A DIGEST

OF THE

REPORTED ENGLISH CASES

RELATING TO

PATENTS, TRADE MARKS

AND

COPYRIGHTS

Determined in the House of Lords and the Courts of Common Law and Equity, with reference to the Statutes; founded on the Analytical Digest by Harrison, and adapted to the present Practice of the Law

BY R. A. FISHER
Of the Middle Temple

EDITED AND BROUGHT DOWN TO THE PRESENT TIME, WITH INDEX, TABLE OF CASES, ETC.

BY HENRY HOOPER

CINCINNATI
ROBERT CLARKE & CO

NEW YORK: BAKER, VOORHIS & CO
1872

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PREFACE TO THE AMERICAN EDITION.

THIS work contains a digest of the existing law, equity, and practice relating to Patents, Trade Marks, and Copyrights, as determined in the English Courts of Common Law and Equity, including the House of Lords. To the Analytical Digest of Harrison and the later Digest of R. A. Fisher have been added all the contemporaneous reports of English cases upon the above branches of the law, down to the present year.

The English statutes upon these subjects, when short and comprehensive in their terms, have been introduced in the language of the legislature. Overruled cases have been omitted, as well as obsolete law. In short, it is believed that all rulings and decisions, from the earliest period until the present time, upon Patents, Trade Marks, and Copyrights, are here collated and presented for the use of the profession.

CINCINNATI, *May* 3, 1872.

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ABBREVIATIONS.

A. C.—Full Court of Appeal in Chancery.
C.—Lord Chancellor's Court.
B. & S.—Best and Smith, Queen's Bench Reports.
Bank.—Court of Bankruptcy.
C. C. J.—County Court Judge.
C. L.—Common Law.
Chanc.—Chancery.
C. P.—Common Pleas.
De G. F. & J.—De Gex, Fisher and Jones, L. Chancellor and Court of Appeal in Chancery.
Exch.—Exchequer.
Ex. Cham.—Exchequer Chamber.
H. L.—House of Lords.
Hopw. & C.—Hopwood and Coltman.
Ir. R., C. L.—Irish Reports of 1867, Current Common Law Series.
Ir. R. Eq.—Irish Reports, Equity Series of 1867.
L. JJ. and L. J.—Lord Justices' Court, or Lord Justice.
L. R.—Law Reports.
L. J.—Law Journal.
L. T. R.—Law Times Reports.
M. C.—Magistrates' Cases.
Moore P. C. C., N. S—Moore's Report of Privy Council.
N. S.—New Series.
P. C.—Privy Council and Privy Councillor.
Q. B.—Queen's Bench.
R.—Rolls' Court.
V. C. M.—Vice-Chancellor Malin's Court.
V. C. G.—Vice-Chancellor Gifford's Court.
V. C. B.—Vice-Chancellor Bacon's Court.
V. C. J.—Vice-Chancellor James' Court.
V. C. S.—Vice-Chancellor Stuart's Court.
S. C.—Same Case.
S. P.—Same Point.
W. R.—Weekly Reporter.

Patent Cases.

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English Patent Cases.

I. FOR WHAT GRANTED.

1. Statutes.

By 21 Jac. 1, c. 3, s. 6, *patents for the term of fourteen years or under, of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor of such manufactures, which others at the time of making such patent shall not use, are good; so also as they be not contrary to the law nor mischievous to the state, by raising prices of commodities at home, or the hurt of trade, or generally inconvenient; the fourteen years to be accounted from the date of the first letters patent.*

The crown has always exercised a control over the trade of the country; and though restrained by the common law and the Statute of Monopolies (21 Jac. 1, c. 3) within reasonable limits, the crown might grant the exclusive right to trade with a new invention for a reasonable period. The 21 Jac. 1, c. 3, did not create but controlled the power of the crown in granting to the first inventors the privilege of the sole working and making of new manufactures. *Caldwell* v. *Vanvlissengen*, 9 Hare, 415; 16 Jur. 115; 21 L. J., Chanc. 97.

5 and 6 Will. 4, c. 83, *amends the law touching letters patent for inventions.*

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By 2 and 3 Vict. c. 67, and 7 and 8 Vict. c. 69, *the term of letters patent may be extended and new letters patent granted after the expiration of the original term, by application to the judicial committee of the privy council.*

By 14 and 15 Vict. c. 82, s. 7, *the lord chancellor and secretary of state are to make rules for passing letters patent.*

15 and 16 Vict. c. 83 (the Patent Law Amendment Act, 1852), *is amended by* 16 *and* 17 *Vict. c.* 115.

By 16 and 17 Vict. c. 5, *stamp duties are substituted for fees on passing patents.*

By 22 Vict. c. 13, *provisions are made for protecting inventions for improvements in instruments and munitions of war, by assignment to the secretary of state for war.*

By 33 and 34 Vict., c. 27, *the exhibition of new inventions at international exhibitions in the United Kingdom is not to prejudice patent rights.*

2. Subject-matter generally.

An invention must be both new and useful, and not confined to the knowledge of the party making it, to be the subject of a patent. *Hill* v. *Thompson*, 2 Moore, 424; 8 Taunt. 375; Holt, 636; 3 Mer. 629.

An addition to an old invention may be the subject of a patent. *Hornblower* v. *Boulton*, 8 T. R. 95.

But the application of a known article to a new use, the mode of application not being new, can not be the subject of a patent. *Reg.* v. *Cutter*, 3 C. & K. 215; 14 Q. B. 372, n.—Denman.

An invention, consisting in no more than the use of things already known, and acting with them in a way already known, and producing effects already known, but producing those effects so as to be more economically or beneficially enjoyed by the public, is properly the subject-matter of a patent. *Crane* v. *Price*, 5 Scott, N. R. 338; 4 M. & G. 586; 12 L. J., C. P. 81.

A patent may be taken out, for that includes the subject-matter of a patent still in force, if the specification properly distinguishes that which is new from that which is old. *Ib.*

The degree of labor and expense of experiments does not properly enter into the consideration of whether or not an invention is the subject-matter of a patent. *Ib.*

The adoption by an inventor of a suggestion, made in the course of experiments, of something calculated more easily to carry his conceptions into effect, does not affect the validity of the patent. *Allen* v. *Rawson*, 1 C. B. 551.

The discovery that a particular advantage may be attained by the use of a machine known before, in a manner known before, is not an invention which can be made the subject of a patent. *Tetley* v. *Easton*, 2 C. B., N. S. 706; 26 L. J., C. P. 269.

The new application of any means or contrivance may be the subject of a patent, if it lies so much out of the tract of the former use as not naturally to suggest itself, but to require some application of thought and study. *Penn* v. *Bibby*, 2 L. R., Chanc. 127; 36 L. J., Chanc. 455—C.

A patent can not be taken out for one particular use of a known machine, though the patentee may have discovered how to use the machine more beneficially than the owner. *Ralston* v. *Smith*, 11 H. L. Cas. 223; 20 C. B., N. S. 28; 13 L. T., N. S. 1; 35 L. J., C. P. 49.

Where A. has in a specification described a result, but has not added such a statement of means as to make that result practically attainable, and B. afterward takes out a patent for the same result, but fully explains the means to be employed to attain it, the patent of B. is sustainable. *Betts* v. *Menzies*, 31 L. J., Q. B. 233; 11 W. R. 1; 7 L. T., N. S. 110; 10 H. L. Cas. 117.

Where something remains to be ascertained which is necessary for the useful application of the discovery, that affords sufficient room for another valid patent. *Hills* v. *Evans*, 8 Jur., N. S. 525; 31 L. J., Chanc. 457; 6 L. T., N. S. 90—C.

A patent can not be upheld for the mere application of a well-known mechanical contrivance to a purpose which is analogous

to the manner or to the purpose in or to which it has been hitherto notoriously used or applied. *Harwood* v. *Great Northern Railway Company*, 35 L. J., Q. B. 27; 11 H. L. Cas. 654; 12 L. T., N. S. 771.

3. **Inventions, Manufactures, and Discoveries.**

A person, to be entitled to a patent for an invention must be the first and true inventor, and there must not be any public use thereof by himself or others, prior to the grant of the patent *Housebill Coal Company* v. *Neilson*, 9 C. & F. 788.

Trials of an incomplete invention, by way of experiment, are not evidence of a prior use for the purpose of invalidating a patent. Prior use for this purpose, means public use and exercise of the invention. *Ib.*

Evidence of the existence of a completed invention, once in public use, although abandoned or the use long discontinued, but not altogether lost sight of, is sufficient to invalidate a patent which is subsequently granted for the same invention. *Ib.*

What previous user will invalidate, and what user, if any, can be admitted in contravention of the patent right, are different questions, depending one upon the extent of previous knowledge, and the other upon the effect of the grant. *Caldwell* v. *Vanvlissengen*, 9 Hare, 428; 16 Jur. 115; 21 L. J., Chanc. 97.

To support an allegation of want of novelty, whatever is essential to the practical working and real utility of the invention must be found substantially in the prior publication. *Hills* v. *Evans*, 8 Jur. N. S. 525; 31 L. J., Chanc. 457; 6 L. T., N. S. 90—C.

The antecedent existence of an invention, not shown to have been brought to any successful result, and which was so far similar, that if subsequent in date to a patent, it would have been held a colorable and clumsy imitation, for the purpose of effecting the same result, does not invalidate the patent by anticipation. *Daw* v. *Ely*, 3 L. R., Eq. 496—V.-C. W.

It is not every useful discovery that can be made the subject of a patent, but the words "new manufacture" in 21 Jac. 1, c. 3, will comprehend not only a production, but the means of

producing it. *Ralston* v. *Smith*, 11 H. L. Cas. 223; 13 L. T., N. S. 1; 35 L. J., C. P. 49; 20 C. B., N. S. 28.

When a thing has once been used for a certain purpose, no patent is valid for applying that thing to a similar but not an identical purpose. *Jordan* v. *Moore*, 1 L. R., C. P. 624; 12 Jur. N. S. 766; 35 L. J., C. P. 268; 14 W. R. 769.

A patent granted for constructing vessels of an iron frame covered with a wooden planking, and before its date vessels having been built of iron, or of iron and wood combined, is invalid. *Ib.*

Where there are two things similar in form used for a similar object, and capable of the same application, one of them having been known to mechanics, the introduction of the other into use will not constitute a good ground for a patent. *Harwood* v. *Great Northern Railway Company*, 11 H. L. Cas. 654; 35 L. J., Q. B. 27; 12 L. T., N. S. 771.

A slight difference in the mode of application is not sufficient for such a purpose, nor will it be sufficient to take a well-known mechanical contrivance and apply it to a subject to which it has not been hitherto applied. *Ib.*

A valid patent for an entire combination for a process gives protection to each part that is new and material for that process; but a part which in itself could not have been the subject of a patent, or the advantages of which are merely collateral to the objects of the invention, is not protected. *Parkes* v. *Stevens*, 18 W. R. 233; 22 L. T., N. S. 635; 5 L. R., Chanc. 36.

The application to a globular lamp of a sliding door instead of a hinged one, can not be the subject of a patent. *Ib.*

The adaptation of a sliding door to a spherical lamp, sliding doors having previously been applied to cylindrical lamps and to other glazed surfaces, can not of itself be the subject of a patent. *Ib.*

4. Importations from Abroad.

A party availing himself of information from abroad is an inventor within 21 Jac. 1, c. 3, s. 6. *Nickels* v *Ross*, 8 C. B. 679.

So, an importer of an invention from abroad is an inventor within 5 and 6 Will. 4, c. 83. *Claridge's Patent, in re*, 7 Moore, P. C. C. 394.

Semble, that an agent in this country of an inventor abroad receiving a confidential communication of an invention, not in a practically useful state, may take out a patent for his own benefit, if he, pursuing the idea thus thrown out, discovers a practical way of carrying it into effect. *Milligan* v. *Marsh*, 2 Jur., N. S. 1083. See *Steedman* v. *Marsh*, 2 Jur., N. S. 391—V.-C. W.

When a patent is taken out as for an original invention, the subject of the patent being in fact a communication from a British subject resident abroad, the patent is void. *Ib.*

5. Combinations of old and new Matters and Processes.

When a patent is granted for a combination of several things, some of which are old and some new, the question is, whether, taking the specification altogether, that which is claimed as a whole is new, and the imitation by a chemical or a mechanical equivalent of a part of the combination, which is both material and new, is an infringement. *Newton* v. *Grand Junction Railway Company*, 5 Exch. 331; 20 L. J., Exch. 427, n.

There may be a patent for a combination of old and new mechanism, and such patent will be infringed by using so much of the combination as is material, and it will not be less an infringement because the result is attained by the substitution of a mechanical equivalent. *Sellers* v. *Dickinson*, 5 Exch. 312; 20 L. J., Exch. 417.

An old mode of operation, more extensively than hitherto applied, to a well-known article, does not afford a ground on which to grant a patent. *Ormson* v. *Clarke*, 13 C. B., N. S. 337; 9 Jur., N. S. 749; 32 L. J., C. P. 8; 11 W. R. 118; 7 L. T.,

N. S. 361. Affirmed on appeal, 14 C. B., N. S. 475; 32 L. J., C. P. 291; 10 Jur. N. S. 128; 11 W. R. 787—Exch. Cham.

Casting in iron an article which has never been cast before, if no new method of casting is adopted in the process, is not the subject of a patent. *Ib.*

A claim for a patent for improvements in the mode of doing anything by a known process is sufficient to entitle the claimant to a patent for his improvements when applied either to the process as known at the time of the claim, or to the same process altered and improved by discoveries subsequently published, so long as it remains the same with regard to the improvements claimed and their application. *Electric Telegraph Company* v. *Britt*, 10 C. B. 838; 15 Jur. 579; 20 L. J., C. P. 123.

A patent was taken out for "a new and improved mode of manufacturing silk, cotton, linen, and woolen fabrics." The specification and a disclaimer set forth, that the patentees claimed "the mode hereinbefore described of producing or preparing stripes of silk, cotton, woolen, or linen, or of a mixture of two or more of these materials, in such a manner that the weft, or lateral fibres of both cut edges of each stripe are all brought up on one side, and into close contact with each other, and the re-weaving of such stripes with the whole fur or pile uppermost, into the surfaces of carpets," etc. One of these processes was old. The judge directed the jury, that if one was new, the patent could be supported for the combination of them, and would only be invalid if there had been a public use of both before the date of the patent: Held, that this direction was erroneous, and that the patent was void. *Templeton* v. *Macfarlane*, 1 H. L. Cas. 595.

A patent can not be supported for the application of a process already known, producing a known result, unless the object to which the process is applied is different from the object to which it was formerly applied; and the question whether the object is different is one of fact for the jury. *Steiner* v. *Heald* (in error), 6 Exch. 607; 17 Jur. 875; 20 L. J., Exch. 410—Exch. Cham.

The application of a known process to a new article, the mode of application not being new, can not be the subject of a patent.

Brook v. *Aston*, 8 El. & Bl. 478; 4 Jur., N. S. 279; 27 L. J., Q. B. 145. Affirmed on appeal, 5 Jur., N. S. 1025; 28 L. J., Q. B. 174—Exch. Cham.

But this principle does not apply where the process is chemical. *Young* v. *Fernie*, 10 Jur., N. S. 926; 12 W. R. 901, 10 L. T., N. S. 861; 4 Giff. 577.

The application of a well-known tool to work previously untried materials, or to produce new forms, is not the subject a patent. *Bottle Envelope Company* v. *Seymour*, 5 C. B., N. S. 164; 5 Jur., N. S. 174; 28 L. J., C. P. 22.

A patent for a combination does not import a claim that each of its parts is new, and the patent may be valid, though each part is old; but the use of a subordinate part only of the combination may be an infringement of a patent for the combination if the part so used is new and material. *Lister* v. *Leather*, 8 El. & Bl. 1094; 4 Jur., N. S. 947; 27 L. J., Q. B. 295—Exch. Cham.

If, having a particular purpose in view, a person takes the general principles of mechanics, and applies one or other of them to a manufacture to which it has not before been applied, this is sufficient ground to warrant an application for a patent; assuming such manufacture to be new, desirable, and of public utility. *Dangerfield* v. *Jones*, 13 L. T., N. S. 142—V.-C. W.

Hoops of whalebone, cane, and other substances, suspended from the waist and forming a petticoat, had long since been used by ladies. A person took out a patent for using, for the same purpose, hoops made of steel watch springs: Held, that this was not an invention which could properly be made the subject of a patent. *Thompson* v. *James*, 32 Beav. 570.

The application of a known article to a purpose analagous to that to which it had before been applied, is not the subject of a patent, although the result of the application may be the production in a cheaper and a better manner of a known article. *Horton* v. *Mabon*, 12 C. B., N. S. 437; 31 L. J., C. P. 255; 10 W. R. 582; 6 L. T., N. S. 289. Affirmed on appeal, 16 C. B., N. S. 141; 12 W. R. 491; 9 L. T., N. S. 815—Exch. Cham.

Therefore, a double angle iron being a well-known article, the application of it in the construction of the hydraulic cap joints of gas-holders, instead of constructing them by riveting two pieces of single angle iron to a plate, is not the subject of a patent. *Ib.*

Ladies' mourning bonnets and hat falls having previously been made with the ornamental folds on the outside only, so that when turned up a "wrong side" was exposed to view, the plaintiff introduced and patent an improved mode of making them with the folds on the inner side also, so as to form both sides alike, but there was no novelty in the process of manufacture: Held, that this was not a subject for a patent. *White* v. *Toms*, 37 L. J., Chanc. 204; 17 L. T., N. S. 348—V.-C. M.

Although a patent includes matters some of which are new, and some old, it may be upheld by limiting the claim to the particular combination in the particular manner described in the specification. *Daw* v. *Eley*, 3 L. R. Eq. 496—V.-C. W.

A patent was taken out for an improvement in the mode of manufacturing glass. The old mode had been that of putting the materials which were to form the glass in pots placed on "sieges" or benches, with the fire underneath, the rising flames of which played around them, and when they became too hot and cracked, they were removed from their position, and the overheated and cracked parts were presented to a current of cooling air and the molten material was thus, partially at least, saved from waste, and the cracks in the pots were stopped up with a portion of it, and were thus preserved from destruction. The new method consisted in adopting some previous improvements (such as suppressing the fire-pots, placing the materials in a tank, etc.), to which the patentee laid no claim, and in combining these things with an improved furnace. His invention consisted of "forming the sides of the tank or chamber containing the glass-making materials hollow, in such wise that a current of refrigerating air may circulate and prevent any excessive heating of the sides which retain or inclose the fused materials." Though all the principles upon which the new method was based were well known, the new form of combining them was shown to make the melting of the materials less subject to danger and

less costly in use: Held, that this new form of combination being useful and valuable constituted a valid ground for a patent Held, also, that a direction to a jury that if the combination was new and useful, the patent could be supported, though each separate process employed in it was previously known, was correct. *Cannington* v. *Nuttall*, 5 L. R., H. L. 205.

6. Chemical Combinations and Processes.

Inventions in mechanics are as totally different from inventions in economical chemistry as the laws and operations of mechanical powers differ from the laws of chemical affinities, and the results of analysis in the comparatively infant science of chemistry with its boundless field of undiscovered laws and substances. *Young* v. *Fernie*, 4 Giff. 577; 10 Jur., N. S. 926; 12 W. R. 901; 10 L. T., N. S. 861.

Where, therefore, prior to the date of a patent, something necessary for the useful application of a chemical discovery for manufacturing purposes remained to be discovered, which the plaintiff's invention supplied: Held, that the manufacture, with the materials and processes in the specification, was a new manufacture not in use at the date of the patent. *Ib.*

The law recognizes the right of an inventor who finds out and supplies for commercial purposes an article known previously only as a chemical curiosity. *Ib.*

Vegetable gas had been obtained from oils which were separated from seeds and other oleaginous substances by pressure. It was discovered that gas might be distilled at once from the seeds and other oleaginous substances, without first separating the oil: Held, that assuming the invention to be new, it was such as might be the subject of a patent. *Booth* v. *Kennard* (in error), 1 H. & N. 527; 3 Jur., N. S. 21; 26 L. J., Exch. 23—Exch. Cham.

A person claimed an invention for the purification of gas, by means of hydrated or precipitated oxides of iron, and also a process of revivification, by which the old materials could again be applied as a purifying element: Held, that an application to the purification of gas of a natural substance called bog ochre, containing precipitated oxides of iron, was not an infringement of

the patent, but the revivification of that natural substance was. *Hills* v. *Liverpool United Gaslight Company*, 9 Jur., N. S. 140; 32 L. J., Chanc. 28; 7 L. T., N. S. 537—C.

The employment of hydrate of lime for the purpose of precipitating the animal and vegetable matter contained in sewage water, and so producing an agricultural manure, is a good subject-matter for a patent. *Higgs* v. *Goodwin*, 5 Jur., N. S. 97; 27 L. J., Q. B. 421; El., Bl. & El. 529.

A person using the same process, and obtaining a product, not for the purposes of commercial profit, but for purifying sewage water merely, is not guilty of an infringement of the patent. *Ib.*

A specification is to be understood according to the acceptation of practical men at the time of its enrollment. Therefore, where a specification stated that the apparatus mentioned would extract gas "from any substance from which gas capable of being employed for illumination can be extracted by heat," and the apparatus was not suited to extract gas from oil: Held, that this did not avoid the patent, oil not then being considered fit for the manufacture of gas for lighting towns, though it was then known as a chemical fact that gas might be produced from oil by heat, and this property has since been applied to the purposes of illumination. *Crossley* v. *Beverly*, 9 B. & C. 63; M. & M. 283; 3 C. & P. 513; 1 Russ. & Mylne, 166.

When a patent has been obtained for the use of a known substance, described by its specific name, and it is afterward discovered that the use of two other and equally known substances will produce the same effect, though the evidence of scientific men may go to show that the two substances became, in the act of so using them, the one substance described in the patent, their use will not constitute an infringement of the patent. *Unwin* v. *Heath* (in error), 5 H. L. Cas. 505; 16 C. B. 713; 2 Jur., N. S. 1029; 25 L. J., C. P. 8.

The plaintiff, on applying for a patent, prior to the 15 and 16 Vict. c. 83, delivered to the attorney-general a deposit paper stating that his invention was "for absorbing sulphuretted hydrogen and other gases into porous bodies, and renovating them again either by heat or by taking off the atmospheric pressure." In 1849, he obtained a patent for "an improved mode of com-

pressing peat for making fuel or gas, and of manufacturing gas, and of obtaining certain substances applicable for purifying the same. The invention, described in the specification, was, passing the gas through a mixture consisting of the subsulphates, the oxy-chlorides, or the hydrated or precipitated oxides of iron, either by themselves or mixed with sulphate of lime and sawdust, or peat charcoal, "so as to make a porous material, whereby the gas will be deprived of its sulphuretted hydrogen, which will be absorbed into the porous material, water being formed by the union of the oxygen of the oxide with the hydrogen of the sulphuretted hydrogen. As soon as the material ceases to purify the gas from sulphuretted hydrogen, the gas is to be shut off from the purifier, and a communication opened with the external air, which is to be admitted to the purifying material, and by the agency of which it will be renovated, and the uncombined gases which have been absorbed driven off. The best way to effect this is partially to take off the atmospheric pressure at the top or bottom of the purifier in which the purifying material is contained, by connecting it with a pipe to a hot and powerful chimney, so as to cause a current of air to pass through the purifier The current of air will drive off the volatile gases, and reoxidize the iron of the sulphuret of iron. As soon as the iron is reoxidized, the gas is to be passed through it again." He claimed, first, purifying gas by passing it through precipitated or hydrated oxides of iron; and secondly, renovating the purifying material by exposing it to the action of the air. The jury found that the invention, in respect of which the plaintiff applied for a patent, and in respect of which his patent was granted, whether aptly described in the deposit paper or not, was the plaintiff's invention: Held, first, that, assuming the deposit paper delivered to the attorney-general did not correctly describe the matter in respect of which the plaintiff applied for a patent, the defendant was not entitled to have a verdict, on a plea that the invention described in the specification was another and a different invention from that for which the letters patent were granted. *Hills* v. *London Gaslight Company*, 5 H. & N. 312; 29 L. J., Exch. 409.

In the specification of a prior patent by C. for purifying gas, dated in 1840, after speaking of the use of black oxide of

manganese for purifying gas, he went on to say, "the same effect may be produced by the application of the oxide of zinc, and the oxides of iron treated precisely in the way above described:" Held, that, assuming that C. meant to claim all oxides of iron for purifying gas, inasmuch as some would not answer, the court could not say, as a matter of law, that a patent could not be had by a person who afterward discovered that precipitated hydrated oxides were those which it was proper to use. *Ib.*

The jury having found that C.'s specification did not disclose the use of hydrated oxides of iron, the court refused to grant a new trial. *Ib.*

In working for the purpose of completing the specification of his patent, C. had used oxides of iron for the purification of gas, and the gas purified by him to the extent of 20,000 feet a day, had for many days been mixed with the ordinary gas, and supplied to the public from the mains of a gas company. He had renovated the material by exposing it to heat on the top of some retort beds. The oxides were originally in a hydrated state, and the heat used by him while so working was not sufficient to render them anhydrous; but, not knowing the difference between hydrated and anhydrous oxides, and supposing that a better result would thereby be obtained, he directed in his specification that the material should be raised to a red heat, which would render the oxides anhydrous. The jury having found that what C. did was in the nature of an experiment, and not a publication to the world, the court refused to disturb the verdict on that point. *Ib.*

In 1847, F. having obtained a patent for the purification of gas by chloride of calcium, specified a mode of making the chloride of calcium by decomposing muriate of manganese, iron, or zinc, and said, "The oxides or carbonates which result are useful for the said purification of gas, and need not be removed." The oxides so prepared would be hydrates: Held, that the court, on a comparison of F.'s specification with that of the plaintiff, could not say, as a matter of law, that F. had anticipated the plaintiff's invention. *Ib.*

Before the date of the plaintiff's patent, it was known that hydrated oxides of iron would absorb sulphuretted hydrogen;

but it was not known that they could be practically used in the purification of coal gas from sulphuretted hydrogen: Held, that a patent might be had for applying hydrated oxides to absorb sulphuretted hydrogen from coal gas. *Ib.*

It was also known that sulphuret of iron produced by the action of sulphuretted hydrogen upon hydrated oxide of iron, would be reoxidized by being exposed to the action of atmospheric air. But it was not known that when the sulphuret was produced by exposure of hydrated oxide of iron to the action of sulphuretted hydrogen mixed with coal gas, the reoxidation of the iron might not be prevented by the cyanogen, compounds of ammonia, and tarry matter which would be mixed with it: Held, that a patent might be had for reoxidizing the iron by exposure to the air after it had been used in the purification of coal gas. *Ib.*

Held, also, that the invention came within the title of his patent as an improved mode of manufacturing gas. *Ib.*

7. Prior Publication and User.

Before a party took out a patent for a machine, a model of a similar machine was made, unknown to him, and a machine was begun to be made from it, but no similar machine was ever used in this country before the patent: Held, that this was not sufficient to defeat the patent. *Lewis* v. *Marling*, 4 C. & P. 52, 5 M. & R. 66; 10 B. & C. 22.

Where, a few months before the date of a patent for an improvement in paddle-wheels, two pairs of the wheels were made for a party (to whom the patent was afterward assigned) by an engineer and his workman at his own manufactory, under the directions of the patentee, and under an injunction of secrecy, the engineer being paid for them by the party; that when finished they were taken to pieces, packed up, and shipped for a foreign port, where, according to his directions, they were put together and used (after the date of the patent) in steamboats belonging to a company, of which he was the manager and principal shareholder: Held, that this was not such a publication of the invention as to avoid the patent. *Morgan* v. *Seaward*, 2 M. & W. 544; M. & H. 55; 1 Jur. 527.

If at the time a patent is granted for an invention, such invention has already been made public in England by a description contained in a work, whether written or printed, which has been publicly circulated, in such case the patentee is not the first and true inventor, whether he has himself borrowed his invention from such publication or not. *Stead* v. *Williams*, 7 M. & G. 818; 8 Scott, N. R. 440; 8 Jur. 930; 13 L. J., C. P. 215.

If the inventor of a machine lends it to another in order to have its qualities tested, and that person uses it for some weeks in a public work-room, this is not giving the invention such publicity as to deprive the inventor of his right to obtain letters patent for it. *Bentley* v. *Fleming*, 1 C. & K. 587—Cresswell.

A machine does not cease to be the subject of a patent, merely because of the length of time during which the inventor may keep it by him, after it has been made a complete workable machine. *Ib.*

The prior use of an invention which invalidates a patent is a use by persons in carrying on their trade, and without concealment. *Heath* v. *Smith*, 2 C. L. R. 1584; 3 El. & Bl. 256; 18 Jur. 601; 23 L. J., Q. B. 167.

B. applied for a patent for improvements in making capsules. Some delay occurred in the office, and between the time of the application for and the issuing of the letters patent, B. manufactured a quantity of the articles, in the making of which he had discovered improvements. They were made by his own workmen, and were not intended for sale before the patent was granted, nor were they sold: Held, that this did not invalidate the patent. *Betts* v. *Menzies*, 5 Jur., N. S. 1164; 28 L. J., Q. B. 361.

The public use and exercise of an invention which prevents it from being considered a novelty, is a use in public, so as to come to the knowledge of others than the inventor, as contradistinguished from the use of it by himself in private, and does not mean a use by the public generally. *Carpenter* v. *Smith*, 9 M. & W. 300.

The prior deposit of articles of novel manufacture in a warehouse, for sale, is a sufficient publication to defeat a patentee's claim to novelty in the invention of similar articles. *Mullins* v. *Hart*, 3 C. & K. 297—Jervis.

Although a party may believe himself to be the first and original inventor, yet he can not shelter himself under willful ignorance, but will be fixed not only with what he knew, but with that which he might have known had he made the inquiries which it was incumbent upon him to make. *Hoinball's Patent, in re*, 9 Moore, P. C. C. 378.

A first and original inventor means a person who could claim the merit of the first invention without reference to the user. *Ib.*

Where a man, having conjectured a new method of effecting a desired object, takes out a patent for it, but never puts it in practical operation, that will not invalidate letters patent taken out for the same process by a subsequent inventor, who shall of himself discover the same method. *Betts* v. *Menzies*, 3 Jur., N. S. 357—V.-C. W.

A contractor for harbor works had in the progress of his undertaking invented an apparatus which greatly facilitated the works, but which could only be tested in a place accessible to the public. After having used the apparatus for four months in the progress of the work, he applied for a patent: Held, that such user amounted to a dedication to the public, and that he was not entitled to a patent. *Adamson's Patent, in re*, 6 De G., M. & G. 420; 25 L. J., Chanc. 456.

An invention was described in a book published in France, copies of which were sent to England to a bookseller for sale: Held, that this was a publication of the invention, and that no valid patent could afterward be taken out in this country for the same invention. *Laing* v. *Gisborne*, 31 Beav. 133; 8 Jur., N. S. 736; 31 L. J., Chanc. 769; 10 W. R. 368; 6 L. T., N. S. 771.

The circumstance of a patentee having previously filed (but abandoned) a provisional specification describing in part the same invention does not render a subsequent patent void, the filing of the previous provisional specification not being a publication within the statute. *Oxley* v. *Holden*, 8 C. B., N. S. 666; 30 L. J., C. P. 68.

A necessary and an unavoidable disclosure of an invention to others, if made in the course of mere experiments, is not such a

publication as will avoid the subsequent grant of a patent, though the same disclosure, if made in the course of a profitable use of an invention previously ascertained to be useful, would be a publication; but an experiment performed in the presence of others, which not only turns out to be successful, but actually beneficial in the particular instance, is not necessarily a publication, so as to constitute a gift of the invention to the world. *Newall, in re*, 4 C. B., N. S. 269; 4 Jur., N. S. 562; 27 L. J., C. P. 337.

Prior knowledge to avoid a patent, must be knowledge equal to that required to be given by a patent; that is, such knowledge as will enable the public to perceive the very discovery, and to carry the invention into practical use. *Hills* v. *Evans*, 31 L. J., Chanc. 457.

8. Particular Instances of Inventors, new and old.

A patent for the method of lessening the consumption of steam and fuel in fire-engines is a subject of a patent. *Hornblower* v. *Boulton*, 8 T. R. 95. And see *Boulton* v. *Bull*, 2 H. Bl. 463, 500.

If the shearing of cloth from list to list by shears is known, and the shearing it from end to end by means of rotatory cutters is also known, and a person constructs a machine to shear from list to list by means of rotatory cutters: this is a new invention. *Lewis* v. *Davis*, 3 C. & P. 502—Tenterden.

A patent for an improvement or improvements in the making or manufacturing of elastic goods or fabrics, and the production of cloth from cotton, flax, or other suitable material, not capable of felting, in which are interwoven elastic cords or strands of India rubber, coated or wound round with filamentous material, is properly the subject-matter of a patent. *Cornish* v. *Keene*, 4 Scott, 337; 3 Bing. N. C. 570; 2 Hodges, 281.

A patent was taken out for improvements in making buttons. The specification stated the improvement to consist in the substitution of a flexible material for metal shanks, and it described the mode in which this material might be fixed to the intended button, and made to project from it in the necessary condition for use, by the help of a metal collet or ring with teeth. Neither the construction of the button, nor the applica-

tion of the flexible shank, was new; the use of the toothed ring, as described in the specification, was so, but this was not stated to be the subject-matter of the invention; and it appeared by the specification, that the effect produced by it might be brought about in other modes, which the patentee had also used: Held, that the patent was not maintainable, since the invention consisted only in combining two things which were not new, and the use of the toothed ring in forming the flexible shank, though new, was not the object of the invention, but only a mode, among others which was already known, of carrying it into effect. *Saunders* v. *Aston*, 3 B. & Ad. 881.

A patent for an improvement in the manufacture of iron by the application of anthracite or stone, coal and culm, combined with the using of the hot air blast in the smelting and manufacture of iron from iron stone mine or ore, is a new invention. *Crane* v. *Price*, 5 Scott, N. R. 338; 4 M. & G. 586; 12 L. J., C. P. 81.

V. obtained a patent for an improvement in packing hydraulic and other machines by means of a lining of soft metal, the effect of which was to make certain parts of the machines air and fluid tight. Subsequently to this, N. discovered that soft metal had the effect of diminishing friction, and of preventing the evolution of heat when applied to the surfaces in contact with machines in rapid motion, and subject to pressure; and he embodied the application of that discovery to machines in a patent: Held, that N.'s application of the soft metal differed essentially from that of V., and that N.'s patent was new. *Newton* v. *Vaucher*, 6 Exch. 859; 21 L. J., Exch. 305.

A patent for certain improvements on, or additions to, the apparatus or parts constituting what are called braiding or plaiting machines, whereby the inventor was enabled to produce by such machines elastic and non-elastic braids and other fabrics, with elastic or non-elastic strands, yarns, or threads introduced lengthwise of the fabric, and four or more in the same surface or plane, or mixtures of elastic or non-elastic fibres in combination in the same fabric, is a novel invention. *Nickles* v. *Ross*, 8 C. B. 679.

If a patent is taken out for blocks for paving with stone "or

any other suitable material," this will include wood pavement, although no wood pavement was in actual use at the date of the patent, and although the inventor might not have had wood pavement in his contemplation. *Macnamara* v. *Hulse*, Car. & M. 471—Abinger.

A patent for an invention of improvements in cards for carding wool, cotton, silk, and other fibrous substances, and for raising the pile of woolen and other cloths by the application and adaptation of caoutchouc or India rubber, as a substitute for the fillets or sheets of leather, is a new invention. *Walton* v. *Potter*, 4 Scott, N. R. 91; 3 M. & G. 411.

A patent was obtained for a new and improved process or manufacture of silk, and silk in combination with certain other fibrous substances. By the specification, the inventors declared the nature of the invention to consist of eight several and distinct parts or heads, the sixth being "the application of an improved process to the throstle machine, on the principle of the long-ratch, for the new and useful purpose of spinning silk waste;" and the seventh, "certain improvements effected by them in the throstle machine, by which the utility in spinning silk waste was greatly augmented." After describing the old process of converting silk waste into yarn, the specification proceeded to describe the novel process by which the plaintiffs produced their new or improved manufacture; and, referriug to drawings, continued: "The annexed drawings, for the most part, represent the well-known spinning frame, called 'a throstle,' on the principle of the long-ratch, as implied in the spinning of flax; which machine, combined with the improvements we have applied to it, we apply to the new and useful purpose of spinning silk waste of long fibres, in combination with flax or wool." And the specification concluded thus: "We desire it to be understood that we disclaim those parts of the process, or mechanism, which were or may have been, previous to the granting of our patient, well-known or in use for the same purposes; but we restrict our claims to the eight several heads of invention mentioned in the early part of the specification, all of which we believe to be new, and of great public utility:" Held, that this was a claim either of a new invention, or a new

combination of parts of the throstle machine; and the jury having found "that the invention was not new but an improved process, not a new combination," that the defendant was entitled to the verdict upon these issues. *Gibson* v. *Brand*, 4 Scott, N. R. 844; 4 M. & G. 179.

When a patent has been obtained for strengthening and polishing linen and cotton yarns by means of friction brushes, another patent can not be taken out for applying the same process to yarn of wool or hair, or to fabrics made of cotton, linen, silk, wool, or hair. *Brook* v. *Aston*, 5 Jur., N. S. 1025; 28 L. J., Q. B. 175; 8 El. & Bl. 478—Exch. Cham.

A patent for improvements in looms for weaving by means of the clutch box is novel. *Sellers* v. *Dickinson*, 5 Exch. 312; 20 L. J., Exch. 417.

Previously to a patent being granted, gelatine was obtained by submitting large pieces of hides to the action of caustic alkali, or by reducing them to pulp in a paper machine, and employing blood to purify the product. The invention claimed consisted in cutting the hides into shavings, thin slices, or films, whereby the use of blood in the process of purification become unnecessary. The specification did not state whether they were to be cut wet or dry, or to what degree of thinness, or what was the minimum of heat they ought to be subjected to in the subsequent processes. It was proved that they might be cut either wet or dry, and that the thinner they were cut the better if the fibrine texture was preserved, and that the most satisfactory result would be obtained if no more heat was used than would dissolve the gelatine in the shortest period. The defendant cut the hides wet, and about twelve to the inch: Held, that the invention was the subject of a patent, and that the defendant had infringed it. *Wallington* v. *Dale*, 7 Exch. 888; 23 L. J., Exch. 49.

In 1844, G. obtained a patent for improvements in grinding wheat and other grain. He described as his invention "the forcing and distributing of atmospheric air from the eye or center of millstones, for the purpose of cooling the grain during the process of grinding." This was effected by an air box placed below the millstones, into which the air was forced by

the rapid rotation of a fan or a blower, which caused a current of air perpendicular to the axis of the fan, and the air was conducted by a pipe through the eye of the lower stone to the center of the two stones, and there distributed between them by an apparatus provided with fans or arms. In 1846, B. obtained a patent "for improvements in manufacturing wheat and other grain into meal and flour." His invention consisted of the application of ventilating vanes or screws at the center of the stones for supplying the air between the grinding surfaces; a portable ventilating machine, blowing by a screw vane, which caused a current of air parallel to the axis of the vane, was attached externally to the eye of the upper millstone, the screw vane being set in rapid motion, the air was compelled to pass through the eye into the center of the two stones, and so find its way out between them. In 1851, C. obtained a patent for improvements in grinding wheat, and his plan was to remove from the center of both stones a large circular portion of each, and in this space, opposite to the separation of the two stones, to place a fan or blower, by the rapid rotation of which a centrifugal motion was given to the air, and it was driven between the stones: Held, that C.'s invention was no infringement of B.'s, but that each was a new method of accomplishing a well-known object, viz., the cooling grinding substances by the common principle of obtaining a current of air by a rotating vane. *Bovill* v. *Pimm*, 11 Exch. 718. See *Boville* v. *Keyworth*, 7 El. & Bl. 725; 3 Jur., N. S. 817.

The plaintiff took out a patent for "improvement in the manufacture of candles, and in apparatus for applying light." In his specification he claimed, first, the mode of manufacturing candles by the application of peculiarly-formed plaited wicks; secondly, the mode of manufacturing candles by the application of two or more plaited wicks so disposed that the ends always turned outward; and thirdly, the mode of applying lenses to lamps, in order to concentrate or conduct a portion or portions of the rays of light to a distance; the plaintiff afterward entered a disclaimer as to the first and third parts of his invention, and he sued the defendant for an infringement of the second part. At the trial the plaintiff produced a candle purchased of the defendant, the wicks of which were so plaited that the ends

always turned outward: Held, that the patent was not for the candle itself, but for the mode of manufacturing it, and that the mere production of a candle made by the defendant was no evidence of an infringement of the plaintiff's patent. *Palmer* v. *Wagstaff*, 9 Exch. 494; 2 C. L. R. 1052; 23 L. J., Exch. 217.

A patentee of a sewing machine in his specification claimed "the application of a shuttle in combination with a needle, as shown in sheet 1, for forming and sewing loops of thread or other substance for the purpose of producing stitches either to unite or ornament fabrics, whatever may be the means employed for working such shuttle and needle when employed together:" Held, that this claim was not confined to the single application of a shuttle in combination with a needle, as shown in sheet 1, but extended generally to the application of a shuttle with a needle for the attaining the object therein stated. *Thomas* v. *Foxwell*, 5 Jur., N. S. 37—Q. B. Affirmed on appeal, 8 Jur., N. S. 271—Exch. Cham.

The following inventions were held void for want of novelty:

Turning-tables for railway purposes. *Holmes* v. *London and Northwestern Railroad Company*, 12 C. B. 831; 22 L. J., C. P. 58; 17 Jur. 304.

Manufacture of gas direct from seeds, leaves, flowers, branches, nuts, fruit, and other substances containing oil, or oily, or resinous matter, similar to K.'s previous patent. *Booth* v. *Kennard*, 2 H. & N. 84; 26 L. J., Exch. 305—Exch. Cham.

Though a valid subject of a patent if novel. *S. C.* in Exch., 1 H. & N. 527; 3 Jur., N. S. 21; 26 L. J., Exch. 23.

Agricultural reaping machines. *M'Cormick* v. *Gray*, 7 H. & N. 25; 31 L. J., Exch. 42; 9 W. R. 809; 4 L. T., N. S. 832.

Fishes and fish-joint for connecting the ends of rails on railways. *Harwood* v. *Great Northern Railway Company*, 11 H. L. Cas. 654; 35 L. J., Q. B. 27; 12 L. T., N. S. 771; though a good subject-matter for a patent. *S. C.* in Q. B., 6 Jur., N. S. 993; 29 L. J., Q. B. 193.

Betts' manufacture of capsules, in the Exchequer Chamber,

held void on the ground of D.'s previous patent of Albion metal for facings of cisterns, etc. *Betts* v. *Menzies*, 30 L. J., Q. B. 81; 6 Jur., N. S. 1290; but on appeal to Dom. Proc., Betts' Patent, held to be valid. *Betts* v. *Menzies*, 10 H. L. Cas. 117; 9 Jur., N. S. 29.

II. LETTERS PATENT.

I. Grant.

On behalf of Foreigners.]—A patent granted to a British subject in his own name for an invention communicated to him by a foreigner, the subject of a state in amity with this country, is not void, although such patent is in truth taken out and held by the grantee in trust for such foreigner. *Beard* v. *Egerton*, 3 C. B. 97; 10 Jur. 643; 15 L. J., C. P. 270.

In such case, the grantee is the true and first inventor within this realm, within 21 Jac. 1, c. 3. *Ib.*

Master and Servant.]—If a servant, while in the employ of his master, makes an invention, that invention belongs to the servant, and not to the master. *Bloxam* v. *Elsee*, 1 C. & P. 558; R. & M. 187—Abbott.

Where a master and his foreman both invented certain improvements, for which the master sought letters patent: Held, that they ought only to be granted on the terms of their being vested in trustees for the master and the foreman. *Russell, in re*, 2 De G., M. & G. 130.

Where a servant filed a provisional specification for an invention, after which the master filed a provisional specification for a similar invention, and subsequently filed a complete specification, and obtained letters patent: Held, that, under these circumstances, the great seal might be affixed to the letters patent for the servant's invention, and that the letters patent might bear the date of his provisional specification. *Ex parte Scott and Young*, 6 L. R., Chanc. Ap. 274—C.

To two or more Persons jointly.]—When letters patent are granted to two or more persons, any one of them may use the invention

for his own benefit without the consent of the others. *Mathers* v. *Green*, 11 Jur., N. S. 845; 35 L. J., Chanc. 1; 14 W. R. 17; 13 L. T., N. S. 420—C.

Date and Duration.]—Original letters patent for a term of fourteen years were dated on the 26th February, 1825, and renewed letters patent were dated on the 26th of February, 1839: Held, that the day of the date must be reckoned inclusively, and that the renewed letters patent were not granted after the original letters patent had expired. *Russell* v. *Ledsam*, 14 L. J., Exch. 353; 14 M. & W. 574.

Sealing.]—Letters patent were sealed in a case where the evidence showed great similarity between the alleged invention and one for which a patent was already in force. *Tolson's Patent*, 6 De G., M. & G. 422.

Sealing letters patent after time for provisional protection had expired under 15 and 16 Vict., c. 83, ss. 19, 20. *Mackintosh's Patent*, *in re*, 2 Jur., N. S. 1242—C.

The crown can at any time before the great seal is affixed, upon a proper case being made out, countermand the warrant. *Schlumberger*, *in re*, 9 Moore, P. C. C. 1.

Unless a patent is clearly bad, the lord chancellor will not refuse to seal it, as the effect of such refusal, if erroneous, would be irremediable, whereas the sealing of a bad patent leaves every one at liberty to dispute it. *Spence*, *in re*, 3 De G. & J. 523.

Where there was but one affidavit distinctly swearing to the public use and sale of an alleged invention prior to the date of the application for a patent, the great seal was ordered to be affixed to the patent. *Tolhausen's Patent*, *in re*, 14 W. R. 551—C.

The time within which the application for the warrant and for the letters patent ought to be made under the rules of the patent commissioners extended, where the delay was small and accidental. *Hersee*, *in re*, 1 L. R., Chanc. 518; 14 L. T., N. S. 842.

The lord chancellor, on an application for sealing a patent, will not interfere with the decision of the law officer of the

crown, unless in a case of fraud, or of surprise, or of some material fact having come to the knowledge of the party since the case was before the law officer. *Vincent's Patent, in re*, 2 L. R., Chanc. 341; 15 W. R. 524.

Where the law officer has reported that part of an invention for which a patent is sought is identical with part of an invention which is the subject of an existing patent, a second patent will not, except under special circumstances, be granted for that part, although the validity of the first patent is disputed. *Ex parte Manceaux*, 6 L. R., Chanc. App. 272—C.

When the sealing of a patent is opposed on the ground that the invention is similar to one which is the subject of an existing patent, a reference will be made to the law officer whether, having regard to the prior patent, the seal ought to be affixed to the patent as applied for, the opponent paying the costs of the hearing, unless there has been fraud on the part of the applicant. *Manceaux, ex parte*, 5 L. R., Chanc. 518; 18 W. R, 854.

Letters patent will not be sealed where a prior patent was granted for the same invention. *Manceaux's Patent, in re*, 18 W. R. 1184—C.

Where the granting of a patent was opposed by the owner of a similar patent, on the ground that the application was, under the circumstances, a breach of good faith on the part of the applicant, the lord chancellor directed the patent to issue upon certain terms. *Daine's Patent, in re*, 26 L. J., Chanc. 298—C.

Notice of objections was filed to sealing of letters patent, and afterward withdrawn. On petition, the costs occasioned by such objections were ordered to be paid by the person who had filed them. *Cobley's Patent, in re*, 8 Jur., N. S. 106; 31 L. J., Chanc. 333; 5 L. T., N. S. 387—C.

Where a petition to have the great seal affixed to a patent had been filed, and the respondents served with notice two months before the first day of Michaelmas term, for which day the petition was answered, and the respondents only filed affidavits on the morning of that day: Held, that they could not be

read, and the patent was ordered to be sealed. *M'Kean's Patent, in re*, 1 De G., F. & J. 2; 8 W. R. 1; 1 L. T., N. S. 19.

L. and W. were joint patentees of an invention for propelling vessels, and whilst engaged in making experiments with regard to it, an accident happened, which appeared to have suggested to each an improvement upon the method previously adopted. They communicated their ideas to each other, but neither took any steps to secure the benefit of the invention for two years, when L. applied for a patent, against the sealing of which W. entered a caveat, on the ground that he (W.) was the first inventor. The evidence on this point being conflicting: Held, that L., having first applied, was entitled to have his patent sealed, though possibly W. might be able to get it repealed upon scire facias. *Lowe's Patent, in re*, 25 L. J., Chanc. 454—C.

Opposing Grant.]—Leave was given to oppose the granting of letters patent, notwithstanding the time for entering an opposition had expired, the reason for the delay in entering such opposition being accounted for. *Brennand's Patent, in re*, 7 Jur., N. S. 690; 4 L. T., N. S. 456—C.

A party who has not opposed the sealing of a patent before the law officer of the crown, will not be allowed to oppose before the lord chancellor. *Mitchell's Patent, in re*, 2 L. R., Chanc. 343—C.

A person may give notice of objection, and oppose the sealing of a patent before the lord chancellor, without previously applying to the court for leave to enter opposition. *Vincent's Patent, in re*, 2 L. R., Chanc. 341; 15 W. R. 524—C.

Entering Caveats.]—A party who had lodged an unsuccessful caveat against the granting of a patent, ordered to pay to the patentee the taxed costs occasioned by the caveat. *Cutler's Patent, in re*, 4 Mylne & Cr. 510.

The effect of a caveat lodged at the chambers of the attorney-general is merely to entitle the party lodging it to notice. *Reg.* v. *Cutler*, 3 C. & K. 215—Denman.

Where a caveat was lodged before the great seal was affixed to a patent, the lord chancellor declined to enter into the merits of the opposition, but referred the matter back to the attorney-general. *Fawcett's Patent, in re*, 2 De G., M. & G. 439.

No caveat against the sealing of letters patent will be entered without the express leave of the lord chancellor. *Heathorn's Patent, in re*, 10 Jur., N. S. 810; 12 W. R. 1068; 10 L. T., N. S. 802.

2. Amendment.

An application for amendment of a patent, granted in 1856, by rectifying an error in the spelling of the name of the patentee was refused on the ground of lapse of time. *Blamaud, in re*, 3 L. T., N. S. 800—C.

3. Stamp Duty.

The 16 and 17 Vict., c. 5, *which substitutes stamp duties on patents for fees, by s. 2, makes patents, granted under* 15 *and* 16 *Vict., c.* 83, *subject to avoidance on non-payment of certain stamp duties within certain periods, and its effect is to give the patents by installments, first for three years, on the payment of* 25*l. stamp duty, then four for three years more on payment of* 50*l. within the three years, and then for the full period on payment of* 100*l. within seven years from the date of the grant.*

By a deed, an inventor agreed with the defendant that he should do all acts necessary, except the payment of money, for procuring and perfecting letters patent, and should, immediately after the same were procured, execute an assignment to the defendant of one-third share in the patent, and the defendant agreed to pay all fees and disbursements which might be necessary for procuring the letters patent, enrolling the specification, and otherwise perfecting the same: Held, that the assignment by the inventor was the entire consideration for the defendant's undertaking to pay the fees and disbursements, and a condition precedent, and that without having executed such an assignment he could not sue the defendant for not paying the 50*l.* necessary to be paid within three years. *Hill* v. *Mount*, 18 C. B. 72; 25 L. J., C. P. 190.

The day of the date of the letters patent is excluded, and the three years do not expire until twelve o'clock at night of the anniversary of the day on which the letters patent are granted. *Williams* v. *Nash*, 5 Jur., N. S. 696; 28 L. J., Chanc. 886; 27 Beav. 93.

4. Reservation of Right of User by the Crown.

A grant of letters patent to a subject for an invention, does not exclude the crown from using the invention without the license of the patentee. *Feathers* v. *Reg.*, 12 L. T., N. S. 114; 6 B. & S. 257; 30 L. J., Q. B. 200.

The crown is not responsible, by way of petition of right, for an infringement of a patent by the lords of the admiralty, but the remedy is by action against the wrong-doers. *Ib.*

A patent for the exclusive use of an improvement in the invention of anchors, contained a proviso for avoiding the patent, if the patentee should not supply for his majesty's service all such articles of the invention as should be required, on such reasonable terms as should be settled by the lords of the admiralty. The latter used the invention, but did not take the articles from the patentee. The court refused to issue a mandamus to them, to settle the terms according to the patent. *Pering*, *ex parte*, 4 A. & E. 949; 6 N. & M. 472.

5. Scotch.

It is essential to the validity of a Scotch patent that the machinery or improvement for which it is granted should be new as well in England as in Scotland. *Brown* v. *Annandale*, 8 C. & F. 437; *S. P. Robinson's Patent*, *in re*, 5 Moore, P. C. C. 65.

6. Foreign.

Grant in England.]—The 15 and 16 Vict., c. 83, s. 25, applies where a foreign patent is de facto granted, though it is afterward canceled ab initio. *Daw* v. *Eley*, 36 L. J., Chanc. 482; 3 L. R., Eq. 496; 15 L. T., N. S. 559—V.-C. W.

7. Expunging Entries in Registry of Proprietorship.

By 15 and 16 Vict., c. 83, s. 38, *if any person shall deem himself aggrieved by any entry made in the register of proprietors, it shall be lawful for such person to apply by motion to the master of the rolls, or to any of the courts of common law at Westminster in term time, 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, may make such order for expunging, vacating, or varying such entry, and as to the costs of such application, as to the master of the rolls, or to the court or judge, may seem fit, and the officer having the care and custody of the register, on the production to him of any such order, shall expunge, vacate, or vary the same, according to the requisitions of such order.*

Under this provision, the court can expunge an entry fraudulently made; it can direct any facts relating to the proprietorship to be inserted on the register, but not the legal inferences to be drawn from them. *Morey, in re*, 25 Beav. 581.

A patentee assigned half a patent to A., and afterward he assigned the whole to B. by a deed, reciting that he had already granted a license to work and use it to A. B.'s assignment was first registered: Held, that B. had constructive notice of A.'s rights, and an entry was ordered to be made in the register that the license referred to in B.'s assignment was the deed of assignment to A. subsequently entered. *Ib.*

A patentee, in 1853, assigned his patent, but the assignees omitted to register it. Afterward, in August, 1855, the patentee assigned the patent to another person, who registered it on the same day. The first assignees registered their assignment a week afterward. The court, in 1857, on the motion of the first assignees, ordered the register of the second assignment to be expunged, and with costs. *Green's Patent, in re*, 24 Beav. 145.

The assignee of a patent may maintain a suit against the assignor and subsequent licensees from the assignor with notice of the assignment, to restrain them from using the patent, although

at the time of the institution of the suit the assignment has not been registered. *Hassell* v. *Wright*, 10 L. R. Eq. 509; 18 W. R. 821—V.-C. M.

Semble, that registration of the assignment of a patent relates back to the date of the assignment so as to entitle the assignee to maintain a suit to restrain an infringement instituted between the dates of the assignment and the registration. *Ib.*

The court will, on motion of the persons aggrieved, correct an entry in the register of proprietors of patents, which purports to affect the rights of persons not parties to the deed registered. *Horsely and Knighton's Patent, in re*, 39 L. J., Chanc. 157—R.

One of two joint patentees by deed assigned his interest in the patent to a third person, and released to him all the rights of action against him of both the patentees; and the deed was set out completely on the register: Held, that the other joint patentee was entitled to have the entry struck out. *Ib.*

8. Penalty for imitating or using Name or Mark of Patentee.

In an action for a penalty under 5 and 6 Will. 4, c. 83, s. 7, for putting on an article made according to a patent the words "K. & G. Patent Elastic," without the license of the patentee, it is no defense that the invention was not a new manufacture. *Myers* v. *Baker*, 3 H. & N. 802; 28 L. J., Exch. 90; 7 W. R. 66.

But it is necessary to prove that such words did imitate, and were so put on with a view of imitating the mark of the patentee. *Ib.*

9. Assignee.

It is no ground of objection to the title of an assignee of a patent, that the assignors, the executors of the grantee, omitted to register the probate until after the date of the assignment; though possibly it might be an obstacle to the maintenance of an action by the assignee for an infringement, if commenced before the registration of the probate. *Elwood* v. *Christy*, 17 C. B., N. S. 754; 34 L. J., C. P. 130; 13 W. R. 498; 11 L. T., N. S. 342; 10 Jur., N. S. 1079.

An assignee of a patent may maintain an action for an infringement, even though he has acquired the right by assignment of two separate moieties, and the party sued is the original grantee. *Walton* v. *Lavater*, 8 C. B., N. S. 162; 29 L. J., C. P. 275.

An action is maintainable although there has been no infringement since the defendant has received notice that the entire interest in the patent has become vested in the assignee. *Ib.*

It is competent to an assignee of a separate and distinct portion of a patent to sue for an infringement of that part, without joining one who has an interest in another part; the damages to be recovered in the action accruing to the former alone. *Dunnicliff* v. *Mallet*, 7 C. B., N. S. 209; 6 Jur., N. S. 252, 29 L. J., C. P. 70; 8 W. R. 260.

To a declaration for the infringement of a patent, brought by an alleged assignee (by deed) of the patent, the defendant pleaded, by denying the assignment modo et formâ. On the trial, it appeared that an instrument of assignment had been executed by the patentee, but that it had not been registered under 15 and 16 Vict. c. 83: Held, that as, by s. 35, the original patentee is, until the entry of the registration, to be deemed and taken to be the sole and exclusive proprietor of the patent, the defendant was entitled to a verdict, although the objection was not specified in the notice of objections delivered by him. *Chollett* v. *Hoffman*, 7 El. & Bl. 686; 3 Jur., N. S. 935; 26 L. J., Q. B. 249.

10. When Void.

A patent being granted upon a specification that the machine was capable of performing all the operations necessary to the perfection of the proposed invention; and it appearing that a second patent was taken out for improvements necessary to the efficient operation of the original machine: Held, that the consideration of the first patent having failed, both patents were void. *Bloxam* v. *Elsee*, 9 D. & R. 215; 6 B. & C. 169; 1 C. & P. 558; R. & M. 187.

If it appears that the patent was granted for a different thing from that mentioned in the specification, it is void. *Rex* v. *Wheeler*, 2 B. & C. 345.

Where one part of an invention is not new, the patent is void as to the whole. *Kay* v. *Marshall*, 1 West, 682; 5 Jur. 1028; 8 C. & F. 245.

A patent granted to A. for improvements in the construction of racks and pulleys for window-blinds and other useful purposes, besides claiming a mode of making the frames by constructing them in a particular manner of drawn open metal tubes, claimed a mode of fixing the pulley in the frame by turning the knob of the spindle upon which the pulley revolved, and thereby of screwing a piece of metal, made to slide within the frame tight to the edge of the frame, by which means the pulley spindle became firmly fixed to the frame. By a patent previously granted to B., the same object was effected by a similar method, but with the addition merely of a piece of thin metal called an escutcheon, which worked outside the frame; but the specification stated that the pulleys might be made without the escutcheon: Held, that the two patents were substantially the same as to one of the things claimed, and, therefore, that A.'s patent was void. *Dobbs* v. *Penn*, 3 Exch. 427.

III. SPECIFICATION.

1. Provisional.

(15 and 16 Vict. c. 83, ss. 6, 8, 9, 10, 11, 13, 14.)

A provisional specification, if allowed by the law officer of the crown, can not be impeached as being too general. *Penn* v. *Bibby*, 2 L. R., Chanc. 127; 36 L. J., Chanc. 455; 15 W. R. 208; 15 L. T., N. S. 399—C.

The office of the provisional specification is only to describe, generally and fairly, the nature of the invention, and not to enter into all the minute details as to the manner in which the invention is to be carried out, as in the complete specification. *Newall, in re*, 4 C. B., N. S. 269; 4 Jur., N. S. 562; 27 L. J., C. P. 237.

Where a provisional specification was filed on the 17th of

March, and afterward abandoned by the inventor, who delivered another specification for the same invention on the 10th of April, in respect of which a patent was granted to him on the 12th of October, but dated as of the 10th of April: Held, that there had not been a dedication of the invention to the public by the abandonment of the first provisional specification, but that the patent was valid by 15 and 16 Vict. c. 83, s. 24. *Oxley* v. *Holden*, 8 C. B., N. S. 666; 30 L. J., C. P. 68; 8 W. R. 626; 2 L. T., N. S. 464.

2. Variance between Provisional and Complete Specification.

The complete specification must not claim anything different from that which is included in the provisional specification, but it need not extend to everything so included. *Penn* v. *Bibby*, 2 L. R., Chanc. 127; 36 L. J., Chanc. 455; 14 W. R. 208; 15 L. T., N. S. 399—C.

The provisional specification of a patent for an improvement in the bearings and bushes for the shafts of screw and submerged propellers described the invention as consisting in employing wood in the construction of such bearings and bushes. The complete specification, after describing the mode in which the wood was to be used, claimed the employing of wood in the construction of bearings and bushes "as therein described:" Held, this was no such variation between the provisional and complete specification as invalidated the patent. *Ib.*

The provisional specification of a patent for sewing machines, claimed, amongst other improvements, that a certain instrument which moved the work, "or another acting therewith," acted to hold the work during the insertion of the needle, while the complete specification appeared to describe only one instrument as moving and holding the work: Held, that such a variance would not invalidate the patent. *Thomas* v. *Welsh*, 1 L. R., C. P. 192; 12 Jur., N. S. 316; 35 L. J., C. P. 200.

3. Construction and Interpretation.

The words of a specification are to be construed according to their ordinary and proper meaning unless there is something in the context (which may be explained by evidence), to show that a different construction ought to be made. *Elliott* v. *Turner*, 2 C. B. 446; 15 L. J., C. P. 49.

In an action upon a deed of license to use a patent for making buttons, the issue being, whether buttons made by the defendant were made under the license, the specification stated the invention to be, the application of such fabrics only wherein the ground is produced by a warp of soft or organzine silk, such as is used in weaving satin; and claimed the application of such fabrics to the covering of buttons, as have the ground woven with soft or organzine silk for the warp: Held, that the proper meaning of the word "or" being disjunctive, it ought to be so construed, unless there was anything in the context, or the facts proved, to give it a different meaning; and that the judge ought not to have told the jury absolutely, that unless the buttons were made of organzine silk, they were not within the patent; but that the words "soft or organzine" were capable of being construed to mean the same thing, if the jury was satisfied that there was only one description of silk, viz: organzine used for weaving satin at the date of the patent. *Ib.*

The construction of a specification is a question of law for the court, and not for a jury. *Bovill* v. *Pimm*, 11 Exch. 718.

Although the construction of a specification belongs to the court, the explanation of the words used therein, or of technical terms of art, is matter of fact upon which it is the province of a jury to decide. *Hills* v. *Evans*, 8 Jur., N. S. 525; 31 L. J., Chanc. 457; 6 L. T., N. S. 90—C.

Where two specifications of different dates, relating to the same external objects, contain terms of art, though the expressions used in both are identical, their construction can not be declared to be the same without the meaning and use of the terms of art employed therein being first ascertained by evidence, and being shown to be the same at the date of both the specifi-

cations. *Betts* v. *Menzies*, 10 H. L. Cas. 117; 31 L. J., Q. B. 233; 11 W. R. 1; 7 L. T., N. S. 110; 9 Jur., N. S. 29.

An antecedent specification, declaring a principle, but not disclosing a practical mode of obtaining a result, is not to be held to be an anticipation of a subsequent specification relating to the same matter, which does disclose a practicable mode of producing the result. If the latter specification alone supplies that practicable mode, it forms the groundwork for a valid patent. *Ib.*

A barren general description, probably containing some suggested information, or involving some speculative theory, can not be considered as anticipating a subsequent specification of invention which involves a practical truth, which is productive of beneficial results, unless you ascertain that the antecedent publication involves the same amount of practical and useful information. *Ib.*

In construing a specification, it is not competent to an inventor to pray in aid the provisional specification, in order to explain or enlarge the meaning of the complete specification. *Mackelcan* v. *Rennie*. 13 C. B., N. S. 52.

Though the construction of a patent or a specification is ordinarily for the judge, yet where a specification mentioned "the precipitated or hydrated oxides of iron," there was (on the issue of novelty) a prior patent proved, the specification of which mentioned carbonate of iron, and the scientific evidence showed that real carbonate of iron was so difficult to be preserved, that it was not commonly sold in the shops (though it existed as a chemical substance), and what was sold for it would be, in fact, a hydrate, through absorption, but that carbonate would not be understood chemically as meaning hydrate. The judge having ruled that the specification was to be construed commercially, not scientifically, that carbonate commercially meant the "hydrate," and that on the issue of novelty the plaintiff must be nonsuited, the court, after great doubt, set aside the nonsuit, and granted a new trial. *Hills* v. *London Gaslight Company*, 27 L. J., Exch. 60.

The rules governing the construction of specifications are the ordinary rules for the interpretation of written instruments; but, unless a specification particularly describes the nature of an invention, and in what manner the same is to be performed, in such a manner as to be intelligible to a workman of ordinary knowledge, the grant of the letters patent is void. *Simpson* v. *Holliday*, 13 W. R. 577; 12 L. T., N. S. 99—C.

The specification of a patent instrument, called the Miner's Safety Fuse, after describing the manner in which the case of the instrument was to be made, proceeded thus.: "By means whereof I embrace in the center of my fuse, in a continuous line throughout its whole length, a small portion or compressed cylinder or rod of gunpowder, or other proper combustible matter, prepared in the usual pyrotechnical manner of the firework for the discharge of ordnance." In an action for infringing the patent, at the trial, it was objected that the patentee had not shown that any other material but common gunpowder had ever been used in the fuse, or, if introduced, would answer the purpose: Held, first, that the question as to the sufficiency of the specification was for the jury. *Bickford* v. *Skewes*, 1 G. & D. 736; 1 Q. B. 938; 6 Jur. 167.

Held, secondly, that the language of the specification was not to be astutely construed so as to overthrow the patent, and that it was for the defendant to make out his objection clearly. *Ib.*

Held, thirdly, that the former part of the objection, that any other material but common gunpowder had ever been used in the fuse, was immaterial; because, although other materials not specified, but still within the description given, would answer the purpose, no ambiguity was occasioned, nor was the difficulty of hereafter making the instrument increased by the introduction of the terms which imported that the patentee himself had ever used other materials than gunpowder in the construction of the instrument. *Ib.*

4. Comparing with Others.

In the comparison of two specifications, each of which is filled with terms of art, and with the description of technical processes, it is the duty of the court to give the legal construction, but the work of comparing the two specifications is for the jury. *Hills* v. *Evans*, 8 Jur., N. S. 525; 31 L. J., Chanc. 457; 6 L. T., N. S. 90—C.

D. in 1804, took out a patent for making "a new article of trade, which I denominate 'Albion metal,' and which I apply" to various purposes, such as the facings of cisterns, coffin furniture, "and other things which are required to be made of a flexible" substance. D. stated in his specification the principle of his invention, and that he proposed to unite lead and tin by pressure; but he did not state the exact proportions of the two metals, nor give with precision the mode by which they were to be combined. It did not appear that the patent had been acted on. In 1849, B. took out a patent for "a new manufacture of capsules, and of a material to be employed therein, and for other purposes." The new material was to be composed of lead and tin combined. B. specified the proportions of the two metals, gave the details of the mode of working in order to combine them, and did not claim the production of the new material except according to the directions he had given for its production: Held, that this was not a case in which the court, looking at the two instruments, could determine the validity of the latter patent as a matter of construction only; that evidence must be resorted to; and that then it was apparent that the earlier patent only stated a principle, and that the latter patent, as it did not claim the discovery of the principle, but only a new mode of carrying it into effect, was valid. *Betts* v. *Menzies*, 10 H. L. Cas. 117; 9 Jur., N. S. 29; 31 L. J., Q. B. 233; 11 W. R. 1; 7 L. T., N. S. 110.

The question of novelty of invention, when raised by the comparison of two specifications, is a question of law for the court, if the two specifications do not contain expressions of art and commerce, the meaning of which must be explained by evidence.

Thomas v. *Foxwell*, 5 Jur., N. S. 37—Q. B. Affirmed on appeal, 8 Jur., N. S. 271.

In an action for an alleged infringement of a patent where the defense is that the supposed invention is not new, the judge may compare the plaintiff's specification with the specification of a previous patent, and may on such comparison, direct the jury to find a verdict. *Bush* v. *Fox* (in error), 5 H. L. Cas. 707; 2 Jur., N. S. 1029; 25 L. J., Exch. 251.

The specification of a patent for improvements in the manufacture of gas described the invention to consist in the direct use of seeds, leaves, flowers, and beech nuts, fruit and other substances, and matters containing oil, or oily and resinous matter, and stated that the mode of using the seed and constructing the apparatus might be the same as the apparatus used in the mode of making gas from coal; but that the inventor preferred placing the seed in a red-hot retort. The claim was "for making gas direct from seeds and matters therein named, for practical illumination or other useful purposes, instead of making it from oils, resins, or gums previously extracted from such substances." On the trial of an action for an infringement of this patent, upon proof on the part of the defendant that a patent had been previously granted to a third person for improvements in artificial light, the inventor proposing by his specification to use residuary matters obtained in the manufacture of fatty substances, and also the residium after the oil had been pressed from the seeds, such as oil-cake, and also beech nuts, or mast, cocoa nuts, and all others abounding in oil. The judge directed the jury to find a verdict for the defendant: Held, that the direction was right, the two patents being substantially the same, and it being the province of the court to take notice of the identity apparent upon the written document, and the consequent want of novelty, and that it was not necessary to submit the question of novelty to the jury. *Booth* v. *Kennard*, 26 L. J., Exch. 305; 2 H. & N. 84.

5. Correction by Disclaimer.

A disclaimer is not essential to a specification. *Lister* v. *Leather*, 4 Jur., N. S. 947; 27 L. J., Q. B. 295—Exch. Cham.

A count in scire facias to repeal a patent for improvements in instruments used for writing and marking, and in the construction of inkstands, contained suggestions of want of novelty and utility in a certain part of the invention. The objections filed with the declaration, pointed out the sixth claim in the specification as wanting novelty, and being useless. After issue joined, the defendant filed a disclaimer, of the fifth, sixth, seventh, and eighth claims mentioned in the specification. These claims related to pens and to instruments used for marking with a stamp. Those which remained untouched by the disclaimer were for improvements in penholders and pencil-cases, and in the construction of inkstands: Held, that the title of the letters patent was satisfied by the specification as amended by the disclaimer. *Reg.* v. *Mill*, 10 C. B. 379; 1 L. M. & P. 695; 15 Jur. 59; 20 L. J., C. P. 16.

If a specification of a patent comprises what is in truth an impracticable generality, it is not competent for the inventor to rectify the defect by means of a disclaimer purporting to alter the specification into a grant of a patent for a specific process, though it is comprised within the general terms of the specification, but could not be discovered to be there without going through the same course of experiment which led to the discovery of the specific process in the disclaimer. *Ralston* v. *Smith*, 11 C. B., N. S. 471; 8 Jur., N. S. 100; 31 L. J., C. P. 102—Exch. Cham.

S. took out a patent for an improvement in machinery used for roving cotton. His specification appeared to claim the discovery of the application of the principle of centrifugal force for such a purpose, but he filed a disclaimer, declaring that he intended to claim only the application of centrifugal force in the particular manner described in the specification: Held, that taking these two instruments together they sustained the patent. *Seed* v. *Higgins*, 8 H. L. Cas. 550; 30 L. J., Q. B. 314.

The particular manner described was by the use of "a weight." The defendant employed a machine similar in many respects, but though using weight, or pressure occasioned by weight, as a force, not using a weight:" Held, that this did not amount to an infringement of the patent. *Ib.*

6. Explanatory by Drawings.

In the specification of an improved instrument, it is essential to point out precisely what is new and what is old; and it is not sufficient to give a general description of the construction of the instrument without making such distinction, although a plate is annexed containing a detached and a separate representation of the parts in which the improvement consists. *Macfarlane* v. *Price*, 1 Stark. 199—Ellenborough.

An inventor of a machine is not tied down to make such a specification as by words only would enable a skillful mechanic to make the machine, but he is allowed to call in aid the drawings which he may annex to the specification; and if, by a comparison of the words and the drawings, the one will explain the other sufficiently to enable a skillful workman to perform the work, such a specification is sufficient. *Bloxam* v. *Elsee*, 1 C. & P. 558; R. & M. 187; 9 D. & R. 215; 6 B. & C. 169.

When a specification in the first instance describes the invention in too general terms, but afterward, in describing the method of performing the invention, refers to figures in drawings annexed thereto, and the claim made is for the manufacture of the invention described with reference to those figures, the specification is sufficient. *Daw* v. *Eley*, 14 W. R. 126; 13 L. T., N. S. 399—V.-C. W.

7. General Sufficiency.

The specification of an invention, which consists in the use of known materials in new proportions, is not necessarily bad for uncertainty, though the patentee does not limit himself to the proportions recommended. *Patent Type Founding Company* v. *Richard*, 1 Johnson, 381; 6 Jur., N. S. 39.

In a patent for an improved arrangement, or for a new combination of machinery, the specification must describe the im-

provement and define the novelty otherwise, and in a more specific form, than by the general description of the entire machine, it being part of the condition of a patent that the specification shall particularly describe and ascertain the invention. *Foxwell* v. *Bostock*, 12 W. R. 723; 10 L. T., N. S. 144—C.

A patent, when the specification is insufficient, is void. *Ib.*

A patent is a patent for a combination, if a combination is expressly stated in the specification to be a part of the invention, although the combination is not expressly claimed; for a claim is not an essential part of the specification, or necessary for the protection of the invention, nor is it necessary to disclaim those matters which manifestly form no part of the invention. *Lister* v. *Leather*, 27 L. J., Q. B. 295; 4 Jur., N. S. 947; 8 El. & Bl. 1004—Exch. Cham.

A patentee, describing his invention in the specification, is to be taken to claim as part of his invention all that he describes as the means by which it is to be carried into effect, unless he clearly expresses a contrary intention. *Tetley* v. *Easton*, 2 C. B., N. S. 706; 26 L. J., C. P. 269.

A specification, when construed grammatically, claimed to effect a particular object by two processes, one of which would not effect the object, but evidence showed that no skilled practical workman would be misled, as such a one would know that the one process would be ineffectual, and would adopt the other: Held, that the specification was defective, and the patent void. *Simpson* v. *Holliday*, 1 L. R., H. L. 315; 35 L. J., Chanc. 811.

The specification was as follows: "I mix aniline with dry arsenic acid, and allow the mixture to stand for some time, *or* I accelerate the operation by heating it to or near to its boiling point:" Held, that the word "or" could not be read as "and." *Ib.*

The description, "a roller of hard metal or other suitable material," is not too uncertain, on account of the use of the words "or other suitable material;" such words would mean any material equally sufficient for the purpose with hard metal. *Ralston* v. *Smith*, 11 H. L. Cas. 223; 35 L. J., C. P. 49; 20 C. B., N. S. 28; 13 L. T., N. S. 1.

8. Title of Invention.

The title described a patent to be for a certain invention of "a new or an improved method of obtaining the spontaneous reproduction of all the images received in the focus of the camera-obscura," is sufficiently precise and certain. *Beara* v. *Egerton*, 3 C. B. 97; 10 Jur. 643; 15 L. J., C. P. 270.

The title of a patent must (though not as minutely as the specification) describe the nature of the invention; and the patent is void if the title is so generally worded as to be capable of comprising, not only the particular invention, but improvements not contemplated in it: as where the patent was taken out for improvements in carriages, and the invention was, in fact, an improvement in German shutters, which were used only in some kinds of carriages. *Cook* v. *Pearce*, 8 Q. B. 1044; 8 Jur. 449; 13 L. J., Q. B. 189—Exch. Cham.

Where the title is not inconsistent with the specification, and no fraud is practiced on the crown or the subject, it is not a fatal objection that the title is so general as to be capable of comprising a different invention from that for which the patent is claimed. *Ib.*

The title need not give any idea of the invention; it is sufficient if the specification is consistent with it. *Neilson* v. *Harford*, 8 M. & W. 806.

A declaration in scire facias to repeal a patent for "improvements in instruments used for writing and marking, and in the construction of inkstands," contained suggestions that a certain part of the invention was not new, a part useless, and that no sufficient specification had been enrolled. The prosecutor filed with his declaration a notice of objections, pointing out claim 6 in the specification as old and useless. The specification contained eleven claims. 1–7, for improvements in pencil-cases, penholders, and pens; 7 and 8, instruments for marking; 9–11, inkstands. After issue joined, the defendant enrolled a disclaimer of claims 5–8: Held, that (notwithstanding the defendant had disclaimed the claims 7 and 8, which specifically related to instruments for marking) the specification was still as comprehensive as the title, inasmuch as penholders and pencil-cases

may be well described as instruments used for marking as well as writing. *Reg.* v. *Mill*, 10 C. B. 379; 1 L. M. & P. 695; 15 Jur. 59; 20 L. J., C. P. 16.

Infringement of a patent for "improvements in the manufacture of gas for the purpose of illumination, and in the apparatus used when transmitting and measuring gas." At the trial the plaintiff put in a specification, the title of which described the invention to be of "improvements in the manufacture of gas for illumination, and in the apparatus used therein, and when transmitting and measuring gas;" and which stated it to relate, "first, to a mode of manufacturing gas for the purpose of illumination; secondly, to improvements in setting and heating clay retorts for making coal-gas; thirdly, to a mode of manufacturing clay retorts; and fourthly, to improvements in apparatus for measuring gas when it is being transmitted to the consumer:" Held, that there was a material variance between the invention specified and that described in the title of letters patent; and consequently, that the letters patent were void. *Croll* v. *Edge*, 9 C. B. 479; 14 Jur. 553; 19 L. J., C. P. 261.

N. obtained letters patent for "improvements in the manufacture of plaited fabrics." The specification described that which together amounted to but a single improvement in the mode of manufacture: Held, that this was not such an inconsistency between the title of the patent and the description in the specification as to invalidate the patent. *Nickles* v. *Haslam*, 8 Scott, N. R. 97; 7 M. & G. 337; 8 Jur. 470; 13 L. J., C. P. 146.

9. Description of Invention.

In General.]—A patent is void if the specification is ambiguous, or gives directions which tend to mislead the public. *Turner* v. *Winter*, 1 T. R. 602.

The invention must be accurately described in the specification, and if it is sought to cover more than is actually new and useful, the patent is void. *Hill* v. *Thompson*, 2 Moore, 424; 8 Taunt. 375; Holt, 636; 3 Mer. 629.

The specification must be sufficient to enable others to make

the invention; as the object is, that, after the term, the public may have the benefit of the discovery. *Liardet* v. *Johnson*, Bull. N. P. 76; *S. P. Newberry* v. *James*, 2 Mer. 446.

A patent is void, if the specification omits any ingredient which, though not necessary to the composition of the thing for which the patent is claimed, is a more expeditious and beneficial mode of producing the manufacture. *Wood* v. *Zimmers*, Holt, 58—Gibbs.

If, in the specification of an improved gas apparatus, no direction is given respecting a condenser, which is a necessary part of every gas apparatus, this will not invalidate the patent, if it appears that every one capable of constructing a gas apparatus must know that a condenser must form a part of it. *Crossley* v. *Beverley*, 9 B. & C. 63; M. & M. 283; 3 C. & P. 513; 1 Russ. & Mylne, 166.

Where a patentee of certain apparatus, between the time of taking out the patent and enrolling the specification, made certain improvements in his apparatus, and in the specification claimed the machine so improved as a new invention: Held, that this did not affect the validity of the patent, as the public ought to have the advantage of all improvements down to the time of the specification. *Ib.*

One of the ingredients in a composition was a white substance imported from Germany, and which could be purchased at one or two color shops in London; the only description or denomination given to it in the specification was "the purest and finest chemical white lead;" but there was no article known by that denomination in the trade, or in the shops where white lead is usually sold; and the finest white lead which could be obtained would not answer the purpose: Held, that the specification was insufficient. *Sturz* v. *De la Rue*, 5 Russ. 322.

Where a person obtains a patent for a machine, consisting of an entirely new combination of parts, though all the parts may have been used separately in former machines, the specification is correct in setting out the whole as the invention of the patentee; but, if a combination of a certain number of those parts has previously existed up to a certain point in former

machines, the patentee merely adding other combinations, the specification should only state such improvements, though the effect produced is different throughout. *Boville* v. *Moore*, 2 Marsh. 211.

In an action for invading a patent right to machinery for drying calicoes, where the specification, after setting forth the mode in which the cloth was to be extended for the purpose of drying, proceeded to state that it might be taken up again by the same machinery; a jury having found that the invention was new and useful on the whole, but that the machine was not useful in some cases for taking up goods, the court refused to set aside the verdict for the plaintiff and enter a nonsuit. *Haworth* v. *Hardcastle*, 4 M. & Scott, 720; 1 Bing. N. C. 182.

A brush differing from a common one in no other respect than the hairs or bristles being of unequal lengths, is improperly described in a patent for a new invention as a tapering brush. *Rex* v. *Metcalfe*, 2 Stark. 249—Ellenborough.

A patent was for a machine for making paper in single sheets, without seam or joining, from one to twelve feet or upward wide, and from one to forty-five feet and upward in length: Held, that this imported that paper varying in width between those extremes could be made by the same machine; and that the patentee, at the time of taking out the patent, not having any machine capable of producing paper of different widths, the patent was void. *Bloxam* v. *Elsee*, 6 B. & C. 169; 9 D. & R. 215; 1 C. & P. 558; R. & M. 187.

An invention for giving paper, by the application of a certain composition, such a surface as renders the lines of copper and other plate printing more clear and distinct, may properly be described in a patent, as an improvement in copper and other plate printing. *Sturz* v. *De la Rue*, 5 Russ. 322.

If a specification contains 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 therefore bad, and the patent invalidated, although the jury finds that a competent workman, acquainted with the subject, would not be misled by the

error, but would correct it in practice. *Neilson* v. *Harford*, 8 M. & W. 806.

The omission to mention in a specification anything which may be necessary for the beneficial enjoyment of the invention, is a fatal defect. *Ib.*

But aliter if such omission goes only to the degree of the benefit. *Ib.*

If the apparatus described can be used beneficially in its simplest form, it is no objection that great improvements may have been made. *Ib.*

If experiments are necessary for the production of any beneficial effect, the patent is void. *Ib.*

If a substance as generally known contains a foreign matter, it must be shown either that such foreign matter is not detrimental, or that it can be easily removed. *Derosne* v. *Fairie*, 2 C., M. & R. 476; 3 Tyr. 393; 1 Gale, 109.

A specification must state at least one method which will succeed. *Ib.*

In an action for the infringement of a patent for the daguerreotype invention, it appeared that the invention was for the reproduction of images of nature by the action of light on prepared iodized plates, through the lens of a camera-obscura. The specification divided the process into five distinct operations, the first of which was the cleaning the plates with acid, the second the coating them with iodine, and the third the submitting them to the camera-obscura. At the end of the description of the first operation it was said, "When the plate is not intended for immediate use or operation, the acid may be used only twice upon its surface, after being exposed to heat. . . It is, however, considered indispensable that just before the moment of using the plates in the camera, or the reproducing the design, to put at least once more some acid on the plate, and to rub it lightly with pounce, as before stated." The evidence was, that using the acid after the plates had been coated with iodine, would render the whole operation abortive: Held, that the specification was not calculated to mislead an operator of

fair intelligence, it being sufficiently clear to be understood by such operator, that the direction to use the acid was, that the acid should be used before and not after the plates had been iodized. *Beard* v. *Egerton*, 8 C. B. 165; 13 Jur. 1004; 19 L. J., C. P. 36.

A patentee describing his invention in the specification, is to be taken to claim as part of his invention all which he describes as the means by which it is to be carried into effect, unless he clearly expresses a contrary intention. *Tetley* v. *Easton*, 2 El. & Bl. 956; 18 Jur. 350; 23 L. J., Q. B. 77.

Particular Instances.]—A patent claimed the invention of manufacturing tubes by drawing them through rollers, using a maundril in the course of the operation. A later patent claimed the invention of manufacturing tubes by drawing them through fixed dies or holes, but the specification was silent as to the use of the maundril: Held, that the court, taking the whole of the latter specification together, would infer that the maundril was not to be used, and that the latter patent was good. *Russell* v. *Cowley*, 1 C., M. & R. 864.

In summing up his inventory, a patentee state it thus: "My 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 against the back of such chair as above described:" Held, that this was not a claim to the principle of the lever, but to an application of that principle to a certain purpose by certain means, and that the patent was good. *Minter* v. *Wells*, 1 C., M. & R. 505; 5 Tyr. 163.

In a patent for blocks for pavement, the patentee claimed as his invention, that his block was beveled both inward and outward on the same side of the block; but the specification did not state at what angle the bevels should be made; and one witness stated that the angle was material, but another witness stated that any angle would be of some benefit: Held, that if the jury thought that a bevel at any angle would be beneficial, the specification would be good, although it omitted to state any particular angle at which the bevels should be made. *Macnamara* v. *Hulse*, Car. & M. 471—Abinger.

The specification of a patent granted for improved arrangements for raising ships' anchors, and other purposes, claimed, as the invention of the patentee, a cable-holder, which was described thus: "The scolloped shell in which the iron chain cable appears in the drawing is upon a new plan, to hold without slipping a chain cable of any size, as shown by the opening form of the scollops at the top and bottom of figure 2." It also claimed "the new form of a scolloped shell (as shown in figure 2), in conjunction with the arrangements hereinbefore described." A drawing attached to the specification showed that the inner sides of the cable-holder, on which the scollops were shown, were not to be parallel, but should converge toward the center of the cable-holder; but the angle formed by the sides of the cable-holder, as shown in the drawing, was not the precise angle which practically would be used. The specification and drawings would enable a competent workman to make a cable-holder which would hold chain cables of different sizes. At the date of the patent a cable-holder which would hold one chain cable of any size was known: Held, that the specification was ambiguous in describing the nature of the invention, whether it was an invention of a cable-holder to hold a chain cable of any one size, or to hold chain cables of different sizes, and was therefore bad. *Hasting* v. *Brown*, 1 El. & Bl. 450; 17 Jur. 647; 22 L. J., Q. B. 161.

A patent was granted for a machine to sharpen knives and scissors, and in the specification this was directed to be done by passing their edges backward and forward in an angle formed by the intersection of two circular files; and it was also stated that other materials might be used, according to the delicacy of the edges. It was proved, that for scissors there ought to be one circular file and a smooth surface, but that two Turkey stones might also succeed: Held, that the specification was bad, as it neither directed the machines for scissors to be made with Turkey stones, nor to be made with one circular file and a smooth surface. *Felton* v. *Greaves*, 3 C. & P. 611—Tenterden.

A patent was taken out for improvements in evaporating sugar. The specification was as follows: "My invention consists in a method or apparatus by which I am enabled to evaporate

liquids and solutions at a low temperature. And my invention and improvement consist in forcing, by means of bellows, or any other blowing apparatus, atmospheric or any other air, either in a hot or cold state, through the liquid or solution subjected to evaporation; and this I do by means of pipes, whose extremities reach nearly (or within such distance as may be found most suitable under peculiar circumstances) to the upper or interior area of the bottom of the pan or boiler containing such liquid or solution, the other extremities of such pipes being connected with larger pipes, which communicate with the bellows or other blowing apparatus, which forces the air into them." The lesser pipes were to be equally distributed, and their lower ends on a level with each other. It was further declared, that the form of the apparatus might be varied, provided the essential properties were maintained: Held, that, taking the whole of the specification together, it appeared that the invention consisted of the particular method or process of forcing, by means of bellows, etc., air through the liquid subjected to evaporation, viz., by pipes connected with larger pipes, and placed as mentioned in the specification; and, therefore, that it was not void because another patent had been before granted to other persons for effecting the same object by a coil of pipes (lying at the bottom of a vessel), perforated with small holes, or by a shallow cullender placed at the bottom of the vessel. *Hullet* v. *Hague*, 2 B. & Ad. 371.

The specification of a patent for "a process or method of combining various materials, so as to form stuccoes, plasters, and cements, and for the manufacture of artificial stones, marbles, etc., used in buildings," after stating the invention to consist in producing certain hard cements of the combination of the power of gypsum, powder of limestone and chalk, with other materials, such combination being (subsequent to their mixing) submitted to heat, described the method or process of making a cement from gypsum, to consist in mixing with powdered gypsum strong alkali (ex. gr. best American pearlash) dissolved in a certain proportion of water, this solution to be neutralized with acid (sulphuric acid being the best), the mass to be kept in agitation, and the acid to be added gradually till the effervescence should

cease; and then a certain proportion of water to be added (if other alkali were used, the quantity to be varied in proportion to its strength); and the mixture having been brought to a proper consistence by the further addition of powdered gypsum, to be dried in molds, and finally subjected to a furnace capable of producing a red heat. The description of making the cement differed little from that of the preceding process. The specification after proceeding to state the mode of using the cement so made, concluded by stating, that other alkalies and acids besides those before mentioned would answer the purposes of the invention, though not so well, and that the inventor claimed the method or process thereinbefore described: Held, that the specification was bad, for that either the inventor claimed all acids and alkalies, or only those which would answer the purpose; in the former of which cases, as some acids and alkalies would not answer the purposes of the invention, the specification was therefore bad; and in the latter it was bad, for not specifying those acids and alkalies which would be found to succeed. *Stevens* v. *Keating*, 2 Exch. 772; 19 L. J., Exch. 57.

A specification of a patent for "improvements in the process of hosiery and other goods manufactured from lambs' wool," stated the invention to consist in submitting the hosiery, and other similar goods, "to the finishing process of a press heated by steam, etc., in the manner hereinafter mentioned." A description was given, by letters, of a drawing, which represented a press, which consisted of a box heated by steam, up to which another box, similarly heated, was to be pressed by means of hydraulic pressure, or by screws or other well-known means. After describing the method of pressing the goods between these hot boxes, the specification concluded by confining the inventor's process as above described: Held, that a method of finishing hosiery goods, by passing them through heated rollers, was not included in his patent, and, therefore, was no infringement of it. *Barber* v. *Grace*, 1 Exch. 339; 17 L. J., Exch. 122.

Patent for the invention of a nipping lever for causing the rotation of wheels, shafts, or cylinders, under certain circumstances. The specification claimed as the invention "the nipping lever, with its tusk and sliding-box, applied to a rimmed

wheel, or to a rimmed flange, for the purpose of causing the same to rotate or move together any shaft, cylinder, or other suitable machinery which may be attached thereto." The nipping lever was not new; but the application of it by means of the sliding-box was new: Held, that it must also appear that the use of sliding-boxes was essential to the invention. *How* v. *Taunton*, 9 Jur. 1056—Q. B.

Patent for a new or improved method of drying and preparing malt. In the specification it was stated, that the invention consisted in exposing malt previously made to a very high degree of heat; but it did not describe any new machine invented for that purpose, nor the state, whether moist or dry, in which the malt was originally to be taken for the purpose of being subjected to the process; nor the utmost degree of heat which might be safely used; nor the length of time to be employed; nor the exact criterion by which it might be known when the process was accomplished: Held, that the patent was void, inasmuch as, first, the specification was not sufficiently precise; and as, secondly, the patent appeared to be for a different thing from that mentioned in the specification. *Rex* v. *Wheeler*, 2 B. & A. 345.

Held, also, as the word "malt" was here not to be taken in its usual sense, viz., of an article used in the brewing, but only in the coloring of beer, that in the patent it was necessary to have stated the purpose to which the prepared malt was to be applied, and to have said that it was obtained for a new method of drying and preparing malt to be used in the coloring of beer. *Ib.*

A patent was granted for an invention of certain improvements in extracting sugar or syrups from cane juice and other substances containing sugar. The specification stated the invention to consist "in a means of discoloring syrups of every description by means of charcoal produced by the distillation of bituminous schistus, or mixed with animal charcoal, and even of animal charcoal alone." The discoloration was to be produced by means of a filter made of the charcoal, and that there was nothing particular in the carbonization of the bituminous schistus, "only it is convenient before the carbonization to separate the

sulphurets of iron which are mixed with it?" The specification said nothing as to any previous operation on the syrup before it was submitted to the filter, but it did state that syrup, in a proper state, might be obtained by a mixture of sugar and water: Held, that the patentee sufficiently specified his invention, upon proof that it was applicable with advantage to the syrup after it had undergone a certain degree of heat, though it failed when applied to the first drawings of syrup, and that a discoloration of such syrup and of syrup of sugar and water, warranted the title of improvements "in extracting sugar or syrup from cane juice." *Derosne* v. *Fairie*, 2 C., M. & R. 476; 3 Tyr. 393; 1 Gale, 109.

Specification—New Process.]—A patent may be sustained though each principle or process in it was previously well known to all persons engaged in the trade to which the patent relates, provided that the mode of combining these processes was new, and produced a beneficial result, and provided, also, that the specification claimed not the old processes, or any one of them, but only the new combination. *Cannington* v. *Nuttall*, 5 Law Rep., H. L. 205.

A person having a patent for improvements in gas lamps, made further improvements in such lamps, and obtained a patent for the subsequent improvements. The specification to the second patent stated that the invention related to the construction of lamps of a class forming the subject of the former patent, and then described the mode of making the improved parts of the lamp: Held, that the specification was sufficient. *Parkes* v. *Stevens*, 18 W. R. 233; 22 L. T., N. S. 635; 5 L. R., Chanc. 36.

10. Specification or Claim larger than Invention.

In order to establish the validity of a patent for an improvement or a discovery, it should be stated in substance what is set out in detail in the specification; and if it is taken out for more than is strictly the inventor's own addition or improvement, or for discovery, when it is merely an addition or an improvement, it is bad. *Hill* v. *Thompson*, 2 Moore, 424; 8 Taunt. 375; Holt, 636; 3 Mer. 629.

A patent "for an improved mode of lighting cities, towns, and villages," is not supported by a specification describing an improved lamp. *Cochrane* (*Lord*) v. *Smethurst*, 1 Stark. 205—Le Blanc.

So, a patent for an improvement in the construction of ship's anchors, windlasses, and chain-cables, can not be supported, unless there is novelty in each invention. *Brunton* v. *Hawkes*, 4 B. & A. 541.

Where a patent was obtained for "a new and improved method of making and manufacturing double canvas and sail cloth with hemp and flax, without any starch whatever," and the specification described the invention to consist in an improved texture, or mode of twisting the threads, to be applied to the making of unstarched cloth; on its being proved that the exclusion of starch had been before adopted: Held, that such patent was void, as being taken out for more than the patentee had really discovered. *Campion* v. *Benyon*, 6 Moore, 71; 3 B. & A. 5.

But a patent is not avoided by the specification claiming as part, but not as an essential part of the invention, something which proved useless. *Lewis* v. *Marling*, 5 M. & R. 66; 10 B. & C. 22; 4 C. & P. 52.

If a patentee sums up the principle of his invention in the specification, and that principle is not new, the patent can not be supported, though it appears that the application of the principle as described in the specification is new. *Rex* v. *Cutler*, 1 Stark. 354—Ellenborough.

A patent taken out for an invention, consisting of two distinct parts, one of which is not new, the whole is void. *Kay* v. *Marshall*, 5 Bing. N. C. 492; 7 Scott, 548; 2 Arn. 78: *S. C.*, 1 Beav. 535: in Dom. Proc., 5 Jur. 1028; 8 C. & F. 245; West, 682.

So, if a patent is taken out for several inventions, which are claimed as improvements, and one of them is not an improvement, the patent is altogether void. *Morgan* v. *Seaward*, 2 M. & W. 544; M. & H. 55; 1 Jur. 527.

A specification is defective if the patentee professes to effect

his object in one or two specified modes, or else in the other representing each as available, and it appears that one of them will effect the purpose, but the other will not. *Reg.* v. *Cutler*, 14 Q. B. 372, n.; 3 C. & K. 215.

Where a specification claimed as an invention the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acted as a counterbalance to the pressure against the back; and it appeared that A., previously to the letters patent, had made and sold chairs in which the same principle was applied, but which could not be called into action without the use of additional machinery: Held, that the patent could not be supported, as it claimed too much, and would have prevented A. from making the chairs which he had made formerly. *Minter* v. *Mower*, 1 N. & P. 595; 6 A. & E. 735; W., W. & D. 262.

A patent was granted for "improvements in the manufacture of cases or envelopes for covering bottles." The specification, after describing the apparatus, in the arrangement of which the invention was stated to consist, claimed the combination of mechanism and the making of envelopes for bottles as described: Held, that the specification was for the mode of making, and not for the envelope; and that it was, therefore, not larger than the grant. *Patent Bottle Envelope Company* v. *Seymer*, 28 L. J., C. P. 22; 5 C. B., N. S. 164; 5 Jur. 174.

A patent was taken out for "certain improvements in the doors and sashes of carriages." In the specification the patentee said, "I have shown my invention as applied to railway carriage doors and window fittings, although they are equally applicable to the doors and windows of any other description of carriage, or in any position where windows and doors are subject to jar and vibration: Held, that the claim in the specification was not larger than the title of the patent. *Oxley* v. *Holden*, 8 C. B., N. S. 666; 30 L. J., C. P. 68; 8 W. R. 626; 2 L. T., N. S. 464.

One part of an invention was described as a novel arrangement and mode of fitting and working sliding sashes, glass frames, blinds and shutters for railway and other carriages, "which consisted of a metal plate with a slot and a stud or pin working in a

groove on each side of the sash or frame, and the patentee claimed the metal fittings, and the mode of applying the same described herein as the second part of my invention:" Held, that this was a claim not for the metal fittings themselves, but for the mode of applying them, and consequently that the patent was sustained by proof that the application was new, though the stud and plate themselves were old. *Ib.*

Where a patentee, in his specification, professes to do by machinery what has never before been done by machinery, and describes the machinery by which he does it, his claim is not too large on the face of it, because it claims generally to perform the operation "by machinery."

A patentee, in his specification, described an improved ruffle or frill, and the machinery by which he proposed to make such improved ruffle, and to fasten it to a plain fabric by a single series of stiches. By his claim he claimed "the production by machinery of ruffles, and the simultaneous attachment of them to a plain fabric by a single series of stitches: Held, that the claim was not, on the face of it, too large. *Arnold* v. *Bradbury*, 6 Law Rep., Chanc. App. 706—C.

R. obtained a patent for the use of animal fibre, by preference Russian wool, or wool of a coarse texture, in the manufacture of artificial hair to be made up for ladies' head-dresses, and for upholstery, and other like purposes. Upon a bill filed to restrain an infringement of the patent: Held, that the specification was too extensive; that even the use of a new material to produce a known article could not be the subject of a patent unless some invention and ingenuity were displayed in the adaptation; that in this case a prior use of wool for the purpose was proved, and that the bill must be dismissed with costs. *Rushton* v. *Crawley*, 10 L. R., Eq. 522—V.-C. M.

II. Inspection of Provisional Specification.

By 16 and 17 Vict. c. 115, s. 2, *the commissioners of patents shall cause true copies of all provisional specifications left at the office of the commissioners to be open to the inspection of the public at such times after the date of the record thereof respectively, as the commissioners shall by their order from time to time direct.*

An application under this provision for the inspection of the provisional specification of letters patent, on the ground that the subject-matter was the same as that for which the applicant had obtained letters patent was refused. *Tolson's Patent*, 6 De G., M. & G. 422.

12. Filing.

By 15 and 16 Vict. c. 83, s. 27, *all letters patent granted under that act, save only letters patent granted after the filing of a complete registration, shall require the specification thereunder to be filed in the high court of Chancery, instead of requiring the same to be enrolled, and no enrollment shall be requisite.*

By 16 and 17 Vict. c. 115, s. 3, *a true copy, under the hand of the patentee or applicant, or agent of the patentee or applicant, of every specification and of every complete specification, with the drawings accompanying the same, if any, shall be left at the office of the commissioners of patents on filing such specification or complete specification.*

One having obtained a patent for a manufacturing machine, of which he duly enrolled a specification, afterward obtained another patent for improvements in the machine, in which the grant of the former patent was recited; and the letter patent contained the usual condition that it should be void, if the patentee did not within one month enroll a specification, particularly describing and ascertaining the nature of the invention, and in what manner the same was to be performed: Held, that a specification containing a full description of the whole machine so improved, but not distinguishing the new improved parts from the old parts, or referring to the former specification, otherwise than as the second patent recited the first, was a performance of that condition. *Harmer* v. *Playne*, 11 East, 101; 14 Ves. 133.

A clerical error in the enrollment of the specification of a patent will be amended. *Redmund, in re*, 5 Rus. 44.

A patent, dated 10th May, contained a proviso that a specification should be enrolled within one calendar month next, and immediately after the date thereof, and it was enrolled on the

10th of June following: Held, that the month did not begin to run until the day after the date of the patent, and that the enrollment was in time. *Watson* v. *Pears*, 2 Camp. 294—Ellenborough.

A patent was granted "for improvements in the manufacture of gelatinous substances, and in the apparatus to be used therein," with a proviso as to the enrollment of the specification within six months. Before the expiration of the six months, the grantee assigned all his interest in the patent. He then, by leave of the solicitor-general, disclaimed that part of the title contained in the words "and in the apparatus to be used therein," a copy of which disclaimer was filed by the clerk of the patents of England, the original having been duly certified. In an action by the assignee of the grantee for an infringement, the declaration stated the patent to have been granted for "certain improvements in the manufacture of gelatinous substances, and the apparatus to be used therein," and also stated the specification, the disclaimer, and the assignment: Held, upon an issue as to the specification of the invention being enrolled, that no objection could be taken that the apparatus specified was not new. *Wallington* v. *Dale*, 7 Exch. 888; 23 L. J., Exch. 49.

Held also, that the disclaimer by the grantee after the assignment was valid as soon as it was entered of record. *Ib.*

Held also, that the filing of a copy of the disclaimer was a sufficient compliance with the 5 and 6 Will. 4, c. 83, s. 1. *Ib.*

IV. DISCLAIMER.

By 5 and 6 Will. 4, c. 83, s. 1, *any person having obtained letters patent for any invention, may enter a disclaimer of any part of his specification, or a memorandum of any alteration therein, which, when filed, is to be deemed part of the specification.*

By 7 and 8 Vict. c. 69, s. 5, *the disclaimer and memorandum of alteration may be made notwithstanding the original patentee may have assigned his rights.*

Where a patent is originally void, but amended by filing a disclaimer of part of the invention, the above act has not a retrospective operation, so as to make a party liable for an infringement of the patent, prior to the time of entering such disclaimer. *Perry* v. *Skinner*, 2 M. & W. 471; M. & H. 122; 1 Jur. 433.

A declaration for the infringement of a patent stated a grant to the plaintiff in 1836 of letters patent for improvements in pumps, and that a specification of the same was duly enrolled within six months. It then alleged the entering by the plaintiff, in 1844, of a disclaimer of part of this title and specification, and an infringement afterward by the defendant of the patent as altered by the disclaimer. Plea, that, in 1840, after the grant to the plaintiff, and before entry of the disclaimer, a patent was granted to B., under whom the defendant was licensee, which was alleged to cover the infringement complained of: Held, that the plea was bad, upon the ground that it appeared from the record that the grant to B. was void, as being in respect of an invention already made known to the public by the enrollment of the plaintiff's specification. *Stocker* v. *Waller*, 1 C. B. 148; 9 Jur. 136.

A grantee of letters patent, who, having parted with his interest, afterward becomes assignee of a share in them, may enter a disclaimer of part of the invention, and may maintain an action for an infringement of the patent so altered. *Spilsbury* v. *Clough*, 2 G. & D. 17; 2 Q. B. 466; 6 Jur. 579.

A disclaimer will be valid, notwithstanding the grantee, at the time he entered it, had assigned all his interest in the patent. *Wallington* v. *Dale*, 7 Exch. 888; 23 L. J., Exch. 49.

The filing of the copy of a disclaimer is a compliance with the provisions of the 5 and 6 Will. 4, c. 83, s. 1. *Ib.*

In a scire facias to repeal letters patent, a disclaimer, though enrolled subsequently to issue joined, is admissible for the defendant, and is to be read as a part of the original specification put in by the prosecutor, and it is not necessary to plead the disclaimer puis darrein continuance. *Reg.* v. *Mill*, 10 C. B. 379; 20 L. J., C. P. 16; 1 L. M. & P. 695; 15 Jur. 59.

The effect of a disclaimer is merely to strike out from the specification those parts of the machinery which are disclaimed; it can not be read as explanatory of that which remains. *Tetley* v. *Easton*, 2 C. B., N. S. 706—Per Cresswell.

A disclaimer can not be made use of for the purpose of converting a barren and an unprofitable generality in a specification into a specific practical description, or to convert that which, upon the description in the specification, is not applicable to any one definite form into a description applicable to a specific and a definite mode of proceeding. *Ralston* v. *Smith*, 11 H. L. Cas. 223; 35 L. J., C. P. 49; 13 L. T., N. S. 1; 20 C. B., N. S. 28.

The object of 5 and 6 Will. 4, c. 83, is, that where a specification containing a sufficient and good description of a useful invention, is imperiled by reason of the description having something annexed to it which is capable of being severed, leaving the original description good and sufficient, without the necessity of addition (except of such slight additions only as may be required to render intelligible that which remains), the vicious excess may be lopped off by a disclaimer. *Ib.*

R., in his specification, described his patent for improvements in embossing and finishing woven fabrics, as enabling him upon a roller, either spirally or longitudinally, or in a circular form, to groove, or flute, or engrave, or mill, or otherwise indent any design. The fact was, that if the design was engraved longitudinally it would destroy the material. R., therefore, in a disclaimer, altered "upon" into "around the roller:" Held, first, that the disclaimer was bad, as it sought in effect to extend the specification, or to convert a bad specification into a good one by adding words. *Ib.*

Held, secondly, that the construction of the specification, as amended by the disclaimer, excluded spiral engraving, and confined it to circular engraving or grooves. *Ib.*

Held, thirdly, the description "or roller of hard metal, or other suitable material," was not too vague as regards material. *Ib.*

Any part of the provisional specification of a patent may be omitted in the complete specification, if there is no fraud, and the effect of the remainder is not altered by the omission. All the claiming clauses may be struck out of the specification of a patent by a disclaimer, if there remain in the body of the specification words sufficiently distinguishing what the invention is which the patentee claims. *Thomas* v. *Welch*, 1 L. R., C. P. 192; 12 Jur., N. S. 316; 35 L. J., C. P. 200.

An alteration, verbal merely, and not substantive, by means of a disclaimer, will not make a patent void. *Ib.*

A patentee claimed by his specification "the application of the principle of centrifugal force to the flyers employed in" certain machinery for roving cotton and other fibrous substances, but declared that his improvements "apply solely to such part of the machinery called the flyers which is employed in connection with the spindle for the purpose of winding cotton." He attached drawings to his specification, and went on to say that these drawings and the specification represented "one particular and practicable mode of applying" his invention, but "I do not intend to confine myself to this particular method, but I claim as my invention the application of the law or principle of centrifugal force to the particular or special purpose above set forth, that is, to flyers used in machinery for preparing cotton." He afterward disclaimed "all application of the law or principle of centrifugal force as being part of my invention, or as being comprised in my claim of invention contained in the specification, except only the application of centrifugal force, by means of a weight acting upon a presser so as to cause it to press against a bobbin, as described in the specification:" Held, that this disclaimer did not extend the claim, but confined it to a particular mode of applying the principle of centrifugal force, and did not claim the discovery of that principle, or the application of it, except in a particular way, and that therefore the patent was good. *Seed* v. *Higgins*, 4 Jur., N. S. 258; 27 L. J., Q. B. 145. Affirmed in Exch. Cham. and Dom. Proc., 27 L. J., Q. B. 411; 8 H. L. Cas. 550; 30 L. J., Q. B. 314; 6 Jur., N. S. 1262.

V. ASSIGNMENT, SALE, LICENSES, AND ROYALTIES.

I. Assignments.

Absolute.]—Where an act of parliament secured to certain persons for a further term of years the benefit arising from a patent for making a machine, with a proviso that it should become void if they should transfer or assign their interest therein to any persons exceeding the number of five; and two of the patentees became bankrupt: Held, that the assignment of their interest to their assignees for the benefit of creditors, though the number exceeded twenty, was not within the proviso. *Bloxam* v. *Elsee*, 9 D. & R. 215; 6 B. & C. 169; 1 C. & P. 558; R. & M. 187.

A voluntary assignment by a patentee of letters patent to trustees, for the benefit of creditors more than twelve in number, is not such an assignment as will avoid the patent. *McAlpine* v. *Mangnall*, 3 C. B. 496; 15 L. J., C. P. 298.

The executors of a patentee having obtained probate of their testator's will, assigned his patent to another person, but the probate was not registered till after the assignment: Held, that the assignment was valid. *Ellwood* v. *Christy*, 10 Jur., N. S. 1079; 13 W. R. 498; 11 L. T., N. S. 342; 17 C. B., N. S. 754; 34 L. J., C. P. 130.

An act of parliament empowering a bankrupt patentee, his executors, administrators, and assigns, to assign the right to a greater number of persons than allowed by the letters patent, and declared to be a public act, does not enable either the bankrupt or his assigns to make a better title than they could before the act. *Hesse* v. *Stevenson*, 3 B. & P. 565.

A., by a deed (reciting that a suit was depending between him and B. respecting certain patents, and that they could not be assigned without hazard of defeating the suit), granted absolutely the patents, together with some others, to C., excepting, however, until the determination of the suit, such patents as should be necessary to support A.'s legal title. Then followed a covenant that A., upon the determination of the suit, should assign the

excepted patents to C., and that until such assignment A. should stand legally possessed of the same: Held, that the legal interest in the excepted patents vested in C. upon the determination of the suit, without further assignment. *Cartwright* v. *Amatt*, 2 B. & P. 43.

Where a bond was given for payment of 10,000*l.*, with a condition that the money should be paid on the obligee's procuring subscriptions for 9,000 shares in a company to be formed of many persons, for the purpose of becoming assignees of a patent, and carrying on the patent process; and the patent contained a proviso, that it should be void if assigned to more than five persons: Held, that the obligee must be presumed to know of that proviso, and that, as the bond was subject to a condition for the performance of an illegal act, it was void. *Duvergier* v. *Fellows*, 10 B. & C. 826; 1 C. & F. 39; 2 M. & P. 384.

No action can be maintained on a bond given to a person in consideration of his doing something contrary to the terms of letters patent; and he is equally incapable of recovering, whether he knew or did not know the terms of the letters patent. *Ib.*

See also *Hassell* v. *Wright*, 10 L. R., Eq. 509; 18 W. R. 821; *Horsley & Knighton's Patent, in re*, 39 L. J., Chanc. 157, cited *supra*.

Agreements for.]—A declaration stated that a petition had been presented by the plaintiffs, at the request of the defendant, for the granting to the defendant of a patent; that the plaintiffs had filed a provisional specification, at their own expense, upon condition that the defendant should complete the specification within six months, and that afterward it was agreed that the defendant should sell to the plaintiffs his right in respect of the patent for 5*l.*, to be paid by the plaintiffs to the defendant on their having completed at their own expense the patent; that it thereupon became necessary, in order to enable the plaintiffs to complete the patent in pursuance of the agreement, that the defendant should sign and seal a complete specification; that the plaintiffs tendered to the defendant a complete specification for his signature. Breach, that he would not sign it: Held, that he was bound to sign the specification. *Lewin* v. *Brown*, 14 W. R. 640—C. P.

A defendant signed a written proposal that the plaintiff should assign a patent in trust for an institution of which the defendant was manager, and the plaintiff was to have 5*l.* per cent. upon the profits made thereby, and the defendant was to provide for the next payment to be made in respect of the patent; and that if the payments did not equal a certain sum in the first and subsequent years, the plaintiff should have the right, upon giving a month's notice, and repaying any moneys made to keep up the patent, to reclaim it, unless the deficiency in the year was made up within the month; and in case of the institution not being carried on, the patent was to revert to the plaintiff, subject to repaying any moneys paid to keep it up. The plaintiff assented by word of mouth to the proposal, and allowed the institution to have the use of the patent, and otherwise fulfilled the terms of the agreement: Held, that it sufficiently appeared from the agreement that what the plaintiff had to do was not intended to be postponed beyond the year, and therefore it was not within the 4th section of the Statute of Frauds; and that if it was within that section, the proposal signed by the defendant, and accepted by word of mouth by the plaintiff, was sufficient to satisfy the statute. *Smith* v. *Neale*, 2 C. B., N. S. 67; 3 Jur., N. S. 516; 26 L. J., C. P. 143.

To a declaration alleging a contract for the assignment by the plaintiff of the letters patent in trust for the institution, and upon the terms contained in the proposal of the defendant, the defendant pleaded non concessit: Held, that the contract involved no warranty by the plaintiff that the invention was new, or that the manufacture was within the statute of James, and that therefore the plea put in issue no more than the grant of the letters patent which the plaintiff contracted to assign. *Ib.*

An agreement was entered into between four persons who were interested in patents and inventions relating to gutta percha, that all patents taken out, or in the course of being taken, or intended to be taken out, or that might at any time thereafter be taken out by any or either of them, or on account of and for the benefit of any or either of them in relation to the preparation and application of gutta percha, or the manufacture of

any article therefrom, should be assigned to trustees, and held for their common benefit. Subsequently one of the parties took out a patent for "improvements in apparatus and machinery for giving shape and configuration to plastic substances," and refused to assign the patent to the trustees, alleging that it was not comprised in the agreement: Held, that the patent, so far as it related to gutta percha, was subject to the trusts of the agreement, and that it could not be treated as not being so, because it was for machinery which might be applied to the manufacture of articles of gutta percha, and was not for the manufacture of any such articles. *Bewley* v. *Hancock*, 6 De G., M. & G. 391; 2 Jur., N. S. 289.

A covenant, by a licensee for the residue of a term of fourteen years, of patented improvements in machinery for slubbing fibrous substances, not to make or send any slubbing frames whatever without the invention applied to them, is not void as a covenant in restraint of trade. *Jones* v. *Lees*, 1 H. & N. 189; 2 Jur., N. S. 645; 26 L. J., Exch. 9.

2. Licenses to Use and Vend.

The grant of an exclusive license to use a patent does not invalidate the patent itself, although the patent may be vested in twelve persons; and it is wholly immaterial to its validity in what number of persons such a license is vested, whether exclusive or not. *Protheroe* v. *May*, 5 M. & W. 675.

Such a license would not be invalid if the districts or district covered by the license included the whole extent of the patent. *Ib.*

While a person is using, under a license, a patent machine and paying a royalty for its use, or the use of its principle embodied in any other machine, he can not, in a proceeding against him for non-payment of royalties in respect of the use of another machine alleged to embody the principle of the patent invention, set up as a defense that the patent is not valid. He can only be allowed to contend that the second machine does not embody the principle of the patent. *Crossley* v. *Dixon*, 10 H. L. Cas. 293; 9 Jur., N. S. 607; 32 L. J., Chanc. 617; 11 W. R. 716; 8 L. T., N. S. 260.

A license to A. to manufacture a patent article is an authority to his vendees to vend it without the consent of the patentee. *Thomas* v. *Hunt*, 17 C. B., N. S. 183.

A licensee under another's patent is not estopped thereby from contesting the novelty of such patent. *Dangerfield* v. *Jones*, 13 L. T., N. S. 142—V.-C. W.

A., asserting that he had a right to a patent machine, covenanted with B. that he should use it in a particular manner, in consideration of which B. covenanted that he would not use any other; in an action by A. on the covenant, B. is not estopped by his covenant from pleading in bar to the action, that the invention was not new, or that the patentee was not the inventor: but he may thus show that the patent was void. *Hayne* v. *Maltby*, 3 T. R. 438.

But in an action by the assignee of the patentee against the patentee, the latter is estopped from showing that it was not a new invention against his own deed. *Oldham* v. *Langmead*, 3 T. R. 439—Kenyon.

Where a license to use certain patent machines is granted by indenture, in which it is recited that the grantor has invented the machines, and has obtained letters patent for the sole use of the invention, and enrolled the specification, parties (and privies) to the deed are estopped from pleading either that the invention is not a new invention, or that the grantor was not the first inventor, or that no specification was enrolled. *Bowman* v. *Taylor*, 4 N. & M. 264; 2 A. & E. 278; *S. P. Smith* v. *Scott*, 5 Jur., N. S. 1356; 28 L. J., C. P. 325; 6 C. B., N. S. 771.

Action for the price of a license, granted by the plaintiff to the defendant, to use an invention for a patent furnace. The plaintiff, having obtained the patent, granted the defendant a license, which was in writing, but not under seal, to use the patent; and the defendant, having received the license, kept it, and used the invention, but when called upon to pay the price agreed upon, objected to pay for it, on the ground that it was void, as not being under seal. By the terms of the letters patent all persons were commanded not to "make, use, or put in practice the invention, or any part of the same, nor in anywise

counterfeit, imitate, or resemble the same, nor make, or cause to be made, any addition thereunto or subtraction from the same, whereby to pretend himself or themselves to be the inventor or inventors, devisor or devisors thereof, without the license, consent, or agreement of the patentee, in writing, under his hand and seal, first had and obtained, upon pain of a contempt of the royal command, and of being answerable to the plaintiff in damages:" Held, first, that the defendant, having obtained the license he had bargained for, and kept it, was bound to pay for it. *Chanter* v. *Dewhurst*, 12 M. & W. 823; 13 L. J., Exch. 198.

Held, secondly, that the license was not void, as not being under seal. *Ib.*

N. obtained a patent for the application of the principle of smelting iron by the use of heated air applied to furnaces. B. obtained a license from him to use this process, on the payment of 1*s.* per ton on the iron thus smelted. Disputes, and then litigation, arose between them, and it was agreed, by an instrument in writing, dated 11th November, 1833 (which recited the previous circumstances), that both parties should withdraw their law proceedings; that "in consideration of the payment of 400*l.*, to be accepted by N. in full of 1*s.* per ton on the whole iron smelted from the erection of B.'s works up to the 11th day of November, and in consideration of the payment of 1*s.* per ton upon the whole iron which shall be smelted from the 11th of November till the expiration of the letters patent, by the use of heated air in any of the modes heretofore applied, or in any other mode falling under the said patent," N. should grant to B. a license, which was described to relate to "the application or use of heated air in any of the modes heretofore practiced at B.'s works, or in any other mode falling under the description in the said patent, or in the specification thereof." N. afterward instituted a suit to compel B. to perform this agreement. B. instituted a cross suit to suspend N.'s proceedings, on the ground that the process of smelting by heated air used at B.'s works did not fall within the patent: Held, that after this agreement, B. could not set up such a defense to the claim of N. *Baird* v. *Neilson*, 8 C. & F. 726.

By articles of agreement under seal reciting that letters patent had been granted to the defendant, for improvements in purifying gas, and other letters patent had been granted to the plaintiff for an improved mode of manufacturing gas, and that disputes had arisen between the parties as to their rights under the letters patent to the use of oxides of iron for the purpose of purifying gas, and that a scire facias had been sued out by the plaintiff to repeal the letters patent granted to the defendant, and that another patent for purifying coal gas by oxide of iron had been applied for by the defendant, and that other letters patent had been sued out by the plaintiff, and that in order to put an end to their differences the parties had entered into that agreement; the defendant covenanted with the plaintiff, and the plaintiff agreed that the defendant should have the exclusive use of the inventions granted to the plaintiff, so far as the same related to the purification of gas by the hydrated oxides of iron, paying therefor certain royalties; that the plaintiff should have the exclusive use of the inventions granted to the defendant so far as the same related to the purification of gas by anhydrous oxides of iron, paying therefor certain royalties; that for the purpose of that agreement and the determination of the amount of royalties, it should be assumed that the defendant was entitled to the exclusive use of anhydrous oxides, and the plaintiff entitled to the use of hydrated oxides. The agreement also provided that in case of any breach of certain stipulations, the party so doing should pay to the other a certain sum as liquidated damages. In an action to recover that sum the defendant pleaded the plaintiff's patents were not valid, that the inventions were not new, and that the plaintiff was not the first inventor: Held, that the pleas were bad, inasmuch as the defendant was estopped by the agreement from disputing the validity of the patents. *Hills* v. *Laming*, 9 Exch. 256; 23 L. J., Exch. 60.

Action by assignee of H., original patentee, for an infringement of a patent. Plea, a license, by deed, from H. to S. and A., and to such persons as they should from time to time license or authorize, to make, use, and vend the invention in Great Britain and Ireland; and that S. and A. assigned to the defendant all the liberty and license granted to them by the deed.

Replication, on equitable grounds, that by deed of even date with the deed of license from H. to S. and A., and made between H. of the first part, the plaintiff and five other persons of the second part, and S. and A. of the third part, reciting that under arrangements between H. and the parties of the second part, the parties of the second part were entitled to participate in the profits to be derived from the letters patent, and that S. and A. had contracted with the parties of the first and second parts for the purchase of a license for the exclusive use of the invention, and that the contract was carried out by the deed of license, it was witnessed that each one of the parties covenanted that S. and A. should not manufacture machines under the license for sale out of Great Britain and Ireland; of all which the defendant, before the assignment to him of the license, had notice: that afterward, by deed between S. and A. and the defendant, reciting the grant of the license, and the making of the deed of even date therewith, and that in the deed were contained covenants on the part of the parties thereto with respect to the license, and that by deed of even date S. and A. assigned the license to the defendant, the defendant covenanted that he would perform all the covenants in the secondly-recited deed contained on the part of S. and A. to be performed, and would indemnify S. and A. from all actions for breach of the covenants: Held, that the deed of covenant not to manufacture for sale out of Great Britain and Ireland was no answer to the license, and that therefore the replication was not good at law, nor upon equitable grounds. *Schlumberger* v. *Lister*, 6 Jur., N. S. 1336; 9 W. R. 138; 3 L. T., N. S. 549; 2 El. & Bl. 870; 29 L. J., Q. B. 157.

3. Sale.

Of Part.]—The sale of a moiety of a patent right conveys an interest pro tanto in the patent. *Walton* v. *Lavater*, 6 Jur., N. S. 1251; 29 L. J., C. P. 275; 3 L. T., N. S. 272; 8 C. B., N. S. 162.

Consideration and Parties.]—By an agreement, not under seal, between the plaintiff and A., B. and C. of the one part, and the defendant of the other part, reciting that the plaintiff had ob-

tained a patent for an improvement in furnaces, and was solely interested in another patent invention; that the plaintiff and A. had obtained a patent for another invention; the plaintiff and B. for another; and the plaintiff and C. for another; it was agreed between the parties, that, for the considerations therein mentioned, it should be lawful for the defendant exclusively to use, manufacture, and sell any or all of the patent inventions, within certain limits, during the continuance of the several patents, on certain terms specified in the agreement. In an action on this agreement by the plaintiff alone, to enforce one of such terms, the defendant set out the plaintiff's patent for the improvements in furnaces, and pleaded that it was not, at the time of the grant, a new invention as to the public use thereof in England, whereby the grant was void, which the plaintiff, at the time of making the agreement, well knew: Held, that the plea was a bar to the action. *Chanter* v. *Leese*, 4 M. & W. 295; 1 H. & H. 224; *S. C.* (in error), 5 M. & W. 698, affirmed.

Held, also, that the declaration was bad, on the ground of variance, as it stated the agreement to be made between the plaintiff and defendant, whereas there were other parties to it of the first part besides the plaintiff. *Ib.*

Brown being patentee of an engine, Broadhurst bought a license of him to erect it in Cornwall only. Ridgway, by agency of Brown, contracted with Brown & Co. to erect such an engine in Cambridgeshire, Brown telling Ridgway that Philip and Broadhurst were his partners. During the building of the Cambridgeshire engine, Broadhurst frequently came to inquire how it went on, and when it would be finished. After the engine had failed in its object, Ridgway, previously to suing Philip and Broadhurst, inquired from Broadhurst if Brown had been correct in declaring that Broadhurst and Philip were his partners; to which he answered that he had. He then sued Philip and Broadhurst. The jury having found a verdict for them, on the ground that Broadhurst was not a partner, the court refused to set it aside and grant a new trial. *Ridgway* v. *Philip*, 1 C., M. & R. 415; 5 Tyr. 131.

By an agreement, after reciting that the plaintiff had invented a method for preventing boiler explosions, and that he had ob-

tained a patent for the use of it, and that he was desirous of disposing of half his interest in such patent, to which he declared he had full right and title, and that he had applied to the defendant to purchase such half of his interest in such patent, it was stipulated that the defendant should pay to the plaintiff 2,500*l.*, "in such manner as shall be mutually agreed on;" and, in consideration of such engagement, the plaintiff agreed to make over, and accordingly made over, to the defendant one-half of the patent. In an action on this agreement the plaintiff assigned three breaches; first, that the defendant did not pay the 2,500*l.* on request; secondly, that he refused, after the lapse of a reasonable time, to make any agreement with the plaintiff respecting the manner in which the money was to be paid; and, thirdly, that he refused to fix any time at which the money should be paid: Held, that the second breach was good, as, even if the agreement as to the mode of payment was a condition, the defendant, by refusing to enter into any agreement, had rendered the performance of it impossible. *Hall* v. *Conder*, 2 C. B., N. S. 22; 3 Jur., N. S. 366; 26 L. J., C. P. 138.

Held, that by the agreement the plaintiff did not profess to sell, nor did the defendant profess to buy, a good and indefeasible patent right, but only the moiety of the patent, such as it was; and that as there was also no express or implied warranty of title or quality, it was no answer to the breaches to plead that the invention was wholly worthless and of no public utility, and not new, and that the plaintiff was not the first and true inventor. *Ib.: S. C.*, affirmed on appeal, 3 Jur., N. S. 963—Exch. Cham.

A declaration stated that, by deed, the plaintiff sold certain letters patent to the defendants, and they covenanted to pay the price by installments; provided, that if within twelve months from the date of the deed they should disapprove of the patent, and of their disapprobation and intention to sell if they should give notice to the plaintiff, the payment of the installments should be suspended; and if they should within six months after notice sell the patent, and, retaining to themselves 246*l.*, pay over the surplus to the plaintiff, the covenant for payment of the entire sum should cease. But if they having given such

notice, should neglect or refuse to observe all the other matters in the proviso, the covenant for payment of 840*l.* should stand. Averment, that the defendants gave due notice of their disapprobation, and of their intention to sell, and that the defendants had not sold the letters patent. Breach, non-payment of the installments. Plea, that the defendants were ready and willing, and endeavored to sell the letters patent, but that no bona fide sale could be effected: Held, that the defendants, not having sold the letters patent, were liable to pay the installments. *Cherry* v. *Heming*, 2 Exch. 557; 17 L. J., Exch. 305.

Action for money payable by the defendant to the plaintiff, due by agreement, in respect of a manure manufactured or sold by the defendant pursuant to the plaintiff's permission, such manure having been manufactured by means of the use of an invention mentioned in letters patent granted to the plaintiff. Plea, that at the time of the agreement, and since, the letters patent were void; that the defendant was, before and at the time of the agreement, entitled as of right, and without permission of the plaintiff, to use the invention and sell the manure; and there was not any consideration for the agreement: Held, that the action was upon an executed consideration, and that the plea was no answer. *Lawes* v. *Purser*, 6 El. & Bl. 930; 3 Jur., N. S. 182; 26 L. J., Q. B. 25.

A. having obtained a patent for an invention, of which he supposed himself the inventor, agreed to let B. use it upon payment of an annual sum secured by bond; this sum was paid for several years, when B. discovering that A. was not the inventor, but that it was in public use before A. obtained his patent, brought an action to recover back the amount of the annuity paid: Held, that he could not recover. *Taylor* v. *Hare*, 1 N. R. 260.

By an agreement, after reciting that the plaintiff had lately invented an improved composition or material to be employed in waterproofing or rendering woven fabrics impervious to moisture, for which he had duly obtained provisional protection, and had obtained a certificate of protection, it was agreed between them for the considerations therein mentioned, and in consideration of a further sum of 350*l.* to be paid on the completion of the

necessary specification and grant of the letters patent, to transfer and make over to the defendant all his interest in the invention or improvement thereof, and all benefit to be derived from the provisional protection, or from any letters patent to be thereafter granted for the invention. In an action on this agreement to recover the 350*l.* the defendant pleaded that the plaintiff had not invented an improved composition or material to be employed in waterproofing or rendering woven fabrics impervious to moisture: Held, that the plea was bad. *Smith* v. *Buckingham*, 18 W. R. 314; 21 L. T., N. S. 819—Q. B.

4. Royalties.

One who makes a patent article under a license from the inventor, can not, in an action against him for royalties, set up any objection to the novelty or utility of the invention, or the validity of the specification; but, if the claim in the specification is susceptible of two constructions, one of which would make the specification bad, and the other and more natural one would make it good, it is competent to him to insist that the latter is the true construction. *Trotman* v. *Wood*, 16 C. B., N. S. 479.

Payment of royalties on letters patent can not be refused on the ground of want of novelty in the invention. *Noton* v. *Brooks*, 7 H. & N. 499; 8 Jur., N. S. 155; 10 W. R. 111.

A declaration stated that on the 16th of March, 1858, an agreement was made between H. and the plaintiff that a patent of the plaintiff's for an alloy should be assigned to H., H. paying to the plaintiff, by way of royalty, 1*d.* per pound for each pound of alloy made or used by him under the letters patent during the existence of the letters patent, the royalty to be accounted for every six months after the date of the letters patent, or from making any of the alloy, with a covenant for further assurance by the plaintiff that, on the 13th of November, 1858, by deed, between the plaintiff and H., the letters patent were assigned to H., subject to the payment of the royalty upon every pound of alloy which should be manufactured by H., and H. covenanted to pay 1*d.* per pound for each pound of the alloy which he should make or sell; that on the 17th of December, 1858, the defend-

ant, in consideration of 250*l.*, agreed to purchase the right of the plaintiff, "in an agreement entered into with H., dated March, 1858, to receive a royalty of 1*d.* per pound on the metal sold under the patent specified therein; the second installment to be paid continually; otherwise the 250*l.* to be paid on the 23d proximo to be considered as full purchase money for the plaintiff's right in the agreement." Breach, that the defendant had not paid the 250*l.* A plea set out the deed of November 13th, which reciting that the plaintiff had agreed to assign the patent to H., H. paying 1*d.* per pound on the alloy which he should manufacture and vend, the plaintiff assigned to H., subjected to the payment of a royalty of 1*d.* per pound on every pound of alloy manufactured by him, to be ascertained in manner and at the times therein mentioned. And H. covenanted to pay a royalty of 1*d.* per pound on every pound of alloy which he should make and sell, to be paid quarterly, the first payment to be made on the quarterly day next after the vending of any of the alloy; and, for the purpose of ascertaining the quantity sold, to keep an account of the quantity made and vended, provided that if H. neglected to supply any person desirous of purchasing alloy, it should be lawful for the plaintiff to manufacture and vend the alloy, and use the invention for his own use; that the plaintiff accepted the deed and agreement thereon in the place of the previous agreement, and exonerated H. from any further performance of the agreement; that the defendant, when he entered into the agreement, had no knowledge of the deed or of the exoneration of H.; that the defendant meant to buy the royalty under the agreement, and not under the deed; and that he had no knowledge of the provision in the deed that the plaintiff was to be at liberty to make the alloy for his own use. Replication, that before action the defendant had notice of the deed, and did not, within a reasonable time, repudiate or give any notice to the plaintiff of his intention to repudiate his agreement: Held, first, that the plea was a good answer to the action, inasmuch as it showed that the plaintiff had, by the deed, incapacitated himself from giving to the defendant that which he had bought. *Webster* v. *Newsome*, 5 H. & N. 42.

Held, secondly, that the replication was bad. *Ib.*

A patentee of an invention for improved beaters for threshing machines, granted a license to C. to make, manufacture, and sell machines, as described in the specification, for a term of years, and during the period to apply the invention to other machines made, or to be made, paying a royalty of 1*l.* for every threshing-machine manufactured by them, and the like sum for every machine made, or to be made, to which the invention should be wholly or in part applied by them; and they covenanted to affix royalty plates to every new and altered machine which should be manufactured or applied by them: Held, that C. was not intended to pay the royalty merely on every threshing machine, but that the true construction of the license was, that they were to pay on all beaters manufactured by C. according to the patent, and applied to machines originally, or by way of renewal. *Goucher* v. *Clayton*, 11 Jur., N. S. 462; 13 L. T., N. S. 111—V.-C. W.

A declaration set out an indenture, containing a license from A. (the patentee) to B., his executors, administrators, and assigns, to make and sell certain iron pipes, yielding and paying to A. a royalty of —*l.* for every ton of pipes which B., his executors, etc., should make and sell in pursuance of the license, but such patent rent to be paid on or before the twenty-first day after each quarter; and B. covenanted with A. that he would, seven days after each quarter, deliver to A. an account of pipes sold within the quarter, and would within twenty-one days after the quarter pay to A. the money as should, upon the face of such account, be payable by way of royalty. The declaration, after setting out an assignment of the patent license from B. to the plaintiff, ultimately showed an assignment of the license to R. and M., in trust for the defendants, with a covenant by the defendants with the plaintiff to pay the money and perform the covenants payable and to be performed in respect of the license, and that the defendants made and used, in pursuance of the license, iron tubes, and that thereby sums of money became payable to A. in respect of the license. Breach, non-payment by the defendants of the sums of money; and further, non-delivery of a true account in writing of the quantity of iron tubes sold: Held, that the declaration contained a good breach, the

covenant to render an account being auxiliary to the covenant to pay, and the defendants being shown to be the licensees of A., and to have made the pipes under such license. *Bower* v. *Hodges*, 17 Jur. 1057; 22 L. J., C. P. 194; 13 C. B. 765.

In a deed by which A. assigned to B., for a term of years, an exclusive license to use a patent after covenants for payment of sums in the nature of royalties, there was the following clause: "That if it shall happen in any year during the term that the royalties or sums of money covenanted to be paid shall not amount to 2,000*l.*, then B. shall, within fourteen days after the expiration of any year in which it shall so happen, pay to A. such a sum of money as with the royalties will amount to 2,000*l.* for that year; or if B. shall at any time make default in payment of such sum within the time appointed for payment, then it shall be lawful to and for A., by writing signed by him, and indorsed on the deed or duplicate thereof, to declare that the deed, and the license and power thereby granted, shall cease and determine:" Held, that this was not an absolute covenant by B. to pay 2,000*l.* a year during the term, but only empowered A. to put an end to the grant upon non-payment of that sum. *Tielens* v. *Hooper*, 5 Exch. 830; 20 L. J., Exch. 78.

By an indenture reciting that by a deed, the plaintiff licensed the defendant to use his patent during a term, paying a stated royalty. By the deed declared upon, reciting the earlier deed, and a subsequent contract of the defendant with the plaintiff for purchase of half the patent, subject to the former deed, but with benefit to the defendant of half the royalty, the plaintiff, in pursuance of the contract, and in consideration of 2,200*l.* to be paid to him by the defendant, assigned the patent to a trustee, subject to the previous indenture, and in trust to apply the sums accruing from licenses to use the patents, and likewise to apply the royalties for or under the direction of the plaintiff and defendant, in specified proportions, and to stand possessed, as to one moiety of the letters patent, for the plaintiff, as to the other for the defendant. The plaintiff covenanted that for and notwithstanding anything done by him, the patent was valid, and should be held and enforced by the trustees without lawful let by the plaintiff, or any claiming under him, or by his act and

default; and the defendant covenanted with the plaintiff to pay him the 2,200*l.* by installment. To a declaration for non-payment of such installments, the defendant pleaded, that the plaintiff was not the first inventor, by reason whereof the patent, before the supposed breach of covenant, was void: Held, that the plea was bad; for first, no eviction was stated; and in fact, the matter pleaded did not go to the whole consideration, since, even if the patent was void, the first executed deed would have bound the defendant by estoppel to payment of the royalty; and by the latter deed he became entitled to half the royalty; and secondly, that the covenant to pay the 2,200*l.* was an independent covenant, and capable of being enforced whether the plaintiff's covenants were performed or not. *Cutler* v. *Bower*, 11 Q. B., 973; 12 Jur. 721; 17 L. J., Q. B. 217.

VI. INFRINGEMENT.

1. What is an Infringement.

Where a patent is for an invention consisting of several parts, the imitation of any part of the invention is an infringement of the patent. *Smith* v. *London and Northwestern Railway Company*, 2 El. & Bl. 69; 17 Jur. 1071.

A declaration stated, that certain persons, through whom the plaintiffs claimed, were "the inventors of certain improvements in giving signals and sounding alarms in distant places by means of electric currents transmitted through metallic circuits;" and that the defendants had "wrongfully used and put in practice the said invention." In the title of the patent and in the specification the electric currents were throughout described as being transmitted through metallic circuits, but no claim was made to metallic circuits as a substantive invention: Held, first, that the finding of the jury of an infringement in respect of one of the improvements was a sufficient finding of the infringement alleged in the declaration. *Electric Telegraph Company* v. *Brett*, 10 C. B. 838; 15 Jur. 579; 20 L. J., C. P. 123.

Held, secondly, that inasmuch as the patentees, by the specification, made no claim to metallic circuits, but only an improved method of using the electric currents, the specification

must be considered as comprising all circuits which are metallic, as far as it is material to the improvements claimed; and that, therefore, any infringement of such improvements, although the electric current should not be wholly transmitted through a metallic circuit, was an infringement of the patent. *Ib.*

Held, thirdly, that whatever might have been the case if the method of transmitting the electric current adopted by the defendants had been publicly known at the time of granting the patent, yet that the title gave sufficient notice to any person secretly acquainted with that discovery. *Ib.*

Where, in an action for infringing a patent for blocks for pavement, the plaintiff claimed as his invention that his block was beveled both inward and outward on the same side of the block, and it was alleged that the defendant's blocks were an imitation of the plaintiff's as two of the defendant's blocks were equivalent to one of the plaintiff's: Held, that it was for the jury to say whether the defendant's blocks were, in effect, the same as the plaintiff's, although no single block of the defendant's was beveled both inward and outward on the same side. *Macnamara* v. *Hulse*, Car. & M. 471—Abinger.

The question of infringement or not is for the jury and not for the judge, although there is no question with respect to whether the defendant has or has not used the particular machine or process which is alleged to be an infringement. *De la Rue* v. *Dickinson*, 7 El. & Bl. 738; 3 Jur., N. S. 841.

The specification of a patent for an invention of "improvements in the manufacture of envelopes," described a machine in which a piece of paper was held upon a platform, whilst the flaps of the envelope were folded, and concluded by claiming "the so arranging machinery that the flaps of envelopes may be folded thereby, as herein described:" Held, that a machine in which flaps of an envelope were folded might be an infringement of the patent, although the envelope was not held down during the operation of folding. *Ib.*

The specification of a patent for an invention with a similar title, described and claimed "the application of gum or cement to the flaps of envelopes by apparatus acting in the manner of

surface printing:" Held, that an apparatus for applying the gum might be an infringement, although it acted only in part in the manner of surface printing, according to the description contained in the specification. *Ib.*

The precipitation of animal and vegetable matter from sewage water, by means of byrate of lime, for agricultural purposes, is a good subject-matter for a patent; and if another person uses the same process and obtains a product, not for the purposes of commercial profit, but for the purpose solely of deodorizing and purifying the sewage water, he is not guilty of an infringement of the patent. *Higgs* v. *Goodwin*, El. Bl. & El. 529; 4 Jur., N. S. 258; 27 L. J., Q. B. 145. Affirmed on appeal, 27 L. J., Q. B. 411—Exch. Cham.

The sale of an article of the same fabric, and made in the same manner as the article which is the subject of the patent, is evidence of a using of the invention within the prohibitory clause of the letters patent. *Gibson* v. *Brand*, 4 M. & G. 179; 4 Scott, N. R. 854.

Ignorance of the existence of a former invention is no answer to a charge of infringement, where the second invention is capable of being accurately represented as an imitation of the former. *Curtis* v. *Platt*, 11 L. T., N. S. 245—C.

The merely "exhibiting to sale" imitations of an invention is not any infringement of the patent. *Minter* v. *Williams*, 5 N. & M. 647; 4 A. & E. 251; 1 H. & W. 585.

But the manufacture of a patent article for the purpose of sale and offering it for sale, although no sale is actually effected, is a user of the invention. *Oxley* v. *Holden*, 8 C. B., N. S. 666; 30 L. J., C. P. 68.

A sale in this country of a patent article imported from abroad is a user of the invention within the prohibition of the letters patent. *Walton* v. *Lavater*, 8 C. B., N. S. 162; 6 Jur., N. S. 1251; 29 L. J., C. P. 275; 3 L. T., N. S. 272.

It is sufficient to constitute user of a patented article, that the same sort of benefit, however temporary and indirect, has been in fact derived from it in its ordinary use. It is immaterial whether the use of the article is active or passive. *Betts* v.

Neilson, 11 Jur., N. S. 679; 34 L. J., Chanc. 537; 13 W. R. 1028; 12 L. T., N. S. 719; 3 De G., J. & S. 82.

Ale was sent from Scotland to England, for transhipment to India, in bottles covered with capsules made abroad, according to a mode of manufacture patented in England only: Held, that the transitory resting in England of the bottles so covered constituted a user in infringement of the English patent. *Ib. S. P.* and *S. C.* 37 L. J., Chanc. 321: 3 L. R., Ch. 429—C.

B. held an English patent for the manufacture of a combined metal, to be (among other purposes) applied as capsules to put on bottles. T. (who resided and carried on the business of a brewer in Scotland) purchased capsules, made according to the process described in B.'s patent, from a foreign manufacturer, and, in *Scotland*, put these capsules upon his beer bottles, which he then sent to his agents in *England* for transhipment and exportation. There was no evidence that the beer was sold in *England* for consumption here: Held, that though the capsules were put on in Scotland, their user while the beer remained here was a continued user of them which amounted to an infringement of the patent. *Ib.: S. P.* and *S. C.*, 5 L. R., H. L. 1. Affirming decision cited *supra*.

If there is a patent for a combination of machinery originally directed to one purpose, and a person afterward adopts that combination in order to make it minister to another and additional purpose, his doing so constitutes an infringement of the patent. *Per* Lord Westbury, in *Cannington* v. *Nuttall*, 5 L. R., H. L. 205.

Though the manufacture in this country of the several parts of a patented machine, and the exportation of those parts, may not be an infringement of the patent, the machine being the novelty, and the parts being old, it is otherwise where the part exported is itself the patented invention. *Goucher* v. *Clayton*, 11 Jur., N. S. 462; 13 L. T., N. S. 115—V.-C. W.

An infringement of any part of a patented process is actionable, if that part is of itself new and useful, so as that it might be the subject-matter of a patent, and is used by the infringer to effect the object proposed, either wholly or partially, by the pat-

entee. *Patent Bottle Envelope Company* v *Seymer*, 5 C. B., N. S. 164; 5 Jur., N. S. 174.

A patent for an entire combination is not infringed by a different combination, for the same object, of the same elements though important, or of equivalents for them, if not a mere colorable evasion or imitation. *Curtis* v. *Platt*, 35 L. J., Chanc. 852—H. L.

If a patent is taken out for an invention by means of a combination, the use of a subordinate part of the combination is no infringement of the patent, unless such part is new and material. *White* v. *Fenn*, 15 W. R. 348; 15 L. T., N. S. 505—C. P.

W. took out a patent for "improvement in the manufacture of frills and ruffles, and in the machinery or apparatus employed therein." The specification described a process of plaiting fabrics by a reciprocating knife in combination with a sewing machine. The first claim was for the general construction, arrangement, and combination of machinery for producing plaited frills or trimmings in a sewing machine; the second was for the application and use of a reciprocating knife for crimping fabrics in a sewing machine; and the third for the peculiar manufacture of crimped or plaited frills or trimmings "as hereinbefore described" and illustrated by a drawing. A patent was afterward taken out by O. for "improvement in doubling, folding, or plaiting woven or other web fabrics, and in the machinery or apparatus employed therein or connected therewith." In this O. imitated, with slight variations, W.'s reciprocating knife, but did not combine its use with a sewing machine: Held, first, that W.'s patent was not for the manufactured product, but for the process of manufacturing it. *Wright* v. *Hitchcock*, 5 L. R., Exch. 37; 39 L. J., Exch. 97.

Held, secondly, that W.'s patent was not limited to the manufacture of plaited fabrics by the knife in combination with a sewing machine. *Ib.*

Held, thirdly, that O.'s process was therefore an infringement. *Ib.*

The defendants bought and sold, in the way of trade, articles manufactured by O.'s process under the description of "Orr's

patent machine-made plaiting," but they were not aware that Orr's process was an infringement, nor of the existence of W.'s patent: Held, that they were guilty of an infringement of W.'s patent. *Ib.*

2. Where Infringed.

A patent granted for the United Kingdom, the Channel Islands, and the Isle of Man, is not infringed by acts done between Malta and Alexandria. *Newall* v. *Elliott*, 10 Jur., N. S. 954; 13 W. R. 11; 10 L. T., N. S. 792—Exch.

3. Actions by and against Parties.

Assignees.]—Where there are two assignees of a patent, and one of them dies, an action for an infringement in his lifetime descends to the survivor, who is entitled to recover the whole damages. *Smith* v. *London and Northwestern Railway Company*, 2 El. & Bl. 69; 17 Jur. 1071.

An assignee of a separate and distinct part of a patent is entitled to sue for an infringement of such part, without joining persons who are interested only in the other part of the patent. *Dunnicliff* v. *Mallet*, 29 L. J., C. P. 70; 7 C. B., N. S. 209.

So the assignee of two several moieties of a patent has a sufficient legal interest in the patent to sue for an infringement. *Walton* v. *Lavater*, 29 L. J., C. P. 275; 8 C. B., N. S. 162.

Defendants.]—The directors of a company are personally responsible for the infringement of a patent by their workmen, notwithstanding such infringement may be in contravention of orders. *Betts* v. *De Vitre*, 37 L. J., Chanc. 325; 3 L. R., Chanc. 429; 18 L. T., N. S. 165.

4. Pleadings.

Declarations.]—A form of declaration for the infringement of a patent is given in Schedule (B), No. 31, to the C. L. P. Act, 1852.

It is material to aver that the patentee has complied with the proviso which requires him to enroll a specification within six

calendar months. *Bentley* v. *Goldthorp*, 2 D. & L. 795; 1 C. B. 368; 9 Jur. 470; 14 L. J., C. P. 115.

Several Pleas.]—Pleas denying that parts of the invention were known, and are not the subject of letters patent, will not be allowed with pleas denying the novelty of the invention as a whole, and that the invention was a new manufacture within the meaning of 21 Jac. 1, c. 3. *Walton* v. *Bateman*, 4 Scott, N. R. 397; 3 M. & G. 773.

In an action for an infringement of a patent, for six distinct improvements in an old machine, the defendants were allowed to plead that two parts of the invention were not, nor was either of them, a new manufacture within the statute of James. But the court refused to allow them to plead, that, as to a part, A. was the first and true inventor; and that, before the grant of the patent, A. and others publicly used and exercised in England a part of the invention. *Bentley* v. *Keighley*, 6 M. & G. 1039; 7 Scott, N. R. 987; 1 D. & L. 944; 13 L. J., C. P. 167.

A plea alleging that the plaintiff falsely represented to the Queen that the invention was an improvement; that her Majesty, confiding in such representation, made the supposed grant; that such representation was false; and that the invention was not an improvement, might properly be pleaded with a plea that the invention was of no use to the public, the two pleas not being substantially the same. *Bedells* v. *Massey*, 7 M. & G. 630; 8 Scott, N. R. 337; 8 Jur. 808; 13 L. J., C. P. 173.

The court allowed, first, not guilty; secondly, the patentee not the inventor; thirdly, non concessit; fourthly, the invention not a manufacture; fifthly, the invention not new; and, sixthly, a traverse of the specification, on an affidavit of the defendant's attorney, that he was advised and believed that the defendant had just ground to traverse the several matters. *Platt* v. *Else*, 8 Exch. 364; 17 Jur. 188; 22 L. J., Exch. 192.

In an action for infringing a patent, to which a disclaimer as to part has been entered, the defendant will not be allowed to plead that the whole invention was not new, and also that the undisclaimed part was not new. *Clark* v. *Kenrick*, 12 M. & W. 219; 1 D. & L. 392; 13 L. J., Exch. 6.

The court refused to strike out a plea, that the instrument in writing in the declaration mentioned did not particularly describe and ascertain the nature of the invention in the letters patent. *Ib.*

The court disallowed a plea, that the plaintiff, having petitioned for letters patent, represented to the solicitor-general, to whom the matter was referred, that the invention consisted of matters mentioned in a paper writing exhibited to the solicitor-general, who confiding therein, reported that the letters patent might be granted; that after the grant the plaintiff enrolled his specification and falsely described his invention therein, and that so much of the invention as was stated in the specification was not part of the invention in the paper writing and letters patent mentioned, and was not part of the invention for which the letters patent were granted. *Hancock* v. *Noyes*, 9 Exch. 388; 2 C. L. R. 1060; 23 L. J., Exch. 110.

Effect and Proof of Pleas.]—A plea that the invention is not a new manufacture within 21 Jac. 1, c. 3, involves the question, not only whether the alleged patent is new, but also whether it is a manufacture within the meaning of the statute. *Walton* v. *Bateman*, 3 M. & G. 773; 4 Scott, N. R. 397.

In an action by the assignee of a patent for an infringement non concessit is a good plea. *Bennett* v. *Smith*, 2 D. & L. 380; 13 M. & W. 552; 8 Jur. 1634; 14 L. J., Exch. 47.

When letters patent were granted for improvements in apparatus for the manufacture of certain chemical substances, and the jury found that the apparatus was not new, but that the patentee's mode of connecting the parts of that apparatus was new, the court directed the verdict to be entered for the defendant upon an issue taken upon the novelty of the invention. *Gamble* v. *Kurtz*, 3 C. B. 425.

A declaration alleged that the plaintiff was the inventor and the grantee of the patent, plea non concessit: Held, that the plaintiff having, at the trial, put in the letters patent and specifications, and shown the novelty of the invention, was entitled to a verdict, on the issue joined on the plea. *Nickels* v. *Ross*, 8 C. B. 679.

Pleas which deny that the plaintiff was the true and first inventor, and that the manufacture was not new, do not bind the plaintiff to the description of the invention as given in the specification, so as to preclude him from giving evidence to show that the invention does not consist, as might be inferred from the specification in the use of several new matters, but in the new combination of several old matters. *Bateman* v. *Gray*, 8 Exch. 906; 22 L. J., Exch. 290.

To a declaration stating that the plaintiff was the first inventor of a new manufacture, and that the defendant infringed his patent right, a plea that the invention was not a matter for which letters patent would by law be granted, does not put in issue the novelty of the invention. *Booth* v. *Kennard* (in error), 1 H. & N. 527; 2 Jur., N. S. 21; 26 L. J., Exch. 23—Exch. Cham.

In an action for breach of an agreement to make the necessary periodical payments for stamp duty, to keep alive a patent which had been assigned to the defendant, a plea of non concessit, in the absence of any fraud, or of any warranty that the invention was new, or was a manufacture within the statute of James, puts in issue merely the fact of the Queen having granted the patent, and not its validity. *Smith* v. *Neale*, 2 C. B., N. S. 67; 3 Jur., N. S. 516; 26 L. J., C. P. 143.

In an action by an assignee, a plea that the property is not vested in him is bad, as embarrassing, and will be set aside. *Cottula* v. *Soames*, 3 F. & F. 93—Mellor.

To an action for the infringement of a patent for improvements in a cabriolet, the general issue, that the improvements were not new, and that the plaintiff was not the true and first inventor, were pleaded: Held, that, on this state of the pleadings it could not be contended that the patent was illegal, as being a monopoly. *Gillett* v. *Wilby*, 9 C. & P. 334—Coltman.

Held, also, that though all the improvements claimed must be shown to be new, yet it need not be shown that the defendant's cabriolet was an imitation of the whole of them; but an imitation of one was sufficient to maintain the action. *Ib.*

A plea which refers for explanation to drawings not traced on the record, but annexed to it, is inadmissible. *Betts* v. *Walker*,

14 Q. B. 363; 14 Jur. 647. See *Sealy* v. *Browne*, 9 Jur. 537; 14 L. J., Q. B. 169.

A plea that the invention is not of such use to the public as to make it a sufficient consideration for the grant of the letters patent is bad. *Ib.*

Upon an issue of not guilty to an action for infringement of a patent, the question whether there was a fraudulent evasion of the patent does not arise. *Stead* v *Anderson*, 4 C. B. 806; 11 Jur. 877; 16 L. J., C. P. 250.

In determining whether a defendant has infringed a patent, no question arises as to his intention, but only as to his acts. *Ib.*

A plea that the plaintiff was not the first and true inventor, is proved by showing a publication before the invention. *Ib.*

When the specification described a different and more extensive invention than that for which the patent was granted: Held, that this objection might be taken either on a plea that the patentee did not particularly describe the nature of his invention, or on a plea that the invention described was not the invention for which the letters patent were granted. *Croll* v. *Edge*, 9 C. B. 479; 14 Jur. 553; 9 L. J., C. P. 261.

A declaration averred that by indenture between the grantee and the plaintiff, letters patent were duly assigned to the plaintiff. Plea, that the letters patent were not assigned as alleged: Held, first, that the allegation amounted to a statement not only that the indenture had been executed, but that the letters patent had been duly assigned to the plaintiff, so that he had a right to maintain the action as the sole and exclusive proprietor, in pursuance of the 15 and 16 Vict. c. 83, and therefore the defendant might show that the assignment was not registered. *Chollet* v. *Hoffman*, 3 Jur., N. S. 935; 26 L. J., Q. B. 249; 7 El. & Bl. 686.

Held, secondly, that the defendant might insist on the want of registration of the assignment, notwithstanding his notice of objections made no reference to the assignment, inasmuch as the requirements of the 5 and 6 Will. 4, c. 83, as well as of the 15 and 16 Vict. c. 83, were confined to notices affecting the validity of the patent. *Ib.*

Particulars of Breaches and Objections.

Statutes.]—By 15 and 16 Vict. c. 83, s. 41, *in any action in any of the superior courts of record at Westminster for the infringement of letters patent, the plaintiff shall deliver with his declaration particulars of the breaches complained of in the action;*

And 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 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 objections impeaching the validity of such letters patent which shall not be contained in the particulars delivered:

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 to amend the particulars delivered, upon such terms as to such judge shall seem fit. (A similar and a more comprehensive enactment than that contained in 5 and 6 Will. 4, c. 83, s. 5.)

Of Breaches.]—In an action for infringement of Talbot's patent for improvements in obtaining pictures or representations of objects, the court refused to compel the plaintiff in his particulars of breaches to specify particularly the persons and occasions, and the particular parts of the specification alleged to have been infringed, although the declaration merely averred an infringement in general terms. *Talbot* v. *La Roche*, 15 C. B. 310.

The particulars of breaches can not be called in aid of the defective particulars of objections. *Palmer* v. *Cooper*, 9 Exch. 231; 2 C. L. R. 430; 23 L. J., Exch. 82.

Objections.]—The provisions contained in these statutes, as to notice of objections for infringement of a patent, are confined to objections affecting the validity of letters patent; and a de-

fendant may object to a validity of an assignment of the patent, though no notice of such objection has been given. *Chollet* v. *Hoffman*, 26 L. J., Q. B. 249; 7 El. & Bl. 686.

A particular of objections must be precise and definite; it is not sufficient to say that the improvements, or some of them, have been used before: the defendant should point out which. *Fisher* v. *Dewick*, 4 Bing. N. C. 706; 6 Scott, 587; 6 D. P. C. 739; 1 Arn. 282.

A defendant pleaded, first, that the nature of the invention and manner in which it was performed were not particularly described in the specification; and, secondly, that the invention was not new; and the objections delivered with the pleas stated, first, that the specification did not sufficiently describe the nature of the invention and the manner in which it was to be performed; and, secondly, that the invention was not new, as being wholly or in part used and made public before the obtaining of the letters patent: Held, that the first of these objections was sufficient, but that the second was bad, and ought to have pointed out what portions of the invention were previously in use. *Heath* v. *Unwin*, 2 D., N. S. 482; 10 M. & W. 684; 6 Jur. 1068; 12 L. J., Exch. 47.

The notice of objections ought to contain more particular information than that which is necessarily conveyed by the pleas. *Jones* v. *Berger*, 5 M. & G. 208; 6 Scott, N. R. 208; 7 Jur. 883; 12 L. J., C. P. 179; *S. P. Betts* v. *Walker*, 14 Q. B. 363.

When a defendant pleads that a patentee was not the first inventor, and that the alleged invention was not new, he is not bound to state in his objections who was the first inventor, or under what circumstances the alleged improvements had been used previously. *Russell* v. *Ledsam*, 11 M. & W. 647; 1 D. & L. 347; 7 Jur. 585; 12 L. J., Exch. 439; *Heath* v. *Unwin*, 2 D., N. S. 482; 10 M. & W. 684; 6 Jur. 1068; 12 L. J., Exch. 47; *S. P. Bulnois* v. *Mackenzie*, 4 Bing. N. C. 127; 6 D. P. C. 215; 5 Scott, 489.

Where a defendant pleads that the report of the judicial committee of the privy council on which the letters patent were

granted was obtained by fraud, covin, and misrepresentation, he ought to state in his notice of objections the species of fraud, covin, and misrepresentation on which he intends to rely. *Ib.*

Notices of objection were, first, that the patentee did not, by the specification, sufficiently describe the nature of the invention; secondly, that he had not caused any specification sufficiently describing the nature of the invention to be enrolled: Held, that the last objection was not sufficiently precise. *Leaf* v. *Topham*, 2 D. & L. 863; 14 M. & W. 146; 14 L. J., Exch. 231.

A notice of objections stated that the invention was known to, and used by, M. R., J. W., and others, before the grant of the patent. The court refused to strike out the words "and others." *Bentley* v. *Keighley*, 8 Scott, N. R. 372; 7 M. & G. 652; 1 D. & L. 944; 13 L. J., C. P. 167.

The court has a general power to order a particular of the alleged infringements. *Electric Telegraph Company* v. *Nott*, 4 C. B. 462; 11 Jur. 590; 16 L. J., C. P. 319.

A defendant can not, by his notice of objections, go beyond his pleas. *Mcnamara* v. *Hulse*, Car. & M. 471—Abinger.

Where a defendant relies on a general user of the supposed invention, it is sufficient to state in his particulars of objection that the invention was used by manufacturers generally at a particular place, without meaning any person or specifying any manufactory. *Palmer* v. *Wagstaff*, 8 Exch. 840; 17 Jur. 581; 22 L. J., Exch. 295.

A plaintiff's particulars of breaches can not be called in aid of the defective particulars of objection. *Palmer* v. *Cooper*, 9 Exch. 231; 2 C. L. R. 430; 23 L. J., Exch. 82.

Generality.]—If the objections are not sufficiently specific, the plaintiff's course is to apply to a judge for an order for the delivery of a more specific notice; but if he omits to do so, he can not object to the generality of the notice at the trial: the only question then is whether the notice is sufficiently large to include the objections relied on by the defendant. *Neilson* v. *Harford*, 8 M. & W. 806.

If the particulars of objections delivered with the pleas are too general, the party who means to object to them must procure an order for better particulars. *Hull* v. *Bollard*, 1 H. & N. 134; 25 L. J., Exch. 304.

The act does not prevent defective particulars from being available at the trial, and the plaintiff can not resist the admission of evidence, which is within the literal meaning of the particulars, on the ground that the statement is too general, and that the particulars do not give the required information as to the place in which the invention is alleged to have been used. *Ib.*

In an action for infringing a patent for machinery for grinding corn, the defendant delivered the following particulars: that the improvement was not new, and that the same had been generally known and publicly used in corn-mills for many years previously: Held, that evidence on the part of the defendant was admissible of a user by two millers at Chester of the invention in question prior to the granting of the patent, such evidence being within the literal meaning of the words in the particulars, and that the plaintiff was too late in his objection to the admissibility of it, it being his duty, if he objected to the generality of the particulars, to apply to have them amended. *Ib.*

Operation and Effect.]—The objections are not part and parcel of the record, so as to be incorporated with the issues raised, and show that those specific objections are in issue. *Reg.* v. *Mill*, 1 L., M. & P. 695; 10 C. B. 379; 15 Jur. 59; 20 L. J., C. P. 16.

6. Interrogatories and Discovery.

Where a defendant does not deny the infringement, it is no ground for his refusing to answer interrogatories, that the answers would expose persons to whom he had sold the patented articles to action. *Tetley* v. *Easton*, 18 C. B. 643; 25 L. J., C. P. 293.

But the court refused to allow a plaintiff to administer interrogatories before declaration, it appearing that the cause of action arose more than six years before the action was com-

menced. *Jones* v. *Pratt*, 6 H. & N. 697; 7 Jur., N. S. 978; 30 L. J., Exch. 365; 9 W. R. 696; 4 L. T., N. S. 411.

A plaintiff in a patent case, where the novelty of the invention is denied by the answer in equity, has no right to a discovery of the particulars on which the defendant relies, as showing a user of the thing patented prior to the date of the patent. *Daw* v. *Eley*, 2 Hem. & M. 725.

In an action by a patentee against his licensee, on a covenant to pay for using machines made with his invention, and to make none without; first, breach in paying for roving machines made with the invention; and secondly, in making machines without it, the defendant having, in answer to interrogatories, admitted the making of hundreds of roving machines, but not with the invention, and declared that he could not state to whom they were sold, nor give any further information about them without disclosing his own evidence, and the plaintiff claiming in respect of all the machines the defendant had made under one or other of the covenants; and asserting that he had seen some of them which had his invention applied: Held, that the defendant was entitled to such particulars as should ascribe those portions of the machines to which the plaintiff contended that his invention had been applied, so as to enable the defendant to understand as far as possible the nature of the machines as to which he was to be charged under either of the covenants; and that it was no answer to the application for such particulars, that the defendant's answer to the interrogatories was insufficient to enable the plaintiff to furnish the particulars; for if the answers were insufficient, they should have been objected to. But the plaintiff was allowed to inspect the machines on the premises of the defendant, and also to examine him *viva voce*. *Jones* v. *Lee*, 25 L. J., Exch. 241.

7. Inspection.

By 15 and 16 Vict. c. 83, s. 42, *in any action in any of the superior courts of record at Westminster 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 sitting then for a judge of such court, on the application of the plaintiff or defendant*

respectively, to make such order for an inspection, and to give such direction respecting such action and inspection and the proceedings therein, as to such court or judge may seem fit.

An application to inspect the defendant's machinery may be made by the plaintiff before the delivery of the declaration, in an action of infringement of the plaintiff's patent; but such inspection will not be granted as of course, or without the party applying for it showing that the inspection is material for the purposes of the cause. *Amies* v. *Kelsey*, 1 B. C. C. 123; 16 Jur. 1047; 22 L. J., Q. B. 84—Crompton.

The court will not grant an order for an inspection of a machine, upon an affidavit, that the machine used by the defendant is the same for which the plaintiff has obtained a patent. *Shaw* v. *Bank of England*, 22 L. J., Exch. 26.

The inspection intended by the above provision is an inspection of the instrument or machinery manufactured or used by the parties, with a view to evidence of infringement, and not an inspection of books. *Vidi* v. *Smith*, 3 El. & Bl. 969; 1 Jur., N. S. 14; 23 L. J., Q. B. 342.

In an action for the infringement of a patent for a mode of making veneers or moldings, the court refused to order an inspection of the defendant's manufactory and machinery, it being doubtful, on the plaintiff's affidavit, whether his patent was for the kind of veneering or for the process by which it was done, and the defendant positively swearing that he used no machinery in the process. *Meadows* v. *Kirkman*, 29 L. J., Exch. 205.

In an action by an assignee of a patent against the publisher of a newspaper who had bought and used the article, the plaintiff having applied to the court to compel the defendant to "permit the plaintiff, his manager and witnesses, to inspect the type of the defendant used by him in printing the newspaper, and, if necessary, to take specimens for the purpose of being analyzed, in order to produce evidence at the trial of the cause," the court refused the application. *Patent Type-founding Company* v. *Walter*, 5 H. & N. 192; 29 L. J., Exch. 207; 6 Jur., N. S. 103.

But the plaintiff subsequently filed a bill in equity against the defendant, and an order was made for inspection and the de-

livery of a competent portion of the type for the purposes of analysis. *S. C.*, Johns. 727; 8 W. R. 353.

8. Evidence of Infringement.

In general.]—When a question of novelty, or infringement, depends merely on the construction of the specification, it is one entirely for the judge; but where it also depends on other circumstances, such as the degree of difference or of similitude between two machines, it is a mixed question of law and fact; what the jurymen find to have been done is a matter of fact, but the judge must apply that fact according to the rules of law, and is entitled and bound to say whether what has been done amounts to an infringement. *Seed* v. *Higgins*, 8 H. L. Cas. 550; 30 L. J., Q. B. 314; 6 Jur., N. S. 1264.

The opinion of scientific witnesses as to whether there has or not been an infringement ought to be received. *Ib.*—Lord Wensleydale.

The plaintiff obtained letters patent for improvements in the manufacture of iron and steel. In his specification he declared his invention to be the use of carburet of manganese in any process whereby iron is converted into cast steel, and he described the process which he claimed thus: "I do it by introducing into a crucible bars of steel broken into fragments, 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." He then stated that he did not claim the use of the mixture of cast and malleable iron and carbonaceous matter as any part of his invention, but only the use of carburet of manganese, in any process for converting iron into cast steel. The defendant produced the same result, a superior and more valuable description and quality of cast steel, as certainly and more cheaply, by substituting for the carburet of manganese, its elements: viz., oxide of manganese and coal tar, which, being put into the crucible with the iron, according to the evidence of chemists, would form carburet of manganese before the iron was in a state of fusion, and consequently before any combination therewith could take place. The judge told the jury that there was no evidence of infringement: Held, a right direction.

Unwin v. *Heath*, 16 C. B. 713; 5 H. L. Cas. 505; 25 L. J., C. P. 8.

A patent for the use of a substance in a process is infringed by the use of a chemical equivalent, known to be so at the time of the use, if used for the purpose of taking the benefit of the patent, and of making a colorable variation therefrom. *S. P.*, 13 M. & W. 583; 9 Jur. 231.

In a suit to restrain the sale of a patented article, it is incumbent on the plaintiff not only to prove the sale, but to prove that the article was not made by himself or his agents.

When the owner of a patent manufactures and sells the patented article in a foreign country as well as in England, the sale of the article in one country implies a license to use it in another. But if he has assigned his patent in either country, the article can not be sold so as to defeat the rights of the assignee. The owner of English patent, manufactured the patented article in *France* as well as in England. In a suit to restrain the sale of the article in *England*, the plaintiff proved that it was not made at his manufactory in *England*, but could not prove that it was not made at his manufactory in *France*. The bill was dismissed with costs. The decision of James, V.-C., affirmed. *Betts* v. *Wilmot*, 6 L R., Chanc. App. 239—C.

In ordinary cases the duty of establishing that the thing patented has been pirated, lies on the patentee, and courts of equity grant limited orders of inspection for the purpose of enabling him to discharge that duty. Such orders can not be granted where the piracy alleged has taken place abroad: Semble, that then it becomes the duty of the defendant to give evidence of a negative character to prove, in answer to the *prima facie* case made by the patentee, that the process used was of a different character from that which had been patented. Where that negative evidence was not given by the defendant, but positive evidence on the part of the patentee was given by one workman that he had been employed at the foreign manufactory, and there saw the article manufactured by a process not distinguishable from that of the patentee: Held, that these circumstances justified the conclusion of identity of material and process, and were

sufficient warrant for the grant of an injunction. Where a patent had been taken out by D. in 1804, and another patent had been taken out by B. in 1849, and B. took proceedings against N. for infringement, to which N. set up as an answer want of novelty, and proved D.'s patent, evidence of all that was done in the trade to which the patent related between the date of D.'s patent and of B.'s patent was admissible on this question of novelty. *Neilson* v. *Betts*, 5 L. R., H. L. 1.

The importation and sale in England of articles manufactured abroad according to the specification of an English patent, is an infringement. *Elmslie* v. *Boursier*, 9 L. R., Eq. 217; 39 L. J., Chanc. 328; 18 W. R. 665—V.-C. J.

A patentee can not maintain a suit against a retail dealer who unwittingly sells articles which are an infringement of his patent, provided such retail dealer gives full information as to the persons from whom he obtained the articles complained of, and promises not to retail any more. *Betts* v. *Wilmott*, 18 W. R. 946—V.-C. J.

Declarations of Prior Use.]—In an action for an infringement of a patent taken out in 1849, the defendant, in support of a plea that the invention was not new, gave evidence that O., who was dead, had in 1846 used a process identical with that in the patent. On the cross-examination of the witnesses it appeared that, if O. used the invention and sold the product before the date of the patent, it was only in very small quantities, and that it was not brought into general use; and one of the witnesses was asked in cross-examination whether O. had not sold some of the product to S., and said he had. The plaintiff in reply called S., who gave evidence that in 1850 or 1851, O. sold him a small quantity of the product, and at the time of the sale said that it was a new article, that he did not wish it to be publicly known, and he would sell him all he could manufacture: Held, that evidence of what O. said at the time of that sale was not admissible in reply, as it would not have been admissible in chief on an issue whether O., before 1849, used the invention. *Hyde* v. *Palmer*, 3 B. & S. 657; 41 W. R. 433; 7 L. T., N. S. 823.

9. Questioning Validity of Patent Infringed.

Proceedings in chancery for an infringement of a patent, the validity of which was in question, were referred to an arbitrator, who awarded that the patent was not illegal and void: Held, that in an action between the same parties for another infringement, the defendant was not estopped from disputing the validity of the patent. *Newall* v. *Elliott*, 1 H. & C. 797; 9 Jur., N S. 359; 32 L. J., Exch. 120; 11 W. R. 438; 7 L. T., N S. 753.

A patentee brought an action for damages for infringement against a firm, who gave judgment by consent before the delivery of a declaration, and immediately took a license to use the patent for a term. On a bill being filed by the patentee, after the expiration of the license, to restrain a further infringement of his patent by the defendants in the action, and certain other persons who had joined the firm after the date of the judgment: Held, that the defendants in the suit were not estopped, either by the license or by the judgment, from denying the validity of the patent. *Goucher* v. *Clayton*, 11 Jur., N. S. 107; 34 L. J., Chanc. 239; 13 W. R. 336; 11 L. T., N. S. 732—V.-C. W.

10. Damages and Costs.

Damages.]—A suit was instituted in equity to restrain a defendant from infringing the plaintiff's patent for an invention applicable to steam-vessels. By the decree the defendant was ordered to pay to the plaintiff the damages which he had sustained by reason of the defendant's use or vending of the invention. The plaintiff had been in the habit of granting licenses to use the invention at the rate of 2*s.* 6*d.* per horse-power per ship: Held, that the compensation to which he was entitled was a sum calculated on this basis upon the ships to which the defendant had applied the invention, and that he was not entitled to any additional sum in respect of contracts which he had missed by reason of the piracy. *Penn* v. *Jack*, 37 L. J., Chanc. 136; 5 L. R., Eq. 81—V.-C. W.

Costs.]—By 15 and 16 Vict. c. 83, s. 43, *in taxing the costs in any action in any of the superior courts at Westminster, for infringing letters patent, regard shall be had to the particulars delivered in*

such action, and the plaintiff and the 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;

And it shall be lawful for the judge before whom any such action 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 letters patent, shall entitle the plaintiff in any such suit or action, or the defendant in such proceeding by 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. (Similar to 5 and 6 Will. 4, c 83, s. 3, impliedly repealed.)

By 5 and 6 Will. 4, c. 83, s. 6, *in any action for infringing the right granted by letters patent, in taxing the costs thereof, regard shall be had to the part of such case which has been proved at the trial, which shall be certified by the judge before whom the same shall be had, and the costs of each part of the case shall be given according as each party has succeeded or failed therein, regard being had to the notice of objections as well as the counts in the declaration, and without regard to the general result of the trial.*

In an action for the infringement of a patent, the defendant obtained a verdict on one issue, which covered the whole cause: Held, that he was entitled to the costs of that issue, and the general costs of the cause, subject to deduction in respect of the issues found for the plaintiff. *Losh* v. *Hague*, 7 D. P. C. 495; 5 M. & W. 387; 3 Jur. 409.

The certificate of the judge who tries the cause, that the defendant's particulars of objections have been proved by him, is a condition precedent to his right on taxation to any costs in respect of such particulars, even in the case of a nonsuit. *Honiball* v. *Bloomer*, 10 Exch. 538; 1 Jur., N. S. 188; 24 L. J., Exch. 11.

The certificate should be as to the determination of each objection of which notice has been given, and not as to the issues. *Losh* v. *Hague*, 5 M. & W. 387.

To an action for the infringement of a patent, there was a plea denying the novelty of the invention: Held, at the trial, that the validity of the patent might be considered as having come in question under this plea, so as to entitle the plaintiff to a certificate to that effect, under 5 and 6 Will. 4, c. 83, s. 3. *Gillett* v. *Wilby*, 9 C & P. 334—Coltman. See *Gillett* v. *Green*, 7 M. & W. 347; 9 D. P. C. 219.

But if the defendant at the trial consents to a verdict for the plaintiff, without any evidence being given, the judge will not certify that the validity of the patent came in question before him. *Stocker* v. *Rodgers*, 1 C. & K. 99—Erskine.

An action having been brought by a patentee (substantially) for the recovery of royalties under a due license, a compromise was entered into before the plaintiff's case was closed, and an order of nisi prius was drawn up, under which the defendant was to pay an agreed sum, and a verdict was to be entered for the plaintiff in the action, for 40*s.* damages, and costs, with all usual certificates. After the cause was thus disposed of, the judge, upon an ex parte application, indorsed on the record a certificate that the record in a certain action, wherein B. was plaintiff and K. was defendant, and the certificate thereon indorsed, were given in evidence at the trial of this action: Held, that this certificate was improperly granted, the record and certificates in the former action not having been given in evidence, and it not being, under the circumstances, a usual certificate within the contemplation of the parties. *Bovill* v. *Hadley*, 17 C. B., N. S. 435; 10 L. T., N. S. 650.

In an action for infringement of a patent, the plaintiff, after giving notice of trial, abandoned the action. The defendant had delivered with his pleas particulars of objections: Held, that he was entitled to his costs of preparing the particulars, and the evidence in support of them, inasmuch as s. 43, which makes the certificate of the judge who tried the cause, that the particulars of objections have been proved by the defendant, a

condition precedent to his right on taxation to any costs in respect of such particulars, applies only where there has been a trial. *Greaves* v. *Eastern Counties Railway Company*, 5 Jur., N. S. 733; 28 L. J., Q. B. 290; 1 El. & El. 961.

Held, also, that the cause not having been tried, the defendant, under 6 Geo. 4, c. 50, s. 34, was not entitled to the costs of a special jury applied for by him. *Ib.*

In an action for the infringement of a patent an order was made giving further time for pleading, the defendant to take short notice of trial, and the plaintiff to be at liberty at once to set the cause down for trial by a special jury. Pleas were afterward delivered, but issue was never joined. A special jury was nominated by the plaintiff, but it was not struck. The plaintiff having obtained a rule to discontinue without ever having given notice of trial: Held, that the master was right in refusing to allow the defendant any of the costs of preparing for trial. *Curtis* v. *Platt*, 10 Jur., N. S. 823; 33 L. J., C. P. 255; 10 L. T., N. S. 383.

II. Injunction to restrain.

By 15 and 16 Vict. c. 83, s. 42, *in any action in any of the superior courts of record at Westminster, 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 sitting then for a judge of such court, on the application of the plaintiff or defendant respectively, to make such order for an injunction, and to give such direction respecting such injunction, and the proceedings therein respectively, as to such court or judge may seem fit.*

Injunction granted by a court of equity against subjects of the kingdom of Holland, to restrain them from using on board their ships within the dominions of England, without a license, an invention, to the benefit of which the plaintiffs were exclusively entitled under the Queen's patent. *Caldwell* v. *Vanvlissengen*, 9 Hare, 415; 16 Jur. 115; 21 L. J., Chanc. 97.

In order to obtain an injunction against the violation of a patent, the party must, at the time of applying, swear as to his

belief that he is the original inventor. *Hill* v. *Thompson*, 2 Moore, 424; 8 Taunt. 375; Holt, 636; 3 Mer. 622.

A rule for a writ of injunction as to restrain a defendant from infringing a patent, under 17 and 18 Vict. c. 125, s. 82, is a rule to show cause only in the first instance. *Gittins* v. *Symes*, 15 C. B. 362; 24 L. J., C. P. 48.

The same relief may be had under 15 and 16 Vict. c. 83, s. 42. *Ib.*

The court will not entertain a bill for the mere purpose of giving relief in damages for the infringement of a patent when the bill has been filed, so immediately before the expiration of the patent as to render it impossible to have obtained an interlocutory injunction. *Betts* v. *Gallais*, 10 L. R., Eq. 392; 18 W. R. 945.

12. Account of Sale and Profits.

By 15 and 16 Vict. c. 83, s. 42, *in any action in any of the superior courts of record at Westminster 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 sitting then for a judge of such court, on the application of the plaintiff or defendant respectively, to make such order for an account and to give such direction respecting such account and the proceedings therein, as to such court or judge may seem fit.*

This provision vests in the courts of common law the powers before exercised exclusively by courts of equity, and enables them to grant either by interlocutory order an account of all patent articles sold during the action, or, after verdict for the plaintiff, and as part of the final judgment, an account of all profits made by the defendant since the commencement of the action and after notice that an account would be required. *Holland* v. *Fox*, 2 C. L. R. 1576; 3 El. & Bl. 977; 1 Jur., N. S. 13; 23 L. J., Q. B. 357.

But the court has no power, where damages nominal or substantial have been recovered, to order an account of profits made by the defendant prior to the commencement of the action, the damages assessed by the jury being considered as the compensation for the loss of such profits. *Ib.*

Where an action has been brought for the infringement of a patent, a retrospective account of the defendant's sales and profits of the patented article will not be granted before final judgment. *Vidi* v. *Smith*, 3 El. & Bl. 969; 2 C. L. R. 1573; 1 Jur., N. S. 14; 23 L. J., Q. B. 342.

But, upon reasonable evidence of the existence of a valid patent, and of its having been infringed by the defendant's making a profit by such infringement, he will be ordered to keep an account of all sales to be made of the article alleged to be an infringement of the patent, and of the profits thereon, until the further order of the court, upon condition of the plaintiff's waiving all right to more than nominal damages at the time of the action, and undertaking, in case the verdict and judgment should be in favor of the defendant, to pay to him the expense of keeping such account. *Ib.*

Where a patentee has obtained a verdict against the defendant for infringing the patent, the court will compel him to render to the plaintiff an account of all articles made by him in imitation of his patent articles, and to pay to the plaintiff a sum equal to the price of those which he has sold, and a further sum equal to the value of so many of such articles as the defendant has remaining in stock. *Holland* v. *Fox*, 23 L. J., Q. B. 211—B. C. —Erle.

The court will only direct an account to be taken of the profits which have been actually made by the defendant, and not of the loss which the plaintiff has sustained by the infringement. *Ellwood* v. *Christy*, 18 C. B., N. S. 494; 34 L. J., C. P. 130; 13 W. R. 498.

In the case of an assignee of the patent, the account will only be taken from the date of the registration of the assignment. *Ib.*

Three descriptions of anchors were well known: 1. The Dutch or common anchor, in which the arms and the shank were all in one piece, the palm or fluke being sometimes placed inside and sometimes outside the extremity of the arm; 2. Rogers' anchor, the peculiarity of which was that the palm or fluke was placed outside the extremity of the arm; 3. Porter's anchor, the arms of which moved on an axis in the shank, the palm be-

ing placed inside the arm, with a horn or a toggle at the back, and of the width of the arm. T. took out a patent for improvements in anchors, such improvements mainly consisting in placing the palm at the back or outside or intermediately of the breadth of the arm, and making the arm or toggle form part of, and of the same width as the palm, combined with Porter's movable arms. In his specification he thus described his invention: "The improvements are chiefly applicable to that class of anchors known as Porter's anchors, and consist, first, of forming or fixing the palm intermediately of the breadth of the arm; secondly, in forming the horn wider than the arm; and thirdly, in forming or affixing the palm of that class of anchor known as Porter's anchor, at the back of the arm;" and after describing the drawings he concluded thus: "I would remark that I am aware that it is not new to place the palm at the back of the arm of ordinary anchors; this part of the invention therefore consists of combining the fixing of the palms to the back of those arms of anchors which move on an axis. The angles which the faces of the arms and the faces of the palms make to the shank and to each other, may be varied, but it is important that the angles which the palms make to the shank and those made by the arms should be different. The construction shown are those I employ." W. (having a license from T.) made anchors with the arms moving on an axis, like Porter's, and with the palm at the outside of the arm, with a horn of a greater width than the arm, and nearly identical with that described in T.'s specification and drawings; but he forged the arms, palm, and horn all in one piece, whereas T.'s palm and horn were formed together, and then fixed to the back or "intermediately of the breadth" of the arm. The jury, in an action against W. for non-payment of royalties, and for an account, found, as regarded the palm, that W. had adopted T.'s invention, but not being able to agree as to the horn, they were discharged from any finding as to that: Held, that T. was entitled to an account of the anchors so made. *Trotman* v. *Wood*, 16 C. B., N. S. 479.

For a form of rule or order for an account, see *Walton* v. *Lavater*, 8 C. B., N. S. 162.

VII. CONFIRMATION, RENEWAL, AND EXTENSION OF LETTERS PATENT.

I. In what Cases.

See 5 *and* 6 *Will.* 4, *c.* 83, *s.* 4; 2 *and* 3 *Vict. c.* 67; 7 *and* 8 *Vict. c.* 69; 15 *and* 16 *Vict. c.* 83, *s.* 40; 16 *and* 17 *Vict. c.* 115, *s.* 7.

Generally.]—Original letters patent, for a term of fourteen years, were dated on the 26th February, 1825, and renewed letters patent were dated on the 26th February, 1839: Held, that the day must be reckoned inclusively, and that the former term expired on the 25th February, 1839, and, consequently, the renewed letters patent were granted after the original letters patent had expired. *Russell* v. *Ledsam*, 14 M. & W. 574; 9 Jur. 557; 14 L. J., Exch. 353.

The 5 and 6 Will. 4, c. 83, s. 4, does not authorize the judicial committee of the privy council to impose terms as conditions on which patents are to be renewed. The authority of the committee is limited to reporting on matters as between the public and the party applying. *Ledsam* v. *Russell* (in error), 1 H. L. Cas. 687.

An application for a renewal is prosecuted with effect, within the terms of 5 and 6 Will. 4, c. 83, s. 4, if the party applying obtains the report of the judicial committee of the privy council before the expiration of the original patent. *Ib.*

The crown is not restricted as to the time within which it may act upon such report, and renewed letters patent are not void because they are dated after the expiration of the original letters patent. *Ib.*

If the judicial committee should impose a condition on a party applying for the renewal of a patent, such party need not, in an action for the infringement of the patent, aver that such condition was complied with before the patent was renewed. *Ib.*

By an act of parliament reciting that letters patent had been granted to A.; that the specification had been enrolled within six months, instead of being enrolled within four months,

after date, as required by the letters patent; that the letters patent contained a proviso for making them void, if they should become vested in, or in trust for more than twelve persons; and that certain persons had agreed to form themselves into a company for working the patent; powers were given for the formation of a company, and enabling the patentee to assign the patent to them, or to license them to work it. A subsequent section, reciting the enrollment of a specification within due time, and that such enrollment had arisen from inadvertence and misinformation, and that it was expedient that the patent should be rendered valid to the extent thereinafter mentioned, enacted, that the letters patent should, during the remainder of the term, be considered, deemed, and taken to be as valid and effectual to all intents and purposes as if the specification so enrolled by A., within six months after date, had been enrolled within four months: Held, that the confirmation of the patent was unconditional, and was not dependent on the formation of a company. *Stead* v. *Carey*, 1 C. B. 496; 9 Jur. 511; 14 L. J., C. P. 177.

The authority conferred upon the crown by 5 and 6 Will. 4, c. 83, s. 2, to confirm letters patent, is discretionary, in the judicial committee, to recommend or not a confirmation. *Honiball's Patent*, *in re*, 9 Moore, P. C. C. 378.

The jurisdiction is one which is most cautiously and sparingly to be exercised, as the effect of a confirmation of letters patent is to give force and validity, by a quasi legislative authority, to a grant of monopoly actually void, and to exclude from the use of the invention not only other subjects of her Majesty in England, but even the first and original inventor, who may have actually brought it into public, though not into general use, before the patent was taken out. *Ib.*

Two conditions are required from a petitioner applying for a confirmation, to establish, first, that before the date of the letters patent (the subject of application) the invention was not publicly and generally used; and, second, that the grantee of such letters patent believed himself the first and original inventor. *Ib.*

The 5 and 6 Will. 4, c. 83, s. 2, applies to confirmation of letters patent for an extended term, as the grant of such ex-

tended term is a grant of new letters patent, which are subject to the same conditions and open to the same objections, and entitled to the same advantages as the original letters patent. *Ib.*

The judicial committee has jurisdiction to entertain a petition referred to them by the crown, seeking to revoke an order in council, made upon their recommendation, upon an application by patentees for a prolongation of letters patent, and to recall the warrant for sealing such letters patent. *Schlumberger, in re*, 9 Moore, P. C. C. 1.

The power given by 7 and 8 Vict. c. 69, s. 2, to recommend an extension of the term of letters patent for an invention, is exhausted when an extension has been once recommended, and new letters patent granted. *Goucher's Patent, in re*, 2 Moore, P. C. C., N. S. 532.

In the objections filed by the objectors, this point was not taken: Held, that the objection could be raised on the application to fix a day for hearing of the petition. *Ib.*

The prolongation of a patent is, by 5 and 6 Will. 4, c. 83, and 16 and 17 Vict. c. 115, the same as a new grant. *Betts' Patent, in re*, 1 Moore, P. C. C., N. S. 49; 9 Jur., N. S. 137; 11 W. R. 221; 7 L. T., N. S. 577.

Application.]—Letters patent being about to expire, an application for an extension will be heard during the pendency of legal proceedings as to the validity of the patent. *Kay's Patent, in re*, 2 Moore, P. C. C. 241.

The circumstance of there being a lis pendens respecting the validity of the letters patent is no objection to the grant of an extension of the original letters patent. *Heath's Patent, in re*, 8 Moore, P. C. C. 217.

Assignees.]—Assignees of letters patent may lawfully obtain a renewal of such letters patent. *Ledsam* v. *Russell*, 14 M. & W. 574; 9 Jur. 557; 14 L. J., Exch. 353. Affirmed in Exch. Cham., 16 M. & W. 633; 16 L. J., Exch. 145; and in Dom. Proc., 1 H. L. Cas. 687.

The inventor and patentee had lost largely by the patent, but his assignees had lately made very considerable profits, and from

their position in the trade were likely to command a very large sale of the patent article. The patent was of high merit, and of great service to the public safety. A prolongation of the term was granted to the assignees for four years, upon conditions, first, that the assignees secured to the patentee half the profits derived from the sale; and, secondly, that the patented article should be sold by the assignees to the public at a fixed price. *Hardy's Patent, in re*, 6 Moore, P. C. C. 441; 13 Jur. 177.

Where the executor of the surviving assignee of a patentee petitioned for an extension, and it was established that a valuable consideration had been given for the assignment, and that the assignee had sustained considerable loss, the judicial committee, in granting an extension, refused to impose terms upon the petitioner, in favor of the patentee. *Bodmer's Patent, in re*, 6 Moore, P. C. C. 468.

When a patentee entered into an agreement with parties to work the patent, but owing to disputes between them the invention was not prosecuted until a short time before the expiration of the letters patent, an extension was refused. *Patterson's Patent, in re*, 6 Moore, P. C. C. 469; 13 Jur. 593.

An extension was recommended in favor of an assignee, on his securing an annuity to the inventor during the subsistence of the new letters patent. *Whitehouse's Patent, in re*, 2 Moore, P. C. C. 496.

To entitle an equitable assignee to appear with the legal assignees of a patent, on a petition for a prolongation of the letters patent, the name of such equitable assignee must appear with the other petitioners in the advertisements required by the 5 and 6 Will. 4, c. 83, s. 4, and rule 2. *Noble's Patent, in re*, 7 Moore, P. C. C. 191.

After an assignee of a patent had incurred considerable loss in carrying out a patent for a smoke prevention apparatus, a statute passed to compel the owners of furnaces in the metropolis to construct them so as to consume their own smoke: Held, that though the act might, in effect, compel the use of the petitioner's patent, yet that such circumstance formed no objection to a renewal of the term of the letters patent, the merits of the inven-

tion and loss incurred in carrying it out being established *Foarde's Patent, in re*, 9 Moore, P. C. C. 376.

The committee has power, under 7 and 8 Vict. c. 69, s. 4, to grant an extension to the assignee of the patentee. *Napier's Patent, in re*, 13 Moore, P. C. C. 543; 9 W. R. 390.

Although by 7 and 8 Vict. c. 69, s. 4, the assignee of a patentee is entitled to apply for an extension, yet he does not, unless under peculiar circumstances, stand on the same favorable footing as the original inventor, as the ground that the merits of the inventor ought to be properly rewarded, in dealing with an invention which has proved useful and beneficial to the public, does not exist in the case of an assignee, unless such assignee is a person who has assisted the patentee with funds to enable him to perfect and bring out his invention, and thus to bring it into use. *Norton's Patent, in re*, 1 Moore, P. C. C., N. S. 339.

Scotch Patents.]—The use of an invention in England prior to the date of letters patent granted for Scotland will invalidate the Scotch patent; and the judicial committee accordingly refused to confirm a Scotch patent, the invention being used in England before the date of the Scotch patent. *Robinson's Patent, in re*, 5 Moore, P. C. C. 65.

Prolongation and Extension of Terms.]—Three separate original letters patent were granted to the inventor of England, Scotland, and Ireland, respectively. The Scotch patent was void for want of novelty, and afterward a prolongation of the terms of the three original patents was granted by one and the same letters patent under the great seal of the United Kingdom, pursuant to 15 and 16 Vict. c. 83: Held, that the grant of prolongation was divisible, and operated as if there had been separate grants by separate instruments for the three countries, so that the prolongation of the English patent was not rendered void by the invalidity of the Scotch patent. *Bovill* v. *Finch*, 39 L. J., C. P. 277; 5 L. R., C. P. 523; 18 W. R. 1071; 23 L. T., N. S. 151.

Residents Abroad.]—Where the party applying for an extension of a patent is resident abroad, and has no manufacture in Eng-

land, advertising in the newspapers published in the towns or country where the persons to whom he has granted licenses are resident, is a sufficient compliance with the 5 and 6 Will. 4, c. 83, s. 4. *Derosne's Patent, in re*, 4 Moore, P. C. C. 416.

Foreigners.]—The importer of an invention from abroad is an inventor within the 5 and 6 Will. 4, c. 83, and entitled to apply for an extension, but the judicial committee will look with jealousy into the merits of an invention imported. *Claridge's Patent, in re*, 7 Moore, P. C. C. 394.

An importer of a foreign invention, by which the public is benefited, is entitled to be put on the same footing as an original inventor, when applying for a prolongation for such foreign importation. *Berry's Patent, in re*, 7 Moore, P. C. C. 187.

An alien resident abroad, who was interested in an English patent by a foreign inventor, and who had also considerable dealings in this country in respect of sales of the patented machine and in granting licenses for the use of such patent, has such a locus standi as to entitle him to petition the crown to revoke an order in council for granting an extended term of an English patent, and to recall the warrant for sealing such patent. *Ib.; Schlumberger, in re*, 9 Moore, P. C. C. 1.

Application was made under 5 and 6 Will. 4, c. 83, and 2 and 3 Vict. c. 69, by assignees of a patentee, for extension of an English patent for a foreign importation, patented in France. At the date of the application the French patent had expired: Held, that as the foreign patent had expired, no renewed grant would be valid, by s. 25 of the 15 and 16 Vict. c. 83, as s. 7 of the 16 and 17 Vict. c. 115, made an extended patent a new patent, within the provision of the 15 and 16 Vict. c. 83, s. 25. *Aube's Patent, in re*, 9 Moore, P. C. C. 43.

The provisions of the 15 and 16 Vict. c. 83, s. 25, apply only to patents granted in the United Kingdom subsequent to the passing of that statute. *Bodmer's Patent, in re*, 8 Moore, P. C. C. 282.

A patent (a communication from a foreigner abroad) was taken out in England, and the inventor a few weeks afterward obtained letters patent for the invention in America. An applica-

tion was made for a prolongation of the English patent before the American patent had expired: Held, that the case fell within the spirit of the provisions of 15 and 16 Vict. c. 83, s. 25, and the application was refused. *Newton's Patent, in re*, 15 Moore, P. C. C. 176; 9 Jur., N. S. 109.

On an application for the prolongation of a patent granted in the United Kingdom in January, 1849, it was proved that the applicant obtained letters patent in France in respect of the invention in January, 1850, and letters patent in Belgium in respect of the invention in January, 1852, which last letters patent had expired at the time of the application: Held, first, that the earlier part of s. 25 of the 15 and 16 Vict. c. 83, applies only to cases where patents have been granted in foreign countries before the grant of the patent in the United Kingdom, and that the words in the proviso, "any such patent or like privilege," must be taken to refer to the entire description of the patents mentioned in the foregoing part of the section, and to no others. *Betts' Patent, in re*, 1 Moore, P. C. C., N. S. 49; 9 Jur., N. S. 137; 11 W. R. 221; 7 L. T., N. S. 577.

When a patent is taken out in a foreign country before a patent for the invention in the United Kingdom, the latter patent is to terminate at the same time as the foreign patent. *Ib.*

Where the term in a foreign patent has expired, any grant of letters patent in the United Kingdom made after that period is of no validity. *Ib.*

Letters patent for an invention communicated by a foreigner resident abroad, extended for five years. The invention (machinery for letter-press printing) was of a meritorious and useful character, but of an expensive nature, and only at the latter end of the term of the letters patent brought into public use; and although the patent had been worked at a profit, it was not, in the opinion of the judicial committee, sufficiently remunerative, considering the value of the invention. *Newton's Patent, in re*, 14 Moore, P. C. C. 156; 10 W. R. 731.

The 15 and 16 Vict. c. 83, s. 25, does not deprive the judicial committee of the power to entertain an application for an extension of the term of letters patent taken out first in England,

though a patent has been obtained for the same invention in a foreign state; and the foreign patent would expire before the expiration of the prolonged term. *Poole's Patent, in re*, 1 L. R., P. C. 514.

Secus, if the patent was first obtained abroad by a foreign subject, and afterward taken out in England. *Ib.*

When a foreigner patented his invention first in England and afterward in France, which latter patent, at the date of the application for a prolongation of the English patent, had a year to run, the privy council will not recommend the crown to extend the term upon the chance of the French patent being extended. *Normand's Patent, in re*, 3 L. R., P. C. 193; 6 Moore, P. C. C., N. S. 477.

Held, also, that if the French patent had expired there was no power to recommend an extension of the English patent. *Ib.*

An assignee of the patentee who had taken an assignment of four-fifths of the patent within a few months of the expiration of a patent, which had only just been brought into use, for a small consideration, is not entitled to any extension. *Ib.*

2. Grounds, Terms, and Conditions.

What.]—To entitle a patentee to a confirmation of letters patent, under 5 and 6 Will. 4, c. 83, s. 2, the patentee must show that he believed himself the first and original inventor. *Card's Patent, in re*, 6 Moore, P. C. C. 207; 12 Jur. 507.

The merit and utility of the invention; the merit of the petitioner in patronizing an ingenious inventor, and liberally expending money to introduce the invention; the amount of profit not being greater than the ordinary profit on capital employed in similar trades; the annoyances, anxiety, and costs of litigation, are several grounds of consideration in recommending an extension. *Whitehouse's Patent, in re*, 2 Moore, P. C. C. 496.

An extension was granted for five years, the invention being of great merit and public utility, but the patentee and his grantees had received no remuneration in consequence of the originality of the patent being disputed at law. *Smith's Patent, in re*, 7 Moore, P. C. C. 133.

An extension was opposed by the apprentices of the patentee, who alleged that they should not be able to get employment. It appearing, however, that they had been so instructed as to be able to get employment in another branch of the trade, no condition was imposed on the patentee on that account. *Baxter's Patent*, 13 Jur. 593—P. C.

Where letters patent embraced several subjects, one only of which had been worked out, and that part of the patent was affected by subsequent patented improvements by the same patentee, and could not be effectually used without such subsequent improvements, the judicial committee, before recommending an extension of the term of the first patent, put the petitioner upon terms of disclaiming all the parts of the original patent not worked out, and restricted the prolongation of the unexpired term of the subsequent patents. *Bodmer's Patent, in re*, 8 Moore, P. C. C. 282.

A patentee, formerly in partnership with J. and W., by a deed of dissolution stipulated that they should have the exclusive right of granting, in certain cases, licenses for manufacturing the patent article. In recommending an extension, the judicial committee imposed a condition upon the patentee to secure to J., in whom the interest under the deed of dissolution then vested, the same interest in the new letters patent as related to the granting of licenses as was provided by the deed of dissolution, but refused to allow J. to substitute new licenses for those granted under the original letters patent, in the event of the original licensees declining to renew their licenses from him under the new grant. *Normandy's Patent, in re*, 9 Moore, P. C. C. 452.

If it can be clearly shown that the patent sought to be extended is bad for want of originality, the privy council will not entertain the application. Aliter, if at most, a doubtful question as to the validity of the letters patent can be raised. *Betts' Patent, in re*, 1 Moore, P. C. C., N. S. 49; 9 Jur., N. S. 137; 11 W. R. 221; 7 L. T., N. S. 577.

The grounds on which extension of patents are granted have all reference to the inventor. They are, first, to reward the

inventor for the peculiar ability and industry he has exercised in making the discovery. Secondly, to reward him, because some great benefit of an unusual description has by him been conferred upon the public through the invention itself; or, thirdly, because the inventor has not been sufficiently remunerated by the profits derived from his strenuous exertions to make the invention profitable. All these grounds proceed on the supposition that the invention is a new and a useful invention. But where an inventor intentionally delays for a great length of time attempting to put the invention into practice, those reasons for a prolongation of the patent can not be relied upon by him, unless he shows some reasonable ground, such as want of funds, for the delay. *Norton's Patent, in re*, 1 Moore, P. C. C., N. S. 339; 9 Jur., N. S. 419; 11 W. R. 720: *S. P. Markwick, in re*, 8 W. R. 333; 13 Moore, P. C. C. 310.

In an application for a prolongation, the privy council will not try the validity of the patent; and though in general it will not enter into questions of doubtful validity, yet it will not recommend an extension of a patent which is manifestly bad. *Hills' Patent, in re*, 1 Moore, P. C. C., N. S. 258; 9 Jur., N. S. 1209; 12 W. R. 25; 9 L. T., N. S. 101.

In determining whether to recommend an extension, though the validity of a patent may not be directly impeached, yet with respect to the novelty and the utility of the invention, the degree of merit to be attributed to the petitioner is to be taken into account, as well as the amount of remuneration received by him under the patent, as an extension is not of strict right, but rather of equitable reward. *Ib.*

A patent was granted in England before 15 and 16 Vict. c. 83. A patent for a similar invention had been granted in France to another person prior to the English patent, but it did not satisfactorily appear that the English patentee had any previous knowledge of the foreign invention. The French patent had not expired at the time of the application for prolongation: Held, that, although the case did not fall strictly within the terms of s. 25, yet that the policy which the legislature there indicated, was to guide the committee in the exercise of their

discretion, that policy being, to prevent, in the case of inventions made and patented in any foreign country, the continuance of a monopoly in England by means of a patent granted subsequently here, and after the time when the discovery shall have become public property in the foreign country, and that the prolongation of an existing patent fell within such rule. *Ib.*

The patentee of a patent had received large sums of money from government for the expenses of experiments, and by way of bounty and reward, but from the nature of the patent had not, in the opinion of the judicial committee, received sufficient remuneration for his invention; and in granting an extension, the committee refused to impose a condition in the new grant, that the crown should be at liberty to use the invention for the public service without license from the patentee. *Lancaster's Patent, in re*, 2 Moore, P. C. C., N. S. 189.

When the utility of a patent has not been tested by actual employment, for a period of fourteen years, although efforts have been made by the patentee to bring it into use, it raises a very strong presumption against its practical utility, which presumption can only be rebutted by the strongest evidence. *Allan's Patent, in re*, 1 L. R., P. C. 507; 36 L. J., P. C. 76.

If an invention has not been brought into practical use during the term of the letters patent, it raises a strong, though not conclusive, presumption against its utility; and unless there are circumstances to rebut such presumption, an extension will not be granted. *Herbert's Patent, in re*, 1 L. R., P. C. 399.

The fact of a patent of a valuable nature, but having a limited maket, not having been so generally used as to remunerate the inventor, is sufficient to remove the presumption against the utility of the invention. *Ib.*

Petition for prolongation by a patentee, together with the assignees of a moiety of the patent. After the presentation of the petition, and before the hearing, the patentee died, having by his will appointed his widow executrix and residuary legatee. Extension granted to the assignees on condition that they held the moiety of the patent in trust for the widow of the patentee. *Ib.*

A patentee, who was not a manufacturer, granted a license to a manufacturing firm to manufacture the patented article, which, by agreement between them, was of an almost exclusive character. In granting a prolongation, the new letters patent were directed to be made upon condition that licenses should be granted by the patentee to the public upon terms similar to the one already granted. *Mallet's Patent, in re*, 1 L. R., P. C. 308.

Account of Profits.]—The account of profit and loss of the patentee in working a patent, ought to be clear and precise; and it is the duty of a patentee, if engaged in any other business, or as a manufacturer of his own invention, to keep the accounts of the patent and the manufacture separately. *Betts' Patent, in re*, 1 Moore, P. C. C., N. S. 49; 9 Jur., N. S. 137; 11 W. R. 221; 7 L. T., N. S. 577.

If a patentee is also manufacturer of his patent article, in taking account of the profits of the patent he is entitled to deduct his profits as a manufacturer. *Ib.*

In taking an account of the profits and loss of the working of a patent, the patentee is entitled to charge, as part of his expenses, for loss of time in endeavoring to bring the invention into general use. *Newton's Patent, in re*, 14 Moore, P. C. C. 156; 10 W. R. 731.

In calculating whether any profit has been obtained through or by means of a patent, it is correct to deduct, in the first place, beyond the cost price, a fair manufacturer's profit on the articles sold; and the mere preference of the market obtained by the manufacturer is not to be deemed a profit derived from the patent. *Galloway's Patent, in re*, 7 Jur. 453.

The most unreserved and clear statement of the patentee's remuneration is an indispensable condition for extension. *Hill's Patent, in re*, 1 Moore, P. C. C., N. S. 258; 9 Jur., N. S. 1209; 12 W. R. 25; 9 L. T., N. S. 101.

The patentee was also manufacturer and sold the patented articles. In his accounts he deducted two-thirds as profits from the manufacture and sale, and only credited the patent with one-third: Held, to be an unreasonable deduction. *Ib.*

Although law expenses by the patentee in maintaining his patent rights are allowed in deduction of his profits, yet where the patentee compromised suits and gave up costs to which he had an apparent title, a deduction on that head will not be allowed. *Ib.*

To entitle a patentee to a prolongation of the term of letters patent, he must satisfactorily establish the amount of his profits. *Trotman's Patent, in re*, 1 L. R., P. C. 118.

Licenses stand, with respect to the profits, in the same position as assignees of the patent. *Ib.*

Application, under 14 and 15 Vict. c. 99, s. 6, by parties who opposed an extension for production and inspection of the petitioner's accounts previously to the hearing of the petition, refused, with costs. *Bridson's Patent, in re*, 7 Moore, P. C. C. 499.

The books of a petitioner in respect to the profits having been lost during his bankruptcy, the account of profit and of loss was taken upon his own evidence. *Hutchinson's Patent, in re*, 14 Moore, P. C. C. 364.

A patentee, residing in America, for the purpose of getting the patented article into general use in England, arranged with an agent in England, and in consideration gave him a moiety of the royalties: Held, that in estimating the profits of the patentee derived from the patent, such moiety was to be deducted. *Poole's Patent, in re*, 1 L. R., P. C. 514.

A petitioner seeking the grace and favor of the crown, in applying for an extension of the term of letters patent, is bound to bring his accounts before the committee in such a shape as to leave no doubt what the remuneration has been that he has received from the patent. The petition for extension, and the accounts furnished by the petitioner (the patentee), not containing sufficiently full and accurate information in respect to the patent, or the remuneration received by him, the judicial committee declined to recommend a prolongation of the term. The principle, where the statement of the remuneration received by the patentee is, on the face of the petition and accounts filed, unsatisfactory, of adjudicating without reference to the merits

of the invention, as acted on in *In re Saxby's Patent*, recognized *Clark's Patent, in re*, 3 L. R., P. C. Ap. 421—L. J.

Prolongation of term of letters patent for seven years, the invention being a meritorious one, and of great value as a new material for the manufacture of paper; no profit having been made either by the inventor or his assignees. The statement of accounts furnished being *prima facie* satisfactory, the petitioners were allowed to prove the merits of the invention before going into the accounts. *In re Saxby's Patent*, distinguished. *Houghton's Patent, in re*, 3 L. R., P. C. 461—J. C.

3. Practice on.

Caveats.]—The judicial committee will not permit a party to be heard in opposition to an application for a prolongation, unless a caveat has been entered in his name. *Lowe's Patent, in re*, 8 Moore, P. C. C. 1.

Any one of the public has a right to enter a caveat, and to be heard in opposition. *Ib.*

Practice respecting hearing of counsel where several parties enter caveats. *Woodcroft's Patent, in re*, 3 Moore, P. C. C. 171.

An application by the Lords of the Admiralty to enter a caveat, and be heard against a petition for an extension, such caveat not having been filed within the time required by the rules of the Privy Council Office, refused, as the attorney-general was present to watch the interests of the government. *Smith's Patent, in re*, 7 Moore, P. C. C. 133.

A petitioner inserted the last advertisement of his intention to petition for a prolongation on the 24th May, but did not present his petition until the 5th of June. The registrar refused to receive the petition, as being too late. Upon a special application for that purpose, it appearing that the delay arose from a mistake of the petitioner's agent, an order was made admitting the petition. A caveat had been entered: Held, that as the party filling the caveat was interested in sustaining the objection to the reception of the petition, notice of the application must be served on him. *Hutchinson's Patent, in re*, 14 Moore, P. C C. 364.

Attorney-General.]—In cases for an extension, the attorney-general represents the government and the public generally. *Smith's Patent, in re*, 7 Moore, P. C. C. 133.

Costs.]—The judicial committee will exercise a discretion as to the allowance of an opposer's costs upon an abandoned petition for extension of letters patent. *Milner's Patent, in re*, 9 Moore, P. C. C. 39.

A gross sum allowed for costs of opposers, instead of referring their costs to taxation. *Ib.*

An affidavit of merits by a petitioner, upon the question of costs, rejected, as no copy had been served upon the opposers. *Ib.*

Where there were two opponents to an application for a prolongation upon substantially the same grounds of objection, upon a successful opposition, a gross sum was allowed for the costs of both parties. *Jones' Patent, in re*, 9 Moore, P. C. C. 41.

Opponents' costs were directed to be taxed at 100*l.*, and divided between the opponents. *Ib.*

Opposition to an application for extension or confirmation is rather encouraged than otherwise, and upon a successful opposition, the opposer's costs will, in general, be allowed. *Honiball's Patent, in re*, 9 Moore, P. C. C. 378.

When a petition is abandoned, it is not necessary that the opposers should serve the petitioners with notice of their intended application to the court for costs of opposition. *Bridson's Patent, in re*, 7 Moore, P. C. C. 499.

On a petition for prolongation, a day was fixed for hearing. Objections were lodged against an extension. Before the hearing, the petitioners abandoned the prosecution of the petition, and the costs of the opposition were allowed. *Hornby's Patent, in re*, 7 Moore, P. C. C. 503.

VIII. REPEAL OF LETTERS PATENT.

Where it lies.]—By 15 and 16 Vict. c. 83, s. 15, *the writ of scire facias shall lie for the repeal of any letters issued under that act, in the like cases as the same would lie for the repeal of letters patent which may now be issued under the great seal.*

By 12 and 13 Vict. c. 109, s. 29, *the writ of scire facias shall or may be directed to the sheriff of any county.*

Parties.]—To a declaration in scire facias to repeal letters patent, on the ground that B. and S. were not the first and true inventors, and that the invention was not new, or an improvement, B. pleaded that before the suing out of the scire facias, S. assigned to him all his share in the letters patent, and the privilege thereby granted, and had not since had any interest whatever in the letters patent; that S. could not be compelled to plead or demur to the writ and declaration, and therefore B. prayed judgment, whether he ought to be compelled to plead or demur to the declaration: Held, that both had been properly made defendants, the letters patent having been granted to them jointly. *Reg.* v. *Betts*, 15 Q. B. 540; 14 Jur. 912; 19 L. J., Q. B. 531.

Held, also, that the joinder of too many defendants could not be made the subject of a plea in abatement, and therefore that the plea was bad. *Ib.*

Particulars.]—By 15 and 16 Vict. c. 83, s. 41, *the prosecutor in any proceedings by scire facias to repeal letters patent shall deliver, with the declaration, particulars of any objections on which he means to rely at the trial in support of the suggestions of the declaration in the proceedings by scire facias;*

And at the trial of such proceeding by scire facias 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 prosecutor to amend the particulars, upon such terms as to such judge shall seem fit. (Similar to 5 and 6 Will. 4, c. 83, s. 5, but more comprehensive.)

On scire facias to repeal a patent, the prosecutor having, while the record was in chancery, filed notice of objections, namely, that other persons than the patentee had used the invention in England before the grant of the patent, the court refused to order delivery of a particular, stating the names and addresses of such persons. *Reg.* v. *Walton*, 2 Q. B. 969.

Pleadings.]—By 12 and 13 Vict. c. 109, s. 31, *the pleadings are to be delivered and not filed.*

The notice of objections in scire facias to repeal a patent, is not part of the record. *Reg.* v. *Mill*, 1 L. M. & P. 695; 10 C. B. 379; 15 Jur. 59; 20 L. J., C. P. 16.

A scire facias having issued out of chancery to repeal letters patent, the patentee presented a petition to the common law side of the court, alleging that the writ contained improper recitals and suggestions, which, if used as a defense in an action for the infringement of a patent, would be inadmissible, and praying that the writ might be quashed or reformed by striking out the objectionable matter, Cranworth, C., declined to exercise the jurisdiction reserved to him by 12 and 13 Vict. c. 109, s. 46, on the ground that, by s. 39, jurisdiction in such cases was conferred on the judges of the superior courts of common law, and that they could more satisfactorily dispose of the question of pleading involved in the case. *Reg.* v. *Hancock*, 5 De G., M. & G. 332.

Trial.]—By 12 and 13 Vict. c. 109, s. 32, *issues may be tried in any of the superior courts.*

By 15 and 16 Vict. c. 83, s. 41, *at the trial of any proceedings by scire facias to repeal letters patent the defendant shall be entitled to begin and to give evidence in support of such letters patent, and in case evidence shall be adduced on the part of the prosecutor impeaching the validity of such letters patent, the defendant shall be entitled to the reply.* See *Reg.* v. *Cutler*, 3 C. & K. 215.

The court upon terms postponed the trial of a patent cause for a definite period, to await the result of a motion pending in another court on a scire facias to repeal the patent. *Smith* v. *Upton*, 6 Scott, N. R. 804: *S. C.* nom. *Muntz* v. *Foster*, 1 D. & L. 942.

Pending a proceeding in scire facias to repeal a patent, the patentee disclaimed a part. The prosecutor still proceeded, and ultimately failed: Held, that he ought to pay the costs subsequent to the disclaimer. *Reg.* v. *Mill*, 14 Beav. 312.

A patentee applied to the court of Chancery to stay all proceedings on a scire facias to repeal the patent, or that a nolle prosequi might be entered, on the ground, first, that the prosecutor was an alien; secondly, that he had no special interest in the patent or the repeal of it, but was acting in collusion with other persons, with a view to oppress the patentee; and thirdly, that the security for costs given by the prosecutor was improper and insufficient: Held, that the court had no authority to interfere in the matter. *Reg.* v. *Prosser*, 11 Beav. 306; 13 Jur. 71; 18 L. J., Chanc. 35.

The attorney-general conducts the proceedings on a scire facias according to his own judgment and discretion, and may, when he thinks fit, stay the proceedings or enter a nolle prosequi. The control which the attorney-general exercises is subject only to the responsibility to which every public servant is liable in the discharge of his duty, and subject to the jurisdiction which the courts may have over him, upon a charge properly brought against him for negligence or an erroneous performance of his duty. *Ib.*

The usual issues may be granted in a patent suit before the hearing of the cause, although the defendant denies the validity of the plaintiff's patent on the ground of the generality of the claim in the specification. Decision of Wickens, V.-C., reversed. *Arnold* v. *Bradbury*, 6 L. R., Chanc. App. 706—C.

Judgment.]—On scire facias brought in the Petty Bag Office in Chancery to repeal letters patent for an invention, if issues of fact are joined there, and the record sent to the Queen's Bench

for a trial, which is had, and a verdict found for the crown, the Queen's Bench, though the letters patent remain in Chancery, may give judgment that they be revoked, cancelled, vacated, disallowed, annulled, void and invalid, and be altogether had and held for nothing, and also that the enrollment thereof be cancelled, quashed, and annulled, and that they be restored to the court of Chancery, there to be cancelled. *Bynner* v. *Reg.* (in error), 9 Q. B. 523; 10 Jur. 867; 15 L. J., Q. B. 414—Exch. Chanc.

After a judgment in scire facias in the Queen's Bench, annulling letters patent, and directing that they should be restored to the court of Chancery to be cancelled, the lord chancellor has no jurisdiction to stay the execution of the judgment, his duty in cancelling the enrollment being only ministerial. *Reg.* v. *Eastern Archipelago Company*, 4 De G., M. & G. 199.

IX. PROOF OF PATENT DOCUMENTS.

English.]—By 16 and 17 Vict. c. 115, s. 4, *printed or manuscript copies or extracts, certified and sealed with the seal of the commissioners of patents, of letters patent, specifications, disclaimers, memoranda of alterations, and all other documents recorded and filed in the commissioners' office, or in the office of the court of Chancery appointed for the filing of specifications, shall be received in evidence in all proceedings relating to letters patent for inventions in all courts whatever within the United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, and her Majesty's colonies and plantations abroad, without further proof or production of the originals.*

Foreign.]—The grant of letters patent by a foreign country (being an act done by the governing power in a matter which is to affect the public interests, restraining them for the present, and giving a particular individual specific rights, but throwing open and protecting the public rights after the expiration of a certain term) is an act of state, within 14 and 15 Vict. c. 99, s. 7,

and is therefore provable by a copy of the letters patent, purporting to be sealed with the seal of such foreign state, without proof of the seal or signature, or judicial character of the person signing the same. *Betts' Patent, in re*, 1 Moore, P. C. C. 49; 9 Jur., N. S. 137; 11 W. R. 221; 7 L. T., N. S. 577.