 97, unless the judge certifies at the trial to give him his costs under stat. 3 & 4 Vict. cap. 24, s. 2. After

(*k*) Gillett v. Wilby, 9 C. & P. 334; S. C. Webst. P. C. 270.
(*l*) Stocker v. Rodgers, 1 C. & K. 99.
(*m*) Newhall v. Wilkins, 17 Law Times, 20, Lord Campbell, N. P.
(*n*) See Bowyer v. Cook, 4 C. B. 236.

the taxation of costs, the judge has no power to grant such a certificate.(*o*)

66. Where an action was not directed, but the Court of Chancery, on a motion for an injunction, ordered that the plaintiff should be at [*180] liberty to bring such action as he might *be advised, provided he delivered a declaration within a month, Baron Parke considered, that the question as to the costs of the action must be determined by the rules of the common law, inasmuch as either plaintiff or defendant could apply for a nonsuit or new trial, or bring a writ of error, without the leave of the Court of Chancery.(*p*)

[*181] *CHAPTER XIX.

REMEDIES OF PATENTEE.—INJUNCTION.—ACCOUNT.

1. Courts of equity have hitherto granted injunctions to restrain persons from using the invention without license, and compelled the rendering of an account of the profits made by any wrongful use of the invention.

2. Concurrent jurisdiction in such matters is now given to the superior courts of common law. In any action pending in any of her Majesty's superior courts of record at Westminster and Dublin, for the infringement of letters patent, it shall be lawful for the Court in which such action is pending, if the Court be then sitting, or if the Court be not then setting, then for a judge or such court, on the application of the plaintiff or defendant, to make such order for an injunction, inspection, and account, and the proceedings therein, as to such Court or judge may seem fit.(*a*)

3. Lord Eldon, in one case, granted an injunction against a public servant, to restain him from employing patented inventions in the service of the Government. He subsequently punished him for disobeying the injunction; suggesting, at the same time, but not deciding, that probably the injunction ought not to have issued. However, as it had been infringed, he said he would treat Government as he would any suitor of the court, subject to the question at law. He ordered an account to be kept of all machines made in violation of the plaintiff's patent, and of the profits to which the plaintiff would be entitled if the patent had been infringed. He recommended the Government to pay the costs of the application, and said, he would have it understood that if *the [*182] recommendation was not attended to, he would make an order for the defendant, Sir William Congreve, to pay.(*b*)

(*o*) Gillett v. Green, 7 M. & W. 347; Webst. P. C. 271.
(*p*) Russell v. Cowley, before Parke, B. at chambers, Webst. P. C. 471, n.
(*a*) Stat. 15 & 16 Vict. cap. 83, s. 42.
(*b*) Walker v. Congreve, Rep. 1829, 202; 1 Carp. R. 356. See Rankin v. Huskisson, 4 Sim. 14; Priddy v. Rose, 3 Mer, 102; Frewen v. Lewis, 4 Myl. &. Cr. 255; De Haber v. The Queen of Portugal, 20 L. J. N. S. Q. B. 488.

4. The Court of Queen's Bench have refused a mandamus to the Lord's of the Admiralty, to settle the terms on which they might be allowed to make use of an invention protected by letters patent, of which they were availing themselves.(c) The proper course for the patentee to take, when his patent is infringed by the officers of Government acting in that capacity, is, perhaps, by petition of right.(d)

5. Foreigners coming in their own ships into the ports of this country, may be restrained from infringing a patented invention on board such ships.(e)

6. The jurisdiction of the Court of Chancery is founded upon legal rights. Great latitude is allowed to the Court in dealing with the application. When an interlocutory injunction is applied for, several courses are open. The Court may at once grant the injunction simply, without more; a course which is not likely to be taken, when the defendant raises a question as to the validity of the plaintiff's title. Or it may follow the more usual and wholesome practice of either granting the injunction and at the same time directing the plaintiff to establish his title at law; or of requiring him first to establish his title at law, suspending the grant of the injunction till the result of the legal investigation is known.(f)

7. It is the duty of a court of equity to protect property pending litigation; but when it is called upon to do so, it requires some proof of the title of the party asking its interference. When a patent is new, the Court considers the proof of title in the patentee to be wanting, inasmuch as the public have had no opportunity of contesting the validity of the patent. In such a case, the Court will not act upon its own notions as to the validity of the patent, but will oblige the *patentee to establish his title at law before it will grant him the injunction.(g) [*183]

8. If there be any doubt as to the validity of the legal right, the Court will be very cautious in granting an injunction, first, because if the legal right ultimately fails, or if the acts complained of turn out not to be a violation of the legal right, it will have acted without any authority whatever, the authority being merely derivable from the legal right; secondly, and principally, because an injunction, if improperly granted, causes infinitely more mischief to the defendant, than the delay of granting it can possibly cause to the plaintiff. As a general rule, the Court will not grant an injunction unless satisfied that, in the result, the legal right will be established, and that the acts complained of are a violation of it.

9. If the Court does not entertain any serious doubt on these subjects,

(c) Ex parte Pering, 4 A. & E. 949.

(d) See Smith v. Upton, 6 M. & G. 252, n. See, however, The Baron de Bode's case, 8 Q. B. 208, 271, and cases in note; The Baron de Bode v. The Queen, 13 Q. B. 380.

(e) Caldwell v. Van Vlissingen, 9 Hare, 415.

(f) Bacon v. Jones, 4 M. & C. 433.

(g) Hill v. Thompson and Farnam, Webst. P. C. 331; 3 Mer. 622; S. C.; per Lord Cottenham, Coop. C. C. 48; Baxter v. Combe, 1 Irish Chan. R. 284.

it will grant an injunction without putting the plaintiff to establish his title at law.(*h*)

10. The legal right being in doubt is a matter for the serious attention of the Court, and one to which great weight should be given; but it is not a matter which renders it absolutely incumbent on the Court to refuse an injunction. The Court must be guided by a discretion, to be exercised according to the circumstances of each particular case.(*i*)

11. In a patent case, long and exclusive possession and enjoyment is considered such prima facie evidence of title, as to justify the Court in protecting the patent right by an injunction until its invalidity is established at law.(*k*) In such a case, there is less inconvenience in granting the injunction than in refusing it; for unless such injunctions were [*184] granted, patentees might be ruined by litigation.(*l*) Thus, *where the plaintiff had been successful in proceedings at law and in equity against other persons, and had had exclusive enjoyment of the patent for a considerable time, although some doubt existed as to the validity of the patent, the Court granted an injunction.(*m*) Where a bill alleged exclusive possession for ten years, and that the plaintiff had established his title by repeated actions, a demurrer, on the ground of the invalidity of the patent, as appearing from the specification set out in the bill, was overruled.(*n*)

12 Lord Eldon said, "If a party had got his patent, and put his invention into execution, and proceeded to sell articles made according to it, that was a sufficient possession."(*o*)

Lord Cottenham said, "He should be satisfied if he found manufacturers had acquiesced in the patentee's enjoyment; but that he should require very satisfactory evidence of the exclusive possession of the patentee. He did not think it enough where some manufacturers stated, that out of respect for the patentee they had not used the invention, and others stated, that they had done so constantly."(*p*)

13. The period of enjoyment which will be sufficient, must vary according to the circumstances. In the case of Losh's patent for "wheels for railway carriages," enjoyment for seven years was held sufficient. In Bickford's patent for a "miner's fuze," six years was considered sufficient, though the article was one in which there was little competition.(*q*)

(*h*) Electric Telegraph Company v. Nott, 2 Coop. C. C. 41; Stevens v. Keating 9 Phillips, 333; Bacon v. Jones, 4 M. & C. 436.

(*i*) Ollendorff v. Black, 20 L. J. N. S. Chy. 165.

(*k*) Hill v. Thompson and Forman, Webst. P. C. 231; 3 Mer. 622, S. C.; Stevens v. Keating, 2 Phillips, 333; Bickford v. Skewes, 4 M. & C. 500; Neilson v. Thompson, Webst. P. C. 275.

(*l*) Harmar v. Plane, 14 Ves. 132; Boulton and Watt v. Bull, 3 Ves. 140; Universities of Oxford and Cambridge v. Richardson, 6 Ves. 707; Muntz v. Foster, 2 Law Times, 325.

(*m*) Newall v. Wilson, 19 Law Times, 161, Chy. Court of Appeal; Beeston v. Collyer, 2 Coop. C. C. 58, Lord Lyndhurst.

(*n*) Kay v. Marshall, 1 M. & C. 373.

(*o*) Boulton and Watt v. Bull, 3 Ves. 140.

(*p*) Collard v. Allison, 4 M. & C. 488; Curtis v. Cutts, 2 Coop. C. C. 59.

(*q*) Losh v. Hague, Webst. P. C. 200; Bickford v. Skewes, Webst. P. C. 212.

14. In some cases the conduct of parties will induce the Court to assume the validity of the patent as against them. Thus, where a patent had been worked by the plaintiff and defendant as partners, and during the partnership the defendant did not dispute the validity of the patent, the Court, on an interlocutory application against him after the dissolution of the partnership, assumed that the patent was valid.(*r*)

*Where a license had been taken by the defendant for the use of two inventions, one of which was afterwards disclaimed, the defendant refusing to pay the royalties reserved, a demurrer to a bill, praying for an account or an injunction to restrain the defendant from all future use of the invention, in case of his refusal to pay the royalties, was overruled.(*s*) [*185]

15. Where there is conflicting evidence upon the question of infringement, the Court will not grant an injunction till it has been ascertained by action at law, that the acts complained of are an infringement of the legal right granted by the patent.(*t*)

Lord Eldon said, "Where there is one question, whether a patent is valid, and another, whether it has been infringed, the Court would be going a great way if it granted an injunction.(*u*) If there has been no infringement, the Court has no power to make compensation to the defendant for the injury occasioned by the injunction.(*x*)

16. An injunction will not be granted on the application of the assignee of a patent, unless his title as assignee is clear.(*y*)

17. It is a principle of equity, that a person shall not, by his silence or acquiescence, induce another to expend his money, and incur risk, and then come in and share in the profit. Where the defendants went to considerable expense in erecting hot-blast apparatus, the plaintiff not interfering to stop them, but permitting them to complete their works, under the expectation that if they proved successful, the defendants would take a license, Lord Cottenham dissolved the injunction obtained by the patentee; but the plaintiff having succeeded in an action, the injunction was revived by Lord Lyndhurst.(*z*)

18. If the plaintiff has been guilty of unnecessary delay in coming to the Court, though the impression of the Court is strong in his favour, an injunction will be refused till the *legal right is established.(*a*) [*186] The difficulty of proving the infringement by the defendants, they having prevented all access to their manufactory, has been held a sufficient excuse.(*b*) So a delay of a year and a half was explained by the pendency of an action in the Court of Exchequer, and writ of error

(*r*) Muntz v. Grenfell, V. C. Knight Bruce, 2 Coop. C. C. 61; 7 Jurist, 121.
(*s*) Haddam v. Smith, 17 L. J. Chy. N. S. 43. See Neilson v. Fothergill, Webst. P. C. 289.
(*t*) The Electric Telegraph Company v. Nott, 2 Coop. C. C. 41.
(*u*) Wood v. Cockerell, 2 Coop. C. C. 57.
(*x*) Morgan v. Seaward, Webst. P. C. 168.
(*y*) Lowndes v. Duncombe, 2 Coop. C. C. 216.
(*z*) Neilson v. Thompson, Webst. P. C. 286. See Crossley v. Derby Gas Company, Webst. P. C. 120. See Wood v. Sutcliffe, 21 L. J. N. S. Chy. 253; Rochdale Canal Company v. King, 20 L. J. N. S. Chy. 675.
(*a*) Bridson v. Benecke, 12 Beav. 1; Baxter v. Combe, 1 Irish Chan. R. 284.
(*b*) Crossley v. Derby Gas Company, Webst. P. C. 119.

in the Exchequer Chamber, in which a point on which the plaintiff's title depended was determined.(*c*)

19. An interlocutory injunction will not be granted, if irreparable injury, or even very serious inconvenience, would be the result of granting it, unless the case is so clear, that there can be no reasonable doubt about the legal title.(*d*) Thus, when the effect would have been to stop the running of a steamboat, in which it was said that the plaintiff's rudder was pirated, it was refused.(*e*)

20. The balance of convenience in granting or refusing the injunction, will be considered. Where an undertaking by the defendant, to keep an account, will afford to the Court ample means of doing justice to the patentee, the Court rarely grants an interlocutory injunction.(*f*)

21. An allegation not denied, that the defendant's circumstances are such as to render it improbable that he would be able to meet the pecuniary demands to which he would be liable if unsuccessful at law, may be an additional reason for granting an injunction.(*g*) In Pow v. Bettelcy, the fact of the defendant's solvency was considered by Knight Bruce, V. C., in refusing to grant an injunction.(*h*)

22. There is no doubt of the power of a court of equity to grant an injunction absolutely, and leave the defendant to impeach the patent if he can by scire facias. But it is not usual to do so. The patentee is generally compelled to bring an action to establish his right.(*i*) A trial [*187] at law, in which *the plaintiff has been successful, is not binding on another person alleged to have committed infringement, so as to induce the Court to grant the injunction absolutely.(*k*)

23. In Muntz v. Grenfell, before Vice-Chancellor Knight Bruce, the plaintiff, on obtaining the injunction, undertook to abide by any order which the Court might make as to compensation and damages, in the event of the injunction being dissolved. It is the present practice to impose this condition.(*l*)

24. The Scotch courts allow damages to be recovered, when an interdict or suspension is pronounced, if the party applying for it ultimately fails.(*m*)

25. Where the terms of bringing an action are imposed, the Court will deprive the plaintiff of the protection of the injunction, if he does not commence and proceed with his action with reasonable promptitude.(*n*)

(*c*) Buxton v. James, 5 De Gex & Smale, 80, V. C. Parker.
(*d*) Neilson v. Thompson, Webst. P. C. 286; Spottiswoode v. Clarke, 2 Phillips, 154; Sheriff v. Coates, 2 Russ. & Myl. 157.
(*e*) Laird v. Crispin, Times, Dec. 3, 1851.
(*f*) Jones v. Pearce 2 Coop. C. C. 58.
(*g*) Newall v. Wilson, 19 Law Times, 161, Chy. Court of Appeal.
(*h*) Pow v. Betteley, 24 Newt. Lond. Jour. C. S. 223.
(*i*) Wilson v. Tindal, Webst. P. C. 730: Russell v. Barnesley, Webst. P. C. 472; Bramwell v. Holcomb, 4 Myl. & Cr. 737.
(*k*) Crosskill v. Tuxford, 5 Law Times, 342; Crosskill v. Evory, 10 Law Times, 459.
(*l*) Muntz v. Grenfell, 2 Coop. C. C. 59, n.; Morison v. Moat, 21 L. J. N. S. Chy. 248; Newall v. Wilson, 19 Law Times, 161.
(*m*) Stirling v. Roebuck, Webst. P. C. 50, n.
(*n*) Stevens v. Keating, 2 Phillips, 336.

But it will not interfere, if the defendant has acquiesced in the delay by not coming to the court to complain of it.(*o*)

26. Where an injunction has been obtained ex parte, the defendant may move to dissolve it. The plaintiff will not be permitted to subject the defendant to any inconvenience which is not necessary for his protection.(*p*)

27. It is almost a matter of course to grant or revive an injunction when the plaintiff has established his title at law.(*q*)

28. There are some cases in which the Court is to such an extent satisfied by a verdict that the legal right exists, that it will give the plaintiff the benefit of an injunction, though further litigation is necessary; as where a bill of exceptions had been tendered, but many of the points raised had been decided in proceedings against a former infringer.(*r*)

*The Court will, in such cases, sometimes consult the judge who tried the cause.(*s*) [*188]

29. An injunction will not be granted, pending a rule *nisi* for a new trial, in an action in which the patentee has obtained a verdict, where it had been refused before trial.(*t*)

30. The Court of Chancery will be guided in some degree by its opinion of the correctness of the decision at law. Where an action had been brought, and a verdict obtained by the patentee, which was set aside by the Court of Exchequer, on grounds which the Vice-Chancellor considered unsatisfactory, it being objected, in answer to a motion for an injunction, that the bill ought to be dismissed, the Court ordered the motion to stand over, the bill to be retained for twelve months, and the plaintiff to bring such action as he should be advised.(*u*)

31. The defendant cannot demur to a bill in Chancery, because the specification is not set out in it.(*x*) Nor where a prima facie title is stated, because the specification as set out in the bill appears defective.

The Court will not on demurrer make an order directing the bill to be retained, with liberty to the plaintiff to bring an action.(*x*)

32. When the cause comes on to a hearing on bill and answer in Chancery, the case must, generally speaking, be in such a state that the Court can adjudicate upon it. If prior to that the patentee has not established his legal title, it is a question of discretion how far the Court will assist him, by allowing the bill to be retained and an action then brought.(*y*) Where four years had elapsed between the filing of the bill and the hearing, and the plaintiff had not made out such a case as would have entitled

(*o*) Bickford v. Skewes, 4 Myl. & Cr. 498.
(*p*) Bacon v. Jones, 4 M. & C. 433; 1 Beav. 382.
(*q*) Neilson v. Harford, Webst. P. C. 373; Russell v. Cowley, Webst. P. C. 471.
(*r*) Bridson v. Benecke, 12 Beav. 1. (*s*) Bridson v. MacAlpine, 8 Beav. 229.
(*t*) Collard v. Allison, 4 Myl. & Cr. 487; Hill v. Thompson, Webst. P. C. 236; S. C. 3 Mer. 626.
(*u*) Heath v. Unwin, 15 Sim. 552.
(*x*) Westhead v. Keene, 1 Beav. 287; Kay v. Marshall, 1 Myl. & Cr. 373.
(*y*) Bacon v. Jones, 1 Beav. 382; on appeal, 4 Myl. & Cr. 433; Few v. Guppy, 1 Myl. & Cr. 487.

him to an interlocutory injunction, the Court refused to retain the bill, and dismissed it with costs.

[*189] In Ward v. Key, the defendant submitted to an interlocutory *injunction, the order not containing a direction that the plaintiff should try his right at law. The defendant put in an answer, and both parties examined witnesses, and the case was brought to a hearing without a preliminary trial of the right at law. Vice-Chancellor Wigram, considering that there was a sufficient case for protecting the plaintiff's right, but not a case for a perpetual injunction without the establishment of the right at law, retained the bill for a year, to give the patentee an opportunity of establishing his right.(*z*)

33. The plaintiff must come at the earliest possible period to ask for an injunction. If he has been delayed by unavoidable circumstances, on the hearing, an injunction may be granted, and made perpetual, if none has been previously obtained.(*a*)

34. The sale or use of machines piratically made during the existence of the patent, will be restrained both before and after the term. The articles manufactured, and things used in the manufacture, may be ordered to be given up and destroyed.(*b*)

35. An account of the profits made by the wrongful use of the patented invention, will be granted. Considerable difficulties sometimes occur in taking it.(*c*) Lord Eldon stated in one case, that if there was an invincible difficulty in taking the account, the Court might send the case to a jury, to ascertain what damage the plaintiff had sustained.(*d*)

36. Where the defendants had sold the invention, making no profit of it, and not used it otherwise than by furnishing the patent burners to their customers, Lord Langdale thought the plaintiff not entitled to an account.(*e*)

37. An account of the profits made during the existence of a patent, has been ordered four years after the expiration of *a patent.(*f*)

[*190] But it has been said, that an account will not be ordered unless an injunction is also granted (*g*)

38. If the defendant cannot deny the infringement, he should at once submit to the injunction, and offer to pay the costs of the suit up to that time. The plaintiff is not bound to be satisfied with an undertaking, but has a right to the protection of an injunction. If the defendant does not submit to these terms, the Court will give the plaintiff the costs of the suit to the hearing, and make the injunction perpetual.(*h*)

39. The affidavits used in moving for the injunction, should state the

(*z*) Ward v. Key, 10 Jurist, 792, Chy. (*a*) Bacon v. Spottiswoode, 1 Beav. 387.
(*b*) Crossley v. Beverley, 1 Russ. & Myl. 166; Crossley v. Derby Gas Company, 3 Myl. & Cr. 420; MacRae v. Holdsworth, 1 De Grex & Smale, 496.
(*c*) Crossley v. Derby Gas Company, 3 Myl. & Cr. 420, as to an account of the profits made by the use of a gas-meter. See ante, p. 160.
(*d*) Per Lord Eldon, 6 Ves. 706.
(*e*) Bacon v. Spottiswoode, 1 Beav. 387. See ante, p. 161.
(*f*) Crossley v. Derby Gas Company, Webst. P. C. 119.
(*g*) Bailey v. Taylor, 1 Russ. & Myl. 73.
(*h*) Losh v. Hague, Webst. P. C. 200; Geary v. Norton, 1 De Gex & Smale, 9; Fradella v. Weller, 2 Russ. & Myl. 247; Stericker v. Matthews, V. C. Turner, July 25, 1852.

belief of the patentee at the time of swearing it, that he was the true and first inventor. For though when he obtained the patent, he might very honestly have sworn to his belief of such being the fact, yet he may have since been convinced of the contrary.(*i*)

Accordingly where on a motion by the assignee of a patent for an injunction, neither the affidavits nor the bill stated the belief of the assignee at the time when he made the application, that the invention was new, the injunction was dissolved with costs.(*k*)

The affidavits should state particularly the facts which are relied on, as showing that an infringement has been committed.(*l*)

40. The Court will not make an order for costs where it is probable that proceedings may afterwards take place which would affect the decision of the Court on the question of costs.(*m*) It is the practice of courts of equity to make no order for the costs, except where the opposition is without foundation, until the hearing.(*n*)

41. Courts of common law, in dealing with questions of *injunction, inspection, and account will probably regulate their [*191] practice by that which has hitherto been the practice of the Court of Chancery. Where the title of the patentee has already been established at law, or the patentee has had long and uninterrupted possession, they may sometimes grant interlocutory injunction before trial, especially where the circumstances of the defendant are such that a judgment for damages is not likely to be a sufficient remedy. If an injunction is refused, at any rate an order for an inspection and account may be obtained. Probably the proper course would be, to obtain a summons or rule in the alternative.

In Howard v. Brown, the first case under this section, it was ordered, that on notice being given to the defendant or his attorney, he should within four days show cause why he should not be enjoined not to make, use, exercise, or vend springs made in imitation of Woods's invention; why he should not furnish an account of all springs theretofore made by him in such manner, and keep an account of all springs thereafter to be made. The affidavits stated the plaintiff's title as assignee, the substance of the patent and specification, the belief of the plaintiff and different scientific persons that Woods, the patentee, who was dead, was the first inventor, the novelty of the invention, and the sufficiency of the specification. They referred to the springs of the plaintiff and defendant, which were in court, and stated that the defendant's springs were substantially the same as the plaintiff's.

It was suggested that the best course would be to follow the practice of the Court of Chancery, and receive affidavits in reply to the defendant's affidavits; that it would be a convenient course to grant the injunction

(*i*) Hill v. Thompson, 3 Mer. 622; Webst. P. C. 231, S. C.; Neilson v. Thompson, Webst. P. C. 276, n. 279, n.
(*k*) Sturtz v. De la Rue, 5 Russ. 522.
(*l*) Hill v. Thompson, 3 Mer. 622; Webst. P. C. 229.
(*m*) Ward v. Key, 10 Jurist, 792, Wigram, V. C.
(*n*) Russell v. Cowley, Webst. P. C. 471, Lord Lyndhurst, C.

ex parte on a prima facie case, and leave the defendant to move to dissolve it.(*o*)

Rules will probably be made on the subject.

[*192] *CHAPTER XX.

FRAUDULENTLY USING THE NAME OR MARK OF PATENTEE.

1. It often happens that the goods of a particular manufacturer are ordinarily known in the trade by some figure, mark, or name, which he is in the habit of using. If another trader uses such a mark for the purpose of passing off his own goods as those of the man whose goods are well known by such mark, it is a fraud, for which an action for damages will lie at common law.(*a*)

Courts of equity will restrain such practises by injunction.(*b*) But where the manufacturer who complains of the use of his mark, adopted it for the purpose of deception, or has used a name he had no right to, courts of equity will not interfere.(*c*)

2. In addition to these remedies at common law, by stat. 5 & 6 Wm. 4, cap. 83, s. 7, it is enacted, that if any person shall put upon anything made, used, or sold by him, for the sole making or selling of which he has not obtained letters patent, the name, or any imitations of the name of any other person who has obtained letters patent for the sole making and vending of such thing, without leave in writing; or shall upon such thing, not having been purchased from the patentee or his licensee, or not having had the license or consent in writing of such patentee or his assigns, put the word "patent," the words "letters patent," or the words [*193] "by the king's *patent," or any words of the like kind, with a view of imitating 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, to be recovered by action of debt 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. Nothing therein contained is to 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 made, for the sole making or vending of which a patent before obtained shall have expired.

(*o*) Howard v. Brown, Q. B. Jan. 24, 1853.

(*a*) Rodgers v. Nowill, 5 C. B. 110; Crawshay v. Thompson, 4 M. & G. 357; Sykes v. Sykes, 3 B. & C. 541; Blofield v. Payne, 4 B. & Ad. 410.

(*b*) Ransome v. Bentall, 3 L. J. N. S. Chy. 161; Rodgers v. Nowill, 6 Hare, 325; Holloway v. Holloway, 13 Beav. 209; Millington v. Fox, 3 Myl. & Cr. 338; Motley v. Downman, 3 Myl. & Cr. 1.

(*c*) Perry v. Truefitt, 6 Beav. 66; Pidding v. How, 8 Si. 477

3. An action has been held to lie against a person fraudulently representing that an exclusive right to manufacture a particular article, which he was then bringing into the market, was vested in other persons, with intent to prevent the plaintiff from manufacturing such article, and deprive him of the profits to be derived from such manufacture.(*d*)

*CHAPTER XXI. [*194]

REMEDIES AGAINST PATENTEE.

Scire Facias to repeal Letters Patent.

1. The writ of scire facias to repeal letters patent lies, in the ordinary course of justice, in three cases: First. When the king, by his letters patent, doth grant, by several letters patent, one and the same thing to several persons, the *former patentee* shall have a scire facias to repeal the second patent.

Secondly. When the king granteth anything 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 anything which by law he cannot grant, he, jure regio, for advancement of justice and right, may have a scire facias to repeal his own letters patent.(*a*)

The writ issues out of the common-law side of the Court of Chancery.

2. A writ of scire facias to repeal letters patent was formerly obtained upon a petition to the Crown, the prayer of which was grantable as of course, the petition being in the nature of a petition of right.(*b*) In The Earl of Kent's case, it is said that the petition is the original writ. The remedy to be obtained is the cancelling of the letters patent, after calling upon the patentee to show why the grant should not be repealed.

*The writ of scire facias was said to be founded on the record of the patent remaining in Chancery. [*195]

3. By stat. 15 & 16 Vict. cap. 83, s. 15, the writ of scire facias shall lie for the repeal of any letters patent issued under that Act, in the like cases as the same would lie for the repeal of letters patent which before that Act were issued under the Great Seal.

4. All parties are to have all their remedies by scire facias in Ireland, as if the letters patent had been granted to Ireland only.(*c*)

Nothing in the Act contained is to affect the jurisdiction or forms of proceeding in the courts of Scotland. When any proceedings shall require to be taken in Scotland to repeal any letters patent, such pro-

(*d*) Barley v. Walford, 9 Q. B. 197.

(*a*) 4 Inst. 88; Rex v. Mussary, Bull. N. P. 76, *a*; Brewster v. Weld, 6 Mod. 229; Hunt v. Coffin, Dyer, 197, *b*; Penwarren v. Thomas, Dyer, 198, *a*.

(*b*) 6 M. & G. 251, note to Smith v. Upton, citing The Earl of Kent's case, 21 E. 3, fol. 47, pl. 68. See further, Webst. P. C. 669, n.; 2 Wms. Saund. 72, *w*, note 4.

(*c*) Stat. 15 & 16 Vict. cap. 83, s. 29.

ceedings shall be taken in the form of an action of reduction at the instance of her Majesty's Advocate, or at the instance of any other party having any interest, with concurrence of her Majesty's Advocate, which concurrence her Majesty's Advocate is empowered to give upon just cause shown only.(*d*) In any proceedings in Scotland to repeal any letters patent, service of all writs and summonses is to be made according to the existing forms and practice.(*e*)

5. It is not necessary that the prosecutor in a scire facias should have any direct interest in the repeal of the patent. An alien may be the prosecutor.

An illegal monopoly is a public grievance, and the Crown having been informed of such a grievance, and having the power and duty to remove it, if it be such, ought not to be disabled from directing the necessary proceedings to ascertain the truth because the prosecutor is an alien, has no interest in the matter, or is endeavouring improperly to promote the interests of other people.

If there is reason to suspect collusion, the Attorney-General may stay the proceedings.(*f*) It has been said, that after one person has sued out a scire facias, another cannot *do so.(*g*) Instances to the con- [*196] trary have occurred. Probably, pending one writ, the Attorney-General would not allow another to be issued or proceeded with.

6. By the Petty Bag Office Amendment Act, 1849, every solicitor of the Court of Chancery shall, by virtue of his admission, be an attorney of the Petty Bag. All proceedings which, before the passing of that Act, were conducted by the clerks of the Petty Bag as the attorneys for their clients, may now be taken by such client in his own proper person, or by his attorney.(*h*) The solicitor acting as an attorney on the common-law side of the Court of Chancery, is in all proceedings to be named and treated as the attorney of the party by whom he is retained.(*i*)

7. Any party changing, or ceasing to employ his attorney in the course of any action, &c., is to cause an entry of such change to be entered with the clerk of the Petty Bag, and to cause notice thereof to be served on every party to such proceeding. Until such entry and notice, the former attorney is to be deemed the attorney of the party.(*k*)

8. Attorneys are entitled to such costs for the transaction of business on the common-law side of the court, as are allowed to attorneys for business of a similar nature in her Majesty's superior courts of common law.(*l*)

9. Attorneys are to cause their names to be entered in a book at the

(*d*) Stat. 15 & 16 Vict. cap. 83, s. 43. (*e*) Stat. 15 & 16 Vict. cap. 83, s. 35.

(*f*) Reg. v. Prosser, 11 Beav. 306. See Sir Oliver Butler's case, 2 Vent. 344; 3 Lev. 221; Rex v. Wakelin, 1 B. & Ad. 50.

(*g*) Per Pollock, A. G. arg. Reg. v. Neilson, Webst. P. C. 673. See Hawk. P. C. Ch. 34; Com. Dig. Abatement, H. 24.

(*h*) Stat. 12 & 13 Vict. cap. 109, s. 24.

(*i*) Rules of the Petty Bag Office, 1849, rule 9.

(*k*) Rules of the Petty Bag Office, 1849, rule 10.

(*l*) Stat. 12 & 13 Vict. cap. 109, s. 25.

Petty Bag Office, with their addresses, at which pleadings, notices, and other proceedings may be left for, or sent to them.(*m*) The omission of the entry of the name of the attorney in the book is not a thing which renders the proceedings void, though it may be ground for setting them aside as irregular.(*n*)

10. All persons who have any interest in the letters patent should be joined as defendants. Their names may be taken from the register of proprietors.(*o*) The Crown has a right *to call on all the persons who obtained the patent to show cause why it should not be cancelled. The suggestion is, that the Queen has been deceived: the writ should call upon all those who are supposed to be guilty of the deception. A plea in abatement, by one of two defendants, that the other defendant had assigned all his interest to him, and that the action ought to have been brought against him alone, is bad.(*p*) [*197]

It is said that if a defendant is prejudiced by the fact that a party having no interest is collusively joined as a co-defendant, an application may be made to the Court for its summary interference, as upon an abuse of process. It would seem that the person improperly joined might plead in abatement.(*q*) So if the parties really interested in the patent are not made defendants.(*r*)

Where judgment had already passed against the patent in a writ in which one party was defendant, a writ of scire facias called upon others to show why the patent should not be vacated as to them, and so far as their interests were concerned, and no objection was taken. In a subsequent case, the Court questioned the regularity of this course of proceeding.(*s*)

11. The control of the proceedings in scire facias rests with the Attorney-General. In one case Lord Lyndhurst, on the application of the defendant, ordered an application to stay the proceedings in scire facias to stand over till after the decision of an appeal to the House of Lords from the Court of Session of Scotland, in which the validity of the patent would be determined.(*t*)

But in a subsequent case, Lord Langdale said, "That the Lord Chancellor acting as a judge, had no power to interfere with the discretion of the Crown. He might suggest to the Attorney-General the propriety of considering the circumstances of the case, and stay the proceedings, to give him an opportunity of doing so, but could not overrule his decision when formed. The Attorney-General might enter a nolle prosequi, and determine on what conditions the action should *be prosecuted; but he would not be permitted to prosecute an action if merely vexatious, and without any legal object."(*u*) [*198]

In a recent case, the Attorney-General (Sir F. Pollock,) on a petition for relief against certain suggestions in a writ of scire facias, which had

(*m*) See 12 & 13 Vict. cap. 109, s. 44.
(*n*) In re Baddley, 4 Exch. 508. (*o*) Stat. 15 & 16 Vict. cap. 83, s. 35.
(*p*) Reg. v. Betts and Stocker, 15 Q. B. 540; S. C. 14 Jurist, 912.
(*q*) See Com. Dig. Abatement, F. 14. (*r*) Com. Dig. Abatement, F. 4.
(*s*) See Reg. v. Hamilton, cited Bynner v. Reg. 15 Q. B. 544.
(*t*) Reg. v. Neilson, Webst. P. C. 665.
(*u*) Reg. v. Prosser, 11 Beav. 306; 18 L. J. N. S. Chy. 35; 13 Jurist. 71 S. C.

issued regularly, decided that he would direct a nolle prosequi to be entered to some of the suggestions in the writ; if the prosecutor insisted on retaining them.(*x*)

12. According to the present practice, the draft of the writ—having been settled by the counsel for the prosecution, with a short statement of any legal proceedings that have taken place with respect to the patent, that the amount of security may be fixed, and the names of the two sureties for the bond—must be taken to the Attorney-General, who thereupon subscribes his fiat.

Forms of writs may be found—Tidd's Forms, p. 446; Abbott's Forms of Writs on the Common Law Side of the Court of Chancery, p. 97. It will be necessary to observe, that if the scire facias is to repeal letters patent granted under the provisions of stat. 15 & 16 Vict. cap. 83 the words referring to the enrolment of the letters-patent in Chancery, must be omitted. Forms of suggestions will be found in Reg. v. Cutler, 3 Car. & K. 216; Reg. v. Bynner, 9 Q. B. 525; Reg. v. Mill, 10 C. B. 380. As to the degree of particularity required—Rex v. Arkwright, Dav. P. C. 51. See Dyer, 198.

A caveat may be entered at the chambers of the Attorney-General against the issuing of the writ, upon which notice will be given of the application for it, and the parties will come before him.(*y*)

13. Formerly a memorial was presented to the Crown for a scire facias, and a warrant issued to the Attorney-General for issuing it out. The Attorney-General then granted his fiat. This practice has been abandoned, but at what period, or on what grounds, has not been noticed in any of the books of practice.(*z*)

[*199] The fiat of the Attorney-General is necessary, whether *the writ issues ex debito justitiæ, or not. The writ does not issue as of course in any case.

14. It was said formerly, that any one prejudiced by the granting of letters patent, was entitled to a scire facias as a matter of right, and therefore without conditions.(*a*)

By the Rules of practice in the Petty Bag Office, made in pursuance of the forms of stat. 12 & 13 Vict. cap. 109, s. 41, a writ of scire facias to revoke letters patent, is not to be sealed—

First. Until the fiat of the Attorney-General is filed in the Petty Bag Office.

Secondly. Until the name of one of the superior courts of common law is indorsed or written thereon.

Thirdly. Until a true copy of the writ, and of any drawings or plans annexed thereto (to be verified by affidavit), has been filed in the Petty Bag Office.(*b*)

The name and address of the attorney or party suing out the writ, must be indorsed on the writ and copy.(*c*)

(*x*) Reg. v. Newall, Webst. P. C. 671, n.
(*y*) Webst. P. C. 671, note *h*.
(*z*) Webst. P. C. 669, n.; 2 Wms. Saund. 72, *u*, note 4.
(*a*) 9 Q. B. 547, per Hill, arg.; Brewster v. Weld, 6 Mod. 239, ante, 194.
(*b*) Rules of Practice in the Petty Bag Office, 1849, rule 14.
(*c*) Abbott, Forms of Writs in the Petty Bag Office, Introduction.

15. A bond of indemnity against costs to be incurred in the prosecution of an action of scire facias, may (if so desired by the Attorney-General) be taken in the name of the clerk of the Petty Bag; but the same is not to be deposited or filed in the office of Petty Bag, unless the intended obligors, and the sums for which they are to give security, be named by the Attorney-General.(*d*)

The penal sum in the bond is usually £1,000, but it may be a larger sum if the Attorney-General think fit. See the form of bond and condition—Abbott's Forms of Writs in the Petty Bag Office, p. 921; 4 Beav. 314.

16. The bond of indemnity filed or deposited in the Petty Bag Office, may, at the request of the Attorney-General, be put in suit under such terms and conditions as the Lord Chancellor or Master of the Rolls may approve of.(*e*)

The enforcement of the bond is subject to the discretion of the Lord Chancellor or Master of the Rolls, and the Attorney-General, who will exercise a proper discretion upon it. Where a prosecutor persisted in proceeding with a scire facias, *after a defective patent had been cured by a disclaimer, the Court caused the bond to be put in suit for all costs subsequent to the entry of the disclaimer, deducting those previously incurred.(*f*) [*200]

17. The writ is to be sealed with the Chancery common seal.(*g*)

It may be issued and tested on any day, not being Sunday, Good Friday, or Christmas-day, either in term or vacation.(*h*) It must be tested on the day when it is sealed;(*i*) and indorsed with the name and address of the attorney or party suing it out.(*j*)

18. All proceedings may be taken either in term-time or vacation, on any day, not being Sunday, Good Friday, or Christmas-day.(*k*) Before the passing of this Act, proceedings must have been taken in term.(*l*)

The writ may be made returnable on any day certain to be mentioned in the writ, not being Sunday, Good Friday, or Christmas-day, whether in term-time or vacation, or forthwith after the execution thereof.(*m*)

If not executed, it must be lodged with the proper officer at least two days before it is returnable; and no alias sci. fa. shall be issued before the first sci. fa. shall be issued, lodged, and returnable as aforesaid.(*n*)

19. It may be directed to the sheriff of any county in England or Wales.(*o*)

By stat. 15 & 16 Vict. cap. 83, s. 35, any writ of scire facias to repeal letters patent, may be issued to the sheriff of the county or counties in

(*d*) General Rules as to proceeding in the Petty Bag, 1849, rule 17.
(*e*) Ib. rule 18.
(*f*) Reg. v. Mill, 14 Beav. 314. See in that case the form of condition and fiat of the Attorney-General.
(*g*) 12 & 13 Vict. cap. 109, s. 14. (*h*) 12 & 13 Vict. cap. 109, s. 26.
(*i*) Rules of the Petty Bag Office, 1849, rule 6.
(*j*) Abbott's Forms of Writs on the Common Law Side of the Court of Chancery, Introduction.
(*k*) 12 & 13 Vict. cap. 109, s. 28.
(*l*) Ex parte King, 1 Sanders' Orders in Chancery, 355.
(*m*) 12 & 13 Vict. cap. 109, s. 27.
(*n*) 1 Sanders, Orders in Chancery, 443, 444. (*o*) 12 & 13 Vict. cap. 109 s. 29.

which the grantee or grantees resided at the time when the said letters patent were granted; and in case such grantee or grantees do not reside in the United Kingdom, it shall be sufficient to file such writ *in [*201] the Petty Bag Office, and serve notice thereof in writing at the last known residence or place of business of such grantee or grantees.

20. If the sheriff warns the defendant, he returns scire facias.(*p*)

The defendant is generally served with a copy of the sheriff's warrant, which recites the writ of scire facias; or at least, has some notice of the proceedings given to him.(*q*)

It is said that where the sheriff returns scire feci, the Court will not inquire into the validity of the summons on motion, but leave the party to his action against the sheriff for a false return.(*r*)

Personal service of the writ seems not necessary. If the defendant is abroad, it seems sufficient if he has reasonable notice of the proceeding.(*s*)

If the sheriff does not warn the defendant, he returns nihil, in which case an alias scire facias issues. If the sheriff return nihil to the second writ, and the defendant does not appear, there shall be judgment against him.(*t*)

Where the defendant is prevented from pleading by the plaintiff's procuring two nihils to be returned, the Court will relieve him on motion.(*u*) An audita querela will not lie against the Crown.(*v*)

21. When the writ is returned by the sheriff, it is to be immediately filed, and the day and hour of filing are to be indorsed upon the writ.(*w*)

Upon the return of the writ, it is the practice to enter a rule to answer. It seems that judgment signed without entering such rule might be set aside.(*x*)

22. An appearance is to be entered by or on behalf of any defendant who has been summoned by the sheriff, within eight days after the writ of scire facias has been returned and filed.(*y*)

*If the defendant does not appear, judgment shall go against [*202] him by default, and the patent will be avoided.(*z*)

23. As soon as the defendant has appeared, the declaration may be delivered to the defendant or his attorney.(*a*)

Forms of declaration may be found in Abbott's Forms of Writs on the Common Law Side of the Court of Chancery, p. 97, form 90; Tidd's Forms, &c.

(*p*) Tidd's Practice, 1092.

(*q*) 2 Wms. Saund. 72, y, note to Underhill v. Devereaux, ib. 72, c c.

(*r*) 2 Wms. Saunders, 72, y, citing Barr v. Satchwell, 2 Stra. 813. See, however, Pool v. Wills, 2 T. R. 758; Webb v. Harvey, ib. 757.

(*s*) Weatherhead v. Sanders, 3 Scott, 407; 5 Scott, 189.

(*t*) Rex v. Eston, Dyer, 198, a.

(*u*) Holt v. Frank, 1 M. & S. 199; 2 Wms. Saund. 72, c c; Sampson v. Collingwood, 1 Salk. 262; Ludlow v. Lennard, 2 Ld. Ray. 1295.

(*v*) Manning's Exchequer Practice, 617.

(*w*) Rules of Practice in the Petty Bag, 1849, rule 7.

(*x*) Rex v. Newcastle-upon-Tyne, 1 Sanders' Orders in Chancery, 390.

(*y*) Rules of Practice in the Petty Bag, 1849, rule 19.

(*z*) Vin. Abr. Prerog. x. 6; Bro. Ab. Patents, 20; Rex v. Toly, Dyer, 197, b; Rex v. Blage, ib.; Rex v. Eston, ib. 198, a; Penwarren v. Thomas, ib.; Vin. Ab. Sci. Fa. 9, pt. 3; Rex v. Amery, 2 T. R. 515, 554, 567.

(*a*) Stat. 12 & 13 Vict. cap. 109, s. 30,

The prosecutor with his declaration is to deliver particulars of the objections on which he means to rely. At the trial, no evidence shall be allowed to be given which shall not be contained in the particulars.(*b*) As to the particulars of objection, see ante, 169—174.

24. It appears that by the practice of the Court, the defendant has eight days' time to plead after the delivery of the declaration. No rule to plead is requisite.

If the defendant does not plead at the expiration of the eight days, judgment by nil dicit may be signed against him, and the patent will be avoided.(*c*)

The defendant may obtain time to plead on application to the Master of the Rolls or a judge of a court of common law.(*d*)

25. The defendant may plead in abatement(*e*) or in bar, or may demur to the declaration, or to each suggestion in it; or he may demur to some of the suggestions, and plead to others. But as the Crown is not bound by the stat. 4 & 5 Anne, cap. 16, the defendant cannot plead several matters.(*f*)

In a case where the defendant pleaded several matters, Lord Langdale made an order setting aside the pleas with costs, for irregularity.(*g*) Defendants may sever in pleading, one demurring and the other pleading; and in such case *the Attorney-General may try which issues he pleases first.(*h*) [*203]

26. Every demurrer, plea, and subsequent pleading, shall be delivered by the party demurring or pleading, or his attorney, to the opposite party or his attorney; and the issue shall be made up by either party or his attorney, and delivered to the opposite party or his attorney.(*i*)

The form of issue may be seen—Abbott's Forms of Writs, p. 95.

27. Notice of trial must be indorsed on the issue. The same number of days' notice is to be given as in the common law courts in ordinary cases.(*k*) See stat. 15 & 16 Vict. cap. 76, s. 97.

28. The Chancellor, though a common law judge, has no power to summon a jury. Therefore, if there are issues in fact, the Court of Chancery cannot try the issues, but the Lord Chancellor delivers the record by his proper hands into the common law court, the name of which is indorsed on the writ to be tried there.(*l*)

If there be issues in law and fact, the whole record must be sent into the court of common law;(*m*) for there cannot be a judgment of the Chancellor upon one part of the record, and a judgment of the court of common law upon another part of the same record.

(*b*) Stat. 15 & 16 Vict. cap. 83, s. 41.
(*c*) Hunt v. Coffin, Dyer, 197, b. (*d*) Stat. 12 & 13 Vict. cap. 109, s. 39.
(*e*) Rex v. Hare and Mann, 1 Stra. 146; Reg. v. Betts and Stocker, 15 Q. B. 547.
(*f*) The King v. Archbishop of York, Willes, 533.
(*g*) Reg. v. Nickels, Hindmarch on Patents, 400, 430.
(*h*) Rex v. Hare and Mann, 1 Stra. 260.
(*i*) Stat. 12 & 13 Vict. cap. 109, s. 31. (*k*) Abbott, Forms of Writs, &c. 104.
(*l*) See 4 Inst. 80; Smith v. Upton, 6 M. & G. 253, n.; 12 & 13 Vict. cap. 109, s. 32.
(*m*) Jefferson v. Morton, 2 Saund. 23. See a query, note to Smith v. Upton, 6 M. & G. 258.

Where there are several defendants, and some of them plead to issue, and the others demur, the whole record must come to the court of common law, which shall give judgment both on the verdict and demurrer.(*n*)

Where there is a demurrer only, it has sometimes been the practice to [*204] determine it in the Court of Chancery, without transmitting it into the Court of Queen's Bench.(*o*) But *although it is the practice to adjudge demurrers in law joined in Chancery before the Lord Chancellor, yet the Court of Chancery may, if it will, adjourn any cause either before or after demurrer or issue joined.(*p*)

29. In case issue is joined respecting any matter of fact, to be tried by the country, the record shall be made up and filed in the office of the Petty Bag; and the issue may be tried either in the Queen's Bench, Common Pleas, or Exchequer of Pleas.(*q*) The trial is to take place in the court, the name of which is indorsed on the writ.(*r*) See form of record of issue—Abbott's Forms of Writs, p. 104, form 97.

30. The writ of venire facias was formerly issued out of the Petty Bag Office.(*s*) It was returnable and returned in the court in which the issue was to be tried.(*t*) (See Abbott's Forms, p. 105.) It seems no longer necessary since stat. 15 & 16 Vict. cap. 76, s. 104. It may be prudent to retain it as an instruction, till some decision has taken place on the point.

31. A transcript of the record containing the issue, shall be taken or sent into the court in which the issue is to be tried.(*u*) It is delivered out to the attorney of the party, and taken by him into the court of common law.

The transcript is sealed with the Chancery common-law seal. This transcript is filed: if sent to the Queen's Bench, in the Crown Office. Another record, setting out the Chancery record, is then to be prepared, and the cause set down in the common law court in the usual manner.(*x*) See forms—Abbott's Forms of Writs, pp. 104, 105. See stat. 15 & 16 Vict. cap. 76, s. 102. See forms of record of Nisi Prius—Abbott's Forms of Writs, pp. 104, 105; Corner's Crown Practice, App. pp. 99, 128. The venue must be laid in Middlesex.

32. Upon the transcript of the record being brought into *the [*205] court of common law, the Court may proceed to try the issue, either at Bar or at Nisi Prius, as such Court shall think fit.(*y*)

Since the passing of this Act, the Attorney-General's warrant seems not necessary, to enable the prosecutor to have a writ of nisi prius in a

(*n*) Jefferson v. Morton, 2 Saund. 23; Jefferson v. Dawson, 1 Sid. 437.

(*o*) The King v. Butler, 3 Lev. 220; Vin. Ab. Prerog. T. b. pl. 21; Sir Oliver Butler's case, 3 Vent. 344; Vin. Ab. Prerog. T. b. pl. 4, n.; The King v. Knox, G. Coop. 98.

(*p*) Jefferson v. Morton, 2 Saund. 23, Acc.; Reg. v. Betts, 15 Q. B. 540; Jefferson v. Dawson, 1 Sid. 437; Rex v. Hare, 1 Stra. 146.

(*q*) Stat. 12 & 13 Vict. cap. 109, ss. 32, 33.

(*r*) Rules of the Petty Bag Office, 1849, rule 16.

(*s*) Abbott's Forms, 105; Reg. v. Aires, 10 Mod. 259.

(*t*) 12 & 13 Vict. cap. 109, s. 32.

(*u*) Stat. 12 & 13 Vict. cap. 109, s. 32.

(*x*) Abbott's Forms of Writs, 105.

(*y*) Stat. 12 & 13 Vict. cap. 109, s. 32.

scire facias to repeal a patent.(z) However, it appears to be still the practice to obtain it. The record need not be sealed or passed.

33. In case any issue in law, or in fact and law, shall be joined, the record of such issue or issues shall be made up and filed in the office of the Petty Bag; and a transcript of the record shall, or may be, sent into one of the superior courts of common law, who may hear and determine the same.(a)

34. The superior courts of common law, and the judges thereof respectively, are to have the same powers in respect of the transcript of any record, and the pleadings, issues, and matters therein contained, as they would have with respect to the record in any action commenced and pending in such court.(b)

35. The action being on a record, must be tried in Middlesex.(c) The issues may be tried either by a special or common jury. The provisions of the Common Law Procedure Amendment Act as to juries and jury process appear to apply to the trial of issues in scire facias. The Attorney-General's warrant for a tales should be obtained.(d) If no tales is prayed, and the cause goes off for want of a jury, neither party is liable to pay costs.(e) If the prosecutor does not proceed to trial according to notice, he will have to pay costs.(f)

36. The form of a subpœna ad testificandum may be seen Corn. Cro. Pr. App. 198. It will be proper to give notice to admit any documents proposed to be adduced in evidence, *though the statutes and rules of court relating to notices to inspect and admit, do not [*206] apply to proceedings at the suit of the Crown. The court of common law may issue a commission to examine witnesses.(g)

If the prosecutor is guilty of delay in carrying the cause to trial, an application should be made to the court.(h)

37. On the trial of any proceedings in scire facias, the defendant is entitled to begin and give evidence in support of the letters patent; and in case evidence shall be adduced on the part of the prosecutor impeaching the validity of the letters, the defendant shall be entitled to the reply.(i) The burden of proof is apparently not affected by this enactment. The onus of proving the truth of the suggestions in the scire facias will still lie upon the prosecutor. If the jury find that the case is left in doubt, they must find a verdict for the defendant.(k)

38. It has been doubted whether a defendant is entitled to tender a bill of exceptions, the king not being named in the statute of Westminster. There are several instances in which it has been allowed.(l)

(z) See Rex v. Archbishop of York, Willes's Reports, 535; 2 Inst. 424; Rex v. Astry, 6 Mod. 123. See Rex v. Wright, 1 A. & E. 434.

(a) Stat. 12 & 13 Vict. cap. 109, s. 33. (b) Stat. 12 & 13 Vict. cap. 109, s. 34.

(c) 2 Chit. Pl. 337. (d) Corn. Cro. Pr. 142; 2 Hawk. P. cap. 41, s. 18.

(e) Rex v. Righton, 3 Burr. 1695.

(f) Corn. Cro. Pr. 141; Rex v. Bartrum, 8 East, 269; Rex v. Waring, 5 T. R. 454.

(g) Hargrave v. Hargrave, 4 C. B. 654; Bourdeaux v. Rowe, 1 B. N. C. 721.

(h) Rex v. Dyde, 7 T. R. 661; Rex v. Macleod, 2 East, 202; Rex v. Masters. Parker, 51; Rex v. Banks, 6 Mod. 247.

(i) Stat. 15 & 16 Vict. cap. 83, s. 41. (k) Reg. v. Cutler, 3 Car. & K 229.

(l) Willes's Reports, 535, and cases cited in note, ib.: Reg. v. Cutler, 3 Car. & Kir. 229.

New trials may be granted. If the trial is had in vacation, motions for new trials must be made within the first four days of term.(*m*) After verdict for the Crown, a new trial may be ordered on payment of costs.(*n*)

39. Stat. 15 & 16 Vict. cap. 109, s. 32, directs that a transcript of the record shall be sent into the court of common law; the old forms stated, that the Chancellor delivered a record. The transcript seems a sufficient record to enable the court of common law to give judgment.(*o*) There is a difference of opinion, whether judgment should be given in
[*207] *the court to which the record is sent, or whether the record is to be remanded into Chancery for final judgment.

40. Where the judgment of the court of common law is in favour of the patentee, it is the practice to enter up final judgment for the patentee in the court of common law, because nothing remains to be done in the Court of Chancery. Judgment was so entered in The Queen v. Mill.

41. When judgment is given for the Crown, final judgment may be given in the Court of Queen's Bench to cancel the patent, though the letters patent remain in the Court of Chancery. The Court has authority to award the judgment, and afterwards to transmit either the record or the terms thereof to the Court of Chancery, to be fully carried into execution.(*p*) The cancellation of the letters patent has been said to be a mere ministerial act. But it seems to be doubted, whether the Lord Chancellor would consider it as such.(*q*)

In Corner's Crown Practice, it is stated, that interlocutory judgment is signed in the Court of Queen's Bench, and that final judgment is given in Chancery upon the record being sent back after the issues have been tried. It is there said not to have been the practice to give judgment in the Queen's Bench.(*r*) In The Queen v. Steiner, an entry was made upon the record, that it did not belong to the Court of Queen's Bench to give judgment, and the record was transmitted to the Court of Chancery, and final judgment given there. In The Queen v. Nickels, the record of the verdict was sent out of the Queen's Bench into Chancery, and judgment given for the Crown there, to revoke and cancel the patent, and cancel the enrolment. A writ of error was afterwards brought in the House of Lords, but the want of authority of the Court of Chancery to
[*208] give judgment, was not assigned as a ground of *error.(*s*) The statute enacts, that the superior courts of common law are to have the same power as the Court of Queen's Bench had; "but nothing

(*m*) Rex v. Macleod, 3 Price, 203.
(*n*) Rex v. Bewdley, 1 P. Wms. 207; Hullock on Costs, 396.
(*o*) Bynner v. Reg. 9 Q. B. 551, Tindal, C. J.; Reg. v. Bynner, 9 Q. B. 529.
(*p*) Bynner v. The Queen, 9 Q. B. 523; Rex v. Aires, 10 Mod. 258, 354. See The Baron de Bode's case, 8 Q. B. 208; The Baron de Bode v. The Queen, 13 Q. B. 380; Tidd's Practice, 1095; Rex v. Arkwright, Dav. P. C. 144; Webst. P. C. 74; Jefferson v. Morton, 2 Saund. 6 a, 27; 1 Eq. Ca. Ab. 128; note to Smith v. Upton, 6 M. & G. 256.
(*q*) Cancelling the king's letters patent under the great seal is said to be the highest point of the Lord Chancellor's jurisdiction, 4 Inst. 88.
(*r*) Corner's Crown Practice, 252. See contra, Tidd's Practice, 1095.
(*s*) Reg. v. Nickels, Hindmarch on Patents, 419; Corner's Crown Practice, 202.

is to authorize the giving final judgment in any case in which the Court of Queen's Bench had not such authority."(*t*)

The superior courts of common law are to give judgment, and execute judgment, as the Court of Queen's Bench might have done.(*u*)

42. Judgment in the case of The Queen v. Bynner was signed and entered in the following manner. Interlocutory judgment was entered in a book at the Crown Office, and signed by one of the masters on the Nisi Prius record; the continuance(*x*) and verdict, together with a judgment thereon, which was drawn and settled by counsel, were entered by the attorney on the Queen's Bench roll, and a transcript was then made and returned into the Court of Chancery; the original Queen's Bench roll remaining in that court.(*y*)

43. Upon the trial or determination of any issue in any of the superior courts of common law, or upon any rule or order being made, or judgment given in any action, suit, orp roceeding, in which the transcript of the record shall be brought before them, a transcript of such judgment, rule, or order, and of the proceedings of the court of common law upon such issues, shall be taken into the Court of Chancery, to the end that judgment may be given, or such other proceedings had in Chancery, according to the law and custom of England; and no mittimus shall be necessary to remand the transcript.(*z*)

44. The clerk of the Petty Bag, upon receiving the return of the transcript of the verdict of the jury, and proceedings or judgment of any court of common law upon any issue in law or in fact, is to file the same in the Petty Bag Office, and *is to cause an entry to be made of such verdict and proceedings or judgment, and such transcript is [*209] to be annexed to the original record in the Petty Bag Office; and thereupon the judgment of the Court of Chancery is to be entered on or annexed to the same record, in conformity with the judgment of the court from which the transcript is returned.(*a*)

45. The judgment of the Court of Queen's Bench may be, that the letters patent be revoked, cancelled, vacated, disallowed, annulled, and held void, and that the enrolment be cancelled and annulled, and that the letters patent be restored into the Court of Chancery, there to be cancelled.(*b*)

46. The king's warrant for a scire facias used to recite that it would be in the king's power, after conviction, to suspend the entry of any judgment to vacate the patent.(*c*) The case of confirmation after verdict is specially provided for by stat. 5 & 6 Wm. 4, cap. 83, s. 2. After verdict for the Crown, if the defects in the patent or specification can be cured by disclaimer or confirmation, the defendant may apply to the

(*t*) Stat. 12 & 13 Vict. cap. 109, s. 34. (*u*) Stat. 12 & 13 Vict. cap. 109, s. 35.
(*x*) See Corn. Cro. Pr. 145; a form, ib. App. 104; 2 Wms. Saund. 300, note 3, 253; note 8; Tidd's Practice, 778. See 15 & 16 Vict. cap. 76, s. 104.
(*y*) Reg. v. Bynner, Corn. Cr. Pr. 202. (*z*) Stat. 12 & 13 Vict. cap. 109, s. 36.
(*a*) General Rules of the Court of Chancery as to Petty Bag Office, 1849, No. 9.
(*b*) Bynner v. The Queen, 9 Q. B. 523. See 4 Inst. 88.
(*c*) 2 Rich. C. P. 392, 394, cited 9 Q. B. 532.

Court to suspend its judgment, or to the Attorney-General to stay the proceedings, to enable him to disclaim or obtain confirmation.(*d*)

47. It has been held that the patent is not effectually and finally destroyed by surrender, unless there is an actual surrender or cancelling, and a vacatur of the enrolment entered.(*e*)

In The Queen v. Newton, the defendant being unable to bring the patent into court to be cancelled, being merely the trustee of the person in possession of it, who resided abroad, was excused from producing it in obedience to the judgment, on undertaking not to assign the patent, or bring any writ of error.(*f*) The enrolment was ordered to be cancelled, and a vacatur entered upon the roll.

[*210] *After verdict and judgment for the Crown, an application was made in pursuance of leave given, that certain letters patent granted to the defendant might be restored into Chancery, and that the letters patent and the enrolment thereof might be cancelled and vacated; and that in default of producing the letters patent, the defendant might be committed for contempt. The Lord Chancellor ordered the clerk of the Petty Bag formally to call upon the defendant to produce the letters patent. The officer thereupon three times called upon the defendant to appear and produce the letters patent; the defendant, however, did not appear. The Lord Chancellor ordered an entry of the defendant's default to be made. He doubted whether the judgment obtained in favour of the Crown, was a sufficient ground to enable the Court to make the order sought, or that, in the first instance, the enrolment of the letters patent should be vacated, in the absence of the letters patent themselves. He said, the defendant should not be allowed to evade the power of the Court by withholding the letters patent; and made an order that the defendant should show cause on a day named, why, in default of production of the letters patent, the enrolment should not be vacated, and an attachment issue for the commitment of the defendant. The patent being afterwards brought into court, was ordered to be cancelled, and the enrolment vacated.(*g*)

48. For errors in law in the judgment of the Court of Chancery in the Petty Bag Office, error lies to the House of Lords.(*h*) A form of writ of error may be found in Abbott's Forms, p. 45. The fiat of the Secretary of State for the writ must be obtained. For errors in the judgment of the Queen's Bench, the writ of error lies to the Exchequer Chamber.(*i*)

49. Before 1849, interlocutory matters in proceedings in the Petty Bag Office, before the transmission of the record into the Court of Queen's Bench, were heard before the Master of the Rolls.

(*d*) 9 Q. B. 547, Bynner v. The Queen, Tindal, C. J. See Reg. v. Bynner, note to Smith v. Upton, 6 M. & G. 260.

(*e*) Sir Robert Sidnie's case, Dyer, 167, *a*; Sir T. Wroth's case, ib.; Kemp v. Makewilliams, Dyer, 195, *a*; Com. Dig. Patent, E. G.

(*f*) Reg. v. Newton, Hindmarch on Patents, 426; 5 Law Times, 261; S. C. cited 9 Q. B. 528.

(*g*) Reg. v. Steiner, 18 Law Times, Chy. 267.

(*h*) Note to Smith v. Upton, 6 M. & G. 257.

(*i*) See Bynner v. The Queen, 9 Q. B. 523.

In every action, suit, and proceeding in the Court of Chancery *on the common-law side, the courts of common law, and [*211] the judges thereof, are to hear and determine all such matters and applications, and do all things which before the passing of the Act might have been decided and ordered by the Lord Chancellor and Master of the Rolls, subject to the laws and rules in force for the regulation of the Court and the practice thereof.(*k*) The jurisdiction of the Chancellor and Master of the Rolls is not affected.(*l*)

Such applications *may* therefore be disposed of either by the Master of the Rolls or the Court, or a judge of the court the name of which is indorsed on the writ of scire facias.

But it seems that if an application be made to the Master of the Rolls, in a matter properly within the cognizance of a court of common law, he would either adjourn the case to the court of common law, or refuse to entertain the application altogether.(*m*)

50. Affidavits to be used in the Court of Chancery on the common-law side, may be sworn before the clerk of the Petty Bag.(*n*) By the rules of the court, affidavits, affirmations, and declarations to be used in any proceeding in the common-law side of the Court of Chancery, are to be sworn, affirmed, or declared before the clerk of the Petty Bag, or before a Master Extraordinary in Chancery, and are to be filed in the office of the Petty Bag.(*o*)

51. No costs are recoverable as part of the judgment by the prosecutor.(*p*) The defendant is entitled to costs according to the condition of the bond required from the prosecutor by the Attorney-General. Costs are sometimes given upon interlocutory proceedings.(*q*) In Reg. v. Crawfurd, the defendant having appealed against an order of Lord Langdale, setting aside his pleas with costs, the Lord Chancellor refused the motion, but directed that, on payment of the costs of that *application, the defendant should be at liberty to plead de novo. A [*212] new trial may be granted on payment of costs.(*r*) In all cases where any party shall be entitled to the costs of any issues or proceedings in any court of common law, the costs shall be taxed by one of the Masters of the court, who shall indorse his allocatur on the rule or order as the case may be, or upon the postea before the same shall be taken or returned into the Court of Chancery.(*s*)

The costs of proceedings in the Court of Chancery or the Petty Bag are taxed by the clerk of the Petty Bag.

(*k*) Stat. 12 & 13 Vict. cap. 109, s. 39. (*l*) Stat. 12 & 13 Vict. cap. 109, s 45.
(*m*) See In re Baddeley, 4 Exch. 508. See also Montgomery v. Blair, 2 Sch. & Lef. 136.
(*n*) Stat. 12 & 13 Vict. cap. 109, s. 45.
(*o*) General Rules of Practice in the Petty Bag, 1849, rule 5.
(*p*) Rex v. Miles, 7 T. R. 367.
(*q*) Hindmarch on Patents, 430, citing Reg. v. Nickels, Reg. v. Crawfurd.
(*r*) Hullock on Costs, 396. (*s*) Stat. 12 & 13 Vict. cap. 109, s. 37.

APPENDIX.

FORMS.

1.—PETITION.(*a*)

To the Queen's Most Excellent Majesty.

The humble petition of [here insert name and address of petitioner] showeth, that your petitioner in possession of an invention for [the title of the invention] which invention believe will be of great public utility; that(*b*) [he is the true and first inventor thereof; he acquired the same by means of a communication made to him by a certain person residing abroad, &c.; or the like] and that the same is not in use by any other person or persons to the best of knowledge and belief.

Your petitioner therefore humbly prays, that your Majesty will be pleased to grant unto h executors, administrators, and assigns, your royal letters patent for the United Kingdom of Great Britain and Ireland, the Channel Islands, and the Isle of Man, for the term of fourteen years, pursuant to the statutes in that case made and provided.

And your petitioner will ever pray, &c.

[The name and address of the petitioner, and the title of the invention, to be written very legibly. The petition must be impressed with a stamp of £5.]

[*216] *2.—DECLARATION.

I, , of , in the county of , do solemnly and sincerely declare that in possession of an invention for [the title as in

(*a*) The necessary forms, on paper of the proper size and description can be had in any quantity of Messrs. Sackett and Ruscoe, 8, Quality-court, Chancery-lane.

(*b*) The words in the Act are, "that I am the first and true inventor," which must be used when not a communication.—See Nickels v. Ross, 8 C. B. 679. If patented abroad, it should be so stated.

petition] which invention believe will be of great public utility; that I am the true and first inventor thereof [or otherwise, as the case may be], and that the same is not in use by any other person or persons to the best of knowledge and belief;(*c*) and 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 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.'"

* (*d*)

Declared at , this day of , in the year of our Lord 185 , before me,

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3.—DECLARATION WHEN COMPLETE SPECIFICATION IS DEPOSITED.

The same as the preceding, but at the (*c*), after the word belief, insert, "And that the instrument in writing, under my hand and seal hereunto annexed, particularly describes and ascertains the nature of the said invention, and the manner in which the same is to be performed."

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*4.—PROVISIONAL SPECIFICATION. [*217]

I, [or we] do hereby declare the nature of the said invention for [here insert title] to be as follows: [here insert description].

Dated this day of , A. D. .

[To be signed by the applicant or his agent.]

[Indorse the name of the petitioner or his agent.]

5.—CERTIFICATE OF RECORD OF PETITION, DECLARATION, AND PROVISIONAL SPECIFICATION.

Patent Law Amendment Act, 1852.

This is to certify, that the petition, declaration, and provisional of spe-

(*c*) The old form was, "hath not been practised or used by any person within this realm." If patented or in use abroad, it should seem that it should be so stated.

(*d*) To be signed by the party making the declaration, where the asterisk is placed, and to be declared before a master in Chancery or justice of the peace.

cification of , applying for letters patent for the invention of , have been this day left and recorded in the office of the Commissioners of Patents for Inventions.

Dated this day of , 185 .

6.—CERTIFICATE OF RECORD OF PETITION, DECLARATION AND COMPLETE SPECIFICATION.

Patent Law Amendment Act, 1852.

This is to certify, that the petition and declaration of , applying for letters patent for the invention of , have been this day left and recorded in the office of Commissioners of Patents for Inventions, and the complete specification accompanying such petition and declaration has been filed in the said office.

Dated this day of , 185 .

[*218] *7.—CERTIFICATE OF LAW OFFICERS AS TO SUFFICIENCY OF PROVISIONAL SPECIFICATION.

Patent Law Amendment Act, 1852.

This is to certify, that the petition, declaration, and provisional specification of , for the invention of , left and recorded in the office of the Commissioners of Patents for Inventions, on the day of , 185 , having been referred to me, and I, being satisfied that the said provisional specification describes the nature of the invention, have allowed the same.

Dated this day of , 185 .

8.—ALLOWANCE OF AMENDMENT OF PROVISIONAL SPECIFICATION.

Patent Law Amendment Act, 1852.

Petition of , for a patent for .

Whereas the provisional specification upon this petition is insufficient, I hereby allow the same to be amended by

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9.—NOTICE OF ALLOWANCE OF PROVISIONAL PROTECTION, FOR THE "GAZETTE."

Patent Law Amendment Act, 1852.

Office of the Commissioners of Patents for Inventions.

Notice is hereby given, that provisional protection has been allowed to

, for the invention of , on petition recorded in the office of the Commissioners on , the day of , 185 .

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*10.—NOTICE OF DEPOSIT OF COMPLETE SPECIFICATION, FOR "GAZETTE."

[*219]

Patent Law Amendment Act, 1852.

Office of the Commissioners of Patents for Inventions.

Notice is hereby given, that the petition of , praying for letters patent for the invention of , was deposited and recorded in the office of the Commissioners on the day of , 185 ; and a complete specification accompanying such petition was at the same time filed in the said office.

11.—NOTICE OF PROCEEDING.

Patent Law Amendment Act, 1852.

I, [or agent for] , do hereby give notice, that it is intention to proceed [if by agent, on behalf of] with application for letters patent for the invention of , as set forth in petition recorded in the office of the Commissioners of Patents for Inventions, on the day of , 185 .

Dated this day of , 185 .

12.—CERTIFICATE OF NOTICE TO PROCEED, FOR "GAZETTE."

Patent Law Amendment Act, 1852.

Office of the Commisioners of Patents for Inventions.

Notice is hereby given, that given notice at the office of the Commissioners, of intention to proceed with application for letters patent for the invention of , as set forth in petition recorded in the said office, on the day of , 185 . And notice is hereby further given, that all persons having an interest in opposing such application, are at liberty to leave particulars in writing of their objections to the *said application at the said [*220] office of the Commissioners, within twenty-one days after the date of the Gazette in which this notice is issued.

[The certificate of record of notice to proceed, must be impressed with a £5 stamp.]

13.—NOTICE OF OBJECTION.

Patent Law Amendment Act, 1852.

I, , hereby give notice, that I object to the grant of letters patent to , for the invention of , as set forth in petition recorded in the office of the Commissioners of Patents for Inventions, on the day of , 185 . And my objection to the grant of such letters patent as follows:—

Dated this day of , 185 .

14.—REFERANCE TO LAW OFFICERS.

[To be indorsed on the petition.]

Her Majesty is pleased to refer this petition to , to consider what may be properly done herein.

15.—NOTICE OF HEARING.

Her Majesty having referred to me the petition of , praying letters patent for , I therefore appoint to consider thereof; of which let all parties have notice.

By order of the Attorney-General.

To Mr.

[*221] *16.—WARRANT FOR PATENT.

In humble obedience to her Majesty's command referring to me the petition of , of , to consider what may properly be done therein, I hereby certify as follows: That the said petition sets forth that the petitioner

[Allegations of the petition.]

And the petitioner most humbly prays,

[Prayer of the petition.]

That in support of the allegations contained in the said petition, the declaration of the petitioner has been laid before me, whereby he solemnly declares, that

[Allegations of the declaration.]

That there has been also laid before me [a provisional specification, signed , and also a certificate] *or* [a complete specification and a certificate of the filing thereof], whereby it appears that the said invention was provisionally protected, [*or* protected] from the day

of , A. D. , in pursuance of the statute. That it appears that the said application was duly advertised. Upon consideration of all the matters aforesaid, 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 her Majesty to encourage all arts and inventions which may be for the public good, I am of opinion that her Majesty may grant her royal letters patent unto the petitioner, his executors, administrators, and assigns, for his said invention within the United Kingdom of Great Britain and Ireland [colonies to be mentioned, if any], for the term of fourteen years, according to the statute in that case made and provided, if her Majesty shall be graciously pleased so to do, to the tenor and effect following:— [See next form.]

Given under my hand this day of , A. D.

(Seal) of the Commissioners.

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*17.—LETTERS PATENT. [*222]

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 hath by his petition humbly represented unto us that he is in possession of an invention for , which the petitioner conceives will be of great public utility; that he is the true and first inventor thereof; and that the same is not in use(*e*) by any other person or persons, to the best of his knowledge and belief: the petitioner therefore most humply prayed, that we would be graciously pleased to grant unto him, his executors, administrators, and assigns, our royal letters patent for the sole use, benefit, and advantage of his said invention within our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man [colonies to be mentioned, if any], for the term of fourteen years, pursuant to the statutes in that case made and provided:

[And whereas the said hath particularly described and ascertained the nature of the said invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and has caused the same to be duly filed in :](*f*)

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: 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 , his executors, administrators, and assigns, our especial license, full power, sole privilege, and authority, that he the said , his executors, administrators, and

(*e*) The old form ran,—"And that the same has not been practised or used before within this Kingdom."

(*f*) These words will be used if a complete specification has been deposited at the time of filing the petition.

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 , 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 his said invention within our United Kingdom of Great Britain and Ireland, the Channel Islands, and
[*223] *Isle of Man, in such manner as to him, the said his executors, administrators, and assigns, or any of them, shall, in his or their discretion, seem meet; and that he the said , 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 licenses, powers, privileges, and advantages hereinbefore granted or mentioned to be granted unto the said , his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years from the day of , A. D. next and immediately ensuing, according to the statute in such case made and provided; and to the end that he the said , 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 our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man [colonies to be mentioned, if any], 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 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 consent, license, or agreement of the said , 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 , 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, head-boroughs, and all other officers and ministers whatsoever of us, our heirs and successors, for the time being,
[*224] 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 , 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 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, or that the said is not the true and first inventor thereof within this realm as aforesaid, 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 , 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, 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 , 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 the said (*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 filed in within calendar months next and immediately after the date of these our letters patent;] [and also if the said instrument in writing, filed as aforesaid, does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed;](*h*) [and also if the said , his *executors, administrators, or assigns, shall not pay or cause to be [*225] paid at the office of our Commissioners of Patents for Inventions the sums following; that is to say, the sum of pounds on or before the day of , A. D. , and the stamp-duty payable in respect of the certificate of such payment, and the sum of pounds on or before the day of , A. D. , and the stamp-duty payable in respect of the certificate of such payment;](*i*) and

(*g*) Executors cannot specify. As to the death of the patentee after the sealing of the patent and before specification, see ante, p. 67.

(*h*) These words are to be used if a complete specification has been deposited.

(*i*) This condition is to be complied with by the payment of the stamp-duty, under stat. 16 Vict. In patents granted after the passing of 16 Vict. cap. , the words will be,—"And also subject to a condition that the same shall be void, and that the powers and privileges thereby granted shall cease and determine at the expiration of three years and seven years respectively from the date thereof, unless there be paid before the expiration of the third year and seventh year respectively,

also if the said , 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 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: Provided that nothing herein contained shall prevent the granting of licenses 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 , his executors, administrators, and assigns, that these our letters patent, or the filing 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 , 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 our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, and amongst all and every the subjects of us, our heirs and successors, whatsoever and wheresoever, notwithstanding the not full and certain describing the
[*226] 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, this day of , A. D. , and to be sealed and bear date as of the said day of , in the year of our reign.

[A stamp of £5 must be impressed on the patent.]

18.—SPECIFICATION.

To all to whom these presents shall come;
I, of , send greeting.

Whereas her most excellent Majesty Queen Victoria, by her letters patent bearing date the day of , A. D. , in the year of her reign, did for herself, her heirs and successors, give and grant unto me the said her special license, that I, the said , my executors, administrators, and assigns, or such others as I, the said , 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 therein expressed, should and lawfully might make, use, exercise, and vend, within the United Kingdom of Great Britain and

that is to say, fifty pounds at the expiration of the third year, and one hundred pounds at the expiration of the seventh year."

Ireland, the Channel Islands, and Isle of Man [colonies to be mentioned, if any], an invention for , [insert title as in letters patent] upon the condition (amongst others), that I, the said by an instrument in writing under my hand and seal, should particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, and cause the same to be filed in within calendar months next and immediately after the date of the said letters patent. Now know ye, that I, the said , do hereby declare the nature of my said invention, and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement; that is to say,

[describe the invention.]

In witness whereof, I, the said A. B., have heretofore set my hand and seal, this day of , A. D. .

A. B.

[A stamp of £5.]

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*DISCLAIMER. [*227]

19.—CAVEAT AGAINST DISCLAIMER.

Caveat against any fiat or leave being granted to , to enter any disclaimer or memorandum of alteration of any part of the title or specification in the patent of , for , dated the day of , 185 , without notice to

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In case of patents under stat. 15 & 16 Vict. cap. 83, this caveat must be lodged at the office of the Commissioners, and is subject to stamp-duty of £2.

In case of patents in respect of applications before the passing of the Act, the caveat must be entered at the chambers of the law officers.

20.—FORM OF PETITION TO THE COMMISSIONERS OF PATENTS FOR LEAVE TO ENTER A DISCLAIMER OR MEMORANDUM OF ALTERATION.

The petition of , of , in the county of , showeth, that your petitioner hath obtained her Majesty's letters patent for , bearing date the day of , 185 , and hath duly described the nature of his invitation, and in what manner the same is to be performed, by an instrument in writing duly filed in the office of the Court of Chan-

cery appointed by the Lord Chancellor for filing specifications. [State the nature of the alterations wished to be made, and the reasons for the same.]

Your petitioner therefore prays leave to file, in the office appointed for filing specification in Chancery, the said disclaimer [or memorandum of alteration], a copy of which, signed by your petitioner, is left herewith in the form in which your petitioner is desirous the same should be entered as aforesaid.

[*228] If the patent is one granted in respect of an application before *the 1st of October, 1852, the petition must be addressed to one of the law officers.

In cases under the Patent Law Amendment Act, the application is subject to a stamp duty of £5. 16 Vict. cap.

21.—FORM OF DISCLAIMER.

In the matter of a patent granted to , Disclaimer [or Memorandum of alteration] proposed to be filed in the office for filing specifications in Chancery by , pursuant to the provisions of an Act passed in a session of Parliament holden 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 also the Patent Law Amendment Act, 1852."

[State the proposed alteration and the reason for it, setting out such parts of the patent and specification as are necessary to make the sense clear.]

22.—FIAT OF LAW OFFICER.

See old form—Hindmarch on Patents, Appendix, page 640.

PROLONGATION AND CONFIRMATION.

23.—NOTICE OF INTENTION TO APPLY FOR CONFIRMATION.

In the matter of certain letters patent granted to , bearing date the day of 185 , for certain improvements in the manufacture of , notice is hereby given, under and in pursuance of an Act of Parliament (5 & 6 Wm. 4, cap. 83) and of the Patent Law

Amendment Act, 1852, I, , intend to apply by petition to her Majesty in Council for the *confirmation of the said letters patent for improvements, &c. granted to , and bearing [*229] date the day of , 185 ; and notice is hereby given, that I, the said , intend to apply by counsel to the Lords of the Judicial Committee of the Privy Council, on the day of next; or if the said Judicial Committee shall not be then sitting, then at the next sitting of the Judicial Committee, for a time to be fixed for the hearing of the matter of my petition; and that on or before such day of , notice must be given of any opposition intended to be made to my petition; and any person desirous of being heard in opposition to the prayer of my petition, must lodge a notice to that effect on or before the said day of , A. D.

24.—NOTICE OF OPPOSITION.

In the Judicial Committee of the Privy Council.

In the matter of the petition of , of , for a confirmation of letters patent granted to , notice is hereby given, that , of , intends to oppose the said application.

25.—NOTICE OF APPLICATION FOR PROLONGATION.

In the matter of certain letters patent granted to , of , in the county of , bearing date the day of , 185 , for certain improvements in the manufacture of , notice is hereby given, that under and by virtue, and in pursuance of an Act made and passed in the session of Parliament holden 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 of an Act made and passed in the session of Parliament held in the second and third years of the reign of her present Majesty Queen Victoria, intituled "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;'" *and of an Act made [*230] and passed in the session of Parliament held in the seventh and eighth years of the reign of her said present Majesty, intituled "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;'" and of the "Patent Law Amendment Act, 1852," a petition will be presented to her Majesty in Council by , praying her Majesty to grant a prolongation of the term of the said letters patent: And notice is hereby further given, that an application will be made to the Right Honourable the Lords of the Judicial Committee of her Majesty's Privy Council, for the said committee to fix an early day for the hearing of the

matters contained in the said petition; and any person desirous of being heard in opposition to the prayer of the said petition, must enter a caveat to that effect in the Privy Council Office on or before the said day of next.

Dated the day of , in the year of our Lord 185 .

26.—CAVEAT AGAINST PROLONGATION.

In the Privy Council.

In the matter of the petition of .

Caveat against the prolongation of the term of the exclusive privileges granted by certain letters patent for improvements , granted to , on the day of , 185 , without notice to .

Dated this day of , 185 .

(Signed)

27.—FORM OF PETITION FOR PROLONGATION OF THE TERM.

To the Queen's Most Excellent Majesty in Council.

The humble petition of , of , in the county of .

Showeth,—[*Here state fully the facts relied on, as, for instance,—the history of the invention—difficulties contended against—the* [*231] *obtaining the patent—the filing of the specification—the importance and utility of the invention—any efforts made for the purpose of getting it adopted—the patentee's expenditure—any infringements—any successful legal proceedings against pirates—the patentee's losses or annoyances thereby—that the patentee has not received any adequate reward, and how—that patentee has been always ready to grant licenses—that the petitioner has caused to be published the advertisements required by the statute, &c.*].

Your petitioner therefore humbly prays, that your Majesty will be graciously pleased to refer the matter of his petition to the Judicial Committee of your Majesty's most honourable Privy Council, to consider and report to your Majesty thereon; and that your petitioner may be heard before such Committee by his counsel, agents, and witnesses; and that your Majesty will be graciously pleased to grant new letters patent for a term of years from and after the expiration of the term of years granted by the said letters patent so granted to your petitioner as aforesaid, or for such other term as to your Majesty shall seem fit, according to the statutes in such case made and provided.

And your petitioner will ever and most humbly pray.

(Signed)

28.—NOTICE OF OBJECTIONS TO PROLONGATION.

In the Privy Council.

In the matter of the petition of of , in the county of , mechanic, for the prolongation of the sole privilege of using, exercising, and vending an invention of , granted to him by letters patent, &c.

Notice is hereby given of the several grounds of objection of , of , to the granting of the prayer of said petition, that is to say,

Dated this day of , in the year of our Lord 185 .

(Signed) ——

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*ASSIGNMENTS AND LICENSES. [*232]

29.—AGREEMENT FOR PURCHASE OF A SHARE OF AN INVENTION, AND OF THE PATENT TO BE OBTAINED FOR THE SAME.

Memorandum of agreement indented, made, and entered into this 26th day of December, 1831, between , of , in the county of , of the one part, and , of , in the county of , of the other part.

Whereas the said hath recently invented and discovered certain improvements in , never known or used in this kingdom.

And whereas the said intends forthwith to apply for her Majesty's royal letters patent for her special license and authority for him, the said , his executors, administrators, and assigns, to make, use, exercise, and vend his said invention for his and their sole use and benefit during the term of fourteen years.

And whereas the said hath contracted with the said for the purchase of one-fifth share of and in the said invention, and the benefits thereof, and of the said letters patent, and all improvements thereof applicable thereto, and all future letters patent, in respect thereof, and advantages arising therefrom, at the sum of , to be paid as hereinafter mentioned.

Now these presents witness that the said agrees to sell, and the said to purchase, one part or share of and in the said invention of and in the said letters patent, and also of and in all improvements whatsoever which the said shall or may hereafter make or discover in the said invention, and of and in all future letters patent (if any) which he the said shall or may obtain for or in respect of such improvements, and of and in all rights, profits, or advantages whatsoever incident to the said letters patent, whether the same shall arise from making or manufacturing the said improved , or by the vending or sale thereof, or of any part thereof, or from the granting or sale of

any license or licenses for the using or manufacturing thereof, or of any part thereof, or from the working thereof, or by any other means [*233] *howsoever; the same to be held by the said , together with all powers and remedies for recovering the moneys to arise as aforesaid for all the term for which the said letters patent shall be granted, and for such renewed term or terms as may hereafter be granted therein.

And it is hereby agreed, that the said shall, and within days next after the date of these presents, apply and petition for the said letters patent, and shall and will follow up such petition by all proceedings and means necessary and usual in such cases, so that the said letters patent may be obtained, and the specification duly enrolled as soon as circumstances will permit; the same letters patent to be at the costs and expenses in all things of the said .

And that the said shall and will, within days after the said letters patent, or any future letters patent shall be granted, or at any time or times thereafter, if so required by the said , and at his expense, by such good and sufficient conveyances and assurances in the law as the said or his counsel shall advise and require, assign and make over the said part or share as aforesaid unto the said , his executors, administrators, or assigns; and shall and will, in such assignment or assurance, enter into all usual covenants for the quiet possession or enjoyment and further assurance of the said share; and also into a covenant not to do so; or assent to, or cause to be done, any act, deed, matter, or thing whatsoever, whereby, or in consequence of which, the said letters patent shall or may be forfeited or invalidated, or the right of the said to his share thereof be affected or incumbered; and also that the business of the said letters patent shall be managed and conducted by the said , and that he shall keep regular accounts of the same, and that such accounts shall be at all times open to the examination and inspection of the said , and that he shall have full power to make copies of, or extracts from the same; and that the said shall pay the said sum £ in manner hereinafter mentioned, viz., ; and that the sum of £ shall be applied by the said in payment of the fees and expenses incident to obtaining the said letters patent.

And it is hereby further agreed, that in case the said shall hereafter obtain letters patent for , then that he will, if and when thereunto requested by the said , and in consideration of the [*234] further sum of £ , to be *paid to him by the said , assign to the said one part or share of such last-mentioned letters patent, and all the benefit and advantage arising therefrom.

And it is lastly agreed, that if the said shall hereafter be inclined to sell and dispose of any further share or shares of the said letters patent or either of them, that he will in the first instance offer the same to the said ; and the said agrees that he will not in any instance whatever sell and dispose thereof, or offer to sell and dispose

thereof, to a third person, before the said shall have refused to purchase the same.

For a form of agreement between a person residing here and a foreigner for obtaining letters patent in the name of such person or trustee, with power to the trustee to grant licenses, see 3 Martin's Conveyancing, by Davidson, 182.

Covenant to obtain and assign letters patent, 9 Jarman, by Sweet, 660.

Assignment of letters patent, 9 Jarmen, by Sweet, 664; 3 Martin's Conveyancing, by Davidson, 361.

As to covenants when the vendor retains some interest in the patent, ib. 364.

Assignment of shares in a patent, Crabb's Conveyancing, by Christie, 279.

30.—LICENSES.

A bare license under the patentee's hand and seal, not being by deed, see Chanter v. Johnson, 14 M. & W. 408.

A license by deed-poll to use an invention, to cease on the death of the licensee, or on alienation, 7 Jarman, by Sweet, 588.

License within a certain district, with covenants, ib. 590.

License, with powers of distress and special restrictions on alienation, ib. 595.

RULES.

FIRST AND SECOND SET OF RULES AND REGULATIONS,

Under the Patent Law Amendment Act, 1852, *for the passing of Letters Patent for Inventions.*

[*235] *FIRST SET OF RULES AND REGULATIONS.

Under the Act 15 & 16 Vict. cap. 83, for the passing of letters patent for inventions.

By the Right Honourable Edward Burtenshaw Lord St. Leonards, Lord High Chancellor of Great Britain; the Right Honourable Sir John Romilly, Master of the Rolls; Sir Frederick Thesiger, her Majesty's Attorney-General; and Sir Fitzroy Kelly, her Majesty's Solicitor-General; being four of the Commissioners of Patents for Inventions under the said Act.

Whereas a commodious office is forthwith intended to be provided by the Crown as the Great Seal Patent Office; and the Commissioners of her Majesty's Treasury have, under the powers of the said Act, appointed such office as the office also for the purposes of the said Act.

1. All petitions for the grant of letters patent, and all declarations and provisional specifications, shall be left at the said Commissioners' office, and shall be respectively written upon sheets of paper of twelve inches in length by eight inches and a half in breadth, leaving a margin of one inch and a half on each side of each page, in order that they may be bound in the books to be kept in the said office.

[*236] *2. The drawings accompanying provisional specifications shall be made upon a sheet or sheets of parchment, paper, or cloth, each of the size of twelve inches in length by eight inches and a half in breadth, or of the size of twelve inches in breadth by seventeen inches in length, leaving a margin of one inch on every side of each sheet.

3. Every provisional protection of an invention allowed by the law officer shall be forthwith advertised in the London Gazette, and the advertisement shall set forth the name and address of the petitioner, the title of his invention, and the date of the application.

4. Every invention protected by reason of the deposit of a complete specification, shall be forthwith advertised in the London Gazette, and the advertisement shall set forth the name and address of the petitioner the title of the invention, the date of the application, and that a complete specification has been deposited.

5. Where a petitioner applying for letters patent after provisional protection, or after deposite of a complete specification, shall give notice in

writing at the office of the Commissioners of his intention to proceed with his application for letters patent, the same shall forthwith be advertised in the London Gazette, and the advertisement shall set forth the name and address of the petitioner and the title of his invention; and that any persons having an interest in opposing such application, are to be at liberty to leave particulars in writing of their objections to the said application at the office of the Commissioners, within twenty-one days after the date of the Gazette in which such notice is issued.

6. The Lord Chancellor having appointed the Great Seal Patent Office to be the office of the Court of Chancery for the filing of specifications, the said Great Seal Patent Office and the office of Commissioners shall be combined; and the clerk of the patents for the time being shall be the clerk of the Commissioners for the purpose of the Act.

7. The office shall be open to the public every day, Christmas-day and Good Friday excepted, from ten to four o'clock

8. The charge for office or other copies of documents in the office of the Commissioners, shall be at the rate of twopence for every ninety words.(*a*)

(Signed) St. Leonards, C.
John Romilly, M. R.
Fred. Thesiger, A. G.
Fitzroy Kelly, S. G.

Dated the 1st October 1852.

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*FEES. [*237]

By the Right Honourable Edward Burtenshaw Lord St. Leonards, Lord High Chancellor of Great Britain; and the Right Honourable Sir John Romilly, Master of the Rolls.

Ordered, that there shall be paid to the law officers and to their clerks the following fees:—

By the person opposing a grant of letters patent.

	£.	s.	d.
To the law officer	2	12	6
To his clerk	0	12	6
To his clerk for summons	0	5	0

By the petitioner on the hearing of the case of opposition.

	£.	s.	d.
To the law officer	2	12	6
To his clerk	0	12	6
To his clerk for summons	0	5	0

By the petitioner for the hearing, previous to the fiat of the law officer

(*a*) See stat. 16 Vict. cap. , schedule.

allowing a disclaimer or memorandum of alteration in letters patent and specification.

	£.	s.	d.
To the law officer	2	12	6
To his clerk	0	12	6

By the person opposing the allowance of such disclaimer or memorandum of alteration, on the hearing of the case of opposition.

	£.	s.	d.
To the law officer	2	12	6
To his clerk	0	12	6

By the petitioner for the fiat of the law officer allowing a disclaimer or memorandum of alteration in letters patent and specification.

	£.	s.	d.
To the law officer	3	3	0
To his clerk	0	12	6

(Signed) ST. LEONARDS, C.
JOHN ROMILLY, M. R.

Dated the 1st October, 1852.

[*238] *ORDER

Ordered by the Right Honourable Edward Burtenshaw Lord St. Leonards, Lord High Chancellor of Great Britain.

1. All specifications in pursuance of the conditions of letters patent, and all *complete specifications accompanying petitions and declarations* before grant of letters patent, shall be filed in the Great Seal Patent Office.

2. All specifications in pursuance of the conditions of letters patent, and all complete specifications accompanying petitions for the grant of letters patent, shall be respectively written bookwise upon a sheet or sheets of parchment, each of the size of twenty-one inches and a half in length by fourteen inches and three-fourths of an inch in breadth; the same may be written upon both sides of the sheet, but a margin must be left of one inch and a half on every side of each sheet.

3. The drawings accompanying such specifications shall be made upon a sheet or sheets of parchment, each of the size of twenty-one inches and a half in length by fourteen inches and three-fourths of an inch in breadth, or upon a sheet or sheets of parchment, each of the size of twenty-one inches and a half in breadth by twenty-nine inches and a half in length, leaving a margin of one inch and a half on every side of each sheet.

4. The charge for office or other copies of documents in the Great

Seal Patent Office shall be at the rate of twopence for every ninety words.(*b*)

(Signed) ST. LEONARDS, C.

Dated the 1st October, 1852.

NOTE.—It is recommended to applicants and patentees to make their elevation drawings according to the scale of one inch to a foot.

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*SECOND SET OF REGULATIONS [*239]

Under the Act 15 & 16 Vict. cap. 83, for the passing of letters patent for inventions.

By the Right Honourable Edward Burtenshaw Lord St. Leonards, Lord High Chancellor of Great Britain; the Right Honourable Sir John Romilly, Master of the Rolls; Sir Frederick Thesiger, her Majesty's Attorney-General; and Sir Fitzroy Kelly, her Majesty's Solicitor-General; being four of the Commissioners of Patents for Inventions under the said Act.

1. The office of the Director of Chancery in Scotland, being the office appointed by the Act for the recording of transcripts of letters patent, shall be the office of the Commissioners in Edinburgh for the filing of copies of specifications, disclaimers, memoranda of alterations, provisional specifications, and certified duplicates of the register of proprietors.

2. All such transcripts, copies, and certified duplicates, shall be bound in books, and properly indexed; and shall be open to the inspection of the public at the said office, every day from ten to three o'clock.

3. The charge for office copies of such transcripts, copies, and certified duplicates, recorded and filed in the said office, shall be at the rate of twopence for every ninety words.

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4. The Enrolment Office of the Court of Chancery in Dublin, being the office appointed by the Act for the enrolment of transcripts of letters patent, shall be the office of the Commissioners in Dublin for the filing of copies of specifications, disclaimers, memoranda of alterations, provisional specifications, and certified deplicates of the register of proprietors.

5. All such transcripts, copies, and certified duplicates, shall be bound in books, and properly indexed, and shall be open to the inspection of the public at the said Enrolment Office every day, Christmas-day and Good Friday excepted, from ten to three o'clock.

6. The charge for office copies of such transcripts, copies, and certified duplicates, enrolled and filed as aforesaid, shall be at the rate of twopence for every ninety words.

(*b*) See stat. 16 Vict. cap. , schedule.

7. No warrant is to be granted for the sealing of any letters patent which contain two or more distinct substantive inventions.

[*240] *8. A provision is to be inserted in all letters patent in respect whereof a provisional, and not a complete specification, shall be left, on the application for the same, requiring the specification to be filed within six months from the date of the application.

9. No amendment or alteration, at the instance of the application, will be allowed in a provisional specification after the same has been recorded, except for the correction of clerical errors or of omissions made *per incuriam*.

10. The provisional specification must state distinctly and intelligibly the whole nature of the invention, so that the law officer may be apprized of the improvement, and of the means by which it is to be carried into effect.

(Signed) St. Leonards, C.
John Romilly, M. R.
Fred. Thesiger, A. G.
Fitzroy Kelly, S. G.

Dated the 15th October, 1852.

ORDER.

Ordered by the Right Honourable Edward Burtenshaw Lord St. Leonards, Lord High Chancellor of Great Britain.

Every application to the Lord Chancellor against or in relation to the sealing of letters patent shall be by notice, and such notice shall be left at the Commissioners' office, and shall contain particulars in writing of the objections to the sealing of such letters patent.

(Signed) St. Leonards, C.

Dated the 15th October, 1852.

[*241] *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 stat. 5 & 6 Wm. 4, 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 stat. 5 & 6 Wm. 4, cap. 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.

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*RULES TO BE OBSERVED IN PROCEEDINGS BEFORE THE JUDICIAL COMMITTEE OF THE PRIVY COUNCIL, [*242]

Under the Act 5 & 6 Wm. 4, cap. 83, intituled, "An Act to amend the Law touching Letters Patent for Inventions."

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 anything 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 his 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 of the advertisements required to be published in the London Gazette.

4. All petitions must be accompanied with affidavits of advertisements

[*243] *having been inserted according to the provisions of section 4 of the said Act, and the 1st and 2nd 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 petition 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 affidavit 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.

Council Office, Whitehall, Nov. 18, 1835.

SUBSEQUENTLY THE FOLLOWING RULES WERE ADDED.

A 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. [*244]

Council office, Whitehall, Dec. 21, 1835.

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*TABLES OF FEES. [*245]

At the Rolls Chapel Office.

	£.	s.	d.
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 Enrolment Office.

For enrolling specifications, disclaimers, and memorandums of alteration, for every skin of the enrolment containing about nine 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 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

At the Patent Office.

For filing disclaimers and memorandums of alteration in respect of patents before the Patent Law Amendment Act .	0	1	0
For entering, per folio of 90 words . . .	0	0	10
If the length does not exceed twenty-seven folios, the fee is .	0	9	0

Fees to be taken by the Clerk of the Petty Bag.

For sealing every original writ of scire facias to revoke letters patent or commission on petition of right . .	5	0	0
For sealing every alias or testatum scire facias . .	2	10	0
*For examining and filing every bond of indemnity against costs and affidavits . . . . [*246]	1	0	0

	£.	s.	d.
Entering appearance for every defendant	0	10	0
For entering every rule requiring entry only	0	7	0
For drawing up and entering every other rule	0	10	0
For drawing up and entering a special order	2	0	0
For signing every judgment or entry of nolle prosequi	1	0	0
For filing a record of issue on a scire facias to revoke letters patent, and sealing the transcript	5	0	0
For drawing and entering an order to vacate letters patent	2	0	0
For filing order for delivery out of bond	0	10	0
For swearing every deponent to an affidavit	0	1	6
For every exhibit thereto	0	2	6
For taxing a bill of costs for every side	0	1	0
For filing every affidavit	0	1	0
For office copy of affidavit, per folio	0	0	4
For preparing, engrossing, and perfecting the exemplification of any record, if one skin only	5	5	0
For every additional skin	1	6	8
For every search for a precipe or writ filed	0	1	0
For searching the calendar for every year	0	1	0
For inspection of any record besides the search	0	2	6
For office copy of any record, per folio	0	0	4
For certificate of examination under the officer's hand and the office seal	0	3	6
For the re-examination of the copy of any record, if short	0	3	6
If long, per folio	0	0	1

Fees payable to the Attorney-General or Solicitor-General in cases of disclaimers and memorandums of alteration of patents before the Patent Law Amendment Act, 1852.

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 at the chambers of each officer	0	5	0
For hearing opposition	3	5	0

For fees on opposition to the grant of letters patent and in respect of disclaimers, payable to law officers since the passing of the Patent Law Amendment Act, see page 237.

*STAMP DUTIES. [*247]

Stamp-Duties to be paid pursuant to Stat. 16 *Vict. cap.* 5.

	£	s.	d.
On petition for grant of letters patent	5	0	0
On certificate of record of notice to proceed	5	0	0
On warrant of law officer for letters patent	5	0	0
On the sealing of letters patent	5	0	0
On specification	5	0	0
On the letters patent, or a duplicate thereof, before the expiration of the third year	50	0	0
On the letters patent, or a duplicate thereof, before the expiration of the seventh year	100	0	0
On certificate of record of notice of objections	2	0	0
On certificate of every search and inspection	0	1	0
On certificate of entry of assignment or license	0	5	0
On certificate of assignment or license	0	5	0
On application for disclaimer	5	0	0
On caveat against disclaimer	2	0	0
On office copies of documents, for every ninety words	0	0	2

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*TABLE OF STATUTES. [*248]

21 Jac. 1, cap. 3. "An Act concerning Monopolies and Dispensations with penal Laws and the Forfeitures thereof."

5 & 6 Wm. 4 cap. 83. "An Act to amend the Law touching Letters Patent for Inventions."

Part of section 4, as to prosecution with effect within the term repealed by 2 & 3 Vict. cap. 67, s. 1. Section 3, as to treble costs, repealed. Full costs, 5 & 6 Vict. cap. 97.

2 & 3 Vict. cap. 67. "An Act to amend an Act of 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.'"

7 & 8 Vict. cap. 69. "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.'"

15 & 16 Vict. cap. 83. "An Act for amending the Law for granting Patents for Inventions."

Sections 17, 44, 45, 46, and 53, and so much of the schedule as relates to fees and stamp-duties, repealed by 16. Vict. cap. 5.

16 Vict. cap. 5. "An act to substitute stamp-duties for fees on passing letters patent for inventions, and to provide for the purchase for the public use of certain indexes of specifications."

[*249] *STATUTES RELATING TO LETTERS PATENT.

BEFORE THE PASSING OF THE PATENT LAW AMENDMENT ACT, 1852.

18 H. 6, cap. 1. "An Act that letters patent shall bear the date of the king's warrant delivered into the Chancery."

13 Eliz. cap. 6. "An Act that the exemplification or constat of letters patent shall be as good and available as the letters patent themselves."

55 Geo. 3, cap. 184. Schedule, title, specification.

5 & 6 Wm. 4, cap. 62, s. 11. Declaration substituted for oath on taking out a patent.

1 & 2 Vict. cap. 96, ss. 12 and 13. As to enrolments in the Rolls Chapel Office.

11 & 12 Vict. cap. 94, repealed and its provisions re-enacted by 12 & 13 Vict. cap. 109. See ss. 12, 13, 15, 18, 19. As to enrolment in the Enrolment Office, and evidence of enrolment in the Enrolment and Petty Bag Offices.

14 & 15 Vict. cap. 82. "An Act to simplify the forms of appointments to certain offices, and the manner of passing grants under the great seal."

TEMPORARY ACTS.

14 Vict. cap. 8. "An Act to extend the provisions of the Designs Acts, and to give protection from piracy to persons exhibiting new inventions in the Exhibition of the Works of Industry of all Nations, in 1851.

15 Vict. cap. 6. "An Act for extending the term of the provisional registration of inventions under the Protection of Inventions Act, 1851."

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