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AND IN THE COLONIES.

WITH AN APPENDIX CONTAINING THE STATUTES,

RULES, ETC.

BY WILLIAM FISCHER AGNEW,

OF LINCOLN'S INN, BARRISTER-AT-LAW.

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THE LAW AND PRACTICE RELATING TO LETTERS PATENT FOR INVENTIONS.

CHAPTER I.

OF THE GRANT OF LETTERS PATENT.

Monopoly.

THE right to grant monopolies to inventors of new manufactures has always been considered as part of the prerogative of the Crown. Sir Edward Coke defines monopolies as follows: "A monopoly is an institution or allowance by the king; by his grant, commission, or otherwise, to any person or persons, bodies politic or corporate, of or for the sole buying, selling, making, working, or using of any thing whereby any person or persons, bodies politic or corporate, are sought to be restrained of any freedom or liberty that they had before, or hindered in their lawful trade."(a)

The grant is by "letters patent," that is, open letters, *litteræ patentes*: so called because they are not sealed up but exposed to open view, with the great seal pendent at the bottom; and are usually directed or addressed by the sovereign to all her subjects at large, in this respect differing from other letters of the sovereign which are closed up and sealed on the outside, and are therefore called writs *close*, *litteræ clausæ*. (b)

(a) 3 Inst. 181.

(b) 2 Bl. Com. 349 (Kerr).

CHAP. I.

Before the statute of monopolies (21 Jac. I. c. 3) was passed, it was decided that a monopoly might be granted to any person who "by his own charge and industry or by his own wit or invention doth bring any new trade into the realm," (*a*) and in the *Cloth-workers of Ipswich case*, (*b*) it was said that "if a man hath brought in a new invention and a new trade within the kingdom in peril of his life and consumption of his estate or stock, or if a man hath made a new discovery of anything, in such cases the king of his grace and favour, in recompence of his costs and travail, may grant by charter unto him, that he only shall use such a trade or trafique for a certain time because at first the people of the kingdom are ignorant and have not the knowledge or skill to use it."

Term of patents.

These principles were followed in the statute, which, after declaring monopolies to be void, enacts that "any declaration before mentioned shall not extend to any letters patent, and grants of privilege, for the term of fourteen years or under, hereafter to be made of the sole working or making of any manner of new manufacture, within this realm to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patent and grants shall not use, so that they be not contrary to law or mischievous to trade, by raising the prices of commodities at home or hurt of trade or generally inconvenient." This statute does not introduce a new law, but is simply declaratory of the common law and simply exempts patents which were good at common law from the penalty which the statute

(*a*) *Darcy* v. *Allin*, Noy. 182; Shepp. Abr. part III. tit. Prerog. p. 61.

(*b*) Godb. 254.

imposes upon such patents as were thereby prohibited. (*a*)

Object of granting patents.

The object of granting patents is that the person, who has benefited the public by bringing some new and useful manufacture into the country, may be rewarded for his ingenuity and trouble, and for the expense to which he has been put.

A patent is not a grant of a monopoly in the sense of the old definition, but is a grant by the Crown to an inventor, of the right of practising a new and useful invention for a limited time. The patentee may be looked upon as a purchaser from the public; for an inventor has not an exclusive property in an invention, he has only the right to exercise his own invention freely for a limited period; and the consideration for which this grant is made, is the benefit to the public resulting from the invention by the use of it; first, under the patent, and secondly, after the term has expired. On the other hand the patentee is not obliged to make his invention known, he may keep it a secret; it is therefore only reasonable that if he makes it known he should receive some compensation from the public, who are to have the ultimate benefit of the invention.

The mode of securing such compensation to the patentee, adopted in this and in almost every other country, namely, of granting to him the sole right of using his invention for a limited time, seems to be the best that can be devised. In certain cases where the merit of the invention has been very great, or where the inventor could not be rewarded in any other way, grants of public money have been made, but it is evident that this course could not be adopted in every case, not only from

(*a*) 3 Co. Inst. c. 85, pp. 181—184.

CHAP. I.

the expenditure of money that would be required, but also from the impossibility of ascertaining what the proper remuneration should be; whereas by granting a monopoly, the gain made by the inventor when his invention is known will be proportionate to the amount of benefit which the public derive from the use of it.

Utility.

There must be a certain amount of utility in the invention, otherwise a patent will not be granted (see *post*, Ch. III.) (*a*)

(*a*) See as to the history of letters patent for inventions, Hindmarch on Patents; Webster on the Law of Patents; Curtis on Patents (America).

CHAPTER II.

OF THE PERSONS TO WHOM LETTERS PATENT MAY BE GRANTED.

True and first inventor.

THE Statute of Monopolies (21 Jac. I. c. 3) provides that letters patent may be granted to the "true and first inventor." If the invention, for which a patent has been taken out, is borrowed from a previous specification, (*a*) or has been communicated by other persons in the kingdom, (*b*) or has been previously described in a book published in the kingdom, (*c*) even if it has not been reduced into practice, (*d*) and is in fact practically a new discovery to the world, (*e*) or if there has been any public user of a similar invention, (*f*) the patentee cannot be the "true and first inventor." (*g*)

Invention must be that

In order that a patent may be valid the subject matter

(*a*) *Walton* v. *Potter*, 1 Webs. P. R. 592; *Lewis* v. *Marling*, 4 C. & P. 52; 10 B. & C. 27; 1 Webs. P. R. 495.

(*b*) *Cornish* v. *Keene*, 1 Webs. P. R. 507; *Tennant's Case*, Dav. P. C. 29; 1 Webs. P. R. 125, n.

(*c*) *Walton* v. *Potter*, 1 Webs. P. R. 592; *Cornish* v. *Keene*, 1 Webs. P. R. 507; *Muntz* v. *Foster*, 2 Webs. P. R. 102; *Jones* v. *Pearce*, 1 Webs. P. R. 122.

(*d*) *Walton* v. *Potter*, 1 Webs. P. R. 592.

(*c*) *Cornish* v. *Keene*, 1 Webs. P. R. 507; *Muntz* v. *Foster*, 2 Webs. P. R. 102.

(*f*) *Carpenter* v. *Smith*, 9 M. & W. 300; 1 Webs. P. R. 543.

(*g*) See also *post*, Ch. III., publication and user.

CHAP. II.

of patentee himself.

must have been invented by the patentee himself,(a) and he must have invented every part of what he claims to have invented.(b) In *Losh* v. *Hague*,(c) Lord Abinger, C.B., said: "If a man claims by his patent a number of things, as being the inventor of them, whether they consist of improvements or original inventions, and it turns out that some of them be not original and not improvements, his patent is void."

If not, the Crown is deceived

If it can be shown that the patentee is not the inventor of the patented article, the crown is deceived in the suggestion on which the patent is granted, and the patent is therefore void.(d)

and the interests of the public affected.

It is against the interests of the public also that they should be prevented from using the invention. The object of the grant is to reward the inventor for the future benefit to be received by the public, and this reason cannot apply to a person who has not invented the machine, for the public are already entitled to use it.

"A patent," said Lord Ellenborough, "is a species of property highly important, as it respects the interests of the individual, and with him also the interests of the public; on the one hand, persons who are really the means of promoting any beneficial object should be protected for the period the law allows, and should have the benefit of the article so invented; and on the other hand, in case they are not the inventors they should not lock up from the public for that limited period of

(a) *R.* v. *Arkwright*, Dav. P.C. 68; *R.* v. *Wheeler*, 2 B. & Ald. 349; *Jones* v. *Pearce*, 1 Webs. P. R. 124.

(b) *Tennant's Case*, 1 Webs. P. R. 125, n.

(c) 1 Webs. P. R. 208.

(d) *Minter* v. *Wells*, 1 Webs. P. R. 129; *R.* v. *Wheeler*, 2 B. & Ald. 349.

time that invention, which, if they are not the inventors, they have no priority to, and which ought to be open to the public." (*a*)

Simultaneous discoverers, first patentee is inventor.

If several persons simultaneously discover the same thing, the one who first communicates it to the public under the protection of a patent becomes the legal inventor, and is entitled to the benefit of it. (*b*)

Invention by servant.

If a servant while in the employment of his master invents a machine, the invention belongs to him and not to the master. (*c*)

Patentee may have assistance.

But if an inventor employs mechanics to work out the details of his invention and to carry his idea into execution, any thing suggested or invented by any person so employed and subsidiary to such idea is the invention of the patentee. (*d*) In *Minter* v. *Wells*, (*e*) it was suggested that the invention was that of a mechanic named Sutton. Alderson, B., said: "Minter and Sutton were together about the time the invention took place; which of the two suggested the invention and which carried it into effect is a question for you to decide. If Sutton suggested the principle to Mr. Minter, then he would be the inventor. If, on the other hand, Mr. Minter suggested the principle to Sutton, and Sutton was assisting him, then Mr. Minter would be the first and true inventor, and Sutton would be a machine, so to speak, which Mr. Minter used for the purpose of enabling him to carry his original conception into effect." (*f*)

(*a*) *Huddart* v. *Grimshaw*, 1 Webs. P. R. 86; Dav. P. C. 265.

(*b*) *Forsyth* v. *Rivière*, 1 Webs. P. R. 97; *Cornish* v. *Keene*, 1 Webs. P. R. 508.

(*c*) *Bloxam* v. *Elsee*, 1 C. & P. 558; 6 B. & C. 169; *R.* v. *Arkwright*, Dav. P. C. 61; 1 Webs. P. R. 64.

(*d*) *Barker* v. *Shaw*, 1 Webs. P. R. 126; *Barber* v. *Walduck*, 1 C. & P. 567.

(*e*) 1 Webs. P. R. 129.

(*f*) And see *Bloxam* v. *Elsee*, 1 C. & P. 558; 6 B. & C. 169.

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The rule appears to be that where the principle and object of the invention are complete without the suggestions of the servant, and his suggestions merely carry out the intention of the inventor more easily, the validity of the patent will not be affected. "It would be difficult," said Sir N. C. Tindal, C. J., "to define how far the suggestions of a workman are to be considered as distinct inventions by him, so as to avoid a patent incorporating them taken out by his employer. Each case must depend upon its own merits. But when we see that the principle and the object of the invention are complete without it, I think it is too much that a suggestion of a workman, employed in the course of the experiments of something calculated more easily to carry into effect the conceptions of the inventor, should render the whole patent void." (*a*) See as to the terms on which letters patent were granted, in the case of dispute between master and servant, *Re Russell's Patent*. (*b*)

Importer of an invention is true and first inventor.

The importer of an invention which has never before been used in this country has from a very early period been considered to be an inventor and entitled to letters patent. (*c*)

Invention must be new in England.

The earliest case reported on this point since the statute of monopolies (21 Jac. I. c. 3) is the case of *Edgeberry* v. *Stephens*, (*d*) where it was held that "if the invention be new in England a patent may be granted, though the thing was practised beyond the sea before;

(*a*) *Allen* v. *Rawson*, 1 C. B. 575; *Hatton* v. *Kean*, 7 C. B. (N. S.) 275.

(*b*) 2 D. G. & J. 130; noted *post* under the head of sealing, tit. "Terms."

(*c*) *Darcy* v. *Allin*, Noy. 182; Sheph. Abr. part. III. tit. Prerog. p. 5; *Clothworkers of Ipswich Case*, Godb. 254.

(*d*) 2 Salk. 447; 1 Webs. P. R. 35.

for the statute speaks of new manufactures within this realm; so that if they be new here, it is within the statute; for the act intended to encourage new devices useful to the kingdom, and whether learned by travel or by study it is the same thing." (*a*)

In *Walton* v. *Bateman*, (*b*) Cresswell, J., said: "The party obtaining the patent must be the true and first inventor in this country. If he import from a foreign country that 'which others at the time of the making of such letters patent and grants did not use,' it will suffice." (*c*)

If a patent is taken out as for an original invention when it is in fact communicated from abroad by a British subject it is void. (*d*)

If an invention has been known in Scotland, a person importing it into England cannot be considered the first and true inventor. (*e*)

Patent may be taken out by trustee for foreign inventor.

When a patent was taken out in this country by a British subject and held by him as trustee for the inventor, a foreigner, it was contended, that in order to come within the statute the person taking out the patent in this country should be the meritorious importer, and not merely servant or agent for the purpose of taking out the patent for the benefit of the foreign inventor. Sir N. C. Tindal said: "No authority is cited for such dis-

(*a*) See also *Boulton* v. *Bull*, 2 H. Bl. 491.

(*b*) 1 Webs. P. R. 615.

(*c*) And see *Carpenter* v. *Smith*, 1 Webs. P. R. 535; *Stead* v. *Anderson*, 2 Webs. P. R. 149; *Crane* v. *Price*, 4 M. & Gr. 580; 5 Scott, N. R. 338; 1 Webs. P. R. 411; *Nickels* v. *Ross*, 8 C. B. 723.

(*d*) *Milligan* v. *Marsh*, 2 Jur. (N. S.) 1083.

(*e*) *Brown* v. *Annandale*, 8 C. & F. 437; *Robinson's Patent*, 5 Moo. P. C. C. 65; *S. C. nom. Pow's Patent*, 2 Webs. P. R. 2.

tinction, and so far as the public are concerned in interest no such distinction is necessary." It was also contended that the patent was invalid, as being taken out in trust for aliens residing abroad, and this objection was also overruled. (*a*)

Alien enemy.

In another case the point was raised whether a patent could be taken out in trust for an alien enemy, but was not decided. (*b*)

Foreign inventor parted with interest abroad.

If the original inventor abroad has parted with his discovery abroad, he may nevertheless take out a patent here, as his right to an English patent is not affected by the foreign transaction. (*c*)

Communication from abroad, not confidential, entitles recipient to patent.

Any person receiving a communication from abroad may take out a patent if the communication is not confidential. "I apprehend," said Sir W. P. Wood, V.C., "that any person not being in a confidential position towards the first inventor, receiving from a person abroad an invention, is entitled, perhaps not in a strictly moral view, but at all events according to law, to take out a patent on his own account for an invention so communicated." (*d*)

And he may improve on a confidential communication.

And it appears that a person who receives a confidential communication from abroad which is useless in itself and incapable of application may take out a patent for his own benefit, if the effect of the communication is to set him thinking, and leads to a discovery of a practical mode of carrying out the idea. (*e*)

(*a*) *Beard* v. *Egerton*, 3 C. B. 129.

(*b*) *Bloxam* v. *Elsee*, 1 C. & P. 558; 6 B. & C. 169; and see *Beard* v. *Egerton*, 3 C. B. 129.

(*c*) *Beard* v. *Egerton*, 3 C. B. 131.

(*d*) *Steedman* v. *Marsh*, 2 Jur. (N. S.) 392.

(*e*) *Milligan* v. *Marsh*, 2 Jur. (N. S.) 1083.

CHAPTER III.

OF THE SUBJECT MATTER OF LETTERS PATENT.

Novelty.

THE sixth section of the Statute of Monopolies (21 Jac. I. c. 3) provides "that any declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under, hereafter to be made of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patent and grants shall not use, so as they be not contrary to the law nor mischievous to the State by raising prices of commodities at home, or hurt of trade or generally inconvenient."

In *Liardet* v. *Johnson*, (*a*) Lord Mansfield said that it was always a question whether the invention was publicly known and in use before the patent was taken out. It will be convenient to consider first, what amount of publication and user will invalidate a patent: secondly what constitutes a "new manufacture" within the meaning of the statute, and thirdly whether the invention is useful, which is a condition imposed by the common law and not by the statute.

Publication in a book, which

If the invention has been previously described in a

(*a*) Bull (N. P.) 76; 1 Webs. P. R. 53.

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has been circulated, invalidates subsequent patent.

book published in this country, the patent will be void. In *R.* v. *Arkwright*, (*a*) Buller, J., said: "It is admitted that this is not a new discovery, for Emmerson's book was produced, which was printed a third time in 1773, and that is precisely the same as this;" and in the course of the argument of *Morgan* v. *Seaward*, (*b*) Alderson, B., referring to the case of Dollond's patent cited in *Boulton* v. *Bull*, (*c*) said: "If Dr. Hall had published his discoveries in a book, I apprehend that would have put an end to Dollond's patent." (*d*) In *Cornish* v. *Keene*, (*e*) the same learned judge said; "Although it is proved that this is a new discovery so far as the world is concerned, yet if anybody is able to show, that although that was new, that the party who got the patent was not the man whose ingenuity first discovered it, that he got it from A. or B., or took it from a book that was printed in England, and which was open to all the world then, although the public had the benefit of it, it would become an important question whether he was the first and true inventor." And in *Walton* v. *Potter*, (*f*) Sir N. C. Tindal, C. J., said: "Though the matter may not have been used, the party is not entitled to his patent unless he is the first and true inventor; therefore, if the subject matter of the patent has been discovered, has been published in a dictionary, for example, though it has not been reduced into practice, if a man merely adopts it, the merit is so small, that his patent for it would be worth nothing."

In the course of the argument in the case of *The*

(*a*) 1 Webs. P. R. 72.

(*b*) 2 M. & W. 554; 1 Webs. P. R. 190.

(*c*) 2 H. Bl. 470.

(*d*) See *Carpenter* v. *Smith*, 9 M. & W. 300; 1 Webs. P. R. 543.

(*e*) 1 Webs. P. R. 507.

(*f*) 1 Webs. P. R. 592.

Household Co. v. *Neilson*, (*a*) Lord Lyndhurst observed: "If the machine is published in a book, distinctly and clearly described, corresponding with the description in the specification of the patent, though it has never been actually worked, is not that an answer to the patent? It is continually the practice on trials for patents to read out of printed works, without reference to what has been done." And Lord Brougham added: "It negatives being the true and first inventor, which is as good as negativing the non-user. The book that is generally referred to is the 'Repertory of Arts and Sciences.' It must not be a foreign book, but published in England."

In a case before Lord Romilly, M. R., his lordship said that it would make no difference that the book was in a foreign language, if it was exposed for sale. It does not appear, however, from the report, that the case of *The Household Co.* v. *Neilson* was cited in argument. (*b*)

Secus, if book has not been circulated.

Where the book has never been circulated, and has been lost sight of, it becomes a question whether there has been such a publication as to invalidate a patent. "If the invention," said Sir N. C. Tindal, C. J., "has already been made public in England, by a description contained in a book, whether written or printed, which has been publicly circulated, in such a case the patentee is not the first and true inventor within the meaning of the statute, whether he has himself borrowed his invention from such publication or not; because the public cannot be precluded from the right of using such information as they were already possessed of at the time the patent was granted. It is obvious that the application of this principle must depend upon the particular circumstances

(*a*) 1 Webs. P. R. 718 *n.*

(*b*) *Lang* v. *Gisborne*, 31 Beav. 133.

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

Publication in a book is an objection, not merely evidence of objection.

Publication in a book which has been exposed for sale is an objection to the validity of the patent, not merely evidence of an objection. "I think," said Maule, J., "it is an objection, to the patent, and not evidence simply of an objection that there has been a previous patent and a specification enrolled, and therefore published being enrolled, containing the invention. In the same way, I think it is an objection to a patent that it has been published in such a book." (*b*)

Sale of book not necessary.

It is not necessary to establish the fact that a single copy of the book has been sold—the publication is complete as soon as the book is exposed for sale in the bookseller's shop. (*c*)

Publication in a specification vitiates subsequent patent,

If an invention has been described in a specification, a subsequent patent for a similar invention will be void; but in certain cases when the invention has been abandoned it has been held that a subsequent patent was not void, (*d*) and by 5 & 6 Will. IV. c. 83, s. 2, provision is made for confirming letters patent granted to a *bonâ fide* inventor who

(*a*) *Stead* v. *Williams*, 8 Scott (N. R.) 472; 2 Webs. P. R. 142; *Stead* v. *Anderson*, 2 Webs. P. R. 150.

(*b*) *Jones* v. *Berger*, 6 Scott (N. R.) 219; 1 Webs. P. R. 550.

(*c*) *Lang* v. *Gisborne*, 31 Beav. 133.

(*d*) See *post*, tit. Experiments.

discovers that his invention has already been described. (*a*) The general rule is, however, that if prior to the time of obtaining a patent any part of the substance of the invention has been communicated to the public by a specification of any other patent, or is known, the benefit of a patent cannot be claimed; (*b*) and the latter patent will be void even if there is some difference in the mode of working, if the invention is substantially the same. Thus where a patent was granted for "improvements in the construction of racks and pulleys for window blinds and other useful purposes," which, 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, so as to fix the pulley spindle firmly to the frame; and it appeared that by a previous patent the same object had been effected by a similar method, with the addition merely of a thin piece of metal called an escutcheon which worked outside the frame, but the specification stated that the pulleys might be made without the escutcheon, it was held that the two patents were substantially the same as to one of the things claimed, and that the one first described was void. (*c*)

even if some difference in mode of working.

The fact that another specification for a similar invention has been filed since the date of the plaintiff's patent, but

(*a*) See *post*, chapter on Confirmation of Letters Patent.

(*b*) *Huddart* v. *Grimshaw*, 1 Webs. P. R. 86; *Hill* v. *Thompson*, 8 Taunt. 375; 1 Webs. P. R. 244; *Brunton* v. *Hawkes*, 4 B. & Ald. 542; *Forsyth* v. *Rivière*, 1 Webs. P. R. 97; *Muntz* v. *Foster*, 2 Webs. P. R. 107.

(*c*) *Dobbs* v. *Penn*, 3 Exch. 427; *Bush* v. *Fox*, 5 H. & C. 707; *McCormick* v. *Gray*, 7 H. & N. 26.

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before the latter was filed, is not of itself any proof of want of novelty in the plaintiff's invention. (*a*)

In *Booth* v. *Kennard* (*b*) the plaintiff's patent, obtained in 1852, for improvements in the manufacture of gas, was described in the specification to "consist in the direct use of seeds, leaves, flowers, branches, nuts, fruit, and other substances and matters containing oil or oily or resinous matter," and the mode of using the materials, it was stated, might be the same as the apparatus used in the ordinary mode of making gas from coal. The claim was in these words: "I claim for making gas direct from seeds and matters herein named for practical illumination or useful purposes, instead of making it from the oils, resins, or gums previously extracted from such substances." A patent obtained in 1829 was given in evidence by the defendant, in which the inventor proposed to use fatty substances such as greases or grains; also the residuum after the oil had been expressed from seeds such as oil cake; also beech nuts, mast, cocoa nuts, and other matters abounding in oil, and it was held that the latter specification showed that the making gas direct from seeds and other oily matters was not new at the date of the plaintiff's patent and that it was therefore void. (*c*)

Specification not different from any other publication.

A specification of a patent does not differ from any other publication of an invention for the purpose of invalidating a subsequent patent for want of novelty; (*d*) it may describe the process to be adopted so insufficiently as to invalidate the patent and yet disclose enough to

(*a*) *Cornish* v. *Keene*, 1 Webs. P. R. 519.

(*b*) 2 H. & N. 84.

(*c*) See also *Hullett* v. *Hague*, 3 B. & Ad. 370; *Muntz* v. *Foster*, 2 Webs. P. R. 92; *Allen* v. *Rawson*, 1 C. B. 551.

(*d*) *Hills* v. *Evans*, 4 D. G. F. & J. 288; 8 Jur. (N. S.) 529.

show that what is claimed by a subsequent patent is not new. (*a*)

Publication in provisional specification.

If a patentee files a provisional specification which he abandons, and afterwards files another provisional specification before the time for provisional protection has expired, the abandonment itself will not be a publication. (*b*)

Amount of information must be equal to that required from a specification.

The amount of information given by a prior publication in order to avoid a subsequent patent, must be equal to that required to be given by a specification and must be enough to enable the public to carry the invention into practical use. (*c*)

In *Hills* v. *Evans* (*d*) Lord Westbury said: "The antecedent statement must be such that a person of ordinary knowledge of the subject would at once perceive, understand, and be able practically to apply the discovery without the necessity of making further experiments and gaining further information before the invention can be made useful. If something remains to be ascertained which is necessary for the useful application of the discovery, that affords sufficient room for another valid patent. By the words of the statute of James it is necessary for the validity of a patent that the invention should not have been known, or used at the time. These words are held to mean, 'not publicly known or publicly used.' What amounts to public knowledge or public use is still to be ascertained. One of the means of imparting knowledge to the public is the publication of a

(*a*) *Betts* v. *Neilson*, L. R. 3 Ch. 429.

(*b*) *Oxley* v. *Holden*, 8 C. B. (N. S.) 660.

(*c*) *Young* v. *Fernie*, 4 Giff. 577; *Lewis* v. *Marling*, 10 B. & C. 22; 4 C. & P. 52; 1 Webs. P. R. 490.

(*d*) 4 De G. F. & J. 300; 8 Jur. (N. S.) 529.

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book or the recording of a specification of a patent. If, therefore, in disproving that allegation which is involved in every patent that the invention was not previously known, appeal be made to an antecedently published book or specification, the question is what is the nature and extent of the information thus acquired which is necessary to disprove the novelty of the subsequent patent? There is not I think any other general answer that can be given to this question than this, that the information as to the alleged invention given by the prior publication must for the purpose of practical utility be equal to that given by the subsequent patent. The invention must be shown to have been before made known. Whatever therefore is essential to the invention must be read out of the prior publication. If specific details are necessary for the practical working and real utility of the alleged invention, they must be found substantially in the prior publication." And in *Betts* v. *Menzies* (*a*) his lordship said, "A barren general description, probably containing some suggested information or involving some speculative theory, cannot be considered as anticipating, and as therefore avoiding for want of novelty, a subsequent specification or invention which involves a practical truth productive of beneficial results, unless you ascertain that the antecedent publication involves the same amount of practical information."

General description not vitiate subsequent patent.

Antecedent publication must enable public to use invention.

The amount of information must be such as to enable the public to use the invention, if not with infallible success, at least with certainty, (*b*) and the novelty of a patent will not be impeached by proof that a patent for a similar invention has been taken out many years pre-

(*a*) 10 H. & C. 154. (*b*) *Betts* v. *Neilson*, L. R. 3 Ch. 435.

viously, if it can be shown that the object of the second could not have been obtained by the first even with the assistance of subsequent knowledge and improved machinery. (*a*)

If an alleged discovery is made, but is not claimed, and no article is made according to it, it is a strong argument that the alleged discoverer has not been able to make the principle available for general use, (*b*) and any person who subsequently discovers a practical method of using such principle will be entitled to a patent. (*c*)

Public user of an invention vitiates subsequent patent.

No valid patent can be granted for an invention which has been publicly used and generally known, that is to say, known to the public generally, or at least to that portion of the public whose attention is turned to such matters, even though the user is unknown to the patentee. (*d*) A very slight amount of user is enough to vitiate a patent, provided that it is public. Thus, where a patent was taken out for a process of bleaching, and the great utility of the invention and the fact that the process was not known to bleachers was proved; but it was shown that another person had used the same process for five or six years anterior to the date of the plaintiffs' patent and had kept his method secret from all but his two partners and two servants employed in working the process, Lord Ellenborough non-suited the plaintiff on the ground of previous user. (*e*) In *Cornish* v. *Keene* (*f*) Sir N. C. Tindal

(*a*) *Muntz* v. *Foster*, 2 Webs. P. R. 93; *Betts* v. *De Vitre*, 11 L. T. (N. S.) 445; *Neilson* v. *Betts*, L. R. 5 H. & I. 345; *Stevens* v. *Keating*, 2 Exch. 772; 2 Webs. P. R. 192; *McCormick* v. *Gray*, 7 H. & N. 26.

(*b*) *Minter* v. *Mower*, 1 Webs. P. R. 139; *Morgan* v. *Seaward*, 1 Webs. P. R. 186.

(*c*) *R.* v. *Wheeler*, 2 B. & Ald.

(*d*) *Stead* v. *Anderson*, 2 Webs. P. R. 149.

(*e*) *Tennant's Case*, Dav. P. C. 429; 1 Webs. P. R. 125, n.

(*f*) 1 Webs. P. R. 508.

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said: "The main question is whether this invention was or was not in use in England at the time of granting these letters patent; was it or was it not in the language of the Act of Parliament, such a manufacture (which has a very wide and extended meaning you may almost call it invention); was it or was it not such an invention at the time of making the letters patent as was current in use? If it was at the time these letters patent were granted in any degree of general use; if it was known at all to the world publicly and practised openly so that any other person might have the means of acquiring the knowledge of it, as well as this person who obtained the patent, then the letters patent are void."

Public user is user in public.

The public user and exercise of an invention means a user and exercise in public, not by the public, such a user as to come to the knowledge of others than the inventor as contradistinguished from the user of it by himself in private. Thus where the plaintiff was the inventor of a new lock, and it was proved that a similar lock had been used on a gate adjoining the public road for several years, and also that several dozens of the locks had been made in England and sent abroad without any secresy, it was held that this was such a public user and exercise of the invention as to avoid the patent. (*a*)

User need not come down to date of patent.

It is not necessary that the user should come down to the time when the patent was granted. (*b*) In the case of *The Househill Iron Co.* v. *Neilson*, (*c*) Lord Lyndhurst said: "If it is proved distinctly that a machine of the same kind was in existence and was in public use, that is, if use or if trials had been made of it in the eye and in the

(*a*) *Carpenter* v. *Smith*, 9 M. & W. 300; 1 Webs. P. R. 543.

(*b*) *Ibid.*

(*c*) 9 C. & F. 788; 1 Webs. P. R. 709.

presence of the public, it is not necessary that it should come down to the time when the patent was granted. If it was discontinued, still that is sufficient evidence in support of the prior use so as to invalidate the letters patent. . . . . I never heard it before questioned that the notorious public use of an invention before the granting of the letters patent, though it may have been discontinued, is sufficient to invalidate the letters patent."

General user to be distinguished from experiments.

General user in public must however be distinguished from experiments and trials kept secret by the inventor or experiments abandoned as useless. (*a*)

If invention kept secret, subsequent patent not vitiated.

But if a person who has made a discovery does not publish it, a subsequent patent for the same invention will not be void. In order to constitute such publication as will defeat a subsequent patent, there must have been some user of the invention, some steps must have been taken to make it known. In *Boulton* v. *Bull*, (*b*) the case of *Dollond's* patent was referred to and Buller, J., said: "The objection to *Dollond's* patent was that he was not the inventor of the new method of making object glasses. But it was holden that as Dr. Hall had confined it to his closet and the public were not acquainted with it, Dollond was to be considered as the inventor."

In *Hill* v. *Thompson*, (*c*) Dallas, J., said: "It is not enough to have discovered what was unknown to others, if the discovery be confined to the knowledge of the party having made it; but it must have been communicated more or less, it must have been more or less made use of so as to constitute discovery as applied to subjects of this sort," and the learned judge referred to *Dollond's case*

(*a*) See *post*, title experiments.

(*b*) 2 H. Bl. 470.

(*c*) 8 Taunt. 382; 2 B. Moore, 433; 1 Webs. P. R. 244.

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and *Tennant's case* (*a*) as illustrating the distinction between public user and user in private. (*b*)

In *Lewis* v. *Marling*, (*c*) Bayley, J., said: "If I make a discovery and am entitled to produce an effect from my own experience, judgment and skill, it is no objection that some one else has made a similar discovery by his mind unless it becomes public. So if I introduce a discovery *bonâ fide* made, I may have a patent for it, though a person might have received privately a communication from abroad which would have enabled him to have made his machine."

And in *Carpenter* v. *Smith*, (*d*) a case which turned entirely on the question of public user, Lord Abinger, C. B., said: "What is meant by public use is this—a man is entitled to a patent for a new invention, and if his invention is new and useful he shall not be prejudiced by any other man having invented that before and not made any use of it, because the mere speculations of ingenious men, which may be fruitful of a great variety of inventions if they are not brought into actual use, ought not to stand in the way of other men equally ingenious who may afterwards make the same inventions and apply them. A great many patents have been taken out, for example, upon suggestions made in a very celebrated work by the Marquis of Worcester, and many ingenious patents have been derived from hints and speculations by that ingenious author. But yet as he never acted on them, as he never brought out any

(*a*) Dav. P. C. 429; 1 Webs. P. R. 125, n.

(*b*) See also *Smith* v. *Davidson*, 19 Dec. of Ct. of Sess. 2nd series, p. 691.

(*c*) 4 C. & P. 57; 10 B. & C. 22; 1 Webs. P. R. 497.

(*d*) 1 Webs. P. R. 534.

machines whatsoever, those patents are good, so that the meaning of the words 'public use' is this, that a man shall not by his own private invention which he keeps locked up in his own breast, or in his own desk, and never communicates, take away the right that another man has for the same invention." On a motion for a new trial on the ground of misdirection, the Court of Exchequer refused to grant a rule, and agreed with law as thus laid down by Lord Abinger. (*a*)

In *Betts* v. *Menzies*, (*b*) Sir W. P. Wood, V.C., said: "If a man sits down and takes out a patent from his own conjectures without ever having tried the experiment set forth in it, that will not invalidate a subsequent patent taken out and practically worked, especially when it turns out that the method prescribed by the earlier patent is practically useless," and His Honour referred to the Marquis of Worcester's book, and the valid patents taken out from hints contained in it.

Accidental user of piece of machinery not vitiate patent;

The accidental user of a piece of machinery forming part or the whole of a mechanical contrivance, which may be applied afterwards to some ulterior purpose without any intention of producing the result, is not such a user of the invention as to prevent a patent from being taken out by another person, who afterwards discovers that the contrivance may be attended with beneficial results, and *bonâ fide* invents a means of carrying it into effect. (*c*)

nor accidental combination of materials;

And if in a patent for a combination of materials, it is

(*a*) *S. C.* 9 M. & W. 300; 1 Webs. P. R. 541. See also *Gibson* v. *Brand*, 4 Scott (N. R.) 879; 4 M. & Gr. 198; 1 Webs. P. R. 638.

(*b*) 3 Jur. (N. S.) 357.

(*c*) *Harwood* v. *Great Northern Railway Co.*, 2 B. & S. 209; *S. C. nom. Harrison* v. *Great Northern Railway Co.*, 6 Jur. (N. S.) 996.

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shown that they have been accidentally combined before, but not for the purposes for which the patent has been taken out, the patent will not be invalidated. (*a*)

nor use of method or principle in ignorance.

The user of a method or principle in a machine in ignorance of the effect which may be produced by a proper adaptation will not vitiate a subsequent patent in which the method or principle is utilised with greater success. (*b*)

User for private purposes.

If the antecedent invention has been used for private purposes only, there will, nevertheless, be such a public user as to defeat a subsequent patent. Thus, where in an action for the infringement of a patent for wood-paving, it was proved on behalf of the defendants that wood-paving had been used in the portico of a private house, it was held that if the mode of making the paving was similar to the plaintiff's, that would be a sufficient user to destroy his patent, though put in a place to which the public had not free access. (*c*)

Manufacture by the inventor before patent not user if secret.

If a patentee makes some of the patented articles before the date of the patent, but does not sell them or expose them for sale, and keeps his invention secret, that will not be such a user as to defeat his patent. (*d*)

Where the patentee, a few months before the date of his patent, which was for improvements in the construction of paddle-wheels, caused two pairs of the wheels to be made by an engineer, under an injunction of secresy; which was observed; on the express ground that he was about to take out a patent, and after the wheels were

(*a*) *Muntz* v. *Foster*, 2 Webs. P. R. 108.

(*b*) *Minter* v. *Mower*, 1 Webs. P. R. 140, 142; 6 A. & E. 744.

(*c*) *Stead* v. *Williams*, 2 Webs. P. R. 130; *Stead* v. *Anderson*, 2 Webs. P. R. 149.

(*d*) *Bramah* v. *Hardcastle*, Hol. 81; 1 Webs. P. R. 44, n.; *Betts* v. *Menzies*, 5 Jur. (N. S.) 1164.

made, they were taken to pieces, and sent abroad, and used, after the patent was taken out, in foreign steamboats belonging to a company of which the patentee was manager, it was held that this transaction could not be considered as a user by others, or a public user within the meaning of the statute. (*a*)

Unless sale.

But if the patentee makes the patented article and sells it in the public market before the date of the patent, the patent will be void, (*b*) and it appears that if an inventor were to make the article and sell it, and keep the process secret, he would not afterwards be able to take out a patent. The point, however, has not been expressly decided. (*c*)

Manufacture by other persons before patent constitutes user.

It is sufficient to constitute public user if the article has been manufactured openly and not for the purpose of experiment. (*d*)

Where in a patent for improvements in the manufacture of iron and steel, which consisted in making steel by applying a combination of carbon and manganese producing carburet of manganese, it was proved that five firms of ironmasters had used a similar process by which a perfect manufactured article was produced for profit in large quantities, it was held that this was not a mere experiment, and that as the process had been used openly by three of the firms there was such a user as to avoid the subsequent patent. (*e*)

(*a*) *Morgan* v. *Seaward*, 2 M. & W. 544; M. & H. 56; 1 Webs. P. R. 187. And see *Smith* v. *Dickinson*, 3 Bos. & Pul. 630, and 15 & 16 Vict. c. 83, s. 10, as to fraud.

(*b*) *Wood* v. *Zimmer*, Holt (N. P.) 60; 1 Webs. P. R. 44.

(*c*) *Heath* v. *Smith*, 3 El. & Bl. 271.

(*d*) *Betts* v. *Neilson*, L. R. 3 Ch. 429.

(*e*) *Heath* v. *Smith*, 3 El. & Bl. 270.

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Exposing for sale is user though no sale effected.

The publicly making and exposing an article for sale, though there is no demand or use for it, will vitiate a subsequent patent; (*a*) and it is not necessary to show that any sale has been effected. (*b*)

Where in an action for infringement of a patent it was proved that the defendants had made articles of the same description before the plaintiff's patent was taken out, that they had no shop for the exhibition of goods, and that the articles had been deposited for sale in their warehouse, it was held that there was sufficient evidence of user to defeat the plaintiff's claim to novelty in the invention. (*c*)

Experiments by inventor not user.

An inventor is entitled to make experiments, to test the sufficiency of his invention, and experiments conducted for that purpose only, in private, will not constitute such a user of the invention as to deprive him of his right to a patent. (*d*)

If an invention has already been ascertained by previous experiment to be useful, the inventor's public user of it for profit is a gift of the invention to the public, and avoids a subsequent patent; but a user before the patent, merely experimental and tentative, does not avoid it. (*e*)

Must be in private.

Where a machine was invented during the progress of some public works, on which the inventor was engaged, and was tested in a place accessible to the public for four months during the progress of the works, it was held that such user amounted to a dedication to the public, and an

(*a*) *Losh* v. *Hague*, 1 Webs. P. R. 205.

(*b*) *Mullins* v. *Hart*, 3 C. & K. 297; *Oxley* v. *Holden*, 8 C. B. (N. S.) 666; *Betts* v. *Neilson*, L. R. 3 Ch. 429.

(*c*) *Mullins* v. *Hart*, 3 C. & K. 297.

(*d*) *Bramah* v. *Hardcastle*, Hol. 81; 1 Webs. P. R. 44, n.

(*e*) *Re Newall* and *Elliott*, 4 C. B. (N. S.) 294.

application for a patent was refused. Lord Cranworth said: "The petitioner admits he completed his invention in May, 1855, and that he used it publicly for upwards of four months before applying for the patent. No doubt an experiment might have been made; and if made *bonâ fide* only for the purpose of testing the merits of an invention, I do not think it would have amounted to a dedication to the public; but where, as in the present case, thousands of persons had the opportunity of seeing the apparatus at work for a period of four months, during the carrying on of the petitioner's contract, and in the regular course of the undertaking, it is quite clear that no intention of applying for a patent originally existed; and under such circumstances, and after the lapse of such a time, I must hold that there was a dedication to the public, and refuse the application." (*a*)

Unless disclosure unavoidable.

But a necessary and unavoidable disclosure to the public, if it be only made in the course of mere experiments, is no publication; although the same disclosure, if made in the course of a profitable user of an invention previously ascertained to be useful, would be a publication. 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 gift of the invention to the world. Thus, where a person had invented an improved apparatus for laying down submarine telegraphic cables and experiments on dry land were found to be indecisive, and the inventor successfully used his apparatus in the course of a contract for laying down a cable at sea, and immediately afterwards took out a patent, it was held that there was not

(*a*) *Adamson's Patent*, 6 D. M. G. 420.

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such a publication as to prevent him from obtaining a patent. (*a*)

Where the inventor of a carding-machine lent it to a person in order to test it, and the machine was used in a room in a mill where men were constantly going backwards and forwards, it was held that this was not such a user of the invention as to deprive the inventor of his right to a patent. (*b*)

Unsuccessful experiments by a previous inventor will not vitiate a subsequent patent.

If an experiment towards an invention is made, and fails, and is abandoned, the invention of a subsequent inventor, who in effect remedies the defects in the first invention, though he has never seen it, will not be vitiated by the previous user. Thus, where the plaintiff in an action for infringement had taken out a patent for wheels constructed on the suspension principle, and for the defence it was shown that previously to the date of the patent a Mr. Strutt had made wheels on the same principle, Pattesen, J., in summing up, said: "If, on the whole of this evidence, either on the one side or the other, it appeared that this wheel constructed by Mr. Strutt's orders was a wheel on the same principle, and in substance the same wheel as the other for which the plaintiff has taken out his patent, and that it was used openly in public, so that everybody might see it, and had continued to use the same thing up to the time of taking out the patent—undoubtedly, then, that would be a ground to say that the plaintiff's invention is not new, and if it is not new, of course his patent is bad, and he cannot recover in his action; but if, on the other hand, you are of opinion that Mr. Strutt's wheel was an experiment, and

(*a*) *Re Newall* and *Elliott*, 4 C. B. (N. S.) 295.

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

that he found it did not answer, and ceased to use it altogether, and abandoned it as useless, and nobody else followed it up, and that the plaintiff's invention which came afterwards was his own invention, and remedied the defects, if I may so say, although he knew nothing of Mr. Strutt's wheel, he remedied the defects of Mr. Strutt's wheel, then there is no reason for saying that the plaintiff's patent is not good, it depends entirely upon what is your opinion upon the evidence with respect to that." (*a*)

Where a patent was taken out in 1818 for the application of a rotary cutter in shearing cloth from list to list, it was proved that in 1811 a specification in which the principle was stated was brought over from America and a machine commenced but never finished, that in 1816 a model of such a machine was brought over and though no machine was made from it, the model was shown to several persons, that the American invention was in fact useless, and that the persons who had the model of it bought and used machines made by the plaintiffs,—Lord Tenterden, C.J., said: "It is no doubt incumbent on the plaintiffs to show that their machine is new, but it is not necessary that they should have invented it from their own heads, it is sufficient that it should be new as to the general use and public exercise in this kingdom. If it were shown that the plaintiffs had borrowed from some one else, then of course their patent would fail . . . . it appears to me that the defendant has failed to prove that such a machine was generally known or generally used in England before the taking out of this patent by the plaintiffs. (*b*)

(*a*) *Jones* v. *Pearce*, 1 Webs. P. R. 122.

(*b*) *Lewis* v. *Marling*, 4 Car. & P. 52; 1 Webs. P. R. 490.

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In *Carpenter* v. *Smith*, (*a*) Alderson, B., said that *Lewis* v. *Marling* went to the very extreme point of the law; and in *Morgan* v. *Seaward* (*b*) the same learned judge said that he should have entertained very considerable doubt as to whether there had not been a publication of the invention.

Both *Jones* v. *Pearce* and *Lewis* v. *Marling* appear, however, to have been decided on the ground that the former machines were mere experiments, which totally failed, and in *Murray* v. *Clayton* (*c*) Sir W. M. James, L. J., said: "I am not aware of any principle or authority upon which the exhibition of a useless machine which turns out a failure can be held to affect the right of a patentee who has made a successful machine, although there may be a degree of similarity between some of the details of the two machines," and referred to the ruling of Patteson, J., in *Jones* v. *Pearce*.

The following cases support the proposition that an unsuccessful experiment will not vitiate a subsequent patent for a similar invention.

In *Galloway* v. *Bleaden* (*d*) Sir N. C. Tindal, C. J., said: "A mere experiment or a mere course of experiments for the purpose of producing a result which is not brought to its completion, but begins and ends in uncertain experiments, that is not such an invention as will prevent another person, who is more successful or perseveres with greater energy in the line that has been laid out for him by the preceding inventor, from availing himself of it and having the benefit of it."

(*a*) 9 M. & W. 300; 1 Webs. P. R. 543.

(*b*) 2 M. & W. 553; 1 Webs. P. R. 190.

(*c*) L. R. 7 Ch. 581.

(*d*) 1 Webs. P. R. 525.

In *The Household Co.* v. *Neilson*, (*a*) Lord Lyndhurst said that their Lordships must not be understood to have given any decision as to the case of an invention which had been formerly used and abandoned many years ago, and the whole thing lost sight of.

In *Stead* v. *Williams* (*b*) Cresswell, J., said: "I take it that there is a great difference between the knowledge of an invention as a thing that would answer and was in use, and the knowledge of it as a mere experiment that had been found to be a failure and thrown aside. If you are dealing with an article of merchandise or with an article of ordinary use; if a person has had a scheme in his head and has carried it out, but after a trial has thrown it aside and the thing is forgotten and gone by, then another person re-introducing it may within the meaning of this Act be the inventor and the first user of it so as to justify a patent."

And in *Hills* v. *The London Gas Light Co.*, (*c*) Sir G. W. Bramwell, B., said: "If there has been a user of an invention, not of a substantial character but in the character of an experiment, then although the thing has been done before, it does not preclude a person from taking out a patent for it."

The former article must have had the same properties as that claimed by the patentee.

It must be shown that the article made before answered the purposes and had the properties of that which the patentee has made and claims as his invention, and also that it was known and used. (*d*) Thus where it is proved that there was an invention in existence before the patent was taken out which has never been properly completed so

(*a*) 9 C. & F. 816; 1 Webs. P. R. 717.

(*b*) 2 Webs. P. R. 135.

(*c*) 5 H. & N. 312.

(*d*) *Walton* v. *Bateman*, 1 Webs. P. R. 617.

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as to have any practical effect, and which if it had appeared after the patent, would have been held to be a colourable imitation, the subsequent patent will not be invalidated. (*a*)

It is difficult to distinguish accurately where the use of an invention for the mere purpose of experiment stops, and the employment or user of it as a completed invention which the inventor thinks cannot be made more perfect begins, and the test seems to be, has the inventor used the invention for the purpose of making a profit by it in trade? (*b*)

Exhibitions of new inventions at international exhibitions not to prejudice patent rights.

By 33 and 34 Vict. c. 27, s. 2, it is provided that the exhibition shall not, nor shall the publication during the period of the holding of such exhibition of any description of such invention, nor shall the user of such invention within the place where the same may be held, nor shall the user of such invention elsewhere by any person without the priority and consent of the true and first inventor thereof, prejudice the right of the exhibitor thereof, he being the true and first inventor, within six months from the time of the opening of such exhibition, to obtain letters patent for his invention.

The question of user is for the jury to decide.

The question of public user is a question of fact which it is for the jury to decide. (*c*) The question whether or not the manufacture was in public use in England before the date of the patent, or whether the evidence only shows that experiments have been made which have been abandoned, is one of considerable delicacy; a slight alteration in the effect of the evidence will establish either the one proposition or the other, and the only proper mode of

(*a*) *Daw* v. *Eley*, L. R. 3 Eq. 496; *Murray* v. *Clayton*, L. R. 7 Ch. 585.

(*b*) *Lang* v. *Gisborne*, 31 Beav. 135.

(*c*) *Elliott* v. *Aston*, 1 Webs. P. R. 224.

deciding it is to leave to the jury; and if they hear the evidence patiently, and apply it with intelligence, their verdict will not be disturbed.(*a*)

Delay in publication.

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 invention.(*b*)

Wilful ignorance.

An inventor will not be permitted to shelter himself under wilful ignorance, but will be fixed with knowledge not only of what he did know, but of what he would have known if he had made the inquiries, which it is incumbent on him to make.(*c*)

What is a new manufacture.

The meaning of the word "manufacture" has often been discussed.(*d*) In the case of *Boulton* v. *Bull*,(*e*) Eyre, C. J., said: "According to the letter of the statute the saving goes only to the sole working and making; the sole buying, selling and using remain under the general prohibition. It was admitted that the word manufacture in the statute was of extensive signification, that it applied not only to things made, but to the practice of making; to principles carried into practice in a new manner; to new results of principles carried into practice. Let us pursue this admission. Under things made, we may class in the first place new compositions of things, such as manufactures in the most ordinary sense of the word; secondly, all mechanical inventions,

Things made.

(*a*) *Per* Sir N. C. Tindal, C. J., in *Cornish* v. *Keene*, 4 Scott, 352; 3 Bing. (N. C.) 588; 1 Webs. P. R. 519; *Walton* v. *Bateman*, 1 Webs. P. R. 619.

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

(*c*) *Westrupp and Gibbins' Patent*, 1 Webs. P. R. 555; *Honiball's Patent*, 9 Moo. P. C. C. 390.

(*d*) See Webster on Subject Matter, p. 98.

(*e*) 2 H. Bl. 492.

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Practice of making.

whether made to produce old or new effects, for a new piece of mechanism is certainly a thing made. Under the practice of making, we may class all new artificial manners of operating with the hand or with instruments in common use, new processes in any art producing effects useful to the public."

In *R.* v. *Wheeler*, (*a*) Abbott, C. J., said "that the word 'manufacture' had generally been understood to mean either a thing made or some part of an engine or instrument to be employed in making some previously known article or in some other useful purpose."

Manufacture means either the machine or mode of constructing it.

"The word 'manufacture' in the statute," said Parke, B., "must be construed in one of two ways; it may mean the machine when completed, or the mode of constructing the machine." (*b*) In *Ralston* v. *Smith*, (*c*) it was said that it is not every useful discovery that can be made the subject of a patent, but that the words "new manufacture" will comprehend not only a production, but the means of producing it, and in *Bush* v. *Fox*, (*d*) Coleridge, J., said: "Manufacture includes both process and result."

Amount of invention immaterial.

The amount of labour and thought bestowed, or expenditure of money, is immaterial in considering whether or not a patent should be granted, for inventions are of various kinds, sometimes they are the result of study, sometimes of accident. (*e*)

It was objected in *Orane* v. *Price*, (*f*) that the quality

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

(*b*) *Morgan* v. *Seaward*, 2 M. & W. 558; M. & H. 58; 1 Webs. P. R. 193.

(*c*) 11 H. & C. 223.

(*d*) Macr. 176.

(*e*) *Liardet* v. *Johnson*, Bull (N. P.) 76; 1 Webs. P. R. 53.

(*f*) 4 M. & G. 604; 5 Scott (N. R.) 390; 1 Webs. P. R. 410.

or degree of invention was so small, that it could not become the subject matter of a patent, but Sir N. C. Tindal, C. J., said that in point of law the labour of thought or experiments, and the expenditure of money, are not the essential grounds of consideration on which the question, whether the invention is or is not the subject matter of a patent ought to depend, for if the invention is new and useful to the public, it is not material whether it is the result of long experiments and profound research, or of some sudden and lucky thought, or mere accidental discovery. Where the invention consisted in the manufacture of tubes without the use of a maundril, so as to weld them without hammering them on any solid surface, "though that seems to be a very simple invention," said Lord Lyndhurst, "it has been productive of great advantages, inasmuch as it has enabled the manufacturer to construct pipes for gas and other purposes very correctly, and also of lengths much beyond what could be done previously to this discovery."(*a*)

In the case of *Lewis* v. *Davis*,(*b*) the amount of invention was very small, but the patent was supported. The patent was for a machine to shear from list to list, by means of rotary cutters. Before the patent the shearing of cloth from list to list by means of shears was known, and the shearing it from end to end, by means of rotary cutters, was also known. Lord Tenterden said: "If, before the plaintiff's patent, the cutting from list to list, and the doing that by means of rotary cutters, were not combined, I am of opinion that this is such an invention

(*a*) *Russell* v. *Cowley*, 1 Webs. P. R. 467; 1 C. M. & R. 875.

(*b*) 1 Webs. P. R. 488.

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by the plaintiffs as will entitle them to maintain the present action."

Mode or process of manufacturing apart from things produced is good subject matter for a patent.

It was at one time considered doubtful whether a mode, or process of producing a result, apart from the thing produced could be the subject of a patent. The point was not actually decided until the case of *Crane* v. *Price*, (*a*) but it had previously been discussed in several cases, and the received opinion was that such a patent would be valid. In *Boulton* v. *Bull*, (*b*) Eyre, C. J., said: "When the effect produced is some new substance or composition of things, it should seem that the privilege of the sole working or making ought to be for such new substance or composition, without regard to the mechanism or process by which it has been produced, which though perhaps also new, will be only useful as producing the new substance, when the effect produced is no substance or composition of things, the patent can only be for the mechanism, if new mechanism is used, or for the process, if it be for a new method of operating, with or without old mechanism by which the effect is produced." His lordship then referred to the case of *Hartley's patent*, where the invention consisted in the method of applying iron plates to secure buildings from fire, and to a list of patents with which he had been furnished, where there were several for new methods of manufacturing articles in common use, and said that he thought these methods might be said to be new manufactures. His lordship then proceeded, "The patent" (which was for a method of lessening the consumption of steam and fuel in fire engines) "cannot be for the effect produced, for it

(*a*) 4 M. & G. 602; 5 Scott (N.R.) 388; 1 Webs. P. R. 409.

(*b*) 2 H. Bl. 493.

is either no substance at all, or, what is exactly the same thing as the question upon a patent, no new substance, but an old one produced advantageously for the public. It cannot be for the mechanism, for there is no new mechanism employed, it must then be for the method, and I would say in the very significant words of Lord Mansfield in the great case of the copyright, it must be for method detached from all physical existence whatever." In *R.* v. *Wheeler*,(*a*) Abbott, C. J., said that the word "manufacture" might extend "to a new process to be carried on by known implements or elements acting upon known substances and ultimately producing them in a cheaper or more expeditious manner, or of a better or more useful kind."

In *Hall* v. *Boot*,(*b*) the patent was for applying the flame of gas to singe off the superfluous fibres of lace where the flame of oil had been used before for the same purpose, and the patent was supported.

In *Losh* v. *Hague*,(*c*) the patent was for the use of an old wheel on railways. Lord Abinger, C. B., referring to the above case, said that that was the application of a new contrivance to an old object and was good, but that applying a new contrivance to an old object and applying an old contrivance to a new object were different things.(*d*) In *Gibson* v. *Brand*,(*e*) the jury specially found that the alleged invention was not new or a new combination, but that it was an improved process. Sir N. C. Tindal, C. J., said that it was not necessary to go into the question, whether or not a patent could be supported

(*a*) 2 B. & Ald. 350.

(*b*) 1 Webs. P. R. 100.

(*c*) 2 Webs. P. R. 207.

(*d*) See also *Stevens* v. *Keating*, 2 Webs. P. R. 183; *Curtis* v. *Platt*, 11 L. T. (N. S.) 245.

(*e*) 4 M. & Gr. 199; 4 Scott (N. R.) 1879; 1 Webs. P. R. 633.

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for a process only, and that if the specification were properly prepared it might probably be considered a fit subject for a patent, and in support of his opinion cited the remarks of Eyre, C. J., and Abbott, C. J., noted above.

Shortly after the decision in *Gibson* v. *Brand* the case of *Crane* v. *Price* (*a*) came before the same court, when the question as to whether there could be a patent for a process was fully discussed. The patent was "for an improvement in the manufacture of iron." The specification described the subject of the invention to be the application of anthracite or stone coal, combined with hot air blast, in the smelting or manufacture of iron from ironstone mine or ore. It was distinctly stated that the patentee did not claim the use of a hot-air blast separately as his invention, when uncombined with the application of anthracite or stone coal; nor did he claim the application of anthracite or stone coal when uncombined with the use of hot-air blast; but that what he did claim as his invention was the application of anthracite or stone coal and culm, combined with the use of the hot-air blast in the smelting and manufacture of ironstone mine or ore. The question in the suit therefore was whether, admitting the use of the hot-air blast to have been known before in the manufacture of iron with bituminous coal, and the use of anthracite or stone coal to have been known before in the manufacture of iron with the cold blast, but that the combination of the two together (the hot-air blast and the anthracite) was not known before in the manufacture of iron, such combination could be the subject of a patent. Sir N. C. Tindal, C. J., in delivering the judgment of the Court, said: "We are of

(*a*) 5 Scott (N. R.) 388; 4 M. & Gr. 602; 1 Webs. P. R. 409.

opinion that if the result produced by such a combination is either a new article or a better article or a cheaper article to the public than that produced before by the old method, such combination is an invention or a manufacture intended by the statute, and may well become the subject of a patent."

The decision in *Crane* v. *Price* was questioned in *Horton* v. *Mabon*,(a) by Willes, J., who said that the only ground on which it could be supported was that the product was a materially better article, but it has never been overruled. In *Murray* v. *Clayton*,(b) Sir W. M. James, L. J., said: "No doubt *Crane* v. *Price* has been questioned, and if I may be permitted to say so with all respect to the very powerful tribunal which decided that case, I have never been satisfied with the decision. That, however, was simply because I could not see how the word 'combination' could be properly applied to the introduction of a particular kind of fuel in the making of iron; and neither I, nor, so far as I am aware, any other judge, has ever questioned the principles upon which that case was decided," and his lordship quoted the judgment of Sir N. C. Tindal cited above.

In *Stevens* v. *Keating*,(c) Sir F. Pollock, C. B., said: "The real invention may be not so much for the thing when produced, as for the mode in which it is produced; and its novelty may consist not so much in its existence as a new substance, as in its being an old substance, but produced by a different process. In one sense an old substance produced by a new process is a new manufacture; of that there cannot be a doubt; and therefore

(a) 12 C. B. (N. S.) 448.
(b) L. R. 7 Ch. 584.
(c) 2 Webs. P. R. 182.

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although the language of the Act has been said to apply only to manufactures and not to processes, when you come to examine it, either literally or even strictly, it appears to me the expression 'manufacture' is free from objection, because although an old thing, if made in a new way, the very making of it in a new way makes it a manufacture."

In *Newall* v. *Elliott*, (*a*) the patent was for "improvements in apparatus employed in laying down submarine telegraph wires." The specification claimed: "First, coiling the wire or cable round a cone; secondly, the supports placed cylindrically outside the coil round the cone; thirdly, the use of the rings in connection with the cone as described." The patent was objected to as being for a mode, but it was held that there was such an improvement as to constitute a good subject matter for a patent.

Meaning of the words method and mode.

"A method of performing a process," said Rooke, J., "means the mode or manner of effecting. A newly invented method, therefore, means the idea of a new mode of construction;" and Heath, J., said that when a mode of doing a thing is referred to something permanent it is properly termed an engine; when to something fugitive, a method. (*b*)

"Engine and method," said Lawrence, J., in *Hornblower* v. *Boulton*, (*c*) "mean the same thing and may be the subject of a patent. Method, properly speaking, is only placing several things and performing several operations in the most convenient order; but it may signify a contrivance or device, so may an engine, and therefore I think it may answer the word method. So principle

(*a*) 10 Jur. (N. S.) 954; 13 W. R. 11.

(*b*) *Boulton* v. *Bull*, 2 H. Bl. 478, 468.

(*c*) 8 T. R. 106.

may mean a mere elementary truth, but it may also mean constituent parts."

No patent can be granted for a principle only.

Though a patent may be granted for a method or process of manufacturing anything apart from the thing itself, which is made, nevertheless a patent cannot be granted for a bare principle.

The leading case on this point is *Boulton* v. *Bull.*(*a*) The patent was for "a method of lessening the consumption of steam and fuel in the fire-engines." The specification commenced by saying, "My method of lessening the consumption of steam and consequently fuel in fire-engines consists of the following principles," and then described how they were to be carried into effect. The patent was objected to on the ground that a patent could not be granted for a principle.

The judges differed as to the construction of the specification, but they were all agreed that there could be no patent for a principle. Rooke, J., said: "The term principle is equivocal, it may denote either the radical elementary truths of a science or those consequential axioms which are founded on radical truths, but which are used as fundamental truths by those who do not find it expedient to have recourse to first principles." Heath, J., said that the patent must be for the vendible matter and not for the principle, and that it had always been held that the organization of a machine might be the subject of a patent, but that principles could not. Buller, J., said: "The very statement of what a principle is proves it not to be a ground for a patent. It is the first ground and rule for arts and sciences, or in other words, the elements and rudiments of them. A patent must

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

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be for some new production from those elements and not for the elements themselves." And Eyre, C. J., said: "Undoubtedly there can be no patent for a mere principle; but for a principle so far embodied and connected with corporeal substances as to be in a condition to act, and to produce effects in any art, trade, mystery, or in manual occupation, I think there may be a patent." Owing to the difference of opinion among the judges as to construction of the specification the case went to the Court of King's Bench, and it was unanimously determined that there could be no patent for a principle. (*a*) In the case of *R.* v. *Wheeler*, (*b*) Abbott, C. J., said, "No merely philosophical or abstract principle can answer to the word 'manufacture.' Something of a corporeal and substantial nature, something that can be made by man from the matters subjected to his art and skill, or at the least some new mode of employing practically his art and skill, is requisite to satisfy this word." (*c*)

Philosophical or abstract principle cannot be patented.

But a patent may be granted for a mode of applying the principle.

A patent may, however, be granted for the application of a principle to some machine or process. The patent in such a case is not for the principle, but for the mode of carrying it into effect. (*d*) "You cannot," said Alderson, B., "take out a patent for a principle; you may take out a patent for a principle coupled with the mode of carrying it into effect, provided you have not only discovered the principle but invented some mode of carrying it into effect." (*e*)

(*a*) *Hornblower* v. *Boulton*, 8 T. R. 95.

(*b*) 2 B. & Ald. 350.

(*c*) See also *Household Iron Co.* v. *Neilson*, 1 Webs. P. R. 683.

(*d*) *Boulton* v. *Bull*, 2 H. Bl. 463; *Crossley* v. *Potter*, Macr. 244; *Walton* v. *Bateman*, 1 Webs. P. R. 620.

(*e*) *Jupe* v. *Pratt*, 1 Webs. P. R. 146; *R.* v. *Cutler*, 1 Stark. 354; *Minter* v. *Mower*, 6 A. &

In *Neilson* v. *Harford* (*a*) the patent was "for the improved application of air to produce heat in fires, forges and furnaces where bellows or other blowing apparatus are required," and the specification described the invention to consist in passing a blast of air from the ordinary blowing apparatus into an air vessel which, during the continuance of the blast, was to be kept heated to a considerable temperature, and from that vessel by means of a pipe into the furnace. The form of the vessel was stated to be immaterial, and might be adapted to the local circumstances or situation. It was necessary sometimes to use water twires to prevent the pipe from melting. It was contended that the patent was void as being for a principle, but it was held that the patent was not merely for a principle, but for a principle embodied in a machine. Alderson, B., said: "The blowing apparatus was perfectly well known; the heating of air was perfectly well known; the twire was perfectly well known as applicable to blast furnaces; then what he really discovered is that it would be better for you to apply air heated up to red-heat or nearly so instead of cold air as you have hitherto done. That is the principle; that is the real discovery; but in order to take out a patent you must have an embodiment of the principle, and his embodiment of the principle is the heating of air in a separate vessel intermediately between the blowing apparatus and the point where it enters the furnace. Then he says, 'I do not mean to claim any shape in which it is done; it may be done in a vessel of any shape, provided only you have such a vessel of

E. 735; *Hullett* v. *Hague*, 2 A. & E. 370.

(*a*) 1 Webs. P. R. 331.

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such a shape, a fire so applied as that in the intermediate space between the blowing apparatus and the furnace the air arrives at the red-heat.' . . . . I take the distinction between a patent for a principle, and a patent which can be supported, to be, that you must have an embodiment of the principle in some practical mode described in the specification of carrying the principle into actual effect, and then you take out your patent not for the principle but for the mode of carrying the principle into effect. In Watt's patent, which comes the nearest to the present of any you can suggest, the real invention of Watt was, that he discovered that by condensing steam in a separate vessel a great saving of fuel would be effected by keeping the steam cylinder as hot as possible, and applying the cooling process to the separate vessel and keeping it as cool as possible, whereas before, the steam was condensed in the same vessel; but then Mr. Watt carried that practically into effect by describing a mode which would effect the object. The difficulty which presses on my mind here is, that this party has taken out a patent in substance like Watt's for a principle, that is the application of hot air to furnaces, but he has not practically described any mode of carrying it into effect. If he had perhaps he might have covered all other modes as being a variation."

The same patent was the subject of litigation before the Court of Session, in the case of *The Househill Iron Company* v. *Neilson*,(*a*) and Lord Justice Clerk Hope said :—" It is quite true that a patent cannot be taken out solely for an abstract philosophical principle—for instance, for any law of nature, or any property of

(*a*) 1 Webs. P. R. 683.

matter apart from any mode of turning it to account in the practical operations of manufacture, or the business and arts and utilities of life. The mere discovery of such a principle is not an invention in the patent law sense of the term. Stating such a principle in a patent may be a promulgation of the principle, but it is no application of the principle to any practical purpose. And without that application of the principle to a practical object and end, and without the application of it to human industry or to the purposes of human enjoyment, a person cannot in the abstract appropriate a principle to himself. But a patent will be good, though the subject of the patent consists in the discovery of a great general and most comprehensive principle in science or law of nature, if that principle is by the specification applied to any special purpose, so as thereby to effectuate a practical result and benefit not previously attained."(a)

Skill of inventor shown in application of principles.

"The skill and ingenuity of the inventor," said Lord Hatherly in *Cannington* v. *Nuttall*,(b) "are shown in the application of principles. Few things come to be known now in the shape of new principles, but the object of the invention generally is the applying of well known principles to the achievement of a practical result not yet achieved." And Lord Westbury said: "I may construct an apparatus, and may in point of fact make the merit and the benefit of that apparatus depend upon the application of some natural force or property which is perfectly well known, but my invention consists in the construction of the apparatus in such a manner as to bring the natural agency or power to bear upon and

(a) And see *Dangerfield* v. *Jones*, 13 L. T. (N.) 142; *Baxter* v. *Combe*, 1 Ir. Ch. 284.

(b) L. R. 5 H. L. 216.

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effect the object which I desire to effect, and that I do by means of an apparatus constructed so as to bring into action that natural power. If, for example, I avail myself of the well-known expansive force of steam in order to effect a new object or a more beneficial result, and I introduce that by means of an apparatus constructed for the purpose of bringing this well-known expansive power into utility for my particular purpose, I have no right of invention in the discovery of that expansive power. My invention consists in the arrangement of the apparatus, in order to receive that ordinary and well-known dynamic agent, and make it a fit instrument for effecting a new result."

Instances.

In *Jones* v. *Pearce*, (*a*) the patent was for an improvement in carriage wheels, and consisted in the application of the suspension principle to their construction. The means of application was described, and the patent was supported.

In *Minter* v. *Wells*, (*b*) the patent was for "an improvement in the constructing, making, and manufacturing of chairs." The specification described the invention to consist "in 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." The claim was in the same words. It was objected that the claim was for a principle, and not for any particular mode of applying it, but it was held that the application of a self-adjusting leverage producing the effect, constituted the machine, and that the patentee claimed that machine and the right to make it by the application of the particular form of self-adjusting

(*a*) 1 Webs. P. R. 121. (*b*) 1 Webs. P. R. 134; 1 C. M. & R. 507.

leverage. Lord Lyndhurst, C.B., said: "It is not a leverage only, but the application of a self-adjusting leverage; and it is not a self-adjusting leverage only, but it is a self-adjusting leverage producing a particular effect by the means of which the weight on the seat counterbalances the pressure against the back." It was said, in argument, that this was nothing more than one of the first principles of mechanics, and Parke, B., said: "But that not being in combination before, cannot that be patented? It is only for the application of a self-adjusting leverage to a chair—cannot he patent that? He claims the combination of the two, no matter in what shapes or way you combine them; but if you combine the self-adjusting leverage which he thus applies to the subject of a chair that is an infringement of his patent."

In *Hills* v. *London Gas Light Company*,(a) it was contended that the mere application of hydrated oxides to absorb the sulphuretted hydrogen from coal gas, was not the subject of a patent, as that property of it was previously well known. It was held that the application of the hydrated oxide was the principle, and that if a man were to say, "I claim the use of hydrated oxide of iron for the purification of coal gas," without saying how it was to be applied, the objection might be well founded, but that as the patent said: "I claim it in the manufacture of gas in the way I have described," and showed how it might be used, the objection failed.

In a patent for "improvements in giving signals and sounding alarums in distant places by means of electric currents transmitted through metallic circuits," one of

(a) 5 H. & N. 369.

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the improvements was described as an improvement "whereby a set of combined conducting wires having a voltaic battery, and a set of buttons or finger keys, and also a dial with metallic needles for giving signals, as well as an apparatus for sending alarums at each end of the set, may also have duplicates of such dials with needles and apparatus for alarums, at intermediate places between the two ends; all such duplicates operating simultaneously with each other and with the two end dials and alarums, to give like signals and to sound like alarums." The jury found that "the sending of signals to intermediate stations" was a new invention of the patentees. In an action for infringement it was insisted that the giving of duplicate signals at intermediate stations was not the proper subject of a patent, being an idea or principle only, and not a new manufacture. The Court of Common Pleas, however, held that the patentees not only communicated the idea or principle, that duplicate signals might be given, but showed how it might be done, and that it was the fit subject of a patent, for though it might be probable *à priori* that a circuit having a distant coil could have an intermediate one also which would operate in the same manner, still it was a matter of experiment that it could be practically done.(*a*)

Particular method cannot be extended because of common principle.

Where a subject is not new, any patent taken out for a method of performing the operation will be substantially confined to that method, and cannot be extended to other methods obviously different, because they involve some common principle applied to the common object, and may apparently be described by the same general terms.(*b*)

(*a*) *Electric Telegraph Co.* v. *Brett*, 8 C. B. 883.

(*b*) *Bovill* v. *Pimm*, 11 Exch. 739.

If mode not pointed out, patent will be for principle, and invalid.

If the specification does not point out the mode by which the process is to be performed, so as to accomplish the object in view, it will be a statement of a principle only, and the patent will be invalid. Thus, where a patentee stated in his specification the principle of his invention, and that he proposed to unite lead and tin by pressure, but did not give the exact proportions in which they were to be used, nor the mode in which they were to be combined; and a subsequent patentee specified the proportions of the two metals, gave the details of the mode of working, and did not claim the production of the new material, except according to the directions given, it was held that as the earlier patent only stated a principle, 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. (*a*)

So if every mode of carrying principle into effect is claimed.

If the patentee claims a principle to be carried into effect in any way in which it can be used, the claim is for the principle and the patent is bad. In the course of the argument of *Neilson* v. *Harford* (*b*) the plaintiff's counsel said that the patentee claimed every vessel and every shape of vessel in which air could be heated between the blowing apparatus and the furnace. Alderson, B., said: "Then I think that is a principle, if you claim every shape. If you claim a specific shape and go to the jury and say that which other people have adopted is a colourable imitation, then I can understand it. If you claim every shape you claim a principle. There is no difference between a principle to be carried into effect in any way

(*a*) *Betts* v. *Menzies*, 10 H. & C. 117; *Bovill* v. *Keyworth*, 7 El. & Bl. 735.

(*b*) 1 Webs. P. R. 355.

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you will and claiming the principle itself; you must detail some specific mode of doing it. Then the rest is a question for the jury." But it is not necessary to claim every mode which will succeed so long as some mode is pointed out. See the remarks of Lord Abinger in the same case, p. 356.

Additions to and improvements on machines good subject matter for a patent.

There was formerly a doubt as to whether there could be a patent for an addition to an old manufacture. This doubt rested entirely on *Bircot's case*, (*a*) where Lord Coke held that there could not be such a patent; but in *Boulton* v. *Bull*, (*b*) Eyre, C. J., said that the principle on which it was decided had not been adhered to; and Buller, J., said: "What were the particular facts of that case we are not informed, and there seems to me to be more quaintness than solidity in the reason assigned, which is, that it was but to put a new button to an old coat, and it is much easier to add than to invent. If the button were new, I do not feel the weight of the objection that the coat on which the button was to be put was old. But, in truth, the arts and sciences at that period were at so low an ebb in comparison with that point to which they have since advanced, and the effect and utility of improvements so little known, that I do not think that case ought to preclude the question. In later times whenever the point has arisen the inclination of the Court has been in favour of the patent for the improvement, and the parties have acquiesced where the objection might have been brought directly before the Court."

In *Morris* v. *Bransom* (*c*) it was decided that an addition to an old stocking frame was the subject of a patent,

(*a*) 3 Inst. 184.
(*b*) 2 H. Bl. 463.
(*c*) Bull (N. P.) 76 c.; 1 Webs. P. R. 51.

Lord Mansfield saying that the objection, that there could not be a patent for an addition, would if valid go to repeal almost every patent that was ever granted. And in *Hornblower* v. *Boulton*, (*a*) Grose, J., said that if *Bircot's case* were law it would set aside many patents for very ingenious inventions in cases where the additions to manufactures before existing are much more valuable than the original manufactures themselves, and that Lord Coke's opinion seemed to have been formed without due consideration, and was not well founded. The addition or improvement must be new and of benefit to the public. The law on this point was thus laid down by Buller, J., in *R.* v. *Arkwright*: (*b*) "In the case of an invention, many parts of a machine may have been known before, yet if there be anything material and new which is an improvement of the trade that will be sufficient to support a patent."

Addition or improvement must be new and of benefit to the public.

If it appears that any part of the invention which is claimed as an improvement is not so, the patent will be void as the Crown is deceived in the grant. (*c*) In *Morgan* v. *Seaward* (*d*) Parke, B., in considering this point said: "Upon the authorities we feel bound to hold that the patent is void upon the ground of fraud on the Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent where such utility is not suggested in the patent itself as the ground of the grant. That a false suggestion of the grantee avoids an ordinary grant of lands or tenements from the Crown is a maxim of the Common Law,

Patent void if what claimed as new is not so, as Crown is deceived in grant.

(*a*) 8 T. R. 104.

(*b*) 1 Webs. P. R. 71.

(*c*) *Losh* v. *Hague*, 1 Webs. P. R. 208.

(*d*) 2 M. & W. 561; M. & H. 60; 1 Webs. P. R. 196.

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and such a grant is void not against the Crown merely, but in a suit against a third person. It is on the same principle that a patent for two or more inventions when one is not new is void altogether, as was held in *Hill* v. *Thompson* (*a*) and *Brunton* v. *Hawkes*, (*b*) for although the statute invalidates a patent for want of novelty, and consequently by force of the statute the patent would be void so far as related to that which was old, yet the principle on which the patent has been held to be void altogether, is that the consideration of the grant is the novelty of all, and the consideration failing or, in other words, the Crown being deceived in its grant, the patent is void and no action is maintainable upon it. (*c*)

Claim for improvements valid though discoveries made since claim.

The claim to a patent for invention is not affected by the circumstance that by subsequent discoveries improvements have been made which lead to results being obtained which could not be obtained by the original invention. Where the plaintiff's invention was described both in the title and in the specification as consisting in "improvements in giving signals and sounding alarums in distant places by means of electric currents transmitted through metallic circuits," and it was subsequently discovered by the defendant that the circuit need not be continuously metallic, but that the earth might be used as a connecting medium, it was contended in an action for infringement that the words "metallic circuit" would mislead a person who was in possession of improvements identical with those of the plaintiff, but which he intended to use in giving signals by non-metallic circuits.

(*a*) 2 B. Moo. 424; 8 Taunt. 375; 1 Webs. P. R. 237.

(*b*) 4 B. & Ald. 542.

(*c*) *Barber* v. *Grace*, 1 Exch. 339; *Huddart* v. *Grimshaw*, 1 Webs. P. R. 85; *Heath* v. *Smith*, 3 El. & Bl. 256.

It was held, however, that the title did—the earth circuit not being publicly known—give sufficient notice to any person secretly acquainted with that discovery. In delivering the judgment of the Court of Common Pleas, Cresswell, J., said, "It appears to us reasonable to hold that a claim for a patent for improvements in the mode of doing something 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 not known at the time of the claim, so long as it remains identical with regard to the improvements claimed. (*a*)

Improvement on existing patent valid.

A patent for an improvement on an existing patent is valid. (*b*) In *Crane* v. *Price* (*c*) Sir N. C. Tindal, C. J., said that upon reason and principle there did not appear to be any objection to such a patent, the new patent after the expiration of the old one would be free from every objection, and while the former existed the new one could be legally used by the public by procuring a licence from the original patentee or by purchasing the apparatus from him or some of his agents. (*d*)

But if the improvements cannot be used without the machine for which the first patent has been granted, the patentees must wait until the original term has expired. (*e*)

Value of improvement question for jury.

It is a question for the jury to decide whether the im-

(*a*) *Electric Telegraph Co.* v. *Brett*, 10 C. B. 881.

(*b*) *Hill* v. *Thompson*, 3 Mer. 629; 1 Webs. P. R. 237; *Bovill* v. *Moore*, 2 Marsh. 211; *Lewis* v. *Davis*, 3 C. & P. 502; *Harmar* v. *Playne*, 11 East, 101.

(*c*) 1 Webs. P. R. 41

(*d*) See *Lister* v. *Leather*, 8 El. & Bl. 1017.

(*e*) *Ex parte Fox*, 1 V. & B. 67; *Lewis* v. *Davis*, 3 C. & P. 502; *Fox* v. *Dellestable*, 15 W. R. 194.

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provements claimed are trifling and insignificant and not worth a patent. (*a*)

Patent for a combination of known articles in new manner valid.

A patent may be granted for a combination of machinery or substances, all of which were known and in use previously so long as the combination is new, and useful. In *Boulton* v. *Bull*, (*b*) Buller, J., said that it is no objection to a patent for a mechanical or chemical discovery that the articles of which it is composed were known and were in use before, provided the compound article which is the object of the invention is new. (*c*)

"There are," said Lord Ellenborough, "common elementary *materials* to work with in *machinery*, but it is the adoption of those materials to the execution of any particular purpose that constitutes the invention; and if the application of them be new, if the combination in its nature be essentially new, if it be productive of a new end and beneficial to the public, it is that species of invention which protected by the king's patent ought to continue to the person the sole right of vending." (*d*)

Where the patent was for "an *improvement* or *improvements* in the making or manufacture of elastic goods or fabrics applicable to various useful purposes," and the invention consisted in the use of elastic threads or strands of India rubber covered with filaments wound round them, with yarns of cotton or other non-elastic materials placed alternately side by side as a warp and combining them

(*a*) *Losh* v. *Hague*, 1 Webs. P. R. 205.

(*b*) 2 H. Bl. 487.

(*c*) See also *Lukie* v. *Robson*, 2 Jur. 201.

(*d*) *Huddart* v. *Grimshaw*, 1 Webs. P. R. 86; *Bovill* v. *Moore*, 2 Marsh. 211; *Hill* v. *Thompson*, 8 Mer. 629; 1 Webs. P. R. 237; *Derosne* v. *Fairie*, *ib.* 154; *Gamble* v. *Kurtz*, 3 C. B. 425; *Bateman* v. *Gray*. 1 C. L. R. 514; *Cannington* v. *Nuttall*, L. R. 5 H. L. 205.

by means of a weft, when in extreme tension and deprived of their elasticity, so that a cloth was produced in which the non-elastic threads formed a limit up to which the elastic threads might be stretched, but beyond which they could not be stretched and therefore could not be easily broken, and the materials were old; but the jury found that the combination was new, the patent was supported. (*a*)

In *Bovill* v. *Keyworth* (*b*) the specification of a patent for improvements in manufacturing wheat and other grain into flour, claimed as the invention exhausting the dusty air when the same had been blown through the grinding surfaces of the mill stones from the chambers receiving the meal, by means of a blast of air. This invention consisted of the combination of a blast and an exhaust, both of which had been used separately in mills, and it was held to be the subject of a patent.

"If," said Lord Westbury, "a combination of machinery for effecting certain results has previously existed, and is well known, and an improvement is afterwards discovered, consisting for example of the introduction of some new parts, or an altered arrangement in some particulars of the existing constituent parts of the machine, an improved arrangement or improved combination may be patented." (*c*)

A patent may be granted for a machine formed by the mere arrangement of common elementary mechanical materials, even if it produce no other results than have been previously accomplished by other mechanical arrangements and construction, if it appears that the results ob-

(*a*) *Cornish* v. *Keene*, 4 Scott, 337; 3 Bing. (N. C.) 588; 1 Webs. P. R. 517. And see *Carpenter* v. *Smith*, 1 Webs. P. R. 538.

(*b*) 7 El. & Bl. 725.

(*c*) *Foxwell* v. *Bostock*, 12 W. R. 725.

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tained are produced with greater expedition and economy, and are of a better quality. (*a*)

The discovery of a property in a combination of known articles for useful purposes may be the subject of a patent. Thus the discovery that the combination of copper and zinc of a certain quality in specified proportions for the purpose of making an alloy, which combination would be defeated by the introduction of any foreign ingredients, was held to be a good subject matter for a patent. (*b*)

Combination does not claim each part as new.

A patent for a combination is not a claim that each part of it is new, but on the contrary each part may be old, and yet a new and useful combination of such old parts may be valid. (*c*)

A valid patent for a process gives protection to each part that is new and material for the process without any express claim of particular parts, and although the parts of the combination are old. (*d*)

Combination of things partly old and partly new.

A patent may be granted for a combination of old and new machinery. (*e*)

Test of novelty of combination.

In order to test whether a part of a combination for which a patent is taken out is new, it ought to be considered whether a patent could be granted for the part by itself. (*f*)

And in order to discover whether the whole invention is new the proper mode is to take the specification alto-

(*a*) *Murray* v. *Clayton*, L. R. 7 Ch. 570.

(*b*) *Muntz* v. *Foster*, 2 Webs. P. R. 93; *Walton* v. *Potter*, Webs. P. R. 604.

(*c*) *Lister* v. *Leather*, 8 El. & Bl. 1017.

(*d*) *Lister* v. *Leather*, 8 El. & Bl. 1023; *Parkes* v. *Stevens*, L. R. 8 Eq. 367; on app., L. R. 5 Ch. 36.

(*e*) *Sellers* v. *Dickenson*, 5 Exch. 312; *Newton* v. *Grand Junction Railway Co.*, *ib.* 331.

(*f*) *Parkes* v. *Stevens*, L. R. 5 Ch. 36.

gether, and see whether the matter claimed as a whole is new.(a) "I take it," said Lord Hatherley in *Cannington* v. *Nuttall*,(b) "that the test of novelty is this: Is the product which is the result of the apparatus for which an inventor claims letters patent effectively obtained by means of your new apparatus, whereas it had never before been effectively obtained by any of the separate portions of the apparatus which you have now combined into one valuable whole for the purpose of effecting the object you have in view."

Application of old machine to analogous purposes or new materials cannot be patented unless mode of application new.

A patent cannot be granted for the application of a well known machine to purposes analogous to the purpose to which it has already been applied, unless the mode of application is new.(c)

In *Kay* v. *Marshall*(d) the plaintiff claimed to have invented "new and improved machinery for preparing and spinning flax, hemp, and other fibrous substances by power." The specification, after setting forth and describing the invention and in what manner the same was to be performed, claimed as the invention in respect of new machinery, for preparing flax, hemp, and other fibrous substances certain macerating vessels, and the trough of water described in the specification; and claimed as the invention in respect of improved machinery for spinning flax, etc., the trough for holding the rovings when taken from the macerating vessels, and placing the retaining rollers and the drawing rollers nearer to each other than they had ever been placed before. It was shown that before the date of the patent fibrous substances

(a) *Newton* v. *Grand Junction Railway Co.*, 5 Exch. 334.

(b) L. R. 5 H. L. 216.

(c) *Losh* v. *Hague*, 1 Webs. P. R. 208.

(d) 2 Webs. P. R. 36.

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had been spun at a shorter reach than two-and-a-half inches, but that it was not known that flax could be spun by means of maceration, as having a short fibre at a reach of two-and-half inches. It was held by the Court of Common Pleas on a case sent by Lord Langdale that there was not such an invention as to support a patent. Sir N. C. Tindal, C. J., said: "Now whether a patent can by law be taken out for placing the retaining rollers and the drawing rollers of a spinning machine, which machine itself was known, and in use before, within two inches-and-a-half of each other under the circumstances stated in the case is the real question between the parties, and we think it cannot." The case then went to the House of Lords, where the judgment of the Court of Common Pleas was affirmed. Lord Cottenham said, p. 82, "that if a man has discovered any means of using a machine which the world has not known before the benefit of, that he has a right to secure to himself by means of a patent, but if the mode was known before, then he cannot deprive the public of having the benefit of that which they enjoyed before."

In *Pow* v. *Taunton* (*a*) the patent was for the application of a nipping lever to the surface of a wheel for the purpose of making it revolve; and it was held that, though the application of the nipping lever might be new, it must be shown that the means essential for carrying the application into effect were new also. So in *Reg.* v. *Cutler* (*b*) it was held that the application of iron tubes coated with brass to form the tubular flues of steam boilers could not be supported as, although the application of the tubes was new, neither the tubes themselves nor the mode of applying them was new.

(*a*) 9 Jur. 1056. (*b*) 2 C. & K. 215.

In *Harwood* v. *The Great Northern Railway Co.*,(a) the patent was for "improvements in fishes and fish joints for connecting the rails of railways." The material part of the specification was as follows: "The fishes are made with a groove or recess in their outer surfaces, which groove serves to receive the square heads of the bolts, and prevent them turning round when the nuts are screwed on or off. Washers are placed in the groove of the fish, which is next to the nuts, so as to allow of the nuts being turned round; or the fish on this side may be made without the groove. The position of the bolts and nuts may be reversed if preferred, so that the nut may be prevented from turning round while the bolt is screwed into it. The groove renders the fish lighter for an equal strength or stronger for an equal weight of metal than a fish which is made of an equal thickness throughout. The top and bottom of each fish is a plane surface, and the parts of the rail with which they come in contact are also plane surfaces forming the same angle as the top and bottom surfaces of the fish. The fishes are thus made to fit into their places with greater facility than if these surfaces were of curved or irregular forms. If, however, the surfaces of the rails are curved, the fishes may be made to fit them."

It was proved that before the date of the patent the rails of railways had been connected by fishes and fish joints, attached to each side of the rails at the joints by means of bolts and nuts, but until the time of the patent, fishes for connecting the rails of railways had never been made with a groove or recess in their outer or lateral surfaces so as to receive the square heads of the bolts.

(a) 11 H. L. C. 654.

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It was also proved that double channelled iron had been used for fishing the beams of railway bridges. Lord Westbury, in moving the judgment of the House of Lords, said: "The question is whether there can be any invention of the plaintiff in having taken that thing which was a fish for a bridge, and having applied it as a fish to a railway. Upon that, I think, the law is well and rightly settled, for there would be no end to the interference with trade and with the liberty of adopting any mechanical contrivance if every slight difference in the application of a well known thing should be held to constitute ground for a patent. . . There is the familiar contrivance of the button to the button hole taken from the waistcoat or coat, which may be applied in some particular mechanical combination in which it has not hitherto been applied, to constitute that application the subject of a patent to be granted for a new invention. No sounder doctrine was ever established than . . . . that you cannot have a patent for a well known mechanical contrivance, merely when it is applied in a manner or to a purpose which is not quite the same, but is analogous to the manner or to the purpose in or to which it has been hitherto notoriously used. The channelled iron was applied in a manner which was notorious, and the application of it to a vertical fish would be no more than the application of a well known contrivance to a purpose exactly analogous or corresponding to the purpose to which it had been previously applied."

In *Jordan* v. *Moore*,(*a*) it was decided that the combination of iron and timber in the construction of ships, being already well known and commonly used, a patent

(*a*) L. R. 1 C. P. 635.

for a peculiar combination of those two materials could not be sustained; and in *Mackelcan* v. *Rennie*, (*a*) it was said by the Court, though the point was not expressly decided, that the use of iron instead of timber in the construction of floating docks was not an invention for which a patent could be granted.

Use of old machine in old manner cannot be patented.

A patent cannot be taken out for the use of a machine known before, in a manner known before, so as to gain a particular advantage. (*b*)

In *Tetley* v. *Easton*, (*c*) the patent was for an invention of "certain improvements in machinery, for raising and impelling water and other liquids." The specification described the machine, which was a pump working by centrifugal force, and the part of the machine upon which the question arose was thus described: "In the interior of the case *gg* is placed a hollow wheel having hollow spokes or radial arms of which *qq* are two, *rr* I call a nave, which is hollow; and *ss* are two hollow shafts, one at each side of the wheel." "In reference to the hollow wheel, I do not confine myself to the number or to the use of hollow spokes, but in some cases propose to substitute circular discs with a narrow water channel between, and a valve or flexible valve or valves on the circumference so as to have a channel or channels in the interior thereof for the passage of liquids, and adapted to neutralize the effects of suction by having a corresponding or proportionate degree of suction each side." The patentee after disclaiming any exclusive right to wheels when consisting of hollow spokes or of a channel or

(*a*) 13 C. B. (N. S.) 61. See *Arnold* v. *Bradbury*, L. R. 6 Ch. 706.

(*b*) *Ralston* v. *Smith*, 11 H. L. C. 223.

(*c*) 2 C. B. (N. S.) 706.

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channels between discs, when considered apart or separate from the machinery described, claimed as his invention "the means of increasing the action of the machine by causing the liquid to enter the wheel on both sides. It was proved that the form of the patentee's wheel was not now and that the plan of admitting water at both sides for the purpose of being projected forward by centrifugal force was not now, it having been made known by a previous specification of a patent for a similar purpose. Cresswell J., said: "It may be true that the plaintiff first explained the full benefit obtained by so introducing it, but the discovery that a particular advantage was obtained by the use of a wheel known before, in a manner known before, cannot be called an invention or application to sustain a patent."

Nor application of known machine and new material.

In the case of *The Patent Bottle Envelope Co.* v. *Seymour*, (*a*) Willes, J., said that the application of a well known tool to work previously untried materials or to produce new forms is not the subject matter of a patent, and that to hold the contrary might tend to produce oppressive monopolies in the application of old and well known implements to new materials without any further novelty or merit than discovery of the material or the form into which it is to be worked; and that such a discovery was not one of a new manufacture within the statute, and that a patent for it alone could not be maintained. When a patent was taken out in the year 1853 for "certain improvements in preparing, dressing, finishing, and winding cotton and linen yarns or threads, and in the machinery connected therewith," the specification of which stated that "the yarns or

(*a*) 5 C. B. (N. S.) 164.

thread to be dressed are wound upon a roller or beam at one end of the machine, pass through the operation of sizing as in common use, and from thence to the corresponding beam at the opposite or finishing end of the machine;" and in the year 1856 a patent was taken out for "an improvement in finishing yarns of wool or hair, and in the finishing of woven fabrics or piece goods," a similar process being described by the specification, except that no mention was made of sizing, it was held that sizing was not a part of the process or apparatus patented in 1853, and that the latter patent was void as being for the application of the same machinery to a new material as had already been applied to other material with the same result.(*a*)

Mere improvement in existing process not subject of patent.

A mere improvement in performing an operation already well known and long practised cannot be the subject of a patent. In *Brunton* v. *Hawkes*(*b*) the invention consisted in casting the two flukes of an anchor in one piece; previously the two flukes had been welded to the shank, and the patent was held to be void. "A patent," said Abbott, C. J., "for a machine, each part of which was in use before, but in which the combination of different parts is new and a new result is produced, is good, because there is novelty in the combination. But here the case is perfectly different; formerly three pieces were united together, the plaintiff only unites two; and if the union of those two had been effected in a mode unknown before, as applied in any degree to similar purposes, I should

(*a*) *Brook* v. *Aston*, 8 E. & B. 478; affd., 5 Jur. (N. S.) 1025; 28 L. J. Q. B. 175. See also *Bush* v. *Fox*, 5 H. & C. 707; *Willis* v. *Davison*, 1 N. R. 234; *Rushton* v. *Crawley*, L. R. 10 Eq. 522.

(*b*) 4 B. & Ald. 540.

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have thought it a good ground for a patent; but unfortunately the mode was well known and long practised. I think a man cannot be entitled to a patent for uniting two things instead of three, where that union is effected in a mode well known and long practised for a similar purpose."

In *Ormson* v. *Clarke*,(*a*) it was held that casting tubular boilers in one piece, they having previously been made in several pieces, was not the subject of a patent. In *Horton* v. *Mabon*,(*b*) the patentee claimed as his invention the substitution of double angle iron, for two pieces of single angle iron in the formation of hydraulic cups or points to telescopic gas holders. It was well known that the cups might be made by riveting two pieces of single angle iron to a plate, and it was held that the substitution of double angle iron was not an invention for which a patent could be granted. Willes, J., said: "No doubt a new combination of old machinery or instruments, whereby a new and useful result is obtained, may be the subject of a patent. But there must be some invention. There is none here. By making a thing in one piece instead of as before uniting several pieces together the patentee no doubt effects a considerable saving of labour and expense. The merit is due to the person who first produced the article called double angle iron. That is old and well known, and had long been applied to purposes not dissimilar to that to which the present plaintiff applies it. The mere fact of its application to gasholders rendering their construction better or cheaper does not constitute a subject matter of a patent."

There must be some invention

(*a*) 14 C. B. (N. S.) 475.

(*b*) 12 C. B. (N. S.) 437 affd. 16 C. B. (N. S.) 141.

The invention must consist either in some new combination of old existing materials or else in the discovery of something that did not exist before. Thus, in *Thompson* v. *James*, (*a*) it was held that the substitution of steel for whalebone hoops for distending petticoats was not the subject of a patent. (*b*) "The use of a new material," said Sir R. Malins, V. C., "to produce a known result is not the subject matter of a patent, but there must be some invention, something really new, something more valuable to the public than the simple use of a new material to produce a known article." (*c*)

Combination or discovery.

If the new application of any machine or process lies so much out of the track of the former use as not naturally to suggest itself to a person turning his mind to the subject, but to require some application of thought or study; it may be the subject of a patent. (*d*)

Some application of thought and study necessary.

If the invention is in reality a modification or alteration of the original idea, and the result produced is new and useful, then it appears that a patent may be granted, although the machine or the process is old. Thus in *Steiner* v. *Heald*, (*e*) a known process applied to fresh madder, was applied by the patentee to "spent madder," which, before the date of his patent was known to contain some colouring matter, but no process was known by which it could be extracted, and it was consequently thrown away as useless. The result of the invention was to render the "spent madder" valuable. It was held that though the properties of fresh and spent madder

A real alteration in the original idea will support a patent.

(*a*) 32 Beav. 573.

(*b*) And see *White* v. *Toms*, 37 L. J. Ch. 204.

(*c*) *Rushton* v. *Crawley*, L. R. 10 Eq. 522.

(*d*) *Penn* v. *Bibby*, L. R. 2 Ch. 127; *Harwood* v. *Great Northern Railway Co.*, 2 B. & S. 208.

(*e*) 6 Exch. 607.

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might be the same or might be different, it did not follow as a matter of law that the plaintiff's patent was void, but that it was a question for the jury whether the invention was a new manufacture.(*a*)

In *Newton* v. *Vaucher*,(*b*) the defendant obtained a patent for packing parts of hydraulic engines or machines, or rendering the same fluid tight. The invention consisted in the application of soft metal instead of elastic substances, which had been in use before for enabling the axis of the machine to work in a case and to be water, air, and steam tight. Nothing was said as to friction or bearings. After the date of the defendant's patent the plaintiff discovered that when there was pressure upon soft metal, friction was in a great degree diminished, and he took out a patent for the application of this discovery to improvements in the construction of boxes for the axles or axle-trees of locomotive engines or carriages, and for the bearings of machinery in general. It was held that the patent was for a new principle embodied in a new machine, that the application of the soft metal differed essentially from that of the specification, and that the patent was valid.

Change in order of process may be good subject matter.

Where the invention is for a mere process, any change in the order of the process constitutes a new manufacture. Thus, where the invention was the rendering fabrics waterproof, but at the same time leaving them pervious to air by immersing the fabric in a mixture of a solution of alum with carbonate of lime and then in a solution of soap, and it appeared that before the plaintiff's patent a solution of alum and soap was made in which the

(*a*) See also *Derosne* v. *Fairie*, 1 Webs. P. R. 154.

(*b*) 6 Exch. 859.

fabric was immersed, it was held that the plaintiff's patent was good.(*a*) So, where the use of soap and water in the process of felting, instead of acidulated water, was known, and the use of rollers was also known, it was held that a patent for the application of soap and water in combination with rollers was a good subject matter for a patent.(*b*)

Adaptation of known substance to new purpose is subject of a patent.

The adaptation of a known substance to a purpose to which it has never before been applied, and the properties and qualities of which for the purpose of being adopted to the particular purpose have never been known or used before, is the subject of a patent. In *Walton* v. *Potter* (*c*) it was held that the adaptation of caoutchouc as a substitute for the fillets or sheets of leather which are commonly used in the construction of cards, for carding wool, cotton, silk and other fibrous substances was a new invention.(*d*)

Omission of part of process may be subject of patent.

An invention or a discovery by means of which some part of a machine or of a process may be omitted is a useful invention, and the subject of a patent.(*e*) In *Russell* v. *Cowley*,(*f*) the invention was for the manufacture of tubes for gas and other purposes without the use of a maundril, which had always been previously used, and in *Booth* v. *Kennard*(*g*) the patent claimed the making gas directly from seeds and other oleaginous

(*a*) *Halliwell* v. *Dearman*, 1 Webs. P. R. 401.

(*b*) *Allen* v. *Rawson*, 1 C. B. 551.

(*c*) 4 Scott (N. R.) 145; 3 M. & Gr. 438; 1 Webs. P. R. 604.

(*d*) And see *Cornish* v. *Keene*, 4 Scott, 337; 3 Bing. (N. C.) 570; 1 Webs. P. R. 517.

(*e*) *Minter* v. *Mower*, 6 A. & E. 735; 1 Webs. P. R. 139.

(*f*) 1 C. M. & R. 864; 1 Webs. P. R. 463.

(*g*) 1 H. & N. 527.

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substances, instead of making it from oil obtained from those substances, and thus got rid of one process. In both these cases it was held that, assuming the invention to be new the patent could be sustained. In *Wallington* v. *Dale*, (*a*) it appeared that in the manufacture of gelatine before the date of the plaintiff's patent the hides of animals were cut in large pieces and submitted to the action of caustic alkali, or else were reduced to pulp in a mill similar to a paper mill, and that blood was employed for the purpose of purification. The patentee's invention consisted in reducing the hides to thin slices or shavings, so as to retain a texture which could be dealt with mechanically without destroying the fibre, and by this means he avoided the use of acids or alkalis or blood, and the patent was held to be good.

New use of old materials.

A process by which old materials can be used again in the same manufacture is a good subject for a patent. (*b*)

A process, which makes a chemical curiosity available for practical purposes, may be patented.

A patent may be taken out for a discovery or an invention by means of which any substance previously known as a chemical curiosity may be supplied to the public for useful and economical purposes. (*c*)

In *Young* v. *Fernie* (*d*) the patent was for "improvements in the treatment of certain bituminous mineral substances and matters or products therefrom," and the invention consisted in treating bituminous coals in such manner as to obtain an oil containing paraffine (which

(*a*) 7 Exch. 888.

(*b*) *Hills* v. *The Liverpool Gas Light Co.*, 9 Jur. (N. S.) 140; *Hills* v. *The London Gas Light Co.*, 5 H. & N. 313; *Steiner* v. *Heald*, 6 Exch. 607.

(*c*) *Stevens* v. *Keating*, 2 Webs. P. R. 189; *Sellers* v. *Dichinson*, 5 Exch. 326; *Bewley* v. *Hancock*, 6 D. M. G. 391.

(*d*) 4 Giff. 577.

was called paraffine oil) and from which oil paraffine was obtained. The coals which were deemed to be best fitted for this purpose were such as are usually called parrot coal, cannel coal and gas coal, as they yielded, upon distillation at a high temperature, olefiant and other highly illuminating gases in considerable quantity. Paraffine was first discovered by Dr. Reichenbach in 1830, and was first obtained from beechwood tar. What first attracted the special attention of chemists was, that paraffine, though a white solid substance, was composed of exactly the same elements in exactly the same proportion as olefiant gas. It had been supposed by some persons that paraffine might be obtained from certain schists, but the plaintiff's experiments led him to conclude that the proper materials were the cannel and highly bituminous coals. The principle of the plaintiff's discovery was the degree of heat at which the distillation was to be carried on, and this was substantially the process patented. It was proved that many practical and manufacturing chemists had been endeavouring before the plaintiff's patent to manufacture paraffine oils so as to supply the market, but that none had been successful.

In a book published by Dr. Reichenbach in 1854 occurred the following passage: "So remained paraffine until this hour, a beautiful item in the collection of chemical preparations, but it has never escaped from the rooms of the scientific man." Sir John Stuart, V.C., said: "Something therefore remained to be ascertained in order to the useful application of this article for economical and commercial purposes. This illustrates the important distinction between the discoveries of the merely scientific chemist and of the practical manufacturer

The question is whether anything remained to be discovered.

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who invents the means of producing in abundance, suitable for economical and commercial purposes, that which previously existed as a beautiful item in the cabinets of men of science.

The law looks to the inventor who supplies useful article.

"What the law looks to is the inventor and discoverer who finds out and introduces a manufacture which supplies the market for useful and economical purposes with an article which was previously little more than the ornament of a museum. . . . Inventions in mechanics are as widely different from inventions in economical chemistry as the laws and operations of mechanical forces differ from the laws of chemical affinities, and the results of analysis and experiment in the comparatively infant science of chemistry with its boundless field of undiscovered laws and undiscovered substances."

Chemical and mechanical inventions widely different.

In *Higgs* v. *Goodwin* (*a*) it was held that a patent for "treating chemically the collected contents of sewers and drains in cities, towns and villages, so that the same may be applicable to agricultural and other purposes," by employing hydrate of lime for precipitating the animal and vegetable matter contained in the sewage water, could be supported as a process producing a new result,—manure in a particular form.

In *Hills* v. *The London Gas Light Co.* (*b*) the patent was for "an improved mode of compressing peat and of manufacturing gas and of obtaining certain substances applicable to purifying the same." It was known before the date of the patent 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. It was objected that the mere application of the hydrated oxides to absorb

(*a*) El. Bl. & El. 529. (*b*) 5 H. & N. 312.

the sulphuretted hydrogen from coal gas was not the subject of a patent, as that property of it was previously well known, but it was held that as the patentee said that he claimed the application in the manufacture of gas in the way he had described, and had shown how it might be used, the patent was good.

A discovery that the mixture of two or more simple substances in certain definite proportions will form a compound substance, valuable for medical or other qualities, is a good subject matter for a patent. (*a*)

There may be several patents having the same object in view so long as the modes of attaining the object are different. (*b*) "There can be no doubt whatever," said Sir N. C. Tindal, C. J., in *Walton* v. *Potter*, (*c*) "that although one man has obtained a patent for a given object, there are many modes still open for other men of ingenuity to obtain a patent for the same object; there may be many roads leading to one place, and if a man has by dint of his own genius and discovery after a patent has been obtained been able to give to the public without reference to the former one or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent for that purpose. In *Palmer* v. *Wagstaff* (*d*) Sir F. Pollock, C. B., said, "If any other person can discover a method of producing the same effect by a totally different means, he has a right to do so." The invention must be complete in itself and not require the use of another person's invention. (*e*)

There may be several patents with the same object, mode must be different.

Invention must be complete.

(*a*) Per Lord Cranworth in *Bewley* v. *Hancock*, 6 D. M. G. 391.

(*b*) *Huddart* v. *Grimshaw*, 1 Webs. P. R. 92.

(*c*) 1 Webs. P. R. 591.

(*d*) 9 Exch. 501.

(*e*) *Woodcroft's Patent*, 2 Webs. P. R. 27

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In *Hullett* v. *Hague* (*a*) the patent was for "improvements in evaporating sugar." The specification described the invention to consist 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." A prior specification was proved in which the same object was attained by means of a pipe or pipes, perforated with a number of small holes, coiled at the bottom of the boiler. It was held that though the object of the two patents was the same, the mode of effecting the object was different; and that as the latter patent was for the mode or apparatus, it was not void because of the prior specification. (*b*)

Novelty of invention question for jury.

The question as to whether an invention is a new manufacture or not is one of fact for the jury. (*c*)

(*a*) 2 B. & Ad. 370.

(*b*) And see *Booth* v. *Kenward*, 2 H. & N. 84; *Seed* v. *Higgins*, 8 H. & C. 550; *Losh* v. *Hague*, 1 Webs. P. R. 207; *Steiner* v. *Heald*, 2 C. & K. 1022; 6 Exch. 607.

(*c*) *Losh* v. *Hague*, 1 Webs. P. R. 207; *Steiner* v. *Heald*, 6 Exch. 607; *Spencer* v. *Jack*, 11 L. T. (N. S.) 242; *Kay* v. *Marshall*, 5 Bing. (N. C.) 492; *Saunders* v. *Aston*, 3 B. & Ad. 881; *Manton* v. *Parker*, Dav.

Utility in the invention is requisite.

An invention must not only be new but it must also be useful. This condition is not imposed by the Statute of Monopolies (21 Jac. I. c. 3, s. 6), which only requires that the invention shall be new, not that it shall be useful; and if it is proved to be new then the condition imposed by the statute is complied with;(*a*) but it is a condition required by the common law, for the public have a right to receive a meritorious consideration in return for the protection which the patent claims.(*b*) "I think," said Ashurst, J., "that as every patent is calculated to give a monopoly to the patentee, it is so far against the principles of law and would be a reason against it, were it not for the advantages which the public derive from the communication of the invention after the expiration of the term for which the patent is granted."(*c*)

"A grant of a monopoly," said Parke, B., in *Morgan* v. *Seaward*,(*d*) "for an invention which is altogether useless may well be considered as 'mischievous to the state, to the hurt of trade, or generally inconvenient,' within the meaning of the statute of James I., which requires, as a condition of the grant, that it should not be so, for no addition or improvement of such an invention could be made by any one during the continuance of the monopoly, without obliging the person making use of it to purchase the useless invention; and on a review of the cases it may

P. C. 327; *De la Rue* v. *Dickinson*, 7 El. & Bl. 738; *Hill* v. *London Gas Light Co.*, 27 L. J. Ex. 60; *Bush* v. *Fox*, 5 H. L. C. 707.

(*a*) *Lewis* v. *Marling*, 4 C. & P. 58; 10 B. & C. 27; 1 Webs. P. R. 497.

(*b*) *Boulton* v. *Bull*, 2 H. Bl. 477.

(*c*) *Turner* v. *Winter*, 1 T. R. 605; 1 Webs. P. R. 8.

(*d*) 2 M. & W. 562; M. & H. 61; 1 Webs. P. R. 197.

be doubted whether the question of utility is anything more than a compendious mode introduced in comparatively modern times of deciding the question whether the patent be void under the Statute of Monopolies."

In *R.* v. *Arkwright*, (*a*) Buller, J., said that the question for the jury to consider was whether the improvement for which the patent was taken out was material or useful; and in *Morgan* v. *Seaward*, (*b*) Alderson, B., said that if the invention was useful, it was a subject to be supported by a patent, and if it was not useful, then it was no subject to be supported.

In *Manton* v. *Parker*, (*c*) the patent was held to be void, as the utility of the invention wholly failed. (*d*)

A patent which is taken out merely for the purpose of obstructing subsequent improvements, and to prevent the introduction of other inventions adapted to the particular subject to which it is applicable, cannot be supported. (*e*)

Amount of utility not considered.

The amount of utility is not to be considered, it is sufficient if there is some utility. In *Morgan* v. *Seaward*, (*f*) Alderson, B., said: "It is not material that the improvement should be great. It is sufficient if there is an improvement at all." (*g*)

Invention may fail in unessential particulars.

If the invention is new and useful on the whole, it is

(*a*) 1 Webs. P. R. 73.

(*b*) 1 Webs. P. R. 172.

(*c*) Dav. P. C. 327.

(*d*) See also *Manton* v. *Manton*, Dav. P. C. 349; *Bovill* v. *Moore*, *ib.* 399; *Huddart* v. *Grimshaw*, 1 Webs. P. R. 85; *Russell* v. *Cowley*, *ib.* 467; 1 C. M. & R. 874; *Hill* v. *Thompson*, 3 Mer. 629; 1 Webs. P. R. 237; *Minter* v. *Wells*, 1 Webs. P. R. 129; *Brunton* v. *Hawkes*, 4 B. & Ald. 541.

(*e*) *Crossley* v. *Potter*, Macr. 245.

(*f*) 1 Webs. P. R. 172.

(*g*) *Betts* v. *Walker*, 14 Q. B. 374; *Stead* v. *Williams*, 1 Webs. P. R. 134.

no objection that it fails in some particular, if that has not been claimed as essential,(a) and there is no false suggestion.(b)

Where the patent was for an improved machine for shearing woollen cloths by means of rotary cutters going from list to list, and the plaintiff claimed in his specification, among other things, the application of a proper substance to brush the cloth, which turned out to be useless, but did not claim it as essential, Lord Tenterden, C. J., said: "As to the objection on the ground that the application of a brush was claimed as part of the invention, adverting to the specification, it does not appear that the patentee says the brush is an essential part of the machine, although he claims it as an invention. When the plaintiffs applied for the patent, they had made a machine to which the brush was affixed, but before any machine was made for sale, they discovered it to be unnecessary. I agree that if the patentee mentions that as an essential ingredient in the patent article, which is not so, nor even useful, and whereby he misleads the public, his patent may be void; but it would be very hard to say that this patent should be void, because the plaintiffs claim to be the inventors of a certain part of the machine not described as essential, and which turns out not to be so. Several of the cases already decided have borne hardly on the patentees, but no case has hitherto gone the length of deciding that such a claim renders a patent void, and I am not disposed to

(a) *Haworth* v. *Hardcastle*, 1 Bing. (N. C.) 182; 1 Webs. P. R. 480; *Boulton* v. *Bull*, 2 H. Bl. 498; *Neilson* v. *Harford*, 8 M. & W. 806; 1 Webs. P. R. 316; *Huddart* v. *Grimshaw*, Dav. P. C. 265.

(b) *Morgan* v. *Seaward*, 2 M. & W. 563.

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make such a precedent." And Bayley, J., said: "Now at the period when this specification was made, the plush (the substance used) was in use, and there is no reason to believe that this patentee did not think it was a useful part of the machine. His patent is for an instrument where something of that kind was always thought material, and I am of opinion that the subsequent discovery that the plush was unnecessary is no objection to the validity of the patent. If the party knew that it was unnecessary, the patent would be bad on the ground that this was a deception, but if he thought that it was proper, and only by a subsequent discovery finds out that it is not necessary, I think that it forms no ground of objection." (*a*)

It is not necessary that a patent should be so useful as to exclude every other means of attaining the same end, it is sufficient, if on any occasion it is useful. (*b*)

Question of utility is for the jury to decide.

It is for the jury to decide whether or not the invention is useful, (*c*) and it is not necessary to prove that the invention has actually been tried and found to answer, but the jury may accept the evidence of scientific persons that such an invention would be useful. (*d*) The fact of an invention not getting into use is a presumption against its utility. (*e*)

(*a*) *Lewis* v. *Marling*, 4 C. & P. 57; 10 B. & C. 22; 1 Webs. P. R. 495.

(*b*) *Tetley* v. *Easton*, Macr. 63.

(*c*) *Lewis* v. *Davis*, 3 C. & P. 502; *Bloxam* v. *Elsee*, 1 C. & P. 565; 6 B. & C. 173; *Haworth* v. *Hardcastle*, 1 Bing. (N. C.) 182; 1 Webs. P. R. 480; *Tetley* v. *Easton*, Macr. 63.

(*d*) *Neilson* v. *Harford*, 1 Webs. P. R. 316.

(*e*) *Morgan* v. *Seaward*, 1 Webs. P. R. 186.

CHAPTER IV.

OF THE SPECIFICATION.

Condition voiding letters patent if specification not accurate.

ALL letters patent are now granted upon the express condition that they shall be void if the patentee does not particularly describe and ascertain the nature of his invention and in what manner the same is to be performed, by an instrument in writing, called a specification, and cause the same to be filed in the office for filing specifications within six calendar months, next and immediately after the date of the letters patent. (*a*)

Accuracy important.

It is of the greatest importance that the specification should give the most ample and accurate description of the invention, for the description of the invention is to be taken from it and not from the patent. (*b*)

In *Morgan* v. *Seaward*, (*c*) Alderson, B., said: "It is absolutely necessary that the patentee should state in his specification not only the nature of his invention but how that invention may be carried into effect; unless he is required to do that, monopolies could be given for fourteen years to persons who would not on their part do what in justice and in law they ought to do, state fairly to the public what their invention is in order that other persons may know the prohibited ground, and in order that the public may be made acquainted with the means by

(*a*) 15 & 16 Vict. c. 83, s. 9. 1 Webs. P. R. 60.
(*b*) *Arkwright* v. *Nightingale*, (*c*) 1 Webs. P. R. 173.

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Object of specification is to enable public to use invention at expiration of term.

which the invention is to be carried into effect." (*a*) Absolute precision is of course not practicable. (*b*) The object of the specification is that the invention shall be so described that after the term has expired the public shall have the benefit of it, (*c*) and the specification must so far describe the invention as to enable any person of ordinary skill to make the machine or perform the process. (*d*) In *R.* v. *Arkwright*, (*e*) Buller, J., said: "A man to entitle himself to the benefit of a patent for a monopoly must disclose his secret and specify his invention in such a way that others may be taught by it to do the thing for which the patent is granted, for the end and meaning of the specification is to teach the public after the term for which the patent is granted, what the art is, and it must put the public in possession of the secret in as ample and beneficial a way as the patentee himself uses it, and unless the discovery be true and fair the patent is void;" and in *Liardet* v. *Johnson* (*f*) it was said that one principal question on patents is, whether the specification is sufficient to enable others to make it up, for the meaning of it is that others may be taught to do the thing for which the patent is granted, so that the public may have the benefit of the discovery when the term has expired. (*g*)

(*a*) And see *Morton* v. *Middleton*, 1 Dec. of Ct. of Sess. 3rd series, 719; *Thomas* v. *Welch*, L. R. 1 C. P. 201.

(*b*) *Boulton* v. *Bull*, 2 H. Bl. 493.

(*c*) *Arkwright* v. *Nightingale*, 1 Webs. P. R. 61.

(*d*) *Stead* v. *Williams*, 2 Webs. P. R. 135; *Betts* v. *Menzies*, 8 El. & Bl. 937.

(*e*) 1 Webs. P. R. 66.

(*f*) Bull (N. P.) 76; 1 Webs. P. R. 53.

(*g*) See also *Newberry* v. *James*, 2 Mer. 446; *Hills* v. *London Gaslight Co.*, 5 H. & N. 340; *Ralston* v. *Smith*, 9 C. B. (N. S.) 117; *Holmes* v. *The London and North-Western Railway Co.*, Macr. 16.

The specification is the price that the inventor pays for the patent privileges. (*a*)

Specification is price paid by inventor for patent.

It must describe the same invention as the patent, (*b*) and the patent will be void if the inventor attempts by his specification to include matters that are not of his own actual invention.

Must describe same invention as patent, and not attempt to include matters not of patentee's invention.

In *Hill* v. *Thompson*, (*c*) Lord Eldon said: "Not only must the invention be new and useful, and the specification intelligible, but the specification must not attempt to cover more than that which being both a matter of actual discovery and of useful discovery, is the only proper subject for the protection of a patent." (*d*)

In *Campion* v. *Benyon*, (*e*) a patent was obtained for a "new and improved method of making and manufacturing double canvas and sail-cloth, with hemp and flax, or either of them, without any starch whatsoever." 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. It was proved that canvas had been woven without starch before the date of the letters patent, and it was held that the patent was void as being taken out for more than the patentee had really discovered, and in *Huddart* v. *Grimshaw* (*f*) Lord Ellenborough said, that if a patentee in stating the means by which the invention is to be used, oversteps his right, and appropriates more than is his own, he cannot avail himself of the benefit of the patent.

(*a*) *Walton* v. *Potter*, 1 Webs. P. R. 595; *Gibson* v. *Brand*, *ib.* 629; *Morgan* v. *Seaward*, *ib.* 173; *Wood* v. *Zimmer*, Holt (N. P.) 60; 1 Webs. P. R. 83.

(*b*) See the judgment of Abbott, C. J., in *R.* v. *Wheeler*, 2 B. & Ald. 251.

(*c*) 3 Mer. 626; 1 Webs. P. R. 237.

(*d*) And see *Rushton* v. *Crawley*, L. R. 10 Eq. 527.

(*e*) 6 B. Moo. 71; 3 Brod. & Bing. 5.

(*f*) 1 Webs. P. R. 86.

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Specification must give best mode of working known to the patentee.

The specification must give all the inventor's knowledge to the public, and if the patentee knows a better mode of working than that which he gives to the public, the specification will be void. (*a*) "A man," said Pollock, C. B., "has no right to patent a principle, and then give the public the humblest instrument that can be made from his principle, and reserve to himself all the better part of it." (*b*) Where a substance directed to be used contained foreign matter which was injurious, and the specification did not show any method of removing it, and it was not generally known how it could be removed, the specification was held insufficient. (*c*)

The rule was thus laid down by Gibbs, C. J., in *Wood* v. *Zimmer*: (*d*) "A man who applies for a patent and possesses a mode of carrying on that invention in the most beneficial manner, must disclose the means of producing it in equal perfection and with as little expense and labour as it costs the inventor himself. The price that he pays for his patent is that he will enable the public at the expiration of his privilege to make it in the same way and with the same advantages. If anything that gives an advantageous operation to the thing invented be concealed, the specification is void." In this case the specification described a mode of making verdigris, but it appeared that the patentee had been in the habit of clandestinely using aquafortis, by means of which the process was hastened, and it was held that the speci-

Omission of material part of process bad.

(*a*) *Walton* v. *Bateman*, 1 Webs. P. R. 622.

(*b*) *Tetley* v. *Easton*, Macr. 76. And see *Sturtz* v. *De la Rue*, 5 Russ. 322; 1 Webs. P. R. 83 *n*.

(*c*) *Derosne* v. *Fairie*, 2 C. M. & R. 476; 1 Gale, 109; 1 Webs. P. R. 157.

(*d*) Holt (N. P.) 60; 1 Webs. P. R. 83.

fication was void. In *Lewis* v. *Marling*, (*a*) Bayley, J., said, "To support a patent it is necessary that the specification should make a full disclosure to the public. If the patentee suppresses anything, or if he misleads, or if he does not communicate all he knows, his specification is bad; but if he makes a full and fair communication, as far as his knowledge extends, he has done all that is required."

In *Morgan* v. *Seaward*, (*b*) Alderson, B., said, "If a patentee is acquainted with any particular mode by which his invention may be most conveniently carried into effect, he ought to state it in his specification," and referred particularly to the case of *Liardet* v. *Johnson*, (*c*) where the patentee omitted what was very necessary for tempering steel, namely rubbing it with tallow; and Lord Mansfield held the patent to be void on that account.

Where a patent was taken out for "improvements in floating docks," and it appeared that the construction of floating docks was not novel, but the plaintiff alleged that his invention did not consist in the construction of floating docks, but in the application of iron so as to form air-tight and water-tight chambers, it was held that as there was no mention of iron in the specification, the plaintiff had not complied with the conditions of the letters patent by duly describing the nature of his invention, and the manner in which it was to be carried into effect, and that the patent was therefore void. (*d*)

Omission not fatal if it goes only to the degree of benefit.

But the specification will not be bad if the omission is slight, and goes only to the degree of the benefit conferred by the invention; and it will be sufficient if a work-

(*a*) 4 C. & P. 57; 10 B. & C. 26; 1 Webs. P. R. 496.

(*b*) 1 Webs. P. R. 175.

(*c*) Bull (N. P.) 76; 1 Webs. P. R. 53.

(*d*) *Mackelcan* v. *Rennie*, 13 C. B. (N. S.) 59.

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man is able to construct a machine that would be productive of some benefit. (*a*)

Specification bad if unnecessary matters stated.

If anything is stated in the specification as being material which is not so, it will be void, as the consideration of the grant has failed in part. (*b*)

In *Savory* v. *Price*, (*c*) the patent was "for a method of making a neutral salt or powder possessing all the properties of the medicinal spring at Seidlitz under the name of Seidlitz Powders." The specification gave recipes for preparing the ingredients to be used, and directed how they were to be mixed. It was proved that the result obtained by following the specification was new and useful, but it appeared that the ingredients were well known, and were sold in chemists' shops before the date of the patent. It was held that the specification could not be supported. Abbot, C. J., said, "It is the duty of a patentee to specify the plainest and most easy way of producing that for which the patent is granted, and to make the public acquainted with the mode which he himself adopts. By reading this specification we are led to suppose a laborious process necessary to the production of the ingredients, when in fact we might go to any chemist's shop and buy the same things ready made. The public are misled by this specification, which tends to make people believe that an elaborate process is essential to the invention."

(*a*) *Neilson* v. *Harford*, 1 Webs. P. R. 322; *Househill Iron Co.* v. *Neilson*, 1 Webs. P. R. 695; *Macnamara* v. *Hulse*, Car. & M. 471.

(*b*) *Huddart* v. *Grimshaw*, 1 Webs. P. R. 93; *Bloxam* v. *Elsee*, 6 B. & C. 178; *Hill* v. *Thompson*, 8 Taunt. 401; 2 B. Moo. 242; 1 Webs. P. R. 244; *R.* v. *Arkwright*, 1 Webs. P. R. 70, where the specification stated ten different instruments, and it appeared that four only were necessary.

(*c*) Ry. & Moo. 1; 1 Webs. P. R. 83.

So if a patentee can only make the article specified with two or three of the ingredients named, and he has inserted others which will not answer the purpose, the patent will be avoided. Thus, where the specification directed different kinds of salts to be used, and it appeared that one of them only would produce the required effect, the patent was held to be void,(*a*) and where the specification directed the use of "the finest and purest chemical white lead," and it appeared that no such substance was known in the trade by that name, but that white lead only was known, the specification was held to be bad.(*b*)

Cheaper materials.

If the patentee makes the article with cheaper materials than those he has named in the specification, although the latter will answer the purpose equally well, the patent is void, because he does not put the public in possession of his invention, or enable them to derive the same benefit from it which he himself does.(*c*)

Class of substances, some not useful.

If a whole class of substances are stated as being useful and one of them is not, this will mislead and the patent will be void.(*d*)

In *Stevens* v. *Keating*,(*e*) the specification of a patent for "a certain process or method of combining various materials so as to form stuccoes, plasters or cements, and for the manufacture of artificial stones, marbles, and

(*a*) *Turner* v. *Winter*, 1 T. R. 606; 1 Webs. P. R. 80.

(*b*) *Sturtz* v. *De la Rue*, 5 Russ. 322; 1 Webs. P. R. 83 *n*. See also *Derosne* v. *Fairie*, 2 C. M. & R. 476; 1 Gale, 109; 1 Webs. P. R. 163; *Lewis* v. *Marling*, 10 B. & C. 25; 4 C. & P. 67; 1 Webs. P. R. 493.

(*c*) *Turner* v. *Winter*, 1 T. R. 606; 1 Webs. P. R. 80.

(*d*) *Bickford* v. *Skewes*, 1 Q. B. 938; 1 Webs. P. R. 218; *Crossley* v. *Potter*, Macr. 246.

(*e*) 2 Exch. 772; 2 Webs. P. R. 192.

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other like substances used for buildings, decorations, or other similar purposes," described the invention to consist in producing certain hard cements of combinations of the powder of gypsum, of powder of limestone, and of the powder of chalk, with other materials, such combinations being, when produced according to the patentee's invention (subsequently to their being mixed) submitted to the action of heat. The process or method of making a cement from gypsum was described as consisting in uniting powdered gypsum with alkali (such as best American pearlash) dissolved in water, the solution to be neutralized with acid, sulphuric acid being the best for the purpose; keeping the solution in agitation, and adding acid gradually until effervescence ceased. A certain proportion of water was then to be added, varying with the nature of the alkali used, powder was to be added until the mixture was of a consistence suitable to be cast or moulded into bricks or other forms which were to be heated to a red heat in a reverberatory furnace. The method of making cement from limestone and chalk did not materially differ from the above process. After describing the manner in which the cement was to be used, the specification concluded by stating that as other alkalies and acids besides those mentioned would answer the purposes of the invention, though not so well as the acid and alkali specifically mentioned, the patentee claimed as his invention the process of mixing the powdered materials, alkalies and acids as described, and subsequently burning them. It was held that the specification was bad, for either the inventor claimed all acids and alkalies, or all acids and alkalies that would answer the purpose. If the claim were for all acids and alkalies, it was bad, as there were some which would not answer

the purpose. If for those only which would answer the purpose, then it was bad in consequence of not stating those which would answer, and distinguishing them from those which would not.

Hills v. *The London Gas Light Company*, (*a*) is another case to the same effect. A patentee in the specification of a patent dated 1840, after speaking of the use of black oxide of manganese for purifying gas, continued, "The same effect may be produced by the application of the oxide of zinc and the oxide of iron treated precisely in the way above described." It was held that assuming that the patentee meant to claim all oxides of iron for purifying gas, inasmuch as some would not answer, the Court could not say as a measure of law that a patent could not be had by a person who afterwards discovered that precipitated hydrated oxides were those which it was proper to use.

Unnecessary matters may be treated as superfluous.

But a specification will not necessarily be avoided if it contain unnecessary matter, so long as the public are not misled, as the unnecessary matter may be treated as superfluous. (*b*)

In *Lewis* v. *Marling* (*c*) Parke, B., said that "the patent will not be void because the patentee claims to be the inventor of a certain part of the machine not described as essential, and which turns out not to be useful." (*d*)

Materiality of process question for jury.

It is for the jury to say whether or not any particular part of the process is a material part of the invention. (*e*)

Not necessary to claim all

It is not necessary to claim all the substances which will answer the purpose of the invention if the public are

(*a*) 5 H. & N. 312.

(*b*) *Boulton* v. *Bull*, 2 H. Bl. 493.

(*c*) 10 B. & C. 25; 4 C. & P. 57; 1 Webs. P. R. 493.

(*d*) See *ante*, p. 74.

(*e*) *Huddart* v. *Grimshaw*, 1 Webs. P. R. 94; *Beard* v. *Egerton*, 8 C. B. 166.

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useful substances if public not deceived.

not misled. In *Bickford* v. *Skewes* (*a*) the specification of a patent instrument called "the Miners' Safety Fuse," after describing the manner in which the case of the instrument was to be made proceeded as follows: "by means whereof I embrace in the centre 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, 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. The objection that any other material but common gunpowder had ever been used in the fuse was considered to be immaterial, because though 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 terms, which imported that the patentee himself had ever used other materials than gunpowder in the construction of the instrument.

It is not necessary for the patentee to describe the mode of making everything he uses, or to detail known processes, or explain the terms appropriate to the particular art or science or branch of industry to which his invention belongs. (*b*)

Specification need not state exact proportions.

The specification of an invention which consists in the use of known materials in certain proportions is not bad for uncertainty, because the patentee does not limit his claim

(*a*) 1 Q. B. 938; 1 Webs. P. R. 218.

(*b*) *Neilson* v. *Harford*, 1 Webs. P. R. 341; *Derosne* v. *Fairie*, *ib.* 154.

to the precise proportions recommended, but the relative proportions must be ascertained. Thus where the patent was for increasing the hardness and durability of type by using tin and antimony, the best proportions being 75 per cent. of tin and 25 per cent. of antimony; but it was said that these proportions might be varied if lead were used, provided that it did not exceed 50 per cent. of the whole, and the specification was objected to on the ground of uncertainty, the objection was overruled.(*a*) But where the specification leaves it uncertain what proportions are to be used it will be bad.(*b*)

All improvements must be stated.

If the patentee between the time of applying for the patent and the time when the specification must be filed makes any fresh discoveries or any improvements in the method of working the patent, he is bound to introduce them into the specification and communicate his latest knowledge to the public. The object of allowing the patentee six months' protection is that he may be able freely to make experiments and improve his invention without any fear of the consequences of publication and user.(*c*)

Means competent to perform specification must be described.

The specification must describe means competent to perform all comprised in the patent.(*d*)

Where a patent was granted for a machine to sharpen knives and scissors, and the specification directed this to be done by passing their edges backward and forward in

(*a*) *Patent Type Founding Co.* v. *Walter*, 1 Johns. 381. And see *Hill* v. *Thompson*, 8 Taunt. 382; 1 Webs. P. R. 243.

(*b*) *Muntz* v. *Foster*, 2 Webs. P. R. 109; *Betts* v. *Menzies*, 10 H. L. C. 117. See note to *Liardet* v. *Johnson*, 1 Webs. P. R. 54.

(*c*) *Crossley* v. *Beverley*, 9 B. & C. 63; 1 Webs. P. R. 117; *Crane* v. *Price*, *ib.* 404; *Jones* v. *Heaton*, *ib.* 404 *n.*; *Liardet* v. *Johnson*, *ib.* 54 *n.*

(*d*) *Crossley* v. *Beverley*, 1 Webs. P. R. 117.

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an angle to be formed by the insertion of two circular files, and it was also stated that other materials might be used according to the delicacy of the edge; but it was proved that for scissors there ought to be one circular file and a smooth surface, and that two Turkey stones might also succeed; it was 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. (*a*)

Mode must be pointed out.

A claim to perform a certain process which does not point out the mode in the specification is too large and cannot be supported. (*b*)

One mode at least must be stated.

One mode at least which will succeed must be stated. In *Derosne* v. *Fairie*, (*c*) a patent was granted for "certain improvements in extracting sugar or syrup from cane juice, and other substances containing sugar, and in refining sugar and syrup." The specification stated the invention to consist in a means of discolouring syrups of every description by means of charcoal, produced by the distillation of bituminous schistus alone or mixed with animal charcoal, and even of animal charcoal alone. The discoloration was to be produced by means of a filter made of charcoal, and it was stated that "the carbonization of bituminous schistus has nothing particular, it is produced in closed vessels, as is done for producing animal charcoal, only it is convenient before the carbonization to separate from the bituminous schistus the sulphurets of iron which are mixed with it." It appeared that the operation failed if applied to cane juice before it was

(*a*) *Felton* v. *Greaves*, 3 C. & P. 611; *Bainbridge* v. *Wigley*, 1 Carp. P. C. 270.

(*b*) *Booth* v. *Kennard*, 2 H. & N. 95.

(*c*) 2 C. M. & R. 476; 1 Gale, 109; 1 Webs. P. R. 154.

boiled, and nothing was said in the specification as to any process before filtering; but it was said that syrup in a proper state might be obtained by a mixture of sugar and water. It was shown in evidence that the process was applicable with advantage to the syrup after it had undergone a certain amount of heat before granulation took place, though it would fail if granulation had taken place. It was held, therefore, that the expression "extract" might fairly be understood to mean the process to be applied with advantage to the extracting of syrup from cane juice before it arrived at that consistency at which granulation took place.

Specification bad if one only of many modes successful.

If the specification represents that there are many modes of doing a thing when in fact one only will do, the patent will be avoided;(a) so, too, if it is stated that the invention may be carried into effect by either of two modes, and one is impracticable.(b)

Ambiguity vitiates specification

The specification is bad if it is so manifestly ambiguous that its meaning cannot be discovered by any person of ordinary judgment.(c) "It is incumbent on the patentee to give a specification of the invention in the clearest and most unequivocal terms of which the subject is capable. And if it appears that there is any unnecessary ambiguity affectedly introduced into the specification, or anything which tends to mislead the public, in that case the patent is void."(d)

(a) *Lewis* v. *Marling*, 4 C. & P. 57; 10 B. & C. 22; 1 Webs. P. R. 496.

(b) *R.* v. *Cutler*, 3 C. & K. 215; 14 Q. B. 372 *n.*; *Turner* v. *Winter*, 1 T. R. 608; 1 Webs. P. R. 82.

(c) *Galloway* v. *Bleaden*, 1 Webs. P. R. 524.

(d) Per Ashurst, J., in *Turner* v. *Winter*, 1 T. R. 605; 1 Webs. P. R. 80. See *Spencer* v. *Jack*, 11 L. T. (N. S.) 244.

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In *Hastings* v. *Brown*, (*a*) the specification of a patent for "certain improved arrangements for raising ships' anchors and other purposes," claimed as the invention an alleged improvement upon the structure of that part of a ship's windlass round which the chain cables of anchors are wound, and by which they are held fast without slipping. The form which was claimed by the invention was denominated a scalloped shell, and the applicability of a windlass so constructed to every size of chain cable was also claimed. It was admitted that there was no novelty in constructing a windlass so as to hold fast a single chain cable of any given size. The specification, so far as is material, was as follows:—"The scallop 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 scallop at the top and bottom of fig. 2." "And I also claim as my invention the new form of a scalloped shell (as shown in fig. 2), in conjunction with the arrangements herein described." The drawings referred to in the specification appeared to show a construction applicable either to a single cable or to cables of different sizes. It was proved that the specification and drawings would enable a competent workman to make a cable holder which would hold chains of different sizes; but it was held that, as the specification did not state distinctly for what the patent was claimed, and was ambiguous, as it did not point out clearly whether it was an invention of a cable holder to hold a chain of one particular size, or to hold cables of different sizes, it was therefore void.

In *Bloxam* v. *Elsee* (*b*) the patent was for a machine for

(*a*) 1 El. & Bl. 450. (*b*) 6 B. & C. 169; 1 C. & P. 558.

making paper in single sheets without seam or joining, from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length. It appeared that the machine was capable only of producing paper of a definite width, and that in order to vary the width a new machine was required. It was held that the meaning of the patent was that paper varying in width between those extremes should be made by the same machine, and that the patent was therefore void.

In *Ralston* v. *Smith* (*a*) the description "a roller of hard metal or other suitable material" was considered not to be too uncertain on account of the use of the words "or other suitable material," as such words would mean any material equally sufficient for the purpose with hard metal.

And in *Macnamara* v. *Hulse* (*b*) it was held that a patent taken out for blocks for paving with "stone or other suitable material" would 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 contemplation.

Claim in the specification not necessary.

It is usual in the specification, after the patentee has described his invention and the means for carrying it into effect, to insert a short clause, in which the patentee expressly states what he claims as his invention. But a claim is not an essential part of the specification, nor necessary for the protection of the invention. (*c*)

Its object.

The claim is introduced for the security of the patentee that he may not be supposed to claim more than what he can support as an invention; it is not intended to be any

(*a*) 11 H. L. C. 223.

(*b*) Car. & M. 471.

(*c*) *Lister* v. *Leather*, 8 El. & Bl. 1004.

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description of the means by which the invention is to be performed, but is for the purpose of making the description intelligible, not to aid it, but to ascertain the extent of what is claimed as new. (*a*)

Means of effectuating invention considered as claimed.

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. (*b*) Where the specification of a patent for "improvements in apparatus for stitching and sewing," to which drawings were attached, after describing an instrument marked "g," continued, "It is the arranging an instrument 'g' as herein described, which, while it is the means of holding the fabric . . . . is also the means by which the step-by-step motion is given to the fabric, which constitutes the peculiarity of my invention." It was held that this was not a claim of all instruments which were at once the means of holding and moving the fabric; nor on the other hand of the exact machine with all its arrangements contained in the drawings; but a claim to the exclusive right to use "g," or any similar instrument, for the purpose of holding and moving the fabric at the same time. (*c*) Where the patent was for "a method of discharging or giving fire to artillery, and all other fire arms, mines, chambers, cavities, and places in which gunpowder or other combustible matter is or may be put for the purpose of explosion," and the means, by which the invention was to be applied, were pointed out in the specification, the patentee was held to be entitled to the exclusive applica-

(*a*) *Kay* v. *Marshall*, 3 My. & Cr. 373; 2 Webs. P. R. 39.

(*b*) *Tetley* v. *Easton*, 2 C. B. (N. S.) 706.

(*c*) *Thomas* v. *Welch*, L. R. 1 C. P. 192.

tion of the detonating mixture as priming, whatever the construction of the lock by which it was discharged. (*a*) So where the invention consisted in the discovery of the principle that air heated to a high temperature was very beneficial in blast furnaces, and the patentee directed that it should be heated in a vessel immediately before entering the furnace, it was held that the specification was not void, because no particular shape of vessel was claimed. (*b*)

Claim for application of new material to old purposes good.

A claim for the application of a new material to an old purpose is good, and will not affect the validity of the patent. (*c*)

General words which do not profess to be part of the description do not vitiate claim.

If thes pecification, as containing the description, be sufficiently precise, it is of no consequence that expressions are used in the claim, which would be too general if they professed to be part of the description. (*d*) Thus where the specification described the invention and the machinery by which the manufactured article was produced, and said that the article was made by machinery, and that nothing but machinery would avail to make it, a claim to perform the work "by machinery" was held not to be too large. (*e*)

Claim may not be more extensive than specification.

But if the specification says definitely that the invention is to be carried out by a particular process or machine; describing it; which is claimed; the claim will be confined to the operation of the process or machine. In *Barber*

(*a*) *Forsyth* v. *Rivière*, 1 Webs. P. R. 97. See also *Neilson* v. *Thompson*, *ib.* 283; *Cochrane* v. *Braithwaite*, 1 Carp. P. R. 493; *Neilson* v. *Baird*, 6 Dec. of Ct. of Sess., 2nd series, 51.

(*b*) *Neilson* v. *Harford*, 8 M. & W. 806; 1 Webs. P. R. 371.

(*c*) *Neilson* v. *Betts*, L. R. 5 H. L. 1.

(*d*) *Kay* v. *Marshall*, 1 My. & Cr. 373; 2 Webs. P. R. 39.

(*e*) *Arnold* v. *Bradbury*, L. R. 6 Ch. 706.

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v. *Grace*(*a*) it was held that a specification which claimed as the invention a process of finishing hosiery by means of a press heated by steam, and the drawings represented the press as consisting of two boxes; could not also include a process of finishing goods by means of heated rollers.

Where the patentees claimed certain machinery for giving diagonal or vibratory motion to the selvages of cloth, and went on to say, "as it is not practicable to describe every possible mode in detail, we desire it to be understood that any mode even of moving one side or selvage of the cloth whilst the other remains stationary, we shall consider to be an evasive imitation of our invention, if for the purpose of drawing the threads into diagonal positions by mechanical means instead of manual labour;" it was held that the patentees only claimed as their invention those improvements on the old machine that gave the vibratory motion to the fabric while in the course of drying.(*b*)

In *Minter* v. *Wells*(*c*) the patentee claimed as his invention "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," Alderson, B., said: "If it could be shown that any self-adjusting leverage had been before the plaintiff's patent applied to a chair, the patent would be void, because the priority of the specification given by him would claim every species of the application of a self-adjusting leverage to the back and seat of a chair; he would have claimed, not the par-

(*a*) 1 Exch. 339.

(*b*) *M'Alpine* v. *Mangnall*, 3 C. B. 496.

(*c*) 1 Webs. P. R. 130.

ticular way of accomplishing the particular purpose by the particular engine, but he would have claimed too much, because he would have claimed the application of such self-adjusting leverage to the back and seat of a chair."

General claim does not include improvements.

A patentee cannot by making a general claim obtain the benefit of improvements of which he was ignorant at the date of his patent. (*a*)

Parol evidence may be admitted to explain claim.

The specification is not conclusive evidence of that for which the patent was obtained, but parol evidence of the patentee is admissible to prove that the patent was not obtained for some of the things obtained in the specification, but for the new combination of several old matters. (*b*)

Specification of patent for new mode of applying old materials must claim materials and mode of applying them.

Where a patent is for a new mode of applying old materials, the claim must be for the materials and the mode of applying them together, else the patent will be void. A patentee claimed "the metal fixings and the mode of applying the same, described herein as the second part of my invention." The jury found that the metal fittings by themselves were old, but that the mode of applying them was new. Erle, C. J., said:—"If the true construction is, that the metal fittings are claimed separately from the mode of applying the same, the patent is void for want of novelty. Then are the metal fittings claimed separately? We think not. The context expresses that one part of the invention consists of metal fittings, and the mode of applying them described herein. If the patentee meant to claim the metal fittings as one separate part, and the mode of applying them as another part, his words do not express that meaning." (*c*)

(*a*) *Tetley* v. *Easton*, Macr. 77.

(*b*) *Bateman* v. *Gray*, 8 Exch. 906; Macr. 111; *Crossley* v. *Potter*, Macr. 253.

(*c*) *Oxley* v. *Holden*, 8 C. B. (N. S.) 705.

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Discovery of principle and application of principle to be distinguished.

If a principle is claimed while the invention consists only in the application of the principle by new machinery, the specification is bad. Thus where a patentee claimed the principle of introducing fuel at the lower part of the grate in a perpendicular or oblique direction, and the principle was not new, though the application of the principle as described was, the patent was held to be void. (*a*)

Specification of patent for application of old invention to new material or purpose must claim means of effectuating invention.

Where the patent is for the application of a known instrument to a new material or purpose, it must appear that the means essential for carrying the application into effect are new, and the specification must claim them. Thus where the patent was for the invention of a nipping lever for causing the rotation of wheels, shafts or cylinders, and in the specification the patentee claimed as his invention "the nipping lever, with its tusk sliding box (before described), applied to a rimmed wheel, or to a rimmed flange, for the purpose of causing the same to rotate or move together with any shaft, cylinder, or other suitable machinery which may be attached thereto," and it appeared that the nipping lever was not new, but that its application by means of the sliding boxes was, it was held that it must also be shown that the use of the sliding boxes was necessary or essential to the use of the invention. (*b*)

Specification of patent for addition or improvement must be for addition or improvement only.

If the invention is for addition or improvement, the patent must be taken out not for the whole machine with the addition, but for the addition or improvement only (*c*) as the public have a right to purchase the improvement

(*a*) *R.* v. *Cutler*, 1 Stark. 354. See also *Gamble* v. *Kurtz*, 3 C. B. 425.

(*b*) *Pow* v. *Taunton*, 9 Jur. 1056.

(*c*) *Hornblower* v. *Boulton*, 8 T. R. 103; *Bovill* v. *Moore*, 2 Marsh. 214.

by itself without being incumbered by other things, (*a*) and if the specification claims discovery when the invention is merely for an addition or improvement, it is bad. In *Hill* v. *Thompson*, (*b*) the specification contained among other things the following claim, "and that my said improvements do further consist in the use and application of lime to iron, subsequently to the operations of the blast furnace, whereby that quality in iron from which the iron is called 'cold short' howsoever and from whatever substance such iron be obtained, is sufficiently prevented or remedied and by which such iron is rendered more tough when cold. And I do further declare that I have discovered that the addition of lime or limestone or other substances consisting chiefly of lime, and free or nearly free from any ingredient known to be hurtful to the quality of iron, will sufficiently prevent or remedy that quality in iron from which the iron is called 'cold short,' and will render such iron more tough when cold; and I do for this purpose—if the iron, howsoever, and from whatever substance the same may have been obtained, be expected to prove 'cold short'—add a portion of lime or limestone or of the other said substances, of which the quantity must be regulated by the quality of the iron to be operated upon, and by the quality of the iron wished to be produced; and further, that the said lime or limestone or other aforesaid substances may be added to the iron at any time subsequently to the reduction thereof in the blast furnace, and prior to the iron becoming clotted or coming into nature, whether the same be added to the iron while it is in the refining or in the

(*a*) *Boulton* v. *Bull*, 2 H. Bl. 489.

(*b*) 8 Taunt. 424; 2 B. Moo. 424; 1 Webs. P. R. 237.

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puddling furnace, or in both of them, previous to the said iron being put into either of the said furnaces." It appeared that "cold short" had been prevented by the use of lime before; and Dallas, J., said: "The purpose is to render bar iron more tough by preventing that brittleness which is called 'cold short,' and which renders bar iron less valuable; the means of prevention stated are application of lime. In what way, then, is lime mentioned in the patent? The first part of the specification, in terms, alleges certain improvements in the smelting and working of iron, during the operations of the blast furnace; and then, introducing the mention of lime, it states that the application of it to iron subsequently to the operation of the blast furnace will prevent the quality called 'cold short.' So far, therefore, the application of lime is in the terms claimed as an improvement—and nothing is said of any previous use—of which the use proposed is averred to be an improvement; it is, therefore, in substance a claim of entire and original discovery. The recital should have stated, supposing a previous use to be proved in the case, that, whereas lime has been in part, but improperly, made use of, etc., and then a different mode of application and use should have been suggested as the improvement claimed. But the whole of the patent must be taken together and this objection will appear to be stronger as we proceed. And here, again, looking through the patent in a subsequent part of the specification, the word 'discovery' first occurs and I will state the terms made use of in this respect: And I do further declare that I have discovered that the addition of lime will prevent that quality in iron from which the iron is called 'cold short' and will render such iron more tough when cold; and that for this purpose

I do add a portion of lime or limestone, to be regulated by the quantity of iron to be operated upon, and by the quality of iron to be produced, to be added at any time subsequently to the reduction in the blast furnace, and this from whatever substance the iron may be produced, if expected to prove 'cold short.' Now this appears to be nothing short of a claim of discovery in the most extensive sense of the effect of lime applied to iron to prevent brittleness, not qualified and restrained by what follows as to the preferable mode of applying it under various circumstances, and therefore rendering the patent void, if lime had been made use of for this purpose before; subject to the qualification only of applying it subsequently to the operations in the blast furnace." (*a*)

In *Bramah* v. *Hardcastle*, (*b*) Lord Kenyon, C. J., said: "Unlearned men look at the specification and suppose everything to be new that is there. If the whole be not new it is hanging terrors over them."

Where the plaintiff's invention which was admitted to be ingenious and useful consisted in the insertion of a pipe into an old stove for conveying the air into it; but the specification claimed the whole apparatus, and did not confine the invention to the application or addition of the pipe to an old stove, the patent was held to be void. (*c*)

And where the specification claimed the exclusive liberty of making lace, composed of silk and cotton-thread mixed not of any particular mode of mixing them; and it was proved that silk and cotton-thread had often previously been mixed on the same frame for lace, in different modes, the patent was held to be void, as the

(*a*) See also *Saunders* v. *Aston*, 3 B. & Ad. 886.

(*b*) 1 Webs. P. R. 76.

(*c*) *Williams* v. *Brodie*, 1 Webs. P. R. 75.

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specification did not claim the particular mode of mixing the lace. (*a*)

A claim for a patent for improvements in the mode of doing something by a known process is sufficient to entitle the patentee 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 not known at the time of the claim so long as it remains identical with regard to improvements claimed and their application. (*b*)

Additions and improvements must be distinguished.

Where a patent is for an entirely new invention, it is not necessary that the specification should describe and distinguish the different parts. But where the invention consists of additions or improvements, all the parts which are new must be described, and distinguished from those which are old, (*c*) and must be distinctly claimed as new. (*d*) It is not sufficient to give a general description of the construction of the machine without making such distinction. (*e*) In *Saunders* v. *Aston* (*f*) the specification of a patent for making buttons stated the improvement to consist in the substitution of a flexible material for metal shanks by the help of a metal collet. The use of the collet was new, but it was not claimed, and the specification was held to be bad. Littledale, J., saying: "Neither the button nor the flexible shank was new, and they did not

(*a*) *R.* v. *Elsee*, Bull (N. P.) 76; 1 Webs. P. R. 76.

(*b*) *Electric Telegraph Co.* v. *Brett*, 10 C. B. 838.

(*c*) *Nickels* v. *Ross*, 8 C. B. 723; *Dangerfield* v. *Jones*, 13 L. T. (N. S.) 144.

(*d*) *Morris* v. *Bransom*, Bull (N. P.) 76; 1 Webs. P. R. 51; *Ormson* v. *Clark*, 14 C. B. (N. S.) 490.

(*e*) *Macfarlane* v. *Price*, 1 Stark. 199; 1 Webs. P. R. 74; *R.* v. *Cutler*, 1 Stark. 354; 1 Webs. P. R. 76; *R.* v. *Arkwright*, 1 Webs. P. R. 67.

(*f*) 3 B. & Ad. 881; 1 Webs. P. R. 75 *n.*

by merely being put together constitute such an invention as could support the patent. It is contended that the operation of the collet under the present patent is new, but that is not stated in the specification as the object of his invention, and is in fact only one mode of carrying it into effect." Lord Westbury in *Foxwell* v. *Bostock*, (*a*) laid down the rule as follows: "In a patent for an improved arrangement or new combination of machinery the specification must describe the improvement and define the novelty otherwise, and in a more specific form than by the general description of the entire machine, it must assign the *differentia* of the new combination. This obligation flows directly from the condition of the patent that the specification shall particularly describe and ascertain the invention." (*b*)

Improvement on existing patent valid, but must be distinguished.

A patent which includes the subject matter of an existing patent is valid, but the specification must properly distinguish the new from the old. (*c*) In *Harmar* v. *Playne*, (*d*) it was held that a specification describing a whole machine the subject of two patents, but not referring to the former specification or pointing out the particular improvements the subject of the latter patent, except in so far as the second specification recited the former, was sufficient. (*e*) Where a patentee has taken out a fresh patent for improvements on his original invention, it is sufficient, if on reading his second specification with the first, an artisan would have no substantial difficulty in ascertaining what was claimed. (*f*)

(*a*) 4 De G. J. & S. 313; 10 L. T. (N. S.) 144.

(*b*) And see *Parkes* v. *Stevens*, L. R. 8 Eq. 358; *Murray* v. *Clayton*, L. R. 7 Ch. 585.

(*c*) *Crane* v. *Price*, 4 M. & Gr. 580; 5 Scott (N. R.) 338; 1 Webs. P. R. 413; *Bovill* v. *Moore*, 2 Marsh. 211.

(*d*) 11 East, 101.

(*e*) And see *Foxwell* v. *Bostock*, 10 L. T. (N. S.) 144.

(*f*) *Parkes* v. *Stevens*, L. R. 8 Eq. 358.

If there is a patent for a machine and also for an improvement in the use of it, if it cannot be supported for the machine, although it might be for the improvement merely, it is bad on account of its attempting to cover too much. (*a*) But if taking the whole specification together the court can see that the improvements only are claimed it will be sufficient. (*b*) Thus where the specification of a patent for "improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein" described a process of plaiting fabrics by means of a reciprocating knife in combination with a sewing machine and claimed (1) the general construction, arrangement and combination of machinery for producing plaited frills or trimming in a sewing machine; (2) the application and use of a reciprocating knife for crimping fabrics in a sewing machine; and (3) the peculiar manufacture of crimped or plaited frills or trimming "as hereinbefore described" and illustrated by a drawing; it was contended that the manufacture described included the use of the sewing machine, or that it was a manufacture by means not only of the reciprocating knife, but of a sewing machine, without which the completed article could not be produced in the manner described. It was held, however, looking at the whole specification and claim, that this was only pointed out as the best mode of completing the manufacture, as the sewing machine was treated as a known invention already in use, and it was separate and distinct from the mode of crimping or plaiting to which the plaintiff laid claim. (*c*)

(*a*) *Hill* v. *Thompson*, 3 Mer. 626; 1 Webs. P. R. 237.

(*b*) *McAlpine* v. *Mangnall*, 3 C. B. 515.

(*c*) *Wright* v. *Hitchcock*, L. R. 5 Exch. 37.

Where the invention is partly original and partly communicated from a foreign country, the part communicated from the foreign country must be defined in the specification.(a)

Part of invention foreign must be distinguished.

If a patent is taken out for an invention consisting of distinct parts, and any one of them is not new, the whole is void. In *Kay* v. *Marshall*,(b) the patent was for "new and improved machinery for preparing and spinning flax, hemp and other fibrous substances by power." The specification claimed as the patentee's invention in respect of new machinery for preparing flax, etc., the macerating vessels marked B in the plan or drawing annexed to the specification, and the trough of water marked C; and in respect of improved machinery for spinning, the wooden or other trough marked D for holding the rovings when taken from the macerating vessels, and placing the retaining rollers *e e* and the drawing rollers *c c* nearer to each other than they had ever before been placed, say within two-and-a-half inches of each other for the aforesaid purpose. Before the date of the patent, flax, hemp and other fibrous substances were spun with machines with slides, by which the reach was varied according to the length of the staple or fibre of the article to be spun, and the reach varied in different kinds of spinning between $\frac{7}{8}$ of an inch and 14 inches, but it was not known that flax could be spun by means of maceration as having a short fibre at a reach of $2\frac{1}{2}$ inches, or about those limits. On a case sent to the Court of Common Pleas by Lord Langdale it was held; and affirmed on appeal to the House of Lords,(c)

Specification bad where one of distinct parts not new.

(a) *Renard* v. *Levenstein*, 10 L. T. (N. S.) 177.

(b) 5 Bing. (N. C.) 492; 7 Scott, 548; 2 Webs. P. R. 71.

(c) 8 C. & F. 245; 2 Webs. P. R. 79.

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that there were two distinct processes, and that though the first relating to macerating the flax was new and useful, and the proper subject of a patent, yet that the second being merely an application of a piece of machinery already well known and in use, to the new macerated state of the flax, the specification claiming both processes as invention could not be supported. (*a*)

One of several inventions not improvement patent void.

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 void. (*b*)

In *Brunton* v. *Hawkes* (*c*) the patent was for improvements in the construction of ship's anchors, windlasses, and chain cables or moorings. That part of the patent which related to the manufacture of anchors was proved not to be new, and the whole patent was therefore held to be void, although there was great merit in the other inventions.

Patent for combination does not claim each part as new; but if specification claims whole combination as new, when not so, it is bad.

A patent for a combination, is not a claim that each part of the combination is new; (*d*) but if the specification of a patent for a combination of things partly new and partly old, claims the whole combination as new, the patent will be void; the nature of the invention must be described in such a manner that a person of ordinary intelligence can, on reading it, see what is claimed as new, and what is old.

In the case of *Holmes* v. *The London and North*

(*a*) And see *Templeton* v. *Macfarlane*, 1 H. L. C. 595; *Gibson* v. *Brand*, 4 Scott (N. R.) 844; 4 M. & G. 179; 1 Webs. P. R. 634.

(*b*) *Morgan* v. *Seaward*, 2 M. & W. 544; 1 Webs. P. R 197; *Cornish* v. *Keene*, 1 Webs. P. R. 505; *Losh* v. *Hague*, ib. 204; *R.* v. *Arkwright*, ib. 72.

(*c*) 4 B. & Ald. 542.

(*d*) *Lister* v. *Leather*, 8 El. & Bl. 1017.

Western Railway Co., (a) the specification of "an improved turning table for railway purposes" described the invention "to consist in supporting the revolving plate and upper platform of the turning table, as also its stays, braces, arms and supports, on the top of a fixed post, well braced and resting on, or planted in, the ground, the top of which post forms a pivot for the table to turn on, while the supporting arms, radiating from a frame work (the weight of which is also suspended on the post), moving round the bottom part of the post with friction rollers, and fastened to the outer edges of the plate, stay the plate at all sides, and keep it steady to receive the superincumbent weight of carriages or whatsoever is to be turned upon it." The manner in which the invention was to be performed was then described with reference to drawings, and the specification concluded as follows:—"Now, whereas I claim as my invention the improved turning-table hereinbefore described, and such my invention being, to the best of my knowledge and belief, entirely new, and never before used, I do declare this to be my specification of the same; and that I do verily believe this my specification doth comply in all respects fully, and without reserve or disguise, with the proviso in the hereinbefore in part recited letters patent contained; wherefore I hereby claim to maintain exclusive right and privilege to my said invention." The jury found that the only novelty in the plaintiff's invention consisted in the suspension rods; as it was proved that, previous to the date of the specification, the rest of the machinery had been described in a patent for an invention for the same purpose, granted to another person,

(a) 12 C. B. 831.

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and it was held that as the plaintiff's specification claimed the whole combination as new, the patent was void.(*a*)

Or if it claims part as new which is not so.

If the specification claims any portion of the combination as new which is not so, the patent is void.(*b*) Where letters patent were granted for "improvements in agricultural machines," and the specification described the invention to consist in "the constructing and placing of holding fingers, cutting blades, and gathering reels respectively, in a manner described, and the embodiment of these parts so constructed and placed, all or any of them, in machines for reaping purposes," it was held that the patent was for the combination, and that the use of a knife alone similar to that described in the patented machine was not an infringement.(*c*)

In *Thomas* v. *Foxwell*,(*d*) the patentee of a sewing machine claimed "the application of a shuttle in combination with a needle, as shown in the drawing, for forming and securing loops of thread or other substances for the purpose of producing stitches, either to unite or ornament fabrics, whatsoever may be the means employed for working such shuttle and needle when employed together." The shuttle and needle had been worked together previously; and it was held that as the claim was not confined to the single application of a shuttle in combination with a needle, as shown in the drawings, but extended generally to the application of a shuttle in combination with a needle, for the purposes of the invention, the patent was void.

(*a*) See also *Bovill* v. *Moore*, 2 Marsh, 211; *Carpenter* v. *Smith*, 1 Webs. P. R. 532.

(*b*) *Lister* v. *Leather*, 8 El. & Bl. 1017.

(*c*) *McCormick* v. *Gray*, 7 H. & N. 25; *Parkes* v. *Stevens*, L. R. 8 Eq. 367.

(*d*) 5 Jur. (N. S.) 37; affd. 6 Jur. (N. S.) 271.

A patentee will not however be presumed to have claimed anything so generally in use that he must have known that to claim it would be to vitiate his patent.(*a*)

Patentee not presumed to claim anything well known.

If a patent includes matters some of which are new and some are old, it may be read by limiting the claim to the particular combination in the particular manner described in the specification.(*b*)

Claim in specification may be limited.

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 actually claimed.(*c*)

Combination need not be expressly claimed.

A patent will be good, although each principle or process in it is well known to all persons engaged in the trade to which the patent relates, provided that the mode of combination is new and produces a beneficial effect, and also that the specification claims, not the old processes, or any one of them, but only the new combination.(*d*)

Combination of old matters.

The rules governing the construction of specifications are the ordinary rules for the interpretation of written instruments, having regard especially to the rule that the specification is void if it does not particularly ascertain and describe the nature of the invention and the manner in which it is to be performed.(*e*)

Rules of construction.

The title must be read in connection with the specification, and the whole instrument must be taken together for the purpose of interpretation.(*f*)

Title and specification read together.

(*a*) *Haworth* v. *Hardcastle*, 1 Webs. P. R. 484.

(*b*) *Daw* v. *Eley*, L. R. 3 Eq. 496; *Seed* v. *Higgins*, 8 H. L. C. 261, where there was an express disclaimer of previous inventions; *Foxwell* v. *Bostock*, 4 De G. J. & S. 298; 10 L. T. (N. S.) 144.

(*c*) *Lister* v. *Leather*, 8 El. & Bl. 1004.

(*d*) *Cannington* v. *Nuttall*, L. R. 5 H. L. 205.

(*e*) *Simpson* v. *Holliday*, 13 W. R. 578, on app. L. R. 1 H. L. 320.

(*f*) *Beard* v. *Egerton*, 8 C. B.

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Specification construed favourably to inventor.

Formerly specifications were construed more strictly against the inventor than they are now, the reason being that a patent was looked upon as a monopoly prejudicial to the public interest. In *Hullett* v. *Hague*,(a) Lord Tenterden, C. J., said, "I cannot forbear saying that I think a great deal too much critical acumen has been applied to the construction of patents, as if the object was to defeat and not to sustain them."

Not with object of setting aside patent.

The rule now followed is, that specifications are to be read in a spirit of fairness and candour, not astutely with the defect of setting aside the patent,(b) but on the principles of good faith.(c)

Nothing to be intended for or against patent.

In *Stevens* v. *Keating*,(d) Sir F. Pollock, C.B., said: "I take the rule to be that you are not to intend anything in favour of a specification or patent, and certainly not to intend anything against it."

Intention of patentee to be looked to.

In *Palmer* v. *Wagstaff*,(e) the same learned judge said, "A patent should be construed in the sense in which the patentee intended, and if any expressions are ambiguous, the Court will endeavour to give effect to the intention, and will expound the patent favourably to the patentee. But the Court will not violate the obvious meaning of the language, unless it is quite clear that the patentee intended something different from that which the expressions indicate."

168; *Newton* v. *Vaucher*, 6 Exch. 834; *Crossley* v. *Beverley*, 3 C. & P. 514; 1 Webs. P. R. 117; *Household Iron Co.* v. *Neilson*, 1 Webs. P. R. 679; *Neilson* v. *Harford*, 8 M. & W. 323; 1 Webs. P. R. 312; *Russell* v. *Cowley*, 1 Webs. P. R. 470.

(a) 2 B. & Ad. 377.

(b) *Bickford* v. *Skewes*, 1 Q. B. 951; 1 Webs. P. R. 219; *Stead* v. *Anderson*, 2 Webs. P. R. 153; *Sellers* v. *Dickenson*, 5 Exch. 326.

(c) *Neilson* v. *Harford*, 1 Webs. P. R. 341; *Russell* v *Cowley*, 1 Webs. P. R. 470.

(d) 2 Webs. P. R. 187.

(e) 9 Exch. 501.

"There can be no rule of law," said Sir N. C. Tindal, C.J., "which requires the Court to make any forced construction of the specification, so as to extend the claim of the patentee to a wider range than the facts would warrant; on the contrary, such construction ought to be made as will, consistently with the fair import of the language used, make the claim of invention co-extensive with the new discovery of the grantee of the patent. (*a*)

Must be fair discovery.

In *Turner* v. *Winter*,(*b*) Buller, J., said: "Many cases upon patents have arisen within our memory, most of which have been decided against the patentees, upon the ground of their not having made a full and fair discovery of their inventions. Whenever it appears that the patentee has made a fair disclosure, I have always had a strong bias in his favour, because, in that case, he is entitled to the protection which the law gives him;" and in *Cartwright* v. *Arnott*,(*c*) Lord Eldon said that patents were to be considered as bargains between the inventors and the public, to be judged of on the principle of keeping good faith, by making a fair disclosure of the invention, and to be construed as other bargains.

Objections must be clearly made out, and verbal objections discouraged.

Any objection must be clearly made out.(*d*) After a patent has stood inquiry and the test of time, the Court do not encourage verbal objections to the specification.(*e*) "The patentee should not be tripped up by captious objections, which do not go to the merits of the specification."(*f*)

(*a*) *Haworth* v. *Hardcastle*, 1 Webs. P. R. 485.

(*b*) 1 T. R. 606; 1 Webs. P. R. 81.

(*c*) Easter Term, 1800, cited 11 East. 107.

(*d*) *Bickford* v. *Skewes*, 1 Q. B. 951; 1 Webs. P. R. 219.

(*e*) *Neilson* v. *Betts*, L. R. 5 H. L. 1; *Muntz* v. *Foster*, 2 Webs. P. R. 95.

(*f*) Per Alderson, B., in *Mor-*

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Evident mistake or misuse of words not vitiate specification.

An evident mistake will not vitiate a specification, as where air was described as "an imponderable substance;"(*a*) nor will the misuse of words vitiate a specification. Thus, where the patentee, a foreigner, used the word "baked" for boiling, and the word "discoloration" for discharge from colour, it was held that the specification was not to be avoided on that account, Lord Abinger, C.B., saying, "One would not be disposed, from any obscure word in the specification, which might be interpreted in favour of the patentee, to deprive him of his patent;"(*b*) and the specification will be sufficient, if, although foreign words are used in it, skilful mechanics can make the machine with the assistance of the drawings annexed. (*c*)

Nor use of scientific terms.

The use of scientific terms, unintelligible to ordinary workmen, will not vitiate a specification. "Where," said Lord Abinger, "a specification uses scientific terms, which are not understood, except by a person acquainted with the nature of the business, the specification is not bad because an ordinary man does not understand it, provided a scientific man does; but where the specification does not make use of technical terms, where it uses common language, and where it states that by which a common man may be misled, though a scientific man would not, when it does not profess to use scientific terms, and an ordinary man reading the specification is misled by it, it would not be good."(*d*)

gan v. *Seaward*, 1 Webs. P. R. 174.

(*a*) *Neilson* v. *Harford*, 1 Webs. P. R. 340.

(*b*) *Derosne* v. *Fairie*, 2 C. M. & R. 476; 1 Gale, 109; 1 Webs. P. R. 157; *Minter* v. *Mower*, 1 Webs. P. R. 141.

(*c*) *Bloxam* v. *Elsee*, 1 C. & P. 563.

(*d*) *Neilson* v. *Harford*, 1 Webs. P. R. 341.

The terms of a specification are to be construed according to the state of knowledge at the time it was drawn up.(*a*)

Specification be construed according to state of knowledge when drawn.

The language of the specification is the language of the patentee himself;(*b*) and the words used in it are to be construed according to their ordinary and proper meaning,(*c*) and a fair and reasonable interpretation given to them, unless there is something in the context, which may be explained by evidence, to show that there ought to be a different construction.(*d*) In *Elliott* v. *Turner*,(*e*) the specification stated that part of the invention consisted in "the application of such fabrics only wherein the ground or face of the ground thereof is produced by a warp of soft *or* organizine silk, such as is used in weaving satin and the classes of fabrics produced therefrom, which are well known, viz., satin ground, with ornamental centre figure, &c.;" and the patentee claimed as his invention the application of such figured, woven fabrics to the covering buttons with flexible shanks, made by pressure in dies, as have the ground, or the face of the ground, woven with soft *or* organizine silk for the warp, when such fabrics have ornamental designs or figures for the centre of buttons. Parke, B., in delivering the judgment of the Court, said: "The word '*or*,' in its ordinary and proper sense, is a disjunctive particle; and the meaning of the term 'soft or organizine' is properly either one or the other; and so it ought to be construed, unless there be something in the context to give it a different meaning."

Language of specification is language of inventor.

Words construed according to ordinary meaning.

(*a*) *Crossley* v. *Beverley*, 3 C. & P. 514; 1 Webs. P. R. 107.

(*b*) *R.* v. *Wheeler*, 2 B. & Ald. 349.

(*c*) *Household Iron Co.* v. *Neilson*, 1 Webs. P. R. 679.

(*d*) *Beard* v. *Egerton*, 8 C. B. 165.

(*e*) 2 C. B. 446.

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In *Simpson* v. *Holliday*(*a*) the invention described by the patentee consisted in the mixing of aniline with dry arsenic acid for the purpose of producing a rich purple colour; and the patentee, after describing that process, added: "*Or* I accelerate the operation by heating it to or near to its boiling point." It was proved that mixing aniline with dry arsenic acid, without the application of heat, would not produce any effectual result. It was contended that the word "or" ought to be read "and;" but the House of Lords, affirming the decision of Lord Chancellor Westbury, held there were two operations described in the specification, and that there was nothing in the terms of the description, nor upon the face of the specification itself, which could justify the Court in changing the form of the expression.

Construction of specification is for the Court, after terms of art explained by jury.

The construction of the specification is the duty of the Court after the meaning of any terms of art or of commerce has been ascertained by the jury.(*b*) In *Neilson* v. *Harford*,(*c*) Parke, B., said: "The construction of the specification, as of all written instruments, belongs to the Court alone, whose duty it is to construe all such instruments as soon as the true meaning of the words in which they are couched, and the surrounding circumstances, if any, have been ascertained by the jury; and it is the duty of the jury to take the construction from the Court either absolutely, if there be no words to be construed as words of art or phrases used in commerce, and no surrounding circumstances to be ascertained; or conditionally when the words or circumstances are necessarily

(*a*) 13 W. R. 577, on app., L. R. 1 H. L. 315.

(*b*) *Hill* v. *Thompson*, 3 Mer. 626; 1 Webs. P. R. 237; *Derosne* v. *Fairie*, 1 Webs. P. R. 156.

(*c*) 8 M. & W. 823; 1 Webs. P. R. 370.

referred to them;" and in *Hills* v. *Evans*(*a*) Lord Westbury laid down the rule as follows: "It is undoubtedly true as a proposition of law that the construction of a specification, as of all other written instruments, belongs to the court; but the specification of an invention contains most generally, if not always, some technical terms, some phrases of art, some processes, and requires generally the aid of the light derived from what are called surrounding circumstances. It is, therefore, an admitted rule of law that the explanation of the words or technical terms of art, the phrases used in commerce, and the proof and results of the processes which are described (and in a chemical patent the ascertainment of chemical equivalents) —that all these are matters of fact upon which evidence may be given, contradictory testimony may be adduced, and upon which, undoubtedly, it is the province and the right of a jury to decide. But when those portions of a specification are abstracted and made the subject of evidence, and therefore brought within the province of the jury, the direction to be given to the jury with regard to the construction of the rest of the patent which is conceived in ordinary language must be a direction given only conditionally; that is to say, a direction as to the meaning of the patent upon the hypothesis or the basis of the jury arriving at a certain conclusion with regard to the meaning of those terms, the signification of those phrases, the truth of those processes, and the result of the technical procedure described in the specification."(*b*)

(*a*) 4 De G. F. & J. 288; 8 Jur. (N. S.) 527.

(*b*) See too *Bovill* v. *Pimm*, 11 Exch. 719; *Simpson* v. *Holliday*, L. R. 1 H. L. 320; *Betts* v. *Menzies*, 10 H. L. C. 153: *Spencer* v. *Jack*, 11 L. T. (N. S.) 242; *Thomas* v. *Foxwell*, 6 Jur. (N. S.) 271.

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Terms of trade to be used in ordinary commercial sense.

Where in a specification terms of trade are used, they must be construed according to their ordinary commercial meaning. Thus where a specification described the articles used as "the best selected copper" and "that quality of zinc known in England as foreign zinc," it was held, that what the patentee was endeavouring to describe for the information of the public was, that the copper and zinc should be of the best kind which at that time were known to exist and were represented by that description of each respective article, and that the patent was not void because "best selected copper" was well known before the patent was granted, and that "foreign zinc" was no longer made;(a) and in *Stevens* v. *Keating*,(b) Sir F. Pollock said that a claim for the use of "acids" would not vitiate the patent if some very unimportant acids known only in the laboratory would not answer the purpose, but that it was otherwise when an acid well known in trade was useless.

But where one of the ingredients in a composition was a white substance imported from Germany, and which could only be purchased at one or two colour shops in London, and the only description given of it in the specification was "the purest and finest chemical white lead," and there was no article known by that name 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, it was held that the specification was insufficient.(c)

Identical terms of art may have different meanings at different dates.

In construing similar specifications of different dates, it must be remembered that it is possible that the terms of art used, although identical, may have different mean-

(a) *Muntz* v. *Foster*, 2 Webs. P. R. 104.

(b) 2 Webs. P. R. 187.

(c) *Sturtz* v. *De la Rue*, 5 Russ. 322; 1 Webs. P. R. 33, n.

ings owing to the advance of science, and it is necessary, therefore, to ascertain whether or not this is so by evidence. In *Betts* v. *Menzies*,(*a*) where the patent was objected to on the ground of prior publication in a specification, the following question was put to the judges: "Can the court pronounce B's patent to be void, simply on the comparison of the two specifications without evidence to prove identity of invention?" The answer of the judges was in the negative, and Lord Westbury in moving the judgment of the House, said that the answer showed that "even if there is identity of language in two specifications, and (remembering that those specifications describe external objects) even if the language is *verbatim* the same, yet if there are terms of art found in the one specification, and also terms of art found in the other specification, it is impossible to predicate of the two with certainty that they describe the same *identical* external object, unless you ascertain that the terms of art used in the one have precisely the same signification and denote the same external objects at the date of the one specification as they do at the date of the other."

Comparison of specifications is question for jury.

After the meanings of the terms of art have been ascertained by the jury and the Court has put the legal construction upon the specifications, there still remains the comparison of the specifications, which is the duty of the jury. In *Hills* v. *Evans*,(*b*) Lord Westbury said: "As it is always a matter of evidence what external thing is indicated and denoted by any description, when the jury have been informed of the meaning of the description contained in each specification, the work of

(*a*) 10 H. L. C. 117.

(*b*) 4 De G. F. & J. 288; 8 Jur. (N. S.) 527.

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comparing the two and ascertaining whether the words (as interpreted by the Court) contained in specification A, do or do not denote the same external matter as the words (as interpreted and explained by the Court) contained in specification B, is a matter of fact, and is, I conceive, a matter within the province of the jury and not within the function of the Court," (*a*) and his lordship also said that the observation of Lord Cranworth in *Bush* v. *Fox*, (*b*) "that it is the duty of the Court to compare the two specifications together" is an *obiter dictum*, and cannot be taken as a declaration of the law.

Unless there is no question to go to the jury.

But where the want of novelty appears distinctly on the face of the specification, and the question of novelty depends solely on its construction, and no evidence of fact is required, and there is no question to go to the jury, then it is for the Court to determine the identity of the inventions. In *Seed* v. *Higgins*, (*c*) Lord Campbell said: "Where novelty or infringement depends merely on the construction of the specification, it is a pure question of law for the judge; but where the consideration arises, how far one machine imitates or resembles another in that which is the alleged invention, it generally becomes a mixed question of law and fact, which must be left to the jury."

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

(*a*) See too *Muntz* v. *Foster*, 2 Webs. P. R. 105; *Walton* v. *Potter*, 4 Scott (N. R.) 91; 3 M. & Gr. 411; 1 Webs. P. R. 585, 597.

(*b*) 5 H. L. C. 707.

(*c*) 8 H. L. C. 261.

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, and 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." It was proved that a patent had previously been granted to A for improvements in artificial light, the patentee using the residuary matter obtained in the manufacture of fatty substances, and also the residuum after the oil had been pressed from the seeds, such as oil cakes, and also beech nuts, or mast, cocoa nuts, and all others abounding in oil. The judge directed the jury to find for the defendant, and it was held that the direction was right, as the two patents were substantially the same and it was 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.(*a*)

Sufficiency of the specification is a question for the jury.

Whether or not the description of the invention contained in the specification is intelligible is a matter of fact for the jury to decide,(*b*) and their finding is conclusive.(*c*)

In *Walton* v. *Potter*,(*d*) Sir N. C. Tindal, C. J., said, referring to the objection that the specification did not particularly describe the nature of the invention: "Generally speaking, the rule which is laid down upon

(*a*) *Booth* v. *Kennard*, 2 H. & N. 84. See also *Thomas* v. *Foxwell*, 5 Jur. (N. S.) 37; 6 Jur. (N. S.) 271; *Allen* v. *Rawson*, 1 C. B. 571; *Tetley* v. *Easton*, 2 C. B. (N. S.) 706 *Hills* v. *London Gas Light Co.*, 5 H. & N. 312.

(*b*) *Hill* v. *Thompson*, 3 Mer. 626; 1 Webs. P. R. 235; *Wellington* v. *Dale*, 7 Exch. 888; *Morton* v. *Middleton*, 1 Dec. of Ct. of Sess. 3rd series, 718.

(*c*) *Bickford* v. *Skewes*, 1 Q. B. 938; 1 Webs. P. R. 220.

(*d*) 1 Webs. P. R. 595.

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occasions where the sufficiency of the specification is called in question is this—that as these specifications are drawn by men who are more conversant with the particular article than juries, who are selected indiscriminately from the public, and certainly much more than judges whose knowledge is confined to one particular department, credit is given to witnesses if they are conversant with the subject-matter of the invention, and they tell you and you believe it that they see enough on the face of the specification to enable them to make the article without difficulty . . . . it always is a proper answer when a patent is set up to say that you have not so described it that it may not be understood."

Exaggerated cases must be discarded.

All exaggerated cases on both sides must be discarded, and if the jury think in substance that the information really communicated would be enough in all ordinary cases or in such cases as are likely to occur, the specification will be sufficient.(*a*)

Sufficiency only to be ascertained by experiment.

Whether or not a specification contains a sufficient description can only be ascertained by an experiment, and in making the experiment, knowledge and means may be employed which have been acquired since the date of the patent.(*b*)

Specification may be construed with the aid of plans or drawings.

The specification may be read with the aid of plans or drawings which will be considered part of it, so as to limit the claim.(*c*) In *Bloxam* v. *Elsee*,(*d*) Abbott, C. J., said

(*a*) *Morgan* v. *Seaward*, 1 Webs. P. R. 180; *Neilson* v. *Baird*, 6 Dec. of Ct. of Sess. 2nd series, 51.

(*b*) *Betts* v. *Neilson*, L. R. 3 Ch. 429.

(*c*) *R.* v. *Arkwright*, 1 Webs. P. R. 71; *Morgan* v. *Seaward*, *ib.* 178; *Ex parte Fox*, 1 V. & B. 67; *Morton* v. *Middleton*, 1 Dec. of Ct. of Sess. 3rd series, 718; *Daw* v. *Eley*, 14 W. R. 126; 11 Jur. (N. S.) 923.

(*d*) 1 C. & P. 564. And see *Barber* v. *Grace*, 1 Exch. 339.

"An inventor of a machine is not tied down to make such a specification as by words only would enable a skilful mechanic to make the machine, but he is to be allowed to call in aid the drawings which he annexes to the specification, and if by a comparison of the words and drawings the one will explain the other sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient."

But they are not necessary.

But plans or drawings are not necessary. In *Boulton* v. *Bull*,(a) Rooke, J., said: "I am not aware of any rule of law which requires a model or drawing to be set forth, or which makes void an intelligible specification of a mechanical improvement merely because no drawing or model is annexed."

Unless patentee cannot distinguish new from old by words only.

If, however, in a patent for improvements the patentee is unable to distinguish the new from the old parts of the machine by words only, he must do so by reference to plans or drawings.(b)

Plans or drawings need not be skilfully executed.

It is not necessary that the plans or drawings should be very skilfully executed or highly finished, it is enough if they would give an ordinary workman sufficient information to enable him to make the machine.(c)

Drawing alone may be sufficient specification.

A drawing alone may apparently be a sufficient specification. In *Brunton* v. *Hawkes*,(d) Abbott, C. J., said that if a drawing or figure enabled workmen of ordinary skill to construct the improvement it was as good as any written description, and in *Foxwell* v. *Bostock*,(e) Lord Westbury said that a patent for a new machine might be good if

(a) 2 H. Bl. 480.

(b) *Macfarlane* v. *Price*, 1 Stark. 201; 1 Webs. P. R. 74, n.

(c) *Bovill* v. *Moore*, 2 Marsh. 211; Dav. P. C. 368.

(d) Carp. P. R. 410.

(e) 4 De G. J. & S. 303; 10 L. T. (N. S.) 144.

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the specification contained nothing but clear drawings and a description of them.

If experiments necessary to produce beneficial effect, specification bad.

The specification must be so clearly expressed as to enable the machine to be constructed or the process to be performed, simply from reading the description without the necessity of trying experiments.

In *R.* v. *Wheeler*, (*a*) Abbott, C. J., said that a specification which casts upon the public the expense and labour of experiment and trial is undoubtedly bad. There the patent was for "a new and improved method of drying and preparing malt." The specification stated that the invention consisted in exposing malt previously heated to a very high degree of heat; but it did not describe any machine for this purpose, nor the state in which the malt was to be taken for undergoing the process, whether moist or dry, nor what was the proper amount of heat to be applied, nor how it was to be known when the process was completed and the patent was held to be void.

In *Turner* v. *Winter*, (*b*) the specification directed heat to be applied until the result aimed at was obtained. It appeared that fusion was necessary, but it was not mentioned, and Buller, J., said that the specification was deficient for that reason.

Where the patent was for "an improved method of drying and finishing paper," and the specification described the invention to consist in conducting paper by means of cloth, or cloths, against a heated cylinder, and contained these words: "which cloth may be made of any suitable material, but I prefer it to be made of linen warp or woollen weft," the patentee knowing, from repeated trials, that no other substance would do, Lord

(*a*) 2 B. & Ald. 349. (*b*) 1 T. R. 607; 1 Webs. P. R. 81.

Tenterden, C. J., said: "The patent was obtained for the discovery of a proper conducting medium. The plaintiff found, after repeated trials, that nothing would serve the purpose except the cloth described in his specification, yet he says the cloth may be made of any suitable material, and merely that he prefers the particular kind there mentioned. Other persons, misled by the terms of this specification, may be induced to make experiments which the patentee knows must fail, and the public therefore has not the full and entire benefit of the invention." (*a*)

In *R.* v. *Arkwright* (*b*) a witness stated that he should, from reading the specification, have made one part of the machine differently from the same part in the patentee's machine, but that from the knowledge he had acquired by seeing the machine he could now make it properly; and Buller, J., said that it does not prove a specification to be sufficient, that a man, from the knowledge he has got from trials and from seeing people employed about the machine, is able to make it. In *Morgan* v. *Seaward*, (*c*) Alderson, B., said: "The specification of a patent must not merely suggest something that will set the mind of an ingenious man at work, but it must actually and plainly set forth what the invention is, and how it is to be carried into effect so as to save a party the trouble of making experiments and trials," and his lordship said that the criterion was whether at the time when the spe-

(*a*) *Crompton* v. *Ibbetson*, Dan. & L. 33; 1 Webs. P. R. 83. See too *Macnamara* v. *Hulse*, 2 Webs. P. R. 128, n.; *Stevens* v. *Keating*, 2 Exch. 778; 2 Webs. P. R. 194; *Hills* v. *Liverpool Gas Light Co.*, 9 Jur. (N. S.) 140; *Muntz* v. *Foster*, 2 Webs. P. R. 109.

(*b*) 1 Webs. P. R. 67.

(*c*) 1 Webs. P. R. 179

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cification was introduced to the world, a witness who had been employed to make models for the patentee for the purpose of the trial, would have been able to construct the machine with his ordinary knowledge and skill, without the peculiar knowledge he had since obtained from his employment. But it appears that the specification is not defective if the experiments are only necessary to produce the greatest beneficial effect. (*a*)

Greatest effect.

Specification must be enough to enable skilled workmen to make the machine or perform process.

The specification must be so clear as to enable skilled workmen to make the machine or perform the process. "It must," said Lord Ellenborough, "convey to the public a corresponding advantage with that of the individual whose sole right is protected, so that any person who is skilled in the subject may accomplish the end." (*b*)

Technical words not necessary.

Technical words are not necessary so long as the specification shows the patent to be for a manufacture, and enables a workman to make the machine. (*c*)

Amount of skill necessary.

The amount of skill demanded from a workman employed to construct the machine depends entirely upon the subject-matter of the invention. "The specification," said Lord Loughborough, "is addressed to persons in the profession having skill in the subject, not to men of ignorance; and if it is understood by those whose business leads them to be conversant in such subjects, it is intelligible." (*d*)

Competent skill.

In *Morgan* v. *Seaward*, (*e*) Alderson, B., said: "A speci-

(*a*) *Neilson* v. *Harford*, 1 Webs. P. R. 320.

(*b*) *Huddart* v. *Grimshaw*, 1 Webs. P. R. 86; *Gibson* v. *Brand*, 1 Webs. P. R. 629; *Betts* v. *Menzies*, 8 El. & Bl. 937.

(*c*) *Hornblower* v. *Boulton*, 8 T. R. 98; *Boulton* v. *Bull*, 2 H. Bl. 475; *Minter* v. *Mower*, 1 Webs. P. R. 141.

(*d*) *Arkwright* v. *Nightingale*, 1 Webs. P. R. 176.

(*e*) 1 Webs. P. R. 176.

fication is addressed to all the world, and therefore all the world, at least those possessed of competent skill, ought to be able to construct the machine by following that specification;" and in *Neilson* v. *Harford* (*a*), Parke, B., said: "You are not to ask yourself the question whether persons of great skill—a first-rate engineer or a second-rate engineer—whether they would do it, because, generally, those are men of great science and philosophical knowledge, and they would upon a mere hint in the specification probably invent a machine which would answer the purpose extremely well; but that is not the description of persons to whom this specification may be supposed to be addressed. It is supposed to be addressed to a practical workman who brings the ordinary degree of knowledge and the ordinary degree of capacity to the subject." (*b*)

Ordinary or tolerable skill.

The specification has also been said to be addressed to persons of ordinary (*c*) or tolerable skill. (*d*)

Specification bad if addition by workmen necessary.

The specification must be such that workmen may be able to make the machine by following the directions given, without any new inventions or additions of their own. Where the patent was for spinning machinery, and the specification said nothing as to the comparative velocity of the rollers, Buller, J., said: "The man that comes to give an account of the invention says, 'I had

(*a*) 1 Webs. P. R. 314.

(*b*) And see also *Household Iron Co.* v. *Neilson*, 1 Webs. P. R. 692; *Bickford* v. *Skewes*, 1 Q. B. 938; 1 Webs. P. R. 218; *Elliott* v. *Aston*, 1 Webs. P. R. 224; *Galloway* v. *Bleaden*, *ib.* 524; *Walton* v. *Bateman*, *ib.* 621; *Beard* v. *Egerton*, 8 C. B. 212.

(*c*) *Sturtz* v. *De la Rue*, 5 Russ. 327; *Foxwell* v. *Bostock*, 10 L. T. (N. S.) 147.

(*d*) *Manton* v. *Manton*, Dav. P. C. 349.

calculated it, and the difference of the velocity was to be as five to one; this is the way I made my rollers.' Now the defendant has not said a word of that in his specification. In that he has kept back the knowledge he had as to the size of the rollers, and velocity, and it is left to people to find it out, as chance may direct." (*a*)

In *Morgan* v. *Seward*, (*b*) Alderson, B., said that people in trade ought to be told the manner in which the invention ought to be carried out, "not by themselves becoming inventors of a method of carrying it into effect, but by following the specification without making a new invention, or making any addition to the specification. If the invention can only be carried into effect by persons setting themselves a problem to solve, then they who solve the problem become the inventors of the method of solving it, and he who leaves persons to carry out his invention by means of that application of their understanding, does not teach them in his specification that which, in order to entitle him to maintain his patent, he should teach them, the way of doing the thing, but sets them a problem which, being suggested to persons of skill, they may be able to solve. That is not the way in which a specification ought to be framed. It ought to be framed so as not to call on a person to have recourse to more than those means of ordinary knowledge (not invention) which a workman of competent skill in his art or trade may be presumed to have. You may call on him to exercise all the actual existing knowledge common to his trade, but you cannot call upon him to tax his ingenuity or invention."

(*a*) *R.* v. *Arkwright*, 1 Webs. P. R. 66. See also *R.* v. *Fussell*, 1 Carp. P. R. 449.

(*b*) 1 Webs. P. R. 174.

If the specification contains a false statement in any material circumstance of such a nature that if literally acted upon by a competent workman it would mislead him, and he would be unable to make the machine, it will be void, although there is evidence to prove that it is not likely that competent workmen would be misled; for this would be to support the invention by the workman's skill and not on its own merits. (*a*)

Untrue statement vitiates specification even if it would not deceive workman.

But when in the specification of a patent for improvements no directions are given respecting a portion of the machine which any competent workman would know to be necessary, the specification will not be void. In *Crossley* v. *Beverley* (*b*) the patent was for an "improved gas apparatus," the specification omitted to state that a condenser was necessary, but as it was shown that any workman who was able to construct a gas apparatus would know that a condenser was necessary, the specification was held to be good.

But omission not fatal if it does not mislead.

A deviation from the precise dimensions shown by the specification and model, so as to make the different parts work together, is within the knowledge of any workman. Thus where the defendants put in a model made according to the specification which would not work though a very slight alteration would have made it work, Alderson, B., said: "Now a workman of ordinary skill when told to put two things together, so that they should move, would of course by the ordinary knowledge and skill he possesses make them of sufficient size to move. There he would have to bring to his assistance his knowledge that

(*a*) *R.* v. *Arkwright*, 1 Webs. P. R. 67; *Neilson* v. *Harford*, 8 M. & W. 824; 1 Webs. P. R. 371; *Simpson* v. *Holliday*, L. R. 1 H. L. 315.

(*b*) 9 B. & C. 63; 3 C. & P. 515; 1 Webs. P. R. 110, n.

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the size of the part is material to the working of the machine. That is within the knowledge of every workman. He says: 'I see this will not work, because it is too small,' and he makes it a little larger and finds it will work; what is required is that the specification should be such as to enable a workman of ordinary skill to make the machine; with respect to that therefore I do not apprehend you will find much difficulty." (*a*)

In *Neilson* v. *Harford*, (*b*) the specification of a patent for "the improved application of air to produce heat in fires, forges and furnaces where bellows or other blowing apparatus are necessary," did not state that it was necessary to use water twires in order to protect the pipe conveying the hot air into the blast furnace. It was proved that the blast could be used to a beneficial extent without the water twires, and that any person acquainted with smelting would apply them if necessary, and the patent was held to be good. In *Russell* v. *Cowley*, (*c*) the patent was for improvements in manufacturing tubes for gas and other purposes without the use of a maundril, which had always been used previously in the manufacture of iron tubes. The specification did not give any directions as to omitting the use of the maundril, but it was held that on reading the specification any person of ordinary intelligence would see that the invention was for the manufacture of tubes without a maundril.

Where the specification is of a long and complicated process consisting of several operations following one another in regular order and the description as a whole is sufficient, it will not be void because of some obscurity

(*a*) *Morgan* v. *Seaward*, 1 Webs. P. R. 176.

(*b*) 1 Webs. P. R. 318. See also *Household Iron Co.* v. *Neilson*, *ib.* 687.

(*c*) 1 Webs. P. R. 457.

in a part of the description which would not mislead a competent workman. In *Beard* v. *Egerton*, (*a*) the patent was for "a new and improved mode of obtaining the spontaneous reproduction of all the images received on the focus of the camera obscura." The specification stated that the process was divided into five operations. "The first consists in polishing and cleaning the silver surface of the plate, in order to properly prepare or qualify it for receiving the sensitive layer or coating upon which the action of the light traces the design. The second operation is, the applying that sensitive layer or coating to the silver surface. The third in submitting in the camera obscura the prepared surface or plate to the action of light so that it may receive the images. The fourth in bringing out or making appear the image, picture or representation, which is not visible when the plate is first taken out of the camera obscura. The fifth and last operation is that of removing the sensitive layer or coating which would continue to be affected, and undergo different changes from the action of light, this would necessarily tend to destroy the design or tracing so obtained in the camera obscura." A description was then given of the first operation, preparing the silver surface of the plate; the concluding part of which directed that nitric acid dissolved in water was to be applied three different times, care being taken to sprinkle the plate each time with powder, and rub it dry and very lightly with clean cotton. No objection was made to this part of the specification, but some further information was given respecting the preparation of the plate as follows: "When the plate is not intended for immediate use or operation, the acid may be used only twice upon

(*a*) 8 C. B. 214.

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its surface after being exposed to heat. The first part of the operation, that is, the preparation as far as the second application of the acid, may be done at any time; this will allow of a number of plates being kept prepared up to the last slight operation. 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: finally, the plate must be cleaned with cotton from all pounce dust which may be on the surface or its edges." Upon this part of the specification it was contended that the direction to apply acid just before the moment of using the plates in the camera (which was the third operation) was a direction to use it after the second operation, viz. the coating the plate with iodine; and that using acid at that period would entirely spoil the whole process. It was held however that the specification was free from any such mistake or obscurity as would mislead a person of fair intelligence. "It must be remembered," said Sir T. Wilde, C. J., "that the passage in question is part of the directions given for performing the first operation, viz. preparing the plate to receive the iodine. It is to be observed when the plate is not intended to be used immediately, and where it has previously been partially, but not entirely, prepared for the iodine, this last application of acid is still to precede the second operation. The whole passage may be considered as in a parenthesis; and the expression, "just before the moment of using the plate in the camera," is put in opposition to the time of partially preparing the plate; after which it is supposed to have been laid by for future use. That this is the real meaning of the passage, is further mani-

fested by what follows in a subsequent part of the printed specification. 'After this second operation (viz. the application of iodine) is completed, the plate is to be passed to the third operation, or that of the camera obscura. Wherever it is possible, the one operation should immediately follow the other.' It is plain therefore that the patentee did not intend any separate operation to intervene between the application of iodine and the introduction of the plate into the camera obscura. The last application of acid must therefore have been intended to precede the second operation.

"This we think is the fair construction of the language of the specification. And although there may at first sight be some appearance of obscurity in it, we think that it is cleared away by a construction of the whole; and that it is sufficient to be understood by an operator of fair intelligence."

The omission must be patent.

But the omission must appear distinctly on the face of the specification and drawings. In *Simpson* v. *Holliday* (*a*) Lord Westbury said, "When it is stated that an error in a specification, which any workman of ordinary skill and experience would perceive and correct, will not vitiate a patent, it must be understood of errors which appear on the face of the specification or the drawings it refers to, or which would be at once discovered and corrected in following out the instructions given for any process or manufacture, and the reason is, because such errors cannot possibly mislead. But the proposition is not a correct statement of the law if applied to errors which are discoverable only by experiment and further inquiry; neither is the proposition true of an erroneous

(*a*) 13 W. R. 577.

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statement in a specification amounting to a false suggestion, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject. For example, if a specification describes several processes or several combinations of machinery and affirms that such will produce a certain result, which is the object of the patent, and some one of the processes or combinations is wholly ineffectual and useless, the patent will be bad, although the mistake committed by the patentee may be such as would at once be perceived by an ordinary workman."

Evidence.

The Court may, in the exercise of its discretion, refuse to consider questions arising on the construction of the specification until the evidence on the whole of the case has been heard.(*a*)

The evidence of persons who say that they could not make the machine from the specification, and that they think it is not probable that the person who drew the specification meant to describe the invention is nothing more than a corollary from their own opinion, because it is not intelligible to them.(*b*)

(*a*) *Young* v. *Fernie*, 4 Giff. 577.

(*b*) *Arkwright* v. *Nightingale*, 1 Webs. P. R. 61.

CHAPTER V.

OF DISCLAIMERS.

BEFORE the year 1835 a patentee whose specification was void by reason of unnecessary matter having been introduced into it, was unable to obtain any relief, although his invention might in other respects be meritorious. By 5 & 6 Will. IV. c. 83, s. 1, it was provided that "any person who as grantee, assignee, or otherwise hath obtained, or who shall hereafter obtain, letters patent for the sole making, exercising, vending or using of any invention, may, if he think fit, enter with the clerk of the patents of England, Scotland, or Ireland, respectively as the case may be, having first obtained the leave of His Majesty's Attorney-General or Solicitor-General in case of an English patent, or of the Lord Advocate or Solicitor-General of Scotland in the case of a Scotch patent, or of His Majesty's Attorney-General or Solicitor-General for Ireland in the case of an Irish patent, certified by his fiat and signature, a disclaimer of any part of either the title of the invention or of the specification, stating the reason for such disclaimer, or may with such leave as aforesaid enter a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall 'extend' the exclusive right granted by the said letters patent."

5 & 6 Will. IV. c. 83. Any person having obtained letters patent for any invention may enter a disclaimer of any part of his specification or a memorandum of alteration therein.

Reasons must be stated.

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The reason for a disclaimer is no part of the disclaimer itself. (*a*)

Meaning of word "extend."

The word "extend" in the above section cannot be used in its ordinary sense of "adding to" or "enlarging," because the exact meaning of the term "disclaimer," to which it is applied, is the renunciation of some previous claim actually made or apparently made or supposed to be made. It must, therefore, be intended to comprehend a case where the disclaimer would give the patentee a right which he could not have enjoyed under the specification as originally framed. (*b*)

Object of the act that unnecessary matter may be struck out.

The object of the act is that where a specification is void for claiming too much, the patent is not necessarily to be avoided, but may be amended by disclaiming the useless part; that is to say, if there is a general claim and a particular claim, and by a disclaimer the general claim is struck out, the particular claim may be good. "The spirit of the Act," said Maule, J., "seems to be this, that where there are objections that go only to a small and insignificant part of a patent, which if sustained would defeat it altogether, the patentee may relieve himself from the difficulty by a disclaimer." (*c*) In *Ralston* v. *Smith* (*d*) the law was very fully laid down by Lord Westbury, who said, "The object of the Act authorizing disclaimers was plainly this, that when you have in your specification a sufficient and good description of a useful invention, but that description is imperilled or hazarded by something being annexed to it which is capable of

(*a*) *Cannington* v. *Nuttall*, L. R. 5 H. L. 227.

(*b*) Per Lord Chelmsford in *Ralston* v. *Smith*, 11 H. & C. 254. See also *Foxwell* v. *Bostock*, 4 De G. J. & S. 306; 10 L. T. (N. S.) 144.

R. v. *Mill*, 10 C. B. 395.

(*d*) 11 H. L. C. 243.

being severed, leaving the original description in its integrity, good and sufficient without the necessity of addition, then you might, by the operation of a disclaimer, lop off the vicious matter and leave the original invention as described in the specification untainted and unimpaired by that vicious excess. But it was never intended that you should convert a bad specification, in the sense of its containing no description of any useful invention at all, into a good specification by adding words that would convert a barren and unprofitable generality into a specific and definite and practical description. It is quite clear that if that could be done you would have an opportunity of introducing into a bad patent which contained no useful invention whatever, some discovery that might be developed by further experiment and which was altogether unknown at the time of the original specification and not at all included in the description contained in it.

But bad specification cannot be made good by adding words.

But a further observation occurs upon this, that not only was it never intended by the statute that a patentee should take advantage of it for the purpose of converting a bad description into a good description in this sense, or that when the original description was wholly bad and contained no new invention it should be converted into a description containing a good invention; but the statute never contemplated that a patentee should have the power under the form of a disclaimer of making material additions to the original specification, so as by the aid of the corrected form of words and the additions so made to introduce into the specification an accurate and perfect description of an invention, which you seek for in vain in the original specification."

In this case the patent was for "improvements in em-

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bossing and finishing woven fabrics, and in the machinery employed therein," and in the specification the patentee said: "I employ a roller of metal, wood, or other suitable material, and groove, flute, engrave, mill, or otherwise indent upon it any desired design." If the design were engraved longitudinally the material would be destroyed. The patentee afterwards entered a disclaimer by which he disclaimed the latter portion of the words of the title, and the use of any pattern rollers except those having circular grooves around their surfaces. It was held that the disclaimer was bad, as the specification was originally drawn up in general terms, and the disclaimer sought to extend the right by describing the alleged invention so as to enable the patentee to assert a right under the patent which he could not have maintained upon the original specification alone.

In *Seed* v. *Higgins*(*a*) the patentee claimed by his specification "the application of the law or principle of centrifugal force to the flyers employed" in certain machinery for roving cotton, and described how the force was to be applied. He afterwards disclaimed "all application of the law or principle of centrifugal force as being part of my said invention, or as being comprised in my claim of invention contained in the said specification, except only the application of centrifugal force by means of a weight acting upon a pressure so as to cause it to press against a bobbin, as described in the specification." Lord Cranworth said: "I think we must understand the patentee to have said that he claimed as his invention the application of centrifugal force to the flyers, as described. But then he did not confine himself to that mode; he

(*a*) 8 H. L. C. 550.

claimed, further, the application of the principle of centrifugal force to flyers used in machinery for preparing and roving cotton, in whatever way it might be applied. The effect of the disclaimer was to strike out of the specification this latter general claim, leaving only the claim for the particular mode of application specially described."

In *R.* v. *Mill*(*a*) the title of the patent was for "improvements in instruments used in writing and marking, and in the construction of inkstands." The specification described eleven heads of invention, some of which were void for want of novelty and utility. The patentee disclaimed "all those parts of my said invention which are respectively described and claimed in the said specification as being the fifth, the sixth, the seventh, and the eighth parts of the said invention." These claims related to pens and instruments used for marking with a stamp. The remaining claims were for improvements in pen-holders and pencil-cases, and in the construction of inkstands, and it was held that as the specification as amended by the disclaimer described improvements in instruments used in writing and marking, viz., pens and pencils, and improvements in the construction of inkstands, the title was satisfied by the specification so amended.

All claiming clauses may be struck out.

All the claiming clauses may be struck out of the specification by a disclaimer, if there remain in the body of the specification words sufficiently distinguishing what the invention is which the patentee claims.(*b*)

Effect of disclaimer.

The effect of a disclaimer is merely to strike out from the specification those parts of the invention which are

(*a*) 10 C. B. 379. (*b*) *Thomas* v. *Welch*, L. R. 1 C. P. 192.

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disclaimed; it cannot be read as explanatory of that which remains. (*a*) An alteration verbal merely, and not substantive, will not make a patent void. (*b*) It is not necessary to disclaim matters which manifestly form no part of the invention. (*c*) The effect of the statute is to render the disclaimer, when made, part of the patent and specification; and the patentee, from the moment of the disclaimer, becomes patentee of the undisclaimed part only. (*d*)

Disclaimer when filed to be deemed part of specification.

The disclaimer, or memorandum of alteration, being filed with the specification, is to be deemed and taken to be part of such letters patent or such specification in all courts whatever. (*e*) Formerly disclaimers were required to be enrolled, but it is now provided that disclaimers and memoranda of alteration shall be filed in the office appointed for filing specifications in Chancery, with the specification to which they relate, instead of being entered or filed and enrolled, as provided in the principal Act, and in the Act 12 & 13 Vict. c. 109. (*f*)

The disclaimer operates as part of the letters patent and specification from the date of the grant. (*g*) There is no express enactment in the statute that the disclaimer, if it transgresses the statutory limit by extending the exclusive right, shall be void to all intents and purposes; and unless it be so it must remain enrolled with and al-

(*a*) *Tetley* v. *Easton*, 2 C. B. (N. S.) 706.

(*b*) *Thomas* v. *Welch*, L. R. 1 C. P. 192.

(*c*) *Lister* v. *Leather*, 8 E. & B. 1004; *Morton* v. *Middleton*, 1 Dec. of Ct. of Sess. 3rd series, 718.

(*d*) *Clark* v. *Kenrick*, 12 M. & W. 219.

(*e*) 5 & 6 Will. IV. c. 83, s. 1.

(*f*) 15 & 16 Vict. c. 83, s. 39.

(*g*) *R.* v. *Mill*, 10 C. B. 379; *Stocker* v. *Warner*, 1 C. B. 148.

ways accompany the letters patent and specification. It might be proper to hold that the disclaimer is inoperative for the excess only when that excess is clearly distinguishable. (*a*)

Filing of copy sufficient.

The filing of a copy of the disclaimer is a compliance with the provisions of the Act. (*b*)

7 & 8 Vict. c. 69, s. 5.

The Act of the 5th & 6th Will. IV. c. 83 only gave the patentee the right to disclaim, and as it was considered doubtful whether the assignee of a patent could enter a disclaimer, it was by the 7th & 8th Vict. c. 69, s. 5, enacted,—"that in case the original patentee or patentees hath or have departed with his or their whole or any part of his or their interest, by assignment to any other person or persons, it shall be lawful for such patentee, together with such assignee or assignees, if part only hath been assigned, and for the assignee or assignees if the whole hath been assigned, to enter a disclaimer and memorandum of alteration under the powers of the principal Act; and such disclaimer and memorandum of such alteration, having been so entered and filed as in the said recited Act mentioned, shall be valid and effectual in favour of any person or persons in whom the rights under the said letters patent may then be or thereafter become legally vested; and no objection shall be made in any proceeding whatsoever on the ground that the party making such disclaimer or memorandum of such alteration had not sufficient authority in that behalf."

Disclaimer and memorandum of alteration may be entered although the original patentee may have assigned his patent right.

Under the latter part of this section it was held that a disclaimer will be valid, although the patentee at the

(*a*) Per Lord Westbury in *Foxwell* v. *Bostock*, 4 De G. J. & S. 307; 10 L. T. (N. S.) 144.

(*b*) *Wallington* v. *Dale*, 7 Exch. 888.

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time he entered it had assigned all his interest in the patent.(*a*)

Filing to be conclusive as to the right of the party.

By the Patent Law Amendment Act (15 & 16 Vict. c. 83, s. 39) it is provided "that such filing of any disclaimer or memorandum of alteration in pursuance of the leave of the law officers as in the principal Act mentioned, certified as therein mentioned, shall, except in cases of fraud, be conclusive as to the right of the party to enter such disclaimer or memorandum of alteration under the said Act; and no objection shall be allowed to be made in any proceeding upon or touching such letters patent, specification, disclaimer, or memorandum of alteration, on the ground that the party entering such disclaimer or memorandum of alteration had not sufficient authority in that behalf."

Disclaimer not to affect actions pending.

The Act of the 5th & 6th Will. IV. c. 83, s. 1, provided that "no disclaimer or memorandum of alteration shall be receivable in evidence in any action or suit (save and except in any proceedings by *scire facias*) pending at the time when such disclaimer or alteration was enrolled, but in every such action or suit the original title and specification alone shall be given in evidence, and deemed and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted."

Act not retrospective where infringement.

Under this section it was decided that where a patent is originally void, but is amended by a disclaimer, the Act has not a retrospective operation, so as to make a party liable for an infringement committed prior to the time of entering the disclaimer, even though the parts

(*a*) *Wallington* v. *Dale*, 7 Exch. 888.

infringed have not been affected by the disclaimer;(*a*) and by the Patent Law Amendment Act (15 & 16 Vict. c. 83, s. 39) it is provided that "no action shall be brought upon any letters patent in which or on the specification of which any disclaimer or memorandum of alteration shall have been filed in respect of any infringement committed prior to the filing of such disclaimer or memorandum of alteration, unless the law officer shall certify in his fiat that any such action may be brought, notwithstanding the entry or filing of such disclaimer or memorandum of alteration."

Action may not be brought without leave of law officer.

The law officer may before granting his fiat require the applicant to advertise his disclaimer or memorandum of alteration in such manner as he may think fit, and if he requires such advertisement, must certify in his fiat that the same has been duly made. (*b*)

Law officer may require disclaimer or memorandum of alteration to be advertised.

Any person may enter a *caveat* against such disclaimer or memorandum of alteration, which gives him a right to have notice of the application being heard by the law officer. (*c*)

Caveats against disclaimer may be entered.

All applications for leave to enter a disclaimer or memorandum of alteration are to be made, and all *caveats* relating thereto are to be lodged, at the office of the commissioners, and are to be referred to the law officer. (*d*)

Applications for disclaimers and caveats to be at the office.

All the provisions of the Acts of the 5th and 6th Will. IV. and 7th and 8th Vict. c. 69, respectively relating to disclaimers and memoranda of alterations in letters patent,

Provisions of 5 & 6 Will. IV. c. 83, and of 7 & 8 Vict. c. 69, as to disclaimer and memorandum of alteration to apply to patents under the Patent Law Amendment Act.

(*a*) *Perry* v. *Skinner*, 2 M. & W. 471; *R.* v. *Mill*, 10 C. B. 379.

(*b*) 5 & 6 Will. IV. c. 83, s. 1. See also App. Rules of Practice before Law Officer.

(*c*) *Ib.*

(*d*) 15 & 16 Vict. c. 83, s. 39. See also App. Rules of Practice before Law Officer.

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are applicable and apply to any letters patent granted and to any specification filed under the provisions of the Patent Law Amendment Act.(*a*)

Stamp duties.

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

(*a*) 15 & 16 Vict. c. 83, s. 39. (*b*) 16 Vict. c. 5.

CHAPTER VI.

OF THE METHOD OF OBTAINING LETTERS PATENT.

THE law relating to the grant of letters patent is now regulated by the "Patent Law Amendment Act, 1852,"(*a*) and the acts of the 16th Vict. c. 5, 16 & 17 Vict. c. 115, and 22 Vict. c. 13. The first five sections of the Patent Law Amendment Act relate to the Commissioners of Patents, their seal, their power of making rules, and to their office and officers. (See post, chap. vii.)

Petition for grant of letters patent the first step.

The first step for an applicant for letters patent to take is to petition the Crown for a grant. The petition states that the petitioner is in possession of an invention (naming it); that he believes that it will be of great public utility; that he is the first and true inventor; and that it is not in use by any other person or persons to the best of his knowledge and belief. The application must be for one invention only.(*b*) The petition is accompanied by a declaration in support Forms of petition and declaration will be found in the schedule to the Act.

Lithographed forms of petition and declaration may be obtained from law stationers.

Declaration where patent communicated from abroad.

In any application for a patent which is stated to be a

(*a*) 15 & 16 Vict. c. 83.

(*b*) See App. Third Set of Rules, cl. 1.

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communication from abroad, the declaration ought to state the name and address of the party from whom it has been received in the following manner:—

No. 1. When declaration is made in the United Kingdom,—"That it has been communicated to me from abroad by (here insert name and address in full)."

No. 2. In other cases,—"That it is a communication from (A. B.), a person resident at (here insert the address in full)." (*a*)

Petition and declaration to be accompanied by a provisional *specification.*

The petition and declaration are then left at the office of the commissioners. There is also left at the same time a statement in writing, called a provisional specification, signed by or on behalf of the applicant, describing the nature of the invention. The day of the delivery of these documents is endorsed on them and recorded, and a certificate given to the applicant or his agent. (*b*)

Size of documents.

The petition for the grant of letters patent and declaration and the provisional specification must be written upon sheets of paper of twelve inches in length by eight inches and a-half in breadth, leaving a margin of one inch and a half on each side of the page, so that they may be bound in the books to be kept at the office. The drawings accompanying the provisional specification must be made upon a sheet or sheets of parchment, paper, or cloth, each of the size of twelve inches in length by eight inches and a-half in breadth, or of the size of twelve inches in breadth by seventeen inches in length, leaving a margin of one inch on every side of each sheet. (*c*)

(*a*) Rule of 23rd Feb. 1859.
(*b*) 15 & 16 Vict. c. 83, s. 6.
(*c*) See First Set of Rules, cls. 1, 2.

All provisional specifications must be written on one side only of the sheet.(*a*)

Amendment of provisional specification.

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

Provisional specification must be distinct.

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

Reference to law officer.

The application and provisional specification are then referred to one of the law officers of the crown.(*d*) He may call to his aid such scientific or other person as he may think fit, who is to be paid such sum by the applicant as the law officer may direct. If the law officer is satisfied that the provisional specification describes the nature of the invention he will allow it and give a certificate of his allowance, which is filed in the office, and the invention is then protected for the term of six months from the consequences of use and publication.(*e*)

Provisional specification must be for one invention only.

The provisional specification must as a rule be for one invention only.(*f*)

Title must be distinct.

The title of the patent must point out distinctly and specifically the nature and objects of the invention.(*g*) "Every patent must stand on the ground of improvement or discovery. If of improvement, it must stand on the ground of improvement invented; if of discovery, it

(*a*) Rule of 23rd Feb. 1859.
(*b*) Second Set of Rules, cl. 9.
(*c*) *Ib.* cl. 10.
(*d*) 15 & 16 Vict. c. 83, s. 7.
(*e*) *Ib.* s. 8.
(*f*) Third Set of Rules, cl. 1.
(*g*) Third Set of Rules, cl. 2; *Household Iron Co.* v. *Neilson*, 1 Webs. P. R. 673.

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must stand on the ground of the discovery of something altogether now; and the patent must distinguish and adopt itself accordingly. If the patent be taken out for discovery when the alleged discovery is merely an addition or improvement, it is scarcely necessary to observe that it will be altogether void." (*a*)

The title must give some idea, and so far as it goes a true idea, of the alleged invention. Where the title described the invention to be "for certain improvements in copper and other plate printing," and it appeared that copper plate printing consisted of a great variety of processes; it was held that an improvement in the preparation of the paper which rendered the lines on the plate engraving more clear and distinct might be considered as an improvement in copper plate printing, and that the title was not too vague. (*b*)

In *Nickels* v. *Haslam*, (*c*) letters patent were obtained for "improvements in the manufacture of plaited fabrics." The specification described only a single improvement in the mode of manufacture. It was held that there was not such an inconsistency between the title of the invention and the description as to invalidate the patent.

In *Wright* v. *Hitchcock* (*d*) the title of the patent described it as being for the invention of "improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein." The specification described a process of plaiting fabrics by means of a reciprocating knife having a straight or serrated edge and provided with suitable notches on its edge for the passage of the

(*a*) Per Lord Eldon in *Hill* v. *Thompson*, 3 Mer. 626.

(*b*) *Sturtz* v. *De la Rue*, 5 Russ. 324.

(*c*) 8 Scott (N. R.) 97. See also *Penn* v. *Bibby*, L. R. 2 Ch. 127.

(*d*) L. R. 5 Exch. 37.

needle or needles of a sewing machine with which it was worked in combination. The claims were—1. The general construction, arrangement and combination of machinery, apparatus or means for producing crimped or plaited frills or trimmings in a sewing machine. 2. The application and use of a reciprocating knife for crimping fabrics in a sewing machine. 3. The peculiar manufacture of crimped or plaited frills or trimmings as hereinbefore described and illustrated by fig. 8 of the drawings. The drawing showed a double frill, or a middle plaited strip with a frill above and a frill below. It was held that the patent was not for the manufactured product but for the process of manufacturing it. Sir F. Kelly, C. B., said: "The title of the patent describes it as being for the invention of "improvements in the manufacture of frills or ruffles and in the machinery employed therein." It is not for an improvement in frills or ruffles, still less for an improved frill or ruffle, but for an improvement in the manufacture of frills or ruffles and the machinery employed therein. The specification also relates entirely to the machinery, and contains from beginning to end nothing which could lead us to construe it as a specification of the articles manufactured." (His lordship then stated the third claim, and proceeded:) "But is it the kind of frill that is made the subject of the claim? On the contrary, it is the peculiar mode of manufacturing it, or the frill as manufactured by a reciprocating knife. Therefore, whether we look at the title of the patent, the specification, or the claim, the patent is not for the artic. manufactured, but for the mode by which the article described is brought into existence."

Where the title is not inconsistent with the speci-

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fication and no fraud is practised 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.(*a*) It must be consistent with the specification, with which it may be read for the purpose of explanation.(*b*)

Instances of sufficient title.

In the following cases the titles were considered to be sufficiently precise. In *Cook* v. *Pearce* (*c*) 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. A patent was taken out for "certain improvements in the doors and sashes of carriages." In the specification, after describing it, 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," and the claim in the specification was held not to be larger than the title of the patent.(*d*)

Before the date of a patent it was known that sulphuret of iron produced by the action of sulphuretted hydrogen upon hydrated oxide of iron would be re-oxidized by being exposed to the action of atmospheric air; but it was not known that when the sulphuret was produced by the exposure of hydrated oxide of iron to the action of sulphuretted hydrogen mixed with coal gas,

(*a*) *Cook* v. *Pearce*, 8 Q. B. 1044; *Neilson* v. *Harford*, 8 M. & W. 806.

(*b*) *Sturtz* v. *De la Rue*, 5 Russ. 324; *Neilson* v. *Harford*, 8 M. & W. 806; *Oxley* v. *Holden*, 8 C. B. (N. S.) 666.

(*c*) 8 Q. B. 1044.

(*d*) *Oxley* v. *Holden*, 8 C. B. (N. S.) 666.

the re-oxidation of the iron might be prevented by the cyanogen compounds of ammonia and tarry matter which would be mixed with it. It was held that a patent might be had for re-oxidizing the iron by exposure to the air after it had been used in the purification of coal gas, and also that the invention came within the title of the patent as an improved mode of manufacturing gas. (*a*)

In *Beard* v. *Egerton*, (*b*) a title which described the 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" was held to be sufficiently precise and certain; and in *Stead* v. *Williams*, (*c*) a title which described the invention as being for a mode of "making or paving public streets and highways, and public and private roads, courts and bridges, with timber or woodon blocks" was held not too vague.

In *R.* v. *Mill*, (*d*) the title of patent was for "improvements in instruments used for writing and marking," and the specification contained a claim for "improvements in pencil-cases, pen-holders and pens." It was held that the specification was as comprehensive as the title, as pen-holders and pencil-cases might be described as instruments used for marking as well as writing.

Instances of bad titles.

But where the patent was for "improvements in the manufacture of gas for the purpose of illuminating, and in the apparatus used when transmitting and measuring gas," and the title of the specification described the invention as consisting of "improvements in the manufacture of gas for illumination and in the apparatus used

(*a*) *Hills* v. *The London Gas Light Co.*, 5 H. & N. 312.

(*b*) 3 C. B. 97.

(*c*) 2 Webs. P. R. 126.

(*d*) 10 C. B. 379.

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therein, and when transmitting and measuring gas," and the specification stated the invention 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," it was held that there was a material variance between the invention specified and that described in the title: as the claim for making retorts could not be called either a mode of manufacturing gas or the apparatus used in measuring and transmitting gas, and that therefore the patent was void.(*a*)

In *R.* v. *Metcalfe*,(*b*) a brush differing from a common one in no other respect than that the hairs or bristles were of unequal length, was held to be improperly described as a "tapering brush" by Lord Eldon, who said, "If the word tapering be used in its general sense the description is defective, there is no coming to a point. If the term has had a different meaning annexed to it by the usage of the trade it may be received in its perverted sense." In the case of *R.* v. *Wheeler*,(*c*) the patent was for "a new and improved method of drying and preparing malt," and the specification showed that the invention was, not as would be supposed, for a method of making malt from barley, but for making a colouring matter for beer from prepared malt; Abbott, C.J., said: "The language in which the supposed invention is described in a patent of this nature is the language of the patentee himself. He represents to the Crown that he has invented this thing or that thing, and

(*a*) *Croll* v. *Edge*, 9 C. B. 479.

(*b*) 2 Stark. 249.

(*c*) 2 B. & Ald. 345.

that he is the first and sole inventor thereof, and the Crown yielding to his representations and willing to give encouragement to all arts and inventions that may be for the public good, grants to the patentee the sole liberty and privilege of using his said invention for a certain time under the conditions before noticed. It is obvious, therefore, that if the patentee has not invented the matter or thing of which he represents himself to be the inventor, the consideration of the royal grant fails, and the grant consequently becomes void. And this will not be the less true if it should happen that the patentee has invented some other matter or thing of which upon a true representation thereof he might have been entitled to a grant of the exclusive use."

In *Cochrane* v. *Smethurst*, (*a*) it was held that a patent "for an improved method of lighting cities, towns and villages" could not be supported by a specification describing an improved lamp; and in *Brunton* v. *Hawkes*, (*b*) it was held that a patent for improvements in the construction of ship's anchors, windlasses and chain cables could not be supported unless there was novelty in each invention.

Amending title.

If the law officer is of opinion that the title is too large or insufficient, he may allow or require it to be amended. (*c*)

No right of priority gained by leaving provisional specification.

Where a provisional specification is left, and provisional protection is thus obtained, there is nothing to prevent another provisional specification for a similar invention being left, and letters patent may be granted to the second applicant, within six months of the time when the first provisional specification was left. (*d*)

(*a*) 1 Stark. 205.
(*b*) 4 B. & Ald. 542.
(*c*) 15 & 16 Vict. c. 83, s. 8.
(*d*) *Ex parte Bates & Red-*

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Complete specification *may be left* instead of provisional specification, such deposit to confer for a limited time the like rights as letters patent.

Instead of leaving a provisional specification, the applicant may, if he thinks fit, file an instrument under his hand and seal called a complete specification, particularly describing and ascertaining the nature of the invention, and in what manner it is to be performed. This instrument must be mentioned in the declaration. The day of delivery of any of the above mentioned documents is endorsed on them, and recorded in the office, and a certificate given to the applicant or his agent. The invention is then protected for six months, and the applicant during that time enjoys the privileges of a patentee. (*a*)

All specifications, in pursuance of the conditions of letters patent, and all complete specifications accompanying petitions for the grant of letters patent, must be written bookwise upon a sheet or sheets of parchment, each of the size of twenty-one inches and a half in length by fourteen inches and three-fourths of an inch in breadth; they may be written on both sides of the sheet, but a margin must be left of one inch and a half on every side of each sheet.

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

But not so as to prevent previous applicant for similar patent from obtaining grant.

The applicant does not, by taking this course, acquire the rights of a patentee, so as, during the six months

gate, L. R. 4 Ch. 577; *Ex parte Bailey*, L. R. 8 Ch. 60; *Ex parte Henry*, *ib.* 169.

(*a*) 15 & 16 Vict. c. 83, s. 9.

(*b*) Order 1st Oct. 1852.

protection, to prevent any other person, who has previously applied for a patent for a similar invention, from obtaining a patent.(*a*)

Variance between provisional and complete specifications.

Any part of the provisional specification may be omitted from the complete specification, if there is no fraud, and the effect of the remainder is not altered by the omission. Thus, in *Thomas* v. *Welch*,(*b*) the provisional specification of a patent for sewing machines claimed amongst other improvements, that a certain instrument which improved 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. It was held that this was not such a variance as could invalidate the patent.

Office of provisional specification.

The office of the provisional specification is not to disclose the entirety of the invention, but only to show that the invention fully specified is the same in substance as that presented to the law officer.(*c*)

The invention described in the two specifications must be the same.

The statute requires, that in the provisional specification "the nature of the invention" shall be described, but that the complete specification shall particularly describe and ascertain the nature of the invention, and in what manner the same is to be performed." If, therefore, it were possible to depart from the nature of the invention described in the provisional specification, protection might be given to a patentee for something described in it, from which he might depart altogether when he filed his complete specification. It is, at all

(*a*) *Ex parte Henry*, L. R. 8 Ch. 167.

(*b*) L. R. 1 C. P. 192.

(*c*) *Newall* v. *Elliott*, 13 W. R. 15; S. C. on app. 4 C. B. (N. S.) 269; *Thomas* v. *Welch*, L. R. 1 C. P. 502; *Wright* v. *Hitchcock*, L. R. 5 Exch. 42.

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events, requisite that the invention, as shown in the two specifications, shall be one and the same. No addition or alteration ought to be made by which the nature of the invention, as described in the complete specification, becomes in a material respect different from the nature of the invention described in the provisional specification. (*a*)

Complete specification need not extend to everything included in provisional specification.

The complete specification must not claim anything different from that which is contained in the provisional specification, but it need not extend to everything so included. Thus, where 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 to consist in employing wood in the construction of such bearings and bushes, and the complete specification afterwards, in describing the mode in which the wood was to be used, claimed the employment of wood in the construction of bearings and bushes "as therein described," it was held that there was not such a variation between the provisional and complete specifications as invalidated the patent. (*b*)

Provisional specification may be in some respects incomplete.

If it were necessary that the provisional specification should enter into all the minute details as to the manner in which the invention is to be carried out, it would have to be as full as the complete specification and drawn with as much care. The statute by the use of the word "complete" implies that the provisional specification may be in some respects executory and incomplete. It enacts that the provisional specification is to describe the nature of the invention and no more, and that the complete specification shall describe not only the nature of the in-

(*a*) Per Lord Westbury in *Foxwell* v. *Bostock*, 4 De G. J. & S. 298; 10 L. T. (N. S.) 144.

(*b*) *Penn* v. *Bibby*, L. R. 2 Ch. 127.

vention but also particularly ascertain the manner in which it shall be performed. In *Re Newall & Elliot*,(*a*) the inventor of an improved apparatus for laying down submarine telegraph cables described his invention in the provisional specification as follows:—"The cable or rope containing the insulated wire or wires is passed round a cone, or if it is a long cable round several cones, so that the cable in being drawn off the coil is prevented from kinking by means of the cone; and there is a cylinder on the outside which prevents the coil from shifting in its place;" and in the complete specification after repeating the above description the inventor went on to say: "When the wire or cable is to be laid down I place over the cone an apex or top which is conoidal as shown in the drawing, or conical, and around this I suspend several rings of iron or other metal by means of cords so as to admit of adjustment at various heights over the cone. The use of these rings is to prevent the bight of the rope from flying out when going at a rapid speed; and the combination of these parts of the apparatus prevents the wire or cable from running into kinks." He claimed as his invention 1st coiling the wire or cable round a cone, 2ndly the supports placed cylindrically outside the coil round the cone, 3rdly the use of the rings in combination with the cone as described. It was held that the omission of the rings from the provisional specification did not invalidate the patent.

The provisional specification cannot be read for the purpose of interpreting the complete specification.(*b*)

Where the applicant has filed a complete specification

(*a*) 4 C. B. (N. S.) 293.

(*b*) *Mackelcan* v. *Rennie*, 13 C. B. (N. S.) 52.

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Conditions voiding the patent.

and letters patent are granted to him; instead of a condition voiding the letters patent in case the invention is not described and ascertained by a subsequent specification, such letters patent will be conditional to become void if such complete specification does not particularly describe and ascertain the nature of the invention and how it is to be performed. (*a*)

Provisional or complete specification obtained in fraud not invalidate letters patent.

Letters patent granted to the true and first inventor of an invention, will not be invalidated by reason of a provisional specification or complete specification deposited in fraud (*b*).

Commissioners to cause protections to be advertised.

Where any invention is provisionally protected under the Act, or protected by deposit of a complete specification, the commissioners to cause such protection to be advertised, (*c*) the advertisement will be in the "London Gazette," and sets forth the name and address of the petitioner, the title of his invention, the date of the application, and in the case of a complete specification, that such has been deposited. (*d*)

Application for letters patent to be advertised, and also oppositions to the same.

As soon as he thinks fit, after the foregoing steps have been taken, the applicant may give notice at the office of commissioners of his intention to proceed with his application; the commissioners then cause the application to be advertised. Any persons having an interest in opposing the grant may leave particulars of their objections to the application as follows. (*e*) The notice of intention to proceed is advertised in the "London Gazette," and the advertisement sets forth the name and address of the petitioner, and the title of his invention; and that any persons having an interest in opposing such application are to be

(*a*) 15 & 16 Vict. c. 83, s. 9.
(*b*) *Ib.* s. 10.
(*c*) *Ib.* s. 11.
(*d*) First set of Rules and Regulations, cls. 3, 4.
(*e*) 15 & 16 Vict. c. 83, s. 12.

at liberty to leave particulars in writing of their objections to the application at the office within twenty-one days after the date of the Gazette in which the notice is issued. (*a*)

Time when notice to proceed to be left at office.

The notice of the applicant's intention to proceed must be left at the office eight weeks before the expiration of the term of provisional protection, and no notice to proceed may be received unless the same has been left in the office eight weeks at the least before the expiration of such provisional protection. The Lord Chancellor may upon special circumstances allow a further extension of time.

Specifications and objections to be referred to the law officer.

After the time for delivery of such objections shall have expired, the provisional specification, or complete specification, and particulars of objection, are referred to the law officer to whom the application has been referred. (*b*)

Power to law officer to order by or to whom costs shall be paid.

The law officer may by certificate order, by or to whom the costs of any hearing or inquiry upon any objection or otherwise in relation to the grant of the letters patent or in relation to the provisional or other protection shall be paid, and in what manner and by whom they are to be ascertained. If they are not paid within four days after they are ascertained, the law officer may make an order for payment, which may be made a rule of court. (*c*)

Power to law officer to cause a warrant to be made for sealing of letters patent.

After the hearing the law officer may cause a warrant to be made for the sealing of letters patent. This warrant is to be sealed with the seal of the commissioners, and sets forth the tenor and effect of the letters patent. The law officer may direct the insertion of all such restrictions, conditions and provisoes as he may deem usual and expedient. The warrant "shall be the warrant for the making and sealing of letters patent under this Act according to the tenor of the said warrant."

When application for warrant to be made.

The application for the

(*a*) First set of Rules and Regulations, cl. 5.

(*b*) 15 & 16 Vict. c. 83, s. 13.

(*c*) 15 & 16 Vict. c. 83, s. 14.

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warrant of the law officer and for letters patent must be made at the office twelve clear days at least before the expiration of the term of provisional protection, and no warrant or letters patent will be prepared unless such application has been made within the time fixed. The Lord Chancellor may upon special circumstances allow a further extension of time, on being satisfied that the same has become necessary by accident and not from neglect or wilful default of the applicant or his agent. (*a*)

All powers which the Lord Chancellor had at the time of the passing of the Act are reserved to him. (*b*) In the case of a provisional specification only having been left, a provision requiring a complete specification to be filed within six months from the date of the application must be inserted. (*c*)

Nothing to affect the prerogative of the Crown in granting or withholding grant of letters patent.

It is provided that nothing in the Act shall extend to abridge or affect prerogative of the Crown in relation to the granting or withholding of any letters patent, and that it shall be lawful for Her Majesty by warrant under her Royal sign manual to direct the law officer to withhold his warrant, or that any letters patent for the issuing of which he has issued a warrant shall not issue, or to direct the insertion in any letters patent of any restrictions, conditions or provisions which she may think fit, and also to direct any complete specification to be cancelled. (*d*)

A grant of letters patent to a subject does not, according to the decision in the case of *Feather* v. *The Queen*, (*e*) exclude the Crown from using the invention without the licence of the patentee, and the Court of

(*a*) Third set of Rules, cl. 6.

(*b*) 15 & 16 Vict. c. 83, s. 15.

(*c*) Second set of Rules and Regulations, cl. 8.

(*d*) 15 & 16 Vict. c. 83, s. 16. See *In re Schlumberger's Patent*, 9 Moo. P. C. C. 1.

(*e*) 6 B. & S. 257.

Queen's Bench will not issue a mandamus to any Government officers to compel them, if they use the invention, to settle terms according to the patent. (*a*) If they have infringed the patent, the remedy is by action, and not by way of petition of right. (*b*)

Munitions of war.

Improvements in instruments or munitions of war may be assigned by the inventor to the Secretary of State for War, who may certify to the Commissioners of Patents that the invention should be kept secret. In such a case the petition for letters patent and the specification, and all documents relating to the invention, are left with the Clerk of the Patents, under the seal of the Secretary of State, to whom at the end of the term of letters patent they are delivered up. (*c*)

Issue of letters patent.

As soon after the sealing of the warrant as required by the applicant, the Commissioners cause letters patent to be prepared according to the tenor of the warrant. The Lord Chancellor then causes these to be sealed with the Great Seal. Such letters patent extend to the whole of the United Kingdom of Great Britain and Ireland, the Channel Islands, and the Isle of Man. If the warrant so directs, they can be made applicable to the Colonies, or such of them as may be mentioned in the warrant. They confer the like powers, rights, and privileges as letters patent issued under the Great Seal. But nothing is to give effect to any letters patent in any colony in which they would be invalid by the law of the colony. (*d*)

Extent.

No letters patent issued after three months from date of warrant.

No letters patent, except in the case of letters patent destroyed or lost, may issue on any warrant, unless appli-

(*a*) *Ex parte Pering*, 4 A. & E. 949.

(*b*) *Feather* v. *The Queen*, 6 B. & S. 257.

(*c*) See 22 Vict. c. 13.

(*d*) 15 & 16 Vict. c. 83, s. 18.

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cation be made to seal them within three months after the date of the warrant;(*a*) nor after the protection given by the Act has expired, unless the application to seal has been made during that time, and has been delayed by reason of a *caveat*. In such a case they may be sealed at such time as the Lord Chancellor shall direct.(*b*)

Power to Lord Chancellor to order letters patent to be sealed in certain cases.

By a later Act (*c*) it is provided that where letters patent have not been sealed during the continuance of the provisional protection through accident, the Lord Chancellor may seal them within a month after the expiration of the provisional protection, and may date the sealing as of any date before the expiration of such provisional protection.

The petition praying for extension, and the affidavit accompanying it, must be left at the office. Where the delay in sealing is alleged to have been caused by adjourned hearings of objections to the grant of letters patent before the law officer, the petitioner, before leaving his petition, must obtain the certificate of the law officer that such allegations are correct, and that the delay has not been caused by the neglect or default of the petitioner.(*d*)

Delay accidental or caused by order of government.

In *Re Hersee & Smith*(*e*) leave was given to extend the time, within which the application for the warrant of the law officer and for the letters patent ought to have been made, the delay being small and accidental. And in another case the time was extended, the petitioner having been ordered to delay making his application by the War Office.(*f*)

Where applicant dies during continuance of protection grant may be to personal representatives.

In case the applicant dies during the continuance of the protection, the letters patent may be issued to his

(*a*) 15 & 16 Vict. c. 83, s. 19.
(*b*) 15 & 16 Vict. c. 83, s. 20.
(*c*) 16 & 17 Vict. c. 115, s. 6.
(*d*) Order of 17th July, 1854.
(*e*) L. R. 1 Ch. 518.
(*f*) *Mackintosh's Patent*, 2 Jur. (N. S.) 1242.

personal representatives during the continuance of the protection, or at any time within three months after the death of the applicant, notwithstanding the expiration of the term of protection.(*a*)

Letters patent destroyed or lost.

In case any letters patent are destroyed or lost, others of the like tenor and effect, sealed and dated as of the same day, may be issued.(*b*)

Opposing the grant before the Lord Chancellor.

By an order of the 15th of October, 1852, it is provided that every application to the Lord Chancellor against or in relation to the sealing of letters patent shall be by notice, and that such notice shall be left at the office, and shall contain particulars in writing of the objections to the sealing of such letters patent. It is not necessary for any opposer to apply to the Court for leave to give notice of opposition.(*c*)

Application to Court not necessary.

Must have been opposition before law officer.

No person who has not opposed before the law officer, except in cases where the reason for not having so opposed is fully explained, will be allowed to oppose before the Lord Chancellor,(*d*) and the opposer cannot bring forward before the Lord Chancellor any facts which were within his knowledge when before the law officer, but which he did not then bring forward, nor can he raise any new legal argument on those facts, or produce any evidence which he could have previously produced.(*e*)

Extension of time for opposing grant.

Leave may be given to oppose the sealing of letters patent notwithstanding the time for entering an opposition has expired, if there is no question of *laches*, and the reason for the delay is properly accounted for.(*f*)

(*a*) 15 & 16 Vict. c. 83, s. 21.

(*b*) *Ib.* s. 22.

(*c*) *Vincent's Patent*, L. R. 2 Ch. 341, overruling *Heathorn's Patent*, 4 N. R. 489.

(*d*) *Mitchell's Patent*, L. R. 2 Ch. 343.

(*e*) *Ex parte Sheffield*, L. R. 8 Ch. 237.

(*f*) *Brennand's Patent*, 7 Jur. (N. S.) 690.

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Duty of the law officer where similar inventions.

It is the duty of the law officer to investigate and decide in the first instance whether two inventions for similar inventions interfere with each other, or which of the two applicants is the true and first inventor,(*a*) and the question ought not to be remitted to the Lord Chancellor by directing warrants for both patents.(*b*) In *Re Faucett's Patent*,(*c*) on a caveat being entered before the Great Seal had been affixed, the Lord Chancellor declined to enter into the merits of the opposition, but referred the matter back to the law officer.(*d*)

This judgment not interfered with.

The judgment of the law officer will not be interfered with; unless a case is made of surprise or fraud, or unless some material fact has come to the knowledge of the appellant which if brought to the knowledge of the law officer would have led him to decide differently.(*e*)

Letters patent will be sealed unless clearly bad.

Unless a patent is clearly bad, the Lord Chancellor will not refuse to sign 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.(*f*) It is for the opposer to show that he has so clear a case as to make it right to do that which, if wrongly done, would, so far as relates to the patentee, be irreparable, but which, if left undone, could not inflict upon the opponent any irreparable injury.(*g*)

The person who first obtains a patent has priority.

Where there are several applicants for patents for

(*a*) *Griffith and Samuda's Patent*, 5 L. T. 141.

(*b*) *Ex parte Henry*, L. R. 8 Ch. 167.

(*c*) 2 D. M. G. 439.

(*d*) And see *Stoll's Patent*, 22 L. T. 233; *Ex parte Henson*, 1 Webs. P. R. 432.

(*e*) *Vincent's Patent*, L. R. 2 Ch. 341.

(*f*) *Spence's Patent*, 3 De G. & J. 523; *Russell's Patent*, 2 *ib.* 130.

(*g*) *Ex parte Sheffield*, L. R. 8 Ch. 240; *Tolson's Patent*, 6 D. M. G. 422.

similar inventions, the one who first obtains the letters patent to be sealed will have priority, though another applicant may have applied for provisional protection first,(*a*) unless it is perfectly clear that there has been fraud, as the opposer will still be able to get the patent repealed.(*b*)

Later patent not allowed to cover any part of earlier.

Where a later applicant for protection obtains his patent first, letters patent will not be granted to an earlier applicant for any part of his invention, which is covered by the letters patent already obtained by the later applicant.(*c*) But in a case where the relation of master and servant existed between the applicants, and the master became acquainted with the servant's invention, and the evidence showed that there was great suspicion that the master had profited by the servant's invention, it was held that, under the circumstances, the letters patent for the servant's invention might be sealed and bear the date of his provisional specification.(*d*)

Reference to law officer where patent sealed and another applied for which is objected to.

If a patent has been actually sealed, and another is applied for, which is objected to on the grounds that the alleged invention is not new, and is a mere evasion or colourable imitation of the invention for which a patent has been already granted, it will be referred to the law-officer to say whether, having regard to the prior patent, the present application ought to be granted;(*e*) and if it appears that part of the invention for which the patent is

(*a*) *Ex parte Bates and Redgate*, L. R. 4 Ch. 579; *Simpson and Isaacs' Patent*, 21 L. T. 81.

(*b*) *Lowe's Patent*, 25 L. J. Ch. 454.

(*c*) *Ex parte Bates and Redgate*, L. R. 4 Ch. 577; *Ex parte Henry*, L. R. 8 Ch. 169.

(*d*) *Ex parte Scott and Young*, L. R. 6 Ch. 274.

(*e*) *Ex parte Yates*, L. R. 5 Ch. 1; *Ex parte Manceaux*, *ib.* 518.

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sought is identical with part of an invention which is the subject of the 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. (*a*)

Objection that first patent obtained by fraud.

Where the sealing of a patent was opposed on the ground of public user, and the applicant contended that such user took place in consequence of fraud, which, under 15 and 16 Vict. c. 83, s. 10, would destroy the effect of the user, it was held that this was a question of fact, which ought to be tried by a jury on *viva voce* evidence, and that the patent ought to be sealed, so as to allow such trial to take place. (*b*)

Lord Chancellor may impose terms.

The Lord Chancellor may, if he thinks fit, direct the letters patent to be sealed upon terms. (*c*)

Where it appeared that a master and his foreman had both invented certain improvements, for which the master sought letters patent, they were granted on the terms of being vested in trustees for both parties. (*d*) As to the terms of a compromise in a similar case see *Brandles' Patent*. (*e*)

It is no objection to the grant of a patent that another person has been making experiments and working towards a similar invention. (*f*)

Delay in applying.

Where, in April, two months after the petition for a patent had been left, the petitioner applied to have the

(*a*) *Ex parte Manceaux*, L. R. 6 Ch. 272; *Stoll's Patent*, 21 L. T. 233.

(*b*) *Vincent's Patent*, 2 Ch. 341.

(*c*) *Daines' Patent*, 26 L. J. Ch. 298.

(*d*) *Re Russell's Patent*, 2 De G. & J. 130.

(*e*) 1 Eq. Rep. 121.

(*f*) *Ex parte Henry*, L. R. 8 Ch. 167.

great seal affixed, and a *caveat* was entered a week afterwards, and in September the applicant presented a petition for sealing, it was held that the delay was no objection.(*a*)

Lord Chancellor's orders to be drawn up by registrar in attendance.

By an order of the 11th February, 1873, it was directed that every order made by the Lord Chancellor upon the hearing of petitions against or relating to the sealing of letters patent shall be drawn up, passed and entered by the Registrar of the Court of Chancery in attendance, and that an office copy of such order shall be remitted by him, without fee, to the clerk of the combined offices of the Great Seal and the office of the Commissioners of Patents for inventions, to be filed with the petition.

Affidavits in opposition.

Where there was only one affidavit distinctly swearing to the public use and sale of an alleged invention, prior to the date of the application for a patent, which was not corroborated by the person alleged to have sold the goods, the patent was ordered to be sealed.(*b*) So, too, the patent was ordered to be sealed when the affidavits in opposition were only filed on the morning of the day on which the petition was ordered to be heard.(*c*)

Substituted service.

Leave was given to serve notice of a petition for sealing upon the solicitor of a person who had entered a *caveat* in opposition, and who was out of the jurisdiction of the Court.(*d*)

Effect of caveat.

The effect of a *caveat* is merely to entitle the person lodging it to notice.(*e*)

(*a*) *Ex parte Bailey*, L. R. 8 Ch. 60.

(*b*) *Tolhausen's Patent*, 14 W. R. 551.

(*c*) *M'Kean's Patent*, 1 De G. F. & J. 2.

(*d*) *Campbell's Patent*, 22 L. T. 93.

(*e*) *R. v. Cutler*, 3 C. & K. 215.

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Costs.

The costs caused by an unsuccessful *caveat* will have to be paid by the person entering it, and will be taxed upon the principle upon which costs in a cause are taxed as between party and party.(*a*) And costs caused by notice of objections which were withdrawn were ordered to be paid by the opposer.(*b*) But where the opposition was considered not to be unreasonable, costs were not given.(*c*)

Of reference to law officer.

Costs of reference to the law-officer will have to be paid by the opposer, if unsuccessful, unless there is fraud.(*d*)

Date of letters patent.

Notwithstanding 18 Henry VI. c. 1, letters patent may be sealed, and bear date as of the day of the application for the same.(*e*)

Reckoned inclusively.

The day of the date is reckoned inclusively.(*f*) They are usually dated as of the date of the provisional protection. But where a second applicant for a patent for a similar invention has obtained letters patent before the first applicant, the first applicant on applying to have the Great Seal affixed, will not be allowed to have his letters patent dated as of the date of the provisional protection, but they will be dated as of the day of the application for sealing;(*g*) even where it is alleged that the second applicant obtained his letters patent to be sealed first by fraud.(*h*)

(*a*) *Cutler's Patent*, 4 My. & Cr. 510: *Alcock's Patent*, *ib.*

(*b*) *Cobley's Patent*, 31 L. J. Ch. 333.

(*c*) *Ex parte Fox*, 1 V. & B. 67.

(*d*) *Ex parte Yates*, 5 Ch. I; *Ex parte Manceaux*, *ib.* 518.

(*e*) 15 & 16 Vict. c. 83, s. 23.

(*f*) *Russell* v. *Ledsam*, 14 M. & W. 574.

(*g*) *Ex parte Bates and Redgate*, L. R. 4 Ch. 579; *Saxby* v. *Hennett*, L. R. 8 Exch. 210.

(*h*) *Ex parte Bailey*, L. R. 8 Ch. 60; *Ex parte Scott and Young*, L. R. 6 Ch. 274.

Ante-dated letters patent.

Any ante-dated letters patent have the same validity as if they had been sealed on the day of the date. But no legal proceedings can be taken in respect of any infringement committed before they were actually granted, except where a complete specification has been filed. (*a*)

Use in foreign ships.

Letters patent do not prevent the use of the invention in any foreign ships in English ports or English waters, where the invention is not used for the manufacture of any goods for sale in the kingdom or for exportation, unless the laws of the State to which the ships belong do not allow English ships to use foreign inventions. (*b*) This section was the result of the decision in *Caldwell* v. *Vanvlissingen*, (*c*) where an injunction was granted against foreigners to restrain them from using the patented invention (a screw propeller) on board ships within the dominions of England without the licence of the plaintiffs.

Penalty for using name of patentee.

Any person who uses the name of the patentee without authority, or who counterfeits his stamp or mark, is liable to a penalty of £50 for each offence. (*d*) It is no defence to an action for a penalty under this section; for putting on an article, made according to a patent, words which imitate the mark of the patentee, without his licence; that the invention is not a new manufacture; but it is necessary to prove that such words do imitate and are so put on with a view of imitating the mark. (*e*)

Specifications to be filed instead of being enrolled.

All letters patent except those granted after the filing of a complete specification are to require the specification

(*a*) 15 & 16 Vict. c. 83, s. 24.
(*b*) 15 & 16 Vict. c. 83, s. 26.
(*c*) 9 Hare, 415.
(*d*) 5 & 6 Will. IV. c. 83, s. 7.
(*e*) *Myers* v. *Baker*, 3 H. & N. 802.

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to be filed in the Court of Chancery, instead of requiring it to be enrolled, and no enrolment is requisite. (*a*)

Specifications, &c., to be filed in such office as Lord Chancellor shall direct.

Every specification to be filed in pursuance of the condition of any letters patent is to be filed in such office of the Court of Chancery as the Lord Chancellor shall appoint, and every provisional specification and complete specification left or filed at the office of the Commissioners on the application for any letters patent is forthwith, after the grant of the letters patent, or if no letters patent are granted, then immediately on the expiration of six months from the time of such application, to be transferred to and kept in the office appointed for filing specifications in Chancery. (*b*) The office appointed for filing is the Great Seal Patent Office. (*c*)

Filing cannot be dispensed with.

It was decided before the Act that enrolments could not be dispensed with in order to keep the invention secret; (*d*) and a specification cannot be left at the office conditionally, but can be delivered there only for the purpose of being filed. (*e*)

Time for filing.

The time within which the specification must be filed (six months) (*f*) begins to run from the day after the date of the patent. (*g*)

Extension of time.

When the specification has not been filed within the time limited, provided that the delay has arisen from accident and not from the neglect or wilful default of the patentee, the Lord Chancellor may, if he think fit, extend the time for filing for one month. (*h*) Every petition

(*a*) 15 & 16 Vict. c. 83, s. 27.
(*b*) s. 28.
(*c*) Order of the 1st Oct. 1852.
(*d*) *Ex parte Koops*, 6 Ves. 599; *Ex parte Heathcote*, 1 Webs. P. R. 431.
(*e*) *Re Brough*, 7 Beav. 104.
(*f*) Second set of Rules, cl. 8.
(*g*) *Watson* v. *Pears*, 2 Camp. 294.
(*h*) 16 & 17 Vict. c. 115, s. 6.

praying for extension of the time for filing and the affidavit accompanying the same must be left at the office of the Commissioners. And where the delay is alleged to have been caused by adjourned hearings of objections to the grant of the letters patent before the law officer to whom the objections have been referred, the petitioner before leaving his petition must obtain the certificate of the law officer to the effect that the allegations in respect of such adjourned hearings and causes of delay are in his opinion correct, and that the delay has not been caused by the neglect or default of the petitioner.(*a*)

Where the petitioners had been unable to file their specification within the time required by the rules, owing to objections having been filed, the time was extended for one month.(*b*) So, too, where the delay was caused by the non-delivery of a letter, dispatched in time, containing directions for filing, the time was extended.(*c*) But the time will not be extended where there has been any neglect or default.(*d*)

Amending complete specification.

The Master of the Rolls has jurisdiction to alter a specification for correction of clerical errors or mistakes from inadvertency.(*e*) Where before the Act a patent was dated the 24th May, 1852, and the writ of the Privy Seal the 22nd May, 1852, and the enrolment was required to be made within six months after the date of the writ, but the patentee, not being aware of the

(*a*) Order of the 17th July, 1854.

(*b*) *Simpson and Isaacs' Patent*, 21 L. T. 81.

(*c*) *Re Harris*, 25 L. T. 90.

(*d*) *Campbell's Patent*, 22 L. T. 93.

(*e*) *Sharp's Patent*, 1 Webs. P. R. 641. See as to amending clerical errors, *Re Redmund*, 5 Russ. 44; *Nickel's Patent*, 1 Webs. P. R. 650; *Rubery's Patent*, 1 Webs. P. R. 649, n.; *Re Dismore*, 18 Beav. 538.

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discrepancy, took the specification to be enrolled a day too late, it was ordered that as the mistake arose from a misprision of the clerk, the enrolment should be amended.(*a*) There must be no delay in making the application for amendment.(*b*)

Duty of patent agent.

It is the duty of an agent to know the latest state of the law respecting patents, and where, owing to the agent not knowing the decision in *Ex parte Bates and Redgate*,(*c*) a second applicant for a similar invention was enabled to get his patent sealed before the first applicant, it was held that there was evidence of negligence.(*d*)

Of the stamp duties to be paid.

Formerly the whole expenses incident to the application for and grant of letters patent had to be paid at the time the patent was taken out. It is now provided,(*e*) that all letters patent granted under the provisions of the "Patent Law Amendment Act, 1852," shall be made subject to the condition that they shall be void at the expiration of three and seven years respectively from their date, unless there is paid before the expiration of the three and seven years respectively the stamp duties in the schedule annexed to the Act, viz. £50 and £100 respectively.(*f*) The day of the date of the 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 were granted.(*g*)

Agreement to pay stamp duties.

By an agreement in writing between the plaintiff (an inventor) and the defendant, it was agreed that the

(*a*) *Adams' Patent*, 21 L. T. 38.
(*b*) *Re Blamond*, 3 L. T. (N. S.) 800.
(*c*) L. R. 4 Ch. 577.
(*d*) *Lee* v. *Walker*, L. R. 7 C. P. 121.
(*e*) 16 Vict. c. 5, s. 2.
(*f*) See also ss. 3—7.
(*g*) *Williams* v. *Nash*, 27 Beav. 93.

plaintiff should do all necessary acts, matters and things, excepting the advance of money, as inventor, for the purpose of procuring, securing and perfecting letters patent, and should immediately after the same were procured, make and execute to the defendant or his nominee a full and effectual assignment and assurance of one-third part or share in the letters patent, and that the defendant should bear payment and discharge all fees and disbursements necessary for procuring and perfecting letters patent. It was held that the whole consideration for the payment of the money by the defendant was the assignment to him by the plaintiff, that the execution of the assignment was a condition precedent to his right to insist upon the payment being made, and that the assignment not having been executed, the plaintiff could not sue the defendant for not paying the £50 necessary to be paid within three years.(*a*)

(*a*) *Hill* v. *Mount*, 18 C. B. 72.

CHAPTER VII.

OF THE OFFICE OF THE COMMISSIONERS.

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Certain persons constituted Commissioners of Patents for Inventions, three of whom may act, the Chancellor or Master of the Rolls being one.

BY the "Patent Law Amendment Act, 1852," the Lord Chancellor and Master of the Rolls, the law officers of the Crown for England, Scotland and Ireland respectively, together with such other persons as may from time to time be appointed by her Majesty, are to be Commissioners of Patents for Inventions; her Majesty may from time to time by warrant under her royal sign manual, appoint such other person or persons as she may think fit to be a Commissioner or Commissioners. Every person so appointed is to continue in office during her Majesty's pleasure, and all the powers vested in the Commissioners may be exercised by any three or more of them, the Lord Chancellor or Master of the Rolls being one.(*a*)

Seal of the Commissioners.

The Commissioners are empowered to cause a seal to be made for the purposes of the Act, and to cause all warrants for letters patent, and all instruments and copies proceeding from the office, to be sealed therewith. Judicial notice is taken of the seal.(*b*)

Power to the Commissioners to make rules and regulations.

The Commissioners may from time to time make such rules and regulations (not inconsistent with the provisions of the Act) respecting the business of the office and all matters and things which under the provisions

(*a*) 15 & 16 Vict. c. 83, s. 1. (*b*) S. 2.

of the Act are to be under their control and direction, as may appear to them necessary and expedient for the purposes of the Act. The rules are to be laid before both Houses of Parliament within fourteen days if Parliament is sitting, and if Parliament is not sitting, then within fourteen days after the next meeting of Parliament; and the Commissioners are to cause a report to be laid annually before Parliament of all proceedings under and in pursuance of the Act. (*a*)

Commissioners to report annually to Parliament.

The Commissioners of the Treasury are to provide proper officers for the purposes of the Act. (*b*) It was provided by the first set of rules (*c*) that the Great Seal Patent Office and the office of the Commissioners should be combined, and that the clerk of the Patents for the time being should be the clerk of the Commissioners for the purposes of the Act.

Treasury to provide offices.

The Commissioners, with the consent of the Commissioners of the Treasury, have power from time to time to appoint such clerks and officers as they may think fit, and to remove any clerks or officers so appointed. (*d*)

Commissioners to appoint clerks.

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, must be left at the office of the Commissioners on filing. (*e*)

Copies of specifications, &c., to be left at the office.

Transcripts of the letters patent are transmitted to the Director of Chancery in Scotland, upon payment of such fees as the Commissioners require, in the same manner and to the same effect as letters patent passing under

Transcript of letters patent to be forwarded to Scotland.

(*a*) s. 3.
(*b*) s. 4.
(*c*) cl. 6.
(*d*) 15 & 16 Vict. c. 83, s. 5.
(*e*) 16 & 17 Vict. c. 115, s. 3.

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the seal appointed by the Treaty of Union to be used in place of the Great Seal of Scotland were formerly recorded. Extracts from the records are furnished on payment of the fees required by the Commissioners, and are received in evidence in Courts in Scotland. (*a*)

Copies of specifications, &c., to be transmitted to Scotland and Ireland to be evidence, without production of originals.

Certified printed copies under the seal of the Commissioners of all specifications, complete specifications, and facsimile printed copies of drawings accompanying them, if any, disclaimers and memoranda of alterations, are transmitted to, and filed in, the Chancery Courts in Scotland and Ireland, and certified copies or extracts from such documents are furnished to all persons requiring the same, upon payment of such fees as the Commissioners may direct, and are received in evidence without further proof or production of the originals. (*b*)

The office of the Directory of Chancery in Scotland is also the office of the Patent Commissioners. (*c*)

Copies of specifications to be open to inspection at office of Commissioners, and at Edinburgh and Dublin.

True copies of all specifications (other than provisional specifications) disclaimers and memoranda of alterations are open to the inspection of the public at the office and at an office in Edinburgh and Dublin. Transcripts of all letters patent are transmitted for enrolment in the Court of Chancery in Dublin, and the transcript or exemplification has the same effect as if the original letters patent had been enrolled there, and all parties have their remedy by *scire facias* or otherwise, as if the letters patent had been granted to extend to Ireland only. (*d*) The enrolment office of the Court of Chancery in Dublin is also the office of the Patent Commissioners. (*e*)

(*a*) 15 & 16 Vict. c. 83, s. 18.
(*b*) 16 & 17 Vict. c. 115, s. 5.
(*c*) Second set of Rules, cl. 1.
(*d*) s. 29.
(*e*) Second set of Rules, cl. 4.

Copies of provisional specifications to be open to inspection.

True copies of all provisional specifications left at the office of the Commissioners are open to the inspection of the public at such times after the date of the record as the Commissioners may direct. (*a*)

Specifications and other documents to be printed and published.

All specifications, disclaimers and memoranda of alterations are printed and published and sold as the Commissioners think fit, as soon after filing as convenient. The Commissioners may present copies of all such publications to such public libraries and museums as they may think fit, and may allow the person depositing or filing any such specification, disclaimer or memorandum of alterations to have any number not exceeding twenty-five of the copies so printed and published, without payment. (*b*)

Indexes to be printed and published.

Indexes of all specifications, disclaimers and memoranda of alterations are open to the inspection of the public, and the Commissioners have power to cause such indexes to be printed and published and sold to the public. (*c*)

Register of patents to be kept.

A register of patents is kept at the Great Seal Patent Office; all letters patent, the deposit and filing of specifications, disclaimers and memoranda of alterations, all confirmations and extensions of letters patent, the expiry, vacating or cancelling of letters patent, with the date, and all other such matters affecting their validity as the Commissioners may direct, are entered and recorded in chronological order in it; and such register or a copy of it is open to the inspection of the public. (*d*)

Fees to law officers.

The Lord Chancellor and Master of the Rolls and the Commissioners have power to appoint the fees to be paid

(*a*) 16 & 17 Vict. c. 115, s. 2.
(*b*) s. 30.
(*c*) s. 32.
(*d*) s. 34. See also *post*, chapter on Registration.

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to the law officers in cases of opposition to the granting of letters patent, and in cases of disclaimers and memoranda of alterations and for office and other copies of documents. (*a*)

(*a*) s. 47. And see generally as to fees, ss. 48—51.

CHAPTER VIII.

OF EXTENSION OF THE TERM OF LETTERS PATENT.

5 & 6 Will. IV. c. 83.

BEFORE the Act of the 5th and 6th Will. IV. c. 83 was passed, the only means of obtaining an extension or renewal of the term of letters patent was by an Act of Parliament. The cases in which patents have been so prolonged will be found in 1 Webs. P. R. 37.

Mode of proceeding in case of application for the prolongation of the term of a patent.

By s. 4 of the above-mentioned Act power was given to a patentee to petition the Judicial Committee of the Privy Council for an extension of the term of using and vending the invention, and it was provided that "the Judicial Committee may report to his Majesty that a further extension of the term in the said letters patent should be granted, not exceeding seven years, and his Majesty is hereby authorized and empowered if he shall think fit, to grant new letters patent for the said invention for a term not exceeding seven years after the expiration of the first term, any law, custom or usage to the contrary in any wise notwithstanding: Provided that no such extension shall be granted if the application by petition shall not be made and prosecuted with effect before the expiration of the term originally granted in such letters patent."

2 & 3 Vict. c. 67, s. 1.

The last proviso in the above section was repealed by 2 & 3 Vict. c. 67, s. 1, which, after reciting that it had happened since the passing of the said Act, and might

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happen again, that parties desirous of obtaining an extension of the term granted in letters patent of which they were possessed and who might have presented a petition for such purposes in manner by the said recited Act directed before the expiration of the said term might nevertheless be prevented by causes over which they had no control, from prosecuting with effect their application before the Judicial Committee of the Privy Council; and that it was expedient therefore that the said Judicial Committee should have power, when under the circumstances of the case they should see fit, to entertain such application and to report thereon, according to the provisions of the said recited Act, notwithstanding that before the hearing of the case before them the terms of the letters patent sought to be renewed or extended might have expired, it was enacted "that so much of the said recited Act as provides that no extension of the term of letters patent shall be granted as therein mentioned, if the application by petition for such extension be not prosecuted with effect before the expiration of the term originally granted in such letters patent, shall be repealed."

Repealing provision requiring the application by petition to be prosecuted with effect before the expiration of the term of the patent.

This enactment was the result of the decision in *Bodmer's Patent*.(*a*) There the petition was duly presented on the 21st of May, 1838, and notices of intention to apply on the 26th of June for a day to be fixed for the hearing were given by advertisement. On that day two *caveats* were entered, and the persons entering them being entitled to four weeks' notice of the time appointed for hearing, the petition could not be heard within the term of the ordinary sitting of the committee, and the

(*a*) 2 Moo. P. C. C. 471; 1 Webs. P. R. 740.

letters patent would have expired before the next sittings. Under these circumstances the 17th of August was fixed for hearing the petition, but on that day a sufficient number of members could not be got together to form a council. On the application being made on the 29th of November the Attorney-General took the objection that the application had not been prosecuted with effect before the expiration of the term of the letters patent, and the objection was held to be fatal.

Term of patent right may be extended in certain cases, though the application for such extension not prosecuted with effect before the expiration thereof.

By section 2, it is enacted "that it shall be lawful for the Judicial Committee of the Privy Council, in all cases where it shall appear to them that any application for an extension of the term granted by any letters patent, the petition for which extension shall have been referred to them for their consideration has not been prosecuted with effect before the expiration of the said term from any other causes than the neglect or default of the petitioner, to entertain such application, and to report thereon as by the said recited Act provided, notwithstanding the term originally granted in such letters patent may have expired before the hearing of such application; and it shall be lawful for Her Majesty, if she shall think fit, on the report of the said Judicial Committee recommending an extension of the term of such letters patent, to grant such extension, or to grant new letters patent for the invention or inventions specified in such original letters patent for a term not exceeding seven years after the expiration of the term mentioned in the said original letters patent: Provided always, that no such extension or new letters patent shall be granted if a petitior for the same shall not have been presented as by the said recited Act directed before the expiration of the term sought to be extended, nor in case of petitions presented after the 30th day of Novem-

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ber, 1839, unless such petition shall be presented six calendar months, at the least, before the expiration of such term, nor in any case, unless sufficient reason shall be shown to the satisfaction of the said Judicial Committee for the omission to prosecute with effect the said application by petition before the expiration of the said term."

Limit of time.

The application is "prosecuted with effect" if it is made, and the report of the Judicial Committee is obtained before the expiration of the original term.(*a*)

7 & 8 Vict. c. 69, s. 2. On petition Her Majesty may grant an extension of patent terms in certain cases.

By another Act (7 and 8 Vict. c. 69, s. 2), after reciting that it was expedient for the further encouragement of inventions in the useful arts, to enable the time of monopoly in patents to be extended in cases in which it can be satisfactorily shown that the expenses of the invention have been greater than the time then limited by the law would suffice to reimburse; it was enacted "that if any person having obtained a patent for any invention shall, before the expiration thereof, present a petition to Her Majesty in Council, setting forth that he has been unable to obtain a due remuneration for his expense and labour in perfecting such invention, and that an exclusive right of using and vending the same for the further period of seven years in addition to the term in such patent mentioned will not suffice for his reimbursement and remuneration; then, if the matter of such petition shall, by Her Majesty, be referred to the Judicial Committee of the Privy Council, the said committee shall proceed to consider the same after the manner and in the usual course of its proceedings touching patents; and if the said committee shall be of opinion, and shall so report to Her Majesty, that a further period greater than seven

(*a*) *Ledsam* v. *Russell*, 1 H. L. C. 687.

years extension of the said patent term ought to be granted to the petitioner, it shall be lawful for Her Majesty, if she shall so think fit, to grant an extension thereof for any time not exceeding fourteen years, in like manner and subject to the same rules as the extension for a term not exceeding seven years is now granted under the powers of the said Act."

Her Majesty may grant extension for a lesser term than that prayed.

It is then provided that nothing therein contained "shall prevent the said Judicial Committee from reporting that an extension for any period not exceeding seven years should be granted, or prevent her Majesty from granting an extension for such lesser term than the petition shall have prayed." (*a*)

Provisions of 5 & 6 Will. IV. c. 83, 2 & 3 Vict. c. 67, and 7 & 8 Vict. c. 69, as to prolongation to apply to patents under this Act.

The provisions of the above Acts as to prolongation apply to patents granted under 15 and 16 Vict. c. 83. Section 40 of that Act provides, "that it shall be lawful for Her Majesty to grant any new letters patent as in the said Acts mentioned; and in the granting of any such new letters patent Her Majesty's order in council shall be a sufficient warrant and authority for the sealing of any new letters patent, and for the insertion in such new letters patent of any restrictions, conditions, and provisions in the said order mentioned; and the Lord Chancellor, on the receipt of the said order in council, shall cause letters patent, according to the tenor and effect of such order, to be made and sealed in the manner herein directed for letters patent issued under the warrant of the law-officer. Provided always that such new letters patent shall extend to and be available in and for such places as the original letters patent extended to and were available in; provided also that such new letters patent shall be sealed, and bear date as of the day after

(*a*) 7 & 8 Vict. c. 69, s. 3.

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the expiration of the term of the original letters patent which may first expire.

Form of Report and Order in Council.

The following is the report and order in council, made in pursuance of the above section in *Heath's Patent*: (*a*) "Their lordships do agree humbly to report to Her Majesty, as their opinion that (in case your Majesty should think fit) a further extension of the letters patent for England, Wales, and the town of Berwick-upon-Tweed, obtained by Josiah Marshall Heath, now deceased, and bearing date at Westminster, 15th of April, 1839, the same being now vested in the petitioner, Charlotte Catherine Heath, widow and administratrix of Josiah Marshall Heath, ought to be granted to Charlotte Catherine Heath, and that such extension should be for the term of seven years from and after the expiration of the term granted by the original letters patent." And the report having been taken into consideration, it was ordered, "That the Right Honourable the Lord Chancellor, upon the receipt thereof, do cause new letters patent, according to the term and effect of this order, to be made and sealed for such part of the United Kingdom of Great Britain as the original letters patent extended to and were available in, namely, for England, Wales, and the town of Berwick-upon-Tweed, for 'certain improvements in the manufacture of iron and steel,' as described in the patent granted to Josiah Marshall Heath, and bearing date at Westminster on the 15th day of April, 1839, and such new letters patent are to be granted to Charlotte Catherine Heath, in whom the legal interest of the original letters patent is now vested, for the further term of seven years from and after the expiration of the term granted in the original letters patent, and whereof the

(*a*) 8 Moo. P. C. C. 225.

Right Honourable the Lord Chancellor and all other persons whom it may concern are to take notice and govern themselves accordingly."

Removing doubts as to provisions of 15 & 16 Vict. c. 83, respecting the making and sealing of new letters patent for a further term.

It was doubted whether the provision of 15 & 16 Vict. c. 83, s. 40, extended to the making and sealing of new letters patent, where such new letters patent were granted by way of extension of the term of letters patent issued before the commencement of the Act, and as it was considered expedient that such new letters patent granted by way of extension should be granted according to the provisions of the Act, it was by 16 & 17 Vict. c. 115, s. 7, provided, "that where Her Majesty's Order of Council for the sealing of new letters patent shall have been made after the commencement of the said Act, the said provision of the said Act for making and sealing in manner aforesaid of new letters patent, shall extend and shall as from the commencement of the said Act be deemed to have extended to the making and sealing in manner aforesaid of new letters patent for a further term, as well where the original letters patent were made before as where such original letters patent have been issued since the commencement of the said Act."

Jurisdiction, extent of.

The Judicial Committee of the Privy Council have somewhat similar powers of discretion in considering whether or not to grant extension of the term of a patent to those formerly exercised by the three branches of Parliament,(a) and they will only exercise this power on the most special grounds alleged and proved in reference to each case.(b)

As to renewed letters patent.

After the term of a patent has once been extended, and new letters patent have been granted, the Judicial Com-

(a) *Morgan's Patent*, 1 Webs. P. R. 739.

(b) *Jones' Patent*, 1 Webs. P. R. 579.

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mittee have no power to recommend an extension of the term of the new patent. (*a*)

As to petition to revoke order.

Under 3 & 4 Will. IV. c. 41, the fourth section of which is as follows: "It shall be lawful for His Majesty to refer to the said Judicial Committee for hearing on consideration any such other matters whatsoever as His Majesty shall think fit, and such committee shall thereupon hear or consider the same, and shall advise His Majesty thereon in manner aforesaid," it has been decided that the Judicial Committee have power to hear and consider a petition which has been referred to them by the Crown, praying that an order in council, made upon their recommendation, to extend letters patent, may be revoked, and also that any warrant for making new letters patent may be annulled. (*b*)

Extension not a matter of course when no opposition.

It is anything but a matter of course that an application for extension should be granted where there is no opposition, either by the public or by the Attorney General on behalf of the Crown. (*c*) The Judicial Committee will not place themselves precisely in the situation of the legislature, and refuse extension where an Act of Parliament would not have been granted; (*d*) but the applicant must show that he is entitled to extension on the usual grounds with as much accuracy as if the petition had been opposed; (*e*) and the circumstances of each case, (*f*) and the merits of the invention will be carefully examined. (*g*)

(*a*) *Goucher's Patent*, 2 Moo. P. C. C. (N. S.) 532.

(*b*) *Re Schlumberger*, 9 Moo. P. C. C. 1.

(*c*) *Jones' Patent*, 1 Webs. P. R. 579; *Cardwell's Patent*, 10 Moo. P. C. C. 490.

(*d*) *Morgan's Patent*, 1 Webs. P. R. 739.

(*e*) *Derosne's Patent*, 4 Moo. P. C. C. 418; *Honiball's Patent*, 9 Moo. P. C. C. 393.

(*f*) *Petitt Smith's Patent*, 7 Moo. P. C. C. 137.

(*g*) *Perkins' Patent*, 2 Webs. P. R. 181; *Morgan's Patent*, 1 Webs. P. R. 739.

Effect of extension

By the joint operation of the Acts of 5 & 6 Will. IV. c. 83, and 16 & 17 Vict. c. 115, s. 7, the extension of a patent is the same as a new grant. (*a*)

on several patents.

Where separate patents had been granted for an invention in England, Scotland, and Ireland, previous to the passing of the Patent Law Amendment Act for terms expiring at the same date, and new letters patent reciting the separate original patents were granted, extending for a term of five years the privileges granted by the three original patents, one of which was void for want of novelty, it was held that the effect was the same as if the three patents had been separately extended, and that the fact of one of the patents being void would not prevent the new letters patent being valid as an extension of the other patents. (*b*)

Date of new letters patent.

As all that it is necessary for the patentee to do is to prosecute his claim with effect before the expiration of the term of the original letters patent, the new letters patent will not be void because they are dated after the expiration of that term. (*c*)

Part of patent only may be extended.

Where the original patent has been taken out for a variety of inventions, and they have not all come into use, an extension of the part only which is useful may be recommended if the other requisites to extension are present. (*d*) It is not quite clear whether in such a case the patentee will be required to disclaim the useless parts. In *Bodmer's Patent*, (*e*) the original patent embraced and

(*a*) *Betts' Patent*, 1 Moo. P. C. C. (N. S.) 57; *Aubé's Patent*, 9 Moo. P. C. C. 43; *Bodmer's Patent*, 8 Moo. P. C. C. 282.

(*b*) *Bovill* v. *Finch*, L. R. 5 C. P. 523.

(*c*) *Ledsam* v. *Russell*, 1 H. L. C. 687.

(*d*) *Lee's Patent*, 10 Moo. P. C. C. 226; *Bodmer's Patent*, 8 Moo. P. C. C. 282.

(*e*) 8 Moo. P. C. C. 282.

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claimed as of the invention of the patentee a great number of distinct matters, many of which were of no practical utility, and one of which only had been actually used by the inventor. There were subsequent patents for improvements by the same patentee, and the original patent could not be worked without them. An extension of so much of the patent as related to the useful parts was recommended upon the petitioner undertaking to disclaim all other parts. In *Lee's Patent* (*a*) no disclaimer was required.

Validity of patent not adjudicated upon by the Judicial Committee.

It is not the duty of the Judicial Committee upon an application for extension to adjudicate upon the validity or invalidity of the patent itself;(*b*) for the extension decides nothing as to the validity of the patent;(*c*) nor will they enter into any questions as to the want of novelty and utility. The new letters patent are subject to any objections on these grounds which may exist to the original letters patent, and unless it is contended that the patent is altogether useless they will not be considered.(*d*) It must, however, be shown that there is such an amount of novelty and utility as will entitle the petitioner, if everything else is satisfactory, to extension.(*e*)

Bad patent not extended.

The meaning of the specification and the sufficiency of the subject matter must be ascertained,(*f*) and if the patent is manifestly bad it will not be extended.

(*a*) 10 Moo. P. C. C. 230.

(*b*) *McDougal's Patent*, L. R. 2 P. C. 1; *Betts' Patent*, 1 Moo. P. C. C. (N. S.) 49; *Heath's Patent*, 8 Moo. P. C. C. 217; *Pinkus' Patent*, 12 Jur. 233.

(*c*) *Woodcroft's Patent*, 2 Webs. P. R. 81.

(*d*) *Galloway's Patent*, 1 Webs. P. R. 725.

(*e*) *Saxby's Patent*, L. R. 3 P. C. 292.

(*f*) *McDougal's Patent*, L. R. 2 P. C. 1.

In *Woodcroft's Patent* (*a*) Lord Brougham said: "Where there is a disputed right as to the validity of the patent, and where the validity of the patent itself must come in question, two things are to be considered. First, is the case to prove the invalidity of the patent, to prove the patent void, clear, past all ordinary and reasonable doubt? Or secondly, does the case hang so doubtful, that their lordships would retire from its consideration, and not because it is not necessary, decide the question here? In the former instance, namely, where it is a clear case, their lordships will not grant an extension; first, because they do not see merit, and secondly, because they will not put the parties against whom the patent right is granted and is sought to be extended, to the vexation, trouble, and expense either of bringing a *scire facias* to repeal the letters patent, or of sustaining an action for infringement. But where the matter hangs very doubtful, where there is conflicting evidence, where upon the construction of the specification on the patent, or in any other way, questions of law or questions of fact, as it may be, shall arise, their lordships have not been used to refuse to exercise their discretionary powers, vested in them by the legislature, of recommending an extension, merely because elsewhere the validity of the patent may reasonably be contested." (*b*)

Nor is it an objection that there is a suit pending respecting the validity of the patent, (*c*) and in such a case, if extension is granted, it will be for a longer period

Lis pendens.

(*a*) 2 Webs. P. R. 30.

(*b*) And see also *Betts' Patent*, 1 Moo. P. C. C. (N. S.) 49; *Hill's Patent*, *ib.* 258; *Erard's Patent*, 1 Webs. P. R. 557.

(*c*) *Kay's Patent*, 3 Moo. P. C. C. 24; *Heath's Patent*, 8 Moo. P. C. C. 217.

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than usual, as some time must elapse before the petitioner can avail himself of the extension. (*a*)

Cognate patents.

Where two cognate patents of different dates are extended, the extension will be granted, so that the new terms shall expire on the same day. (*b*)

Persons to whom extension granted, and who may petition.

The persons to whom extension is granted are those in whom the legal estate in the letters patent is vested at the time of making the application. (*c*) In one case where the petition was presented by the patentee and his mortgagees, extension was granted to the patentee alone. (*d*)

Administrators and executors.

Trustees of company.

Extension has been granted to the administratrix of a patentee, (*e*) to the executrix, (*f*) to the trustees of a joint-stock company, (*g*) where the patentee joined in the petition. Extension has also been granted to trustees when the patentee had parted with all his interest. (*h*)

Assignees.

It was at one time considered doubtful whether extension could be granted to the assignee of a patent. It was therefore by 7 & 8 Vict. c. 69, s. 4, enacted that it should be lawful for Her Majesty on the report of the Judicial Committee to grant extension either to an assignee or assignees, or to the original patentee or patentees, or to an assignee or assignees and original patentee or patentees conjointly, and by s. 7 of the same Act new

(*a*) *Heath's Patent*, 8 Moo. P. C. C. 224.

(*b*) *Johnson and Atkinson's Patent*, L. R. 5 P. C. 87.

(*c*) *Southworth's Patent*, 1 Webs. P. R. 488; *Wright's Patent*, *ib.* 563.

(*d*) *Bovill's Patent*, 1 Moo. P. C. C. (N. S.) 348.

(*e*) *Downton's Patent*, 1 Webs. P. R. 565; *Heath's Patent*, 8 Moo. P. C. C. 217.

(*f*) *Porter's Patent*, 2 Webs. P. R. 193.

(*g*) *Petitt Smith's Patent*, 7 Moo. P. C. C. 138.

(*h*) *Claridge's Patent*, 7 Moo. P. C. C. 138; *Napier's Patent*, 13 Moo. P. C. C. 543.

letters patent granted before the passing of the Act were declared to be valid.(a)

Reasons for granting extension to assignees, interest of patentee injured if not.

The rule followed by the Judicial Committee in granting extension to assignees is laid down by Lord Brougham in *Morgan's Patent*:(b) "That their lordships by taking into their view and favourably listening to the application of the assignee are, though not directly, yet mediately and consequentially, as it were, giving a benefit to the inventor, because if the assignee is not remunerated at all, it might be said that the chance of the patentee of making an advantageous conveyance to the assignee would be materially diminished, and consequently his interest damnified. For this reason consideration has been given to the claims of the assignee who has an interest in the patent."(c) And in *Whitehouse's Patent*,(d) his lordship said that the merit of the assignee in patronizing the inventor, in expending money till he was enabled to complete his invention, and in liberally supplying the funds which were requisite for the purpose of carrying the invention into execution, had been taken into consideration.(e)

Merit of assignee in patronizing patentee.

Extension refused where assignee's risk small.

Where the patented invention was well known abroad and neither the patentee nor his assignee had been at any great risk or expenditure in introducing it into this country, extension was refused.(f) So too, where the assignee had taken an assignment of four-fifths of the

(a) See *Ledsam* v. *Russell*, 1 H. L. C. 687.

(b) 1 Webs. P. R. 738.

(c) See also *Pitman's Patent*, L. R. 4 P. C. 87, where this rule was cited and approved of.

(d) 1 Webs. P. R. 477. *S. C. nom. Russell's Patent*, 2 Moo. P. C. C. 496.

(e) See also *Norton's Patent*, 1 Moo. P. C. C. (N. S.) 339.

(f) *Claridge's Patent*, 7 Moo. P. C. C. 394.

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patent, for a small consideration, only a few months before its expiration. (*a*)

Executor of an assignee may petition.

The executor of an assignee may petition for extension, (*b*) and there does not seem to be any objection to a petition by an equitable assignee. (*c*)

Importer of an invention.

The importer of an invention is an inventor and is entitled to petition. In *Berry's Patent*, (*d*) Lord Brougham said: "The patent law is framed in a way to include two species of public benefactors; the one, those who benefit the public by their ingenuity, industry and science, and invention and personal capability; the other, those who benefit the public, without any ingenuity or invention of their own, by the importation of the results of foreign inventions. Now the latter is a benefit to the public incontestably, and therefore they render themselves entitled to be put upon somewhat if not entirely the same footing as inventors. In this case, certain parties have by their adventurous spirit and by the outlay of capital, benefited the public in the proportion of the value of the foreign invention in question, which but for that adventurous spirit and outlay of capital would not have been available to the people of this country. That therefore is to be considered as a solid claim to the exercise of the *quasi* legislative power which the statute vests in this committee. . . . Upon all principles and all analogy, their lordships are of opinion, that we cannot do otherwise than regard this as a solid ground for the application made on the part of the importers." In

(*a*) *Normand's Patent*, L. R. 3 P. C. 193.

(*b*) *Bodmer's Patent*, 6 Moo. P. C. C. 468; *Honiball's Patent*, 9 Moo. P. C. C. 378.

(*c*) *Noble's Patent*, 7 Moo. P. C. C. 191.

(*d*) 7 Moo. P. C. C. 189.

Newton's Patent (*a*) extension was granted to a petitioner who had obtained the letters patent as agent and trustee for the foreign patentee.

Agent for foreign patentee.

But the merits of the invention, (*b*) and all the antecedent circumstances (*c*) will be enquired into.

An alien resident abroad who was interested in an English patent by a foreign inventor in respect of sales of and licences to use the patent was held to have 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 it. (*d*)

Petition to revoke.

By s. 25 of 15 and 16 Vict. c. 83, it is enacted that "where upon any application made after the passing of the Act, letters patent are granted in the United Kingdom for or in respect of any invention first invented in any foreign country or by the subject of any foreign power or state, and a patent or like privilege for the monopoly or exclusive use or exercise of such invention in any foreign country is there obtained before the grant of such letters patent in the United Kingdom, all rights and privileges under such letters patent shall (notwithstanding any term in such letters patent limited) cease and be void immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in such foreign country shall continue in force, or where more than one such patent or like privilege is obtained abroad immediately upon the expiration or determination of the term which shall first expire or be determined of such

Letters patent obtained in United Kingdom for patented foreign inventions not to continue in force after the expiration of the foreign patent.

(*a*) 14 Moo. P. C. C. 156.

(*b*) *Claridge's Patent*, 7 Moo. P. C. C. 394.

(*c*) *Johnson's Patent*, L. R. 4 P. C. 80.

(*d*) *Re Schlumberger*, 9 Moo. P. C. C. 1.

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several patents or like privileges: Provided always that no letters patent for or in respect of any invention for which any such patent or like privilege as aforesaid shall have been obtained in any foreign country, and which shall be granted in the said United Kingdom after the expiration of the term for which such patent or privilege was granted or was in force, shall be of any validity."

Effect of "such" in proviso.

The earlier part of this section only applies to cases where patents have been granted in foreign countries before the grant of the patent in the United Kingdom, and the words in the proviso "any such patent" refer to the entire description of the patents mentioned in the foregoing part of the section and to no others. This construction renders the section consistent throughout and applicable in every part of it to the same subject. Where a patent is taken out in a foreign country before a patent for the same invention in the United Kingdom the latter patent is to terminate at the same time as the foreign patent. Where the term in a foreign patent has expired, any grant of letters patent in the United Kingdom made after that period is to be of no value.(*a*) And in a late case it was said that the meaning of the proviso is that where a patent is taken out in a foreign country before the grant of letters patent in England and the foreign patent has expired, then that the patent in England shall cease to be in force, and that where one "such" patent or the old patent had been obtained abroad, then the English patent should be determined at the expiration of the earliest of the letters patent granted in a foreign country.(*b*)

(*a*) *Betts' Patent*, 1 Moo. P. C. C. (N. S.) 49.

(*b*) *Blake's Patent*, L. R. 4 P. C. 537.

If it were not the case that this clause only applies to a case where a patent has been previously obtained in a foreign country, an English patentee who takes out a patent for an invention, invented in this country could not venture to take out a patent in a foreign country if the foreign term were less than the English. (*a*)

Foreign patent determined by law.

Where the foreign patent is the first taken out and is determined by act of law abroad, the English patent also is determined. (*b*) But it appears that any part of the English patent which is not identical with the foreign patent would still remain in force. (*c*)

English patentee not prejudiced by subsequently taking out foreign patent.

An English patentee, who after taking out a patent in this country takes out a patent abroad in addition, is in no sense to be prejudiced, either with respect to his original patent or with respect to any application which he may be advised to make for a renewal of it. (*d*)

Jurisdiction of the Court.

The question as to the jurisdiction of the court has often been discussed, and it may now be taken to be clearly settled, that where the foreign patent was obtained before the English, the court has no power to entertain an application for extension after the foreign patent has expired; but that where the English patent was the first obtained, it has such power. (*e*)

Policy of the Act.

The policy of the Act, it was said by Sir J. T. Coleridge, "is to prevent in the case of inventions made and patented in any foreign country, the continuance of a monopoly in

(*a*) *Poole's Patent*, L. R. 1 P. C. C. (N. S.) 49; *Poole's Patent*, L. R. 1 P. C. 518.

(*b*) *Daw* v. *Eley*, L. R. 3 Eq. 510.

(*c*) *Ib.*

(*d*) *Johnson's Patent*, L. R. 4 P. C. 80; *Betts' Patent*, 7 Moo. P. C. 518.

(*e*) See the judgment in *Winan's Patent*, L. R. 4 P. C. 93, and *Blake's Patent*, *ib.* 535, in which all the antecedent cases are examined.

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this country by virtue of any patent subsequently granted here beyond the time when the discovery shall have become public property in the foreign country."(*a*) And Sir W. P. Wood, V.C., said: "Now in looking at s. 25 one sees at once that the object was to prevent the subjects of this kingdom from being fettered in their right to compete with each other in the production and manufacture of different articles, when it was open to foreigners to enter into such competition without being fettered by any exclusive rights claimed by an inventor and patentee, or by the additional price which must be imposed upon the article in consequence of the patent right. The object, I say, is to prevent the English manufacturer from being fettered while the foreigner remains free."(*b*)

Foreign patent taken out shortly after English.

Where the foreign patent has been taken out very shortly after the date of the English patent and is allowed to expire, although the case is not strictly within the provisions of this section, yet it is within the spirit of it, and extension will not be granted.(*c*)

An English patent will not be extended on the mere chance of extension being granted abroad.(*d*)

Act not logically consistent.

Sir W. P. Wood, V. C., remarked, in *Daw* v. *Eley*,(*e*) that the provision of this section is not pursued to its proper logical consequences in the Act, which only deals with the case in which a foreign patent has been granted and determined; whereas, if no foreign patent has ever

(*a*) *Hill's Patent*, 1 Moo. P. C. C. (N. S.) 258.

(*b*) *Daw* v. *Eley*, L. R. 3 Eq. 510; *Normand's Patent*, L. R. 1 P. C. 193; *Johnson's Patent*, L. R. 4 P. C. 75; *Winan's Patent*, *ib.* 94; *Blake's Patent*, *ib.* 535.

(*c*) *Newton's Patent*, 15 Moo. P. C. C. 176; *Winan's Patent*, L. R. 4 P. C. 98; *Blake's Patent*, *ib.* 537.

(*d*) *Normand's Patent*, L. R. 3 P. C. 193; *Winan's Patent*, L. R. 4 P. C. 97.

(*e*) L. R. 3 Eq. 510.

been granted, any number of foreigners may be manufacturing the article abroad, while English manufacturers may be exposed, by the existence of a patent in this country, to the very difficulty from which this section professes to relieve them, and that it undoubtedly does appear very hard to prevent the English manufacturer from having the benefit of manufacturing that which all the rest of the world can manufacture at their pleasure; and yet to say that if it is protected for a certain limited time abroad, then, and then only, when that protection has ceased, shall the English manufacturer become free. This argument was raised in *Blake's Patent*, (*a*) where it was contended that there is not much difference between allowing a foreign patent to expire, and not taking out a foreign patent at all. The difference was there pointed out to be that where a patentee takes out a patent for his invention abroad, he is taking active measures to make the invention known in the country in which he takes out such patent; and the Legislature has not said that no patent shall be granted in England for a foreign invention, unless the inventor shall have taken out a patent in some other country, and that if they had so provided, it would in effect be prohibiting altogether the grant of a patent for a foreign invention.

Grounds of extension generally.

The grounds upon which extension of the term of letters patent are granted were said by Lord Romilly, in *Norton's Patent*, (*b*) to have reference to the inventor himself; and to be, in the first place, to reward him for the peculiar ability and industry he has exercised in making the discovery; in the second place, to reward him, because some great benefit of an unusual description has

(*a*) L. R. 4 P. C. 538. (*b*) 1 Moo. P. C. C. (N. S.) 343.

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by him been conferred upon the public through the invention itself; or lastly, because the inventor has not been sufficiently remunerated by the profits derived from his strenuous exertions to make the invention profitable, and that all these grounds proceed upon the supposition that the invention is new and useful. And Lord Langdale, in *Pinkus' Patent*, (*a*) said that what was usually taken into consideration was, first, the merit of the invention; secondly, the utility of the machinery which has been invented; and lastly, whether the patentee has received a sufficient remuneration for the merit which he has displayed. (*b*)

Interests of public consulted.

Where a patentee agreed with a company, who exclusively worked his patent, that he would not during the continuance of the term grant any other licence or licences than the licence already granted to the company, or otherwise permit or suffer any person or persons other than the said company to make or put in practice the said invention within a certain locality, and that at the determination of the letters patent he would use his interest to obtain a renewal of them, and, in case of obtaining a renewal, would observe and fulfil the covenants contained in the agreement; extension was refused, on the ground that such an agreement manifestly interfered with the public interest, and was at variance with the spirit of the law under which the application was made. (*c*) So, too, where it appeared that the real applicants were a company who had bought the patent with others founded on it, for the purposes of trade, and not for any purpose by which any benefit could be derived by the original inventor, who not only had long since parted with all interest in the

(*a*) 12 Jur. 234.

(*b*) *McDougal's Patent*, L. R. 2 P. C. 1.

(*c*) *Cardwell's Patent*, 10 Moo. P. C. C. 490.

patent, but was dead at the time the application was made, extension was refused. (*a*)

Merit of inventor. Amount of merit.

It is not necessary to show that there is case enough for an Act of Parliament, as there are many cases that "would never have prevailed upon the legislature to make a new personal law prolonging a monopoly, which nevertheless might seem meritorious enough in respect of the individual, beneficial enough in respect of the public, and deficient enough in remuneration to justify interference." (*b*) In *Morgan's Patent*, (*c*) Lord Brougham said: "Their Lordships do not consider that this invention is entirely without merit, but it seems of a very moderate degree, being a substitution of the chemical process of washing with sulphuric acid for the scaling process by fire, making a cheaper and somewhat better article. It is not without merit; at the same time, it cannot be said to be of very great merit—merit which would lead their Lordships to strain much in favour of the inventor." (*d*)

The grounds upon which the Court proceeds in estimating the merit of the inventor were thus laid down in *Hill's Patent* (*e*) by Sir J. T. Coleridge: "It may be collected from what has been already said, that in determining whether to recommend the prolongation of a patent or not, even where the claim to a first discovery and the beneficial nature of that discovery are both con-

(*a*) *Norton's Patent*, 1 Moo. P. C. C. (N. S.) 347; *Claridge's Patent*, 7 Moo. P. C. C. 394.

(*b*) *Per* Lord Brougham in *Soames' Patent*, 1 Webs. P. R. 734.

(*c*) 1 Webs. P. R. 739.

(*d*) And see *Woodcroft's Patent*, 3 Moo. P. C. C. 171; 2 Webs. P. R. 19; *Whitehouse's Patent*, 1 Webs. P. R. 477; *Downton's Patent*, *ib.* 567; *Hardy's Patent*, 6 Moo. P. C. C. 441; *Markwick's Patent*, 13 Moo. P. C. C. 313.

(*e*) 1 Moo. P. C. C. (N. S.) 264.

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ceded, it will be still proper to consider both the degree of merit as inventor, and the amount of benefit to the public flowing directly from the invention. A monopoly limited to a certain time is properly the reward which the law assigns to the patentee for the invention and disclosure to the public of his mode of proceeding. Whether that term shall be extended in effect, whether a second patent shall be granted for the same consideration, and the enjoyment by the public of its vested right be postponed, is to depend on the exercise of a discretion, judicial indeed, yet to be influenced by every such circumstance as would properly weigh on a sensible and considerate person in determining whether an extraordinary privilege, not of strict right, but rather of equitable reward, should be conferred. Now one may be strictly an inventor within the legal meaning of the term; no one before him may have made and disclosed the discovery in all its terms as described in his specification, but this may have been the successful result of long and patient labours, and of great and unaided ingenuity, without which, for all that appears, the public would never have had the benefit of the discovery; or it may have been but a happy accident, or a fortunate guess; or it may have been very closely led up to by earlier and, in a true sense, more meritorious, but still incomplete, experiments. Different degrees of merit must surely be attributed to an inventor under these different circumstances. The moral claim to an extension of time may in this way be indefinitely varied, according as the circumstances approach nearer to the one or the other of the above suppositions." (a)

(a) And see *Johnson's Patent*, L. R. 4 P. C. 85; *Winan's Patent*, *ib.* 96; *Blake's Patent*, *ib.* 536.

Merit of ingenuity and merit of utility.

In *Betts' Patent* (*a*) a distinction was drawn between the merit of ingenuity and the merit of utility. The petitioner's patent was for making a new material by compressing lead and tin. Many years previously a patent for a similar manufacture had been taken out by one Dobbs, but had never been practically used. Lord Chelmsford, in recommending an extension of the term, said, "Dobbs' specification may have given the petitioner the idea of the possibility of uniting the two metals of tin and lead, and may thus have deprived him of the merit of originality. But in Dobbs' hands the discovery was barren; the petitioner, however, who followed out his suggestion, and after repeated trials gave it a practical application, is the real benefactor to the public, and is entitled to claim that description of merit which constitutes one of the grounds for extending the term of a patent."

No objection because improvement small.

An invention may be of very considerable merit, though the amount of advance in improvement is small, and therefore the smallness of the step is not an objection. (*b*)

Nor because of simplicity.

Simplicity, far from detracting from the merit of an invention, greatly increases its value. (*c*)

Nor that original invention has been improved meanwhile.

It is no objection that the original invention has been improved upon, if the invention has merit and the patentee has not been remunerated; (*d*) but it is rather an argument in its favour. (*e*)

Nor that improvements are on expired imported patent.

Nor the patent

(*a*) 1 Moo. P. C. C. (N. S.) 49.

(*b*) *Soames' Patent*, 1 Webs. P. R. 735; *Derosne's Patent*, 4 Moo. P. C. C. 416; *Woodcroft's Patent*, 2 Webs. P. R. 32.

(*c*) *Muntz's Patent*, 2 Webs. P. R. 119; *Newton's Patent*, 14 Moo. P. C. C. 159.

(*d*) *Galloway's Patent*, 1 Webs. P. R. 727; *Bodmer's Patent*, 8 Moo. P. C. C. 284.

(*e*) *Soames' Patent*, 1 Webs. P. R. 735.

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sought to be extended consists of improvements upon an expired imported patent. (*a*)

Nor that mode of manufacture altered.

An alteration in the mode of manufacture will not prevent extension from being granted, if it does not materially detract from the merit of the original invention. (*b*)

Some invention required.

Some invention must be shown by the patentee. (*c*) In endeavouring to show want of invention, reference to a suggestion previously published, of the principle upon which the patent is based, is immaterial, unless it is shown that it is such a suggestion as any one could easily make use of. (*d*)

Merit of importer.

The merit of an importer is of course much less than that of an original inventor, and it is an argument against a patent that it was imported and not invented. The amount of merit is not actually taken away, but it is lessened. (*e*)

Circumstances considered where merit.

The labour, care and science bestowed on an invention, (*f*) the fact that the nature of the invention is such that it would not be likely to come into immediate use, (*g*) that the patentee has not been benefited either owing to the nature of the opposition to the patent, (*h*) or in consequence of his misfortunes and of those connected with

(*a*) *Bovill's Patent*, 1 Moo. P. C. C. (N. S.) 348.

(*b*) *Heath's Patent*, 8 Moo. P. C. C. 223.

(*c*) *Derosne's Patent*, 2 Webs. P. R. 4.

(*d*) *Woodcroft's Patent*, 2 Webs. P. R 23.

(*e*) *Soames' Patent*, 1 Webs. P. R. 733; *Woodcroft's Patent*, *ib.* 740.

(*f*) *Swaine's Patent*, 1 Webs. P. R. 560; *Hill's Patent*, 1 Moo. P. C. C. (N. S.) 265.

(*g*) *Wright's Patent*, 1 Webs. P. R. 576; *Kollman's Patent*, *ib.* 565.

(*h*) *Roberts' Patent*, 1 Webs. P. R. 573; *Russell's Patent*, 2 Moo. P. C. C. 496; S. C. *nom.* *Whitehouse's Patent*, 1 Webs. P. R. 477.

him as agents or otherwise in the management of the patent, (*a*) will be considered where the merit of the patent is established.

Utility of the invention.

As one of the grounds upon which a patent is granted to an inventor is, that he may be rewarded by the monopoly on account of the ultimate benefit to be reaped by the public from the utility of the invention; it is clear that if the invention turns out to be useless and the public are not benefited, the claim of the inventor to extension is gone. A strong case of hardship as well as a strong case upon the utility of the invention must be made out. (*b*)

Public benefit must be proved.

It must be shown that the invention is of such a character that the public will be benefited by it after the original term has expired; (*c*) and the term will be extended in such a case even though there is little novelty in the invention. (*d*)

Extent of benefit.

The extent of the benefit conferred must vary in each case with the circumstances. (*e*) Extension was granted where it appeared that the invention, which introduced a new material for the manufacture of paper, would, if adopted by the trade, be a great public benefit as a valuable addition to the number of raw materials in a trade in which raw materials are very scarce and dear. (*f*)

If detriment to the public, no extension.

If the invention is of such a nature that it will be to

(*a*) *Southworth's Patent*, 1 Webs. P. R. 487; *Wright's Patent*, *ib.* 576.

(*b*) *Erard's Patent*, 1 Webs. P. R. 559.

(*c*) *Simister's Patent*, 4 Moo. P. C. C. 166; *Hardy's Patent*, 6 Moo. P. C. C. 443; *Petitt Smith's Patent*, 7 Moo. P. C. C. 138.

(*d*) *Derosne's Patent*, 2 Webs. P. R. 4.

(*e*) *Hill's Patent*, 1 Moo. P. C. C. (N. S.) 265; *Johnson's Patent*, L. R. 4 P. C. 79.

(*f*) *Houghton's Patent*, L. R. 3 P. C. 461.

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the detriment of the public that the monopoly should be continued, extension will be refused. Thus, where the invention was generally for deodorizing and disinfecting sewage and other offensive matters, by means of a compound of sulphurous acid and carbolic acid, both of which are well known disinfectants, and had been used for disinfecting purposes before the date of the patent, extension was refused on the ground that the restriction by patent from general use, of the combination of the articles referred to in the mode described in the specification would be a great public detriment.(*a*)

Nor if specification too general.

Where the specification described the invention to consist in the application of a metallic soap to the bottoms of ships to prevent their fouling, and it appeared that the soap was composed of well known substances in common use; extension was refused on the ground that as the individual substance for the application of which the patent was sought to be prolonged was not specifically defined, every kind of metallic soap being within the limits of the specification, many questions affecting the patent might be raised if any metallic soap was used by the public in ignorance of the extensive nature of the specification.(*b*)

Delay in using the invention is evidence of inutility.

The petitioner must have done all in his power to bring the invention into notice and use;(*c*) for the fact that an invention when known, has never been generally used, raises a strong presumption against its utility,(*d*)

(*a*) *McDougal's Patent*, L. R. 2 P. C. 1.

(*b*) *McInnes' Patent*, L. R. 2 P. C. 54.

(*c*) *Hill's Patent*, 1 Moo. P. C. C. (N. S.) 265; *Markwick's Patent*, 13 Moo. P. C. C. 313.

(*d*) *Wright's Patent*, 1 Webs. P. R. 576; *Simister's Patent*, *ib.* 723; *Pinkus' Patent*, 12 Jur. 233; *Herbert's Patent*, L. R. 1 P. C. 399; *Allan's Patent*, *ib.* 507.

though it is not conclusive.(*a*) Delay in using the invention may be explained in some circumstances from want of funds to prosecute it, as the pecuniary difficulties, in which the patentee has been involved in working out his invention, may have placed him in a situation which has made it extremely difficult for him to obtain the mears for taking the necessary steps to put the patent into operation. But where the petitioner was a gentleman possessed of ample means to put his invention into operation, and he had taken no effectual steps for this purpose for ten years, extension was refused.(*b*) In this case the non-user was further explained by the disputes between the patentee and his partners. In another case, however, where partnership disputes were given as a reason for want of success, combined with want of capital, and the impossibility of getting other partners on account of the disputes, extension was refused on the ground that the partnership was the petitioner's own act.(*c*)

May be explained by pecuniary difficulties of patentee.

By partnership disputes.

Non-user may also be explained by the circumstance that the nature of the invention is such that it would not be likely to come into immediate use.(*d*) In *Herbert's Patent*,(*e*) the patent was for improvements in constructing and mooring light vessels, buoys and other similar floating bodies. The merit and utility of

By nature of the invention.

(*a*) *Woodcroft's Patent*, 2 Webs. P. R. 29; *Bakewell's Patent*, 15 Moo. P. C. C. 386; *Herbert's Patent*, L. R. 1 P. C. 399.

(*b*) *Norton's Patent*, 1 Moo. P. C. C. (N. S.) 339; *Wright's Patent*, 1 Webs. P. R. 576.

(*c*) *Patterson's Patent*, 6 Moo. P. C. C. 469.

(*d*) *Southworth's Patent*, 1 Webs. P. R. 487; *Jones' Patent*, *ib.* 579; *Woodcroft's Patent*, 2 Webs. P. R. 32.

(*e*) L. R. 1 P. C. 399.

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the invention were not denied. It was shown that the market was very limited, and that there was great difficulty in getting the invention tried, and on these grounds extension was granted.(*a*) If the patent has not been used at all during the whole term, that of itself, unless rebutted by the strongest and most distinct evidence, will as a rule be sufficient ground for refusing extension,(*b*) even though the patent is of such a kind as to require a company to provide sufficient capital.(*c*)

The fact that the patented article is much more expensive than an article for a similar purpose in actual use, and yet that a number of the patented articles have been sold is strong evidence of utility.(*d*)

Sufficiency of remuneration principal question.

The principal question in considering whether extension shall be granted or not, always is, has the individual patentee under all the circumstances received what in equity and good conscience may be considered a sufficient remuneration?(*e*)

The merit and utility being proved.

It is of course necessary to consider the merit and utility of the invention,(*f*) for if the patent is wanting in these essentials, extension will be refused, even though there has been a loss.(*g*)

Reason for non-remuneration must be given.

It must be shown that the patentee has used all reasonable means to make the invention productive; but

(*a*) And see *Berrington's Patent*, cited in Coryton's Law of Patents, 225.

(*b*) *Bakewell's Patent*, 15 Moo. P. C. C. 386; *Allan's Patent*, L. R. 1 P. C. 507.

(*c*) *Ib.*

(*d*) *Downton's Patent*, 1 Webs. P. R. 566.

(*e*) *Hill's Patent*, 1 Moo. P. C. C. (N. S.) 264; *Norton's Patent*, *ib.* 343; *Pinku's Patent*, 12 Jur. 234; *McDougal's Patent*, L. R. 2 P. C. 1; *Downton's Patent*, 1 Webs. P. R. 567.

(*f*) *Morgan's Patent*, 1 Webs. P. R. 738.

(*g*) *Simister's Patent*, 1 Webs. P. R. 724; *Betts' Patent*, 10 Jur. 363.

that nevertheless the remuneration obtained has either entirely failed or has been quite disproportionate to the merits and to the benefit conferred upon the public.(*a*)

Thus extension was granted where it appeared from the nature of the invention; a patent for iron wheels for carriages; that it was hardly possible that within the ordinary period of time remuneration could be expected, and that not only was there no remuneration, but a heavy loss had been sustained.(*b*) So where the loss in working a patent in Southern Australia was owing to want of labour caused by the discovery of the gold fields,(*c*) and where the invention was expensive, and there had been no remuneration till the end of the term.(*d*) But there must be a reasonable prospect of success during the extended term. (*e*)

Benefit to public great, extension though profits.

Where the benefit derived from the patent by the public is proportionately greater than that derived by the inventor, the term will be extended, even though large profits have been made.(*f*)

Profits from foreign patent considered.

Profits made by the patent abroad will be considered in estimating the amount of remuneration.(*g*) In *Poole's Patent*,(*h*) the foreign profits were not taken into account, but their Lordships in *Johnson's Patent*(*i*) desired

(*a*) *Honiball's Patent*, 9 Moo. P. C. C. 393; *Markwick's Patent*, 13 Moo. P. C. C. 393.

(*b*) *Jones' Patent*, 1 Webs. P. R. 579; *Southworth's Patent*, *ib.* 487; *Stafford's Patent*, *ib.* 563; *Kollman's Patent*, *ib.* 564.

(*c*) *Napier's Patent*, 13 Moo. P. C. C. 545.

(*d*) *Newton's Patent*, 14 Moo. P. C. C. 156.

(*e*) *Woodcroft's Patent*, 2 Webs. P. R. 33.

(*f*) *Derosne's Patent*, 2 Webs. P. R. 4; *Hardy's Patent*, 6 Moo. P. C. C. 443.

(*g*) *Johnson's Patent*, L. R. 4 P. C. 82.

(*h*) *Poole's Patent*, L. R. 1 P. C. 514.

(*i*) L. R. 4 P. C. 82.

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it to be understood that that case was not to be considered as laying down any general rule of law, and that they were of opinion that in taking into consideration the remuneration received, they must have regard to the remuneration which the invention has brought in to the patentee or the person who claims the right of the patentee whether it be in one country or another.

Position of assignees.

Assignees are not on the same footing as the patentee, and where it appeared that the patentee had been remunerated though the assignees had not, and the invention was imported and well known abroad, extension was refused.(*a*) So too where the petitioner had purchased the letters patent and stock-in-trade of the patentee at a fair value, and had not sustained any loss.(*b*)

Importers.

Where the patentees were importers of the invention and had incurred loss in their endeavours to introduce it into this country, extension was granted.(*c*)

Patent must be taken as a whole.

Where the patent consists of several branches, it must nevertheless be taken as a whole, and the Court will not allow it to be divided and subdivided to see whether there has been a gain under some branches, and a loss under others,(*d*) and *semble*, that if there has been considerable profit under one branch, that would be a ground for refusing extension, even though there has been loss under the others.(*e*)

Act of Parliament obliging use of patent not objection.

It is no objection to extension that by an Act of Parliament the public will be obliged to use the patentee's in-

(*a*) *Claridge's Patent*, 7 Moo. P. C. C. 394.

(*b*) *Quarrill's Patent*, 1 Webs. P. R. 740.

(*c*) *Berry's Patent*, 7 Moo. P. C. C. 187.

(*d*) *Perkins' Patent*, 2 Webs. P. R. 7.

(*e*) *Ib.*

vention, if it can be proved that at the time of making the application he has not received sufficient remuneration.(*a*)

When application to be made.

The application must not be made until shortly before the expiration of the term of the original patent, as the profits made during the last portion of the term may materially affect the question of extension.(*b*)

The accounts must be clear.

The most unreserved and clear statement of the accounts of the profits made by the patent is necessary;(*c*) for the extension of the term of a patent being a matter of favour and not of right, it is essential to the favourable consideration of an application for extension that the patentee should distinctly prove how much the public have had to pay, that is to say, how much has been received by him on account of his patent; and if he has so acted as to be unable to give such proof when he applies for extension, his application must fail.(*d*)

In *Saxby's Patent*(*e*) Lord Cairns said that it is "the duty of every patentee who comes for the prolongation of his patent to take upon himself the *onus* of satisfying this committee in a manner which admits of no controversy, of what has been the amount of remuneration which, in every point of view, the invention has brought to him, in order that their lordships may be able to come to a conclusion whether that remuneration may fairly be considered a sufficient reward for his invention or not. It is not for this committee to send back the accounts for further particulars, nor to dissect the accounts for the

(*a*) *Foade's Patent*, 9 Moo. P. C. C. 376.

(*b*) *Macintosh's Patent*, 1 Webs. P. R. 739.

(*c*) *Hill's Patent*, 1 Moo. P. C. C. (N. S.) 271.

(*d*) *Trotman's Patent*, L. R. 1 P. C. 124.

(*e*) L. R. 3 P. C. 294.

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purpose of surmising what might be the real outcome if they were differently cast; it is for the applicant to bring his accounts before the committee in a shape which will leave no doubt as to what the remuneration has been that he has received."(*a*)

It was suggested in *Perkins' Patent* (*b*) that where the accounts were not clear, they should be handed to the Solicitor to the Treasury to examine.

What accounts must contain.

The actual expenses must be shown, it is not sufficient to state that there has been neither profit nor loss. (*c*) It is material to know in what ratio profits have increased if they have increased from year to year. (*d*) Profits arising from the sale of the patented article for exportation must be included. (*e*)

Deductions allowed to be made in calculating profits.

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 manu-

Manufacturer's profit.

facturer'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. (*f*) Where the patentee deducted two-thirds as profits from the manufacture and sale, and only credited the patent with one-third, the deduction was held to be unreasonable. (*g*) Lord Brougham in *Muntz's Patent* (*h*) said: "We cannot weigh in golden scales the proportions between manu-

(*a*) And see *Clark's Patent*, L. R. 3 P. C. 425.

(*b*) 2 Webs. P. R. 14.

(*c*) *Quarrill's Patent*, 1 Webs. P. R. 740.

(*d*) *Perkins' Patent*, 2 Webs. P. R. 17.

(*e*) *Hardy's Patent*, 6 Moo. P. C. C. 441.

(*f*) *Galloway's Patent*, 7 Jur. 453; *Betts' Patent*, 1 Moo. P. C. C. (N. S.) 49.

(*g*) *Hill's Patent*, 1 Moo. P. C. C. (N. S.) 269.

(*h*) 2 Webs. P. R. 120.

facturers' profits and patentees', but we must take it in the gross; and applying our minds as men of the world, men of business, neither unfairly towards the inventor nor extravagantly and romantically towards him in his favour, neither against him pressing nor in his favour straining, we must ascertain whether he has in the eyes of men of ordinary but enlightened understandings, judging fairly between him and the public, had a sufficient remuneration."

Loss by litigation.

Expenses caused by litigation in protecting the patent may be deducted.(*a*) But where the patentee compromised suits and gave up costs to which he had no apparent title, a deduction was not allowed.(*b*)

Loss of time.

The patentee may in his accounts charge for loss of time in endeavouring to bring the patent into notice.(*c*)

Experiments.

Deductions will also be allowed on account of the costs of experiments.(*d*)

In *Perkins' Patent*(*e*) the following accounts were allowed:—

	£
Amount of yearly sales of patent apparatus .	64,920
Materials, labour, tools, and expenses belonging to the sales	47,282
Bad debts	2,296

(*a*) *Betts' Patent*, 1 Moo. P. C. C. (N. S.) 49; *Roberts' Patent*, 1 Webs. P. R. 573; *Kay's Patent*, 1 Webs. P. R. 572.

(*b*) *Hill's Patent*, 1 Moo. P. C. C. (N. S.) 268.

(*c*) *Newton's Patent*, 14 Moo. P. C. C. 156; *Mallet's Patent*, L. R. 1 P. C. 311; *Perkins' Patent*, 2 Webs. P. R. 17; *McInnes' Patent*, L. R. 2 P. C. 54; *Clark's Patent*, L. R. 4 P. C. 542. In the three last of the above cases the sum of £400 a year was allowed to be charged.

(*d*) *Kay's Patent*, 1 Webs. P. R. 572; *Perkins' Patent*, 2 Webs. P. R. 17.

(*e*) 2 Webs. P. R. 17.

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	Leaving	15,176

as the amount of profit, subject to the following deductions:

Cost of materials, labour in experiments, and patents	500
Interest at £5 per cent. on the average amount of capital for twelve years at £225 a-year .	2,700
Personal attendance of patentee for thirteen and a-half years at £400 a year . . .	5,400
Total	£8,600

Leaving £6,576 as net profit from the patent business, subject to be reduced should any unpaid debt prove bad.

Royalties paid to agent.

Where a patentee employs an agent to bring the patent forward and pays him by the royalties, the amount so paid may be deducted.(*a*)

Patentee also a manufacturer must keep separate patent accounts.

Where the patentee is also a manufacturer he ought to keep a patent account distinct and separate from any other business in which he may happen to be engaged, so as to be able to give the clearest evidence of everything which has been paid on account of the patent.(*b*) In *Saxby's Patent*(*c*) Lord Cairns said: "Where a patentee is also the manufacturer, the profits which he makes as manufacturer, although they may not be in a strict point of view profits of the patent, must undoubtedly be taken

(*a*) *Poole's Patent*, L. R. 1 P. C. 514; *Perkins' Patent*, 2 Webs. P. R. 16.

(*b*) *Betts' Patent*, 1 Moo. P. C. (N. S.) 61; *McInnes' Patent*, L. R. 2 P. C. 54.

(*c*) L. R. 3 P. C. 295.

into consideration upon a question of this kind. It is obvious that in different manufactures there will be different degrees of connection between the business of the applicant as a manufacturer and his business or his position as the owner of a patent. There may be patents of some kind which have little or no connection with the business of the manufacture, and there may be patents of a different kind where there is an intimate connection with the business of the manufacturer; that the possession of the patent virtually secures to the patentee his power of commanding orders as a manufacturer."(*a*)

Distinction between profits of patentee and profits of manufacturer.

The distinction between the profits made as a patentee and as a manufacturer was thus commented upon by Lord Brougham in *Muntz's Patent*:(*b*) "There are two cases in which a patentee may come before us, and one is where, as in the case of the late Mr. Howard for the sugar refinery, the party is a mere chemist, and has made an invention of the most useful and meritorious process to be used by sugar bakers; there no confusion can ever arise between gains of patentee *quasi* inventor and his gains *quasi* manufacturer. The other case is the case of Mr. Watt, who came before Parliament for the extension of his patent, and obtained an Act, he having been out of pocket by the invention, and having been all his life in law and equity in consequence of the disputes with others—with pirates of his great and immortal discovery. He there combined in his own person the inventor and manufacturer, Mr. Watt never denying that he was to set down to the account of his patent, of the benefit that he had reaped from his patent, the preference that was given him in the market as a manufacturer. He would not

(*a*) And see *Johnson's Patent*, L. R. 4 P. C. 82.

(*b*) 2 Webs. P. R. 121.

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have been able to have carried on his trade to anything like that extent had it not been for that patent. It is impossible to sever the two heads of profit one from the other. Mr. Muntz has gained *quasi* patentee, and even though he obtained and reaped the fruit and, as it were, arrived at the fruits of his ingenuity as an inventor, through his labour and the use of his capital and industry as a manufacturer, it is no answer to say that of these things the one can be deducted from the other. You may make out a very lucrative patent to be of no gain at all to the patentee although agreeing that the patent was lucrative and had been a gain. It is really a monopoly preference which he has; because as patentee he is enabled to sell and to trade in a manner which, but for his invention and but for his patent, he could not."

Royalties from licensees.

The rules laid down above as to perfect openness in stating the accounts, apply as well to a case where the applicant has not manufactured his patented article, but has received his remuneration by royalties received from licensees, as to where he is his own manufacturer, and in such a case he must prove the amount of the profits made by the licensees in respect of the patented article. (*a*)

Course of procedure where accounts primâ facie satisfactory.

If the statement of accounts is *primâ facie* satisfactory, the petitioner may prove the merits of the invention before entering upon the question of the accounts. (*b*) But if it is unsatisfactory the petition will be dealt with without reference to the merits. (*c*) These cases, however, only go to this extent; that where there are special statements which show upon the face of the accounts that

(*a*) *Trotman's Patent*, L. R. 1 P. C. 118.

(*b*) *Houghton's Patent*, L. R. 3 P. C. 461.

(*c*) *Saxby's Patent*, L. R. 3 P. C. 292; *Clark's Patent*, ibid. 421.

the petitioner has in fact made very large profits by his invention, such circumstance is sufficient for the Court at once to determine the application without going into the merits of the invention. (*a*)

Evidence to prove accounts.

The accounts must be strictly proved. (*b*) Where, however, the accounts were unsatisfactory, owing to the loss of the account books, during the petitioner's bankruptcy, extension was granted on a proper account of the profits and losses of the patent verified by affidavit being sent to the Attorney General, with a satisfactory explanation, accounting for the non-production of the books. (*c*) In another case the accounts were taken on the petitioner's own evidence. (*d*) And where it appeared that the estate of a deceased patentee was of little value, and that no accounts had ever been kept, the petitioner, the administratrix of the patentee, on an allegation in the petition that not only had there been no profits but considerable loss, was examined to prove that fact. (*e*)

Terms imposed in certain cases.

The Judicial Committee has power to impose terms on the patentee or his assignees before granting extension. This will be done where it is for the benefit of the public that the government should use the invention. Thus extension was granted in *Petitt Smith's Patent* (*f*), subject to a proviso that the Admiralty should be at liberty to manufacture and fit the invention without any license from the patentee.

(*a*) *Houghton's Patent*, L. R. 3 P. C. 461; *Wield's Patent*, L. R. 4 P. C. 90.

(*b*) *Perkins' Patent*, 2 Webs. P. R. 15.

(*c*) *Markwick's Patent*, 13 Moo. P. C. C. 310.

(*d*) *Hutchison's Patent*, 14 Moo. P. C. C. 364.

(*e*) *Heath's Patent*, 8 Moo. P. C. C. 217.

(*f*) 7 Moo. P. C. C. 139.

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Such a proviso will not, however, be required if the patentee has not received sufficient remuneration. (*a*) An application for the extension of a patent for an improved method of printing in colours was opposed by the apprentices of the patentee, on the ground that they had expected to be able to exercise the trade themselves on the expiration of the patent, and that they would not be able to get employment. It appeared however that they had been so instructed as to be able to get employment in another branch of the trade, and no condition was imposed. (*b*)

Partners.

If there has been a partnership between the patentee and other parties the Court will on extension require the patentee to give the partners the same rights and privileges as they were entitled to under the deed affecting the original letters patent, no further powers will be given than those contained in the deed of partnership, especially if the partners refuse to concur in the application. (*c*)

Licensees.

Where a patentee did not manufacture the article for which he had taken out a patent but had granted a license to a particular firm to manufacture it, and it appeared that there was an agreement that the license should be exclusive, extension was granted on condition that licenses should be granted to any persons who should be desirous of having them upon the same terms as the original license. (*d*)

Assignees.

In the case of a petition by an assignee, the condition

(*a*) *Lancaster's Patent*, 2 Moo. P. C. C. (N. S.) 189; *Carpenter's Patent*, *ib.* 191.

(*b*) *Baxter's Patent*, 13 Jur. 593.

(*c*) *Normandy's Patent*, 9 Moo. P. C. C. 452.

(*d*) *Mallett's Patent*, L. R. 1 P. C. 308.

usually is that he shall secure some remuneration to the patentee. This is generally in the form of an annuity during the extended term. (*a*)

Where a moiety of a patent had been assigned and a petition for extension was presented by the patentee together with the assignees, but before the hearing the patentee died having by his will appointed his widow executrix and residuary legatee, extension was granted to the asignees on condition that they held the moiety of the patent in trust for the widow. (*b*)

Terms, however, will not be imposed upon the assignees when they have lost heavily by the patent. (*c*)

The interests of the public will be considered in granting extension to assignees. Thus in *Hardy's Patent*, (*d*) besides requiring the assignees to pay an annuity to the patentee, a further condition was imposed that neither the assignees nor their assigns should charge for articles made according to the invention, any sum or sums of money, greater than after the rate of the sums thereinafter mentioned, over and above the price of bar iron per ton as fixed by the Staffordshire ironmasters at the quarterly meeting next preceding the date of any contract of sale.

Mode of proceeding in case of application for the prolongation of the term of a patent.

The applicant for prolongation must advertise in the "London Gazette" three times, and in three London papers, and three times in some country paper published in the town where, or near to which, he carries on any manufacture of anything made according to his specifica-

(*a*) *Whitehouse's Patent*, 1 Webs. P. R. 477; S. C. nom. *Russell's Patent*, 2 Moo. P. C. C. 496; *Markwick's Patent*, 13 Moo. P. C. C. 312; *Hardy's Patent*, 6 Moo. P. C. C. 445.

(*b*) *Herbert's Patent*, L. R. 1 P. C. 399.

(*c*) *Bodmer's Patent*, 6 Moo. P. C. C. 468.

(*d*) 6 Moo. P. C. C. 445.

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tion, or near to or in which he resides, in case he carries on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to apply to Her Majesty in Council for a prolongation of his term of sole using and vending his invention, and must petition Her Majesty in Council to that effect. (*a*)

Advertisements.

The petitioner must in the advertisements give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition, which day must not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the "London Gazette." (*b*) These notices will be included in one advertisement. (*c*)

Petitions must be presented within one week from the insertion of the last of the advertisements, and must be accompanied with affidavits of advertisements having been duly inserted, and the matters in such advertisements may be disputed by the parties opposing upon the hearing of the petition. (*d*)

Where the patentee resides abroad, and the manufacture of the patented article is carried on under licenses, the advertisements should be inserted in papers circulating where the manufacture is actually carried on. (*e*)

Where the advertisements were inserted in London papers only, a witness was allowed to be called to prove

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

(*b*) Rules of the Privy Council, cls. 2—4.

(*c*) *Erard's Patent*, 1 Webs. P. R. 559, n.; *Southworth's Patent*, *ib.* 486, n.; *Stafford's Patent*, *ib.* 564; *Wright's Patent*, *ib.* 576.

(*d*) Rules of the Privy Council, 2—4.

(*e*) *Derosne's Patent*, 2 Webs. P. R. 2.

that the patent apparatus was manufactured in London, and not elsewhere. (*a*)

To entitle an equitable assignee to appear with the legal assignee of a patent, his name must appear in the advertisements; and if it does not his counsel will not be heard. (*b*)

The advertisements must be proved before the case is heard. (*c*)

Documents to be lodged at Privy Council office.

The applicant must lodge at the Privy Council office six printed copies of the specification and also four copies of the balance sheet of expenditure and receipts, relating to the patent, which accounts are to be proved at the hearing. If the specification has not been printed, and if the expense of making six copies of any drawing would be considerable, the lodging of two copies only of such specification and drawing will be deemed sufficient. All copies must be lodged not less than one week before the day fixed for hearing the application. (*d*)

Delay in filing

The Court will refuse to enter upon accounts if they have not been filed as required. (*e*)

Where owing to the mistake of the petitioner's agent the petition was not filed within the prescribed time, the petition was allowed to be filed on a special application being made. (*f*)

The petition.

Everything relating to the title of the petitioner must be fully and fairly stated in the petition. (*g*) Where the

(*a*) *Perkins' Patent*, 2 Webs. P. R. 8, n.

(*b*) *Noble's Patent*, 7 Moo. P. C. C. 191.

(*c*) *Perkins' Patent*, 2 Webs. P. R. 8.

(*d*) Rules of the Privy Council, cl. 9.

(*e*) *Johnson and Atkinson's Patent*, L. R. 5 P. C. 87.

(*f*) *Hutchison's Patent*, 14 Moo. P. C. C. 364.

(*g*) *Hutchison's Patent*, 14 Moo. P. C. C. 364; *Johnson's Patent*, L. R. 4 P. C. 83.

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petitioner omitted to state that the patent was in fact a communication from a foreigner living abroad, who had previously taken out a patent for the same invention in America, and that the American patent had expired but had been renewed, the application was refused.(*a*)

Assignees must state their title strictly.(*b*)

Amendment.

Where material facts relating to the petitioner's title were omitted, the hearing of the petition was adjourned with leave to amend.(*c*)

Caveats.

Any person may enter a *caveat* at the council office, and is entitled to be heard in opposition to the petition.(*d*) The *caveat* must be entered before the day on which the petitioner has advertised his intention of applying for a day to be fixed for the hearing. Any person entering a *caveat* is entitled to four weeks' notice of the time appointed for the hearing, to be served with a copy of the petition, and no application to fix a time for hearing may be made without affidavit of such service. All parties served with petitions must lodge at the council office within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions.(*e*)

No person can be heard in opposition to an application for extension unless he has entered a *caveat*. Where a patent agent had entered a *caveat* in his own name, but in reality as the agent of several other persons as well as

(*a*) *Pitman's Patent*, L. R. 4 P. C. 84.

(*b*) *Wright's Patent*, 1 Webs. P. R. 561; *Galloway's Patent*, *ib.* 725.

(*c*) *Hutchison's Patent*, 14 Moo. P. C. C. 365.

(*d*) 5 & 6 Will. IV. c. 83, s. 4; *Lowe's Patent*, 8 Moo. P. C. C. 1.

(*e*) Rules of the Privy Council, cls. 2, 5, 6.

on his own behalf, it was held that his counsel could only be heard for him, and could only ask such questions as respected his interest. (*a*)

Any person who has rights under the patent which the patentee refuses to recognise on extension, may petition that no extension may be granted unless the patentee admits his rights. (*b*)

Any person entering a *caveat* is entitled to notice of any objection which would prevent the patent from being received. (*c*)

Opposition by Attorney-General.

The Attorney-General appears on behalf of the public generally, and is entitled to oppose, although no *caveat* has been entered. (*d*) In *Petitt Smith's Patent*, (*e*) an application by the Lords of the Admiralty to enter a *cavcat* and be heard against the petition, such *caveat* not having been filed within the time required by the rules was refused, on the ground that the Attorney-General represented the interests of the Crown as well as those of the public.

Two counsel only heard.

Unless parties opposing have distinct and separate interests, not more than two counsel will be heard to oppose. (*f*)

Inspection of accounts not compelled.

The Court will not on an application under 14 & 15 Vict. c. 99, s. 6, which gives the Courts of Common Law power to compel inspection of documents on application by either party, and to investigate all documents in the custody or control of the other, and to take and examine

(*a*) *Lowe's Patent*, 8 Moo. P. C. C. 1.

(*b*) *Normandy's Patent*, 9 Moo. P. C. C. 452.

(*c*) *Hutchison's Patent*, 14 Moo. P. C. C. 365.

(*d*) *Petitt Smith's Patent*, 7 Moo. P. C. C. 133; *Erard's Patent*, 1 Webs. P. R. 557 n.

(*e*) 7 Moo. P. C. C. 133.

(*f*) *Woodcroft's Patent*, 3 Moo. P. C. C. 172.

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copies of the same, compel a petitioner to allow the opponents to inspect his accounts.(*a*)

Evidence.

As the proceedings before the Judicial Committee are in substitution for a Bill in Parliament, the Court follows a similar course to that which would be followed by Parliament, and adopts rules of evidence as nearly as possible resembling the rules of evidence in courts of law.(*b*)

Costs.

Costs will not be given to the opposers where there is no ground for opposition.(*c*) Where there was some conflict of opinion on the part of scientific witnesses as to the merits of the invention, costs were refused although extension was granted.(*d*)

Costs will be given to all opposers, if the petition is abandoned upon the hearing,(*e*) and it is not necessary that the opposers should serve the petitioners with notice of their intended application to the Court for costs.(*f*)

Where the petition has been heard and is dismissed, the opposers are generally given their costs, for if costs were not given persons would be discouraged from coming to protect the interests of the public.(*g*) But costs will not be given where the opposition has not been properly conducted, as where the opposers caused expense by relying on irrelevant evidence, and produced

(*a*) *Bridson's Patent*, 7 Moo. P. C. C. 500.

(*b*) 1 Webs. P. R. 557.

(*c*) *Downton's Patent*, 1 Webs. P. R. 567.

(*d*) *Galloway's Patent*, 1 Webs. P. R. 129.

(*e*) *Mackintosh's Patent*, 1 Webs. P. R. 739; *Bridson's Patent*, 7 Moo. P. C. C. 499; *Hornby's Patent*, *ib.* 503; *Milner's Patent*, 9 Moo. P. C. C. 39.

(*f*) *Bridson's Patent*, 7 Moo. P. C. C. 499.

(*g*) *Westrupp and Gibbins' Patent*, 1 Webs. P. R. 556; *Wield's Patent*, L. R. 4 P. C. C. 92.

witnesses who were not credible.(*a*) Where there are several opposers who really represent the same kind of opposition, a gross sum will be allowed for costs to be apportioned between them, unless the petitioner prefers within a certain time to tax the costs of all parties.(*b*)

Where patentees neglected to obtain new letters patent in pursuance of an order in council and a petition was presented to revoke the order and to recall the warrant to seal, and it did not appear that the petitioner or the public had suffered any loss by the laches of the patentee; the Judicial Committee, though they did not consider the delay sufficient to deprive the patentee of all benefit of the renewed patent, made it a condition before dismissing the petition, that the patentees should pay the petitioner £200 for costs, and give an undertaking not to prosecute for any infringement which might have occurred from the date of the order in council to the date of the dismissal of the petition.(*c*)

(*a*) *Honiball's Patent*, 9 Moo. P. C. C. 394.

(*b*) *Milner's Patent*, 9 Moo. P. C. C. 39; *Jones' Patent*, *ib.* 41; *Hill's Patent*, 1 Moo. P. C. C. (N. S.) 271; *Johnson's Patent*, L. R. 4 P. C. 79; *Wield's Patent*, *ib.* 93.

(*c*) *Re Schlumberger*, 9 Moo. P. C. C. 1.

CHAPTER IX.

OF CONFIRMATION OF THE TERM OF LETTERS PATENT.

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Publication unknown to patentee.

IT occasionally happens that there has been a previous publication of an invention for which letters patent have been taken out, and that such publication is unknown to the patentee. The patent is nevertheless void, as has already been seen, for want of novelty. In many cases formerly the patentee suffered great hardship by the operation of this rule. The majority of patents are for improvements on some existing machine, and it often happened that persons having the improvement of the same machine in view carried it out by the same means. In order to provide a remedy for this state of things, it was provided by the 5th & 6th Will. IV. c. 83, s. 2, that "if in any suit or action it shall be proved or specially found by the verdict of the jury that any person who shall have obtained letters patent for any invention or supposed invention was not the first inventor thereof, or some part thereof, by reason of some other person or persons having invented or used the same or some part thereof before the date of such letters patent, or if such patentee or his assignees shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof before the date of such letters patent, it shall and may

5 & 6 Will. IV. c. 83, s. 2.

Mode of proceeding where the patentee is not the real inventor, though he believed himself to be so.

be lawful for such patentee or his assigns to petition his Majesty in Council to confirm the said letters patent or to grant new letters patent, the matter of which petition shall be heard before the Judicial Committee of the privy council; and such committee upon examining the said matter and being satisfied that such patentee believed himself to be the first and original inventor, and being satisfied that such invention, or part thereof, had not been publicly and generally used before the date of such first letters patent, may report to his Majesty their opinion that the prayer of such petition ought to be complied with, whereupon his Majesty may, if he think fit, grant such prayer; and the said letters patent shall be available in law and equity to give such petitioner the sole right of using, making and vending such invention as against all persons whatsoever, any law, usage or custom to the contrary notwithstanding: Provided that any person opposing such petition shall be entitled to be heard before the said Judicial Committee: Provided also, that any person, party to any former suit or action touching such first letters patent shall be entitled to have notice of such petition before presenting the same."

Intention of statute.

The intention of the statute is that the patentee may, if circumstances render it fitting in the judgment of the Judicial Committee, be protected against any prior invention not publicly or generally used, where he has no reason to believe that such prior invention existed, and it confers the power of giving to the patentee that which he did not possess before the passing of the statute, or in other words, of curing that which before the statute would have constituted an invalidity. If the patent were valid by law as it existed before the passing of the statute, it could hardly be necessary to confirm it. The

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case to be remedied is not that of a patentee discovering a prior invention, so known that the patent might be invalidated on that ground, though not publicly and generally used. The statute was framed to protect against circumstances which constituted an invalidity, though the patentee had so far as his knowledge went every reason to believe himself to be the original inventor. (*a*)

When application to be made.

An application for confirmation should be made as soon as possible after the patentee becomes aware that there has been a previous publication.

Powers of the Judicial Committee.

The power of the Judicial Committee to confirm letters patent is discretionary, (*b*) and will be very cautiously exercised, (*c*) as the effect of it is to supersede the ordinary rules of law at the expense of the public in favour of an individual, 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 the public generally, but the first and original inventor, who has actually brought it into public though not into general use before the first patent was taken out. (*d*)

What patentee must prove.

The patentee must prove to the satisfaction of the Judicial Committee that he believed himself to be the first and original inventor at the time that he took out his patent, (*e*) and also that at that time the patent was not publicly and generally used. (*f*)

(*a*) *Stead's Patent*, 2 Webs. P. R. 146.

(*b*) *Westrupp and Gibbins' Patent*, 1 Webs. P. R. 555; *Stead's Patent*, 2 Webs. P. R. 146.

(*c*) *Card's Patent*, 6 Moo. P. C. C. 213.

(*d*) *Honiball's Patent*, 9 Moo. P. C. C. 378.

(*e*) *Card's Patent*, 6 Moo. P. C. C. 213; *Honiball's Patent*, 9 Moo. P. C. C. 378; *Stead's Patent*, 2 Webs. P. R. 146.

(*f*) *Honiball's Patent*, 9 Moo.

In *Heurteloupe's Patent* (*a*) it was discovered that a patent had been granted in France to one L. de Valdahon, for an invention, part of which was similar to the petitioner's invention, but it had never been known in England, otherwise than by a description in a book published in France, a copy of which was in the British Museum. Notice of the day of hearing was directed to be given to L. de Valdahon, and on an affidavit that such notice had been sent through the Post Office, directed to Paris, confirmation was recommended.

An action for infringement not sustainable before petition heard.

A person who desires to have his patent confirmed ought not, before his petition is heard, to bring an action for infringement, as the two proceedings are contradictory: the one admits the invalidity of the patent, the other seeks relief because a valid patent is infringed. (*b*)

Invention must have been abandoned.

When it was proved that the invention for which the patent had been granted had been known before the date of the letters patent, and was being used at the time when the application for confirmation was made, Lord Campbell said, that the case which the legislature had in view when this enactment was passed was, that where there had been an invention which had been actually practised but which had not continued to be practised, the patent should not be rendered invalid by those abortive attempts, but that where the invention was carried on before the patent was granted, was considered beneficial by those who carried it on, was proved to be beneficial by them had never been abandoned and was carried on by them down to the time when the application was made, the Act

P. C. C. 378; *Lamenaude's Patent*, 2 Webs. P. R. 171; *Stead's Patent*, 2 Webs. P. R. 146.

(*a*) 1 Webs. P. R. 553.

(*b*) *Stead's Patent*, 2 Webs. P. R. 147.

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was never intended to apply; and the application was refused. (*a*)

Confirmation not granted adversely to rights of former patentee.

Where an application was made by an assignee to confirm letters patent for "improvements in an apparatus for converting sea water or otherwise impure water into fresh and pure water" and it was stated in the petition that it had been discovered since the date of the assignment that one of the modes of condensing steam from sea water was known but not publicly or generally known or used, and the affidavit in support of the petition stated that the patentees believed that they were the true and first inventors, the application was opposed on the ground that part of the invention had been published many years before the patent in a well-known book and had also been the subject of a patent. Two specifications were produced in support of this allegation. It was also contended that the petitioner ought to have disclaimed that part of the invention which was old. Lord Lyndhurst said that he did not think that the Act was ever intended to apply to the case where the patentees chose to shut their eyes when they might have gone to the office and seen the specifications. That the Act could never be meant to apply to a case where two patents had been taken out for the same thing, the subsequent patentee should have a right to come to the court to apply to have the exclusive benefit of the invention adversely to the rights and interests of the former patentee; and the petition was dismissed with costs. (*b*)

Extended term may be confirmed.

As the grant of an extended term is a new grant by

(*a*) *Card's Patent*, 6 Moo. P. C. C. 206; *Lamenaude's Patent*, 2 Webs. P. R. 171; *Honiball's Patent*, 9 Moo. P. C. C. 378.

(*b*) *Westrupp and Gibbins' Patent*, 1 Webs. P. R. 554.

new letters patent, subject to the same conditions and open to the same objections as the original letters patent, it is entitled, in ordinary cases at least, to the same advantages as the original letters patent and may therefore be confirmed. (*a*)

Scotch patent.

The user in England of an invention prior to the date of a Scotch patent will invalidate the patent, and such a patent cannot be confirmed. (*b*)

Mode of procedure on petition for confirmation of letters patent.

The mode of procedure on a petition for confirmation of letters patent is similar to that on a petition for extension. (*c*) The petition must be directed to Her Majesty in Council, and must state the patent, the specification, and if the applicant is an assignee, the assignment under which he derives his title. (*d*) If the name of the first inventor is known it should be stated in the petition and he should be served with notice in order that he may appear to oppose if he thinks fit. (*e*) The petition must state all the facts on which the plaintiff relies, and must be verified by affidavit.

Evidence.

In *Stead's Patent* (*f*) two petitions had been presented, the second being supplementary to and stating what had taken place subsequent to the presentation of the first. The affidavits made by the petitioner in support of the first petition gave a general history of his invention of the communication from abroad on which it was founded, and of his attempts to introduce it into use in this country; and those in support of the second petition stated pro-

(*a*) *Honiball's Patent*, 9 Moo. P. C. C. 387.

(*b*) *Robinson's Patent*, 5 Moo. P. C. C. 65; S. C. *nom. Pow's Patent*, 2 Webs. P. R. 5.

(*c*) See *ante*, p. 213.

(*d*) *Westrupp and Gibbins' Patent*, 1 Webs. P. R. 544.

(*e*) *Lamenaude's Patent*, 2 Webs. P. R. 164.

(*f*) 2 Webs. P. R. 143.

ceedings at law which had taken place since the presentation of the first petition, the publications adduced at the trial as impeaching the novelty of the invention and the petitioner's title. It was objected that the affidavits could not be received as proof of the matters contained in them, the intention being that they should be received in addition to other evidence, because the applicant having made a good case might be the only person who knew the real case; but it was held that the affidavits were admissible and that the opposers might prove their case by other evidence.

CHAPTER X.

OF ASSIGNMENTS AND LICENCES.

Power to assign and grant licences given by the letters patent.

LETTERS patent are granted to the patentee, his executors, administrators and assigns; there is therefore an implied power of assignment. The letters patent usually contain a clause restricting all persons from making, or using, or vending the patented invention, without the consent, licence, or agreement in writing of the inventor, his executors, administrators or assigns, under his or their hands and seals, first had and obtained in that behalf.

By 15 & 16 Vict. c. 83, s. 35, it is provided that the grantee or grantees of letters patent may assign the letters patent for England, Scotland, or Ireland respectively, as effectually as if the letters patent had been originally granted to extend to England or Scotland or Ireland only, and that the assignee or assignees shall have the same rights of action and remedies, and shall be subject to the like actions and suits, as he or they should and would have had, and been subject to, upon the assignment of letters patent granted to England, Scotland or Ireland, before the passing of the Act.

More than twelve persons may have a legal and beneficial interest in letters patent. (*a*)

Partnership.

The mere fact that a patent has been taken out by

(*a*) 15 & 16 Vict. c. 83, s. 36.

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several persons jointly will not of itself constitute a partnership. Any one of the grantees may use the invention without the consent of the others, and cannot be compelled to become jointly concerned in the working of the patent, and the profit or loss arising therefrom, nor to concur with his co-proprietors in granting licences to others to use it. But if the co-proprietors agree to work the patent together jointly, the relation of partners may be created.

An agreement to advance a sum of money for the purposes of the invention will not constitute a partnership. In *Elgie* v. *Webster*,(*a*) the plaintiff by an agreement in writing agreed to lend the defendant (an inventor), a sum of money, in order to enable him to perfect his invention, and it was also agreed that if the invention was accomplished, and became of public or private use, the defendant should be entitled to one-third part or share of the same, and of all benefit and advantage, and emoluments to arise or be made therefrom, both for public or private use. The agreement contained an express promise on behalf of the defendant to repay the sum of money advanced by the plaintiff. It was objected on behalf of the defendant that the effect of the agreement was to constitute a partnership between the contracting parties, and to prevent their suing each other in respect of the matters contained in the agreement, but it was held in an action brought to recover the money thus advanced, that this agreement did not constitute a partnership between the parties.

There may be a partnership for working a particular patent,(*b*) or for working it in a particular place.(*c*)

(*a*) 5 M. & W. 518.

(*b*) *Lovell* v. *Hicks*, 2 Y. & C. 481.

(*c*) *Ridgway* v. *Phillip*, 1 C. M. & R. 415.

An admission by any person that he is a partner is evidence against him, but is not conclusive, and he may show that he has only a limited interest. Thus where A, a patentee, informed B, who had entered into a contract with him, that C was his partner, which C admitted; on an action by B against A and C for breach of the contract, C was allowed to prove his limited interest. Parke, B., said: "It frequently happens in cases where the liability of persons as partners comes in question, that juries are induced to give too much effect to slight evidence of admissions. An admission does not estop the party who makes it; he is still at liberty, so far as regards his own interest, to contradict it by evidence. (*a*) It appears that joint owners of a patent are answerable for losses occasioned by their co-adventurers only to the extent of their respective shares. (*b*)

Agreement for assignment.

A declaration stated that a petition had been presented by the plaintiffs at the request of the defendants, and at their own expense, for the granting to the defendant of a patent; and that the plaintiffs then duly filed at their own expense the provisional specification, and obtained provisional protection, upon condition that the defendant should complete the specification within six months. And that by an agreement in writing made between the plaintiffs and defendants, it was mutually agreed that the defendant should sell to the plaintiffs his patent rights for the sum of £5, such sum to be paid by the plaintiffs to the defendant on their having completed the patent at their own expense; that thereupon it became necessary in order to enable the plaintiffs to complete the patent

(*a*) *Ridgway* v. *Phillip*, 1 C. M. & R. 415.

(*b*) *Lovell* v. *Hicks*, 2 Y. & C. 46.

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in pursuance of the agreement, that the defendant should sign and seal a complete specification; and that the plaintiffs tendered him the necessary specification for his signature. Breach that he would not sign it. It was held that the defendant was bound under this agreement to sign the specification. (*a*)

Statute of Frauds.

A written proposal containing the terms of a proposed contract signed by the defendant and assented to by the plaintiff by word of mouth, is a sufficient agreement within the 4th section of the Statute of Frauds. (*b*)

An agreement, whereby all that is to be done by the plaintiff constituting one entire concession for the defendant's promise, can be performed within a year, and no part is intended to be postponed until after the expiration of the year, is not within the section, although the performance on the part of the defendant is or may be extended beyond that period. (*c*)

Assignment should be by deed.

An assignment ought to be by deed under hand and seal. The patentee should covenant that he is the true and first inventor, and that the patent is valid. He should also covenant that he will assist the assignee in the case of an application for confirmation.

A grant of a patent, reserving the patentee's legal title until the determination of a suit then pending, with a covenant that the grantor would upon the determination of the suit assign the patent, was held to vest the legal estate in the patentee without assignment as soon as the suit was determined. (*d*)

Must be according to conditions of patent.

Any agreement to assign a patent which is contrary to

(*a*) *Lewin* v. *Brown*, 14 W. R. 640.

(*b*) *Smith* v. *Neale*, 2 C. B. (N. S.) 67.

(*c*) *Ib.*

(*d*) *Cartwright* v. *Amatt*, 2 B. & P. 43.

the policy of the conditions upon which the patent is granted, is void. Thus where a bond was given for payment of £10,000 with a condition that the money should be paid on the obligee's procuring subscriptions for 9,000 shares in a company 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, it was held that as the bond was subject to a condition for the performance of an illegal act, it was void. Lord Tenterden, C. J., said: "Now it is said that the plaintiff might be ignorant that such a consequence would follow: but on this record we cannot find grounds for supposing he was ignorant. If he was not cognisant of the terms of these particular patents, he must be supposed to know the general law of the land. By that all monopolies are illegal, but there is an exception in favour of patent rights, and if he knew that the monopoly proposed to be created could only be justified by the patents, he was bound to know their contents. We cannot presume that he was ignorant of that which it was his duty to know, and presuming that he knew the terms of the patent, the bond is void." (*a*)

Bankruptcy of patentee.

The interest of a bankrupt in a patent passes to his assignees. (*b*) Where by a private act of parliament, the sole making of a newly-invented machine was vested in certain persons, with a proviso that it should be forfeited in case it should "become vested in trust for more than five persons or their representatives, otherwise than by devise or succession," and two of the patentees became bankrupt, it was held that the assignment of their in-

(*a*) *Duvergier* v. *Fellows*, 10 B. & C. 829.

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

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terest to their assignees, though the number exceeded twenty, was not within the proviso. (*a*)

Tenants in common or *joint tenants.*

It seems doubtful whether when a patent is vested in trustees upon trust for several tenants in common, or joint tenants, any one of them is at liberty to work it on his own account. (*b*) But where two or more persons jointly obtain letters patent, any one of them may use the invention without the consent of the others. (*c*)

Licence may be by verbal agreement.

A verbal agreement that a patentee shall supply machines constructed according to his patent to any person constitutes a licence. (*d*)

Need not be under seal.

A licence will not apparently be void if it is not under seal, so long as it is such a licence as the licensee has bargained for, and he has kept it, (*e*) and *semble* that a licence does not require a stamp if there is no pecuniary consideration. (*f*)

Includes all the privileges of a vendee.

A licence to manufacture and sell necessarily includes all the privileges that a vendee can have, including that of selling again without the consent of the patentee. (*g*) It does not convey an interest in the patent, it is an excuse for an infringement. (*h*)

In *Lister* v. *Leather* (*i*) it was argued that if a subsequent patent for a combination includes a part of an invention already protected by patent, it infringes on the

(*a*) *Bloxam* v. *Elsee*, 6 B. & C. 169; *M'Alpine* v. *Mangnall*, 3 C. B. 491.

(*b*) *Hancock* v. *Bewley*, Johns. 601.

(*c*) *Mathers* v. *Green*, L. R. 1 Ch. 29. See too *Re Russell*, 2 De G. & J. 130.

(*d*) *Crossley* v. *Dixon*, 10 H. L. C. 293.

(*e*) *Chanter* v. *Dewhurst*, 12 M. & W. 823.

(*f*) *Chanter* v. *Johnson*, 14 M. & W. 408.

(*g*) *Thomas* v. *Hunt*, 17 C. B. (N. S.) 183.

(*h*) *Bower* v. *Hodges*, 13 C. B. 774.

(*i*) 8 El. & Bl. 1017.

property of another, and so is a violation of his right, and ought to be held illegal on account of his interest. Lord Campbell said that the answer was, "that the patent for an improvement on an invention already the subject of a patent, if confined to the improvement, is not an infringement of the former patent. The use of the improvement with the former invention, during the existence of the former patent, would be an infringement, but with licence that would be lawful." (*a*)

Exclusive licence.

The grant of an exclusive licence 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 licence is vested, whether exclusive or not, and such a licence would not be invalid, if the districts or district covered by the licence included the whole extent of the patent. (*b*)

Manufactory abroad.

Where the patentee has a manufactory abroad as well as one in England, and disposes of the patented article abroad, he necessarily transfers with the goods the licence to use them wherever the purchaser pleases, unless there is some clear agreement to the contrary. But if he has assigned his patent in either country, he cannot sell the articles so as to defeat the rights of the assignees. (*c*)

No implied warranty on sale or licence.

There is no implied warranty upon an agreement for the sale of or licence to use a patent, that the patent is valid, and it is no answer to an action that the invention is not new, and that the plaintiff is not the true and first inventor.

In *Hall* v. *Conder* (*d*) the declaration stated, that by an agreement, made between the plaintiff and the defendants,

(*a*) See p. 53.

(*b*) *Protheroe* v. *May*, 5 M. & W. 675.

(*c*) *Betts* v. *Willmott*, L. R. 6 Ch. 239.

(*d*) 2 C. B. (N. S.) 22.

after reciting that the plaintiff had invented a method for the prevention of boiler explosions, and had obtained a patent for the use of the same within the United Kingdom, and was desirous of taking out patents in France, Belgium, and such other places as might be found expedient; and that he had already parted with or assigned away an interest in one-half of the said English patent, and was desirous of disposing of the remaining half, to which he declared he had full right and title; and that he had applied to the defendants to assist him in taking out the foreign patents, and also to purchase his interest in the English patent; it was agreed that the defendants should take out the foreign patent, and should pay to the plaintiff the sum of £2,500 in such manner as should be mutually agreed upon, and a further sum equal to one tenth part of the net proceeds of one-half of the English patent, from and after the time that the net profits should amount to the sum of £20,000. And in consideration of the engagement on the part of the defendants, the plaintiff agreed to transfer to them one-half of the foreign patents when the same should be obtained, and also one-half of the English patent.

It was contended, among other things, that the invention was wholly worthless and of no public utility and was not new as to the public use and exercise thereof in England, and that the plaintiff was not the true and first inventor. Williams, J., said: "With regard to the sale of ascertained chattels, it has been held that there is not any implied warranty of either title or quality unless there are some circumstances beyond the mere fact of a sale from which it may be implied. . . . In this case the thing sold was ascertained, viz. a moiety of a patent granted by

Her Majesty; there was no express warranty, and whether it be said that the question raised on this plea impeaches the plaintiff's title to the thing sold, or its quality, no warranty can be implied. But did the plaintiff profess to sell and the defendant to buy a good and indefeasible patent right? or was the contract merely to place the defendant in the same situation as the plaintiff was in with reference to the alleged patent? . . . The plaintiff professed to have invented a method for the prevention of boiler explosions. It is not alleged that he was guilty of any fraud. He must therefore have been an inventor; for, if he was not he must have known it, and would have been guilty of fraud in pretending to have invented. Whether he was the true and first inventor within the meaning of the statute of James is another question. The first material allegation in the plea is that the alleged invention was wholly worthless and of no utility to the public. Now, that was a matter as much within the knowledge of the defendants as of the plaintiff. The next allegation, viz. that it was not new as to the public use thereof in England, and that the plaintiff was not the true and first inventor, was also a matter as much within the knowledge of the defendants as of the plaintiff. They had the same means of inquiring into the fact and of learning whether it had been in use or the invention had been previously made known in England. Why, therefore, should we assume that the plaintiff meant to assert that the patent was indefeasible and that the defendants purchased on that understanding rather than that, each knowing what the invention was, and having equal means of ascertaining its value, they contracted for the patent, such as it was, each acting on his own judgment?

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We think that the latter was the true nature of the contract and that there was no warranty, express or implied." (*a*)

Failure of consideration.

The payment of a sum of money for a continuation of a licence to use a patent about to expire, on prolongation of the term being obtained, gives the licensee a right to require an application for prolongation of the patent to be made, not merely to have the benefit of the prolongation if it is granted, and the licensee, if no application is made, will be entitled to maintain an action for the recovery of the money so paid, on the ground that the consideration has wholly failed. (*b*)

Money paid for use of void patent cannot be recovered.

A licensee cannot, if he discovers that the patent is void, recover back money paid for its use. Thus, where a licence was granted in consideration of an annuity secured by bond, which was paid for several years, and it was then discovered that the invention had been in public use before the patent, unknown to the patentee when he granted the licence, it was held that the licensee could not recover back the money he had paid on account of the annuity. Sir J. Mansfield, C. J., said: "Two persons equally innocent make a bargain about the use of a patent, the defendant supposing himself to be in possession of a valuable patent right and the plaintiff supposing the same thing. Under these circumstances the latter agrees to pay the former for the use of the invention, and he has the use of it; *non constat*, what advantage he made of it; for anything that appears he may have made considerable profit. These persons may be considered

(*a*) See also *Smith* v. *Neale*, 2 C. B. (N. S.) 67; *Smith* v. *Scott*, 6 C. B. (N. S.) 771; *Noton* v. *Brooks*, 7 H. & N. 499; *Trotman* v. *Wood*, 16 C. B. (N. S.) 479.

(*b*) *Knowles* v. *Borill*, 22 L. T. (N. S.) 70.

in some measure as partners in the benefit of this invention;" and Heath, J., said: "We cannot take an account here of the profits. It might as well be said, that if a man lease land and the lessee pay rent, and afterwards be evicted, that he shall recover back the rent, though he has taken the fruits of the land."(a) But if money is paid for the use or purchase of a patent which has been obtained by fraud it can be recovered."(b)

Unless there is fraud.

A patentee, after he has parted with his interest in the patent is estopped from contesting its validity and cannot contend that he had no title to convey.(c) Nor can a licensee by deed refuse to pay royalties or contend that the patent is invalid on the ground of want of novelty or utility in the invention; for the principle of estoppel is that where a man has entered into a solemn engagement by deed, under his hand and seal, as to certain facts, he shall not be permitted to deny any matter which he has so asserted,(d) even if the patent has been found invalid at law upon proceedings between the patentee and third parties,(e) and the principle applies even if no formal licence has been executed, but royalties have been paid.(f) But he may refuse to continue the use of the patent and

Estoppel.

(a) *Taylor* v. *Hare*, 1 Bos. & P. (N. R.) 260.

(b) *Lovell* v. *Hicks*, 2 Y. & Coll. 46.

(c) *Oldham* v. *Langmead*, 3 T. R. 441; *Hall* v. *Conder*, 2 C. B. (N. S.) 22; *Walton* v. *Lavater*, 8 C. B. (N. S.) 162; *Chambers* v. *Crichley*, 33 Beav. 374.

(d) *Bowman* v. *Taylor*, 2 A. & E. 291; *Baird* v. *Neilson*, 8 C. & F. 726; *Hills* v. *Laming*, 2 Exch. 256; *Noton* v. *Brooks*, 7 H. & N. 499; *Smith* v. *Scott*, 6 C. B. (N. S.) 771; *Lawes* v. *Purser*, 6 E. & B. 930; *Besseman* v. *Wright*, 6 W. R. 719.

(e) *Grover and Baker Sewing Machine Co.* v. *Millard*, 8 Jur. (N. S.) 713.

(f) *Crossley* v. *Dixon*, 10 H. L. C. 293.

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to make any future payments; (*a*) and after the licence has determined he may contest the validity of the patent. (*b*) A purchaser or licensee may set up the defence that the patent is bad on the ground that it was obtained by fraud. (*c*)

If the claim in the specification is susceptible of two constructions, one of which would make the specification bad, and the other would make it good, a licensee may insist that the latter is the true construction. (*d*) If he use the patented invention in other machines obtained from another quarter, he cannot contest the validity of the patent, but only that the other machines did not embody its principle. (*e*)

Where in an action for infringement against the members of a partnership firm, the defendants submitted to judgment before any pleadings filed and immediately took a licence from the plaintiff to use his invention for a term of five years; in a suit in equity to restrain the original defendants and two new partners from infringing the patent; it was held that they were not estopped from contesting the validity of the patent. (*f*) An agreement to purchase a licence to use a patent will not in equity preclude the purchaser from disputing its validity. (*g*)

(*a*) *Hayne* v. *Maltby*, 3 T. R. 438; *Neilson* v. *Fothergill*, 1 Webs. P. R. 287; *Pidding* v. *Franks*, 1 Mac. & G. 56.

(*b*) *Dangerfield* v. *Jones*, 13 L. T. (N. S.) 144.

(*c*) *Hayne* v. *Maltby*, 3 T. R. 441; *Hall* v. *Conder*, 2 C. B. (N. S.) 22; *Lawes* v. *Purser*, 6 E. & B. 930; *Pidding* v. *Franks*, 1 Mac. & G. 56.

(*d*) *Trotman* v. *Wood*, 16 C. B. (N. S.) 479.

(*e*) *Crossley* v. *Dixon*, 10 H. L. C. 293.

(*f*) *Goucher* v. *Clayton*, 11 Jur. (N. S.) 107.

(*g*) *Baxter* v. *Combe*, 1 Ir. Ch. 284; *Pidding* v. *Franks*, 1 Mac. & G. 56.

If a licensor waives any right to forfeit the licence by reason of breaches in the terms, he will not be entitled to an injunction to restrain the licensee from using the patent.(*a*) A covenant by the licensee of a patent for the residue of the term, that he will not make or use any of a certain class of machines without the patented invention applied to them is not void as a covenant in restraint of trade, for the restraint is not greater than the privilege.(*b*)

Waiver by licensor.

Covenant to use patented invention only.

The sale of a moiety of a patent right conveys an interest *pro tanto* in the patent.(*c*)

Sale of moiety.

(*a*) *Warwick* v. *Hooper*, 3 Mac. & G. 60.

(*b*) *Jones* v. *Lees*, 1 H. & N. 189.

(*c*) *Walton* v. *Lavater*, 8 C. B. (N. S.) 162.

CHAPTER XI.

OF REGISTRATION.

Register of proprietors kept at office.

A REGISTER of proprietors of patents is kept at the office, in which is entered assignments of letters patent, licences and other matters affecting their proprietorship, certified copies of entries are received in evidence, and are *primâ facie* proofs of assignment. But until such entry as is directed by the Act is made, the grantee is deemed to be the exclusive proprietor of the letters patent, and of all licences and privileges connected with them. (*a*)

Registration relates back to day of assignment.

The registration relates back to the day of assignment so as to enable an assignee to maintain an action for an infringement committed between the date of the assignment and of the registration, (*b*) and an assignee who has not registered his deed of assignment cannot maintain an action, (*c*) but where there has been a *bonâ fide* assignment and the assignee has neglected to register, a subsequent assignee cannot, by prior registration, defeat the rights of the first assignee. (*d*)

Fraudulent entry in register.

Any person who wilfully causes a false entry to be made in the register, or who wilfully forges or causes to

(*a*) 15 & 16 Vict. c. 83, s. 35.

(*b*) *Hassall* v. *Wright*, 10 Eq. 509.

(*c*) *Chollett* v. *Hoffman*, 7 El. & Bl. 686.

(*d*) *Green's Patent*, 24 Beav. 145.

be forged any copy of any entry, or produces or tenders any such copy in evidence knowing it to be forged, is guilty of a misdemeanour. (*a*)

Expunging entries.

Any person aggrieved by any entry in the register of proprietors may apply by motion to the Master of the Rolls or to any of the Courts of Common Law for an order to expunge, vacate, or vary such entry. (*b*)

The Court has power to expunge any entry fraudulently made, while the right in the patent is in another person, and can direct any facts relating to the proprietorship to be placed on the register, it will not decide questions of rights and titles; those must be deduced from the facts that appear on the register by any person dealing with the patent. Thus when A assigned one-half of his patent to B on the 13th of January, 1851, but B did not register the assignment till the 5th of August, 1857, and in the mean time A assigned the whole of his patent to C by a deed registered the 21st of June, 1853, which by recital excepted a licence to work and use granted to B, it was held that C had constructive notice of B's rights, and an entry was ordered to be made in the register that the licence referred to in C's assignment was the deed of assignment to B subsequently registered. (*c*)

Joint grantees may not prejudice each others' rights by entries.

Where letters patent are granted to two persons jointly neither of them is entitled to cause any entry to be made in the register which purports to affect or prejudice the rights of the other. Thus where one of two joint grantees assigned his share in the patent by deed and purported to release the assignee from all claims by either of the patentees in respect of the patent, and this

(*a*) 15 & 16 Vict. c. 83, s. 37.
(*b*) *Ib.*
(*c*) *Morey's Patent*, 25 Beav. 581. And see *Green's Patent*, 24 Beav. 145.

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deed was entered on the register *verbatim*; it was held that the non-assigning patentee was entitled to have the whole entry expunged.(*a*)

No appeal from Master of the Rolls.

There is no right of appeal from an order made by the Master of the Rolls under this section.(*b*)

Copies of entries.

Certified copies of all entries made in the register of proprietors are sent to Edinburgh and Dublin.(*c*)

(*a*) *Horsley and Knighton's Patent*, L. R. 8 Eq. 475.

(*b*) *Horsley and Knighton's Patent*, L. R. 4 Ch. 784.

(*c*) 15 & 16 Vict. c. 83, s. 35.

CHAPTER XII.

OF INFRINGEMENT.

Use of invention for profit is infringement.

ANY person who directly or indirectly uses a patentee's invention for the purposes of profit without his licence is guilty of an act of infringement. An infringement, said Sir N. C. Tindal, C.J., is a copy made after and agreeing with the principle laid down in the specification. (*a*)

Colourable difference only will be infringement.

A slight departure from the patentee's specification for the purpose of evasion only is of course a fraud upon the patent, and the question, therefore, that always arises, is, whether the mode of working by the person who is alleged to have committed the act of infringement has or has not been essentially or substantially different, (*b*) that is to say whether, in the case of a machine, the two inventions are the same or substantially the same mode of carrying the principle into effect, or accomplishing the object desired. In *Bovill* v. *Pimm* (*c*) the plaintiff's invention consisted in the application of ventilating vanes or screws at the centre of the stones for supplying the air between the grinding surfaces; a portable ventilating machine, blowing by a screw vane, which caused a current

(*a*) *Galloway* v. *Bleaden*, 1 Webs. P. R. 523.

(*b*) *Hill* v. *Thompson*, 8 Taunt. 491; 2 B. Moo. 433; 1 Webs. P. R. 242; *Stead* v. *Anderson*, 1 Webs. P. R. 155.

(*c*) 11 Exch. 739.

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of air parallel to the axis of the vane was attached externally to the eye of the upper millstone, and thus the screw vane being set in rapid motion, the air was compelled to pass through the eye into the centre of the stones and so find its way out again; the defendant distributed the air from the eye of the mill-stones, by means of an air box placed below them into which air was forced by the rapid rotation of a fan or 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 centre of the two stones and there distributed between them. It was held that the invention was no infringement of the plaintiff's; but that each was a new method of obtaining a well-known object by the common principle of obtaining a current of air by a rotating vane.

In *Walton* v. *Bateman*, (*a*) Cresswell, J., said that the "defendants are not to resemble a counterfeit; they are not to make any addition to or any subtraction from the patent, availing themselves of what is in truth the subject-matter of it, so as by such alteration to pretend that they are the true inventors of that article."

Substance of invention to be considered.

The substance and not the mere form of the invention is to be considered. (*b*)

In *Walton* v. *Potter* (*c*) Sir N. C. Tindal, C.J., said: "Where a party has obtained a patent for a new invention or a discovery he has made by his own ingenuity, it is not in the power of any other person simply by varying in form or in immaterial circumstances the nature or subject-matter of that discovery to obtain either a patent for it himself or to use it without the leave of the patentee,

(*a*) 1 Webs. P. R. 616.

(*b*) *Morgan* v. *Seaward*, 1 Webs. P. R. 171.

(*c*) 1 Webs. P. R. 586.

because that would be in effect and in substance an invasion of the right, and therefore what you have to look at upon the present occasion, is not simply whether in form or in circumstances that may be more or less immaterial, that which has been done by the defendants varies from the specification of the plaintiff's patent, but to see whether in reality, in substance, and in effect, the defendants have availed themselves of the plaintiff's invention in order to make that article which they have sold in the way of their trade; whether in order to make that they have availed themselves of the invention of the plaintiff." (*a*)

Where the patent is for an invention which consists in the use of certain proportions, the patentee is not bound to limit his claim to the precise proportions, and even if he does do so, a stranger will not be allowed to evade the patent by slightly varying the amounts used. (*b*)

Improvements by defendant no answer.

It is no answer to an action for the infringement of a patent that the defendants have greatly improved upon the machinery or apparatus constructed according to the plaintiff's specification. Thus where the plaintiff's patent was for the "improved application of air to produce heat in fires, forges and furnaces," and the invention consisted in heating the air between the time of its leaving the blowing apparatus and its introduction into the furnace in any way in any close vessel exposed to the action of heat, and it was proved that the defendants' apparatus was much superior to that of the plaintiff's but that the principle in both was the same, Parke, B., said: "If the specification is to be understood in the sense

(*a*) See also *Bateman* v. *Gray*, Macr. 102.

(*b*) *The Patent Type Founding Co.* v. *Richard*, Johns. 385.

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claimed by the plaintiff, the invention of heating the air between its leaving the blowing apparatus and its introduction into the furnace, in any way, in any close vessel, which is exposed to the action of heat, there is no doubt that the defendants' machinery is an infringement of that patent, because it is the use of air which is heated much more beneficially, and a great improvement upon what would probably be the machine constructed by looking at the specification alone; but still it is the application of heated air, heated in one or more vessels between the blowing apparatus and the furnace, and therefore if it should turn out that the patent is good, and the specification is good, though unquestionably what the defendants have done is a great improvement upon what would be the machinery or apparatus constructed under this patent, it appears to me that it would be an infringement of it."(*a*)

In *The Electric Telegraph Co.* v. *Brett*(*b*) the patentee's invention was described as an invention of "improvements in giving signals and sounding alarms in distant places, by means of electric currents transmitted through metallic circuits." The defendant used the earth as a return circuit by plunging the two ends of the wire into it, and it was held that such a circuit, if used in connection with the machinery for signals, would be an infringement, as the use of the earth was merely an equivalent for the return wire.

The substitution of a mechanical equivalent to attain the same result is an infringement.

Any person who in order to arrive at the same result aimed at by the plaintiff's patent substitutes for any portion of the patented invention which is new and

(*a*) *Neilson* v. *Harford*, 1 Webs. P. R. 310.

(*b*) 10 C. B. 838.

useful, some mechanical equivalent, so that his machine is only colourably different from that of the patentee, is guilty of an act of infringement. (*a*)

In *Webster* v. *Uther* (*b*) the invention consisted in an improvement on the patent percussion gunlock, by the addition of a bolt sliding or moving in a groove by which the roller magazine was then fixed, that had formerly been fastened by a screw and washer; the defendant's lock had a spring in the bolt, and the jury, upon the evidence of mechanics that a spring in a bolt was the same thing as a bolt sliding in a groove, found that there had been an infringement.

In *Bovill* v. *Moore*, (*c*) Gibbs, C. J., said, referring to the use of mechanical equivalents: "I remember that was the expedient used by a man in Cornwall, who endeavoured to pirate the steam engine. He produced an engine, which, on the first view of it, had not the least resemblance to Boulton and Watt's. Where you looked for the head you found the feet, and where you looked for the feet you found the head. But it turned out that he had taken the principle of Boulton and Watt—it acted as well one way as the other; but if you set it upright, it was exactly Boulton and Watt's engine."

"If," said Sir F. Pollock in *Sellers* v. *Dickinson*, (*d*) "a portion of a patent for a new arrangement of machinery is in itself new and useful, and another person, for the purpose of producing the same effect, uses that portion of the arrangement, and substitutes for the other matters combined with it another mechanical equivalent, that would be an infringement of the patent." (*e*) But the

(*a*) *Morgan* v. *Seaward*, 1 Webs. P. R. 171.

(*b*) Gods. 232.

(*c*) Dav. P. C. 405.

(*d*) 5 Exch. 326.

(*e*) And see *Harwood* v. *The*

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principle which protects a patentee against the use by others of mechanical equivalents is inapplicable to a case where the whole invention depends entirely on the particular machinery, by means of which a well known object is attained. (*a*)

Or chemical equivalent.

The substitution of a chemical equivalent in a process is an infringement. It is very difficult, however, to apply the doctrine of equivalents to a chemical process. In the case of mechanical equivalents, the result can be generally predicted with certainty; whereas, in the case of chemical equivalents, that is not so, and there may be such an amount of experiment required as to constitute a new discovery.

Although exactly the same materials may not be used in a similar process; yet if the same result is arrived at by the introduction of some step into the process, which is not absolutely necessary, and which is merely introduced for the purpose of evasion, this will be an infringement. Thus, where the plaintiff's invention consisted in making metal plates for sheathing the bottoms of ships, of an alloy of zinc and copper in certain proportions, and the specification stated that the invention was to be performed by melting "best selected copper" and "foreign zinc" together in certain propertions, and it was proved that the metal made at the defendant's works was, in fact, made of the same materials and in the same proportions as pointed out in the plaintiff's specification, Lord Lyndhurst said, that if the materials were originally combined in the same proportions, the infringement was clear; and that if other materials were purified in the

Great Northern Railway Co., L. R. 11 H. L. C. 654: *Bateman* v. *Gray*, Macr. 102.

(*a*) *Curtis* v. *Platt*, 35 L. J. (Ch.) 852.

course of manufacture, there would be a colourable imitation. (*a*)

An action was directed to be tried at law, to decide the title to the patent, when Sir N. C. Tindal, C. J., said: "Further, the plaintiff says (and that evidence is before you), that in the month of April, and when the mode of making it and the materials of which it was made were somewhat altered, that is, when, according to the testimony of defendant's witnesses, they used nothing but cake copper, and not the purest copper obtained from the regule of the copper, as the witnesses have stated, yet still it would be for you to say whether, if the very same effect and result is produced, it could have been produced in any other way than by some mode of altering the properties of the common cake copper; because there has been evidence brought before you that the cake copper would not produce the result, and be attended with those properties which the plaintiff has taken out his patent for; and, therefore, upon that second branch you will have to ask yourselves whether, seeing that which has been used, and the analysis of it, and the result of such analysis, and the mode in which the witnesses on the part of the defendants explained that it was carried on, stating certainly that nothing was used but the cake copper for that purpose; whether in the mode of using that cake copper, which before did not produce the result of the plaintiff's discovery, something or other must not have been managed or contrived on the part of the defendants to give it that purity which, if you are satisfied upon the evidence, it did not possess, it must have had through their instrumentality. If it

(*a*) *Muntz* v. *Foster*, 2 Webs. P. R. 93.

were so, that would be a contrivance, and an evasion of the direct letter and description of the patent. Although the patent describes the copper must be of the purest quality (and that seems to me to be the sense of the specification), yet, if persons could take an inferior kind of copper, and by dressing it up, and by some particular way of melting and refining it give it exactly the same effect as the best kind of copper would have done, it must be for you to say whether in that case they intended to imitate (as one branch of the declaration states they did) and to evade the patent which the other party had granted to him." (*a*)

In *Stevens* v. *Keating*, (*b*) the plaintiff claimed the manufacture of cement, or a composition equivalent to cement, by the union of gypsum, acid and alkali. The defendant claimed the manufacture of cement by combining gypsum, sulphate of lime, or other calcareous substances, with borax. On an application for an injunction Lord Cottenham said: "*Primâ facie* that may appear to be a very different thing, because till you come to examine what borax is, it may appear that borax is some substance totally different, and not within what the plaintiff discovered; that borax is a substance of itself which is capable by combination with gypsum of producing very hard cement; and that the patentee has no right to say, I am entitled to the exclusive privilege, because I claim the invention of uniting gypsum with acid and alkali. But then when we find that borax itself is composed of an acid and an alkali, where is the difference? If borax is an article used in the trade found

(*a*) *Muntz* v. *Foster*, 2 Webs. P. R. 101.

(*b*) 2 Webs. P. R. 176.

in a natural state, but used as an artificial composition, composed and compounded of an alkali and acid, is it not exactly the same thing as if the plaintiff had said, I claim as my invention to be the uniting with gypsum the acid and alkali found in borax? It is hardly a different mode of describing the same thing. He has adopted different language, but if the language conveys the same meaning, it is the same thing." An injunction was granted, the plaintiff being ordered to bring an action, which was tried before Sir F. Pollock, C. B., (*a*) who in summing up said: "The only point I have to leave to you is whether you think the defendant has infringed the first patent of the plaintiff by using boracic acid and soda, that is, in the shape of borax, instead of the pearlash, which is potash and sulphuric acid, the only alkali and only acid mentioned in the specification. . . . It has been said that this borax which the defendant uses is a chemical equivalent. I may say that I do not quite go along with the doctrine of equivalents in chemistry, applied in the same way as in mechanics, and those matters to which you can apply the principles of the exact sciences. If a man discovers a machine that can be successfully used to produce any effect, whether to print a newspaper, to make a stucco, to light an apartment, or to do any process whatever, it is well known that if he uses a crank there are two or three substitutes for a crank; if he use one mode of changing the direction of motion, there are three or four perfectly well known means of doing that; and if he puts in a specification describing his machine, and somebody comes and instead of a crank substitutes something else, or if instead

(*a*) 2 Webs. P. R. 182.

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of a pulley to change the motion, he substitutes a wheel or some adaptation of wheels to change the motion, everybody will at once see that to be an evasion of the patent, and for this plain reason, that all these equivalents are perfectly well known; they are just as well known as that 10 added to 6 makes 16, and that 8 added to 8 makes also 16. In the mechanical sciences, or wherever you can apply the exact sciences, you can frequently predict the results without the slightest difficulty, and with the same certainty as that with which a skilful arithmetician can tell you what will be the amount of certain numbers added together, and that a certain other set of numbers apparently differing from them altogether will when added together produce the same result, with precisely the same certainty a skilful mechanic will tell you that such and such a combination will produce a result, and that such and such another combination to the ordinary eye apparently totally different will produce precisely the same result, but looked at with the experienced eye of a mechanic he would say, Yes, here appears to be a great difference; here is a lever instead of an inclined plane, a pulley instead of two wheels to change the motion and so on; but a skilful mechanic will say, the general expression in all these might be put down as exactly the same; so that however different they may appear to the eye, they are to the mind precisely the same.

"I do not think that doctrine applies altogether to the case of chemistry, because although you can predict with confidence in mechanics in some instances, and in some cases where mathematics can be applied, in chemistry you almost entirely fail. You cannot—because sulphuric acid will succeed—tell at all that nitric acid will succeed, or that any other acid will succeed, until you have tried.

They do not exist in any relation to each other as numbers do, or as mechanical science presents to you the different mechanical powers. You cannot anticipate the result, it is a mere question of result upon experiment. Still, there may be a probable anticipation of a result which may be treated and properly treated by a jury as merely a servile imitation or else a colourable evasion of the patent. That may occur in chemistry; and where one of the witnesses in reference to this case stated that he thought borax was a salt that would most probably suggest itself to anybody as likely to answer where sulphate of potash has succeeded, I must own in the first instance, with the highest respect for the gentleman who was giving that evidence, I heard it with very great surprise; but when explained it was perfectly true, perfectly intelligible. . . . The question was asked, 'If you wish to make a cement similar to the plaintiff's without using sulphuric acid and potash, what would you suggest?' And the answer was, 'I should give the preference to borax.' I could not conceive why sulphuric acid, being a very strong acid, boracic acid a very weak one, and potash and soda being very analogous as the two fixed alkalis, I could not understand why anyone's attention as a chemist would be directed to borax more than any other salt. Then it is explained. He says this, 'Sulphate of potash acts as a flux; borax is a salt that also acts as a flux. This opinion I obtained, for I examined the substance with a microscope, and I observed that particles of the plaintiff's cement presented to the microscope the appearance of having melted. I therefore thought that any salt that would operate as a flux would probably answer better than any other salt, therefore I should have used borax.' But if borax is used merely as a flux, and not

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used because it is a mixture of an alkali and an acid, I should say that really has nothing to do with the infringement of the patent, any more than if they had used some totally foreign material that might be suggested, for instance, some of the fifty odd metals that exist; if any one of those should be used as a flux, being neither an acid nor an alkali, he might have used that flux metal and that could not be an infringement of the patent. The use of borax merely as a flux and not as an alkali and acid would probably be considered as no evasion of the patent. . . . Then if sulphate of potash so used (*i. e.* used instead of its ingredients) would be an infringement, would borax, which is the borcate of soda, be an infringement? Why, soda is an alkali, and boracic acid is an acid, and an acid that exists in a separate form; it might be used, it has been used; and the question is, is that within the scope and compass in point of fact of the plaintiff's specification? assuming that the plaintiff claims acids and alkalis beyond those that are specifically named. The true construction in point of law of the specification is in my judgment that he does claim acids and alkalis beyond those he mentions. You will have to say whether in your judgment what the defendant has done has been within the scope of the plaintiff's invention, or whether it is in imitation of it."

The great difficulty that there is in deciding whether a subsequent chemical process does or does not consist in the substitution of a chemical equivalent is well illustrated by the case of *Heath* v. *Unwin*.(a)

The patent was for "certain improvements in the manufacture of iron and steel." The patentee declared

(a) 2 Webs. P. R. 216; on appeal, 5 H. L. C. 505, *nom. Unwin* v. *Heath*.

the nature of his invention to be among other things, the use of a certain portion of oxide of manganese in the process of converting cast iron into malleable iron by the process of puddling; and the use of carburet of manganese in any process whereby iron is converted into cast steel. The specification after describing the use of oxide of manganese in the description of another part of the invention, proceeded to describe the part of the process alleged to have been infringed, in these terms: "Lastly, I propose to make an improved quality of cast steel by introducing into a crucible bars of common blistered steel, broken as usual into fragments, or a mixture of cast and malleable iron, or malleable iron and carbonaceous matters, along with from one to three per cent. of their weight of carburet of manganese, and exposing the crucible to the proper heat for melting the materials, but I do not claim the mixture of any such mixture of cast and malleable iron or malleable iron and carbonaceous matter, as any part of my invention, but only the use of carburet of manganese in any process for the conversion of iron into cast steel." Carburet of manganese is formed by the fusion of black oxide of manganese with carbonaceous matter. The defendant never used carburet of manganese by putting any of it into the crucible, but he placed the black oxide and carbonaceous matter together in the crucible, and scientific witnesses gave their opinion, that those two substances would form during the process of conversion, and before actual union with the melted steel, carburet of manganese in a state of fusion. The jury found that supposition to be true, but also found that the quantity of carburet so formed would be less than one per cent. of the weight of steel in the crucible. Upon

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these facts the Court of Exchequer held that there had been no infringement. Parke, B., said, in delivering the judgment of the Court: "In order to decide this (the question of infringement), we must first determine for what invention the patent as explained by the specification is taken out. It is not for the use of oxide of manganese in the melting of cast-steel, for carburet of manganese is expressly mentioned and distinguished from oxide of manganese; nor could the patent for the use of the oxide have been supported, as that substance had been used long before in steel making; nor is it for the use of oxide of manganese in any mode of combination with carbon generally. If it had, it would have been liable to a similar objection, as oxide of manganese had been used in crucibles containing in their construction a quantity of carbonaceous matter, with a portion of which it would necessarily combine during the process; nor is it for the use of the oxide with such a quantity of carbon as would deoxidize it and leave the manganese alone to operate upon the steel, so that neither the quantity of the steel be altered nor the crucible destroyed by the oxide of manganese abstracting, as it otherwise would do, some quantity of carbon from them. The patent is obtained for the use of one particular combination of carbon and manganese, the metallic substance called carburet of manganese, and for the use of it in that state. The specification is expressly for the employment of carburet of manganese, and the mode of using it, is by putting a certain quantity by weight of that substance in an unmelted state into the crucible. This being, in our opinion, the true construction of the specification, it is clear that the defendant has not directly infringed the plaintiff's patent, for he has never used that substance in the mode described in the

specification. Then comes the question whether he has indirectly infringed the patent by imitating and using the same patent substantially, but making a colourable variation; now there is no doubt, we think, if a defendant substitutes for a part of a plaintiff's invention some well-known equivalent, whether chemical or mechanical, he would probably be considered as only making a colourable variation. But here he has not done so. It is quite clear upon the evidence that the defendant never meant to use the carburet of manganese at all; he certainly never knew—and there is no reason to suppose that prior to this investigation any one else knew—that the substance would be formed in a state of fusion; and it is a mere matter of speculative opinion (though after the verdict we must assume it to be a correct opinion among men of science) that it would, but it was clearly not ascertained and still less was it a well-known fact. There was, therefore, no intention to imitate the patented invention, and we do not think the defendant can be considered to be guilty of any indirect infringement if he did not intend to imitate at all."

Two years after this case the case of *Stevens* v. *Keating* (*a*) was decided, and as the doctrine of intention was there dissented from, (*b*) another action was brought by Mr. Heath in the Court of Common Pleas. (*c*) Sir C. Cresswell considered that he was bound by the decision of the Court of Exchequer and directed a verdict for the defendant on the issue of not guilty, saying: "My ruling is simply this, that the use of the ingredients of the oxide of manganese and the carbonaceous matter was not an

(*a*) 2 Webs. P. R. 175.
(*b*) See *post*, p. 277.
(*c*) 2 Webs. P. R. 228.

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infringement of the patent, although those ingredients form a carburet of manganese before it entered into combination with the steel."

The case then went before the Court of Exchequer Chamber, (*a*) where three of the judges held that there had been an infringement of the patent. Platt, B., said: "Whether the carburet or its constituent parts separately are put into the melting-pot could not make any difference if those parts afterwards combined, and in their combined state acted in the same manner on the subject of the manufacture. The defendant's may be a different manner of manufacturing carburet of manganese, but however manufactured, if used in the conversion of iron into cast steel, it would be an infringement of the patent." Erle, J., said: "The question is, was there evidence that the defendant by heating the elements of carburet of manganese with iron formed first the carburet and then cast steel? If so, there would be a direct infringement." And Wightman, J., said: "The mode adopted by the defendant is not by using chemical equivalents; the material combinations are the same, in both the carburet is formed. The patent is not for the mode of preparing the carburet, but for its use in any process whereby iron is converted into cast steel; the process by which the defendant makes his carburet may be an improvement on that mentioned in the specification, but when made he uses it for the same purpose and the same effect as the defendant." The remaining judges, Coleridge, J., and Alderson, B., while admitting the doctrine of chemical equivalents, held nevertheless that there was not an infringement in this case, as although an equivalent had

(*a*) 2 Webs. P. R. 236.

been used, it was not known at the date of the plaintiff's patent, and they thought therefore that it constituted a new discovery wholly independent of the specification which omitted it.

In the House of Lords the following question was put by their lordships to the judges:—"Whether, looking at the record as set forth in the joint appendix to the printed cases, there was evidence for the jury that the plaintiff in error was guilty of an infringement of the patent stated in the declaration, by using oxide of manganese and carbonaceous matter in the manufacture of cast steel, in the manner in which, according to his admission at the trial, he did use them." To this question seven of the judges answered in the affirmative and four in the negative. The House of Lords, nevertheless, reversed the decision of the Exchequer Chamber, and decided that there had been no infringement. Lord Cranworth, L. C., said: "The invention for which the patent was granted was, according to the language of the specification, a mode of 'making an improved quality of steel by introducing into a crucible bars of common blistered steel, along with from one to three per cent. of their weight of carburet of manganese.' It is certain that this process was not adopted by Unwin. He never used such a substance as carburet of manganese at all. And if, therefore, what he did amounted to a violation of the patent, it must be because he used a substance or a combination of substances which in the process of fusion generated carburet of manganese, so that he indirectly, though not directly, used the substance on the use of which the plaintiff's invention was founded. It must, I think, be assumed that in the course of the process adopted by the defendant carburet of manganese in a liquid state was

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generated. There was evidence from which the jury might reasonably infer such to be the case, and if the use of substances thus producing carburet of manganese in a state of fusion was a violation of the plaintiff's patent, the learned judge at the trial ought not to have told the jury, as he did, that there was no evidence on which they could find a verdict for the plaintiff.

"But I think that the use of substances thus producing carburet of manganese in a state of fusion, was no violation of the patent. The substance for the use of which (*inter alia*) the patent was granted was a solid metallic substance, capable of being broken into fragments and weighed, so that certain definite quantities might be put into the crucible with the steel. There is no evidence whatever tending to prove that at the date of the patent it was known to persons acquainted with the subject of manufacturing cast steel, that coal tar and oxide of manganese would be chemical equivalents for the carburet of manganese claimed by the plaintiff. Indeed, it is obvious that the discovery of such equivalents was made after the use of the carburet, as a distinct metallic substance, had been some short time in operation. It was itself a most valuable discovery, and would have legitimately formed the subject of a new patent. The costly nature of the substance claimed in the patent might and probably would have prevented its use altogether; and if at the date of the specification it was known to the plaintiff that, by the use of two common substances, well known in commerce, more than one hundred-fold cheaper than carburet of manganese, the same results precisely would be obtained, as by the use of that material the specification would have been bad as not truly disclosing the invention.

"On the short ground, therefore, that the invention claimed is for the use of a particular metallic substance, namely, carburet of manganese, in certain definite proportions, according to the weight of steel under fusion, and that no such substance nor any equivalent for it, known to be such at the date of the specification, was used by the defendant, I think there was no evidence of infringement, so that the ruling of the learned judge at the trial was correct."

In *Hills* v. *The Liverpool Gaslight Co.*,(*a*) the plaintiff claimed as his invention "the purifying coal gas from sulphuretted hydrogen, cyanogen, and more or less perfectly from ammonia, by passing it through the precipitated or hydrated oxides of iron from whatever source obtained," and also "repeatedly renovating or re-oxidizing the said purifying materials, by the action of air, whenever they from time to time cease to absorb sulphuretted hydrogen, so that they may be used over and over again to purify the gas. The defendants used for the purification of their gas a natural product or substance, found in Ireland, and known as "bog-ochre." It was held by Lord Westbury, that the user by the defendants of the bog-ochre employed by them in the purification of gas, so long as the same was used in its native state or condition, was not an infringement of the plaintiff's patent, but that the user of the same material in the purification of gas, after it had been re-oxidized or renovated by the means described in the plaintiff's patent, or any other means, was an infringement.

The use of any portion of a patent for a

Where a patent has been taken out for a combination of parts, some of which are new and some old, the use of

(*a*) 9 Jur. (N. S.) 140.

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combination which is new is an infringement.

any part of the combination which is new and material will be an infringement of the patent, though any part which is old may be used, and it is not necessary to show that the whole combination has been imitated. (*a*)

In the case of the *Electric Telegraph Co.* v. *Brett*, (*b*) the breaches in the declaration stated that the defendants had used and counterfeited the invention of the patentees. The invention consisted of nine specified improvements, and it was held that the finding of the proof of an infringement, in respect of one of the improvements, was a sufficient finding of the infringement alleged in the declaration.

In *Sellers* v. *Dickinson*, (*c*) the patent was for improvements in looms for weaving. The specification was for an improved process for stopping power looms, when the shuttle stopped in the shed, by the combination of mechanism described in the specification. The process comprised two main operations, viz. the shifting of the driving strap from the foot to the loose pulley, and the bringing of the break to the fly wheel. The arrangement for shifting the driving strap, by a clutch box and other means, could be distinguished from the arrangement for moving the break to the fly-wheel; but the whole combination was specified without any claim or disclaimer as to any part. The clutch box for shifting the strap was old; the defendant had made a combination for the same purpose, containing two arrangements: that for shifting the driving strap was by a frog instead of a clutch box, and was not the same as the plaintiff's; but that for applying the break to the fly-wheel was the

(*a*) *Gillett* v. *Wilby*, 9 Car. & P. 334; 1 Webs. P. R. 270.

(*b*) 10 C. B. 882.

(*c*) 5 Exch. 312.

same. The defendant contended that if the plaintiff's patent was for the whole there was no infringement, and if it was for each part the clutch box was old, and so the patent was void; but it was held that the patent was valid if the whole combination was new and useful, and that the defendant had infringed if he had taken a new and material part, that is, the arrangement for bringing up the break.

This case was founded on *Newton* v. *Grand Junction Railway Co.*(*a*) where the patent was for improvements in the construction of boxes for axles, and the specification claimed a combination by which boxes cast with fillets were lined, first with a coating of tin, and then of alloy, for the purpose of preventing the abrasion arising in ordinary boxes. The defendant lined boxes with tin without using fillets or alloy; but the lining of tin was intended for and effected the purpose to which the plaintiff's patent related; the judge ruled that the jury must take the whole of that for which the patent was granted, fillets lined with tin and then with alloy, and say whether that was new; that, if a patent was granted for a new combination of several things known before, this did not prevent any one from using what was old; and that it was for the jury to say whether the part used by the defendant was substantially the same thing as the plaintiff's invention. This direction was held to be right. Sir F. Pollock, C.B., in giving judgment, observed: "It was argued that the same criterion was to be applied to the question of infringement as to that of novelty, but that is not so. In order to ascertain the novelty you take the entire invention, and if in all its

(*a*) 5 Exch. 331.

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parts combined together, it answers the purpose by the introduction of any new matter, by any new combination, or by any new application, it is a novelty entitled to a patent. But in considering the question of infringement, all that is to be looked at is, whether the defendant has pirated a part of that to which the patent applies; and if he has used that part for the purpose for which the patentee adapted his invention, and that for which he has taken out his patent, and the jury are of opinion that the difference is merely colourable, it is an infringement;" and Alderson, B., said: "Where the invention consists partly of what is old and partly of what is new, the combination is the subject of the patent. Therefore a person cannot infringe that part of the patent which is old, because the public cannot be prevented from using that which they had before used in that state. If the invention consists of something new, and a combination of that with what is old, then if an individual takes for his own and uses that which is the new part of the patent that is an infringement."

In *Smith* v. *The London and North-Western Railway Co.* (*a*) Lord Campbell, C. J., said: "Where a patent is for a combination of two or three or more old inventions, a user of any of them would not be an infringement of the patent, but where there is an invention consisting of several parts, the imitation or pirating of any part of the invention is an infringement of the patent. Suppose that a man invents a machine consisting of three parts, one of which is a very useful invention, and the two others are found to be of less practical use, surely it could not be said that it was free to any person to use

(*a*) 2 El. & Bl. 76.

the useful part so long as he took care to substitute some other mode of carrying out the less useful parts of the invention." In this case the plaintiff's invention consisted in the manufacture of an improved wheel, "by welding wrought iron bars together into the form of a wheel, whereof the nave, spokes and rim when finished will consist of one solid piece of malleable iron." The evidence showed a clear imitation and infringement of the manner of forming the boxes or nave into one piece of malleable iron with the rest of the wheel, but the mode of forming and welding the rim was different, and it was held that as it appeared that the mode of forming the nave was a new and useful part of the invention, the use of it by the defendant was an infringement, although the patentee stated that the new invention consisted in the circumstance of the centre boxes or nave, arms and rim of the said wheel being wholly composed of wrought or malleable iron, "welded into one solid mass in manner hereinbefore described."

These cases were cited and commented upon in the case of *Lister* v. *Leather*, (*a*) and it was there unanimously decided by the Court of Queen's Bench and in the Exchequer Chamber that the use of a subordinate part of a combination might be an infringement of the patent, if the part so used was new, that is to say, new in itself, or in its effect, not merely in its application and material. (*b*)

Infringed part need not have been claimed expressly.

If the defendants have used a material part of the plaintiff's patent, it is not necessary to determine whether

(*a*) 8 El. & Bl. 1004.

(*b*) See also *Bovill* v. *Keyworth*, 7 El. & Bl. 725; *Thomas* v. *Foxwell*, 5 Jur. (N. S.) 37; *White* v. *Fenn*, 15 W. R. 348; *McCormick* v. *Gray*, 7 H. & N. 35.

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their claim extends to the rest of the patent, for as the manufacture, which is the result of the process invented and patented, is the ultimate object in view, the purpose of the patent laws is to protect all that is new in the process, if it is described, though not expressly claimed. Thus, where the specification of a patent for "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," it was held that a machine in which the 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. In the same case the specification of another of the plaintiff's patents 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," and it was 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. (*a*)

But if the patentee's invention consist merely in the use of an old machine or well known tool to work new materials, or to produce a new effect, that is not the subject matter of a patent, and the use of it by another person is not an infringement. (*b*)

Part used must be for the same purpose.

Not only in order to constitute an infringement, must

(*a*) *De la Rue* v. *Dickinson*, 7 El. & Bl. 738.

(*b*) *Patent Bottle Envelope Co.* v. *Seymour*, 5 C. B. (N. S.) 164; *Finlay* v. *Allen*, 2 Dec. of Ct. of Sess. 2 series, 1087.

the part used be new and material, but it must also be used for the same purpose. (*a*)

In *Newton* v. *Vaucher* (*b*) the plaintiff's patent was for the application of soft metal to the bearings of machinery for the purpose of diminishing friction, and the defendant's patent was for the application of soft metal for the purpose of packing hydraulic and other machines, so as to render them air and fluid tight; and it was held that the principle of the two inventions was totally different, and that there had been no infringement.

In *Lister* v. *Eastwood*, (*c*) Erle, C. J., told the jury that in order to constitute an infringement the defendant must have not only taken a new and material part of the combination, but must also have applied it to a purpose similar or analogous to that which the plaintiff's combination was intended to effect. It was contended that this was a misdirection, but Williams, J., in delivering the judgment of the Court, said, "We are of opinion that it was not, but that it was a correct exposition of the law. It is true that in the judgment of the Court in *Lister* v. *Leather* (*d*) this qualification of the doctrine was not superadded in express terms, but it appears to us to flow inevitably from the principles on which that doctrine was founded."

The adaptation of a machine to another and additional purpose is an infringement.

Where a patent is taken out for a combination of machinery for a particular purpose it will be an infringement to adopt it to another purpose. In *Cannington* v. *Nuttall* (*e*) Lord Westbury said: "If you are obliged to adopt a combination of machinery which originally is directed to one purpose, before you can make it minister

(*a*) *Thomas* v. *Foxwell*, 5 Jur. (N. S.) 37.

(*b*) 6 Exch. 859.

(*c*) 9 L. T. (N. S.) 766.

(*d*) 8 El. & Bl. 1004.

(*e*) L. R. 5 H. L. 220.

to another and additional purpose, the user of it for this additional purpose is an infringement of the patent which first introduced that combination."

New combination of old materials for same purpose not infringement.

But it is not an infringement of a patent for a combination to effect a new combination of the same parts for the same purpose, if it is not a mere colourable imitation or evasion. In *Curtis* v. *Platt*,(a) the plaintiff's patent, which was granted in 1854, specified a combination of mechanism applicable to spinning mules; and the first claim was for "the novel construction, combination and application of mechanism hereinbefore described, whereby one half of the clutch or catch box hereinbefore described, or any mechanical equivalent therefor, is connected with or acts upon cams or other similar parts of mechanism direct." There were other claims, but in respect of these breaches were not alleged in the plaintiff's particulars of breaches. The defendant's patent, granted in 1860, specified a combination of mechanism which embodied the leading idea of the plaintiff's patent, and by which one half of a clutch box was made to act upon cones direct, and he adopted some of the elements combined by the plaintiff, but he disposed them in a different manner. These were important parts of the prior combination, and, although old mechanical contrivances, were new in respect of the particular mode in which the plaintiff applied them, and the immediate object of their combination by him was new, viz. to make a clutch box act on cams direct. The effect brought about by the direct action of the clutch box on the cams had long previously been produced, but less advantageously, by other contrivances of various kinds. The defendant's mode of combination

(a) 35 L. J. Ch. 852; L. R. 1 H. L. 337.

effected the common object of each patent in a more beneficial manner than it was or could be effected by the mode of combination specified in the plaintiff's patent, and it displayed an equal amount of inventive ingenuity. It was held that the plaintiff's claim was limited to the entire combination claimed as before described in his specification; that the defendant's combination was not a mere colourable evasion, and that there was no infringement.

In *Hill* v. *Thompson* (*a*) the patent was for a combination of processes, and it was held that any use made of any of the ingredients singly, or any use made of such ingredients in partial combination, some of them being omitted, or any use of all or some of such ingredients in proportion, essentially different from those specified and yet producing a result equally beneficial with the result obtained by the proportions specified, would not constitute an infringement.

Different machinery to perform same process not infringement.

It is not an infringement of a patent which describes a particular machine, to perform the process by the application of different machinery.

Where the particular manner described in the specification of using the invention was by means of a "weight," and the defendants employed a machine similar in many respects, but though using weight or pressure occasioned by weight as a force they did not use a "weight," it was held that this did not amount to an infringement; (*b*) and where the specification of a patent for improvements in the process of finishing hosiery and other goods manufactured from lambs' wool, Angola and worsted yarns, described the pro-

(*a*) 8 Taunt. 391; 2 B. Moo. 448; 1 Webs. P. R. 242.

(*b*) *Seed* v. *Higgins*, 8 H. L. C. 551.

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cess as consisting in submitting hosiery and similar goods made of elastic stocking fabric to the finishing process of a press heated by steam, hot water, or other fluid in the manner thereinafter described, and a drawing of the machine was given, representing an iron steam box supported upon iron columns, beneath which was another box upon which the goods to be pressed were placed, and which was capable of being pressed against the upper one by means of an hydraulic press, it was held that a method of finishing hosiery goods by passing them through heated rollers was not included in this patent, and therefore was no infringement of it. (*a*)

Patent for application of a principle not infringed, if different application of principle.

Where a patent has been taken out for the application of a principle, the making of an article on the same principle as the patented article will not of itself alone be an infringement, because the principle may be applied in different ways; but if it is applied in the same way as in the patent, then the want of two or three circumstances, which are contained in the plaintiff's specification, will not prevent the plaintiff from recovering. (*b*) Where the patent was for the application of a self-adjusting leverage to the back and seat of a chair, Alderson, B., told the jury that it was material to consider whether the species of self-adjusting leverage had ever been applied to the back and seat of a chair before. For if there had been a self-adjusting leverage applied before, and the patent had been taken out for the particular mode of accomplishing it in the patent chair—any one else might have applied the same principle in any other way, and that would have been no infringement; but if the patent was

(*a*) *Barber* v. *Grace*, 1 Exch. 339. And see *Newall* v. *Elliott*, 10 Jur. (N. S.) 956.

(*b*) *Jones* v. *Pearce*, 1 Webs. P. R. 122.

for the adjustment of a self-acting leverage to the back and seat of a chair, it would become a very different question when the question of infringement was considered. (*a*)

Patentee who has discovered principle as well as mode of carrying principle into effect entitled to all modes.

But if the patentee has not only discovered a mode of carrying a principle into effect, but is also the discoverer of the principle, he is entitled to protect himself from all other modes of carrying the same principle into effect.

In *Crossley* v. *Beverley*, (*b*) the patent was for an improved gas-meter, and the infringement complained of was a close imitation of this improved machine; the patentee obtained a verdict, the principle being the same in both cases. In *Jupe* v. *Pratt*, (*c*) Alderson, B., referring to this case, said: "There never were two things to the eye more different than the plaintiff's invention and what the defendant had done in contravention of his patent right. The plaintiff's invention was different in form, different in construction, it agreed with it only in one thing, and that was by moving in the water a certain point was made to open either before or after, so as to shut up another, and the gas was made to pass through this opening; passing through it, it was made to revolve it; the scientific men, all of them, said the moment a practical scientific man has got that principle in his head he can multiply without end the forms in which that principle can be made to operate. The difficulty which will press on you, and to which your attention will be called in the present case, is this: You cannot take out a patent for a principle; you may take out a patent for a principle coupled with the mode of carrying the principle

(*a*) *Minter* v. *Wells*, 1 Webs. P. R. 130.

(*b*) 1 Webs. P. R. 106.

(*c*) 1 Webs. P. R. 146.

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into effect, provided you have not only discovered the principle, but invented some mode of carrying it into effect. But then you must start with having invented some mode of carrying the principle into effect; if you have done that, then you are entitled to protect yourself from all other modes of carrying the same principle into effect." (*a*)

In *Russell* v. *Cowley*, (*b*) the plaintiff's patent consisted in the manufacture of tubes, by turning up a piece of plate of iron so that the edges abutted on each other, heating the iron so prepared, and drawing it, when at welding heat, through dies having a conical hole. By this process, the use of a maundril was avoided. The defendants passed tubes through grooved rollers, and afterwards through a scorpion, which was in effect the plaintiff's die. Evidence was given, which proved that the two inventions were similar in principle, and it was held that there had been an infringement of the plaintiff's patent.

Acts done on the high seas not infringement.

A patent granted for the United Kingdom, Channel Islands, and Isle of Man is not infringed by acts done on the high seas. In *Newall* v. *Elliott*, (*c*) it was held that a patent for an improved method of laying telegraph cables was not infringed by acts done between Malta and Alexandria.

Contemporaneous inventor.

Where an inventor filed a provisional specification, and obtained within six months letters patent, which were dated as of the date of the provisional specification, and another person had previously made a similar invention, but had not used it for his trade till after the date of the specification being filed, although his invention was completed and might have been used, it was held, that as the

(*a*) And see *Forsyth* v. *Rivière*, 1 Webs. P. R. 97, n.

(*b*) 1 Webs. P. R. 462.

(*c*) 10 Jur. (N. S.) 956.

date of the patent is that of filing the provisional specification, there was not such prior user as to invalidate the patentee's right, and therefore that there had been an infringement of his patent. (*a*)

The making for sale of a patented article is an infringement.

If a person actually makes an article according to the patented process for the purposes of sale, his making it will be a sufficient infringement of the patent. (*b*)

In *Gibson* v. *Brand*, (*c*) Sir N. C. Tindal, C. J., said: "If the defendants have themselves sold an article of exactly the same fabric, made in the same manner as that for which the patent was taken out, such sale may be considered as a using of the invention within the terms of the declaration." (*d*)

Exhibiting to sale not.

In *Minter* v. *Williams*, (*e*) it was held that the merely "exhibiting to sale" imitations of an invention was not any infringement of the patent.

Nor making for amusement and not for profit.

If the article is made for the purpose of amusement only, or as a model, (*f*) or for private use, and not for profit, there is no infringement.

In *Higgs* v. *Goodwin*, (*g*) the invention consisted in the precipitation of all animal and vegetable matter contained in sewage water by the use of hydrate of lime. The defendant applied this process for the purpose of deodorizing sewage water, and did not use the product as an article of value, but *bonâ fide* rejected it as being accidentally

(*a*) *Smith* v. *Davidson*, 19 Dec. of Ct. of Sess. 2nd series, 691.

(*b*) *Jones* v. *Pearce*, 1 Webs. P. R. 122; *Muntz* v. *Foster*, 2 Webs. P. R. 101.

(*c*) 4 M. & G. 179; 4 Scott (N. R.) 844; 1 Webs. P. R. 630.

(*d*) And see *Holmes* v. *The London and North Western Railway Co.*, Macr. 22.

(*e*) 4 A. & E. 251; 1 Webs. P. R. 137.

(*f*) *Jones* v. *Pearce*, 1 Webs. P. R. 122.

(*g*) El. Bl. & Bl. 529.

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produced and useless, and it was held that there was no evidence of infringement.

Sale in this country of article manufactured abroad is infringement.

A sale in this country, of an article manufactured abroad, according to the specification of an English patent is an infringement. In *Walton* v. *Lavater*, (*a*) Sir W. Erle, C. J., said: "The words in the statute of James are 'working or making.' In the granting part of the letters patent the words are, 'make, use, exercise and vend,' and in the prohibitory part, 'make, use, or put in practice.' . . . It appears to me to be clearly the intention of the Crown in granting letters patent for a new invention to prohibit and prevent third persons from using the patent article for the purpose of profit by selling. The object is to give to the inventor the profit of his invention; and the most effectual way of defeating that object would be the permitting others to derive from the sale of the patent article the profit which it was intended to secure to the patentee. It seems to me, therefore, that proof, that a party has sold the patent article without proof of his having made it or procured it to be made, would be good evidence to warrant a jury in finding that he has been guilty of an infringement. As to the circumstance of the goods having been imported from abroad, I should say, that if this were simply the case of an importation without any proof of knowledge on the part of the importer, that the article imported was a patented article, the mere sale would be sufficient to charge him." And in *Elmslie* v. *Boursier*, (*b*) Sir W. M. James, V.C., said: "I am of opinion both upon principle and upon the authorities that the doing what is admitted to have been done by these defendants is a

(*a*) 8 C. B. (N. S.) 162.

(*b*) L. R. 9 Eq. 222.

violation of the rights granted to the plaintiff by the letters patent.

"The plaintiff has by a lawful grant from the Crown under the statute obtained the right to 'make, use, exercise and vend' his invention within the United Kingdom, in such manner as he thinks fit; and the right to have and enjoy 'the whole profit, benefit, commodity and advantage' accruing and arising by reason of the said invention.

"Now one of the most useful inventions is that of a process by which a common article may be made more economically than it was made before.

"It is said that tin-foil can be made by the plaintiff's process at less cost than by the old method; and it is conceded that nobody in England can use the plaintiff's process of making cast tin-foil as distinguished from rolled tin-foil without a licence from the plaintiff. If that cannot be done in England it would be a very strange thing if a person in England could send an order to some one in France, get the same thing manufactured there in exactly the same way, and bring it here so as to compete with the person to whom the Crown has granted 'the whole profit, benefit, commodity and advantage' arising from the patent. It would be a short mode of destroying every 'profit, benefit, commodity and advantage,' which a patentee could have from such a thing if all that a man had to do was to get the thing made abroad, import it into this country, and then sell it here in competition with the English patentee." (*a*)

The sending to England of patented articles made

Where the patented article is made abroad and is

(*a*) And see *Wright* v. *Hitchcock*, L. R. 5 Exch. 37.

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abroad is infringement, though no sale.

there applied to the purposes for which it is made, and is then sent to this country not for sale here, but for exportation to another country, there is nevertheless such a user of the patent here as to constitute an infringement. Thus, where the patent was for capsules which were made abroad according to an English patent and the bottles they were used to cover were sent through England for exportation, it was held that there was an infringement of the patent. (*a*)

Manufacture for exportation is infringement.

If the parts of a patented machine are old, it is not an infringement to manufacture them separately and export them. But the manufacture and exportation of the complete machine will be an infringement. (*b*)

Improvement on existing patent not infringement.

A patent for an improvement on an invention already the subject of a patent if confined to the improvement is not an infringement of the former patent, but the use of the improvement with the former invention during the existence of the former patent without licence is an infringement. (*c*)

Delay in using invention no excuse.

It appears that if an invention, for which a patent is granted, would if put into practice, be useful, an action for infringement may be brought, although the plaintiff's invention has never been put into actual use, except by the defendant when he infringed the patent. (*d*)

Experiments with known articles not infringement.

When it is known that a mixture of certain articles will produce a beneficial result, and a patent is taken out for mixing them in certain proportions, it is not an infringement for another person to make experiments for

(*a*) *Betts* v. *Neilson*, L. R. 3 Ch. 429; S. C. on app. *Neilson* v. *Betts*, L. R. 1 H. L. 1.

(*b*) *Goucher* v. *Clayton*, 11 Jur. (N. S.) 462.

(*c*) *Lister* v. *Leather*, 8 El. & Bl. 1017.

(*d*) *Macnamara* v. *Hulse*, Car. & M. 471.

ascertaining what the proportions or properties of the different articles would come to. (*a*)

Acts done by workmen may be infringements.

It is no answer to an action for infringement or a suit to restrain the infringement of a patent, to say that any infringement which may have taken place was contrary to the orders of the defendant, and that the acts were done by workmen employed by him in the course of their duties, but against his orders. (*b*)

Ignorance of existing patent no excuse.

Ignorance of the existence of a previous patent is no answer to a charge of infringement. If the defendant's patent is capable of being accurately represented as an imitation of the plaintiff's, it will be an infringement, although at the time of making his invention the defendant was innocent of any knowledge of the plaintiff's patent. (*c*)

Intention immaterial.

It has been seen that the Court of Exchequer, in *Heath* v. *Unwin*, (*d*) considered that if the defendant did not intend to imitate the plaintiff's invention, there was no infringement. This doctrine was dissented from in *Stevens* v. *Keating*; (*e*) and when *Heath* v. *Unwin* came before Sir L. Shadwell, V. C., his Honour said: "The party complaining of the act is none the less prejudiced by it, because it was committed unintentionally; and my opinion is that if a party has done an act that is injurious to the rights of another (though without any intention of doing him an injury), he is answerable for the consequences." (*f*) The action is maintainable

(*a*) *Muntz* v. *Foster*, 2 Webs. P. R. 101.

(*b*) *Betts* v. *De Vitre*, L. R. 3 Ch. 441.

(*c*) *Curtis* v. *Platt*, 11 L. T. (N. S.) 245; *Nunn* v. *D'Albergue*, 34 Beav. 595; *Wright* v. *Hitchcock*, L. R. 5 Exch. 37.

(*d*) 2 Webs. P. R. 227.

(*e*) 2 Webs. P. R. 175.

(*f*) *Heath* v. *Unwin*, 15 Sim. 552; *Unwin* v. *Heath*, 5 H. L. C. 535.

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in respect of what the defendant does, not what he intends. (*a*)

Patentee entitled to damages though no loss sustained where infringement.

A patentee is entitled to a verdict with nominal damages, even though he has sustained no real injury, if his rights have been invaded. Thus, where an action was brought against a person for selling hones wrapped in envelopes similar to those of the plaintiff's, and the jury found that the defendant's hones were not inferior to those of the plaintiff, and it was not proved that the plaintiff had suffered any specific damages, it was held that as his right had been invaded, he was entitled to recover nominal damages. (*b*)

Proof of patent documents.

The Patent Law Amendment Act, (*c*) after directing a seal to be made for the purposes of the Act, provides "that all Courts, judges and other persons whomsoever shall take notice of such seal, and receive impressions thereof in evidence, in like manner as impressions of the great seal are received in evidence; and shall also take notice of, and receive in evidence, without further proof or production of the originals, all copies or extracts certified under the seal of the said office of or from documents deposited in such office." A later Act (*d*) provides "that printed or manuscript copies or extracts, certified and sealed with the seal of the commissioners, 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

(*a*) *Stead* v. *Anderson*, 4 C. B. 833; 2 Webs. P. R. 156.

(*b*) *Blofield* v. *Payne*, 4 B. & Ad. 410.

(*c*) 15 & 16 Vict. c. 83, s. 2.

(*d*) 16 & 17 Vict. c. 115, s. 4.

patent for inventions in all courts whatsoever 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 original." (*a*)

Two specifications must be compared.

The specification of the plaintiff's and defendant's patents must be compared, in order to see whether there is that variation in substance that will give the denomination of a new discovery to what the defendant has done, or whether he is not following out the invention of the plaintiff, with some variation in the description which may not allow it the name of a new discovery. (*b*)

It is not proof of an infringement that identical terms are used in different specifications, the things described may be different; it must be proved that they are themselves identical, and are used for the same purpose. (*c*)

The question of infringement is for the jury.

The question as to whether or not there has been an infringement of the plaintiff's patent is a mere question of fact, and peculiarly for the consideration of the jury; and it is for them to say whether, under the circumstances, that which has been done by the defendants amounts to such an infringement or not, (*d*) even though 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. (*e*) Where, in an action for infringing a patent for blocks for pavement,

(*a*) As to proof of transcripts in Scotland and Ireland, see 16 & 17 Vict. c. 115, s. 5, and *ante*, ch. vii.

(*b*) *Walton* v. *Potter*, 1 Webs. P. R. 587.

(*c*) *Cutler's Patent*, 1 Webs. P. R. 427. And see *ante*, p. 114.

(*d*) *Walton* v. *Potter*, 1 Webs. P. R. 586.

(*e*) *De la Rue* v. *Dickinson*, 7 El. & Bl. 738; *Lister* v. *Leather*, 8 El. & Bl. 1004.

the plaintiff claimed as his invention that his block was bevelled both inwards and outwards 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, it was 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 bevelled both inwards and outwards on the same side. (*a*)

The Court will not in deciding whether there has been an infringement, express an opinion as to whether the jury were justified in their verdict unless it is contended that the verdict was given against evidence. (*b*)

Evidence in support of patent.

The plaintiff in an action for infringement must give some evidence to show what his invention is, unless the other side admit that it has been tried and succeeds. (*c*) It is a sufficient test of the sufficiency of the specification that witnesses state that they have been able to make the patented article from the description given in the specification; and that no person has been called who has stated that he could not understand it, has been misled by it or incurred expense in endeavouring to work according to it. (*d*)

Patent is primâ facie evidence of novelty of invention.

The patent is *primâ facie* evidence that the invention in respect of which it is taken out is new. "The plaintiff," said Alderson, B., "in order to establish his right must show that the invention is new, and that it is useful, and that the specification is such that an ordinary

(*a*) *Macnamara* v. *Hulse*, Car. & M. 471; 2 Webs. P. R. 128.

(*b*) *Sellers* v. *Dickinson*, 5 Exch. 323.

(*c*) *Turner* v. *Winter*, 1 T. R. 607; 1 Webs. P. R. 81. And see *Bateman* v. *Gray*, 1 C. L. R. 512.

(*d*) *Cornish* v. *Keene*, 1 Webs. P. R. 502.

workman could make the machine which would answer the purpose which the patent was intended to accomplish. The patent is *primâ facie* evidence on the part of the person who claims the right that he is so entitled, and it is for the person who seeks to infringe that patent to show some circumstances whereby that right, which otherwise would be presumed to exist, is defeated, to show that the Crown's grant has been improperly obtained by the present plaintiff." (*a*)

Where the alleged piracy has taken place abroad, it is the duty of the defendant to give evidence of a negative character to prove (in answer to the *primâ facie* case made by the plaintiff), that the process used is different from that which has been patented. (*b*)

Where defence is set up that the patent is void on account of publication in a previous specification, evidence of all that has been done in the trade to which the patent relates, between the date of the two patents, is admissible. (*c*)

Plaintiff's witnesses can only give negative evidence.

The plaintiff's witnesses can only give negative evidence, and it is for the defendant to show affirmatively that the invention is not new. (*d*)

In *Manton* v. *Manton* (*e*) Gibbs, C. J., said: "The first witness, a man of considerable experience, had never seen any locks with the lips so perforated: *primâ facie* that is good evidence, but when the question is whether this had existence previous to the patent, fifty witnesses

(*a*) *Minter* v. *Wells*, 1 Webs. P. R. 129. And see *Russell* v. *Crichton*, *ib.* 677 n.; 15 Dec. of Ct. of Sess. 1271.

(*b*) *Neilson* v. *Betts*, L. R. 5 H. L. 1.

(*c*) *Neilson* v. *Betts*, L. R. 5 H. L. 1.

(*d*) *Galloway* v. *Bleaden*, 1 Webs. P. R. 526.

(*e*) Dav. P. C. 350.

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proving that they never saw it before would be of no avail if one was called who had seen it and practised it." (*a*)

Validity of patent assumed.

The Court will assume for the purpose of inquiry, whether the defendant has infringed the patent or not, that it is valid, and that no objection arises either to the nature of the grant or the specification. (*b*)

Sale of similar article evidence of infringement.

It is *primâ facie* evidence of infringement that an article has been made according to the patentee's process, when it is seen to agree in all respects with that manufactured and sold by the patentee.

In *Huddart* v. *Grimshaw*, (*c*) the plaintiff's patent was for "a new mode of making great cables and other cordage, so as to attain a greater degree of strength therein, by a more equal distribution of the strain upon the yarns." Pieces of cordage made by the defendant were put into the hands of the plaintiff's witnesses, and from the fact that the same effect was produced in them, and from the similarity of structure, they gave the opinion that they were made by the same process as the plaintiff's. Lord Ellenborough said that it had happened to him in the same morning to give, as far as he was concerned, his consent to the granting of three different patents for the same thing; but the modes of attaining it were all different. But it did not follow that the plaintiff's method of attaining the object was open to the public; and therefore the question for the jury was, whether the defendant had used the plaintiff's method or some other. (*d*)

(*a*) And see *Hill* v. *Thompson*, 8 Taunt. 375; 2 B. Moo. 448; 1 Webs. P. R. 244.

(*b*) *Muntz* v. *Foster*, 2 Webs. P. R. 97.

(*c*) 1 Webs. P. R. 91.

(*d*) See also *Galloway* v. *Bleaden*, *ib.* 523; *Davenport* v. *Richard*, 3 L. T. (N. S.) 503.

Where it was proved that the defendant sold an article in the state to which it would have been brought by the plaintiff's process, and that he had the means of practising the plaintiff's process at hand, it was held that that was sufficient evidence of infringement. (*a*)

Unless patent for mode of manufacture.

Where the patent is for the mode of manufacturing a certain article and not for the article itself, evidence must be brought to prove that the defendant uses the same process as the plaintiff, and the production of an article made by the defendant which is similar to that made by the plaintiff is not evidence of infringement. Thus where the patent was for a mode of manufacturing candles by the application of peculiarly formed wicks, and the mode of manufacturing candles by the application of two or more plaited wicks as described in the specification, it was held that the production of candle with a plaited wick, without showing in what way it was made, was not evidence of infringement. (*b*) But where the alleged infringements took place abroad and the defendant did not bring negative evidence to prove that his process was different from the plaintiff's, and positive evidence was given on the part of the plaintiff by one workman, that he had been employed at the foreign manufactory, and there saw articles manufactured by a process not distinguishable from the patented process; it was held that these circumstances warranted the conclusion of identity of material and process, and were sufficient warrant for the grant of an injunction. (*c*)

Use of similar article.

Where in a patent for "improvements in apparatus

(*a*) *Hall* v. *Boot*, 1 Webs. P. R. 101.

(*b*) *Palmer* v. *Wagstaff*, 9 Exch. 494.

(*c*) *Neilson* v. *Betts*, L. R. 5 H. L. 1.

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employed for laying down submarine electric telegraph wires," the invention consisted in coiling the wire or cable round a cone, and in the supports placed cylindrically outside the coil round the cone; it was held, that the substitution by the defendants of a cylinder having a domed or hemispherical top, for a cone with a conoidal apex in the plaintiff's apparatus—both the plaintiff's and the defendant's apparatus being used for the same purpose and in nearly the same manner, was evidence and strong evidence of infringement. (*a*)

Evidence of motives for prior user inadmissible.

Where evidence of prior user by some third party is attempted to be shown, the declaration of such party as to his motives for such user are inadmissible as mere hearsay. (*b*)

Patentee who has assigned may be witness.

A patentee who has assigned the whole of his interest in a patent may be examined as a witness in an action by the assignees for infringement. (*c*)

The Court looks with distrust on experiments conducted with a view to litigation. (*d*)

(*a*) *Re Newall and Elliott*, 4 C. B. (N. S.) 293.

(*b*) *Hyde* v. *Palmer*, 3 B. & S. 657.

(*c*) *Bloxam* v. *Elsee*, 1 C. & P. 563.

(*d*) *Young* v. *Fernie*, 4 Giff. 577.

CHAPTER XIII.

OF AN ACTION FOR INFRINGEMENT.

THE injury which a patentee sustains by the infringement of his patent entitles him to maintain an action at law against the wrongdoer, to recover compensation for the damage he has sustained. (*a*)

Parties.

In an action to recover damages for the infringement of a patent, the proper person to be plaintiff is the party in whom the legal estate in the patent was vested at the time of the infringement, and the person who has directly or indirectly committed or authorized the alleged wrongful act must be the defendant. (*b*)

Assignee may sue.

The assignee of a patent may maintain an action for infringement, (*c*) and if a patentee has assigned part of his patent he may join with his assignee in bringing an action. (*d*)

The assignee of a separate and distinct part of a patent may sue for an infringement of that part without joining

(*a*) Bull, N. P. 76. As the rules of pleading are so soon to be altered under the Judicature Act, it has not been thought advisable to increase the size of this work by any notes on the subject of pleading. The reader is referred to Bullen and Leake "On Pleading," Chitty's "Precedents in Pleading," and to Fisher's "Common Law Digest," for a collection of the cases.

(*b*) Hindm. 251.

(*c*) *The Electric Telegraph Co.* v. *Brett*, 10 C. B. (N. S.) 838.

(*d*) *Boulton* v. *Bull*, 2 H. Bl. 464.

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any person who has an interest in another part, and the damages will accrue to him alone. In *Dunnicliff* v. *Mallett*,(a) Sir W. Erle, C. J., said: "The question is whether an assignment of part of a patent is valid. I am inclined to think that it is. It is every day's practice, for the sake of economy, to include in one patent several things which are in their nature perfectly distinct and severable. It is also every day's practice by disclaimer to get rid of part of a patent which turns out to be old. Being therefore inclined to think that a patent severable in its nature may be severed by the assignment of a part, I see no reason for holding that the assignee of a separate part which is the subject of infringement may not maintain an action. Then are the assignees bringing an action for an injury done solely to them by an infringement of that, part of which is thus vested in them alone, liable to be defeated because they have not joined the assignees of other parts of the patent who have no manner of interest in the damages sought to be recovered in such action? I see no reason why the action should be defeated on any such ground; I see no reason why the plaintiffs should be put to the trouble and expense of applying for leave to use the names of the other parties, or for compelling them by means of a judge's order to permit their names to be used upon an indemnity where no practical advantage whatever is to be gained by it, the injury being to the assignees of part only, and the damages to be recovered being theirs only."

Even where defendant is original grantee.

When a person becomes the assignee of two several moities of a patent he is entitled to sue for an infringement of the patent although the defendant is the original

(a) 7 C. B. (N. S.) 209.

grantee. In *Walton* v. *Lavater* (*a*) it was argued that the effect of an assignment was only to give the assignee a licence to use the patent and a right to an account, and that the original patent right remained in the grantee; but it was held, following *Dunnicliff* v. *Mallett*, (*b*) that an assignee, whether of the entirety of a patent or of a part or share in it, takes the legal interest, and is not to be considered merely as a licensee. (*c*)

Tenants in common, right descends to survivor.

Where two persons are assignees of a patent as tenants in common, if one of them dies, actions for infringements commenced in his lifetime descend to the survivor, who is entitled at law to recover the whole of the damages. (*d*)

Assignee of bankrupt.

The assignees of a bankrupt patentee may maintain an action for infringement of the patent. (*e*)

Licensee cannot sue unless exclusive.

A mere licensee cannot sue for the infringement of the patent, (*f*) but an exclusive licensee has a right to sue in the name of the patentee. (*g*)

An action may be maintained 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. (*h*)

Notice of objections at law.

By 5 & 6 Will. IV. c. 83, s. 5, it was provided that in actions for infringement and in any *sci. fa.* that notice of objections should be given. This enactment was repealed by s. 41 of the Patent Law Amendment Act, (*i*) which

(*a*) 8 C. B. (N. S.) 162.

(*b*) 7 C. B. (N. S.) 209.

(*c*) And see *Wallington* v. *Dale*, 7 Exch. 888.

(*d*) *Smith* v. *London and North Western Railway Co.*, 2 El. & Bl. 69.

(*e*) *Bloxam* v. *Elsee*, 6 B. & C. 169.

(*f*) *Derosne* v. *Fairie*, 1 Webs. P. R. 154.

(*g*) *Renard* v. *Levinstein*, 2 H. & M. 628.

(*h*) *Walton* v. *Lavater*, 8 C. B. (N. S.) 162.

(*i*) 15 & 16 Vict. c. 83.

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In actions for infringement of letters patent particulars to be delivered, and no evidence allowed not mentioned therein.

provides that "in any action in any of her Majesty's superior Courts of record at Westminster or in Dublin, for the infringement of letters patent, the plaintiff shall deliver with his declaration particulars of the breaches complained of in the said 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 said action; and at the trial of such action no evidence shall be allowed to be given in support of any alleged infringement or of any objection impeaching the validity of such letters patent which shall not be contained in the particulars delivered as aforesaid; provided always that the place or places at or in which and in what manner the invention is alleged to have been used or published prior to the date of the letters patent shall be stated in such particulars. Provided also, that it shall and may be lawful for any judge at chambers to allow such plaintiff or defendant to amend the particulars delivered as aforesaid upon such terms as to such judge shall seem fit.

Particulars of breaches.

The plaintiff's particulars of breaches cannot be called in aid of the defective particulars of objections. (*a*)

Where in an action for the infringement of a patent for "improvements in obtaining pictures or representations of objects" the plaintiff delivered the following particulars of breaches—"that the defendant on the 1st of August, 1853, and on divers days between that day and the commencement of this suit, at No. 65, Oxford Street, in the county of Middlesex, infringed the plaintiff's patent by making, using and selling pictures and portraits made and executed according to the plaintiff's invention in the said

(*a*) *Palmer* v. *Cooper*, 9 Exch. 231.

patent, otherwise than in relation to the parts disclaimed, and also infringed the said patent by making, using and selling pictures and portraits whereby the plaintiff's said invention was counterfeited, imitated and resembled," the Court refused to compel him to specify particularly the persons and occasions, and the particular parts of the specification alleged to have been infringed. (*a*)

Particulars of objections, Effect of.

The requirements of the statute as to the notices by the defendant are clearly confined to notices affecting the validity of the patent only, and a defendant therefore may object to the validity of an assignment although the objection has not been specified in the notice of objections delivered by him. (*b*)

May not go beyond pleas.

The statute does not make the notice of objections stand in the place of pleas, and the defendant cannot by his notice of objection go beyond his pleas. (*c*)

Object of statute.

The object of the statute in requiring the defendant to deliver particulars of objections was to enable the plaintiff to know what objections he had to meet; and the particulars must be precise and definite. It is not sufficient to say that if any part of the invention is now the same is useless, but the defendant must point out what part; or to say that the improvements, or some of them, have been used before: the defendant must point out which. (*d*)

Where the defendant pleaded that the nature of the invention and the manner in which the same was to be performed were not particularly ascertained and described in the specification, and that the invention was not new,

(*a*) *Talbot* v. *La Roche*, 15 C. B. 310.

(*b*) *Chollet* v. *Hoffman*, 7 El. & Bl. 686.

(*c*) *Macnamara* v. *Hulse*, Car. & M. 471.

(*d*) *Fisher* v. *Dewick*, 4 Bing. (N. C.) 706; 6 Scott, 587; 1 Webs. P. R. 264.

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and the particulars of objections stated that the specification did not describe the nature of the invention and the manner in which it was to be performed and that the invention was not new and was either wholly or in part used and made public before the obtaining of the letters patent, it was held that the first of the objections was sufficient, but that the second was bad and ought to have pointed out what portions of the alleged invention were previously in use.(*a*)

An objection that the defendant did not state the best mode with which he was acquainted is sufficient.(*b*) Books intended to be relied on must be distinctly described.(*c*)

Notice of objections is to give plaintiff more information than plea.

The notice of objections is intended to give the plaintiff more information than the plea,(*d*) and it is no answer to a motion for better notice that the notice is as specific as the plea.(*e*) Where a defendant pleaded that the patentee was not the true and first inventor and that the invention was not, when the letters patent were granted, a new invention, it was held that he was not bound to state who was the first inventor nor under what circumstances the invention had been previously used.(*f*)

In *Leaf* v. *Topham*(*g*) the defendant delivered a notice of objections, one of which stated that the patentee did

(*a*) *Heath* v. *Unwin*, 10 M. & W. 684.

(*b*) *Jones* v. *Berger*, 5 M. & Gr. 208; 1 Webs. P. R. 544.

(*c*) *Ib.*

(*d*) *Neilson* v. *Harford*, 8 M. & W. 806; 1 Webs. P. R. 370; *Jones* v. *Berger*, 5 M. & Gr. 208; 1 Webs. P. R. 544; *Bulnois* v. *Mackenzie*, 4 Bing. (N. C.) 127; 1 Webs. P. R. 260.

(*e*) *Betts* v. *Walker*, 14 Q. B. 363.

(*f*) *Russell* v. *Ledsam*, 11 M. & W. 647; *Heath* v. *Unwin*, 10 *ib.* 684; *Bulnois* v. *Mackenzie*, 4 Bing. (N. C.) 127; 1 Webs. P. R. 260.

(*g*) 14 M. & W. 146.

not by his specification sufficiently describe the nature of the supposed invention; and the other stated that he had not caused any specification sufficiently describing the nature of the supposed invention to be enrolled. It was held that the last objection was not sufficiently precise; and an amendment was ordered by inserting the word "other" before "specification."

A notice of objections stated that the invention was known to certain persons (naming them) and others before the date of the patent. The Court refused to strike out the words "and others." (*a*)

Not conclusive.

The notices of objection delivered by the defendant are not conclusive at his peril, but the Court has power to order a further and fuller notice. (*b*) Where the defendant pleaded that the grant of letters patent was obtained by fraud and misrepresentation, it was held that he ought to state in his notice of objections what the fraud and misrepresentation was. (*c*)

Where the defendant relies on a general user of the invention, it is sufficient to state in the particulars of objection that the invention was used by manufacturers generally at a particular place without naming any person or specifying any manufactory. If he relies on a specified user by certain persons named, proof of user by any one of the persons named will support his objection. (*d*) If the place or places are not named, the defendant will not be allowed to give evidence of the user. (*e*)

(*a*) *Bentley* v. *Keighley*, 7 M. & Gr. 652.

(*b*) *Bulnois* v. *Mackenzie*, 4 Bing. (N. C.) 127; 1 Webs. P. R. 260; *Perry* v. *Mitchell*, 1 Webs. P. R. 269; *Electric Telegraph Co.* v. *Nott*, 4 C. B. 462.

(*c*) *Russell* v. *Ledsam*, 11 M. & W. 647.

(*d*) *Palmer* v. *Wagstaff*, 8 Exch. 840.

(*e*) *Palmer* v. *Cooper*, 9 Exch. 213.

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Further notice.

If the plaintiff thinks that the notice of objection does not sufficiently raise the point on which the defendant intends to rely, his course is to apply to a judge at chambers for an order for the delivery of a more specific notice, and if he omits to do so he cannot 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. (*a*)

If the evidence is within the literal meaning of the words of the particulars, however general the statement, it will be received at the trial. Thus where the particulars stated that the invention had been generally known and publicly used in corn mills for many years previously, evidence that the invention had been in use before the date of the patent in mills in Cheshire was admitted. (*b*)

17 & 18 Vict. c. 125, s. 51. Interrogatories.

It is no ground for refusing to answer interrogatories under s. 51 of the Common Law Procedure Act, 1854, when the defendant admits the infringement; that the defendant's customers *may* be liable to actions for infringement. (*c*) Where the cause of action arose more than six years before the action was commenced, the Court refused to allow the plaintiff to administer interrogatories before declaration. (*d*)

Discovery.

In an action by a patentee against a licensee, the declaration stated that the plaintiff obtained a patent for an improved roving machine, and had covenanted to

(*a*) *Neilson* v. *Harford*, 8 M. & W. 806; 1 Webs. P. R. 331; *Hull* v. *Bollard*, 1 H. & N. 134.

(*b*) *Hull* v. *Bollard*, 1 H. & N. 134.

(*c*) *Tetley* v. *Easton*, 18 C. B. 643. As to the form and extent of interrogatories which may be exhibited to a defendant before plea, see *Thomas* v. *Tillie*, 17 Ir. C. L. R. 783.

(*d*) *Jones* v. *Pratt*, 6 H. & N. 697.

grant a licence on certain terms to the defendant, he paying so much for each machine made with the plaintiff's invention, and covenanting to keep a true account of and pay for all the machines he made with the plaintiff's invention applied; and that he would not during the continuance of the licence, make or vend machines, without the invention of the plaintiff. Breaches first that the defendant did not pay the sums due for licences, and secondly, that he made and sold machines without the plaintiff's invention being applied. The defendant, in answer to the interrogatories, stated that he had made and sold 1,200 machines, to which the plaintiff's invention had not been applied, but declared that he could not give any information as to the persons to whom he had sold them; and that he could not give any further information about them. The defendant, however, gave the addresses of the persons to whom he had sold the machines with the invention, but alleged that he could give no 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; it was held that the defendant was entitled to such particulars as should describe 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 machine 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 insuffi-

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cient, 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 *vivâ voce*. (*a*)

Inspection.

By 15 & 16 Vict. c. 83, s. 42, it is provided that 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 is then sitting, or if it is not then sitting, 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.

Affidavit must be clear and precise.

The affidavit in support of an application for an order under this section must be clear and precise. Where in an action for the infringement of a patent for numbering and paging books, it was sworn in the affidavit "that the machine used by the defendants for paging and numbering their books is the same for which the plaintiff has obtained a patent," it was held that the affidavit was too vague and defective, and that it ought to have stated at least that there was such a machine, and that the plaintiff had reason to believe it was an infringement. (*b*)

When application may be made.

There is no limitation in the Act as to the time when the application is to be made, the enactment is general and applicable whenever an action is pending; an application therefore made before the delivery of the declaration is not premature.

Inspection not matter of course.

But an order for inspection will not be granted as of course, and the applicant must show that it is material and really wanted for the purposes of

(*a*) *Jones* v. *Lee*, 25 L. J. Exch.) 241.

(*b*) *Shaw* v. *The Bank of England*, 22 L. J. Exch. 26.

the cause.(*a*) The inspection mentioned in the statute is an inspection of the instruments or machinery manufactured by the parties with a view to evidence of infringement, and does not refer to an inspection of books, which is provided for by another Act of Parliament.(*b*) The Court will not compel the defendant to grant an inspection of his books, under 14 and 15 Vict. c. 99, s. 6, unless a *primâ facie* legal right is established by the plaintiff, and it is not enough for the plaintiff to show that he has been injured, and that there is a possibility of his discovering the amount of injury that he has suffered, if he is allowed to examine the books.(*c*)

An order will not be made, if the defendant positively swears that he does not use the plaintiff's invention, and the plaintiff does not swear that the invention is used. Thus in an action for the infringement of a patent for a mode of making veneers or mouldings, an order was refused, as it was doubtful on the plaintiff's affidavit whether the patent was for the kind of veneering, or for the process by which it was done; and the defendant positively swore that he used no machinery in his process.(*d*)

In *The Patent Type Founding Co.* v. *Walter*,(*e*) an application to the Court of Exchequer for leave to inspect, and if necessary to take specimens of type, alleged to be made according to the plaintiff's patent, for the purpose of analysis, was refused. The plaintiffs

(*a*) *Amies* v. *Kelsey*, 22 L. J. Q. B. 84.

(*b*) *Vidi* v. *Smith*, 3 El. & Bl. 974. And see *Smith* v. *The Great Western Railway Co.*, 3 W. R. 69.

(*c*) *Smith* v. *The Great Western Railway Co.*, 3 W. R. 69.

(*d*) *Meadows* v. *Kirkman*, 29 L. J. Exch. 205.

(*e*) 5 H. & N. 192.

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thereupon filed a bill against the defendant, and an order was made for him to deliver a sample of type to the plaintiffs for analysis. (*a*) Where the defendants refused to produce their books before the Master for the purpose of taking an account, on the ground that they were about to appeal, an order was nevertheless made for production and inspection of the books. (*b*)

Injunction.

By 15 & 16 Vict. c. 83, s. 42, it is provided that 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.

Rule for injunction is rule to show cause only in first instance.

A rule for a writ of injunction to restrain a defendant from infringing a patent is a rule to show cause only in the first instance. (*c*)

Costs.

It is provided, by 5 & 6 Will. IV. c. 83, s. 6, that 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

(*a*) S. C. Johns. 727.

(*b*) *Saxby* v. *Easterbrook*, L. R. 7 Exch. 207.

(*c*) *Gittins* v. *Symes*, 15 C. B. 362, a case which was decided under 17 & 18 Vict. c. 125, s. 82.

regard to the general result of the trial. And by the Patent Law Amendment Act,(*a*) it is provided that, in taxing the costs of 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 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 that it shall be lawful for the judge before whom any such action shall be tried to certify 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. This section virtually repeals section 3 of 5 & 6 Will. IV. c. 83.

Where the defendant obtained a verdict on a plea which went to the whole action, it was held that he was entitled to the general costs of the cause, deducting the costs of the objections on which the plaintiff succeeded and of the issues found for him.(*b*)

(*a*) 15 & 16 Vict. c. 83, s. 43. (*b*) *Losh* v. *Hague*, 5 M. & W. 387.

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Judge's certificate.

The defendant will not be entitled to the costs of his particulars of objections, even in the case of a non-suit, if the judge has not certified that they have been proved. "These particulars," said Parke, B., "and the costs with respect to them, are wholly the creatures of this Act of Parliament; and the Act makes the judge's certificate a condition precedent to the recovery of such costs from the opposing party." (*a*)

The certificate should be as to the determination of each objection, of which notice has been given, and not as to the issues. (*b*)

Where the defendant pleaded that the invention was not new and a verdict was given for the plaintiff, it was held that the validity of the patent might be considered to have come in question under the plea, so as to entitle the plaintiff to a certificate to that effect under 5 and 6 Will. IV. c. 83, s. 3. (*c*)

The judge has no power to grant a certificate after taxation. (*d*)

If the defendant at the trial consents to a verdict for the plaintiff, without any evidence being given to prove the validity of the patent, the judge will not certify that the validity of the patent came in question before him, as the certificate would affect third parties; and it would be possible for two parties by collusion to consent to a verdict in favour of a patent, and to use the certificate afterwards to the injury of another party who was really contesting the validity of the patent. (*e*)

(*a*) *Honiball* v. *Bloomer*, 10 Exch. 538.

(*b*) *Losh* v. *Hague*, 5 M. & W. 387.

(*c*) *Gillett* v. *Wilby*, 9 C. & P. 334.

(*d*) *Gillett* v. *Green*, 7 M. & W. 347.

(*e*) *Stocker* v. *Rodgers*, 1 C. & K. 99.

Where an action was brought to recover damages for an alleged infringement, and a compromise was made upon terms embodied in an order of *nisi prius*, and a verdict was by agreement entered into for 40*s.* and costs, "with all usual certificates," and the judge indorsed and signed on the record a certificate that the record in another case in which the validity of the letters patent had come in question, and the certificate had been given in evidence before him, it was held that the certificate was improperly granted, the record and certificate 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. (*a*)

Trial abandoned, costs of particulars.

If a plaintiff gives notice of trial, which is afterwards abandoned, the defendant is entitled to the costs of preparing the particulars of objection and the evidence in support of them, as the statute applies only to cases where there has been a trial; where there has been no trial, the law stands as it did before. (*b*)

Where the defendant applied for time to plead, which was granted upon the terms that he should take short notice of trial, and that the cause might be set down for trial before issue joined, in order that the case might be tried at the next sittings, and the pleas were afterwards delivered, and on the application of the plaintiff a special jury was nominated but not struck, and the action was abandoned without joinder of issue or notice of trial, it was held that the master was right in disallowing the defendant's costs of preparing for the trial. (*c*)

(*a*) *Bovill* v. *Hadley*, 17 C. B. (N. S.) 435.

(*b*) *Greaves* v. *Eastern Counties Railway Co.*, 1 El. & El. 961.

(*c*) *Curtis* v. *Platt*, 10 Jur. (N. S.) 823.

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If a cause has not been tried, the defendant is not entitled, under 6 Geo. IV. c. 50, s. 34, to the costs of a special jury, for which he has applied. (*a*)

Account.

The Court may, upon the application of the plaintiff or defendant respectively, make such order for an account, and give such directions respecting such account and the proceedings therein as the Court may think fit. (*b*)

Power of court.

The meaning of the legislature was to vest in the Courts of Common Law in which actions for the infringement of patent rights might be brought the power to order an injunction, inspection and account previously exclusively exercised by Courts of Equity; so that suitors might be saved the vexation, delay, and expense to which they had before been exposed. The Court may grant either an interlocutory order, an account of all 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. 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. (*c*)

Retrospective account.

No retrospective account can be granted before final judgment, but the Court has authority to order the defendant pending the action to keep an account of all the articles that he sells made upon the principle alleged to

(*a*) *Greaves* v. *Eastern Counties Railway Co.*, 1 El. & El. 961.

(*b*) 15 & 16 Vict. c. 83, s. 42.

(*c*) *Holland* v. *Fox*, 3 El. & Bl. 983.

be an infringement of the plaintiff's patent, and of the profits arising therefrom until further order of the Court; on condition of the plaintiff agreeing to waive all claim to recover more than nominal damages at the trial of the action, and on condition that in case the verdict and judgment in the action shall be in favour of the defendant he will pay to him the expense of keeping such account. (*a*)

Reasonable evidence of the validity of the patent and of its having been infringed must be given. (*b*)

As there can be no order for an account of profits until final judgment, any prior account ordered to be kept of sales pending the action can only be ancillary to this account of profits; the interim account of sales becoming nugatory if there should be a verdict and judgment for the defendant. (*c*)

An account will be granted as soon as the verdict is given, and the defendant cannot refuse to allow his books to be inspected for the purpose of taking an account on the ground that he is about to appeal. (*d*) Where the patentee has obtained a verdict, an account will be ordered of all pirated goods made and sold by the defendant, and of the number he has in stock, and he will be ordered to pay over the price received for the articles sold and the value of those remaining in stock. (*e*)

If a person adopts a part only of a patentee's invention he will be liable to account. (*f*)

(*a*) *Vidi* v. *Smith*, 3 El. & Bl. 969.

(*b*) *Ib.*

(*c*) *Holland* v. *Fox*, 3 El. & Bl. 985.

(*d*) *Saxby* v. *Easterbrook*, L. R. 7 Exch. 207.

(*e*) *Holland* v. *Fox*, 23 L. J. Q. B. 211.

(*f*) *Trotman* v. *Wood*, 16 C. B. (N. S.) 479.

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The account will be for all profits that the defendant has made by selling the patented article, not of all profits of which the plaintiff has been deprived by the infringement. (*a*)

(*a*) *Elwood* v. *Christy*, 18 C. B. (N. S.) 494. For form of rule or order, see *Holland* v. *Fox*, 3 E. & B. 977; *Walton* v. *Lavater*, 8 C. B. (N. S.) 191.

CHAPTER XIV.

OF A SUIT IN EQUITY.

Jurisdiction of the Court of Chancery.

THE jurisdiction of the Court of Chancery in respect of patents is founded upon the assumption of the legal rights of the patentee to the exclusive use of the invention comprised in his letters patent; and the Court exercises great latitude and discretion in dealing with any application made to it. (*a*)

If the patentee is unable to support his patent on a trial to ascertain its validity, a bill to restrain the infringement of the patent cannot be supported. (*b*)

It must be remembered that the Court now has the power of determining questions of law or fact. (*c*)

Injunction may be granted though title not ascertained by trial.

It was said at one time that if the title was not clear at law the Court would not grant an injunction, till the title was ascertained, but in the case of *The Universities of Oxford and Cambridge* v. *Richardson*, (*d*) Lord Eldon refused to accede to that proposition, and said: "There are many instances within my own memory in which this Court has granted or continued an injunction to the hearing under such circumstances. In the case of patent rights if the party gets his patent and puts his invention

(*a*) *Bacon* v. *Jones*, 4 M. & Cr. 436.

(*b*) *Calcraft* v. *West*, 2 J. & Lat. 123.

(*c*) See *post*, Trial of questions of law or fact.

(*d*) 6 Ves. 707.

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into execution and has proceeded to a sale that may be called possession under it, however doubtful it may be whether the patent can be sustained; this Court has lately said possession under colour of title is enough to enjoin and continue the injunction until it shall be proved at law that it is only colour of title and not real title."

Possession under colour of title.

Course of procedure on application for injunction.

On an application for an injunction the Court has the power to grant the injunction without more; this course however will not be taken when the defendant questions the validity of the patent, but the Court will either grant an injunction and direct the plaintiff to establish his legal title, or will require him to establish his legal title and suspend the grant of the injunction until that investigation is completed, the defendant in the meantime keeping an account.(a) In *Bridson* v. *M'Alpine*,(b) Lord Langdale, M.R., said: "When an injunction is asked to restrain the infringement of a patent, the Court has occasion to consider, first the validity of the patent, and secondly the fact of the infringement. Where these two facts are established, it is within the power as it is the duty of the Court to grant the injunction. It depends on the degree of doubt which exists on these questions whether the Court will grant the interim injunction. In such cases it will cautiously consider the degree of convenience or inconvenience to the parties by granting or not granting the injunction. These things are to be carefully considered; the right between the parties is a legal right, and being a legal right, the Court in cases where the matter is doubtful, is naturally anxious to obtain the decisior of the Court of Law where the

(a) *Bacon* v. *Jones*, 4 M. & Cr. 436; *Hill* v. *Thompson*, 3 Mer. 626.

(b) 8 Beav. 231.

matter is properly cognizable, before it interferes to prevent a party exercising his *primâ facie* right. According to the doubt which may exist in the mind of the Court upon the facts and according to the degree of inconvenience to the parties, the Court not thinking fit to grant the injunction at the time, may take one of several courses; it may either refuse to grant the injunction simply, or it may refuse it on the terms of the party undertaking to keep an account, or it may direct the motion to stand over, on the terms of the plaintiff proceeding to a trial at law. Where it has been determined that the plaintiff must first establish his right at law, the Court does not generally interfere with the mode of trying the legal question, though in some instances it may require the parties to make the necessary admissions of facts to facilitate the trial. It is to be remembered that the proceeding is not like the trial of an issue, but an action in the ordinary form, with which generally the Court will not interfere until the legal right has been determined at law. I must, however, qualify this by saying that in cases of overwhelming mischief, the Court has authority to interfere at any time."

Injunction not granted before title ascertained if injury to defendant great.

In certain cases an injunction if improperly granted might cause infinitely more mischief to the defendant than the delay in granting it would cause to the plaintiff, as where the defendant's works are very extensive, and in such a case the legal right must be proved beyond all possibility of doubt before an injunction will be granted. (*a*)

The Court will not as a general rule grant an injunc-

(*a*) *Neilson* v. *Forman*, 2 Coop. C. C. 61, n. S. C. *nom.* *Neilson* v. *Thompson*, 1 Webs. P. R. 278.

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tion unless satisfied, the legal right being disputed, that in the result, such legal right would be established, or the legal right not being disputed that the acts complained of are an infringement.(*a*)

Injunction granted where uninterrupted enjoyment.

Where the plaintiff has had uninterrupted enjoyment of his patent, the court will not look into the title, but will give credit to it, and will continue an injunction to restrain infringement until it has been shown that the title is bad.(*b*)

In *Hicks* v. *Raincock*,(*c*) a demurrer to a bill, on the ground that the plaintiff had not established his title at law, was overruled.

In *Hill* v. *Thompson*,(*d*) Lord Eldon said: "Where a patent has been granted, and an exclusive possession of some duration under it, the Court will interpose its injunction without putting the party previously to establish the validity of his patent by an action at law. But where the patent is but of yesterday, and upon an application being made for an injunction, it is endeavoured to be shown in opposition to it that there is no good specification, or otherwise that the patent ought not to have been granted, the Court will not from its own notions respecting the matter in dispute act upon the presumed validity or invalidity of the patent without the right having been ascertained by a previous trial, but will send the patentee to law and oblige him to establish the

(*a*) *The Electric Telegraph Co.* v. *Nott*; 2 Coop. C. C. 48; *Wood* v. *Cockrell*, *ib.* 58, n.; *Jones* v. *Peurce*, *ib.* 1 Webs. P. R. 122; *Renard* v. *Levinstein*, 2 H. & M. 628.

(*b*) *Boulton* v. *Bull*, 3 Ves. 140; *Harmer* v. *Plane*, 14 Ves. 130; *Bickford* v. *Skewes*, 4 M. & Cr. 500.

(*c*) 2 Dick. 647.

(*d*) 3 Mer. 622; 1 Webs. P. R. 236.

validity of his patent in a court of law before it will grant him the benefit of an injunction."

In *Caldwell* v. *Vanvlissingen*, (*a*) Sir G. Turner, V.C., said: "It is part of the duty of this Court to protect property pending litigation; but when it is called upon to exercise that duty, the Court requires some proof of title in the person who calls for interference. In the case of a new patent, this proof is wanting: the public whose interests are affected by the patent have had no opportunity of contesting the validity of the patentee's title, and the Court therefore refuses to interfere until his right has been established at law. But in a case where there has been long enjoyment under the patent (the enjoyment of course including use) the public have had the opportunity of contesting the patent; and the fact of their not having done so successfully affords at least *primâ facie* evidence that the title of the patentee is good; and the Court therefore interferes before the right is established at law." (*b*)

The Court will not on any suggested defect in the specification allow the patentee's privilege to be disturbed until the title has been decided. (*c*)

Where a legal right exists the Court cannot refuse to interfere for its protection upon grounds which depend exclusively upon considerations of national policy. (*d*)

A patentee does not lose his title by exclusive enjoyment because he has omitted to proceed by *scire*

(*a*) 9 Hare, 424.

(*b*) See also *Stevens* v. *Keating*, 2 Ph. 335; *Newall* v. *Wilson*, 2 D. M. G. 291; *Bovill* v. *Goodier*, L. R. 2 Eq. 200; *Curtis* v. *Cutts*, 2 Coop. C. C. 60, n.

(*c*) *Muntz* v. *Foster*, 2 Webs. P. R. 95.

(*d*) *Caldwell* v. *Vanvlissingen*, 9 Hare, 215.

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facias to set aside a subsequent patent extending to part of his invention, unless such subsequent patent is put in practice.(*a*) If the patentee has not only proved enjoyment under the patent, but has also successfully maintained actions at law against infringers, the Court will at once grant an injunction, unless there are sufficient grounds for withholding its interference.(*b*)

An allegation which is not denied that the defendant's circumstances are such as to render it improbable that he would be able to meet the pecuniary demands to which he would be liable if unsuccessful in establishing his alleged legal right, is an additional reason for granting an injunction under such circumstances.(*c*) If however it appears from the nature of the invention, or from the conflicting evidence as to its novelty, that the validity of the patent is doubtful, or if the evidence of exclusive possession is not satisfactory, an injunction will not be granted although the patent is of long standing.(*d*)

Injunction after verdict.

Where the plaintiff has been directed to ascertain the validity of the patent and has obtained a verdict, an injunction will be granted almost as a matter of course,(*e*) and where a motion that the verdict should be set aside and a nonsuit entered had failed, Lord Lyndhurst said that it was a matter of course that the injunction should issue till the hearing.(*f*)

(*a*) *Newall* v. *Wilson*, 2 D. M. G. 290.

(*b*) *Caldwell* v. *Vanvlissingen*, 9 Hare, 425; *Davenport* v. *Goldberg*, 2 H. & M. 282; *Bovill* v. *Goodier*, L. R. 2 Eq. 200.

(*c*) *Newall* v. *Wilson*, 19 L. T. (N. S.) 161.

(*d*) *Collard* v. *Allison*, 4 M. & Cr. 487.

(*e*) *Neilson* v. *Harford*, 1 Webs. P. R. 373.

(*f*) *Russell* v. *Cowley*, 2 Coop. C. C. 59, n.

If a trial has been directed the result of which is not conclusive as to the right of the patentee, he must proceed again to prove his right, but no terms will be imposed on him, and the Court may grant an injunction at once, as more evil may be done to the plaintiffs by delaying the injunction than to the defendants by granting it, even if the patent afterwards turns out to be bad.(*a*)

Terms.

If after an injunction has been granted upon the terms of the plaintiff's ascertaining his legal right, he does not proceed to trial, the injunction will be dissolved.(*b*)

Assignee.

Where the plaintiff is assignee of the patent the Court may on directing a trial instead of granting an injunction, order the defendant to admit the plaintiff's title to the patent,(*c*) but where the plaintiff is merely equitable assignee no admissions will be required.(*d*)

Infringement must be shown.

Before an injunction will be granted a fair *primâ facie* case of infringement must be proved, even though the validity of the patent is not denied; and where the evidence on the question of infringement is conflicting, an injunction will not be granted until it has been ascertained by a trial that the acts complained of amount to an infringement of the patent.(*e*)

Where the alleged acts of piracy have taken place

(*a*) *Boulton* v. *Bull*, 3 Ves. 140; *Neilson* v. *Harford*, 1 Webs. P. R. 373; *Bridson* v. *Benecke*, 12 Beav. 7; *Lister* v. *Leather*, 3 Jur. (N. S.) 433; *Baxter* v. *Combe*, 3 Ir. Ch. 245.

(*b*) *Bickford* v. *Skewes*, 4 M. & Cr. 501.

(*c*) *Morgan* v. *Seaward*, 1 Webs. P. R. 169.

(*d*) *Pidding* v. *Franks*, 1 Mac. & G. 56.

(*e*) *Hill* v. *Thompson*, 3 Mer. 626; 1 Webs. P. R. 236; *Bridson* v. *McAlpine*, 8 Beav. 230; *The Electric Telegraph Co.* v. *Nott*, 2 Coop. C. C. 41; *Caldwell* v. *Vanvlissingen*, 9 Hare, 424.

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abroad it becomes the duty of the defendant to give evidence of a negative character to prove (in answer to the *primâ facie* case made by the patentee) that his process is different from that which has been patented, and where such negative evidence was not given by the defendant, but positive evidence on behalf of the patentee was given by a workman employed in the foreign manufactory that the processes were identical, it was held that there was sufficient evidence to warrant the grant of an injunction. (*a*)

The length of time for which the patentee has had exclusive enjoyment will influence the Court in granting an injunction where there is a *primâ facie* case of infringement. (*b*)

If the patented article is made abroad, and is sent to this country for shipment to foreign customers, there will be such a user of the invention as to entitle the patentee to an injunction. (*c*)

It is no answer to a motion for an injunction that the defendant has volunteered to keep an account; (*d*) nor that he has promised not to repeat the infringement. (*e*)

Where the Court is of opinion that the plaintiff is entitled to a decree at once, the final order will not be delayed pending an appeal. (*f*)

Two patents.

Where two parties have obtained patents for the same invention the Court will not interfere to prevent either of

(*a*) *Neilson* v. *Betts*, L. R. 5 H. L. 1.

(*b*) *Davenport* v. *Richard*, 3 L. T. (N. S.) 503.

(*c*) *Betts* v. *Neilson*, L. R. 3 Ch. 429; *Neilson* v. *Betts*, L. R. 5 H. L. 1.

(*d*) *Renard* v. *Levinstein*, 2 H. & M. 628.

(*e*) *Losh* v. *Hague*, 1 Webs. P. R. 200; *Geary* v. *Norton*, 1 De G. & S. 9.

(*f*) *Penn* v. *Bibby*, L. R. 3 Eq. 308.

them from doing what he has a right to do by the act of the Crown, but will leave them to try their legal right by *scire facias*. (*a*)

Admissions of defendant.

The conduct or admissions of the defendant may be such as to show that he has admitted the validity of the patent. Thus where the plaintiff and defendant had worked the patent as partners under circumstances which afforded a presumption that, during the continuance of the partnership the defendant had not disputed that the patent was valid, the Court, upon an interlocutory application for an injunction, assumed that the patent was valid; (*b*) and where the defendant had not contested the validity of the patent when the plaintiff had raised the question in a previous suit of which the defendant had knowledge, it was held that the conduct of the defendant entitled the plaintiff to an injunction until the validity of the patent could be ascertained. (*c*)

In *Dudgeon* v. *Thompson* (*d*) the plaintiff in the year 1872 commenced proceedings against the defendant in Scotland, and the Lord Ordinary granted an interdict which was afforded by the Court of Session in 1873. On an application for an injunction, Sir G. Jessel, M. R., said: "The Court can grant an injunction before the hearing where the patent is an old one and the patentee has been in long and undisturbed enjoyment of it, or where its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to

(*a*) *Copeland* v. *Webb*, 11 W. R. 134. See also *Basket* v. *Cunningham*, 2 Eden, 137.

(*b*) *Muntz* v. *Grenfell*, 2 Coop. C. C. 61, n.

(*c*) *Betts* v. *Menzies*, 3 Jur. (N. S.) 357.

(*d*) 30 L. T. (N. S.) 244.

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enable the Court to say, that, as against the defendant himself, there is no reason to doubt the validity of the patent."

Injunction may be granted though patent recent.

If the patent is new, and if it has not acquired the sanction of enjoyment, the Court will as a rule, however plain the case may be, exercise its own judgment upon the subject until the plaintiff has established his legal title. (*a*)

But the Court has power to grant an injunction to restrain the infringement of a recent patent without requiring the patentee to establish his right, if it appears that such a course will do justice between the parties. (*b*)

Where an action has been brought to establish the validity of a patent, and it has been referred to arbitration, the award of the arbitrator will be considered as equivalent to a verdict establishing the validity of the patent against which there has been no motion for a new trial. (*c*)

Where the award is that the patent is not illegal the defendant in a subsequent suit between the same parties is not estopped from disputing the validity of the patent. (*d*)

Injunction not granted where trial ordered.

An injunction will not be granted after the patentee has been directed to ascertain his right by a trial until the title is fully decided. Thus; after the patentee had obtained a verdict in an action; an application to revive

(*a*) *Hill* v. *Thompson*, 3 Mer. 626; 1 Webs. P. R. 236; *Caldwell* v. *Vanvlissingen*, 9 Hare, 424.

(*b*) *Bacon* v. *Jones*, 4 M. & Cr. 436; *The Electric Telegraph Co.* v. *Nott*, 2 Coop. C. C. 49; *Gardner* v. *Broadbent*, 2 Jur. (N. S.) 1041; *Clark* v. *Ferguson*, 1 Giff. 184; *Renard* v. *Levinstein*, 10 L. T. (N. S.) 176.

(*c*) *Lister* v. *Eastwood*, 26 L. T. 4.

(*d*) *Newall* v. *Elliott*, 9 Jur. (N. S.) 359.

an injunction was ordered to stand over until the result of a motion for a new trial, which the defendant intended to make, should be known. (*a*)

Injunction at the hearing.

The plaintiff is not precluded from asking for an injunction at the hearing, by the fact of his not having applied for it on an interlocutory motion; he must show his title clearly, and if he fails in that and has not previously obtained an injunction, he will not be allowed to use the facts proved in the cause as evidence of a *primâ facie* case. (*b*) "Generally speaking," said Lord Cottenham, "a plaintiff who brings his cause to a hearing is expected to bring it on in such a state as will enable the Court to adjudicate upon it, and not in a state in which the only course open is to suspend any adjudication until the party has had an opportunity of establishing his title by proceedings before another tribunal." (*c*)

An injunction will not be made perpetual until the validity of the patent has been conclusively established. (*d*)

Delay and acquiescence.

A patentee who discovers that his patent is being infringed must proceed to assert his rights at once, and where there has been delay, an injunction will not be granted until the plaintiff has proved his title, even though the Court is in his favour, on the question of the validity of the patent.

But he will have some time allowed him for the purpose of making inquiries. Thus where the plaintiff received

(*a*) *Hill* v. *Thompson*, 3 Mer. 631; 1 Webs. P. R. 238; *Collard* v. *Allison*, 4 M. & Cr. 487; *Bridson* v. *M'Alpine*, 8 Beav. 229.

(*b*) *Bacon* v. *Spottiswoode*, 1 Beav. 382.

(*c*) *Bacon* v. *Jones*, 4 M. & Cr. 437. And see *Patent Type Founding Co.* v. *Walter*, Johns. 731.

(*d*) *Hill* v. *Evans*, 4 De G. F. & J. 288; 8 Jur. (N. S.) 525.

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notice that his patent was being infringed on the 23rd of March, and inquiries were made and some correspondence took place between the parties, and the bill was not filed till the 7th of July, it was held that there had not been such delay as to deprive the plaintiff of his right to an injunction.(*a*) But where the plaintiff knew of the alleged infringement in August, 1835, and did not apply for an injunction till the year 1839, the Court refused either to grant the injunction or to retain the bill; Lord Cottenham, L.C., said: "It is no trifling grievance to a defendant to have a chancery suit hanging over him for four years, in which, if the Court shall so determine at the hearing he will have to account for all the profits he has been making during the intermediate period. Is a defendant to be subject to this annoyance without any absolute necessity or even any proportionate advantage of his adversary, and without that adversary being able to show any reason why he did not apply at an earlier time? It appears to me that it would be very injurious to sanction such a practice, more especially when I can find no case in which the Court has thought it right to retain a bill simply for the purpose of enabling a plaintiff to do that which this plaintiff might have done at any time within the last four years."(*b*) And where the plaintiffs delayed making their application for a year, the injunction was refused, Lord Langdale saying: "I think that a party coming for the assistance of this Court to protect a legal right not absolutely established, against the party who is alleged to have infringed it, ought to come at an early period, I do not say at the earliest possible

(*a*) *Losh* v. *Hague*, 1 Webs. P. R. 201.

(*b*) *Bacon* v. *Jones*, 4 M. & Cr. 436.

period, because that would be putting an application for an injunction on notice, where all parties have an opportunity of being heard in the same condition, as an injunction *ex parte*, which it would not be expedient to do. The rule of this Court is very strict that you must apply in proper time." (*a*)

In *Bovill* v. *Crate* (*b*) an injunction was refused although the delay was caused by the difficulty the plaintiff had found in selecting a person to proceed against from a number who had infringed the patent.

If a patentee is aware that any person is about to use what he alleges to be his invention and he allows him to go on and expend money in erecting machinery and to use it, he will not be entitled to an injunction. (*c*)

Patent expired.

Where the patent has expired the defendant may upon a motion to commit for breach of the injunction show that by the expiration there is no longer any order of the Court existing which he has infringed. (*d*) But an injunction may be granted to restrain the sale, both before and after the expiration of the term limited by the patent, of machines piratically manufactured while the patent is in force with a view of throwing them upon the market when the patent has expired. (*e*)

The invalidity of a patent on the ground of the expiration of a foreign patent cannot be raised at

(*a*) *Bridson* v. *Benecke*, 12 Beav. 1. And see *Baxter* v. *Combe*, 1 Ir. Ch. 284; *Hancock* v. *Bewley*, Johns. 601; *Smith* v. *London and South Western Railway Co.*, Kay, 417.

(*b*) L. R. 1 Eq. 388.

(*c*) *Neilson* v. *Thompson*, 1 Webs. P. R. 275.

(*d*) *Daw* v. *Eley*, L. R. 3 Eq. 496.

(*e*) *Crossley* v. *Beverley*, 1 R. & M. 166, n.; 1 Webs. P. R. 119; *Price's Patent Candle Co.* v. *Bauwen's Patent Candle Co.*, 4 K. & J. 731.

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the hearing if the point has not been raised by the answer. (*a*)

Misrepresentation of machine.

A manufacturer will not be restrained from selling, as the plaintiff's machines, "with the latest improvements," old machines manufactured and sold by the plaintiff without such improvements. (*b*)

Trial of questions of law or fact.

Formerly when a question of law or fact arose during the trial of a suit in equity, it was necessary to state a case for the opinion of a Court of Law on the legal question, or to direct an issue as to the question of fact, or to direct an action to be tried at law if a mixed question of law or fact was raised, the bill being retained until the points in dispute were settled. By 15 and 16 Vict. c. 86, ss. 61 and 62, power was given to the Court of Chancery to determine any question of law which in the judgment of the Court should be necessary to be decided previous to the decision of the equitable question at issue between the parties, and also to determine the legal title or right of any party seeking equitable relief. By 21 and 22 Vict., c. 27, power was given to the Court to try questions of fact before itself either with or without a jury. These powers were enlarged by 25 and 26 Vict. c. 42 which enacted that the Court, should determine every question of law and fact incident to the relief sought, at the same time giving it power to direct issues to be tried at assizes when more convenient.

Where the validity of the patent had already been established in an action, an issue was directed to try whether the plaintiff was the true and first inventor. (*c*)

(*a*) *Bovill* v. *Goodier*, L. R. 2 Eq. 195.

(*b*) *Wilcox & Gibbs Sewing Machine Co.* v. *Wood*, 20 L. T. (N. S.) 10.

(*c*) *Bovill* v. *Goodier*, L. R. 2 Eq. 195.

Effect of the act.

The effect of the Act is simply to say that the Court shall not send away any case to be tried elsewhere, its powers are not limited. The plaintiff will be entitled to an injunction if he can show long and quiet enjoyment of the patent, or if he has successfully supported it in an action, and the Court will now enter into the question of validity on a motion for an injunction. (*a*)

Issues will not be directed to be tried at assizes unless the balance of convenience is greatly in favour of such a course. In *Young* v. *Fernie* (*b*) Lord Westbury said: "I construe the statute as laying down the rule for the future that these things shall be heard and determined in this Court. The proviso operates by way of exception only to the rule; and in order to bring a case within the proviso, the Court must be satisfied that the administration of justice in the particular suit may be more conveniently exercised and promoted by directing issues to be tried by a jury at the assizes or at any sittings in London or Middlesex for the trial of issues in the Common Law Courts, than by completing the hearing and enquiry before itself. In a patent case particularly, and in this case, having regard to the nature of the questions raised, I do not think that anything more inconvenient can be suggested than that where there are mixed questions of law and fact, the one bound up with the other and scarcely capable of being separated, an attempt should be made to cut the cause in halves and to send one half of it to be tried by a jury in a Court of Common Law, reserving the other half for the determination of this Court." (*c*)

Grant of issues.

The usual issues may be granted before the hearing of

(*a*) *Davenport* v. *Jepson*, 1 N. R. 173.

(*b*) 1 De G. J. & S. 354.

(*c*) And see *Fernie* v. *Young*, L. R. 1 H. L. 63; *Copeland* v. *Webb*, 1 N. R. 119.

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the cause, although the defendant denies the validity of the patent.(*a*) Issues will not be granted at the request of the defendant when the motion is opposed by the plaintiff.(*b*)

Separate issues.

The Court may direct separate issues to be tried before itself; the practice is not to be considered as peremptory, but is to be regarded as nothing more than a convenient mode of arranging the questions to be decided by the Court.(*c*)

Addition of new issue.

A defendant will not be allowed to add a totally new issue of fact not in any way suggested by his answer, to the issues which have been already directed for trial, and it appears that to raise such new issue the defendant must file a supplemental answer.(*d*)

Forms of issues.

The forms of issues usually adopted are those ordered to be tried in *Davenport* v. *Jepson*,(*e*) as follows:—

1st. Whether the invention in the pleadings mentioned was the working or making of any manner of new manufacture which others at the time of making the letters patent of the —— day of —— 18— in the pleadings mentioned did not use?

2nd. Whether the grantee of the said letters patent was the true and first inventor of the said new manufacture?

3rd. Whether the specification particularly described and ascertained the nature of the invention for which the said letters patent were granted, and the manner in which the same is to be performed?

(*a*) *Arnold* v. *Bradbury*, L. R. 6 Ch. 706.

(*b*) *Henderson* v. *Runcorn Soap and Alkali Co.*, 19 L. T. (N. S.) 277.

(*c*) *Curtis* v. *Platt*, 11 L. T. (N. S.) 250.

(*d*) *Morgan* v. *Fuller*, L. R. 2 Eq. 296.

(*e*) 1 N. R. 307.

4th. Whether the said defendant A. B. has infringed the said letters patent?

In *Renard* v. *Levinstein*, (*a*) another issue was added, viz. was the invention one of public utility? (*b*)

An issue may be granted to determine whether the invention described in the specification is that for which the patent is granted, and the form is as follows: Whether Her Majesty the Queen did grant the letters patent, dated the —— day of —— 18— for the alleged invention as described and claimed by —— in the specification of the letters patent granted to him for ——. (*c*)

Evidence.

The plaintiff upon trial of issues is entitled to adduce evidence in reply for the purpose of rebutting the case set up by the defendant, as it is impossible for him to know the nature of the evidence which will be produced, but after his evidence in reply has been given, and the evidence for the defence has been summed up, the defendant will not be allowed to bring further evidence to contradict that given by the plaintiff's witnesses in reply. (*d*)

Right to a jury.

If the case is clear, the Court will determine the question of fact without reference to a jury. Where the issues raised have already been determined, the defendant has no right to have them referred to a jury *ex debito justitiæ*. But where there is really a doubtful case, the Court will not refuse to have the question decided by a jury if either party wishes it. (*e*) "If," said Lord

(*a*) 11 L. T. (N. S.) 766.

(*b*) See also *Spencer* v. *Jack*, 11 L. T. (N. S.) 242; *Penn* v. *Jack*, 14 L. T. (N. S.) 496.

(*c*) *Needham* v. *Oxley*, 2 N. R. 232.

(*d*) *Penn* v. *Jack*, L. R. 2 Eq. 314.

(*e*) *Davenport* v. *Goldberg*, 2 H. & M. 282.

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Cairns, "the Court thinks it best that a question should be tried before a jury, a jury can be had, but if in the opinion of the Court a trial without a jury is preferable, neither party can claim a jury as a matter of right. It is a fallacy to say that under the old practice the Court required a legal question to be tried by jury. What it required was the judgment of a Court of Common Law. In most cases it was a necessary incident to proceedings at law that there should be the verdict of a jury before judgment, but these cases were sent to law not that they might be tried by a jury, but because this Court had not jurisdiction to decide upon a legal right. (*a*)

When the plaintiff's counsel made charges which were not raised by the pleadings, and the defendant's counsel thereupon asked for a jury, the application was acceded to, and the cause ordered to stand over. (*b*)

When the Court is sitting without a jury, it will not require the same strictness in matters of pleading as would be necessary in a trial before a jury, but will follow that course of procedure which it deems best to diminish expense, and to hasten the determination of the suit. Thus where the defendant gave no notice of objections to the patent on the ground of prior publication up to the time of proving the cause, and only gave notice of such objection after the plaintiff's case was closed and his own had been opened, a motion by him to amend his particulars of objections by an allegation of prior publication in a given document was allowed. (*c*)

(*a*) *Bovill* v. *Hitchcock*, L. R. 3 Ch. 417. And see *Patent Marine Inventions Co.* v. *Chudburn*, 21 W. R. 745.

(*b*) *Tangye* v. *Stott*, 14 W. R. 128.

(*c*) *Renard* v. *Levinstein*, 11 L. T. (N. S.) 505.

It appears that it is not necessary to certify for a special jury, when questions of fact are tried before the Court itself. (*a*)

New trial.

After the jury have delivered their verdict on a given issue, the Court of Appeal will not, except on a motion for a new trial, or a motion for a judgment *non obstante veredicto* enter into the question and set aside the verdict of the jury, and the same rule holds good upon a trial before a judge alone. (*b*)

There is the same right of appeal from any order of the Court on an application for a new trial as from any other order, (*c*) and the proviso applies equally whether the trial was with or without a jury. (*d*)

The verdict of a judge is of the same effect as the verdict of a jury, and any person may apply for a new trial, either to the judge before whom the trial was had, or to the Court of Appeal in Chancery. (*e*)

Decree enrolled.

An appellant may move for a new trial within the time allowed for that purpose, although the decree has been enrolled. (*f*)

Where the issues raise mixed questions of law and fact, if the decision of one of the questions discussed is sufficient to dispose of the case, final judgment may be given without ordering a new trial. (*g*)

(*a*) *Needham* v. *Oxley*, 2 N. R. 388.

(*b*) *Fernie* v. *Young*, L. R. 1 H. L. 63; *Simpson* v. *Holliday*, *ib.* 315.

(*c*) 21 & 22 Vict. c. 27, s. 3. See also *Simpson* v. *Holliday*, L. R. 1 H. L. 315; *Curtis* v. *Platt*, *ib.* 337.

(*d*) *Curtis* v. *Platt*, L. R. 1 H. L. 337.

(*e*) 21 & 22 Vict. c. 27, s. 5. See also *Fernie* v. *Young*, L. R. 1 H. L. 63: *Curtis* v. *Platt*, *ib.* 337.

(*f*) *Fernie* v. *Young*, L. R. 1 H. L. 63.

(*g*) *Simpson* v. *Holliday*, L. R. 1 H. L. 315.

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Rejection of evidence.

Where a new trial is moved for on the ground that evidence has been improperly rejected; the evidence ought to have been formally tendered to the judge of the Court below and rejected by him. (*a*)

The trial of questions of fact and the hearing of the cause should not be fixed for the same day except by consent. (*b*)

Particulars of breaches and objections.

The plaintiff must before the trial deliver particulars of the breaches complained of by him, and the defendant must deliver particulars of any objections on which he means to rely at the trial. (*c*)

If the particulars and the pleadings give the defendant fair notice of the case intended to be made against him by the plaintiff, they will be sufficient. (*d*) Where the particulars merely mentioned certain machines made by the defendants, they were held to be sufficient. (*e*) The defendant must in his particulars of objections, put the plaintiff in possession of all he himself knows, so far as to enable him to identify the instances alleged, the principle of the court being to prevent the plaintiff from being taken by surprise. (*f*)

Where the defendant had been ordered upon the application of the plaintiff to file amended particulars of objections stating "the names and addresses of the persons by whom, and the places where, and the dates at, and the manner in which" there had been alleged user prior to the date of a patent for improvements in carriages, the alleged invention being that the apparatus for open-

(*a*) *Penn* v. *Bibby*, L. R. 2 Ch. 127.

(*b*) *Fernie* v. *Young*, L. R. 1 H. L. 63.

(*c*) 15 & 16 Vict. c. 83, s. 41. And see *ante*, p. 287, as to practice at law.

(*d*) *Renard* v. *Levinstein*, 11 L. T. (N. S.) 505.

(*e*) *Needham* v. *Oxley*, 1 H. & M. 248.

(*f*) *Curtis* v. *Platt*, 8 L. T. (N. S.) 38.

ing and closing the heads of carriages could be worked by a coachman or person sitting on the driving seat, or by a person sitting behind the carriage; objections that similar head-joints had been commonly used and applied for the same purposes by carriage builders generally throughout Great Britain, long before the date of the plaintiff's patent, and that head-joints similar in form and action to those described in the plaintiff's specification had been actuated in their motions by lever handles and connecting rods before the date of the patent, in carriages fitted up or constructed by various carriage builders in or near London, Liverpool, Manchester, Southampton, and various other of the principal towns of Great Britain, where the carriage building trade had been carried on; were held to be insufficient.(*a*)

It appears, however, that where the objection points to the public use of a particular preparation, the words "by various makers in or near London" might be sufficient, and that if the defendant cannot give the names of the makers in or near London, etc., he will be required to specify the class or classes of invention with respect to which the alleged prior user has taken place.(*b*)

The defendant will not be required to deliver particulars of objections where replication has been filed and the Court has refused to direct issues. (*c*)

Where the novelty of the invention is denied by the answer, the plaintiff has no right to a discovery of the particulars on which the defendant relies as showing prior user.(*d*)

(*a*) *Morgan* v. *Fuller*, L. R. 2 Eq. 297.

(*b*) *Ib.*

(*c*) *Bovill* v. *Goodier*, L. R. 1 Eq. 35.

(*d*) *Daw* v. *Eley*, 2 H. & M.

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Form of order.

The following is the form of order for the delivery of particulars :—" Ordered that the plaintiff do on or before the day of inst. deliver to the solicitor of the said A. B. particulars in writing, of the breaches complained of, and that the said defendant A. B. do on or before the day of inst. deliver to the plaintiff's solicitor, particulars in writing of any objections on which he means to rely at the trial hereby directed." (*a*)

Evidence.

No evidence can be given in support of any alleged infringement or of any objection impeaching the validity of the patent which is not contained in the particulars.(*b*)

The defendant will not be allowed to produce evidence of prior user not disclosed by the objections, even though it has only come to his knowledge since they were delivered; but leave will be given on short notice of

Amendment.

motion, to amend the particulars, so as to introduce such newly discovered evidence, the defendant paying the costs of the application. (*c*)

Pleading.

It is not necessary for the plaintiff to set out the specification of his patent in the pleadings. Where the bill stated that the plaintiff had obtained a patent for new and improved machinery for preparing and spinning hemp, flax, and other fibrous substances, and that in his specification he had set forth, described and ascertained the nature of his invention and the several parts thereof, and by what means the same was to be performed, and referred for greater certainty to the specification and also alleged

725; *Bovill* v. *Smith*, L. R. 2 Eq. 459.

(*a*) *Davenport* v. *Jepson*, 1 N. R. 307.

(*b*) 15 & 16 Vict. c. 83, s. 41.

(*c*) *Daw* v. *Eley*, L. R. 1 Eq. 38; *Renard* v. *Levinstein*, 13 W. R. 229; *Penn* v. *Bibby*, L. R. 1 Eq. 548.

that the plaintiff had been for ten years in the exclusive enjoyment of the patent and had established his legal title by repeated actions, a general demurrer for want of equity was overruled. (*a*)

Nor is it necessary that there should be an express averment of the novelty of the invention, as the allegation of the grant and production of the letters patent throw upon the defendant the *onus* of disputing the novelty. (*b*)

Double plea.

Where a bill was filed to restrain the infringement of a patent, and for an account, and the defendants were desirous of disputing the validity of the patent, on the grounds that so far as the invention was new, it was useless, and that so far as it was useful it was not new, the defendant was allowed to plead first that the invention was not useful; secondly, that it was not new. (*c*)

Order must be obtained.

Before a double plea can be put in, the defendant must obtain an order for leave to do so, and if the plea is filed without an order, it is irregular and liable to be overruled. (*d*)

Parties.

The assignee of a patent may maintain a suit to restrain infringement against the assignor and subsequent licensees from him, who have notice of the assignment, although, when the suit was instituted, the assignment had not been registered. (*e*)

The directors and managers of a company are proper parties. (*f*)

(*a*) *Kay* v. *Marshall*, 1 M. & Cr. 373; *Westhead* v. *Keene*, 1 Beav. 287.

(*b*) *Amory* v. *Brown*, L. R. 8 Eq. 663.

(*c*) *Kay* v. *Marshall*, 1 Keen, 190.

(*d*) *Ib.*

(*e*) *Hassall* v. *Wright*, L. R. 10 Eq. 509.

(*f*) *Betts* v. *De Vitre*, 34 L. J. Ch. 289.

Where a company had been formed for the purchase of the plaintiff's patent, and no written contract had been signed, and no assignment had been executed by the plaintiff, but the company claimed some equitable interest in the patent; a demurrer to a bill, to which the company had been made defendants, on the ground of misjoinder of parties, was overruled. (*a*)

Consolidation of suits.

If the patent has been infringed by several persons who have no connection with each other, there must be a separate bill against each person who has infringed; (*b*) the Court will in such a case direct the suits to be consolidated, if possible. Thus, where a patentee had filed 134 bills; upon a motion by 19 of the defendants, that the plaintiff should proceed in such one only of the suits as he should select for the purpose, until such suit should have been determined, or until the validity of the patent should have been decided, and that the proceedings in the other suits should in the meantime be stayed, the defendants undertaking to abide by the result of the suit to be selected, so far as the validity of the patent was concerned, in like manner as if the same result had been arrived at in the several suits; a trial of the validity of the patent as against the plaintiff and the several defendants before the Court, to be conducted by three of the defendants representing different classes of infringers, on behalf of the remainder, all objections to be delivered within a fortnight; was ordered, with liberty for defendants in any of the other suits to apply to be made parties. (*c*)

In a similar case, Sir W. P. Wood, V. C., suggested that the plaintiff, instead of filing many bills, might, after

(*a*) *Westhead* v. *Keene*, 1 Beav. 287.

(*b*) *Dilly* v. *Doig*, 2 Ves. J. 478.

(*c*) *Foxwell* v. *Webster*, 10 Jur. (N. S.) 136; 2 Dr. & Sm. 250.

getting information of case after case of infringement, select that which he thought the best to try the question fairly, and proceed in that case to obtain his interlocutory injunction, at the same time writing to the others who were *in simili casu*, saying: "Are you willing to take this as a notice to you that the present case is to determine yours? Otherwise I shall proceed against you by way of interlocutory injunction; and if you do not object on the ground of delay, I do not mean to file bills against all of you at once. Am I to understand that you make no objection of that kind? If you do not object, I shall file a bill against only one of you."(*a*)

Affidavits.

The plaintiff, in applying for an injunction *ex parte*, must swear as to his belief that he is the original inventor; for although when he obtained his patent, he might very honestly have sworn as to his belief of such being the fact, yet circumstances may have intervened, or information been communicated, sufficient to convince him that the patent was not his own original invention, and that he was under a mistake when he made his previous declaration to that effect.(*b*) The reason that such an affidavit is required, is that the injunction asks that a legal title may be protected, which legal title ought to be sworn to, and the facts supported before the Court.(*c*) The motion may be ordered to stand over, to allow such an affidavit to be made.(*d*)

(*a*) *Bovill* v. *Crate*, L. R. 1 Eq. 391.

(*b*) Per Lord Eldon in *Hill* v. *Thompson*, 3 Mer. 624; 1 Webs. P. R. 236; *Sturtz* v. *De la Rue*, 5 Russ. 329; *Mayer* v. *Spence*, 1 J. & H. 87.

(*c*) *Gardner* v. *Broadbent*, 2 Jur. (N. S.) 1041.

(*d*) *Mayer* v. *Spence*, 1 J. & H. 87; *Whitton* v. *Jennings*, 1 Dr. & Sm. 211.

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The affidavit must state particularly in what the alleged infringement consists. (*a*)

The plaintiff must prove, first, that the thing made is his own patented article, and, secondly, that it has been unlawfully sold; and he must be prepared to swear distinctly that it is not manufactured by him or his agents. (*b*)

If there is any material variation between the allegations in the bill or the aid sought by it and the affidavits in support of the plaintiff's case, the injunction will be dissolved, with costs. (*c*)

Where the patentee is dead, the affidavits must state the title of the plaintiff. (*d*)

Interrogatories and discovery.

A defendant who submits to answer must answer fully; he cannot by denial of the plaintiff's title escape answering. (*e*) In a suit to restrain the infringement of a patent for improvements in preparing colouring matter for dyeing and printing, the process, as described in the specification, consisted in boiling a mixture of red aniline dye and aniline with hydrochloric acid and water. The defendant denied that his process was an infringement, and alleged that it was a secret, and that his trade depended on his keeping it secret. It was held that he was bound to answer whether he used the materials mentioned in the specification, and whether he used any additional materials, but that he was not bound to disclose

(*a*) *Hill* v. *Thompson*, 3 Mer. 626; 1 Webs. P. R. 236; *Mayer* v. *Spence*, 1 J. & H. 87.

(*b*) *Betts* v. *Willmott*, L. R. 6 Ch. 239.

(*c*) *Stocking* v. *Llewellyn*, 3 L. T. 33.

(*d*) *Bickford* v. *Skewes*, 1 Webs. P. R. 211.

(*e*) *Swinborn* v. *Nelson*, 16 Beav. 416; *Hoffman* v. *Postill*, L. R. 4 Ch. 673.

the proportions in which he used the specified materials, nor what the additional materials were. (*a*)

Where the defendant, by his answer, sets up the defence that the invention is not now, the plaintiff is not entitled 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; (*b*) but the defendant may ask any question tending to destroy the plaintiff's claim. (*c*)

A question in an interrogatory is not less one of fact, because, in maintaining the subject matter of the question, the interrogatory refers to the specification, or to some written document. (*d*)

The defendant must state the names and addresses of all persons from whom he has received sums of money for the use of articles alleged to have been manufactured in infringement of the plaintiff's right, even though such persons reside abroad; (*e*) he must also state the number of machines sold by him, the profit, and the names of the purchasers, and cannot refuse to answer, on the ground that he would thereby disclose the names of his customers and the secrets of his trade. (*f*)

A defendant cannot be excused from answering fully and at once, on the ground that the validity of the patent would require to be established by an issue; (*g*) but if the discovery sought is wholly immaterial to the plain-

(*a*) *Renard* v. *Levinstein*, 3 N. R. 665; 10 L. T. (N. S.) 94.

(*b*) *Daw* v. *Eley*, 2 H. & M. 725; *Bovill* v. *Smith*, L. R. 2 Eq. 459.

(*c*) *Hoffman* v. *Postill*, L. R. 4 Ch. 673.

(*d*) *Ib.*

(*e*) *Crossley* v. *Stewart*, 1 N. R. 426.

(*f*) *Howe* v. *M'Kernan*, 30 Beav. 547.

(*g*) *Foxwell* v. *Webster*, 3 N. R. 103.

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tiff's title, which the defendant denies, he will not be obliged to answer, and is not obliged to put in a plea denying infringement. (*a*)

Where separate bills have been filed against numerous defendants, the plaintiff has a right to have a separate answer from each defendant. (*b*)

Taking bill *pro confesso.*

When a defendant, who was out of the jurisdiction of the Court, had been duly served with the bill and interrogatories, and did not appear or put in an answer, the Court ordered that notice should be given to him, that unless he put in an answer within fourteen days from the service of the notice, an appearance would be entered for him, and proceedings taken to have the bill taken *pro confesso*. (*c*)

Account.

If the plaintiff is able to establish his title to an injunction, an account will also be granted in order that his remedy may be complete. (*d*) And if no case is made for an injunction the account will not be decreed; (*e*) although it may appear at the hearing that since the interim injunction was moved for, the defendants have sold articles, which, had the facts and law been then sufficiently ascertained, the Court would have restrained them from selling. (*f*)

If a patent has been infringed the patentee is entitled to an injunction and an account, even though the defen-

(*a*) *De la Rue* v. *Dickinson*, 3 K. & J. 388.

(*b*) *Foxwell* v. *Webster*, 3 N. R. 103.

(*c*) *Grover & Baker Sewing Machine Co.* v. *Millard*, 8 Jur. (N. S.) 713.

(*d*) *Baily* v. *Taylor*, 1 R. & M. 73.

(*e*) *Smith* v. *The London and South Western Railway Co.*, Kay, 408; *Kernot* v. *Potter*, 3 De G. F. & J. 447.

(*f*) *Price's Patent Candle Co.* v. *Bauwen's Patent Candle Co.*, 4 K. & J. 727.

dant has submitted and has offered before suit, to pay the amount of profits made. (*a*)

Where letters patent are granted to two or more jointly any one of the grantees may use the invention without the consent of the others, and is not liable to account to them for the profits he has made. (*b*) Where a patentee agreed with the defendant that he should make and sell the patented machines, paying not more than a certain sum as royalty to the patentee for each machine sold, and retaining a certain sum on his own account, so that the total amount charged for each machine should not exceed a fixed sum, it was held that the patentee could not maintain a suit in Equity for an account against the defendant as agent, although in one case he had received a sum of money for the patentee. (*c*)

If the account is only a part of an agreement which the Court cannot wholly enforce, the account alone will not be decreed, but the parties will be left to their remedy at law. (*d*)

The account extends over the six years immediately previous to the filing of the bill, and is of all profits and benefits derived from the use of articles made according to the patent for that time. There must be no delay in applying for an account. (*e*)

(*a*) *Nunn* v. *D'Albuquerque*, 34 Beav. 595.

(*b*) *Mathers* v. *Green*, L. R. 1 Ch. 29.

(*c*) *Moxon* v. *Bright*, L. R. 4 Ch. 292. See also as to account between principal and agent, *Edwards* v. *Normandy*, 3 N. R. 562.

(*d*) *Kernot* v. *Potter*, 3 De G. F. & J. 447.

(*e*) *Crossley* v. *Derby Gaslight Co.* 1 Webs. P. R. 119. As to the form of order for an injunction and account, see *Betts* v. *De Vitre*, 34 L. J. Ch. 289.

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Damages.

The Court has power in all cases in which it has jurisdiction to entertain an application for an injunction against a breach of any covenant, contract or agreement, or against the commission or continuance of any wrongful act, or for the specific performance of any covenant, contract or agreement; to award damages to the party injured, either in addition to, or in substitution for such injunction or specific performance, to be assessed either by a jury or by the Court itself. (*a*)

Not given where account.

The Court will not direct both an inquiry as to damages and also an account of profits, as the two things are hardly reconcilable; if an account of profits is taken, the infringement is condoned. (*b*)

Form of inquiry.

Where an inquiry as to damages is directed the form will be "What damages the plaintiff has sustained," not "what damages, if any," as in the case of a trade mark; the difference between the case of a trade mark and that of a patent being that in the former case the article sold is open to the whole world to manufacture, and the only right the plaintiff seeks is that of being able to say, "Don't manufacture under my mark." He may find his customers fall off in consequence of the defendant's manufactures, but it does not necessarily follow that he can claim damages for every article manufactured by the defendant, even though it be under that mark, whereas on the other hand every sale without licence of a patented article must be a damage to the patentee. (*c*)

Remedy against both manufacturer and user of patented article.

Where bills to restrain the infringement of a patent have been filed against both the person who manu-

(*a*) 21 & 22 Vict. c. 27.

(*b*) *Neilson* v. *Betts*, L. R. 5 H. L. 22; *De Vitre* v. *Betts*, L. R. 6 H. L. 319.

(*c*) Per Sir W. P. Wood, V. C., in *Davenport* v. *Rylands*, L. R. 1 Eq. 302; *Betts* v. *De Vitre*, 34 L. J. Ch. 289.

factures and the person who uses the article, and issues of fact have been found for the plaintiff, he is entitled not only to an account against the manufacturer of the patented article, but also to damages against the person who uses it, wherever it be found.(*a*) But a plaintiff who has obtained a decree against wrongful users, not being manufacturers of his invention, and who has been paid the ordinary royalty charged by him, by such users, cannot recover any further royalties from the manufacturer who supplied the machines.(*b*)

Damages may be awarded though patent expired since bill filed.

Damages may be awarded at the hearing although the patent has expired, if there was jurisdiction when the bill was filed.

In *Davenport* v. *Rylands* (*c*) Sir W. P. Wood, V. C., said: "*Primâ facie*, I was somewhat impressed with the notion that in order to award damages at the hearing, the Court must have jurisdiction to grant an injunction. But I think that would be a narrow construction to put upon this beneficial Act. If it were adopted in this case and I were to dismiss the bill without costs, an action would be open to the plaintiff, and thus the very mischief contemplated by the legislature would ensue. A person coming here would be turned round and told, 'Although it be true that the jurisdiction existed at the time of the filing of the bill, something has occurred since which prevents the jurisdiction attaching at the hearing, and therefore, now, you must be left to go to law and the whole matter shall be tried over again there. Although this Court has (assuming the construction of the statute I am adopting) full power to grant damages

(*a*) *Penn* v. *Bibby*, L. R. 3 Eq. 308.

(*b*) *Penn* v. *Jack*, L. R. 5 Eq. 81.

(*c*) L. R. 1 Eq. 302.

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instead of the injunction and settle the whole dispute between the parties; yet the Court will not do that, in consequence of something that has happened since the filing of the bill, and during litigation.' I think the sound view of the whole case is that I ought to exercise the jurisdiction granted to me by the Act, that I ought to consider myself as having had jurisdiction at the time the bill was filed, for the purpose of ultimately giving relief pursuant to the Act, and therefore I shall direct an inquiry as to what damages the plaintiff has sustained, and I shall give the plaintiff the costs up to the hearing."

There must be no doubt as to the validity of the patent.(*a*)

Where, however, the bill was filed so immediately before the expiration of the patent as to render it impossible to obtain an interlocutory injunction the bill was dismissed with costs, it being held that it was a mere device to transfer the jurisdiction to award damages from the Court to which that jurisdiction properly belongs, to the Court of Chancery.(*b*)

A patentee who is not in the habit of manufacturing the patented article but is accustomed to grant particular licences to other manufacturers, on the payment of a royalty, can only on a decree for damages "by reason of user or vending" of the invention, claim damages to the amount of the royalty. He therefore cannot also claim a manufacturing profit, and *à fortiori*, not such a manufacturing profit as he would have made if every unlicensed machine had been sent to him to be fitted with the in-

(*a*) *Fox* v. *Dellestable*, 15 W. R. 194.

(*b*) *Betts* v. *Gallais*, L. R. 10 Eq. 392.

vention. It appears, however, that it would be otherwise if he had been in the habit of charging infringers with a higher royalty than ordinary licensees.(*a*)

Where there will be extreme difficulty in the Court seeing its way to assess the damages, it appears that leave will be given to the plaintiff to proceed at law for the purpose of recovering damages.(*b*)

Inspection.

The plaintiff on making out a *primâ facie* case of infringement is entitled to an order to permit him and his witnesses to inspect the defendant's machinery at work on giving reasonable notice,(*c*) and the defendant and his witnesses will also be entitled to inspect the plaintiff's machinery at work, as it is the object of the Court to enable the parties to produce sufficient evidence at the trial.(*d*) But an order for inspection cannot be granted when the alleged piracy has taken place abroad.(*e*) Inspection is not a matter of right; but the Court will require it to be satisfactorily proved, first that there is really a case to be tried at the hearing of the cause; and secondly that the inspection asked for is of material importance to the applicant's case as made out by his evidence.(*f*)

Inspection of provisional specification.

In *Tolson's Patent*(*g*) an application for an inspection of a provisional specification, on the ground that the subject matter was the same as that for which the application had obtained a patent, was refused.

(*a*) *Penn* v. *Jack*, L. R. 5 Eq. 81.

(*b*) *Betts* v. *De Vitre*, 11 Jur. (N. S.) 9, and see *Hills* v. *Evans*, 8 Jur. (N. S.) 525.

(*c*) *Morgan* v. *Seaward*, 1 Webs. P. R. 169; *Bovill* v. *Moore*, 2 Coop. C. C. 56 n.

(*d*) *Russell* v. *Cowley*, 1 Webs. P. R. 458; *Davenport* v. *Jepson*, 1 N. R. 308.

(*e*) *Neilson* v. *Betts*, L. R. 5 H. L. 1.

(*f*) *Piggott* v. *The Anglo-American Telegraph Co.* 19 L. T. (N. S.) 46.

(*g*) 6 D. M. G. 422.

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Form of order.

The form of the order is as follows: "Ordered that the plaintiff and the defendant A. B. by their solicitors and scientific witnesses be at liberty from time to time upon giving three days' notice of their intention so to do, mutually to inspect the machines heretofore used by the plaintiff and the said defendant in the manufacture of — and that the same machines be put to work upon such inspection, and that the plaintiff and the said defendant, by their said witnesses and solicitors, be at liberty to take samples of the — made or to be made upon the said machines." (*a*)

The defendant will not be compelled to allow the plaintiff to inspect all the machines in his stock; but he will be directed to verify on affidavit the several kinds of machines that he has sold or exposed for sale, and to produce one machine of each class for inspection, (*b*) and the plaintiff will be entitled to put the machines to work and take samples of the produce. (*c*)

Samples for analysis.

The Court has power to order the defendant to deliver samples to the plaintiff for the purpose of analysis. Thus where the plaintiffs were the proprietors of a patent for improvements in the manufacture of type, and the defendant was a printer who used types alleged to be a colourable imitation of the type manufactured by the plaintiffs, he was ordered to deliver up a sample for analysis. (*d*) *Laches* sufficient to defeat the plaintiffs' right to an interlocutory injunction is no bar to an order on the same motion for inspection and analysis. (*e*)

(*a*) *Davenport* v. *Jepson*, 1 N. R. 308.

(*b*) *Singer Manufacturing Co.* v. *Wilson*, 5 N. R. 505.

(*c*) *Davenport* v. *Jepson*, 1 N. R. 308.

(*d*) *Patent Type Founding Co.* v. *Walter*, Johns. 727.

(*e*) *Ib.*

All articles in the possession of the defendant manufactured in violation of the plaintiff's patent may be ordered to be delivered up and destroyed. (*a*) But where a patent for a combination of machinery only has been infringed, the Court will not order the defendant's machines to be broken up, but will order them to be marked. (*b*)

The Court will if asked give such a certificate that the validity of the patent has come in question in the suit and has been determined in favour of the plaintiff as described in the Patent Law Amendment Act (15 and 16 Vict. c. 83, s. 43). (*c*)

Costs of motion.

The usual rules as to the costs of a motion are those laid down by Sir J. Leach in 1 Sim. & S. 357, 1: That the party making a successful motion is entitled to his costs as costs in the cause; but the party opposing it is not entitled to his costs as costs in the cause. 2. That the party making a motion which fails is not entitled to his costs as costs in the cause; but the party opposing it is entitled to his costs as costs in the cause. 3. That where a motion is made by one party and not opposed by the other, the costs of both parties are costs in the cause.

Where the plaintiff obtained an injunction on motion, the defendant appearing and opposing, and at the hearing the bill was dismissed with costs, it was held that the defendant was entitled to the costs of the motion which he had unsuccessfully opposed; (*d*) and where the motion for an injunction stood over pending the trial of

(*a*) *Betts* v. *De Vitre*, 34 L. T. Ch. 289; *Tangye* v. *Stott*, 14 W. R. 386.

(*b*) *Needham* v. *Oxley*, 11 W. R. 852, 2 N. R. 388.

(*c*) *Needham* v. *Oxley*, 11 W. R. 852.

(*d*) *Stevens* v. *Keating*, 1 Mac. & G. 659.

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an action, and nothing was said about costs; and the bill was ultimately dismissed with costs, it was held that the defendant's costs of the motion were costs in the cause. (*a*)

The plaintiff is entitled to the costs of an injunction, although the defendant promises to commit no further act of infringement. (*b*)

Costs of suit.

But if the defendant submits and offers to pay all costs and to give the plaintiff all the relief he requires and the plaintiff nevertheless brings the suit to a hearing, he will not be allowed the subsequent costs of the suit. (*c*)

Where the directors of a company are made parties to the suit, and it is proved that they have been active in causing the patent to be infringed by the company; they may be ordered personally to pay the costs of suit. (*d*)

Costs as between solicitor and client.

By the Patent Law Amendment Act, 15 & 16 Vict. c. 83, s. 43, the judge before whom any action for infringing letters patent shall be tried may certify on the record that the validity of the patent came in question; and the record with such certificate being given in evidence in any suit for infringing the said patent, shall entitle the plaintiff in any such suit or action to his full costs, charges and expenses, taxed as between solicitor and client, unless the judge making such decree or order, or the judge trying such action shall certify that the plaintiff ought not to have such costs.

The certificate required under the above provisions may be given by a judge of the Court of Chancery before whom the validity of the patent has been tried. (*e*)

(*a*) *Betts* v. *Clifford*, 1 J. & H. 75.

(*b*) *Geary* v. *Norton*, 1 De G. & S. 9.

(*c*) *Nunn* v. *d'Albuquerque*, 34 Beav. 595; *Geary* v. *Norton*, 1 De G. & S. 9.

(*d*) *Betts* v. *De Vitre*, 11 Jur. (N. S.) 9.

(*e*) *Needham* v. *Oxley*, 11 W. R. 852. And see *Hills* v. *Evans*, 4 De G. F. & J. 288; 8 Jur. (N. S.) 526.

In order that the costs may be taxed as between solicitor and client, the decree or order must, notwithstanding the words of the Act, contain, as in other cases, an express direction to that effect. (*a*)

As the statute means that the certificate should be produced in evidence on a second trial for the infringement, and the extra costs are given in order to afford a complete indemnity, the costs of a first trial will not be given as between solicitor and client. (*b*)

(*a*) *Lister* v. *Leather*, 4 K. & J. 425; *Hills* v. *Evans*, 4 De G. F. & J. 238; 8 Jur. (N. S.) 526.

(*b*) *Penn* v. *Bibby*, L. R. 3 Eq. 308. And see *Betts* v. *De Vitre*, 11 Jur. (N.S.) 9; *Davenport* v. *Rylands*, L. R. 1 Eq. 302.

CHAPTER XV.

OF PROCEEDINGS TO REPEAL LETTERS PATENT.

CHAP. XV.

A PATENT remains in force until it has been declared void in a court of law, by proceedings taken for that express purpose. The remedy provided by the law against a bad patent is by the writ of *scire facias*, which is prosecuted in the name of the sovereign. If therefore a patent is void for any of the reasons already considered it will be cancelled.(*a*)

The Patent Law Amendment Act(*b*) provides that the writ of *scire facias* shall lie for the repeal of any letters patent issued under that Act, in the like cases as the same would lie for the repeal of letters patent formerly issued under the great seal, and by 12 & 13 Vict. c. 109, s. 29, the writ of *scire facias* may be directed to the sheriff of any county.

Parties.

One of two joint patentees cannot plead in abatement that he had assigned all his interest in the patent to his co-patentee before the writ was issued, and that he has not since had any interest in it.(*c*)

Particulars of objections to be delivered.

The prosecutor in any proceedings by *scire facias* to repeal letters patent must deliver with his declaration

(*a*) For the practice upon writs of *scire facias*, see Hindmarch on Patents, 376; Norman's Law of Patents, 194.

(*b*) 15 & 16 Vict. c. 83, s. 15.

(*c*) *Reg.* v. *Betts*, 15 Q. B. 540.

particulars of any objections on which he means to rely at the trial in support of the suggestion of the declaration, and at the trial no evidence will be allowed to be given which is not contained in the particulars. 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 must be stated in the particulars, and any judge at chambers may allow the prosecutor to amend the particulars upon such terms as to the judge may seem fit. (*a*)

Where the prosecutor, while the record was in Chancery, filed notice of objection that other persons than the patentee had used the invention in England before the grant of the patent, the Court refused on motion after the proceedings were in the Queen's Bench to order the delivery of the particulars, stating the names and addresses of such persons. (*b*)

Pleadings.

The pleadings are to be delivered, not filed. (*c*)

Where the declaration contained suggestions of want of novelty and utility in a certain part of the invention, and the objections pointed out one particular claim as being bad for want of novelty and utility, and the pleas traversed all the suggestions, and after issue joined, disclaimed this particular claim, it was held that the objections were not part of the record so as to form part of the issues to be tried. (*d*)

Applications as to reforming recitals and suggestions in a writ of *scire facias* ought to be referred to one of the superior courts of Common Law and not to the Court of

(*a*) 15 & 16 Vict. c. 83, s. 41. This enactment is similar to, but more comprehensive than, 5 & 6 Will. IV. c. 83, s. 5.

(*b*) *Reg.* v. *Walton*, 2 Q. B. 969.

(*c*) 12 & 13 Vict. c. 109, s. 31.

(*d*) *Reg.* v. *Mill*, 10 C. B. 379.

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Chancery, as they can dispose more satisfactorily of questions of pleading. (*a*)

Evidence.

The defendant is entitled to begin and to give evidence in support of his patent, and if evidence is adduced on the part of the prosecutor impeaching the validity of the patent, the defendant will be entitled to reply. (*b*) The onus of proof is on the prosecutor, and he must show that the patent is void on some of the grounds contained in the suggestions. (*c*)

As to refreshing the memory of a witness by drawings, see *R.* v. *Haddan.* (*d*)

Suit pending stayed on terms.

In *Smith* v. *Upton*, (*e*) the Court of Common Pleas stayed proceedings in an action for infringement for a definite period, [illegible]t the result of a motion pending in the Queen's Bench on a *scire facias*, upon the terms that the plaintiff should pay the defendant any costs which he might have been put to in preparing for trial and the costs of the motion. (*f*)

Where, pending proceedings in *scire facias*, the patentee disclaimed a part of his patent, and the prosecutor still proceeded and ultimately failed, he was ordered to pay the costs subsequent to the disclaimer. (*g*)

The Court has no power to stay proceedings on a *scire facias* or to order a *nolle prosequi* to be entered, as the proceedings are conducted by the Attorney-General

(*a*) *Reg.* v. *Hancock*, 5 D. M. G. 332.

(*b*) 15 & 16 Vict. c. 83, s. 41.

(*c*) *Reg.* v. *Cutler*, 3 C. & K. 215.

(*d*) 2 C. & K. 184.

(*e*) 6 Scott (N. R.) 804 S. C. nom. *Muntz* v. *Foster*, 9 D. & L. 942.

(*f*) See also *Walton* v. *Bateman*, 1 Webs. P. R. 613.

(*g*) *Reg.* v. *Mill*, 14 Q. B. 312.

according to his own discretion. In *Reg.* v. *Prosser*,(a) Lord Langdale said: "The Attorney-General proceeding regularly and being correct in such respects as these, conducts an action of *scire facias* or permits it to be prosecuted according to his own judgment and discretion, and may when he thinks fit stay the proceedings, or enter a *nolle prosequi*. The control is his, subject only to the responsibilities 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 a negligent or erroneous performance of his duty. But I am of opinion that, in the ordinary course of proceeding upon a writ of *scire facias* to repeal letters patent, it is within his discretion to determine upon what or upon whose information, or on what terms or security, he will permit the action to be prosecuted, and that the exercise of his discretion in the conduct of the action is not subject to the control of the courts in which the proceeding takes place."

Where judgment is given for the Crown on a writ issued out of Chancery, which has been sent to a Court of Common Law for trial, final judgment may be given in that Court to cancel the patent, though the letters patent remain in the Court of Chancery. The Court has authority to award the judgment, and afterwards to transmit either the record or the terms thereof to the Court of Chancery, to be fully carried into execution, and the judgment may be that the letters patent be revoked, cancelled, vacated, disallowed, annulled and held void, and that the enrolment be cancelled and annulled,

(a) 11 Beav. 314.

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and that the letters patent be restored into the Court of Chancery there to be cancelled,(*a*) and after such judgment the Lord Chancellor has no jurisdiction to stay the execution of the judgment, his duty in cancelling the enrolment being only ministerial.(*b*)

(*a*) *Bynner* v. *Reg.* 9 Q. B. 523.

(*b*) *Reg.* v. *The Eastern Archipelago Co.* 4 D. M. G. 199.

APPENDIX.

21 Jac. I. c. 3.

An Act concerning Monopolies and Dispensations with Penal Laws, and the Forfeitures thereof.

[A. D. 1623.]

Monopolies contrary to the laws of the realm.

FORASMUCH as your most excellent Majesty in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did, in the year of our Lord God 1610, publish in print to the whole realm, and to all posterity, that grants and monopolies, and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant and agreeable to the ancient and fundamental laws of this your realm: and whereas your Majesty was further graciously pleased expressly to command that no suitor should presume to move your Majesty for matters of that nature: yet, nevertheless, upon misinformations and untrue pretences of public good many such grants have been unduly obtained and unlawfully put in execution, to the great grievance and inconvenience of your Majesty's subjects, contrary to the laws of this your realm, and contrary to your Majesty's most royal and blessed intention, so published as aforesaid: For avoiding whereof and preventing of the like in time to come, may it please your excellent Majesty, at the humble suit of the Lords Spiritual and Temporal, and the Commons in this present Parliament assembled, that it may be declared and enacted, and be it declared and enacted by authority of this

All monopolies, &c., shall be void.

present Parliament, that all monopolies, and all commissions, grants, licences, charters, and letters patent heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of anything within this realm or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty to dispense with any others, or to give licence or toleration to do, use, or exercise anything against the tenor or purport of any law or statute; or to give or make any warrant for any such dispensation, licence, or toleration to be had or made; or to agree or compound with any others for any penalty or forfeitures limited by any statute; or of any grant or promise of the benefit, profit, or commodity of any forfeiture, penalty, or sum of money that is or shall be due by any statute before judgment thereupon had; and all proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things whatsoever, any way tending to the instituting, erecting, strengthening, furthering, or countenancing of the same, or any of them, are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in nowise to be put in use or execution.

Monopolies, &c., shall be tried by the common laws of this realm.

II. That all monopolies, and all such commissions, grants, licences, charters, letters patent, proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things tending as aforesaid, and the force and validity of them, and of every of them, ought to be and shall be for ever hereafter examined, heard, tried and determined, by and according to the common laws of this realm, and not otherwise.

All persons disabled to use monopolies, &c.

III. And be it enacted by the authority aforesaid that all person and persons, bodies politic and corporate whatsoever, which now are or hereafter shall be, shall stand and be disabled, and uncapable to have, use, exercise, or put in use any monopoly, or any such commission, grant, licence, charter, letters patent, proclamation, inhibition, restraint, warrant of assistance or other matter or thing tending as aforesaid, or

any liberty, power or faculty grounded or pretended to be grounded upon them, or any of them.

IV. And be it further enacted by the authority aforesaid, that if any person or persons at any time after the end of forty days next after the end of this present session of parliament shall be hindred, grieved, disturbed, or disquieted, or his or their goods or chattels any way seized, attached, distrained, taken, carried away, or detained by occasion or pretext of any monopoly, or of any such commission, grant, licence, power, liberty, faculty, letters patent, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, and will sue to be relieved in or for any of the premises, that then and in every such case the same person and persons shall and may have his and their remedy for the same at the common law by any action or actions to be grounded upon this statute; the same action and actions to be heard and determined in the courts of King's Bench, Common Pleas, and Exchequer, or in any of them, against him or them by whom he or they shall be so hindered, grieved, disturbed, or disquieted, or against him or them by whom his or their goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained; wherein all and every such person and persons which shall be so hindred, grieved, disturbed, or disquieted, or whose goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained, shall recover three times so much as the damages which he or they sustained by means or occasion of being so hindred, grieved, disturbed, or disquieted, or by means of having his or their goods or chattels seized, attached, distrained, taken, carried away or detained, and double costs; and in such suits, or for the staying or delaying thereof, no essoign, protection, wager of law, aid, prayer, privilege, injunction, or order of restraint shall be in any wise prayed, granted, admitted, or allowed, nor any more than one imparlance: and if any person or persons shall, after notice given that the action depending is grounded upon this statute, cause or procure any action at the common law

The party grieved by pretext of a monopoly, &c., shall recover treble damages and double costs.

He that delayeth an action grounded upon this statute incurs a præmunire.

grounded upon this statute to be stayed or delayed before judgment by colour or means of any order, warrant, power, or authority, save only of the court wherein such action as aforesaid shall be brought and depending, or after judgment had upon such action shall cause or procure the execution of or upon any such judgment to be stayed or delayed by colour or means of any order, warrant, power, or authority, save only by writ of error or attaint; that then the said person and persons so offending shall incur and sustain the pains, penalties, and forfeitures ordained and provided by the statute of provision and *præmunire* made in the sixteenth year of the reign of King Richard the Second.

16 R. II. c. 5.

Letters patent before then granted to use new manufactures saved.

V. Provided, nevertheless, that any declaration before mentioned shall not extend to any letters patent, and grants of privileges for the term of one-and-twenty years or under, heretofore made of the sole working or making of any manner of new manufacture within this realm, to the first and true inventor or inventors of such manufactures which others at the time of the making of such letters patent and grants did not use, so they be not contrary to the law nor mischievous to the State by raising of the prices of commodities at home, or hurt of trade, or generally inconvenient, but that the same shall be of such force as they were or should be if this act had not been made, and of none other. And if the same were made for more than one-and-twenty years, that then the same for the term of one-and-twenty years only, to be accounted from the date of the first letters patents and grants thereof made, shall be of such force as they were, or should have been if the same had been made but for the term of one-and-twenty years only, and as if this act had never been had or made and of none other.

What new patents to be good.

VI. Provided also, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under, hereafter to be made of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manu-

factures which others at the time of making such letters patent and grants shall not use, so as also they be not contrary to the law, nor mischievous to the state, by raising prices of commodities at home or hurt of trade, or generally inconvenient; the said fourteen years to be accounted from the date of the first letters patent or grants of such privilege hereafter to be made, but that the same shall be of such force as they should be if this act had never been made, and of none other.

Act not to extend to grants confirmed by Act of Parliament.

VII. Provided also, and it is hereby further enacted, declared, and enacted by authority, that this act or anything therein contained, shall not in anywise extend or be prejudicial to any grant or privilege, power, or authority whatsoever heretofore made, granted, allowed, or confirmed by any act of parliament now in force, so long as the same shall so continue in force.

Warrants granted to justices saved.

VIII. Provided also, that this act shall not extend to any warrant or privy seal made or directed, or to be made or directed by his Majesty, his heirs, or successors to the justices of the courts of the King's Bench or Common Pleas, and Barons of the Exchequer, justices of assizes, justices of *oyer* and *terminer* and gaol delivery, justices of the peace, and other justices for the time being, having power to hear and determine offences done against any penal statute, to compound for the forfeitures of any penal statute depending in suit and question before them, or any of them respectively, after plea pleaded by the party defendant.

Charters granted to corporations saved.

IX. Provided also, and it is hereby further intended, declared, and enacted, that this act, or anything therein contained, shall not in anywise extend or be prejudicial unto the City of London, or to any city, borough, or town corporate within this realm, for or concerning any grants, charters, or letters patent to them, or any of them made or granted, or for or concerning any custom or customs used by or within them or any of them; or unto any corporations, companies, or fellowships of any art, trade, occupation, or mystery, or to any companies or societies of merchants within this realm erected for the maintenance, enlargement, or ordering

of any trade of merchandize; but that the same charters, customs, corporations, companies, fellowships, and societies, and their liberties, privileges, powers, and immunities, shall be and continue of such force and effect as they were before the making of this act, and of none other; anything before this in this act contained to the contrary in any wise notwithstanding.

Letters patent that concern printing, saltpetre, gunpowder, great ordnance, shot, or offices, saved.

X. Provided also, and be it enacted that this act, or any declaration, provision, disablement, penalty, forfeiture, or other thing before mentioned, shall not extend to any letters patent or grants of privileges heretofore made, or hereafter to be made of, for, or concerning printing, nor to any commission grant, or letters patent heretofore made or hereafter to be made of, for, or concerning the digging, making or compounding of saltpetre or gunpowder; or the casting or making of ordnance, or shot for ordnance; nor to any grant or letters patent heretofore made, or hereafter to be made, of any office or offices heretofore erected, made, or ordained, and now in being; and put in execution, other than such offices as have been decried by any of his Majesty's proclamation or proclamations; but that all and every the same grants, commissions, and letters patent, and all other matters and things tending to the maintaining, strengthening, and furtherance of the same or any of them, shall be and remain of the like force and effect, and no other, and as free from the declarations, provisions, penalties, and forfeitures contained in this act, as if this act had never been had nor made, and not otherwise.

XI. This act shall not extend to commissions for alum mines.

5 & 6 WILL. IV. c. 83.

An Act to amend the Law touching Letters Patent for Inventions. [10th Sept. 1835.]

WHEREAS it is expedient to make certain additions to and alterations in the present law touching letters patent for inventions, as well as for the better protecting of patentees in the rights intended to be secured by such letters patent, as for the more ample benefit of the public for the same; be it enacted,

Any person having obtained letters patent for any invention may enter a disclaimer of any part of his specification, or a memorandum of any alteration therein, which, when filed, to be deemed part of such specification. Caveat may be entered as heretofore. Disclaimer not to affect actions pending at the time. Atty.-Gen. may require advertisement of disclaimer.

I. That any person who as grantee, assignee, or otherwise, hath obtained or shall hereafter obtain letters patent, for the sole making, exercising, vending, or using of any invention, may, if he think fit, enter with the clerk of the patents of England, Scotland or Ireland, respectively, as the case may be, having first obtained the leave of His Majesty's Attorney-General or Solicitor-General in case of an English patent, of the Lord Advocate or Solicitor-General of Scotland in case of a Scotch patent, or of His Majesty's Attorney-General or Solicitor-General for Ireland in the case of an Irish patent, certified by his fiat and signature, a disclaimer of any part of either the title of the invention or of the specification, stating the reason for such disclaimer, or may, with such leave as aforesaid, enter a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent; and such disclaimer or memorandum of alteration, being filed by the said clerk of the patents, and enrolled with the specification, shall be deemed and taken to be part of such letters patent or such specification in all courts whatever: Provided always, that any person may enter a *caveat* in like manner as *caveats* are now used to be entered, against such disclaimer or alteration; which *caveat* being so entered shall give the party entering the same a right to have notice

of the application being heard by the Attorney-General or Solicitor-General or Lord Advocate respectively: Provided also, that no such disclaimer or alteration shall be receivable in evidence in any action or suit (save and except in any proceeding by *scire facias*) pending at the time when such disclaimer or alteration was enrolled, but in every such action or suit the original title and specification alone shall be given in evidence, and deemed and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted: Provided also, that it shall be lawful for the Attorney-General, or Solicitor-General, or Lord Advocate, before granting such fiat, to require the party applying for the same to advertise his disclaimer or alteration in such manner as to such Attorney-General or Solicitor-General or Lord Advocate shall seem right, and shall, if he so require such advertisement, certify in his fiat that the same has been duly made.

Mode of proceeding where patentee is not the real inventor, though he believed himself to be.

II. That if in any suit or action it shall be proved or specially found by the verdict of a jury, that any person who shall have obtained letters patent for any invention, or supposed invention, was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same, or some part thereof, before the date of such letters patent, or if such patentee or his assigns shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof, before the date of such letters patent, it shall and may be lawful for such patentee or his assigns to petition His Majesty in council to confirm the said letters patent or to grant new letters patent, the matter of which petition shall be heard before the Judicial Committee of the Privy Council; and such committee, upon examining the said matter, and being satisfied that such patentee believed himself to be the first and original inventor, and being satisfied that such invention, or part thereof, had not been publicly and generally used before the date of such first letters patent, may report to His Majesty their opinion that the prayer of such petition

ought to be complied with, whereupon His Majesty may, if he think fit, grant such prayer; and the said letters patent shall be available in law and equity to give such petitioner the sole right of using, making, and vending such invention as against all persons whatsoever, any law, usage, or custom to the contrary thereof notwithstanding: Provided, that any person opposing such petition shall be entitled to be heard before the said Judicial Committee: Provided also, that any person, party to any former suit or action touching such first letters patent, shall be entitled to have notice of such petition before presenting the same.

If in any action a verdict, &c., shall pass for the patentee, the judge may grant a certificate, &c.

III. That if any action at law or any suit in equity for an account shall be brought in respect to any alleged infringement of such letters patent heretofore or hereafter granted, or any *scire facias* to repeal such letters patent, and if a verdict shall pass for the patentee or his assigns, or if a final decree or decretal order shall be made for him or them, upon the merits of the suit, it shall be lawful for the judge before whom such action shall be tried to certify on the record, or the judge who shall make such decree or order, to give a certificate under his hand, that the validity of the patent came in question before him, which record or certificate being given in evidence in any other suit or action whatever touching such patent, if a verdict shall pass, or decree or decretal order be made, in favour of such patentee or his assigns, he or they shall receive treble costs in such suit or action to be taxed at three times the taxed costs, unless the judge making such second or other decree or order, or trying such second or other action shall certify that he ought not to have such treble costs.

Mode of proceeding in case of application for the prolongation of the term of a patentee.

IV. That if any person who now hath or shall hereafter obtain any letters patent as aforesaid shall advertise in the "London Gazette" three times, and in three London papers, and three times in some country papers published in the town where or near to which he carried on any manufacture of anything made according to his specification, or near to or in which he resides in case he carried on no such manufacture,

or published in the county where he carries on such manufacture or where he lives in case there shall not be any paper published in such town, that he intends to apply to His Majesty in council for a prolongation of his term of sole using and vending his invention, and shall petition His Majesty in council to that effect, it shall be lawful for any person to enter a *caveat* at the council office; and if His Majesty shall refer the consideration of such petition to the Judicial Committee of the Privy Council, and notice shall first be by him given to any person or persons who shall have entered such *caveats*, the petitioner shall be heard by his counsel and witnesses to prove his case, and the persons entering *caveats* shall likewise be heard by their counsel and witnesses; whereupon and upon hearing and inquiring of the whole matter, the Judicial Committee may report to His Majesty that a further extension of the term in the said letters patent should be granted, not exceeding seven years and His Majesty is hereby authorized and empowered if he shall think fit, to grant new letters patent for the said invention for a term not exceeding seven years after the expiration of the first term, any law, custom, or usage to the contrary in anywise notwithstanding: Provided that no such extension shall be granted if the application by petition shall not be made and prosecuted with effect before the expiration of the term originally granted in such letters patent.(*a*)

In case of action, &c., notice of objections to be given.

V. That in any action brought against any person for infringing any letters patent the defendant on pleading thereto shall give to the plaintiff, and in any *scire facias* to repeal such letters patent the plaintiff shall file with his declaration, a notice of any objection on which he means to rely at the trial of such action, and no objection shall be allowed to be made in behalf of such defendant or plaintiff respectively at such trial unless he prove the objections stated in such notice: Provided always, that it shall and may be lawful for any judge at chambers, on summons served by such defendant

(*a*) This proviso is repealed by 2 & 3 Vict. c. 67, s. 1.

or plaintiff on such plaintiff or defendant respectively to show cause why he should not be allowed to offer other objections whereof notice shall not have been given as aforesaid, to give leave to offer such objections, on such terms as to such judge shall seem fit.

As to costs in actions for infringing letters patent.

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

Penalty for using unauthorized the name of a patentee, &c.

VII. That if any person shall write, paint, or print, or mould, cast, or carve, or engrave or stamp upon anything made, used or sold by him, for the sole making or selling of which he hath not or shall not have obtained letters patent, the name or any imitation of the name of any other person who hath or shall have obtained letters patent, for the sole making and vending of such thing, without leave in writing of such patentee or his assigns, or if any person shall upon such thing, not having been purchased from the patentee or some person who purchased it from or under such patentee, or not having had the license or consent in writing of such patentee, or his assigns, write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word "patent," the words "letters patent," or the words "by the king's patent," or any words of the like kind, meaning, or import, with a view of imitating or counterfeiting the stamp, mark, or other device of the patentee, or shall in any other manner imitate or counterfeit the stamp or mark or other device of the patentee, he shall for every such offence be liable to a penalty of £50, to be recovered by action of debt, bill, plaint, process, or information in any of His Majesty's courts of record at Westminster or in Ireland, or in the court of session in Scotland, one half to His Majesty, his heirs and successors, and the other to any

person who shall sue for the same: Provided always, that nothing herein contained shall be construed to extend to subject any person to any penalty in respect of stamping or in any way marking the word "patent" upon anything made, for the sole making or vending of which a patent before obtained shall have expired.

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2 & 3 VICT. c. 67.

An Act to amend an Act of the Fifth and Sixth Years of the Reign of King William the Fourth, intituled an Act to Amend the Law touching Letters Patent for Inventions. [24th August, 1839.]

WHEREAS by an act passed in the fifth and sixth years of the reign of His Majesty King William the Fourth, intituled "An Act to amend the Law touching Letters Patent for inventions," it is amongst other things enacted (reciting s. 4 of the said act): And whereas it has happened since the passing of the said act, and may again happen, that parties desirous of obtaining an extension of the term granted in letters patent of which they are possessed, and who may have presented a petition for such purposes in manner by the said recited act directed, before the expiration of the said term, may nevertheless be prevented by causes over which they have no control from prosecuting with effect their application before the Judicial Committee of the Privy Council; and it is expedient therefore that the said Judicial Committee should have power, when under the circumstances of the case they shall see fit, to entertain such application, and to report thereon, according to the provisions of the said recited act, notwithstanding that before the hearing of the case before them the terms of the letters patent sought to be renewed or extended may have expired; be it therefore enacted,

Repealing provision re-

I. That so much of the said recited act as provides that no

extension of the term of letters patent shall be granted as therein mentioned if the application by petition for such extension be not prosecuted with effect before the expiration of the term originally granted in such letters patent, shall be and the same is hereby repealed.

Requiring the application by petition to be prosecuted with effect before the expiration of the term of the patent.

II. That it shall be lawful for the Judicial Committee of the Privy Council, in all cases where it shall appear to them that any application for an extension of the term granted by any letters patent, the petition for which extension shall have been referred to them for their consideration, has not been prosecuted with effect before the expiration of the said term from any other causes than the neglect or default of the petitioner, to entertain such application and to report thereon as by the said recited act provided, notwithstanding the term originally granted in such letters patent may have expired before the hearing of such application; and it shall be lawful for Her Majesty, if she shall think fit, on the report of the said Judicial Committee recommending an extension of the term of such letters patent to grant such extension or to grant new letters patent for the invention or inventions specified in such original letters patent, for a term not exceeding seven years after the expiration of the term mentioned in the said original letters patent: Provided always, that no such extension or new letters patent shall be granted if a petition for the same shall not have been presented as by the said recited act directed before the expiration of the term sought to be extended, nor in case of petitions presented after the 30th day of November, 1839, unless such petition shall be presented six calendar months at the least before the expiration of such term, nor in any case unless sufficient reason shall be shown to the satisfaction of the said Judicial Committee for the omission to prosecute with effect the said application by petition before the expiration of the said term.

Term of patent right may be extended in certain cases, though the application for such extension *not prosecuted* with effect before the expiration thereof.

7 & 8 VICT. C. 69.

An Act for amending an Act passed in the Fourth Year of the Reign of His late Majesty, intituled An Act for the better Administration of Justice in His Majesty's Privy Council; and to extend its Jurisdiction and Powers.

[6th August, 1844.]

WHEREAS the act passed in the fourth year of the reign of his late Majesty, intituled "An Act for the better Administration of Justice in His Majesty's Privy Council" hath been found beneficial to the due administration of justice: And whereas another Act, passed in the sixth year of the said reign intituled "An Act to amend the Law touching Letters Patent for Inventions" hath also been found advantageous to inventors and to the public.

On petition, Her Majesty may grant an extension of patent term in certain cases.

II. And whereas it is expedient, for the further encouragement of inventions in the useful arts, to enable the time of monopoly in patents to be extended in cases in which it can be satisfactorily shown that the expense of the invention hath been greater than the time now limited by law will suffice to reimburse; be it enacted, that if any person, having obtained a patent for any invention, shall before the expiration thereof present a petition to her Majesty in Council, setting forth that he has been unable to obtain a due remuneration for his expense and labour in perfecting such invention, and that an exclusive right of using and vending the same for the further period of seven years, in addition to the term in such patent mentioned, will not suffice for his reimbursement and remuneration, then if the matter of such petition shall be by her Majesty referred to the Judicial Committee of the Privy Council, the said committee shall proceed to consider the same after the manner and in the usual course of its proceedings touching patents, and if the said committee shall be of opinion, and shall so report to her Majesty, that a further period greater than seven years' extension of the said patent term ought to be granted to the petitioner, it shall be lawful for her Majesty, if she shall so think fit, to grant an exten-

sion thereof for any time not exceeding fourteen years, in like manner and subject to the same rules as the extension for a term not exceeding seven years is now granted under the powers of the said act of the sixth year of the reign of his late Majesty.

Her Majesty may grant extension for a lesser term than that prayed.

III. Provided always, that nothing herein contained shall prevent the said Judicial Committee from reporting that an extension for any period not exceeding seven years should be granted, or prevent her Majesty from granting an extension for such lesser term than the petition shall have prayed.

As to extension of term where patentees have assigned their patent rights.

IV. And whereas doubts have arisen touching the power given by the said recited Act of the sixth year of the reign of his late Majesty, in cases where the patentees have wholly or in part assigned their right; be it enacted, that it shall be lawful for her Majesty, on the report of the Judicial Committee, to grant such extension as is authorized by the said Act, and by this Act, either to an assignee or assignees, or to the original patentee or patentees, or to an assignee or assignees and original patentee or patentees conjointly.

Disclaimer and memorandum of alteration under 5 & 6 W. IV. c. 83, may be made, notwithstanding original patentee may have assigned his patent right.

V. That in case the original patentee or patentees hath or have departed with his or their whole or any part of his or their interest by assignment to any other person or persons, it shall be lawful for such patentee, together with such assignee or assignees, if part only hath been assigned, and for the assignee or assignees if the whole hath been assigned, to enter a disclaimer and memorandum of alteration under the powers of the said recited Act; and such disclaimer and memorandum of alteration, having been so entered and filed as in the said recited Act mentioned, shall be valid and effectual in favour of any person or persons in whom the rights under the said letters patent may then be or thereafter become legally vested; and no objection shall be made in any proceeding whatsoever, on the ground that the party making such disclaimer or memorandum of alteration had not sufficient authority in that behalf.

Disclaimer and memorandum

VI. That any disclaimer or memorandum of alteration before the passing of this Act, or by virtue of the said recited

of alteration already made valid.

Act, by such patentee with such assignee, or by such assignee as aforesaid, shall be valid and effectual to bind any person or persons in whom the said letters patent might then be or have since become vested; and no objection shall be made in any proceeding whatsoever that the party making such disclaimer or memorandum of alteration had not authority in that behalf.

New letters patent granted under 5 & 6 W. IV. c. 83, to assignees before passing of this act declared valid.

VII. That any new letters patent which before the passing of this Act may have been granted under the provisions of the above recited Act of the sixth year of the reign of his late Majesty to an assignee or assignees, shall be as valid and effectual as if the said letters patent had been made after the passing of this Act, and the title of any party to such new letters patent shall not be invalidated by reason of the same having been granted to any assignee or assignees: *Proviso.* Provided always, that nothing herein contained shall give any validity or effect to any letters patent heretofore granted to any assignee or assignees where any action or proceeding in *scire facias* or suit in equity shall have been commenced at any time before the passing of this Act, wherein the validity of such letters patent shall have been or may be questioned.

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15 & 16 VICT. c. 83.

An Act for Amending the Law for Granting Patents for Inventions. [7th July, 1852.]

WHEREAS it is expedient to amend the law concerning letters patent for inventions: Be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons in this present Parliament assembled, and by the authority of the same, as follows:

Certain persons con-

I. The Lord Chancellor, the Master of the Rolls, her Majesty's Attorney-General for England, her Majesty's

Solicitor-General for England, the Lord Advocate, Her Majesty's Solicitor-General for Scotland, her Majesty's Attorney-General for Ireland, and her Majesty's Solicitor-General for Ireland, for the time being respectively, together with such other person or persons as may be from time to time appointed by her Majesty, as hereinafter mentioned, shall be Commissioners of Patents for inventions; and it shall be lawful for her Majesty from time to time, by warrant under her royal sign manual, to appoint such other person or persons, as she may think fit, to be a commissioner or commissioners as aforesaid; and every person so appointed shall continue such commissioner during her Majesty's pleasure; and all the powers hereby vested in the commissioners may be exercised by any three or more of them, the Lord Chancellor or Master of the Rolls being one.

stituted Commissioners of Patents for Inventions, three of whom may act, the Chancellor or Master of the Rolls being one.

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

Seal of the Commissioners.

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

Commissioners to make rules and regulations which shall be laid before Parliament.

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

Treasury to provide offices.

IV. It shall be lawful for the Commissioners of her Majesty's Treasury to provide and appoint from time to time proper places or buildings for an office or offices for the purposes of this Act.

Commissioners, with consent of Treasury, to appoint clerks, &c.

V. It shall be lawful for the commissioners with the consent of the Commissioners of the Treasury, from time to time to appoint for the purposes of this Act such clerks and officers as the commissioners may think proper: and it shall be lawful for the commissioners from time to time to remove any of the clerks and officers so appointed.

Petition and declaration to be accompanied with a provisional specification.

VI. Every petition for the grant of letters patent for an invention, and the declaration required to accompany such petition, shall be kept at the office of the commissioners, and there shall be left therewith a statement in writing, hereinafter called the provisional specification, signed by or on behalf of the applicant for letters patent, describing the nature of the said invention; and the day of the delivery of every such petition, declaration, and provisional specification shall be recorded at the said office, and endorsed on such petition, declaration, and provisional specification, and a certificate thereof given to such applicant or his agent; and all such petitions, declarations and provisional specifications shall be preserved in such manner as the commissioners may direct, and a registry thereof, and of all proceedings thereon, kept at the office of the commissioners.

Applications to be referred to law officer.

VII. Every application for letters patent made under this Act shall be referred by the commissioners, according to such regulations as they may think fit to make, to one of the law officers.

The provisional specification to be referred to the law officer, who, if satisfied, may give

VIII. The provisional specification shall be referred to the law officer, who shall be at liberty to call to his aid such scientific or other person as he may think fit, and to cause to be paid to such person by the applicant such remuneration as the law officer shall appoint; and if such law officer be satis-

fied that the provisional specification describes the nature of the invention, he shall allow the same, and give a certificate of his allowance, and such certificate shall be filed in the office of the commissioners, and thereupon the invention therein referred to may, during the term of six months from the date of the application for letters patent for the said invention, be used and published without prejudice to any letters patent to be granted for the same, and such protection from the consequences of use and publication is hereinafter referred to as provisional protection: Provided always that in case the title of the invention or the provisional specification be too large or insufficient, it shall be lawful for the law officer to whom the same is referred to allow or require the same to be amended.

a certificate of his allowance, which shall be filed.

IX. The applicant for letters patent for an invention instead of leaving with the petition and declaration a provisional specification as aforesaid, may, if he think fit, file with the said petition and declaration an instrument in writing under his hand and seal (hereinafter called a complete specification) particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed, which complete specification shall be mentioned in such declaration, and the day of the delivery of every such petition, declaration, and complete specification, shall be recorded at the office of the commissioners, and endorsed on such petition, declaration and specification, and a certificate thereof given to such applicant or his agent, and thereupon, subject and without prejudice to the provisions hereinafter contained, the invention shall be protected under this Act for the term of six months from the date of the application, and the applicant shall have during such term of six months the like powers, rights, and privileges as might have been conferred upon him by letters patent for such invention, issued under this Act, and duly sealed as of the day of the date of such application; and during the continuance of such powers, rights and privileges under this provision such invention may be used and published without prejudice to any letters patent

Inventor may deposit, in lieu of a provisional specification, a complete specification, such deposit to confer for a limited time the like rights as letters patent.

to be granted for the same; and where letters patent are granted in respect of such invention, then in lieu of a condition for making void such letters patent in case such invention be not described and ascertained by a subsequent specification, such letters patent shall be conditioned to become void if such complete specification, filed as aforesaid, does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed; and a copy of every such complete specification shall be open to the inspection of the public, as hereinafter provided, from the time of depositing the same, subject to such regulations as the commissioners may make.

Letters patent granted to the first inventor not to be invalidated by protection obtained in fraud of the first inventor.

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

Commissioners to cause protections to be advertised.

XI. Where any invention is provisionally protected under this Act, or protected by reason of the deposit of such complete specification as aforesaid, the commissioners shall cause such provisional protection or such other protection as aforesaid to be advertised in such manner as they may see fit.

Application for letters patent to be advertised, and also oppositions to the same.

XII. The applicant for letters patent, so soon as he may think fit after the invention shall have been previously protected under this Act, or where a complete specification has been deposited with his petition and declaration, then so soon as he may think fit after such deposit, may give notice at the office of the commissioners of his intention of proceeding with his application for letters patent for the said invention, and thereupon the said commissioners shall cause his said application to be advertised in such manner as they may see fit;

and any persons having an interest in opposing the grant of letters patent for the said invention shall be at liberty to have particulars in writing of their objections to the said application at such place, and within such time, and subject to such regulations, as the commissioners may direct.

Specification and objection to be referred to law officer.

XIII. So soon as the time for the delivery of such objections shall have expired, the provisional specification or complete specification (as the case may be), and particulars of objection (if any), shall be referred to the law officer to whom the application has been referred.

Power to law officer to order by or to whom costs shall be paid.

XIV. It shall be lawful for the law officer to whom any application for such letters patent is referred, if he see fit, by certificate under his hand, to order by or to whom the costs of any hearing or inquiry upon any objection, or otherwise in relation to the grant of such letters patent, or in relation to the provisional (or other) protection acquired by the applicant under this Act, shall be paid, and in what manner and by whom such costs are to be ascertained; and if any costs so ordered to be paid be not paid within four days after the amount thereof shall be so ascertained, it shall be lawful for such law officer to make an order for the payment of the same, and every such order may be made a rule of one of Her Majesty's Superior Courts at Westminster or Dublin, and may be recorded in the books of Council and Session in Scotland to the effect that execution may pass thereupon in common form.

Power to law officer to cause a warrant to be made for sealing of letters patent.

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

Chancellor to have same powers in respect to warrant, &c., as he now has.

this Act according to the tenor of the said warrant: Provided always, that the Lord Chancellor shall and may have and exercise such powers, authority, and discretion in respect to the said warrant, and the letters patent therein directed to be made under this Act, as he now has and might now exercise with respect to the warrant for the issue under the Great Seal of letters patent for any invention and with respect to the making and issuing of such letters patent; and

Writ of *scire facias*.

the writ of *scire facias* shall lie for the repeal of any letters patent issued under this 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.

Nothing to affect the prerogative of the Crown in granting or withholding grant of letters patent.

XVI. Provided also: That nothing herein contained shall extend to abridge or affect the prerogative of the Crown in relation to the granting or withholding the grant of any letters patent; and it shall be lawful for her Majesty, by warrant under her royal sign manual, to direct such law officers to withhold such warrant as aforesaid, or that any letters patent for the issuing whereof he may have issued a warrant as aforesaid shall not issue, or to direct the insertion in any letters patent to be issued in manner herein provided of any restrictions, conditions, or provisoes which her Majesty may think fit in addition to or in substitution for any restriction, conditions, or provisoes which would otherwise be inserted therein under this Act; and it shall also be lawful for her Majesty, by like warrant, to direct any complete specification which may have been filed under the provisions hereinbefore contained, and in respect of the invention described in which no letters patent may have been granted, to be cancelled, and thereupon the protection obtained by the filing of such complete specification shall cease.

Letters patent to be made subject to avoidance on non-fulfilment of certain conditions.

XVII. All letters patent for inventions granted under the provisions hereinbefore contained shall be made subject to the condition that the same shall be void, and that the powers and privileges thereby granted shall cease and determine, at the expiration of three years and seven years respectively from the date thereof, unless there be paid, before the expira-

tion of the said three years and seven years respectively the sum or sums of money and stamp duties in the schedule of this Act annexed; and the payment of the said sums of money and stamp duties respectively shall be endorsed on the warrant for the said letters patent; and such officer of the commissioners as may be appointed for this purpose shall issue under the seal of the commissioners a certificate of such payment, and shall endorse a receipt for the same on any letters patent issued under the authority of the said warrant; and such certificate, duly stamped, shall be evidence of the payment of the several sums respectively.(*a*)

Letters patent issued under the Great Seal to be valid for the whole of the United Kingdom, the Channel Islands, and the Isle of Man.

XVIII. The commissioners, so soon after the sealing of the said warrant as required by the applicant for the letters patent, shall cause to be prepared letters patent for the invention, according to the tenor of the said warrant, and it shall be lawful for the Lord Chancellor to cause such letters patent to be sealed with the great seal of the United Kingdom, and such letters patent so sealed shall extend to the whole of the United Kingdom of Great Britain and Ireland, the Channel Islands and the Isle of Man; and in case such warrant so direct, such letters patent shall be made applicable to her Majesty's colonies and plantations abroad, or such of them as may be mentioned in such warrant; and such letters patent shall be valid and effectual as to the whole of such United Kingdom and the said Islands and Isle, and the said colonies or plantations or such of them as aforesaid, and shall confer the like powers, rights and privileges as might in case this Act had not been passed, have been conferred by several letters patent of the like purport and effect passed under the Great Seal of the United Kingdom under the Seal appointed to be used instead of the Great Seal of Scotland, and under the Great Seal of Ireland respectively, and made applicable to England, the dominion of Wales, the town of Berwick-upon-Tweed, the Channel Islands, and the Isle of Man, and the said colonies and plantations, or such of them as aforesaid, to Scotland and to Ireland respectively, save as herein other-

(*a*) This section is repealed by 16 & 17 Vict. c. 5.

Nothing to give effect to any letters patent granted in any colony.

wise provided: Provided always that nothing in this Act contained shall be deemed or taken to give any effect or operation to any letters patent to be granted under the authority of this Act in any colony in which such or the like letters patent would be invalid by the law in force in the same colony for the time being: Provided always that a transcript of such letters shall, so soon after the sealing of the same and in such manner as the commissioners shall direct, be transmitted to the director of Chancery in Scotland, and be recorded in the Records of Chancery in Scotland, upon payment of such fees as the commissioners shall appoint, in the same manner and to the same effect in all respects as letters patent passing under the seal appointed by the treaty of union to be used in place of the Great Seal of Scotland have heretofore been recorded, and extracts from the said Records shall be furnished to all parties requiring the same, on payment of such fees as the commissioners shall direct, and shall be received in evidence in all courts in Scotland to the like effect as the letters patent themselves.

Letters patent not to be issued after three months from date of warrant.

XIX. Provided always, that no letters patent, save as hereinafter mentioned in the case of letters patent destroyed or lost, shall issue on any warrant granted as aforesaid, unless application be made to seal such letters patent within three months after the date of the said warrant.

No letters patent (except in lieu of those lost, &c.) to be issued after expiration of protection given by this Act.

XX. Provided also, that no letters patent (save letters patent issued in lieu of others destroyed or lost) shall be issued or be of any force or effect unless the same be granted during the continuance of the provisional protection under this Act; or, where a complete specification has been deposited under this Act, then, unless such letters patent be granted during the continuance of the protection conferred under this Act by reason of such deposit, save that where the application to seal such letters patent has been made during the continuance of such provisional or other protection as aforesaid, and the sealing of such letters patent has been delayed by reason of a caveat or an application to the Lord Chancellor against or in relation to the sealing of such letters

patent, then such letters patent may be sealed at such time as the Lord Chancellor shall direct.

Letters patent may be granted to personal representatives of applicant during term of protection, or within three months after decease.

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

If letters patent be destroyed or lost, other letters patent may be issued.

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

Letters patent may be dated as of the day of the application.

XXIII. It shall be lawful (the Act of the eighteenth year of King Henry the Sixth, chapter one, or any other Act to the contrary notwithstanding), to cause any letters patent to be issued in pursuance of this Act to be sealed and bear date as of the day of the application for the same, and in the case of such letters patent for any invention provisionally registered under the "Protection of Inventions Act, 1851," as of the day of such provisional registration, or, where the law officer to whom the application was referred, or the Lord Chancellor, thinks fit and directs, any such letters patent as aforesaid may be sealed and bear date as of the day of sealing of such letters patent, or of any other day between the day of such application or provisional registration and the day of such sealing.

Letters patent where antedated to be of the same

XXIV. Any letters patent issued under this Act sealed and bearing date as of any day prior to the day of the actual sealing thereof shall be of the same force and validity as if

validity as if sealed on the day of the date.

they had been sealed on the day as of which the same are expressed to be sealed and bear date: Provided always, that save where such letters patent are granted for any invention, in respect whereof a complete specification has been deposited upon the application for the same under this Act, no proceeding at law or in equity shall be had upon such letters patent in respect of any infringement committed before the same were actually granted.

Letters patent obtained in United Kingdom for patented foreign inventions not to continue in force after the expiration of the foreign patent.

XXV. Where, upon any application made after the passing of this Act, letters patent are granted in the United Kingdom for or in respect of any invention first invented in any foreign country or by the subject of any foreign power or state, and a patent or like privilege for the monopoly or exclusive use or exercise of such invention in any foreign country is there obtained before the grant of such letters patent in the United Kingdom, all rights and privileges under such letters patent shall (notwithstanding any term in such letters patent limited) cease and be void immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in such foreign country shall continue in force, or where more than one such patent or like privilege is obtained abroad, immediately upon the expiration or determination of the term which shall first expire or be determined of such several patents or like privileges: Provided always, that no letters patent for or in respect of any invention for which any such patent or like privilege as aforesaid shall have been obtained in any foreign country, and which shall be granted in the said United Kingdom after the expiration of the term for which such patent or privilege was granted or was in force shall be of any validity.

Letters patent not to prevent the use of inventions in foreign ships resorting to British ports.

XXVI. No letters patent for any invention (granted after the passing of this Act) shall extend to prevent the use of such invention in any foreign ship or vessel, or for the navigation of any foreign ship or vessel, which may be in any port of her Majesty's dominions, or in any of the waters within the jurisdiction of any of her Majesty's courts, where such

invention is not so used for the manufacture of any goods or commodities to be vended within or exported from her Majesty's dominions: Provided always that this enactment shall not extend to the ships or vessels of any foreign state of which the laws authorize subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British ships or vessels, or in or about the navigation of British ships or vessels, while in the ports of such foreign state, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture of goods or commodities to be vended within or exported from the territories of such foreign state.

Except ships of foreign states in whose ports British ships are prevented from using foreign inventions.

XXVII. All letters patent to be granted under this Act (save only letters patent granted after the filing of a complete specification) shall require the specification thereunder to be filed in the High Court of Chancery, instead of requiring the same to be enrolled, and no enrolment shall be requisite.

Specifications to be filed instead of being enrolled.

XXVIII. Every specification to be filed in pursuance of the condition of any letters patent shall be filed in such office of the Court of Chancery as the Lord Chancellor shall from time to time appoint, and every provisional specification and complete specification left or filed at the office of the Commissioners on the application for any letters patent, shall forthwith after the grant of the letters patent, or if no letters patent be granted then immediately on the expiration of six months from the time of such application, be transferred to and kept in the said office appointed for filing specifications in Chancery; and in case reference is made to drawings in any specification deposited or filed under this Act, an extra copy of such drawings shall be left with such specification.(*a*)

Specifications, &c., to be filed in such office as Lord Chancellor shall direct.

As to filing extra copies of drawing.

XXIX. The Commissioners shall cause true copies of all specifications (other than provisional specifications, disclaimers, and memoranda of alterations filed under or in pursuance of this Act, and of all provisional specifications after the term of

Copies of specifications to be open to inspection at office of Commissioners, and at Edinburgh and Dublin.

(*a*) The latter part of this section repealed by 16 & 17 Vict. c. 115, s. 1.

the provisional protection of the invention has expired, to be open to the inspection of the public at the office of the Commissioners, and at an office in Edinburgh and Dublin respectively, at all reasonable times, subject to such regulations as the Commissioners may direct; and the Commissioners shall cause a transcript of the said letters patent to be transmitted for enrolment in the Court of Chancery, Dublin, and shall cause the same to be enrolled therein, and the transcript or exemplification thenceforward shall have the like effect to all intents and purposes as if the original letters patent had been enrolled in the Court of Chancery in Dublin, and all parties shall have all their remedies by *scire facias* or otherwise, as if the letters patent had been granted to extend to Ireland only.

Specifications and other documents to be printed and published.

XXX. The Commissioners shall cause to be printed, published and sold, at such prices and in such manner as they may think fit, all specifications, disclaimers, and memoranda of alterations deposited or filed under this Act, and such specifications (not being provisional specifications), disclaimers and memoranda respectively shall be so printed and published as soon as conveniently may be after the filing thereof respectively, and all such provisional specifications shall be so printed and published as soon as conveniently may be after the expiration of the provisional protection obtained in respect thereof; and it shall be lawful for the Commissioners to present copies of all such publications to such public libraries and museums as they may think fit, and to allow the person depositing or filing any such specification, disclaimer, or memorandum of alteration to have such number not exceeding twenty-five, of the copies thereof so printed and published, without any payment for the same as they may think fit.

As to presenting copies of publications to public libraries.

Enrolments, &c., may be removed to the office for specifications.

XXXI. It shall be lawful for the Lord Chancellor and the Master of the Rolls to direct the enrolment of specifications, disclaimers, and memoranda of alterations heretofore or hereafter enrolled or deposited at the Rolls Chapel Office, or at the Petty Bag Office, or at the Enrolment Office of the Court of Chancery, or in the custody of the Master of the Rolls as

keeper of the public records, to be transferred to and kept in the office appointed for filing specifications in Chancery under this Act.

Commissioners to cause indexes to be made to old specifications, &c.; such specifications, &c., may be printed and published.

XXXII. The Commissioners shall cause indexes to all specifications, disclaimers, and memoranda of alterations heretofore or to be hereafter enrolled or deposited as last aforesaid to be prepared in such form as they may think fit, and such indexes shall be open to the inspection of the public at such place or places as the Commissioners shall appoint, and subject to the regulations to be made by the Commissioners, and the Commissioners may cause all or any of such indexes, specifications, disclaimers and memoranda of alterations to be printed, published, and sold in such manner and at such prices as the Commissioners may think fit.

Copies of specifications, &c., as printed by Queen's printers, to be evidence.

XXXIII. Copies, printed by the printers to the Queen's Majesty, of specifications, disclaimers, and memoranda of alterations shall be admissible in evidence, and deemed and taken to be *primâ facie* evidence of the existence and contents of the documents to which they purport to relate in all courts and in all proceedings relating to letters patent.(*a*)

Register of patents to be kept.

XXXIV. There shall be kept at the office appointed for filing specifications in Chancery under this Act a book or books to be called "The Register of Patents," wherein shall be entered and recorded in chronological order all letters patent granted under this Act, the deposit or filing of specifications, disclaimers, and memoranda of alterations filed in respect of such letters patent, all amendments in such letters patent, and specifications, all confirmations and extensions of such letters patent, the expiry vacating or cancelling such letters patent, with the dates thereof respectively, and all other matters and things affecting the validity of such letters patent as the commissioners may direct, and such register or a copy thereof shall be open at all convenient times to the inspection of the public subject to such regulations as the commissioners may make.

A register of proprietors to

XXXV. There shall be kept at the office appointed for filing specifications in Chancery under this Act a book or books

(*a*) Repealed by 16 & 17 Vict. c. 115, s. 1.

be kept at the office for filing specifications.

entitled "The Register of Proprietors," wherein shall be entered, in such manner as the commissioners shall direct, the assignment of any letters patent, or of any share or interest therein, any licence under letters patent, and the district to which such licence relates, with the name or names of any person having any share or interest in such letters patent or licence, the date of his or their acquiring such letters patent, share, and interest, and any other matter or thing relating to or affecting the proprietorship in such letters patent or licence; and a copy of any entry in such book, certified under such seal as may have been appointed or as may be directed by the Lord Chancellor to be used in the said office, shall be given to any person requiring the same, on payment of the fees hereinafter provided; and such copies so certified shall be received in evidence in all courts and in all proceedings, and shall be *primâ facie* proof of the assignment of such letters patent, or share or interest therein, or of the licence or proprietorship, as therein expressed: Provided always, that until such entry shall have been made the grantee or grantees of the letters patent shall be deemed and taken to be the sole and exclusive proprietor or proprietors of such letters patent, and of all the licences and privileges thereby given and granted; that certified duplicates of all entries made in the said register of proprietors shall forthwith be transmitted to the office of the commissioners in Edinburgh and Dublin, where the same shall also be open to the inspection of the public; and any writ of *scire facias* to repeal such letters patent may be issued to the sheriff of the county or counties in which the grantee or grantees resided at the time when the said letters patent were granted; and in case such grantee or grantees do not reside in the United Kingdom it shall be sufficient to file such writ in the Petty Bag Office, and serve notice thereof in writing at the last known residence or place of business of such grantee or grantees; and such register or a copy shall be open to the inspection of the public at the office of the commissioners, subject to such regulations as the commissioners may make: Provided always, that in any proceeding in Scotland

to repeal any letters patent, service of all writs and summonses shall be made according to the existing forms and practice; provided also, that the grantee or grantees of letters patent to be hereafter granted may assign the letters patent for England, Scotland, or Ireland respectively as effectually as if the letters patent had been originally granted to extend to England or Scotland or Ireland only, and the assignee or assignees shall have the same rights of action and remedies, and shall be subject to the like actions and suits as he or they should and would have had and been subject to upon the assignment of letters patent granted to England Ireland or Scotland before the passing of this Act.

Power for more than twelve persons to have a legal interest in letters patent.

XXXVI. Notwithstanding any proviso that may exist in former letters patent, it shall be lawful for a larger number than twelve persons hereafter to have a legal and beneficial interest in such letters patent.

Falsification or forgery of entries a misdemeanor.

XXXVII. If any person shall wilfully make or cause to be made any false entry in the said register of proprietors, or shall wilfully make or forge or cause to be made or forged, any writing falsely purporting to be a copy of any entry in the said book, or shall produce or tender, or cause to be produced or tendered, in evidence, any such writing, knowing the same to be false or forged, he shall be guilty of a misdemeanor and shall be punished by fine and imprisonment accordingly.

Entries may be expunged.

XXXVIII. If any person shall deem himself aggrieved by any entry made under colour of this Act in the said 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, or by summons to a judge of any of the said courts in vacation, for an order that such entry may be expunged, vacated or varied; and upon any such application the Master of the Rolls or such court or Judge respectively, may make such order for expunging, vacating, or varying such entry and as to the costs of such application, as to the said Master of the Rolls or to such court or Judge may seem fit; and the officer having the care and custody of such register, on the production to him of any

such order for expunging, vacating or varying any such entry, shall expunge, vacate, or vary the same, according to the requisitions of such order.

Provisions of 5 & 6 Will. IV. c. 83, and of 7 & 8 Vict. c. 69, as to disclaimers and memoranda of alterations to apply to patents under this Act.

XXXIX. All the provisions of the Acts of the session holden in the fifth and sixth years of King William IV., chapter eighty-three, and of the session holden in the seventh and eighth years of her majesty, chapter sixty nine, respectively, relating to disclaimers, and memoranda of alterations in letters patent and specifications, except as hereinafter provided, shall be applicable and apply to any letters patent granted, and to any specification filed under the provisions of this Act: Provided always, that all applications for leave to enter a disclaimer or memorandum of alteration shall be made, and all *caveats* relating thereto shall be lodged at the office of the commissioners, and shall be referred to the respective law officers in the said first recited Act mentioned: provided also, that every such disclaimer or memorandum of alteration shall be filed in the office appointed for filing specifications in Chancery under this Act, with the specification to which the same relates, in lieu of being entered or filed and enrolled as required by the said first recited Act, or by the Act of the session holden in the twelfth and thirteen years of her Majesty, chapter one hundred and nine, and the said Acts shall be construed accordingly: provided also, that such filing of any disclaimer or memorandum of alteration, in pursuance of the leave of the law officer in the first recited Act mentioned, certified as therein mentioned, shall, except in case of fraud, be conclusive as to the right of the party to enter such disclaimer or memorandum of alteration under the said Acts and this Act; and no objection shall be allowed to be made in any proceeding upon or touching such letters patent, specification, disclaimer, or memorandum of alteration, on the ground that the party entering such disclaimer or memorandum of alteration had not sufficient authority in that behalf: provided also, that no action shall be brought upon any letters patent in which, or on the specification of which any disclaimer or memorandum of alteration shall have been filed in respect of any infringement committed

Applications for disclaimers and caveats to be at office of Commissioners.

prior to the filing of such disclaimer or memorandum of alteration, unless the law officers shall certify in his fiat that any such action may be brought, notwithstanding the entry or filing of such disclaimer or memorandum of alteration.

Provisions of 5 & 6 Will. IV. c. 83; 2 & 3 Vict. c. 67, and 7 & 8 Vict. c. 69, as to confirmation and prolongation, to apply to patents under this Act.

XL. All the provisions of the said Act of the fifth and sixth years of King William IV. for the confirmation of any letters patent, and the grant of new letters patent, and all the provisions of the said Act, and of the Acts of the session holden in the second and third years of her Majesty, chapter sixty-seven, and of the session holden in the seventh and eighth years of her Majesty, chapter sixty-nine respectively, relating to the prolongation of the term of letters patent, and to the grant of new letters patent for a further term, shall extend and apply to any letters patent granted under the provisions of this Act, and it shall be lawful for her Majesty to grant any new letters patent, as in the said Acts mentioned; and in the granting of any such new letters patent, as in the said Act mentioned; and in the granting of any such new letters patent her Majesty's Order in Council shall be a sufficient warrant and authority for the sealing of any new letters patent, and for the insertion in such new letters patent of any restrictions, conditions, and provisions in the said order mentioned; and the Lord Chancellor on the receipt of the said order in council shall cause letters patent, according to the tenor and effect of such order, to be made and sealed in the manner herein directed for letters patent issued under the warrant of the law officer: Provided always, that such new letters patent shall extend to and be available in and for such places as the original letters patent extended to and were available in; provided also, that such new letters patent shall be sealed and bear date as of the day after the expiration of the term of the original letters patent which may first expire.

In actions for *infringement* of letters patent, particulars to be delivered, and no evidence

XLI. In any action in any of her Majesty's superior courts of record at Westminster or in Dublin for the infringement of letters patent the plaintiff shall deliver with his declaration, particulars of the breaches complained of in the said action, and the defendant, on pleading thereto, shall deliver with his

allowed not mentioned therein.

pleas, and the prosecutor in any proceedings by *scire facias* to repeal letters patent shall deliver with his declaration, particulars of any objections on which he means to rely at the trial in support of the suggestions of the said declaration in the proceedings by *scire facias* respectively; and at the trial of such action or 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 plaintiff or defendant or prosecutor respectively to amend the particulars delivered as aforesaid, upon such terms as to such judge shall seem fit: Provided also, that at the trial of any proceeding 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.

Courts of common law may grant injunction in case of infringement.

XLII. In any action in any of Her Majesty's Superior Courts of Record at Westminster and in Dublin for the infringement of letters patent, it shall be lawful for the court in which such action is pending, 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, inspection, or account, and to give such direction respecting such action, injunction, inspection, and account, and the proceedings therein respectively, as to such court or judge may seem fit.

Particulars to be regarded in taxation of costs.

XLIII. In taxing the costs in any action in any of Her Majesty's Superior Courts at Westminster or in Dublin, commenced after the passing of this Act for infringing letters patent, regard shall be had to the particulars delivered in

such action, and the plaintiff and defendant respectively shall not be allowed any costs in respect of any particular unless certified by the judge before whom the trial was had to have been proved by such plaintiff or defendant respectively without regard to the general costs of the cause; 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: Provided always, that nothing herein contained shall affect the jurisdiction and forms of process of the Courts in Scotland in any action for the infringement of letters patent, or in any action or proceeding respecting letters patent hitherto competent to the said courts: Provided also, that when any proceedings shall require to be taken in Scotland to repeal any letters patent, such proceedings shall be taken in the form of an action of reduction at the instance of Her Majesty's advocate, or at the instance of any other party having interest with concurrence of Her Majesty's advocate, which concurrence Her Majesty's advocate is authorized and impowered to give upon just cause shown only.

Payments and stamp duties on letters.

XLIV. There shall be paid in respect of letters patent applied for or issued as herein mentioned, the filing of specifications and disclaimers, certificates, entries, and searches, and other matters and things mentioned in the schedule to this Act, such fees as are mentioned in the said schedule; and there shall be paid unto and for the use of Her Majesty, her heirs and successors, for or in respect of the warrants and

certificates mentioned in the said schedule, or the vellum, parchment, or paper on which the same respectively are written, the stamp duties mentioned in the said schedule; and no other stamp duties shall be levied or fees except as hereinafter mentioned, taken in respect to such letters patent and specifications, and the matters and things in such schedule mentioned. (*a*)

Duties to be under management of Commissioners of Inland Revenue.

XLV. The stamp duties hereby granted shall be under the care and management of the commissioners of inland revenue; and the several rules, regulations, provisions, penalties, clauses, and matters contained in any Act now or hereafter to be in force with reference to stamp duties shall be applicable thereto. (*a*)

All moneys received to be paid to the Consolidated fund.

XLVI. The fees to be paid as aforesaid shall from time to time be paid into the receipt of the Exchequer, and be carried to and made part of the consolidated fund of the United Kingdom. (*a*)

Not to prevent payment of fees to law officers in case of opposition, &c.

XLVII. Provided always, that nothing herein contained shall prevent the payment as heretofore to the law officers in cases of opposition to the granting of letters patent, and in cases of disclaimers and memoranda of alterations, of such fees as may be appointed by the Lord Chancellor and Master of the Rolls as the fee to be paid on the hearing of such oppositions, and in the case of disclaimers and memoranda of alterations respectively, or of such reasonable sums for office or other copies of documents in the office of the Commissioners, as the Commissioners may from time to time appoint to be paid for such copies, and the Lord Chancellor and Master of the Rolls and the Commissioners are hereby respectively authorized and empowered to appoint the fees to be so paid in respect of such oppositions, disclaimers, and memoranda of alterations respectively, and for such office or other copies.

Fees and salaries of officers.

XLVIII. It shall be lawful for the Commissioners of Her Majesty's Treasury from time to time to allow such fees to the law officers and their clerks (for duties under this Act

(*a*) This section is repealed by 16 & 17 Vict. c. 5, s. 1.

in respect of which fees may not be payable to them under the provisions lastly hereinbefore contained) as the Lord Chancellor and Master of the Rolls may from time to time appoint, and to allow such salaries and payments to any clerks and officers in respect of any additional duties imposed on them by this Act, as the said Commissioners of the Treasury may think fit.

Sums for defraying salaries and expenses under this Act to be paid out of moneys provided by Parliament.

XLIX. It shall be lawful for the Commissioners of her Majesty's Treasury to allow from time to time the necessary sums for providing offices under this Act, and for the fees, salaries, and payments allowed by them as aforesaid, and for defraying the current and incidental expenses of such office or offices; and the sums to be so allowed shall be paid out of such moneys as may be provided by Parliament for that purpose.

Power to Treasury to grant compensation to persons affected by this Act.

L. And whereas divers persons by virtue of their offices or appointments are entitled to fees or charges payable in respect of letters patent as heretofore granted within the United Kingdom of Great Britain and Ireland, or have and derive in respect of such letters patent, or the procedure for the granting thereof, fees or other emoluments or advantages: It shall be lawful for the said Commissioners of the Treasury to grant to any such persons who may sustain any loss of fees, emoluments, or advantages by reason of the passing of this Act, such compensation as, having regard to the tenure and nature of their respective offices and appointments, such Commissioners deem just and proper to be awarded; and all such compensations shall be paid out of such monies as may be provided by Parliament for that purpose: Provided always, that in case any person to whom any yearly sum by way of compensation shall be awarded and paid shall after the passing of this Act be appointed to any office or place of emolument under the provisions of this Act, or in the public service, then and in every such case the amount of such yearly sum shall in every year be diminished by so much as the emoluments of such person for such year from such office or place shall amount to, and provision in that behalf shall be made in the award to him of such yearly sum.

Account of salaries, fees, and compensation allowances to be laid before Parliament.

LI. An account of all salaries, fees, allowances, sums, and compensations to be appointed, allowed, or granted under this Act shall, within fourteen days next after the same shall be so appointed, allowed, or granted respectively, be laid before both Houses of Parliament, if Parliament be then sitting, or if Parliament be not then sitting, then within fourteen days after the next meeting of Parliament.

Not to extend to patents applied for before the commencement of Act.

LII. Letters patent may be granted in respect of applications made before the commencement of this Act in like manner and subject to the same provisions as if this Act had not passed.

As to letters patent granted before commencement of this Act for England, Scotland, or Ireland.

LIII. Where letters patent for England or Scotland or Ireland have been granted before the commencement of this Act, or are in respect of any application made before the commencement of this Act hereafter granted for any invention, letters patent for England or Scotland or Ireland may be granted for such invention in like manner as if this Act had not been passed: Provided always, that in lieu of all the fees or payments and stamp duties now payable in respect of such letters patent, or in or about obtaining a grant thereof, there shall be paid in respect of such letters patent for England or Scotland or Ireland on the sealing of such respective letters patent a sum equal to one-third part of the fees and stamp duties which would be payable according to the schedule to this Act in respect of letters patent issued for the United Kingdom under this Act, on or previously to the sealing of such letters patent; and at or before the expiration of the third year and the seventh year respectively of the term granted by such letters patent for England or Scotland or Ireland, sums equal to one-third part of the fees and stamp duties payable at the expiration of the third year and the seventh year respecti[illegible]y of the term granted by letters patent issued for the United Kingdom under this Act; and the condition of such letters patent for England or Scotland or Ireland shall be varied accordingly; and such fees shall be paid to such persons as the Commissioners of her Majesty's

Treasury shall appoint, and shall be carried to and form part of the said consolidated fund. (*a*)

Forms in schedule may be used.

LIV. The several forms in the schedule to this Act may be used for and in respect of the several matters therein mentioned, and the Commissioners may, where they think fit, vary such forms as occasion may require, and cause to be printed and circulated such other forms as they may think fit to be used for the purposes of this Act.

Interpretation of term.

LV. In the construction of this Act the following expressions shall have the meanings hereby assigned to them, unless such meanings be repugnant to or inconsistent with the context; (that is to say:)

The expression "Lord Chancellor" shall mean the Lord Chancellor or Lord Keeper of the Great Seal, or Lords Commissioners of the Great Seal.

The expression "the Commissioners" shall mean the Commissioners for the time being acting in execution of this Act.

The expression "law officer" shall mean Her Majesty's Attorney-General or Solicitor-General for the time being for England, or the Lord Advocate, or Her Majesty's Solicitor-General for the time being for Scotland, or Her Majesty's Attorney-General or Solicitor-General for the time being for Ireland.

The expression "invention" shall mean any manner of new manufacture the subject of letters patent and grant of privilege within the meaning of the Act of the twenty-first year of the reign of King James the First, chapter three.

The expressions "petition," "declaration," "provisional specification," "warrant," and "letters patent" respectively shall mean instruments in the form and to the effect in the schedule hereto annexed, subject to such alterations as may from time to time be made therein under the powers and provisions of this Act.

(*a*) This section is repealed by 16 & 17 Vict. c. 5, s. 1.

Short title.

LVI. In citing this Act in other Acts of Parliament, instruments, and proceedings, it shall be sufficient to use the expression "The Patent Law Amendment Act, 1852."

Commencement of Act.

LVII. This Act shall commence and take effect from the 1st day of October, 1852.

THE SCHEDULE TO WHICH THIS ACT REFERS.(a)

Fees to be paid.

	£	s.	d.
On leaving petition for grant of letters patent .	5	0	0
On notice of intention to proceed with the application	5	0	0
On sealing of letters patent	5	0	0
On filing specification	5	0	0
At or before the expiration of the third year .	40	0	0
At or before the expiration of the seventh year .	80	0	0
On leaving notice of objections	2	0	0
Every search and inspection	0	1	0
Entry of assignment or licence	0	5	0
Certificate of assignment or licence . . .	0	5	0
Filing application for disclaimer . . .	5	0	0
Caveat against disclaimer	2	0	0

Stamp duties to be paid.

	£	s.	d.
On warrant of law officer for letters patent .	5	0	0
On certificate of payment of the fee payable at or before the expiration of the third year . .	10	0	0
On certificate of payment of the fee payable at or before the expiration of the seventh year .	20	0	0

(a) So much of the schedule as relates to fees is repealed by 16 & 17 Vict. c. 5, s. 1.

FORMS.

PETITION.

No.

To the Queen's most Excellent Majesty.

The humble petition of (*here insert name and address of petitioner*) for, &c.

Showeth:

That your petitioner is in possession of an invention for (*the title of the invention*) which invention he believes will be of great public utility; that he is the true and first inventor thereof; and that the same is not in use by any other person or persons, to the best of his knowledge and belief.

Your petitioner therefore humbly prays, that your Majesty will be pleased to grant unto him, his executors, administrators and assigns your royal letters patent for the United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man (*Colonies to be mentioned if any*) for the term of fourteen years, pursuant to the statutes in that case made and provided.

And your petitioner will ever pray, &c.

DECLARATION.

No.

I of in the county of do solemnly and sincerely declare, that I am in possession of an invention for, &c. (*the title as in petition*), which invention I believe will be of great public utility; that I am the true and first inventor thereof; and that the same is not in use by any other person or persons, to the best of my knowledge and belief; (*where a complete specification is to be filed with the petition and declaration, insert these words*:—" and that the instrument in writing under my hand and seal hereunto annexed, particularly describes and ascertains the nature of the said invention and the manner in which the

same is to be performed;") and I make this declaration conscientiously believing the same to be true, and by virtue of the provisions of an Act made and passed in the session of Parliament held in the fifth and sixth years of the reign of his late Majesty King William the Fourth, intituled "An Act to repeal an Act of the present Session of Parliament, intituled, 'An Act for the more Effectual Abolition of Oaths and Affirmations taken and made in various Departments of the State,' and to substitute Declarations in lieu thereof and for the more entire Suppression of Voluntary and Extra-judicial Oaths and Affidavits, and to make other Provisions for the Abolition of Unnecessary Oaths." A. B.

Declared at this day of
before me, a Master in Chancery, *or* justice
of the peace.

PROVISIONAL SPECIFICATION.

No.

I do hereby declare the nature of the said invention for (*insert title as in petition*) to be as follows: (*here insert description*)

Dated this day of A. D.

(To be signed by the applicant or his agent.)

REFERENCE.

(*To be endorsed on the petition.*)

Her Majesty is pleased to refer this petition to
to consider what may be properly done therein

Clerk of the Commissioners.

WARRANT.

In humble obedience to Her Majesty's command referring to me the petition of of , to consider what may be properly done therein, I do hereby certify as follows: that the said petition sets forth that the petitioner (*allegations of the petition*)

And the petitioner most humbly prays (*prayer of the petition*)

That in support of the allegations contained in the said petition the declaration of the petitioner has been laid before me, whereby he solemnly declares, that (*allegations of the declaration*).

That there has also been laid before me (a provisional specification signed and also a certificate

) or (a complete specification, and a certificate of the filing thereof), whereby it appears that the said invention was provisionally protected (*or* protected) from the day of A. D. in pursuance of the statute:

That it appears that the said application was duly advertized:

Upon consideration of all the matters aforesaid, and as it is entirely at the hazard of the said petitioner whether the said petition is new or will have the desired success, and as it may be reasonable for Her Majesty to encourage all arts and inventions which may be for the public good, I am of opinion, that Her Majesty may grant her royal letters patent unto the petitioner, his executors, administrators, and assigns, for his said invention within the United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, (*Colonies to be mentioned if any,*) for the term of fourteen years according to the statute in that case made and provided, if Her Majesty shall be graciously pleased so to do, to the tenor and effect following: (*see next form.*)

Given under my hand this day of A. D.

(Seal of the Commissioners.)

LETTERS PATENT.

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

Whereas hath by his petition humbly represented to us that he is in possession of an invention for , which the petitioner believes will be of great public utility; that he is the first and true inventor thereof; and that the same is not in use by any other person or persons, to the best of his knowledge and belief: the petitioner therefore most humbly prayed that we would be graciously pleased to grant unto him, his executors, administrators and assigns, our royal letters patent for the sole use, benefit and advantage of his said invention within our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man for the term of fourteen years, pursuant to the statute in that case made and provided:

And we, being willing to give encouragement to all arts and inventions which may be for the public good, are graciously pleased to condescend to the petitioner's request: Know ye, therefore, that we, of our especial grace, certain knowledge, and mere motion, have given and granted, and by these presents, for us, our heirs and successors, do give and grant unto the said , his executors, administrators, and assigns, our especial licence, full power, sole privilege, and authority that the said , his executors, administrators, and assigns, and every of them, by himself and themselves, or by his and their deputy or deputies, servants or agents, or such others as he the said , his executors, administrators, or assigns, shall at any time agree with, and no others, from time to time and at all times hereafter during the term of years herein expressed, shall and lawfully may make, use, exercise, and vend his said invention within our United Kingdom of Great Britain and Ireland, the Channel Islands and Isle of Man in such manner as to him the said , his executors, administrators and assigns, or any of them, shall

in his or their discretion seem meet; and that he the said , his executors, administrators, and assigns, shall and lawfully may have and enjoy the whole profit, benefit, commodity, and advantage from time to time coming, growing, accruing, and arising by reason of the said invention, for and during the term of years herein mentioned; to have, hold, exercise and enjoy the said licences, powers, privileges and advantages hereinbefore granted or mentioned to be granted unto the said , his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years from the day of the date of these presents next and immediately ensuing, according to the statute in such case made and provided; and to the end that he the said , his executors, administrators and assigns, and every of them, may have and enjoy the full benefit and the sole use and exercise of the said invention, according to our gracious intention hereinbefore declared, we do by these presents, for us, our heirs and successors, require and strictly command all and every person and persons, bodies politic and corporate, and all other our subjects whatsoever, of what estate, quality, degree, name, or condition soever they be, within our United Kingdom of Great Britain and Ireland, the Channel Islands and Isle of Man that neither they, nor any of them, at any time during the continuance of the said term of fourteen years hereby granted, either directly or indirectly do make, use, or put in practice the said invention, or any part of the same, so attained unto by the said as aforesaid, nor in any wise counterfeit, imitate, or resemble the same, nor shall make or cause to be made any addition thereunto, or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, devisor or devisors thereof, without the consent, licence or agreement of the said , his executors, administrators or assigns, in writing under his or their hands and seals first had and obtained in that behalf, upon such pains and penalties as can or may be justly inflicted on such

offenders for their contempt of this our royal command, and further to be answerable to the said , his executors, administrators and assigns, according to law, for his and their damages thereby occasioned: And moreover, we do by these presents, for us, our heirs and successors, will and command all and singular the justices of the peace, mayors, sheriffs, bailiffs, constables, head-boroughs, and all other officers and ministers whatsoever of us, our heirs and successors, for the time being, that they or any of them do not nor shall not at any time during the said term hereby granted in any wise molest, trouble or hinder the said his executors, administrators, or assigns, or any of them, or his or their deputies, servants, or agents, in or about the due and lawful use or exercise of the aforesaid invention, or anything relating thereto: Provided always, and these our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted it shall be made to appear to us, our heirs or successors, or any six or more of our or their Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof, within our United Kingdom of Great Britain and Ireland, the Channel Islands and Isle of Man, or that the said is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith cease, determine, and be utterly void to all intents and purposes, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided also, that these our letters patent, or anything herein contained, shall not extend or be construed to extend to give privilege unto the said , his executors, administrators, or assigns, or any of them, to use or imitate any invention or work whatsoever which hath heretofore been found out or invented by any other of our subjects whatsoever, and publicly used or exercised within our United Kingdom of Great Britain and Ireland, the Channel Islands, or Isle of Man, unto whom our

like letters patent or privileges have been already granted for the sole use, exercise, and benefit thereof: it being our will and pleasure that the said , his executors, administrators, and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practice their several inventions by them invented and found out, according to the true intent and meaning of the same respective letters patent and of these presents: Provided likewise nevertheless, and these our letters patent are upon this express condition, that if the said shall not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, by an instrument in writing under his or their or one of their hands and seals, and cause the same to be filed in the Great Seal Patent Office within six calendar months next and immediately after the date of these our letters patent; and also if the said his executors, administrators, or assigns, shall not pay the stamp duty of fifty pounds and produce these our letters patent stamped with a proper stamp to that amount at the office of our commissioners of patents for inventions before the expiration of three years from the date of these our letters patent, pursuant to the provisions of the act of the sixteenth year of our reign, chapter 5; and also if the said his executors, administrators, or assigns, shall not pay the stamp duty of one hundred pounds, and produce these our letters patent stamped with a proper stamp to that amount at the said office of our said commissioners before the expiration of seven years from the date of these our letters patent pursuant also to the said act; and also if the said , his executors, administrators, or assigns, shall not supply or cause to be supplied for our service all such articles of the said invention as he or they shall be required to supply by the officers or commissioners administering the department of our service for the use of which the same shall be required,

in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said officers or commissioners requiring the same; that then and in any of the said cases these our letters patent, and all liberties and advantages whatsoever hereby granted shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted: and, lastly, we do by these presents, for us, our heirs and successors, grant unto the said , his executors, administrators, and assigns, that these our letters patent, or the filing thereof, shall be in and by all things good, firm, valid, sufficient, and effectual in the law according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favourable and beneficial sense for the best advantage of the said , his executors, administrators, and assigns, as well as in all our courts of record as elsewhere, and by all and singular the officers and ministers whatsoever of us, our heirs and successors, in our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, and amongst all and every the subjects of us, our heirs and successors, whatsoever and wheresoever, notwithstanding the not full and certain describing the nature or quality of the said invention, or of the materials thereunto conducing and belonging. In witness whereof we have caused these our letters to be made patent, this day of , A. D. , and to be sealed and bear date as of the said day of , A. D. , in the year of our reign.(*a*)

(*a*) The above form, being the one in actual use, has been substituted for the form given in the schedule to the act. See section LIV.

SPECIFICATION.

To all to whom these presents shall come

I of send

greeting:

Whereas Her Most Excellent Majesty Queen Victoria, by her letters patent bearing date the day of A. D. , in the year of her reign did for herself, her heirs and successors, give and grant unto me the said , her special licence that I the said , my executors, administrators and assigns, or such others as I the said my executors, administrators and assigns, should at any time agree with, and no others, from time to time and at all times thereafter during the term therein expressed should and lawfully might make, use, exercise, and vend, within the United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, (*Colonies to be mentioned, if any*) an invention for (*insert title as in letters patent*) upon the condition (amongst others) that I the said , by an instrument in writing under my hand and seal, should particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, and cause the same to be filed in within calendar months next and immediately after the date of the said letters patent.

Now know ye, that I the said do hereby declare the nature of my said invention, and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement; (that is to say,) (*describe the invention.*)

In witness whereof I the said A. B. have heretofore set my hand and seal this day of A. D.

A. B.

16 VICT. C. 5.

An Act to substitute Stamp Duties for Fees on passing Letters Patent for Inventions, and to provide for the Purchase for the public use of certain Indexes of Specifications. [21st February, 1853.]

15 & 16 Vict. c. 38.

WHEREAS it is expedient that the fees payable in respect of letters patent for inventions under the Patent Law Amendment Act, 1852, and mentioned in the schedule to such Act, be converted into stamp duties; be it enacted, therefore, as follows:

Secs. 17, 44, 45, 46, and 53, and part of schedule of recited Act repealed.

I. Sections seventeen, forty-four, forty-five, forty-six, and fifty-three and so much of the schedule to the said Act as relates to fees and stamp duties to be paid under the said Act, shall be repealed.

Letters patent to be made subject to avoidance on non-payment of stamp duties expressed in schedule to this Act annexed.

II. All letters patent for inventions to be granted under the provisions of the said Patent Law Amendment Act, 1852, (except in the case provided for in the fourth section of this Act,) shall be made subject to the condition that the same shall be void, and that the powers and privileges thereby granted shall cease and determine at the expiration of three years and seven years respectively from the date thereof, unless there be paid before the expiration of the said three years and seven years respectively the stamp duties in the schedule to this Act annexed expressed to be payable before the expiration of the third year and of the seventh year respectively, and such letters patent or a duplicate thereof shall be stamped with proper stamps showing the payment of such respective stamp duties, and shall, when stamped, be produced before the expiration of such three years and seven years respectively at the office of the commissioners; and a certificate of the production of such letters patent or duplicate so stamped, specifying the date of such production, shall be endorsed by the clerk of the commissioners on the letters patent or duplicate, and a like certificate shall be endorsed upon the warrant for such letters patent filed in the said office.

Stamp duties mentioned in the schedule to this Act to be payable.

III. There shall be paid unto and for the use of Her Majesty, her heirs and successors, for or in respect of letters patent applied for or issued under the provisions of the said Patent Law Amendment Act, 1852, warrants, specifications, disclaimers, certificates, and entries, and other matters and things mentioned in the schedule to this Act, or the vellum, parchment, or paper on which the same respectively are written, the stamp duties mentioned in the said schedule; and no other stamp duties shall be levied in respect of such letters patent, warrants, specifications, disclaimers, certificates, entries, matters and things; and the stamp duty mentioned in the said schedule on office copies of documents shall be in lieu of such sums as by the said Patent Law Amendment Act, 1852, are authorized to be appointed to be paid for such office copies.

As to payment of stamp duties on letters patent for England, Scotland, or Ireland respectively.

IV. Where the letters patent for England or Scotland or Ireland have been granted before the commencement of the said Patent Law Amendment Act, 1852, or have been since the commencement of the said Act or hereafter may be granted for any invention, in respect of any application made before the commencement of the said Act, letters patent for England or Scotland or Ireland may be granted for such invention in like manner as if the said Act had not been passed. Provided always that in lieu of all fees or payments and stamp duties which were at the time of the passing of the said Act payable in respect of such letters patent as last aforesaid, or in or about obtaining a grant thereof, and in lieu of all other stamp duties whatsoever, there shall be paid in respect of such letters patent as last aforesaid on the sealing thereof stamp duties equal to one third part of the stamp duties which would be payable under this Act in respect of letters patent issued for the United Kingdom under the said Patent Law Amendment Act, 1852, on or previously to the sealing of such letters patent as last aforesaid, and before the expiration of the third year and the seventh year respectively of the term granted by such letters patent for England, Scotland, or Ireland, stamp duties equal to one third part of the stamp duties

payable under this Act before the expiration of the third year and the seventh year respectively of the term granted by letters patent issued for the United Kingdom under the said Patent Law Amendment Act, 1852, and the condition of such letters patent for England, or Scotland or Ireland shall be varied accordingly.

Duties to be under the management of the Commissioners of Inland Revenue.

V. The stamp duties hereby granted shall be under the care and management of the Commissioners of Inland Revenue; and the several rules, regulations, provisions, penalties, clauses, and matters contained in any Act now or hereafter to be in force with reference to stamp duties shall be applicable thereto.

Who are to provide the proper stamp for the purpose.

VI. The said Commissioners of Inland Revenue shall prepare stamps impressed upon adhesive paper, of the amounts following, that is to say, twopence, fourpence, eightpence, and one shilling, to be used only in respect of the stamp duties on the office copies of documents and on the certificates of searches and inspections mentioned in the schedule to this Act: such adhesive stamps of proper amounts to be affixed by the clerk of the Commissioners of Patents for inventions to such office copies of documents and certificates of searches and inspections as aforesaid; and immediately after such affixing he shall obliterate or deface such stamps by impressing thereon a seal to be provided for that purpose, but not so as to prevent the amount of the stamp from being ascertained; and no such office copy or certificate shall be delivered out until the stamps thereon shall be obliterated or defaced as aforesaid.

Conditions of letters patent already granted under recited Act to be satisfied by payment of stamp duties, &c., under this Act.

VII. The condition contained in any letters patent granted under the said Patent Law Amendment Act, 1852, and before the passing of this Act for making such letters patent void at the expiration of three years and seven years respectively from the date thereof, unless there be paid before the expiration of the said three years and seven years respectively, the sums of money and stamp duties by the said Patent Law Amendment Act, 1852, required in this behalf, shall be deemed to be satisfied and complied with by payment of the like stamp duties as would have been required if such letters

patent had been granted after the passing of this Act, and had been made subject to the condition required by this Act in lieu of the said condition therein contained; and the provision hereinbefore contained concerning the endorsement on the letters patent or duplicate, and on the warrant for the same letters patent, of a certificate of the production of the letters patent or duplicate properly stamped, shall be applicable in the case of such letters patent granted before the passing of this Act.(*a*)

As to the word "duplicate."

IX. The word "duplicate" shall be construed to mean in this Act such letters patent as may be issued under the twenty-second section of the Patent Law Amendment Act, 1852, in case of any letters patent being destroyed or lost.

This Act and 15 & 16 Vict. c. 83 to be construed together.

X. This Act and the Patent Law Amendment Act, 1852, shall be construed together as one Act.

THE SCHEDULE OF STAMP DUTIES TO BE PAID TO WHICH THIS ACT REFERS.

	£	s.	d.
On petition for grant of letters patent . .	5	0	0
On certificate of record of notice to proceed .	5	0	0
On warrant of law officer for letters patent .	5	0	0
On the sealing of letters patent	5	0	0
On specification	5	0	0
On the letters patent or a duplicate thereof, before the expiration of the third year . .	50	0	0
On the letters patent or a duplicate thereof, before the expiration of the seventh year .	100	0	0
On certificate of record of notice of objections .	2	0	0
On certificate of every search and inspection .	0	1	0
On certificate of entry of assignment or licence .	0	5	0
On certificate of assignment or licence . .	0	5	0
On application for disclaimer	5	0	0
On caveat against disclaimer	2	0	0
On office copies of documents, for every ninety words	0	0	2

(*a*) Section 8, which relates to the purchase of indexes from Mr. Bennet Woodcroft, has been omitted.

16 & 17 VICT. C. 115.

An Act to amend certain Provisions of the Patent Law Amendment Act, 1852, *in respect of the Transmission of Certified Copies of Letters Patent and Specifications to certain Offices in Edinburgh and Dublin, and otherwise to amend the said Act.* [20th August, 1853.]

15 & 16 Vict. c. 83.

WHEREAS it is expedient to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act, be it therefore enacted as follows:

Sec. 33, and part of s. 28 of recited Act, repealed.

I. Section thirty-three of the said Act and such part of section twenty-eight of the said Act as directs that in case reference is made to drawings in any specification deposited or filed under the said Act an extra copy of such drawings should be left with such specification, shall be repealed.

Copies of provisional specifications to be open to inspection at the Commissioners' office.

II. The Commissioners 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.

A copy of every specification, &c., under the hand of the patentee or applicant to be left at Commissioners' office.

III. 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 on filing such specification or complete specification.

Copies or extracts of letters patent, &c., certified and sealed, filed at Commissioners' office, to be received in evidence.

IV. Printed or manuscript copies or extracts, certified and sealed with the seal of the Commissioners, 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 whatsoever 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.

Certified printed copies of specifications, &c., under seal of Commissioners, to be transmitted to the Director of Chancery in Scotland, and to the Court of Chancery in Ireland, which shall be evidence, without production of originals.

V. Certified printed copies, under the seal of the Commissioners, of all specifications and complete specifications, and fac-simile printed copies of the drawings accompanying the same, if any, disclaimers, and memoranda of alterations filed or hereafter to be filed, under the said Patent Law Amendment Act, shall be transmitted to the office of the Director of Chancery in Scotland and to the Enrolment Office of the Court of Chancery in Ireland within twenty-one days after the filing thereof respectively, and the same shall be filed in the office of Chancery in Scotland and Ireland respectively, and certified copies or extracts from such documents shall be furnished to all persons requiring the same, on payment of such fees as the Commissioners shall direct; and such copies or extracts shall be received in evidence in all courts in Scotland and in Ireland respectively in all proceedings relating to letters patent for inventions without further proof or productior of the originals.

Lord Chancellor in certain cases may seal letters patent after the expiration of provisional protection.

VI. Where letters patent have not been sealed during the continuance of the provisional protection on which the same is granted, provided the delay in such sealing has arisen from accident, and not from the neglect or wilful default of the applicant, it shall be lawful for the Lord Chancellor, if he shall think fit, to seal such letters patent at any time after the expiration of such provisional protection, whether such expiration has happened before or shall happen after the passing of this Act, and to date the sealing thereof as of any day before the expiration of such provisional protection, and also to extend the time for the filing of the specification thereon; and where the specification, in pursuance of the condition of any letters patent, has not been filed within the time limited by such letters patent, provided the delay in such filing has arisen from accident, and not from the neglect or wilful default of the patentee, it shall be lawful for the

Lord Chancellor, if he shall think fit, to extend the time for the filing of such specification, whether the default in such filing has happened before or shall happen after the passing of this Act: Provided always, that except in any case that may have arisen before the passing of this Act, it shall not be lawful for the Lord Chancellor to extend the time for the sealing of any letters patent, or for the filing of any specification beyond the period of one month.

Removing doubts as to provision of 15 & 16 Vict. c. 83, respecting the making and sealing of new letters patent for a further term.

VII. And whereas doubts have arisen whether the provision of the Patent Law Amendment Act, 1852, for the making and sealing new letters patent for a further term, in pursuance of Her Majesty's order in council, in the cases mentioned in section forty of the said Act, extend to the making and sealing of new letters patent in the manner by such Act directed where such new letters patent are granted by way of prolongation of the term of letters patent issued before the commencement of the said Act: and whereas it is expedient that such new letters patent granted by way of prolongation shall be granted according to the provisions of the said Patent Law Amendment Act; be it declared and enacted, that where Her Majesty's order of Council for the sealing of new letters patent shall have been made after the commencement of the said Act, the said provision of the said Act for making and sealing in manner aforesaid of new letters patent shall extend, and shall as from the commencement of the said Act be deemed to have extended, to the making and sealing in manner aforesaid of new letters patent for a further term, as well where the original letters patent were made before as where such original letters patent have been issued since the commencement of the said Act.

15 & 16 Vict. c. 83 and this Act to be construed as one Act.

VIII. This Act and the Patent Law Amendment Act, 1852, shall be construed together as one Act.

22 VICT. C. 13.

An Act to amend the Law concerning Patents for Inventions with respect to Inventions for Improvements in Instruments and Munitions of War.

[8th of April, 1859.]

WHEREAS in some cases of inventions for improvements in instruments or munitions of war it may be important to the public service that the nature of the invention should not be published, and it is therefore expedient to amend the law concerning letters patent for inventions: Be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal and Commons in this present Parliament assembled, and by the authority of the same as follows:—

Improvements in instruments or munitions of war may be assigned by inventors to Secretary of State for War.

I. Any inventor of any improvement in instruments or munitions of war, or the executors, administrators, or assigns of such inventor, may, for valuable consideration or without, assign to Her Majesty's principal Secretary of State for the War Department, on behalf of Her Majesty, all the benefits of the invention, and of all letters patent obtained or to be obtained for the same, and such Secretary of State may be a party to the assignment, and such assignment shall be effectual to vest the benefit of such invention and of such letters patent in the said Secretary of State for the time being on behalf of Her Majesty at law and in equity; and the benefit of such invention and of such letters patent shall be deemed property acquired by the said Secretary of State on behalf of Her Majesty; and all covenants and agreements contained in such assignment for giving full effect thereto, and for keeping the invention secret, and otherwise in relation thereto, shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced and proceeded upon by the said Secretary of State for the time being accordingly, and all actions, suits, and proceedings in relation thereto may be instituted and conducted by such Secretary of

State for the time being, who shall have all such rights, privileges, and prerogatives in relation thereto as by law provided in the case of actions, suits, and proceedings concerning property under his care, control, and disposition.

Foregoing enactment to extend to assignments already made.

II. The foregoing enactment shall extend to render valid and effectual, and be otherwise applicable to and in respect of, any such assignment as aforesaid made before the passing of this Act, and the covenants and agreements contained in such assignment, as well as any such assignment to be made thereafter, and the covenants and agreements therein contained.

Secretary of State for War may certify to Commissioners of Patents that the invention should be kept secret.

III. Where any such assignment as aforesaid has been made to the said Secretary of State, he may at any time before the filing of the petition for the grant of letters patent for the invention, or after the filing of such petition and before publication of the provisional specification (if any), if he think it for the benefit of the public service that the particulars of the invention, and of the manner in which the same is performed, should be kept secret, certify the fact of such assignment having been so made, and his opinion to the effect aforesaid in writing under his hand to the commissioners of patents for inventions.

Where the Secretary of State for War has so certified, petition for letters patent &c. to be left with the clerk of the patents in a packet under the seal of Secretary of State.

IV. Where the said Secretary of State certifies as aforesaid, the petition for letters patent for the invention, the declaration accompanying such petition, and the provisional specification or complete specification (as the case may be), filed or left therewith, and any specification to be filed in pursuance of the condition of any letters patent for such invention, and all disclaimers and memoranda of alterations to be filed in relation to such letters patent, and any drawings accompanying any of the documents aforesaid, and any copies of any such documents or drawings, or where the said Secretary of State so certifies after the said petition has been filed, such of the said documents and drawings as may be filed after his so certifying, and the copies thereof, shall, in lieu of being filed or left in the ordinary manner in the office of the commissioners, or in the office appointed for that purpose under

"The Patent Law Amendment Act, 1854," be delivered to the clerk of the patents in a packet sealed with the seal of the said Secretary of State.

Such packet to be kept so sealed or under the seal of the Commissioners.

V. Such packet shall at all times after the delivery thereof to the clerk of the patents until the expiration of the term or any extended term for which letters patent for the invention may be granted, be kept by him sealed up as aforesaid, or under the seal of the commissioners, save when it may be necessary to have access to the documents therein contained, or any of them, for the purpose of recording and endorsing the day of the filing thereof, or for the purpose of any reference to one of the law officers, either in relation to the same or any other invention, but in any such case as aforesaid the clerk of the patents shall not part with the care or custody of the said packet, or any of the said documents, save as may be required by one of the law officers for the purposes of any such reference, and shall use such precautions as may be necessary to prevent the contents or particulars of such documents being improperly disclosed.

Such sealed packet to be delivered on demand to Secretary of State or by order of the Lord Chancellor.

VI. Such sealed packet shall be delivered at any time during the continuance of any such letters patent to the said Secretary of State, or to any person having authority to receive the same on his behalf, on demand in writing under the hand of the said Secretary of State, or to such person as the Lord Chancellor may order, and shall if and when the same is returned to the commissioners be again sealed up, and kept under seal as aforesaid.

At the expiration of letters patent, sealed packet to be delivered to Secretary of State.

VII. Such sealed packet as aforesaid shall at the end of the term or extended term for which any letters patent for the invention to which the documents in such packet relate, be delivered up to the said Secretary of State, or to any person having authority to receive the same on his behalf.

Where Secretary of State certifies after filing of petition, documents already filed to be put into a sealed packet.

VIII. Where the said Secretary of State certifies as aforesaid after the filing of the petition, and before the publication of the provisional specification (if any), such petition and the declaration accompanying such petition and the provisional specification and drawings relating to the inven-

tion which may have been filed or left in any such office as aforesaid, and all copies thereof in any such office, shall be forthwith placed in a packet, sealed with the seal of the commissioners, and every such packet shall be subject to all the provisions of this Act concerning any sealed packet delivered to the clerk of the patents.

Copy of specification, &c., not to be sent to Scotland or Ireland, or published; but, otherwise, provisions of Patent Acts to apply.

IX. No copy of any specification or other document or drawing by this Act required to be kept under seal, shall be transmitted to *Scotland* or *Ireland*, or be printed, published, or sold, or be open to the inspection of the public; but save as in this Act otherwise directed, the provisions of the "Patent Law Amendment Act, 1852," and any Act amending the same, shall extend and be applicable to and in respect of every such specification and other document and drawing as aforesaid, and the letters patent and invention to which the same relates, and this Act and the "Patent Law Amendment Act, 1852," shall be construed together as one Act.

No *scire facias* to be brought.

X. It shall not be lawful for any person to take proceedings, by *scire facias* or otherwise, to repeal any letters patent for an invention in relation to which the said Secretary of State has certified as aforesaid.

Secretary of State may waive the benefit of this Act as respects any invention.

XI. The Secretary of State may at any time by writing under his hand waive the benefit of this Act with respect to any particular invention, and the document and matters relating thereto shall be thenceforth kept and dealt with in the ordinary way.

Communications of invention to Secretary of State, &c., not to prejudice letters patent.

XII. The communication of any invention for any improvement in instruments or munitions of war to the said Secretary of State, or to any person or persons authorized by him to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation be deemed use or publication of such invention so as to prejudice the grant or validity of any letters patent for the same.

Construction of "Secretary of State."

XIII. In the construction of this Act, "Her Majesty's Principal Secretary of State for War Department" shall mean Her Majesty's principal Secretary of State for the time being, to whom Her Majesty shall think fit to entrust the seals of the War Department.

33 & 34 VICT. C. 27.

An Act for the Protection of Inventions exhibited at International Exhibitions in the United Kingdom.

[14th of July, 1870.]

WHEREAS it is expedient that such protection as is hereinafter mentioned should be afforded to persons desirous of exhibiting new inventions at exhibitions to be held in the United Kingdom.

Be it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal and Commons in this present parliament assembled, and by the authority of the same as follows (that is to say):

Short title.

I. This Act may be cited as "The Protection of Inventions Act, 1870."

Exhibition of new inventions not to prejudice patent rights.

II. The exhibition of any new invention at any international exhibition shall not, nor shall the publication during the period of the holding of such exhibition, of any description of such invention, nor shall the user of such invention for the purposes of such exhibition, and within the place where the same may be held, nor shall the user of such invention elsewhere by any other person without the privity and consent of the true and first inventor thereof, prejudice the right of the exhibitor thereof, he being the true and first inventor, within six months from the time of the opening of such exhibition to leave at the office of the Commissioners of Patents a petition for the grant of letters patent for such invention, and the declaration accompanying the same, and a provisional specification or a complete specification thereof, under the "Patent Law Amendment Act, 1852," and the Acts amending the same, or to obtain provisional protection or letters patent for such invention, in pursuance of those Acts, nor invalidate any letters patent which may be granted for such invention upon any such petition as aforesaid.

Rules and Regulations.

Made by the Commissioners of Patents for Inventions and by the Lord Chancellor and the Master of the Rolls under the Acts 15 *&* 16 *Vict. c.* 83 *and* 16 *&* 17 *Vict. c.* 115.

First set of Rules and Regulations under the Act 15 *&* 16 *Vict. c.* 83 *for the passing of Letters Patent for inventions.*

By the Right Honourable Edward Burtenshaw, Lord St. Leonards, Lord High Chancellor of Great Britain, The Right Honourable Sir John Romilly, Master of the Rolls, Sir Frederic Thesiger, Her Majesty's Attorney General, and Sir Fitz Roy Kelly, Her Majesty's Solicitor General, being four of the Commissioners of Patents for Inventions under the said Act.

Whereas a commodious office is forthwith intended to be provided by the Crown as the Great Seal Patent Office and the Commissioners of Her Majesty's Treasury have under the powers of the said Act appointed such office as the office also for the purpose of the said Act.

I. All petitions for the grants of letters patent and all declarations and provisional specifications shall be left at the said Commissioners' office and shall be respectively written upon sheets of paper of twelve inches in length by eight inches and a half in breadth, leaving a margin of one inch and a half on each side of each page in order that they may be bound in the books to be kept in the said office.

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

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

IV. Every invention protected by reason of the deposit of a complete specification shall be forthwith advertised in the *London Gazette* and the advertisement shall set forth the name and address of the petitioner, the title of the invention, the date of the application, and that a complete specification has been deposited.

V. Where a petitioner applying for letters patent after provisional protection or after deposit of a complete specification, shall give notice in writing at the office of the Commissioners of his intention to proceed with his application for letters patent the same shall forthwith be advertised in the *London Gazette*, and the advertisement shall set forth the name and address of the petitioner and the title of his invention; and that any persons having an interest in opposing such application are to be at liberty to leave particulars in writing of their objections to the said application at the office of the Commissioners within twenty-one days after the date of the *Gazette* in which such notice is issued.

VI. The Lord Chancellor having appointed the Great Seal Patent Office to be the Office of the Court of Chancery for the filing of specifications, the said Great Seal Patent Office and the Office of the Commissioners shall be combined; and the clerk of the patents for the time being shall be the clerk of the Commissioners for the purposes of the Act.

VII. The office shall be open to the public every day, Christmas Day and Good Friday excepted, from ten till four o'clock.

VIII. The charge for office or other copies of documents in the office of the Commissioners shall be at the rate of twopence for every ninety words.

(Signed)

ST. LEONARDS, C.
JOHN ROMILLY, M. R.
FRED. THESIGER, A. G.
FITZ ROY KELLY, S. G.

Dated the 1st of October, 1852.

By the Right Honourable Edward Burtenshaw, Lord St. Leonards, Lord High Chancellor of Great Britain, and the Right Honourable Sir John Romilly, Master of the Rolls.

Ordered that there shall be paid to the law officers and to their clerks the following fees :—

By the person opposing a grant of letters patent:

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

By the petitioner on the hearing of the case of opposition:

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

By the petitioner for the hearing previous to the fiat of the law officer allowing a disclaimer or memorandum of alteration in letters patent and specification :

	£	s.	d.
To the law officer	2	12	6
To his clerk	0	12	6

By the person opposing the allowance of such disclaimer or memorandum of alteration on the hearing of the case of opposition :

	£	s.	d.
To the law officer	2	12	6
To his clerk	0	12	6

By the petitioner for the fiat of the law officer allowing a disclaimer or memorandum of alteration in letters patent and specification.

	£	s.	d.
To the law officer	3	3	0
To his clerk	0	12	6

(Signed) St. Leonards, C.
John Romilly, M. R.

Dated the 1st of October, 1852.

Ordered by the Right Honourable Edward Burtonshaw, Lord St. Leonards, Lord High Chancellor of Great Britain.

I. All specifications in pursuance of the condition of letters patent and all complete specifications accompanying petitions and declarations before grant of letters patent shall be filed in the Great Seal Patent Office.

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

III. The drawings accompanying such specification shall be made upon a sheet or sheets of parchment each of the size of twenty-one inches and a half in length by fourteen inches and three fourths of one inch in breadth, or upon a sheet or sheets of parchment, each of the size of twenty-one inches and a half in breadth by twenty-nine inches and a half in length, leaving a margin of one inch and a half on every side of each sheet.

IV. The charge for office or other copies of documents in the Great Seal Patent Office shall be at the rate of two pence for every ninety words.

(Signed) St. Leonards, C.

Dated the 1st of October, 1852.

Note.—It is recommended to applicants and patentees to make their elevation drawings according to the scale of one inch to a foot.

Second set of Rules and Regulations under the Act 15 & 16 *Vict. c.* 83 *for the passing of letters patent for inventions.*

By the Right Honourable Edward Burtenshaw, Lord St. Leonards, Lord High Chancellor of Great Britain, the Right Honourable Sir John Romilly, Master of the Rolls, Sir Frederic Thesiger, Her Majesty's Attorney General, and Sir Fitz Roy Kelly, Her Majesty's Solicitor General, being four of the Commissioners of Patents for Inventions under the said Act.

I. The office of the Directory of Chancery in Scotland being the office appointed by the Act for the recording of transcripts of letters patent shall be the office of the Commissioners in Edinburgh for the filing of copies of specifications, disclaimers, memoranda of alterations, provisional specifications, and certified duplicates of the register of proprietors.

II. All such transcripts, copies, and certified duplicates shall be bound in books and properly indexed, and shall be open to the inspection of the public at the said office every day from ten to three o'clock.

III. The charge for office copies of such transcripts, copies, and certified duplicates recorded and filed in the said office shall be at the rate of twopence for every ninety words.

IV. The enrolment office of the Court of Chancery in Dublin being the office appointed by the Act for the enrolment of transcripts of letters patent shall be the office of the Commissioners in Dublin for the filing of copies of specifications, disclaimers, memoranda of alterations, provisional specifications, and certified duplicates of the register of proprietors.

V. All such transcripts, copies, and certified duplicates shall be bound in books and properly indexed, and shall be open to the inspection of the public at the said Enrolment Office every day, Christmas Day and Good Friday excepted, from ten to three o'clock.

VI. The charge for office copies of such transcripts, copies, and certified duplicates enrolled and filed as aforesaid shall be at the rate of twopence for every ninety words.

VII. No warrant is to be granted for the sealing of any letters patent which contains two or more distinct substantive inventions. (*a*)

VIII. A provision is to be inserted in all letters patent in respect whereof a provisional and not a complete specification shall be left on the application for the same, requiring the specification to be filed within six months from the date of the application.

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

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

(Signed) St. Leonards, C.
John Romilly, M. R.
Fred. Thesiger, A. G.
Fitz Roy Kelly, S. G.

Dated the 15th October, 1852.

Ordered by the Right Honourable Edward Burtonshaw Lord St. Leonards, Lord High Chancellor of Great Britain.

Every application to the Lord Chancellor against or in relation to the sealing of letters patent shall be by notice, and such notice shall be left at the commissioners' office, and shall contain particulars in writing of the objections to the sealing of such letters patent.

(Signed) St. Leonards, C.

Dated the 15th of October, 1852.

(*a*) This rule was rescinded by the third set of rules of the 12th December, 1853.

Third Set of Rules and Regulations under the Act 15 *&* 16 *Vict. c.* 83, *for the passing of letters patent for inventions, and under the Act of the* 16 *&* 17 *Vict. c.* 115.

By the Right Honourable Robert Monsey, Lord Cranworth, Lord High Chancellor of Great Britain, the Right Honourable Sir John Romilly, Master of the Rolls, Sir Alexander James Edmund Cockburn, Her Majesty's Attorney General, and Sir Richard Bethell, Her Majesty's Solicitor General, being four of the Commissioners of Patents for Inventions under the said Act of the 15 & 16 Vict. c. 83.

It is ordered as follows:—

Rule 7 of the Second Set of Rules and Regulations of the Commissioners, dated the 15th October, 1852, is hereby rescinded.

I. Every application for letters patent, and every title of invention and provisional specification, must be limited to one invention only, and no provisional protection will be allowed or warrant granted where the title or the provisional specification embraces more than one invention.

II. The title of the invention must point out distinctly and specifically the nature and object of the invention.

III. The copy of the specification or complete specification, directed by the Act 16 & 17 Vict. c. 115, s. 3, to be left at the office of the commissioners on filing the specification or complete specification, shall be written upon sheets of brief or foolscap paper, briefwise and upon one side only of each sheet. The extra copy of drawings, if any, left with the same must be made as heretofore and according to the directions contained in Rule III. of the Lord Chancellor, dated the 1st of October, 1852.

IV. The copy of the provisional specification, to be left at the office of the commissioners, on depositing the same, shall be written upon sheets of brief or foolscap paper briefwise and upon one side only of each sheet. The extra copy of drawings, if any, left with the same must be made as hereto-

fore and according to the directions contained in Rule II. of the commissioners, dated the 1st October, 1852.

V. All specifications, copies of specifications, provisional specifications, petitions, notices, and other documents left at the office of the commissioners, and the signatures of the petitioners or agents thereto, must be written in a large and legible hand.

VI. In the case of all petitions for letters patent left at the office of the commissioners after the 31st day of December, 1853, the notice of the applicant of his intention to proceed for letters patent for his invention shall be left at the office of the commissioners eight weeks at the least before the expiration of the term of provisional protection thereon; and no notice to proceed shall be received unless the same shall have been left in the office eight weeks at the least before the expiration of such provisional protection, and the application for the warrant of the law officer and for the letters patent must be made at the office of the commissioners twelve clear days at least before the expiration of the term of provisional protection; and no warrant or letters patent shall be prepared unless such application shall have been made twelve clear days at the least before the expiration of such provisional protection: Provided always, that the Lord Chancellor may in either of the above cases, upon special circumstances, allow a further extension of time on being satisfied that the same has become necessary by accident, and not from neglect or wilful default of the applicant or his agent.

(Signed) CRANWORTH, C.
JOHN ROMILLY, M. R.
A. J. E. COCKBURN, A. G.
RICHARD BETHELL, S. G.

Dated the 12th of December, 1853.

Order in respect of Applications to the Lord Chancellor to extend the time for sealing Letters Patent.

By the Right Honourable Robert Monsey Lord Cranworth, Lord High Chancellor of Great Britain.

Whereas by the Act 16 & 17 Vict. c. 115 the Lord Chancellor is empowered to extend the time for the sealing of letters patent for an invention, and for the filing of the specification thereon limited to the period of one month after the expiration of the six months of provisional protection of such invention, provided the delay in sealing such letters patent and in filing such specification has arisen from accident, and not from the neglect or wilful default of the applicant,

It is ordered as follows:—

Every petition addressed to the Lord Chancellor praying for the extension of time for the sealing of letters patent and for the filing of the specification thereon, under the provisions of the Act of the 16 & 17 Vict. c. 115, and the affidavit accompanying the same, shall be left at the office of the Commissioners of Patents. And in every case where the delay in sealing such letters patent and in filing such specification is alleged to have been caused by adjourned hearings of objections to the grant of such letters patent before the law officer to whom such objections may have been referred, the petitioner, before leaving his petition as aforesaid, shall obtain the certificate of such law officer to the effect that the allegations in respect of such adjourned hearings and causes of delay are, in the opinion of such law officer, correct, and that the delay arising from such adjourned hearings has not been occasioned by the neglect or default of the petitioner. And such certificate shall be written at the foot of or shall be annexed to such petition.

(Signed) CRANWORTH, C.

Dated this 17th day of July, 1854.

Orders in respect of communications from abroad and provisional specifications.

I. In any application for a patent which is stated to be a communication, the declaration must state the name and address of the party from whom it has been received in the following manner:—

No. I. When declaration is made in the United Kingdom: "That it has been communicated to me from abroad by (*here insert name and address in full*)."

No. 2. In other cases: "That it is a communication from (A. B.) a person resident at (*here insert address in full*)."

II. All provisional specifications on one side only of each sheet.

FITZ ROY KELLY.
H. M. CAIRNS.

Dated the 23rd of February, 1859.

RULES OF PRACTICE BEFORE THE LAW OFFICERS RESPECTING DISCLAIMERS AND MEMORANDA OF ALTERATIONS.

I. The person applying must present a petition to the Attorney-General or Solicitor-General, stating what the proposed disclaimer or alteration is, when a time will be appointed for hearing the applicant. The petition is in general to be accompanied by a copy of the original specification, and of the proposed disclaimer or alteration.

II. If on the hearing the Attorney or Solicitor-General should think fit to disallow the proposed alteration or disclaimer, no further proceeding is necessary. If he should think fit to allow it without any advertisement, then, on being applied to for the purpose, he will put his signature to the fiat authorizing the clerk of the patents to make the required enrolment.

III. If it appears to the Attorney or Solicitor-General that any advertisement or advertisements ought to be inserted, then he will give such directions as he may think fit relative

thereto, and will fix any time not sooner than ten days from the first publication of any such advertisement, for resuming the consideration of the matter.

IV. Caveats may be lodged at any time before the actual issuing of the fiat; and any party lodging a caveat is to have seven days' notice of the next meeting.

V. The fiat must be written or engrossed on the same parchment with the disclaimer or alteration at the foot thereof.(*a*)

Patent Law Amendment Act, 1852. 15 & 16 *Vict. c.* 83.

By the Right Honourable Frederic Lord Chelmsford Lord High Chancellor of Great Britain, the Right Honourable John Lord Romilly, Master of the Rolls, Sir John Rolt, Her Majesty's Attorney General, and John Burgess Karslake, Esquire, Her Majesty's Solicitor General, being four of the Commissioners of Patents for Inventions under the said Act.

It is ordered as follows:—

After the 31st day of December, 1866, every applicant for letters patent shall deliver at the office of the commissioners, with his provisional specification, or (when a complete specification is filed with the petition and declaration) with his complete specification, an abridgment, in duplicate, under his hand or the hand of his agent, of such provisional or complete specification. The abridgment must set forth the name of the applicant, the title of the invention, and describe, in as short a manner as possible, the features of novelty which constitute the invention. The abridgment and the copy thereof must be written upon sheets of foolscap paper, and upon one side only of each page, leaving a margin of one inch and a half on the left hand side of the page.

(Signed) CHELMSFORD, C.
ROMILLY, M. R.
JOHN ROLT.
JOHN B. KARSLAKE.

Dated the 17th day of December, 1866.

(*a*) See Norman's Law of Patents.

Patent Law Amendment Act, 1852. 15 & 16 *Vict.* c. 83.

By the Right Honourable Frederic Lord Chelmsford, Lord High Chancellor of Great Britain, the Right Honourable John Lord Romilly, Master of the Rolls, Sir John Rolt, Her Majesty's Attorney General, and Sir John Burgess Karslake, Her Majesty's Solicitor General, being four of the Commissioners of Patents for inventions under the said Act.

It is ordered as follows :—

That on and after the 1st of July, 1867, no stamp duties payable upon notices to proceed, notices of objection, or warrants and letters patent shall be received in the office of the Commissioners after 2 o'clock in the afternoon of Saturdays, nor after 3 o'clock on other days: Except that on the last day for the payment of any of such stamp duties they shall be received up to 4 o'clock.

(Signed) CHELMSFORD, C.
ROMILLY, M. R.
JOHN ROLT.
JOHN B. KARSLAKE.

Dated the 14th day of May, 1867.

Patent Law Amendment Act, 1852. 15 & 16 *Vict.* c. 83.

By the Right Honourable William Page, Lord Hatherley, Lord High Chancellor of Great Britain, the Right Honourable John Lord Romilly, Master of the Rolls, Sir Robert Porrett Collier, Her Majesty's Attorney General, and Sir John Duke Coleridge, Her Majesty's Solicitor General, being four of the Commissioners of Patents for inventions under the said Act.

It is ordered as follows :—

Rule II. of the First Set of Rules and Regulations of the Commissioners, dated the 1st October, 1852, to be altered by

the addition of the word "drawing" before the word "paper" in the second line of the printed copy.

(Signed) HATHERLEY, C.
ROMILLY, M. R.
R. P. COLLIER, A. G.
J. D. COLERIDGE, S. G.

Dated the 1st day of July, 1871.

GENERAL ORDER. (11TH FEBRUARY, 1873.)

I, the Right Honourable Roundell Baron Selborne, Lord High Chancellor of Great Britain, do hereby in pursuance of all powers and authorities enabling me in that behalf, order and direct in manner following, that is to say:

Every order made by the Lord Chancellor upon the hearing of petitions against or relating to the sealing of Letters Patent, under the Patent Law Amendment Act, 1852, 15 & 16 Vict. c. 83, shall be drawn up, passed, and entered by the Registrar of the Court of Chancery in attendance, and an office copy of such order shall be remitted by him without fee to the clerk of the combined offices of the Great Seal Patent Office, and the office of the Commissioners of Patents for inventions, to be filed with the petition.

SELBORNE, C.

Rules to be observed in Proceedings before the Privy Council under the Act 5 & 6 Will. IV. intituled "An Act to amend the Law touching Letters Patent for Inventions."

I. A party intending to apply by petition under section 2 of the said Act, shall give public notice by advertising in the *London Gazette* three times and in three London papers, and three times in some country paper published in the town where or near to which he carries on any manufacture of anything

made according to his specification, or near to or in which he resides, in case he carries on no such manufacture, or published in the county where he carries on such manufacture or where he lives in case there shall not be any paper published in such town, that he intends to petition Her Majesty under the said section, and shall in such advertisement state the object of such petition, and give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall be not less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*,) and that on or before such day notice must be given of any opposition intended to be made to the petition; and any person intending to oppose the said application shall lodge notice to that effect at the Council Office, on or before such day so named in the said advertisement and having lodged such notice shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

II. A party intending to apply by petition under section 4 of the said Act, shall in the advertisement directed to be published by the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day *caveats* must be entered; and any person intending to enter a *caveat* shall enter the same at the Council Office, on or before such day so named in the said advertisements; and having entered such *caveat*, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

III. Petitions under section 2 and 4 of the said Act must be presented within one week from the insertion of the last of the advertisements required to be published in the *London Gazette*.

IV. All petitions must be accompanied with affidavits of advertisements having been inserted according to the provi-

sions of section 4 of the said Act, and the 1st and 2nd of these rules, and the matters in such affidavits may be disputed by the parties opposing upon the hearing of the petitions.

V. All persons entering *caveats* under section 4 of the said Act, and all parties to any former suit or action touching letters patent, in respect of which petitions shall have been presented under section 2 of the said Act, and all persons lodging notice of opposition under the first of these rules, shall respectively be entitled to be served with copies of petitions presented under the said sections, and no application to fix a time for hearing shall be made without affidavit of such service.

VI. All parties served with petition shall lodge at the Council Office, within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions.

VII. Parties may have copies of all papers lodged in respect of any application under the said Act, at their own expense.

VIII. The registrar of the Privy Council, or other officers to whom it may be referred to tax the costs incurred in the matter of any petition presented under the said Act, shall allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

IX. A party applying for an extension of a patent under section 4 of the said Act, must lodge at the Council Office six printed copies of the specification, and also four copies of the balance sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Lords of the Committee at the hearing. In the event of the applicant's specification not having been printed, and if the expense of making six copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only of such specification and drawing will be deemed sufficient.

All copies mentioned in this rule must be lodged not less than one week before the day fixed for hearing the application. The Judicial Committee will hear the Attorney General or

other counsel on behalf of the Crown against granting any application made under either the 2nd or 4th section of the said Act in case it shall be thought fit to oppose the same on such behalf.

FOREIGN LAW.

AUSTRIA-HUNGARY.

AN inventor desirous of securing an exclusive right to his invention in Austria-Hungary must provide himself with two patents, which are however granted on a single application addressed either to the Cisleithanian or Hungarian Ministry of Commerce and on payment of one fee. The patents thus issued are valid also in the principality of Liechtenstein.

All inventions must have for their object either (1) a new industrial production; (2) a new means of production; or (3) a new method of production. But patents will not be granted for inventions which affect the preparation of food, drink and medicine, nor for those which cannot be used without injury to the interests of the state, the public health, morality and safety.

A foreign invention can only be patented on condition that it is still patented abroad; and a patent for such invention can only be granted to the foreign patentee or the possessor of his rights in it.

Patents for improvement are granted for the improvement only and not for the whole invention.

Patents are not granted for the discovery of scientific principles, unless the latter are actually brought to bear upon production.

One patent is never granted for two or more inventions, except in cases where both or all of them are to be used in the production of one and the same object.

The application for a patent must be accompanied with a

description and drawings and models if necessary. It must be made by the inventor or his agent. If the invention is foreign the original patent and a certified copy must be inclosed.

The petition must state the title of the invention and whether or not secresy is desired, and also the number of years for which the patent is demanded. This number cannot exceed fifteen without the special consent of the Emperor; or if the invention is already patented abroad, the expiration of the patent there granted.

The tax is as follows: For the first five years, 100 florins 10 krs.; for the second five years, 200 florins 20 krs.; for the third five years, 400 florins 40 krs. Total for fifteen years, 700 florins 70 kr.

The provincial governor, to whom the application for a patent is forwarded must see that the subject matter is such that a patent can be granted and that the proper forms have been observed. The application is then forwarded to the Minister of Commerce. If the description is incorrect or the subject not patentable, the documents are returned to the applicant for correction, or as being useless, according to the circumstances.

A patent authorises the patentee to take all requisite measures for working his invention and selling its products, and to empower others to work it for him. He may dispose of his patent as he likes, by sale, testament, lease, etc., and obtain foreign patents for his invention.

A renewal of patents granted for less than fifteen years may be granted so long as the whole term with the extension does not exceed fifteen years.

Patents become invalid:

I. In consequence of being cancelled on the following grounds:

(*a*) When all the legal requirements have not been complied with in obtaining them.

(*b*) On proof being given that the invention in question was not new at the time when the patent was issued; or that

it was introduced from abroad without the consent of the foreign patentees.

(*c*) On proof being given by a patentee that the invention is identical with one for which a patent has already been granted.

(*d*) As being injurious to the public interests.

2. By lapsing:

(*a*) When the patentee fails to make use of his patent for one year from the date of its issue, or later, allows two consecutive years to elapse without working his invention.

(*b*) On the expiration of the term for which the patent was granted or renewed.

(*c*) In consequence of a voluntary renunciation of the rights conferred by a patent.

BAVARIA.

THE department by which patents and trade privileges are issued is that of the Bavarian Ministry of the Interior.

The longest term for the duration of a patent in Bavaria is fifteen years.

The following is the scale of fees:

	Fl.		Fl.
1 year	25	9 years	130
2 years	35	10 „	150
3 „	40	11 „	175
4 „	50	12 „	200
5 „	60	13 „	225
6 „	70	14 „	250
7 „	90	15 „	275
8 „	110		

Patents may be granted for all new inventions, discoveries, or improvements in all branches of industry, whether consisting of new articles, implements, or processes of manufacture. The invention must be new and original and must be likely

to prove beneficial to industry; and it must be shown that neither the article nor the process to be employed in using it is illegal, dangerous, or injurious.

Patents may be granted for inventions patented abroad if they fulfil the foregoing conditions; such patents will only be granted to the foreign patentee or his legal successor, and will not be allowed to continue in force after the foreign term has expired.

Applicants for patents must produce security for the novelty and originality of their inventions. The patent will be revoked if it turns out not to be new and original or that the invention has been made, applied or in any way known elsewhere.

Applicants for patents must petition the minister of the interior. The petition must contain their names in full, their position, residence, and domicile, and in the case of foreigners those of their authorised agent. It must also contain a description of the invention, and must state the term of years for which the patent is required.

The legal fee and stamp duty must be paid when the petition is presented, and a specification, and, if necessary, drawings, models, or samples must be sent at the same time.

The term may be prolonged if the patent has been originally issued for less than fifteen years, but no patent will be allowed to extend over a longer period than fifteen years from the date of the original issue.

A patentee is at liberty to erect the necessary buildings and accommodation, take in operatives, and perform all other acts necessary to the exercise of the rights conferred upon him by his patent, subject to due compliance with the laws, statutes, and police regulations of the country. He may cede his patent to others in the legally prescribed manner, or may admit others to a partnership in the rights taken as a whole conferred by it; but no division of a patent with respect to the right taken separately, or to the places where the privilege is exercised is allowed. A patent will be revoked (1) if facts transpire, subsequently to its issue, which, if known at

the time, would have constituted a disqualification; (2) or if the applicant has concealed or misrepresented any important part of the invention essential to its perfection; (3) or if the patentee has failed to put the invention into execution or to notify the same to the Minister of the Interior within the space of three years; or in the case of patents for shorter terms than six years, within the half of the term; or in the case of an invention already patented abroad, within the space of one year from the date of issue of the patent. (4) In the case of patents granted for inventions patented abroad, upon expiration of the foreign term. (5) In case of the execution having been abandoned for more than two years. (6) By resignation or failure to make use of the patent. (7) By omission to notify change of proprietorship to the Ministry of the Interior within the prescribed time.

Belgium.

PATENTS for inventions are granted without previous examination either of the novelty or of the merit of the invention, and at the risk and peril of the inventor.

The tax on patents is 10 fr. for the first year, and 20 fr. for the second, with a yearly increase of 10 fr.

The government only interferes in questions of annulment of patent, first, for default of payment of the annuity tax within the time prescribed; and, secondly, in the event of the invention not being worked.

In the case of a patent of invention, the period is twenty years; but the time for which a patent of importation is granted must not exceed the period which the original patent has still to run in the countries where it was first delivered.

Three kinds of patents may be granted:—A patent of invention, of importation, and of improvement. A patent of invention is granted to the inventor who takes out his

Belgian patent before obtaining letters patent in any other country. In that case he is entitled to protection for twenty years.

A patent of importation is granted to an inventor who, previously to lodging his demand in Belgium, has applied for letters patent in any other country. The patent of importation is limited to the term for which the previous foreign patent is granted, and expires with it.

Patents of importation may be taken out in the name of the inventor or his assign duly appointed. A simple power from the inventor authorising a party to take out a Belgian patent in his own name suffices for the purpose, the power being stamped and registered.

A patent of improvement may be obtained by a patentee for an improvement on, or addition to, his previous invention. The patent of improvement must be for improvement of the same nature as the original invention, otherwise it would not be held to be legally valid. No tax is required for a patent of improvement which forms part of the original patent, and expires with it.

In applying for a patent, the inventor or his attorney, having paid the first year's tax, presents himself at the office of the Provisional Government, where he lodges the receipt for the tax, and a petition to the Minister of the Interior, praying that letters patent may be granted to him, and also a sealed packet, containing two copies of the specification and drawings illustrating the invention. The specification may be in any form, and written either in French or Flemish; the drawings may be made on paper of any size.

All transfers of patents are subject to a registration tax, fixed by the law at 10 fr., but in practice a few francs more are charged for additionals; and the deed of transfer has to be stamped according to the size of the paper upon which the deed is drawn up. The transfer is then notified to the Minister of the Interior, who has it recorded in the Patent Office.

The government is now obliged to call the attention of the

inventor to the fact that the annual tax is due, by a registered letter to that effect.

All patentees must work their invention, or cause it to be worked, within a year of its having been worked in any other country.

The government alone has power to decide what is to be understood by the working of an invention, and to judge in each case whether the requirements of the law have been complied with.

It appears that it is not considered sufficient to import the patented articles from abroad and put them on sale in one or more shops or warehouses, even if large numbers were sold in the country by this means. It is not even considered sufficient to have a certain number of the patented articles made and sold in Belgium, the same articles being imported also from abroad and sold in Belgium.

The government may grant an extension of the term for working a patent. Practically this seeming act of condescension is valueless; for to obtain such an extension of time the inventor is required to state in his petition the day on which he should have his invention at work, in order to comply with the law—*i. e.*, one year from the date of its having been worked in any other country; which date it is often extremely difficult to be proved against the patentee, unless he himself gives it, as in the case under consideration. The inventor's petition is then referred to the different Chambers of Commerce, and they would not hesitate, in some cases, to give their opinion unfavourably to the patentee, should the invention be valuable, and likely to be of advantage to their fellow-countrymen.

The courts may annul a patent if the invention should have been worked commercially in the kingdom by a third party before the demand of the patent.

The intentional omission of part of the inventor's secret, or an erroneous specification given intentionally, also invalidates a patent.

If the complete specification and exa · drawings should

have been printed and published previously to the demand of the Belgian patent, unless such publication should have been prescribed by law.

A foreign patentee, though his foreign patent may be several years old, may, should his invention not come under any of the stipulations of Article 24, take out a valid Belgian patent, and his Belgian patent will have priority over any patents for the same invention taken out by others between the date of his foreign patent and that of his Belgian patent of importation.

Brazil.

THE law secures to a discoverer or inventor of a useful industry the property and exclusive use of his discovery or invention.

Whosoever improves an invention or discovery has, in such improvement, the right of discoverer or inventor.

To the introducer of a foreign industry a premium will be given in proportion to its utility and the difficulty of introducing it.

The right of a discoverer or inventor will be confirmed by a patent, conceded gratuitously, on payment only of the stamp and costs.

(1.) It must be shown in writing that the invention in question is his own invention.

(2.) He must deposit in the public archives an exact specification of the means and processes to be followed, with plans, drawings, and models explanatory thereof, if possible, to do so.

Patents will be granted according to the species of discovery or invention for periods of from five to twenty years, a longer term being concedable by law.

The proprietor of a patent can dispose of it by using it himself or ceding it.

In the event of two or more persons obtaining by similar

processes a certain result, and applying simultaneously for a patent, it shall be given to all.

The patent expires if it can be proved that the recipient has committed any fraud, or has concealed anything in the declaration. If any one can prove to the declared inventor that the invention is his own. If the recipient does not put in practice the invention two years after the concession. If the discoverer obtains for the same invention a patent in a foreign country. In this case, according to Article 3, he has a right to a premium. If the article produced is found injurious to the public or contrary to law. The right of patent ceases if the recipients, before obtaining the concession, have made use of such invention, patent, or discovery.

The applicant for letters patent addresses a petition to the Crown, asking for a patent or privilege, and transmitting full explanations or models according to law. This is referred by the Minister of Agriculture to the Auxiliary Society of National Industry. They report on the utility of the inventive process or invention. It is then submitted to the law officers, who endeavour to decide as to its originality and as to its non-interference with anterior rights. Should it not be of a nature also to require reference to the Sanitary Board, or other similar technical authorities, it is then discussed and reported on by the Council of State.

Should it not be necessary to refer it to the legislative body, whose authority must be obtained to insure any remittance of Customs dues for the articles proposed to be imported, or any similar sacrifice of public resources or funds, it is then returned to the Minister of Agriculture, and the privilege granted or refused.

The actual legitimate official expenses involved by the ps, documents, &c., varies between £9 and £14, the patent granted gratuitously.

DENMARK.

INVENTORS are protected by Royal letters patent granted through the Ministry of the Interior, in accordance with rules prescribed by the traditional practice of that department. The applicant must address the Ministry, accompanying his demand by detailed specifications and drawings. These papers are forwarded to the Polytechnic school to be reported upon by the director, who states whether a patent should be granted and what he thinks should be the term. The Ministry always adopt the director's conclusion. The patents usually run for three, four or five years. Important inventions are protected for ten years and in some cases for fifteen years.

Patents are never granted to foreigners for more than five years. The fee charged at the Ministry is 17 dollars (£1 17s. 6d.) The time occupied in the correspondence is about two months. The patent is forfeited if it is shown that a similar invention has been used in Denmark before, or if the patentee does not carry out his invention within the year and continue to employ it.

FRANCE.

EVERY new discovery or invention in all departments of industry confers upon its author, under the conditions and for the time hereafter mentioned, the exclusive rights of working for his own profit the said discovery or invention.

The following are considered as new inventions or discoveries:

The invention of a new industrial product.

The invention of new means, or the new application of known means, for obtaining an industrial result or product.

Pharmaceutical compositions or remedies of all kinds; being subject to certain special laws; and schemes and combinations referring to credit and finances, cannot be patented.

The duration of patents is five, ten, or fifteen years. Every

patent is subject to the following tax: 500 francs for a patent of five years, 1,000 for a patent of ten years, and 1,500 francs for a patent of fifteen years. This tax has to be paid by yearly instalments of 100 francs, under penalty of forfeiture if the patentee allows one year to elapse without paying the tax. The inventor must deposit under a sealed cover at the office of the secretary of the Prefecture in the department in which he resides, or in any other department on choosing a residence there: 1st. His petition to the Minister of Agriculture and Commerce. 2nd. A specification of the discovery, invention, or application forming the subject of the petition. 3rd. The drawings or specimens necessary for the comprehension of the specification; and 4th. A memorandum of a document deposited. The demand must be limited to a single principal object, with the details that constitute it, and the application which shall be indicated. It must mention the duration of the term required and must contain neither restrictions, conditions nor reservations; and must set forth a title containing a compendious and precise designation of the object of the invention.

The specification must not be in a foreign language, and a duplicate must be added to the petition. All documents must be signed by the applicant or his agent.

No deposit can be received except on the production of a receipt proving the payment of a sum of 100 francs on account of the tax of the patent.

The duration of the patent begins from the day of the deposit being made.

The letters patent are delivered according to the order in which the petitions are received, without previous examination, at the applicant's own risk, and without guarantee as to either the reality, novelty or merit of the invention, or the accuracy or exactness of the specification.

The duration of patents can only be extended by a special law.

The patentee or his assigns during the whole term of the patent may make alterations, improvements or additions to the invention; by complying on deposit of the petition with the

formalities above described, a certificate is granted which expires with the original patent.

Every application for a certificate of addition is subject to a tax of 20 francs.

A patentee, who, for an alteration, improvement, or addition wishes to take a principal patent of five, ten, or fifteen years, instead of a certificate of addition expiring with the original patent, must comply with the same formalities as on an original patent and must pay the same tax. None but the patentee or his assigns acting as above mentioned can during one year legally obtain a patent for an alteration, improvement or addition to the invention which formed the subject of the patent; but any person who wishes to obtain a patent for an alteration, addition or improvement on an existing patent may during the year make an application which must be transmitted to and remain under seal at the Ministry of Agriculture and Commerce; at the expiration of the year the seal will be broken and the patent delivered. The patentee will however have the preference for all alterations, improvements, and additions for which he has demanded a certificate during the year.

Whoever has taken a patent for a discovery, invention, or application connected with the subject of another patent has no right to work the invention already patented, and the original patentee cannot work the invention which forms the subject of the new patent. A patentee may transfer the whole or part of the proprietorship of his patent, by a notarial deed, and after the payment of so much of the tax then due.

No transfer is valid as regards a third party until registered. The licencees of a patent, and those who may have acquired from the patentee or his assigns the power to work the discovery or invention, have the full benefit of the certificates of addition and *vice versâ*.

All specifications, drawings, specimens and models of patents remain, until the expiration of the term, deposited at the Ministry of Agriculture and Commerce, where they may be inspected free of charge by every applicant.

Foreigners may obtain patents in France on complying with the requisite formalities, and the author of an invention or discovery already patented abroad may obtain a patent, but the duration of this patent must not exceed that of the patent previously obtained abroad.

Patents become null and void, 1st. When the discovery, invention or application is not new. 2nd. When not patentable. 3rd. Whenever they refer to theoretical or merely scientific principles, methods, systems, discoveries, and conceptions, the industrial application of which are not indicated. 4th. Whenever the discovery, invention, or application is known to be contrary to public order or safety, to morals, or to the existing laws of the country. 5th. Whenever the title under which the patent has been demanded indicates fraudulently another object than the real object of the invention. 6th. Whenever the specification accompanying the patent is not sufficient for working the invention, or whenever it does not completely or fairly point out the real means employed by the inventor. Any discovery, invention, or application—to which in France or abroad, and before the date of the deposit of the petition, sufficient publicity has been given to enable the same to be worked—will not be considered as new.

The patentee forfeits his rights, 1st. If he has not paid his annuity before the beginning of each year of the term of his patent. 2nd. If he has not worked his discovery or invention in France within the term of two years from the date of the signature of his patent, or has ceased to work it during two consecutive years, unless in one or the other case, he justifies himself as to the causes of his inaction. 3rd. If he has introduced into France objects manufactured abroad and similar to those which are protected by his patent.

HANOVER.

ANY person making a new invention in industry, may be invested for a certain time with the right of applying it exclusively under certain conditions mentioned hereafter.

A patent may also be delivered to any person importing an invention from foreign countries, unless such invention be already known to the public, and a legalised copy of the foreign patent must be produced.

A patent may also be delivered to any person who shall add an essential improvement to an invention already patented in the kingdom.

Such a patent, however, will not be allowed to interfere with the rights of the original inventor.

The petitioner for a patent must deliver a precise, correct, and complete description of the object to be patented, together with the required drawings or models, and if possible, a pattern of the product, and the petition must set forth the peculiar claims as to novelty.

The petition is to be addressed to the Minister of the Home Department, who will submit the invention to an examination of competent judges as to its novelty and peculiarity, and to decide accordingly.

Foreigners will not be allowed to obtain patents except for inventions intended to be carried out within the kingdom.

A patent will not be granted for a longer term than ten years.

In the case of a patent being granted originally for a shorter period, its duration may, if thought proper, be extended to that term. Such a prolongation, however, must be published at least one year before the expiration of the term originally fixed.

Patents of importation are not allowed to endure beyond the term of the foreign patent.

The patent right must be limited to the object designated by the characteristic features, as laid down in the specification.

A patent may be transferred or made over to others by legacy.

The patent will be cancelled, if it can be shown that the invention is not new; and particularly if, at the time of the granting of the patent, it had already been openly put into practice, or had gained such publicity as to allow of its imita-

tion; or if it be shown that the invention has been wrongly or incompletely described; or if it be proved by some other person that the invention was made or originally imported by him, and that the patentee had illegally appropriated the same.

Finally, if the invention shall not, without sufficient reason, be put into practice in the kingdom within six months from the granting of the patent, or whenever the working of the said invention has been interrupted during six months.

ITALY.

LETTERS patent may be granted for new inventions or discoveries in industry as (1) An industrial product or result; (2) An instrument, machine, tool, engine, or any mechanical apparatus; (3) A process or mode of manufacture; (4) A motion or the application of any known power to industrial purposes; (5) The technical application of a scientific principle provided immediate results in industry are obtained thereby. In the latter case the patent is limited solely to those results expressly pointed out by the inventor.

An invention or discovery in industry is considered as new when not before known, or when even a general notion of it existed without the particulars necessary for its adoption. A patent may be granted for an invention patented abroad, during the continuance of the foreign term and if not known in the kingdom.

Modifications of inventions or discoveries in industry which are already protected by letters patent, may be patented without prejudice to the patent for the original invention.

Inventions or discoveries relating to trades which are contrary to law, morals, or public safety; or not relating to the manufacture of material objects; or of a mere theoretical nature; and all kinds of medicine, may not be patented.

Letters patent do not guarantee the utility or reality of the invention or discovery as claimed by the petitioner, nor do they

prove the existence of those properties which, according to law, an invention or discovery must possess in order to render the patent valid.

Patentees or their assigns may obtain a certificate of addition for any modification made by them in their original discovery or invention. The certificate extends the effect of the original patent to all such modifications from the date of application, and for the whole duration of the latter.

Letters patent take effect with respect to third parties from the date of application.

The duration of a patent can never exceed fifteen years, nor be less than one year.

Patents granted for less than fifteen years may be prolonged for one or more years, so long as the whole term does not exceed fifteen years.

All patents are subject to a proportional and annual tax; the proportional tax consists of a sum of as many ten lire as there are years in the duration of the patent; the annual tax is 40 lire for the first 3 years, 70 lire for the subsequent 3 years, 90 lire for the 7th, 8th, and 9th years, 115 lire for the 10th, 11th, and 12th years, and 140 lire for the remaining 3 years.

The first annuity and the proportional tax must be paid previous to the application for a patent. The other annuities must be paid in advance, *i. e.* on the first day of each year of the duration of the patent, and are also subject to the triennial increase, even in the case of a prolongation of the patent.

The delivery of a certificate of addition is subject only to the payment in advance of 20 lire.

Certificates of prolongation are subject to the payment of 40 lire, besides the proportional tax and annuities; the annuity corresponding to the first year of the prolongation must be paid at the time of application, and the subsequent annuities in advance.

An application for letters patent must be made to the Minister of Agriculture, Industry and Commerce, and must contain (1) the name and surname, birthplace and residence of the

inventor, or his representative; (2) the title of the invention, describing its precise features and object; (3) a statement of the duration of the term required.

One certificate only will be granted for an application, and one certificate only for a single invention. The application must be accompanied by a specification,—which must be in Italian or French,—drawings (if necessary), and the receipt for the tax. In cases of patents for importation, the original foreign patent, or a certified copy, and a power of attorney, must be sent; and in all cases a memorandum of documents and objects delivered is required.

During the first six months of the duration of a patent, any portion of it may be disclaimed on the payment of 40 lire.

Patents will be refused if there is no written application, or if in the application made the title of the invention or discovery has not been mentioned; if the specification is absent; if a single patent is demanded for different inventions or discoveries; or if several patents of the same nature or of different kinds are demanded in the same application; or if the fees do not correspond with the kind of patent asked for.

Assignments of patents must be registered, and are not valid with respect to other parties before the date of registration.

Patents cease to be valid (1) in cases of non-payment, even in a single instance of the annual tax within three months from the date of their expiration; (2) whenever an invention or discovery, patented for not more than five years, has not been worked within the first year of the grant of the patent, or whenever the patentee shall have discontinued working it during a whole year; (3) whenever a patent granted for more than five years has not been worked before the expiration of the second year, or whenever its working has been discontinued for two years. The patentee does not in any of these cases forfeit his rights, if the inaction is attributable to causes beyond his control. The want of pecuniary means is not included in these causes.

Mexico.

INVENTORS must deliver to the Government, or to the magistrate of the place where they wish to execute their project, or to the magistrate of their residence, or to the governor of the state or territory to which that place belongs, the precise description, together with the drawings, models, and all they think to be required for explaining the object in view, all signed by their own hand, when the authorities will deliver to them a certificate. The patent is granted by the Governor.

In case the application has not been made directly to the government of the state, the local authorities are to forward such application, with all the documents, to the Governor, who, after making an entry of the same, is to forward them by the earliest mail to the Minister of the Interior, in case applicants should not do so by themselves.

In granting a patent, the Government does not examine the inventions or improvements as to their utility, but merely as to whether they are contrary to public safety, morality, laws, or regulations; and if not, the grant of protection cannot be refused to applicants.

Patents for inventions remain in vigour during ten years, and those for improvements during six years, to begin from the date of working the patent at any place of the republic.

Inventions or improvements are supposed to be worked from the day on which the patent has been delivered.

If inventors, or those who improve inventions, should wish to have their privilege limited to one state only, the patent is to be granted by the authorities of the said state.

Parties obtaining a patent for an invention or an improvement which has already been worked without a patent by another party, forfeit their privilege, although they declare to be the owners of the invention or improvement.

If the invention or improvement is of such a nature as to admit of its being kept secret, and if a patent has been ob-

tained for the same, the invention or improvement must be thrown open to the public at the expiration of the term.

Patents of improvements will remain inherent to those of the original invention, without prejudice to the arrangement both parties may come to.

If inventors, or those who improve inventions, should wish to have their privilege extended, they must apply to the Government, which is to make a report on purpose to the congress.

The patent fees vary between 10 and 300 dollars (pesos).

Importers of any branch of industry may obtain patents.

POLAND.

PATENTS for all kinds of inventions, discoveries, or improvements, as well as for importations, are granted in the kingdom of Poland.

Patents for inventions, discoveries, or improvements are granted for three, five, or ten years. Patents for importations can only be granted for the term obtained abroad.

Patents of invention are delivered on a mere application without previous examination, and consequently do not guarantee the merit, priority, or quality of the invention.

The right of working and manufacturing the patent article belongs, during the whole term of the patent, to the patentee or his assigns, except in the cases hereafter mentioned. However, if during that time other parties should take out a patent for an improvement in any part of the same invention, they acquire thereby the right of manufacturing that part only.

The taxes on patents are—

150	florins	for 3	years.
250	„	5	„
500	„	10	„

and must be paid in advance.

All applications for patents must be made to the authorities

of the respective Governments, and at Warsaw to the Municipal Board, by fulfilling the following formalities :—

1. A declaration as to whether the article about to be patented is an original invention or an importation.

2. A complete specification (for the Board of Home Affairs and Public Instruction) of the principles, means, and processes that constitute the invention or improvement, as well as the required plans, sections, drawings, and models.

3. The specification must be clear and precise, so as to enable all manufacturers to use the invention at the expiration of the patent.

4. In cases of importations of inventions patented abroad, applicants must at the same time prove the article to be really patented abroad, and the foreign patent not to have expired.

5. Moreover, they must say whether they wish the description to be published in full, by extracts, or not at all.

Whenever patentees desire to transfer their patents entirely or partially to others, they, together with the assignees, must send an extract of the authentic act of transfer to the Board of Home Affairs and Public Instruction, to have it inserted in the public Register of Patents.

Patents for inventions that might be injurious to society, that relate to the common wants of life, or for objects that have already been manufactured in the country, will not be granted.

Patents are annulled—

1. (*a*) If inventors have not delivered an exact description, and indicated with clearness and precision the means of manufacturing the invention, discovery, or improvement; and if it is proved that it would be impossible to attain the object of the invention by following the published description and the information given by the inventor.

(*b*) If during the term mentioned in their letters patent inventors have not worked their invention, or if they cannot show good cause for such inaction.

2. By a judgment of decree of tribunals :—

(c) Whenever it is proved that the invention does not properly belong to the patentee; and also whenever it is proved that the same invention, discovery, or improvement has been known and published before the patent was applied for.

PORTUGAL.

PATENTS are granted for a term of years not exceeding fifteen to the inventor or discoverer, to enjoy during that time the right of property.

From the right of property to an invention is derived the exclusive right of producing or manufacturing the articles which constitute the said invention. Persons making additions to their inventions enjoy the advantage of the additional improvements, and they may apply for a French patent.

The publication of patents, their drawings, models, and specifications, which are required for obtaining the concession, must be shown gratuitously to every one who desires to see them. Applicants, by payment, can procure copies. On the Government devolves the duty to announce officially what patents have fallen into the dominion of the public.

The right of property conferred by a patent is transmissible by will to heirs and successors.

A register of all patents is kept in the Department of Public Works.

A tax of 120,000 reis is exacted on granting a patent for fifteen years, equivalent to about £26 sterling; of this amount 75,000 reis, or £18 12s., is set apart for a fund for the advancement of industry; the remaining sum is absorbed in stamps and fees paid to Government.

Medicines, articles of food, simple changes in the form of an object patented, and ornaments are excluded from obtaining patents.

The civil governor of the district is charged with the duty of granting patents, on whom devolves the duty also of for-

warding to the Office of Public Works information for their due registration.

An invention which involves danger to public safety is prohibited from obtaining a patent.

A foreigner can only obtain a patent subject to the rules laid down by the Civil Code of Portugal, and that also only for the period of time before it falls under the dominion of the public, in conformity with these rules.

No concession of patent for an improvement of an article already patented is granted, except to the patentee himself, during the first year after the patent is granted; application by another person may be made before the expiration of the year to the proper department, where such application will be taken into consideration.

This provision is to ensure to the first applicant the preference over other persons, with the exception of the original patentee, who always has the preference accorded to him, provided his application is also made during the first year.

PRUSSIA.

PATENTS can be obtained both for discoveries and for improvements, and also for the introduction into Prussia of inventions patented abroad.

New goods, new machines, new tools, and new modes of fabrication can be patented, but only on the condition that they are useful to industry and manufacture, and afford new means of industrial development.

Articles of invention patented abroad may also be patented in Prussia, provided, however, that no description of them shall have been published either here or elsewhere, and that no use shall have yet been made of the invention in Prussia.

When once the details of an invention have been published, either in Germany or elsewhere, officially or unofficially, before the application for the Prussian patent has been made in Berlin, it is invariably refused.

An article which is patented abroad may, if it fulfils the necessary requirements, be patented in Prussia by anybody. No rights whatever are reserved to the original patentee, except in the case of patents taken out in other German countries.

Under the agreement concluded between the Zollverein States in 1842, when a patent has been given for an invention in any one of those States, it secures to the patentee the sole right of applying for a patent for the same article in all the other States of the Confederation, but it does not necessarily follow from this that the Prussian authorities will give patents in every case where other German Governments have done so.

In Saxony, Bavaria and Würtemberg, for instance, patents are much more easily obtained than they are in Prussia.

Patents are granted only to natives, or to the subjects of such countries as by treaty are entitled to most-favoured-nation treatment.

The application for a patent is made direct to the Minister of Commerce in Berlin, and must be accompanied by full descriptions, and, if necessary, also by models. These are, however, kept secret from everybody except from the persons whose special duty it is to examine and report upon them.

The applications are registered immediately on receipt at the Ministry, and take their precedence accordingly.

Under the Ministry of Commerce is a special department called the Technical Deputation for Industrial Matters, to whom all these applications are referred. It is their duty to examine the models, descriptions, &c., to see whether patents for similar or kindred inventions have been already given, and to ask for any further explanations which they may require. They then decide absolutely and without appeal whether they will grant the patent or not. They fix the length of time for which the patent is to hold good, and have moreover the right of declaring whether they will give a patent for the whole invention or only for some portion of it.

Their verdict is communicated to the person who has applied for the patent, and he is allowed a period of six weeks to decide whether he accepts or not the conditions proposed by the deputation.

If he agrees to accept them, the patent is then issued under the signature of the Minister of Commerce.

The following conditions are invariably imposed in the case of every patent which is granted:—

1. The patentee must give practical effect to his invention in Prussia within the time fixed by the Minister (usually six months, never more than a year), on pain of forfeiting his patent, and he must produce before the end of that term an official certificate from the local police, or at least from some Government employé, that his invention is, or has been, actually at work within the Prussian dominions.

2. If at any time during the period for which the patent is granted, his invention shall have been unemployed during twelve consecutive months, the patentee shall forfeit all his rights.

3. The patent shall equally be forfeited if, at any time afterwards, it can be proved that the invention was neither new nor original.

The period for which a patent is to run is laid down, specially for each case, in the rescript of the Minister of Commerce. The law is that it shall not be less than six months, nor more than fifteen years; but it is now usually fixed at three years.

A patent which is near expiring may in some cases be renewed, but the entire period for which it can last must never exceed fifteen years. Such prolongations, however, have lately been more difficult to obtain than they were formerly.

Unless in cases where the applicant himself demands a special exception, patents extend to the whole kingdom of Prussia.

The expenses of taking out a patent in Prussia are almost nominal.

The application for a patent must be written on stamped paper of 5 sgr. (6*d.*) The answer of the Technical Deputation is given on stamped paper of 15 sgr. (1*s.* 6*d.*), and the patent itself, if granted, is liable to a stamp duty of 1 th. (3*s.*) There is no further tax or duty whatever.

A patent in Prussia gives to the patentee the exclusive right of working his invention, that is to say, the sole right of making the article in question; and also, in the case of machinery, the sole right of employing it when made. It does not give the right of prohibiting the sale or importation of articles which are like the article for which the patent has been obtained.

RUSSIA.

PATENTS may be obtained for all kinds of discoveries, inventions, and improvements of general utility or a process of carrying on any art, trade, and manufacture.

Patents are granted without being guaranteed by the Government.

The law admits of patents for inventions that are privileged abroad.

Patents for inventions that are already known, but not privileged abroad, are granted only in case of exclusive utility, taking into consideration the expenses required for introducing them.

By the 152nd article of the Russian Code of Laws, vol. xi., relating to manufacturing industry, persons obtaining patents are bound to bring the patented inventions, &c. into operation in Russia before the expiration of the fourth part of the time granted by the patent, and a notification of the fact of the invention being carried out must be made to the Department of Interior Trade and Manufactures in the course of the six months following, and the exact locality stated where the invention is being carried out, otherwise the patent becomes public property. The declaration of the carrying out of the invention must be certified by the proper local administration.

The Department of Trade and Manufactures, on receipt of an application for a patent, accompanied by documents, delivers at once to the applicant a certificate of acknowledgment for such documents.

In cases in which a patent is not granted, the applicant is reimbursed the amount of the tax fixed for the patent, less the charges incurred on account of stamps, postage, and advertisements in the public newspapers.

Any patentee who may change his own invention by making an improvement in it, may take out another patent for such alteration by paying a new tax; but in every case a notification, together with a special description of the improvement must be made to the proper Department on the subject.

Any person making an improvement on an invention already patented can only obtain a special patent for such improvement after having come to terms with the holder of the original patent.

Formalities.—The petitioner must present to the Department of Interior Trade and Manufactures:—

(1) A petition stating the time for which the patent is desired, and the subject to which the invention refers. If the invention has been patented abroad the date on which a patent was granted for it must be stated, as well as the number of years for which it has been granted, or for which a prolongation of it is intended; it must likewise be stated whether the patent has been granted in a country in which the payment of the tax is made annually, as is the case, for instance, in Belgium.

(2) An exact description of the object for which the petitioner wishes to obtain the privilege or patent, specifying all the principal details, advantages, and the way of employing it, with the plans and drawings respecting it. If, for a clearer explanation, it should be necessary to add to the description a model, the petitioner is bound to forward it.

A translation of the description must be furnished in the Russian language.

(3) A receipt certifying the payment of the duties, according to a fixed rate.

Duration.—The duration of a patent is reckoned from the day on which the patent is signed.

Patents for inventions belonging to the applicant are granted for three, five, or ten years—the longest term.

Patents for the introduction of foreign inventions cannot exceed the term of the privilege granted abroad to the inventor; at all events, cannot exceed six years, unless the petitioner be the inventor himself, in which case he may obtain a patent for a term of ten years.

Taxe.—The duties for discoveries, inventions, and improvements belonging to the applicant for the patent are:—

For 3 years	.	.	.	90 roubles	= £12.
„ 5 „	.	.	.	150 „	20.
„ 10 „	.	.	.	450 „	60.

For the introduction of foreign inventions:—

For 1 year	.	.	.	60 roubles	= £8.
„ 2 years	.	.	.	120 „	16.
„ 3 „	.	.	.	180 „	24.
„ 4 „	.	.	.	240 „	32.
„ 5 „	.	.	.	300 „	40.
„ 6 „	.	.	.	360 „	48.

Transfer of Patents.—The patentee may transfer the patent to another person, wholly or partly, or be in partnership with some one else; but the law prohibits either to cede it to any company of shareholders, or be in partnership with it, without being specially authorised by the Government.

Loss of Right.—The causes of forfeiture are:—

(1) If the invention has not been fully carried out before the expiration of the fourth part of the time granted by the patent.

(2) The want of novelty.

(3) Proof that the patentee falsely gave out the invention or discovery for his own, and if the real inventor claims it.

(4) The deficiency of the specification, or a dissimulation

of the essential parts, indispensable for procuring the declared result.

(The expiration of patents is published in the newspapers.)

Infringement.—The patentee has a right to prosecute counterfeiters, and to claim damages in respect of the infringement of the patent.

SPAIN.

LETTERS patent for original inventions are delivered for five, ten, or fifteen years, at the option of the inventor. Letters patent for inventions imported from abroad (patents of importation) are only granted for five years, and available only for the working of the invention within the kingdom; such patentees therefore cannot import their patent article from abroad ready made, unless by submitting to the common duties on foreign articles.

Patents granted for five years may be extended to five years more, if there exist good reason for so doing; those granted for ten or fifteen years cannot be prolonged.

Patents of invention may be taken for objects which have not been worked in Spain or foreign countries, and objects worked abroad but not in Spain are patentable as importations. However, those objects of which models or descriptions in the Spanish language exist at the Royal Conservatory of Arts, cannot be patented unless three years have elapsed since their importation without their being put into practice, in which case letters patent of importation for five years only can be granted.

Royal letters patent may be solicited by the applicants themselves, or their attorney, by means of a memorial, addressed to the governor of the province where they reside, or at Madrid, if convenient.

The memorial must be accompanied with,—

1. A petition on stamped paper, mentioning the object of the patent, whether an original or imported invention, and its duration according. Each application must not contain more than one object.

2. A plan or model, with the description and explanation of the object concerning the mechanism or process represented as not being used at that time, all with the greatest correctness and clearness, so that there never could arise any doubt about the object or its particular nature, which applicants represent as not having been worked in that form, since the patent bears on that point only.

Models must be delivered in a closed and sealed case, and plans, descriptions, and explanations, in a sealed cover.

At the delivery of letters patent a proper receipt of the prepayment of the following taxes to the Conservatory of Arts must be produced, viz.:—

For a privilege of 5 years	.	.	1000 reis.
Do. 10 „	.	.	3000 „
Do. 15 „	.	.	6000 „
For a privilege of importation of five years			3000 „

Besides, 80 reis are to be paid for the delivery of the letters patent themselves.

Patents may be transferred, presented, sold, exchanged, and bequeathed by last will, like any common private property.

All transfers must be made in writing, and express whether the patent is transferred for the whole kingdom or for one or more provinces, or for certain places only; moreover, whether the renunciation is made absolutely or with certain reserves, whether it was made with the right of transferring the patent to others or no, and whether the owner prefers to see it transferred to one or more persons.

Assignees shall be bound to produce the written assignment before the Governor where the application for the patent was made, and the latter, after taking cognizance thereof, shall deliver it to the Council of the Exchequer, who shall inform thereof the Director of the Conservatory of Arts for his registering the same, according to Art. 14. Assignments not presented within thirty days of their date are null and void.

The duration of a patent commences from its date.

Patents become null and void in the following cases:—

1. At the expiration of the legal term.

2. If patentees do not apply for their patents within three months of their first application.

3. If patentees have not put their inventions into practice themselves or by others within one year and one day.

4. If patentees give up their invention by interrupting their works during one year and one day.

5. If the invention is proved to be worked already somewhere in the kingdom, or published in a book or by prints, models, plans, or descriptions existing at the Royal Conservatory of Arts, or if it is worked in another country whilst it is represented by the patentee as new and original.

United States of America.

PATENTS may be granted for any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter not known or used before the application.

The inventor must make an application in writing to the Commissioners of Patents. The form is not material, provided it sets forth the facts to which the applicant is required to make oath, which are that he verily believes himself to be the original and first inventor, that he does not know or believe that the same was ever before known or used, and also of what country he is a citizen.

The taxes are as follows:—On the application for a patent, 15 dollars; on the issue, 20 dollars. The inventor may disclaim any portion of the invention that is not new. Any addition or improvement requires a new patent. If the specification is defective or insufficient, the patent may be surrendered, and re-issued for the residue of the term.

All patents are granted for seventeen years, and no extension is allowed. The term of a patent which has been

patented abroad expires with the term of the foreign patent.

Letters patent are void if the patentee claims what he knows to be useless, or if he withholds any part of his knowledge from the public, or if there has been any previous use of the invention.

Drawings and written references, where the nature of the case admits of drawings, must accompany the specification, which must be in such full, clear and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it appertains to make, construct, compound and use the same. The part, improvement, or combination which the patentee claims as his own invention must be particularly specified and pointed out.

Every patent is assignable, either as to the whole interest or any undivided part thereof. The assignment, and also every grant and conveyance of the exclusive right, under any patent, to make and use, and to grant to others to make and use the thing patented, must be recorded in the Patent Office within three months of the execution thereof.

All applications for patents must be completed and prepared for examination within two years after the filing of the petition, and in default thereof will be regarded as abandoned.

WÜRTEMBERG.

PATENTS in Würtemberg are divided into patents for invention ,and patents for introduction. The latter, however, have reference solely to foreign patents introduced into Würtemberg. A patent for invention taken out in the kingdom includes and carries with it a patent also for introduction. All that is necessary to obtain the latter in the case of a foreigner or native is the production of a certified copy of the foreign patent, together with the written consent of the patentee to its introduction. Every petition for a patent, accompanied by a specification in writing, sealed or open, as

the applicant may prefer, must be delivered at the district Government Office of the locality where the petitioner resides, and is immediately forwarded to the Central Board of Trade and Commerce at Stuttgart, which is a Department of the Ministry of the Interior. The petition is then referred for examination to a Commission *ad hoc*, whose business it is to examine the specification, and report whether it is "useful and new."

No patent can be granted for a longer term than ten years, but the average period of grants is for five, or even less. The patentee, however, can always obtain an extension of the term up to ten years. No fees are payable for the mere grant of a patent, but the patentee has to pay an annual tax, ranging from 5 fl. (8*s.* 6*d.*) to 20 fl. (£1 13*s.* 4*d.*), until the patent expires or is void. A foreigner patenting an invention in Würtemberg is obliged to find some native of the country to stand security for the annual payment of the patent-tax.

An annual tax of from 5 to 20 florins is payable for a patent dur ıg the period for which it is in force; the first payment is to be made when the patent is issued, and it is to be repeated at the commencement of each year of the period. When a patent ceases to be valid before the expiration of the term for which it was granted, the patentee is released from the payment of the tax for the year which has not yet fallen due.

Foreigners applying for patents must furnish the authority to which they deliver their application with a reference to some native of Würtemberg, who will be responsible for the payment of the patent-tax.

A patentee who has concealed or who has incorrectly described an essential part of his invention, with a view to keeping his process a secret, after the lapse of the term for which the patent was granted, renders himself liable to the penalty for fraud; and if the process in question was injurious to the public, to the additional penalty incurred thereby.

ZOLLVEREIN.

EVERY State belonging to the Zollverein possesses the power of granting, by letters patent, a privilege conveying to an individual or individuals specified therein the sole right to make, use, or dispose of some new inventions or discovery for a certain fixed period.

This power, however, has been limited and defined by certain regulations agreed upon at Stuttgart in 1841, between the Zollverein States. The object having been, on the one hand, to remove as far as possible all obstacles to the freedom of trade within the Zollverein States arising from patents or privileges, and, on the other, to establish uniformity in all essential points.

Patents may be granted for those things only which are really novel and peculiar. A patent, consequently, cannot be granted for inventions which have been already practised, have been vendible, or in any way known within the Zollverein previous to the grant of the patent; especially inventions already described in native or foreign works, by drawings or otherwise, in such a way that they can be practised by any competent person.

Each Government is to be the judge whether any invention, for which a patent is demanded, is really novel or peculiar.

No patent shall be granted in one Zollverein State for an invention by a German subject who has obtained a patent for the same in another German State, except to the inventor himself or his legal successor.

A patent may nevertheless be granted for an improvement to an old invention, if the improvement constitutes something novel and peculiar; but the patent must be confined to the addition or improvement, and not injure the patent granted for the original thing.

The grant of a patent does not establish the right to prohibit or limit the importation of such articles as have to do with those for which a patent has been granted, nor the sale and disposal in trade of such articles, nor can the holder claim

in virtue of his patent the right to prohibit the use or consumption of articles of the above kind not procured by him, or obtained elsewhere with his consent, machines and implements for manufacture and industry being alone excepted, these not being general articles of commerce destined for consumption by the public at large.

On the other hand, every Zollverein Government in granting a patent may secure to the holder within their territory the right of the exclusive manufacture or practise of the invention in question, or the right to introduce—

(*a*) A new process or method of manufacture; or,

(*b*) To apply exclusively new machines or implements for manufacture, so that he is entitled to prohibit the use of the method, or the use of the machines or implements by all those who have not acquired the right to do so from him, or procured the said machines or implements from him.

In every State of the Union the subjects of other States of the Union are treated on an equality with their own subjects, both in respect to grants of patents and protection in the enjoyment of the privileges acquired by the patent.

The grant of a patent, however, in one State will never be held as a valid reason for the non-refusal of a patent for the same thing in other States. On the contrary, every State within the limits agreed upon is the judge whether a patent ought to be granted or not, without reference to what may have taken place in the matter in any other Zollverein State.

Further, the grant of a patent does not convey in itself to the subject of another State the right of independent settlement, or of carrying on the trade or business in which the article for which a patent has been granted is used; on the contrary, such right must be specially acquired according to the provisions of the constitution of each State.

A patent becomes void if the invention eventually proves to be neither novel or peculiar.

A patent granted for an invention previously known to certain individuals, but kept secret by them, remains in force, unless rendered void by other causes, except as regards those individuals.

When a patent is granted, the invention must be specified, with the name and domicile of the holder, the period of duration, and must also be notified in the Official Gazette.

Similarly, the prolongation of withdrawal of a patent before the termination of the originally fixed period must be publicly made known.

Persons applying for letters patent must send in a petition in writing to the Board of Trade. The petition must contain accurately and fully the following particulars:—

(1) Christian and surname, profession, domicile, and present residence of the applicant.

(2) Declaration and distinct statement of the nature of the invention.

(3) The distinct statement of the grounds of the petition for an exclusive right—

(*a*) To manufacture or introduce a new article; or,

(*b*) To apply new instruments for manufacture (machines or implements); or,

(*c*) To apply a new method of manufacture.

(4) The number of years for which the patent is demanded. This petition must be accompanied by an accurate description of the articles for which the patent is demanded, with drawings, models and patterns necessary for the elucidation of the same.

This description may be sent in with the petition, either open or sealed up.

If the patent is not demanded by the inventor himself, a power must be obtained from him in duly legalized form.

When the petition is for the privilege of introducing an article similar in kind to one already known, and for which a patent has already been obtained in a foreign country, such patent must be annexed in original or legalised copy.

Foreigners must send in a declaration in the form of a regular deed drawn up by a solvent Baden subject, resident in the Grand Duchy, by which the latter renders himself responsible for the payment of the costs, taxes and fees, and also for the transmission to the applicant of the ministerial decision.

By a Law of 29th July, 1864, respecting stamps, fees and taxes, in matters connected with the Civil and Police Administration, the stamp charged on petitions is fixed at 15 kr. (about 5*d.*), and the tax on letters patent from 15 to 500 fl. (£1 5*s.* to £42.)

Besides this, the cost of the examination of the petitions for patents must be reimbursed to the Treasury, generally 6 fl. (10*s.*) a day for the time spent by a technologist.

The holder of a patent can transfer the right which he acquires by the patent to others for the period of its duration, or admit others to participate in the enjoyment of the same.

On the death of a holder of a patent before its expiration, the right passes to his heirs.

Notice must be given to the Board of Trade on every change of possession taking place, and this must be inserted in the Government Gazette.

A petition for the prolongation of a patent granted for less than fifteen years must be sent into the Board of Trade some months before its expiration. A decision is then passed after due investigation.

When granted, the applicant obtains a fresh Act, and notice is given in the Government Gazette.

The same taxes and fees have to be paid as before.

COLONIAL LAW.

British Guiana.

THE Law relating to the grant of patents in British Guiana is very similar to the English law. The application for a patent is made to the governor, and must be accompanied by an affidavit and provisional specification.

In the event of any inventor being resident out of the colony, the petition, affidavit, and provisional specification may be lodged by any person acting as his agent in the colony, pro-

vided that the petition and affidavit of such inventor (or his declaration in places where a declaration is allowed by law instead of an oath) be certified. The complete specification may be deposited in the same manner.

Applications are referred to the Attorney General for examination and report.

The complete specification protects the invention for twelve months. The sum of 100 dollars stamp duty must be paid at the expiration of seven years.

The provisions as to disclaimers and extension are similar o those in force in this country.

CANADA.

ANY person being a subject of Her Majesty and residing in the province having discovered or invented any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement or any art, machine, manufacture or composition of matter, the same not being known or used in the province by others before his discovery or invention, and not being at the time of his application in public use or on sale in the province with his consent or allowance as the inventor or discoverer thereof, and desiring to obtain an exclusive property therein, may apply by petition to the governor of the province for a patent.

The governor on due proceedings being had is to grant such patent, which is available to the grantee, his heirs, lawful representatives or assigns for the period of fourteen years.

An original and true inventor is not deprived of his right to take out a patent in the province by reason of his having previously taken out a patent in a foreign country, and of the same having been published at any time within six months next preceding the filing of the specification.

The inventor before receiving his patent must make a solemn declaration that he believes that he is the true inventor or discoverer of the art, machine, or improvement for which he solicits a patent. He must deliver such a written

description in duplicate of his invention as will enable a skilled person to make or use it. Drawings, where the nature of the invention permits, or specimens of ingredients, must be delivered with the specification. He may also have to deliver a model if required.

Patent privileges extend to and include any subject of Her Majesty, being an inhabitant of the province, who in his travels in any foreign country has discovered or obtained a knowledge of, and is desirous of introducing into the provinces any new and useful invention not known and not in use in the province, except inventions discovered or used in the United States of America; or in any part of Her Majesty's dominions in Europe and America. Patents are assignable in law either as to the whole interest or any undivided part thereof by an instrument in writing, which assignment and also every licence must be recorded within two months from the execution thereof.

Patents may be issued to the assignee of the inventor, the assignment being first recorded, and the application being duly made and solemnly declared by the inventor.

In case of the death of the inventor, the right of applying for and obtaining a patent devolves on his executor or administrator in trust for the heir-at-law of the deceased, if he died intestate, or on his legal representative in any other case.

Patents may be extended for seven years.

Whenever a patent is invalid by reason of a defective specification, then, if the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the patentee may surrender such patent and obtain a new patent, to be issued to him for the same invention for the residue of the unexpired period of the original patent, in accordance with the corrected specification. The patentee may disclaim part of the invention claimed by mistake.

The specification and drawings may be amended. The date of the patent must be marked on each article offered for sale.

The fee to be paid on presenting the petition is twenty dollars.

Cape of Good Hope.

THE law of this Colony is based upon the Patent Law Amendment Act. The application must be made at the office of the Colonial Secretary, where a specification, which may be amended before the issue of the patent, is left. The application is referred to the Attorney-General, whose recommendation is followed. The term is fourteen years. Portions of the invention may be disclaimed, and the letters patent may be assigned. The following fees have to be paid:—

	£	s.	d.
On depositing specification	2	10	0
To the Attorney-General for any appointment .	2	4	6
On obtaining letters patent	2	10	0
At or before the expiration of the third year .	10	0	0
At or before the expiration of the seventh year .	20	0	0

Ceylon.

AN inventor must petition the Governor for leave to file a specification of his invention. The petition must be in writing, signed by the petitioner or his agent, and must state his name, condition, and residence, and the nature of the invention. An order may be made granting the petitioner leave to file a specification; and if within six months from the date of the order a specification is filed, letters patent will be granted for the term of fourteen years, and for such further term not exceeding fourteen years as the Governor may think fit, upon petition presented not more than one year and not less than six months before the expiration of the original term.

The specification must be in writing, signed by the petitioner, and must particularly describe and ascertain the nature of the invention, and in what manner it is to be carried out.

The petition and specification must be left with the Colo-

nial Secretary, accompanied by a declaration signed by the petitioner, similar to the declaration required in this country; and if the inventor is absent from Ceylon, by a declaration signed by his agent, to the effect that he verily believes that the declaration purporting to be the declaration of the inventor was signed by him, and that its contents are true.

No specification will be filed until all the fees required are paid.

An invention will be deemed to be new if it has not—before the time of applying for leave to file the specification—been publicly used in Ceylon.

The specification may be amended when it is defective or insufficient, provided that there is no fraud.

Where the patent has been obtained by fraud, the patentee may, upon proceedings instituted by the true inventor within two years from the date of the petition to file the specification, be compelled to assign the patent to the true inventor. Every petition for leave to file a specification, or the extension of the term of the patent, must be written or printed upon stamped paper of the value of ten pounds.

India.

THE Act of the 17th May, 1859, entitles inventors of any new manufacture to petition the Governor-General in Council for leave to file a specification thereof, and gives a form of petition, and authorises the Governor-General in Council to grant the petition; but he may previously refer it to be reported upon; and if within six months after the date of the order a specification be filed, the petitioner shall be entitled to a patent for fourteen years, and for such further term not exceeding fourteen years more, as the Governor-General in Council may direct upon petition.

The order authorising the filing of the specification may be made subject to any conditions and restrictions the Governor-General may direct.

The petition must be accompanied with a declaration by the inventor or his agent, as the case may be.

No specification can be filed until the necessary fees are paid.

A book is kept in the office of the Secretary to the Government of India, to record the petition and specification, and the order for the same, and all orders relating thereto; such book is open for inspection, and a certified copy of any entry in it may be obtained; such copy to be *primâ facie* evidence.

If from mistake or inadvertence a mis-statement has been made in the petition, or specification, or something not new or not invented by the inventor is stated, he may petition for leave to file a memorandum pointing out such error, defect, or insufficiency, and disclaiming any part of the alleged invention, or, in case of any defect or insufficiency of the specification, for leave to file an amended specification. The petition must state how the error, defect or insufficiency occurred, and that it was not fraudulently intended.

No person may have a patent if the invention is not useful, or not new, or not by the petitioner, or if the specification has defects specified, or contains wilful or fraudulent mis-statement.

The patent will be revoked if it appears that it is; or the mode in which it is exercised is; mischievous to the State, or generally prejudicial to the public; or if there has been any breach of the conditions upon which it is granted.

The importer of an invention will not be deemed to be an inventor within the meaning of the Act, unless he is the actual inventor.

A patent may be taken out by a foreign inventor.

An invention is deemed to be a new invention, if it has not, before the time of applying for leave to file the specification, been publicly used in India, or in any part of the United Kingdom of Great Britain and Ireland, or been made publicly known in any part of India or of the United Kingdom by means of a publication, either printed or written, or partly printed and part written. But public use or knowledge is of

no effect, if made in fraud or breach of confidence—unless acquiesced in; and public use by or for the inventor himself for a year prior to the date of his petition will not prevent his taking out a patent.

An inventor who has obtained an English patent may, within twelve calendar months from the date of such patent, petition for leave to file a specification of such invention; and in such a case, the invention will be deemed to be a new invention, if it was not publicly known or used in India at or before the date of the petition for such letters patent, notwithstanding it may have been publicly known or used in some part of the United Kingdom or India before the time of petitioning for leave to file the specification. The petitioner must state that such letters patent have been granted, and the date thereof, and the term during which they are to continue in force. The Indian patent will determine if the English patent is revoked or cancelled; and will not be allowed to extend beyond the term of the English patent, unless the same is extended in England, in which case the Indian patent may also be extended for the same term. The Court has power, upon an action for infringement, to cause the specification to be amended where there is no fraud. Where the actual inventor is able to prove that the patent has been fraudulently obtained, the patentee may be compelled to assign the patent to the inventor, and account to him for profits.

The petition must bear a stamp of the value of 100 rupees.

JAMAICA.

AN inventor must apply to the governor by petition for letters patent. If the inventor is an absentee the application may be made by his attorney. The petition must be accompanied with a declaration of belief that the petitioner is the true inventor and also with a specification, and model in case of a machine, and also drawings and specimens. The

term of the grant is fourteen years, and extension may be granted for a further term of seven years. If any letters patent are not brought into operation within two years they will be forfeited and become void.

The patentee may assign or transfer the whole or any part of his patent, and the assignment must be recorded.

Patents may be granted to assignees of foreign patents.

The provisions as to disclaimers are similar to those in force in this country.

The fee on petition is £5.

NEWFOUNDLAND.

By the law of 1856 it is provided that: Whenever any person whomsoever shall apply to the governor alleging that he has invented and discovered any new and useful art, machine, manufacture or composition of matter, not previously known or used and shall by petition to the governor signify his desire to obtain an exclusive property in such new invention and discovery, and shall pray that a patent be granted for the same, it shall be lawful for the governor to cause letters patent to be issued which shall recite the allegations in the petition and shall give a short description of the invention and discovery, for the term of fourteen years.

A declaration as to the novelty of the invention must be made before the patent is granted.

A specification must be delivered at the office of the Colonial Secretary, together with drawings, models and specimens according to the nature of the invention.

The patent may be assigned.

No applicant will be deprived of his right to a patent by reason of his having previously taken out a patent in any other country, if the same has not been introduced into use in the colony, provided that the colonial patent does not continue in force after the foreign patent has expired.

Patents may be granted to the assignee of a person who has

taken out a patent abroad, but not for any invention made abroad for which no patent has been there obtained.

The patent will be void if not worked within two years from the grant.

The Act contains provisions for disclaiming portions of the specification, and in certain cases for the surrender and re-issue of the letters patent.

The sum of £5 must be deposited with the Colonial Secretary upon an application for a patent.

New South Wales.

THE governor may grant letters of registration, for a period of not less than seven or more than fourteen years, for all inventions or improvements in the arts or manufactures, to the author or authors, or designer or designers, or to his or their agents or assignees. Such letters must be registered in the supreme court within three days after the grant.

The applicant must deposit with the colonial treasurer the sum of £20, and after such deposit present a petition to the governor, specifying the particulars of his invention.

The grantee of any such letter of registration may assign the same by an instrument in writing under his hand and seal, to be registered in the supreme court in the same manner and within the same period as the original letter.

Any such letter may be repealed in the same manner as other grants of the Crown.

New Zealand.

THE patent laws of this colony are similar to those in force here.

All applications for the grant of letters patent must be made to the governor by petition.

The following fees must be paid :

	£	s.	d.
On depositing specification	2	10	0
On obtaining letters patent	2	10	0
At or before the expiration of the third year .	15	0	0

No person may receive letters patent for an invention or discovery for which letters patent or any like protection has been issued in Great Britain or any other colony, but the governor may on the application of the patentee or his assignee upon payment to the colonial treasurer of the sum of £10 grant letters of registration, which have the same effect as letters patent to continue during the term of the original patent.

Queensland.

NO patent laws have been enacted in the colony of Queensland since its separation from New South Wales, but the Colonial Act of New South Wales (*see supra*) was continued in force in this colony by an order in council of the 6th November, 1859.

South Australia.

THE law in this colony is similar to that of New South Wales (*supra*).

Tasmania.

THE patent law of Tasmania is similar to the English law.

The following fees must be paid:

	£	s.	d.
On depositing specification . . .	2	10	0
To the law officer for any appointment .	2	4	6
On obtaining letters patent . . .	2	10	0
At or before the expiration of the third year	15	0	0
At or before the expiration of the seventh year	20	0	0

Trinidad.

THE Registrar General on an application by or on behalf of an inventor, and on the delivery of a declaration of novelty, together with a specification signed by the applicant or his agent, may deliver a certificate which protects the invention for the term of fourteen years.

The certificate may be assigned.

Any portion of the invention may be disclaimed either by the inventor or by his assignee.

The following fees must be paid:

	£	s.	d.
On leaving any declaration of invention and specification	10	0	0
Every disclaimer	2	0	0

Victoria.

THE patent law of Victoria is similar to the English law.

The same fees must be paid as in Tasmania.

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