14

THE

LAW AND PRACTICE

OF

PATENTS

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REGISTRATION OF DESIGNS,

Pleadings and all the necessary Forms.

By SIDNEY BILLING,

OF THE MIDDLE TEMPLE, ESQ., BARRISTER-AT-LAW,

AND

ALEXANDER PRINCE,

OF THE OFFICE FOR PATENTS OF INVENTIONS, &c.

LINCOLN'S-INN FIELDS.

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14, LINCOLN'S-INN FIELDS,
LONDON.

ADDENDA.

In re Brough, 7 Bevan, 104.—Condition of a patent was, that the specification be enrolled six months after the date of the grant, 3rd of June, 1843; the 4th of December occurred on a Sunday; on the following day the specification was sent to the Enrolment Office, and upon it the following instructions were written:—"Brough's specification, to be left at the Enrolment Office; but as yesterday was the last day, and it being doubtful whether the patent is not void, although the last day was on a Sunday, we do not wish it to be enrolled at present, until further advised as to its utility. If we wish it to be enrolled, it will, of course, be marked as of to-day." On the 6th, application was made by the agent at the office; and again, on the 9th, when the answer given was, that it had been enrolled. On requesting it to be cancelled, he was informed it could not, without an order from the Master of the Rolls. On application to the Master of the Rolls, upon petition, the prayer was refused. (Ex parte Beck, 1 Bro. C. C. 578.) Master of the Rolls—"I cannot make the order upon petition; I am of opinion the specification can be delivered to the office only for the purpose of being enrolled. I had rather not say any more upon this matter, or as to the effect of the 3rd of December being a Sunday, farther than it appears to me a serious question, whether the petitioner can be relieved by an authority less than an Act of Parliament."

ERRATA.

Page 35, lines 25 and 30, *for carbonet* of manganese, *read carburet* of manganese.

53, 1, *for* probability, *read* possibility.

58, 4, *for* each would bear, *read* each (*if more than one was taken out*) would, &c.

— 20, *for* being, *read* afterwards.

— 21, *for* and it is presumed also for, *read* or.

60, 2, *for* sulpher, *read* sulphur.

61, 15, *dele* of; *for* for, *read* far.

94, 10, *for* on, *read* in.

fr. ix-x mis-placed.

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PREFACE.

THE Patent Law has been the subject of many treatises, all of which, from their peculiar nature, have failed in some important particulars; as either being so technical as not to suit all who might have occasion to consult the contents of such works, or so general, as not to afford the information required; being on the one hand especially intended for the use of lawyers, and on the other for agents and patentees. The authors of this work felt (and doubtless others, also, in their several professions, with them), that a work was wanted which in itself contained both requisites—the legal knowledge and the practical utility—an attempt to supply which has been made in this treatise.

The plan of the work has been to combine the law with the practice in a running commentary, treating of the various subjects in the order in which they would practically occur. The design has been so to write the book that it may be useful to the three classes for which it was written,

viz. Lawyers, Patent Agents, and Patentees (under which last are included those who have availed themselves of the privileges of the 5 & 6 Vict. c. 100, and 7 & 8 Vict. c. 65).

The Lawyer, it is trusted, will find it useful, as being a comment upon all the important cases which have been decided upon this subject, and which, in aid of the text, appear in notes in the shape of a digest;

The Agent, in the points of law upon its various headings being collected and presented in a practical form;

And the Patentee, from the popular mode in which the matter is presented, and the absence of all merely technical expressions, excepting in two chapters, one of which is especially devoted to pleadings; the other, to the objections required by statute to be delivered with the pleadings.

In conclusion, the authors have to acknowledge the great aid they derived from Mr. Webster's collection of cases, and which, excepting in a few instances, they have availed themselves of, as generally containing a fuller report.

2, Churchyard Court, Temple,
14, Lincoln's-Inn Fields,
October, 1845.

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LAW OF PATENTS.

CHAPTER I.

THE LAW OF PATENTS(*a*)—PATENT, WHAT—HISTORY AND ORIGIN —DIGEST OF THE STATUTES RELATING TO PATENTS.

Patent, origin of.

In the early periods of English history continual mention is made of "monopolies," which were exclusive rights, either obtained by purchase or by the favour of the reigning sovereign; and to such a height was this presumed privilege of the crown carried, and so numerous were the grants which had been obtained, that it was found, by the exertion of their rights by the various grantees, commercial enterprise decayed, and, as a necessary consequence, trade became almost extinct. By the continual remonstrances of all classes of the community, the attention of the legislature was at length directed to the consideration

(*a*) "Patents which secure to the authors of improvements the profits of their own ingenuity act as a stimulus to industry and talent; but these patents (monopolies) had for their object the private emolument of certain favoured individuals, to whom they gave, under the pretence of public utility, the control of some particular branch of trade, with authority to frame regulations and to enforce obedience by fines and imprisonments. The committee (instituted to inquire into abuses) began with three patents, one for licensing ale-houses, one for the inspection of inns and hostelries, and another for the manufacture of gold and silver thread, and the investigation disclosed a scene of fraud and oppression such as is seldom to be found under the most despotic governments. All these were declared national grievances, and the patentees, Sir Giles Mompesson and Sir Francis Mitchell, were denounced as criminals, A.D. 1621." Lingard's History of England, vol. ix. p. 182. Dolman's ed.

of the subject,(*b*) and in the reign of James I. we meet with the first statute particularly relating to patents, by which the power of the crown was in their instance curtailed, and though the power to grant continued to exist, it was restrained within a reasonable limit. Patents, as now recognized by law, still are monopolies, moderated in form, and granted upon an express consideration, moving not to the crown particularly, but to the community generally.

Monopolies are offences at common law.

By the common law of England monopolies are an offence,(*c*) and are of the same nature in other branches of trade, as engrossing is in provisions,(*d*) the latter being an act of the subject between party and party, the former acquired by patent from the king,(*e*) which is a licence obtained by a person from the crown of a right of solely using, buying, selling, or working any thing, as the case may be, whereby restraint is placed upon the manufacturing or trading enterprise of the community.

Patent, what.

A patent is a grant from the sovereign, and until the reign of King John, was named therein in the singular number.(*f*) The grant is called a patent, because it is contained in a charter or letters patent, (*i. e.*) open letters (*literæ patentes*); they are not sealed up, but exposed to view, with the great seal pendant at the bottom,(*g*) and are usually addressed by the sovereign to all his subjects at large.(*h*)

(*b*) Lingard's Hist. of Eng. vol. vii. p. 330. Dolman's ed.

(*c*) Wood's Inst. B. iii c. 3, p. 435.

(*d*) 4 Bl. Com. 159. (*e*) Hawkins, P.C. 1, c. 79.

(*f*) Com. Dig. Patent B.

(*g*) Seals, though not common with the Saxons, were used in the time of King Edgar, and afterwards in that of Edward the Confessor. They were introduced into common usage by William the Conqueror (Com. Dig. Fact. A. 2), who sealed his patents with an impression upon wax, and his son Rufus also.

Richard I. used a seal of arms, and after his return from Jerusalem changed his device from two lions *combattant* to three lions *passant*.—Com. Dig. Patent, c. 1. (*h*) 11 Bl. Com. 346.

Monopolies were exclusive privileges (usually in connection with commerce, as the importation of or sole right to sell certain commodities), (*i*) granted by the crown to individuals or communities, and which authority was not the exertion of any legitimate or inherent right of the crown, but arose from its usurpation in an age when the limits of the authority of the crown or the rights of subjects were ill understood, and which were greater or less, as the power of the people or that of the crown predominated. But when a correct understanding was arrived at, as to the positive dependence of one power upon the other, and the necessity of such concessions by either as should make such seemingly antagonistic principles combine and form a grand whole; it was then Acts were passed, not only to preserve and protect the liberties of the people in matters of religion and state, but also in the relations of commerce, for the baneful effects of monopolies were felt by every class of society, and in every financial department of the state.

The first statute generally relating to the subject of patents, and which may be said to be the very hinge of the present patent law, is that of the 21 of Jac. 1, c. 3, whereby the Crown gave up the right which it claimed to grant monopolies, and in lieu thereof, ascertained and fixed a limit to be observed in the consideration of all such matters, reserving to itself certain powers, and which exist and are exerted in the present time, extended as they have been by certain statutes passed in the reign of the late and the present sovereigns, to meet the exigencies of particular cases, and to render impartial justice between man and man.

It has been thought most convenient to place here a digest of the various statutes in relation to the subject of patents, in order to the gradual and thorough development of the subject.

(*i*) Vide Lingard's Hist. of Eng. vol. vii. p. 247. Dolman's ed.

DIGEST OF STAT. 21 J. 1, c. 3.

Monopolies to be void.

Sec. I. All monopolies, commissions, grants, licenses, charters, and letters patent, to any person or persons, bodies politic or corporate, for the sole buying, selling, making, working, or using of any thing within this realm, or Wales, are contrary to the laws of the realm, and shall be void.(j)

(j) I. 'Forasmuch as your most excellent Majesty, in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did in the year of our Lord God One thousand six hundred and ten, publish in print to the whole realm, and to all posterity, that all grants 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 present Parliament, That all monopolies, and all commissions, grants, licenses, 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 any thing within this realm, or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty to dispense with any others, or to give license or toleration to do, use, or exercise any thing against the tenor or purport of any law or statute; or to give or make any warrant for any such dispensation, license, or toleration to be had or made; or to agree or compound with any others for any penalty or forfeitures

II. All such monopolies, &c. &c., ought to be and shall for ever hereafter be tried, &c., according to the common law of this realm, and not otherwise.(*k*) Trial of, by common law.

III. All persons to be disabled from henceforth to use monopolies.(*l*) Disabling clause.

IV. Any person, after forty days after the then session of Parliament (1587), who shall be aggrieved, or goods, &c., seized, on pretext of any monopoly, &c. &c., and shall sue to be relieved, in such case he shall have his remedy at the common law, by action grounded upon this statute, in the common law courts, and therein he shall recover three times as much damages as he suffered injury, and double costs; and if, after notice of action upon the statute, any Seizure of goods on pretence of a monopoly, remedy for.

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limited by any statute; or of any grant or promise of the benefit, profit, or commodity of any forfeiture, penalty, or sum of money, that is or shall be due by any statute, before judgment thereupon had; and all proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things whatsoever, any way tending to the instituting, erecting, strengthening, furthering, or countenancing of the same or any of them; are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in no wise to be put in use or execution.

(*k*) II. And be it further declared and enacted by the authority aforesaid, That all monopolies, and all such commissions, grants, licenses, 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.

(*l*) III. And be it further enacted by the authority aforesaid, That all person and persons, bodies politic and corporate whatsoever, which now are or hereafter shall be, shall stand and be disabled and uncapable to have, use, exercise, or put in use any monopoly, or any such commission, grant, license, charter, letters patents, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, or any liberty, power, or faculty grounded, or pretended to be grounded upon them, or any of them.

one seeks to delay or stay such action before judgment, by means of any order, &c., from any other court than the court wherein the action is depending, or after judgment, seek to delay execution by any other means than a writ of error or attaint, he shall incur the penalties, &c., of a *præmunire*.(*m*)

(*m*) 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 hindered, 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, license, power, liberty, faculty, letters patents, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, and will sue to be relieved in or for any of the premises; that then and in every such case, the same person and persons shall and may have his and their remedy for the same at the common law, by any action or actions to be grounded upon this statute; the same action and actions to be heard and determined in the Courts of King's Bench, Common Pleas, and Exchequer, or in any of them, against him or them by whom he or they shall be so hindered, grieved, disturbed, or disquieted, or against him or them by whom his or their goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained, wherein all and every such person and persons which shall be so hindered, grieved, disturbed, or disquieted, or whose goods or chattels shall be so seized, attached, distrained, taken, or carried away, shall recover three times so much as the damages which he or they sustained by means or occasion of being so hindered, grieved, disturbed, or disquieted, or by means of having his or their goods or chattels seized, attached, distrained, taken, carried away, or detained, and double costs; and in such suits, or for the staying or delaying thereof, no essoin, protection, wager of law, aid, prayer, privilege, injunction, or order of restraint, shall be in any wise prayed, granted, admitted, or allowed, nor any more than one imparlance: And if any person or persons shall, after notice given, that the action depending is grounded upon this statute, cause or procure any action at the common law, grounded upon this statute, to be stayed or delayed before judgment, by colour or means of any order, warrant, power, or authority, save only of the court wherein such action as aforesaid shall be brought and depending, or after judgment had upon such action, shall cause or procure the execution of or upon any such

V. Provided, &c., such declaration is not to extend to any letters patent and grants of privilege, for the term of twenty-one years or under, heretofore made, &c. &c.(*n*) Saving patent therein being for 21 years.

VI. Such declaration not to extend to letters patent, &c., hereafter to be granted for the term of fourteen years, to the true and first inventor of new manufactures within this realm, for the sole working or making of such manufactures, no one at the time of the grant making or using the same(*o*), they not being contrary to law, mischievous to the state, hurtful to trade, or generally inconvenient; the fourteen years to run from the date of the letters patent.(*p*) Saving patent for new manufactures.

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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 and provision and *præmunire* made in the sixteenth year of the reign of King Richard the Second.

(*n*) V. Provided nevertheless, and be it declared and enacted, That any declaration before mentioned shall not extend to any letters patents and grants of privilege for the term of one and twenty years or under, heretofore made, of the sole working or making of any manner of new manufacture within this realm, to the first and true inventor or inventors of such manufactures, which others at the time of the making of such letters patents and grants did not use, so they be not contrary to the law, nor mischievous to the state, by raising the prices of commodities at home, or hurt of trade, or generally inconvenient, but that the same shall be of such force as they were or should be, if this act had not been made, and of none other; and if the same were made for more than one and twenty years, that then the same for the term of one and twenty years only, to be accounted from the date of the first letters patents and grants thereof made, shall be of such force as they were or should have been, if the same had been made but for term of one and twenty years only, and as if this act had never been had or made, and of none other.

(*o*) Vide 5 & 6 Wm. 4, c. 83, s. 2.

(*p*) VI. Provided also, and be it declared and enacted, That any declaration before mentioned shall not extend to any letters patents and grants of privilege for the term of fourteen years or under, here-

Privileges granted by Parliament.

VII. Saving rights then in existence, granted by Parliament for so long as the act continues in force.(*q*)

Warrants to justices, &c. saved.

VIII. Not to extend to warrants, &c., to the judges, &c., having power to hear, &c., offences done against any penal statute, or to compound for forfeiture thereon, depending in a suit or question before them.(*r*)

Charters to cities, &c., trade fellowships, societies of merchants.

IX. Not to extend to charters granted to cities, boroughs, or towns corporate, or the customs used by them, nor fellowships of any trade or art, nor companies of merchants, erected for the maintenance, or enlargement, or ordering any trade of merchandize, &c.(*s*)

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

(*q*) VII. Provided also, and it is hereby further intended, declared, and enacted by authority aforesaid, that this act or any thing therein contained shall not in 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.

(*r*) 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 assize, justices of *oyer and terminer* and gaol-delivery, justices of the peace, and other justices for the time being, having power to hear and determine offences done against any penal statute, to compound for the forfeiture of any penal statute, depending in suit and question before them, or any of them respectively, after plea pleaded by the party defendant.

(*s*) IX. Provided also, and it is hereby further intended, declared, and enacted, That this act or any thing therein contained shall not

X.(*t*) Nor to digging, making, &c., saltpetre or gunpowder, making of ordnance or shot, or offices heretofore erected, &c.(*u*) Gunpowder, ordnance, shot, or offices.

XI. Nor to making alum, or alum mines, &c.(*v*) Alum.

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in any wise extend or be prejudicial unto the city of *London*, or to any city, borough, or town corporate within this realm, for or concerning any grants, charters, or letters patents, to them or any of them made or granted, or for or concerning any custom or customs used by or within them or any of them; or unto any corporations, companies, or fellowships of any art, trade, occupation, or mystery, or to any companies or societies of merchants within this realm, erected for the maintenance, enlargement, or ordering of any trade of merchandize; but that the same charters, customs, corporations, companies, fellowships, and societies, and their liberties, privileges, powers, and immunities, shall be and continue of such force and effect as they were before the making of this act, and of none other; any thing before in this act contained to the contrary in any wise notwithstanding.

(*t*) Vide 5 & 6 Wm. 4, c. 83, s. 2.

(*u*) 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 patents or grants of privilege heretofore made, or hereafter to be made, of, for, or concerning printing, nor to any commission, grant, or letters patents, heretofore made, or hereafter to be made, of, for, or concerning the digging, making, or compounding of saltpetre or gunpowder, or the casting or making of ordnance, or shot for ordnance, nor to any grant or letters patents heretofore made, or hereafter to be made, of any office or offices heretofore erected, made, or ordained, and now in being, and put in execution, other than such offices as have been decried by any of his Majesty's proclamation or proclamations: but that all and every the same grants, commissions, and letters patents, and all other matters and things tending to the maintaining, strengthening, and furtherance of the same, or any of them, shall be and remain of the like force and effect, and no other, and as free from the declarations, provisions, penalties and forfeitures contained in this act, as if this act had never been had nor made, and not otherwise.

(*v*) XI. Provided also, and be it enacted, That this act, or any declaration, provision, disablement, penalty, forfeiture, or other thing before mentioned, shall not extend to any commission, grant,

DIGEST OF STAT. 5 & 6 Wm. 4, c. 83.

Disclaimer of title to part of invention.

Sec. I. Any person who as grantee, assignee, or otherwise, who hath or shall obtain letters patent for sole making, &c., may, if he thinks fit, enter with the clerk of the patents of England, Scotland, or Ireland, having obtained

England. leave, if an English patent, of the attorney or solicitor-

Scotland. general; if a Scotch patent, of the lord-advocate or soli-

Ireland. citor-general of Scotland; if an Irish patent, of the attorney or solicitor-general of Ireland, 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 with such leave as aforesaid, may enter a

Alteration of specification. memorandum of any alteration in the said title or specification, such disclaimer or alteration not to extend (enlarge) the right acquired by the letters patent; and on being filed by the clerk of patents, and enrolled with the specification, shall be deemed a part thereof in all the courts: Provided

Caveat against disclaimer or alteration, where not receivable in evidence. always, any person may enter a *caveat* against such disclaimer or alteration, which shall give such person a right to have notice of the application being heard by the attorney-general, &c., &c. Such disclaimer or alteration not to be receivable in evidence in any action or suit (save and except in any proceeding by *scire facias*) pending at the time when such was enrolled; in such case the original title and specification alone are receivable in evidence. So also, before granting such fiat, the attorney-general, &c., may

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letters patents or privilege heretofore made, or hereafter to be made, of, for, or concerning the digging, compounding, or making of alum or alum mines, but that all and every the same commissions, grants, letters patents and privileges, shall be and remain of the like force and effect, and no other, and as free from the declarations, provisions, penalties, and forfeitures contained in this act, as if this act had never been made, and not otherwise.

require the party applying to advertise his disclaimer or alteration, in such manner as the attorney-general, &c. pleases; and if such advertisement is required, he shall certify that the same has been duly made.(*w*)

Advertisement may be required before fiat.

(*w*) I. Whereas it is expedient to make certain additions to and alterations in the present law touching letters patent for inventions, as well for the better protecting of patentees in the rights intended to be secured by such letters patent, as for the more ample benefit of the public from the same: Be it enacted by the King's most excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present Parliament assembled, and by the authority of the same, that any person who, as grantee, assignee, or otherwise, hath obtained or who shall hereafter obtain letters patent, for the sole making, exercising, vending, or using of any invention, may, if he think fit, enter with the clerk of the patents of England, Scotland, or Ireland, respectively, as the case may be, having first obtained the leave of his Majesty's attorney-general or solicitor-general in case of an English patent, of the lord-advocate or solicitor-general of Scotland in the case of a Scotch patent, or of his Majesty's attorney-general or solicitor-general for Ireland in the case of an Irish patent, certified by his fiat and signature, a disclaimer of any part of either the title of the invention or of the specification, stating the reason for such disclaimer, or may, with such leave as aforesaid, enter a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent; and such disclaimer or memorandum of alteration, being filed by the said clerk of the patents, and enrolled with the specification, shall be deemed and taken to be part of such letters patent or such specification in all courts whatever: provided always, that any person may enter a caveat, in like manner as caveats are now used to be entered, against such disclaimer or alteration; which caveat being so entered shall give the party entering the same a right to have notice of the application being heard by the attorney-general or solicitor-general or lord-advocate respectively: provided also, that no such disclaimer or alteration shall be receivable in evidence in any action or suit (save and except in any proceeding by *scire facias*) pending at the time when such disclaimer or alteration was enrolled, but 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

Where patentee proves not the real inventor, mode of proceeding.

II. If it be found by the verdict of a jury, or be discovered by the person (or his assigns) who had obtained letters patent for a new invention, that he was not the first inventor thereof, or of some part thereof, by reason of some one having invented or used the same before the date of such patent,(*x*) such patentee, or assignee, may petition his Majesty in council to confirm the same or grant new letters patent; the matter of such petition shall be heard before the Judicial Committee of the Privy Council, and if they be satisfied that the patentee believed himself the original inventor, and that such invention, or part thereof, had not been in public and general use before the date of the letters patent, his Majesty, on such report, may, if he thinks fit, grant such prayer, and such grant shall confer as absolute a right as the letters patent would have done supposing them to have been originally valid. Persons opposing such petition are entitled to be heard before the Privy Council, and any person party to the first suit shall be entitled to have notice of such petition before its presentation.(*y*)

Confirmation of, when.

Opposer, right to be heard.

Parties to suit, notice of petition.

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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.

(*x*) Vide supra, 21 Jac. 1, c. 3, s. 6.

(*y*) II. And be it enacted, that if in any suit or action it shall be proved or specially found by the verdict of a jury that any person who shall have obtained letters patent for any invention or supposed invention was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same, or some part thereof, before the date of such letters patent, or if such patentee or his assigns shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof, before the date of such letters patent, it shall and may be

III. If an action at law or suit in equity for an account shall be brought in respect of any alleged infringement of such letters patent granted or to be granted, or a *scire facias* to repeal such, and a verdict or final decree on the merits pass for the patentee or assignee, the judge shall certify on the record, or equity judge give a certificate under his hand that the validity of the patent came in question before him, which record or certificate being given in any other suit or action touching such patent, and a verdict pass or a decree be made in favour of patentee, &c., he shall receive treble the taxed costs, unless the judge certifies that he ought not to have such costs.(x)

On decree or verdict of former suits being given in evidence, patentee shall be entitled to treble costs.

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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.

(z) III. And be it enacted, that if any action at law or any suit in equity for an account shall be brought in respect of any alleged infringement of such letters patent heretofore or hereafter granted, or any *scire facias* to repeal such letters patent, and if a verdict shall pass for the patentee or his assigns, or if a final decree or decretal order shall be made for him or them, upon the merits of the suit, it shall be lawful for the judge before whom such action shall be tried to certify on the record, or the judge who shall make such decree or

Proceeding for an extension of the term.

IV. (*a*) If a person having letters patent shall advertise (three times in the *London Gazette*, and in three London papers, and three times in some country paper published in the town where or near to where he carried on his manufacture according to his specification, or if there be no paper published in the town, then in the county paper, so in case he does not carry on the manufacture then near to his place of residence) that he intends applying to his Majesty in council for a prolongation of his term, &c., and petition his Majesty in council to the effect—it shall be lawful for any person to enter a *caveat* at the council office; and if his Majesty refers the consideration of the petition to the committee of the Privy Council, notice must be given by the petitioner to those entering the *caveats*, and he shall be heard by counsel, and his witnesses, &c., so also those who entered the *caveats*—on report of the committee a further extension of the time for seven years may be granted, if his Majesty thinks fit, by the issue of a new patent for such period, to take effect after the expiration of the old patent; no such extension shall be granted if the petition be not made and prosecuted with effect before the expiration of the term of the original patent.(*b*)

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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.

(*a*) See 2 & 3 Vict. c. 67, repealing this section by extending the power of her Majesty to renew patents.

(*b*) IV. And be it further enacted, that if any person who now hath or shall hereafter obtain any letters patent as aforesaid shall advertise in the *London Gazette* three times, and in three *London*

V. In an action for the infringement of the letters patent, the defendant, on pleading, shall give plaintiff, or on a *scire facias* to repeal such letters patent, the plaintiff shall file with his declaration a notice of the objections which he means to rely upon at the trial, and such objections only shall be allowed: provided that judge at chambers may allow such notice to be altered, and on such terms as he pleases.(*c*)

Trial.

Notice of objections to patent.

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papers, and three times in some country paper published in the town where or near to which he carried on any manufacture of any thing made according to his specification, or near to or in which he resides in case he carried on no such manufacture, or published in the county where he carries on such manufacture or where he lives in case there shall not be any paper published in such town, that he intends to apply to his Majesty in council for a prolongation of his term of sole using and vending his invention, and shall petition his Majesty in council to that effect, it shall be lawful for any person to enter a caveat at the council office; and if his Majesty shall refer the consideration of such petition to the Judicial Committee of the Privy Council, and notice shall first be by him given to any person or persons who shall have entered such caveats, the petitioner shall be heard by his counsel and witnesses to prove his case, and the persons entering caveats shall likewise be heard by their counsel and witnesses; whereupon, and upon hearing and inquiring of the whole matter, the Judicial Committee may report to his Majesty that a further extension of the term in the said letters patent should be granted, not exceeding seven years; and his Majesty is hereby 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.

(*c*) V. And be it enacted, that in any action brought against any person for infringing any letters patent the defendant on pleading thereto shall give to the plaintiff, and in any *scire facias* to repeal such letters patent the plaintiff shall file with his declaration, a notice of any objections on which he means to rely at the trial of such action, and no objection shall be allowed to be made in behalf of

Costs.

VI. The costs of the action to be regulated according to the proofs, and shall be certified by the judge before whom the cause was tried.(*d*)

Imitating patentee's mark.

VII. Any person stamping, &c. on an article for which he has not obtained letters patent the name, or any imitation of the name, of another person who hath, without leave in writing of such patentee, &c., or person purchasing the same, stamping, &c., without such leave, with words "Letters patent," "By the King's patent," or the like kind, meaning, &c., with a view of counterfeiting the mark, &c., or in other manner imitate or counterfeit the stamp; for every offence he shall be liable to a penalty of fifty pounds, to be recovered, &c. &c. Provided, not to extend to marking the word "patent" upon any thing made, of which a patent before obtained shall have expired.(*e*)

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such defendant or plaintiff respectively at such trial unless he prove the objections stated in such notice: provided always, that it shall and may be lawful for any judge at chambers, on summons served by such defendant or plaintiff on such plaintiff or defendant respectively to shew 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.

(*d*) VI. And be it enacted, that in any action brought for infringing the right granted by any letters patent, in taxing the costs thereof regard shall be had to the part of such case which has been proved at the trial, which shall be certified by the judge before whom the same shall be had, and the costs of each part of the case shall be given according as either party has succeeded or failed therein, regard being had to the notice of objections, as well as the counts in the declaration, and without regard to the general result of the trial.

(*e*) VII. And be it enacted, that if any person shall write, paint, or print, or mould, cast, or carve, or engrave or stamp, upon any thing made, used, or sold by him, for the sole making or selling of which he hath not or shall not have obtained letters patent, the name or any imitation of the name of any other person who hath or shall have obtained letters patent for the sole making and vending of

DIGEST OF STAT. 2 & 3 Vict. c. 67.

I. Reciting and repealing the 4th section of the 5 & 6 of Wm. 4.(*f*) Repealed by sec. 4 of 5 & 6 Wm. 4, c. 83.

such thing, without leave in writing of such patentee or his assigns, or if any person shall upon such thing, not having been purchased from the patentee or some person who purchased it from or under such patentee, or not having had the license or consent in writing of such patentee or his assigns, write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word "Patent," the words "Letters patent," or the words "By the King's patent," or any words of the like kind, meaning, or import, with a view of imitating or counterfeiting the stamp, mark, or other device of the patentee, or shall in any other manner imitate or counterfeit the stamp or mark or other device of the patentee, he shall for every such offence be liable to a penalty of fifty pounds, to be recovered by action of debt, bill, plaint, process, or information in any of his Majesty's courts of record at Westminster or in Ireland, or in the Court of Session in Scotland, one half to his Majesty, his heirs and successors, and the other to any person who shall sue for the same; provided always, that nothing herein contained shall be construed to extend to subject any person to any penalty in respect of stamping or in any way marking the word "Patent" upon any thing made, for the sole making or vending of which a patent before obtained shall have expired.

(*f*) I. Whereas by an act passed in the fifth and sixth years of the reign of his Majesty King William the Fourth, intituled "An Act to amend the Law touching Letters Patent for Inventions," it is amongst other things enacted, that if any person having obtained any letters patent as therein mentioned shall give notice as thereby required of his intention to apply to his Majesty in council for a prolongation of his term of sole using and vending his invention, and shall petition his Majesty in council to that effect, it shall be lawful for any person to enter a caveat at the council office, and if his Majesty shall refer the consideration of such petition to the Judicial Committee of the Privy Council, and notice shall be first given to any person or persons who shall have entered such caveats, the petitioner shall be heard by his counsel and witnesses to prove his case, and the persons entering caveats shall likewise be heard by their counsel and witnesses, whereupon, and upon hearing and inquiry of the whole matter, the Judicial Committee may report to

Power to renew patent.

II. If a petition for the extension of a patent right has been preferred but not prosecuted with effect before the Judicial Committee of the Privy Council before the expiration of the patent—for any other cause than the neglect or default of the petitioner—the council may entertain the application, and report thereon, as in the said recited act provided, though the patent has expired; and her Majesty, on the report of the committee, may, if she think fit, extend or grant new letters patent, for a term not exceeding seven years

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his Majesty that a further extension of the term in the said letters patent shall be granted, not exceeding seven years, and his Majesty is thereby 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 notwithstanding; provided that no such extension shall be granted if the application by petition shall not be made and prosecuted with effect before the expiration of the term originally granted in such letters patent: And whereas it has happened since the passing of the said act, and may again happen, that parties desirous of obtaining an extension of the term granted in letters patent of which they are possessed, and who may have presented a petition for such purposes in manner by the said recited act directed, before the expiration of the said term, may nevertheless be prevented by causes over which they have no control from prosecuting with effect their application before the Judicial Committee of the Privy Council; and it is expedient, therefore, that the said Judicial Committee should have power, when under the circumstances of the case they shall see fit, to entertain such application, and to report thereon, according to the provisions of the said recited Act, notwithstanding that before the hearing of the case before them the terms of the letters patent sought to be renewed or extended may have expired: Be it therefore enacted, by the Queen's most excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present Parliament assembled, and by the authority of the same, that so much of the said recited 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.

from the expiration of the term granted by the said original letters patent; but if a petition be not presented before the expiration of the said term, then in no case shall such letters patent be extended; and after November, 1839, unless the petition is presented six months before the expiration of the letters patent, the period will not be extended. The petition must also be prosecuted with effect within the period of the grant; if not, a satisfactory reason must be given to the committee why the petition was not proceeded with.(g)

(g) II. And be it further enacted, that it shall be lawful for the Judicial Committee of the Privy Council, in all cases where it shall appear to them that any application for an extension of the term granted by any letters patent, the petition for which extension shall have been referred to them for their consideration, has not been prosecuted with effect before the expiration of the said term from any other causes than the neglect or default of the petitioner, to entertain such application, and to report thereon as by the said recited act provided, notwithstanding the term originally granted in such letters patent may have expired before the hearing of such application; and it shall be lawful for her Majesty, if she shall think fit, on the report of the said Judicial Committee recommending an extension of the term of such letters patent, to grant such extension, or to grant new letters patent for the invention or inventions specified in such original letters patent, for a term not exceeding seven years after the expiration of the term mentioned in the said original letters patent: provided always, that no such extension or new letters patent shall be granted if a petition for the same shall not have been presented as by the said recited act directed before the expiration of the term sought to be extended, nor in case of petitions presented after the thirtieth day of November One thousand eight hundred and thirty-nine, unless such petition shall be presented six calendar months at the least before the expiration of such term, nor in any case unless sufficient reason shall be shewn, 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.

CHAPTER II.

MATTERS FOR WHICH A PATENT MAY BE GRANTED, AND NECESSARIES THERETO—THE GRANT—MANUFACTURE—COMBINATION—PRINCIPLE—METHOD—PROCESS—NOVELTY—PUBLICATION—INTRODUCTION OF A NEW TRADE.

Patent different to a monopoly.

THOUGH monopolies (*a*) in the eyes of the common law were esteemed odious, yet a patent (as was before said, is a monopoly in a modified form) is looked upon in a different light, for Lord Coke says, "The inventor bringeth to and for the commonwealth a new manufacture, by his invention, costs, and charges;" and in Hornblower *v.* Boulton (*b*) it was said, "Every new invention is of importance to the wealth and convenience of the public, and when they are enjoying the fruits of an useful discovery, it would be hard upon the inventor to deprive him of his reward."

Patent right, grant of.

A patent is not a thing which can be claimed as of right, but is a grant made by and arises from the good-will of the crown; and before the sovereign issues letters patent to any individual, he in his discretion annexes certain conditions to the grant, in order that, to the people generally, may be guaranteed the use of those arts, manufactures, &c. of which they are already in enjoyment, and that they may at

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(*a*) All monopolies except those which are allowed by that statute are declared to be illegal and void; they are so at common law, and the 6th section excepts only those of the sole working or making any new manufacture, whether it be with or without principle, produced by accident or art, it is immaterial. 487, Buller, J., Boulton and Bull, infra.

(*b*) 3 T. R. 99.

the end of the time for which the grant is limited acquire a new privilege from the use of the patented discovery;(c) to effect which, amongst other conditions, it is provided, "that if the patentee shall not particularly describe and ascertain the nature of the discovery, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, to be enrolled in the High Court of Chancery within a certain period, then the patent shall be void."(d)

Inducement for the crown to grant letters patent.

In order to induce the crown to grant the letters patent, the discoverer of the invention represents that he is the first and sole inventor thereof, &c., and the crown, yielding to such representation and ever being willing to give encouragement to all arts and inventions that may be for the public good, grants to the inventor the sole liberty and privilege of using his invention for a certain given period (usually fourteen years), and under certain conditions. It is obvious, therefore, if the patentee has not invented the matter or thing of which he represents himself to be the true inventor, the consideration of the royal grant fails, and consequently it becomes void, and this will not be the less true if it should happen that the patentee has invented some other matter or thing for which, upon a due representation thereof, he might have obtained the grant of the exclusive use;(e) that is, the patent must not represent the patentee to be the inventor of one thing, and the specification shew him to be the inventor of another thing; and a sufficient reason for such a distinction seems to be, that if the matter at first had been properly described, a patent might not have been granted therefor, for it might have been

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(c) 8 T. R. 100.
(d) Rex *v.* Wheeler, 2 B. & Ald. 348, vide infra, Specification.
(e) Rex *v.* Wheeler, ibid. 349.

the thing was well known, or of no use, or in common use.(*f*)

Matters which may be the subject of a patent.

The matters which may be said to be the proper subjects for the grant of letters patent by the statute are as follows, viz. new manufactures (the term manufacture has been divided into many varieties), and the introduction of an invention from abroad, which will be treated of under their several headings. First of manufactures.

MANUFACTURE.

Manufacture, what.

The meaning of the term manufacture, introduced into the statute of James I., is a question of law to be decided by the court and not by the jury;(*g*) it has been open to much cavil, but by the repeated interpretation of many eminent judges who have adorned the bench, the mere broad term is now accurately defined.

In Hornblower and Maberly *v.* Boulton and Watt,(*h*) it was objected that the patent being taken out for a way or mode of effecting certain improvements in an article, and not for the article itself, that such patent was not granted for a manufacture. But Lord Kenyon said, "he had no doubt the patent was obtained for a manufacture, and which he understood to be a something made by the hands of man;" and Abbot, C.J., said,(*i*) "The word manufacture in the 21 of Jac. 1, c. 3, s. 6, has been generally understood to either denote a thing made, which is useful for its own sake, and vendible as such, as a medicine, a stove, &c., or an engine or instrument to be employed in making some previously known article, or in some other useful purpose, as a stock-

Definition of Lord Kenyon.

Definition of Lord Tenterden.

(*f*) Rex *v.* Wheeler, 2 B. & Ald. 350.
(*g*) Crane *v.* Price, 4 M. & G. 580; 5 Scott, 338, S. C.
(*h*) 8 T. R. 99.
(*i*) Rex *v.* Wheeler, supra.

ing-frame, or a steam-engine to raise water; or it may perhaps extend also to a new process (*j*) to be carried on by known implements or elements acting upon some known substances, but producing it in a cheaper and more expeditious manner, or of a better and of a more useful kind. But no merely philosophical or abstract principle can answer the word manufactures; something of a corporal and substantial nature,(*k*) something that can be made by man from the matter 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."

In Boulton *v.* Bull, (*l*) Heath, J., said, "manufactures are reducible into two classes: the first includes machinery; the second, substances, such as medicines, where the vendible substance is the thing produced;" and in the same case, Buller, J., said, "mechanical and chemical discoveries all come within the description of manufactures, and it is no objection to either of them that the articles of which they are composed were known and in use before, provided the compound article, which is the object of the invention, is new." In Huddart *v.* Grimshaw,(*m*) Lord Ellenborough, C. J., in his address to the jury, laid it down as follows:—"There are common elementary materials to work with in machinery, but it is the adoption of those materials to the execution of any particular purpose that constitutes the invention; and if the application of them be new, if the combination in its nature be essentially new, if it be productive of a new end and beneficial to the public, it is that species of invention which, if protected by the king's patent, should continue to the individual

Definition of Heath, J.

Buller, J.

Combination.

(*j*) Vide infra, Process.
(*k*) Vide Neilson's Pat. infra.
(*l*) 2 H. Bl. 482.
(*m*) Webs. Pat. Ca. 86.

the sole right thereto," (*n*) and which was particularly illustrated in a late case, (*o*) where a patent was obtained for the application of the hot air blast with anthracite (stone coal), for the purpose of procuring iron from the ore in a cheaper mode and of a better quality than had been known before; both the hot air blast and the anthracite had been applied for the purpose of smelting the iron stone or ore, previously to the patent, but not in conjunction; Tindal, C. J., in delivering the judgment of the court, said, "We are of opinion, if the result produced by such combination is either a new, a better, 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

Tindal, C. J.

(*n*) In Re Cutler's Patent (Webs. Pat. Ca. 427), it appears all chains hitherto have been formed on one of two principles—either by one branch of the chain being linked in the next which is the ordinary chain; or else the different branches are connected by holes perforated through each, and connected by a pin or screw. The present applicant says, "I adopt bolts, and I unite the two, and the joint of my chain consists not only of that which constitutes a link, and therefore would be operative without a pin, but is also constituted of a pin; and instead therefore of having a joint of one character on the other, my chain has two joints, one consisting of the link—the ordinary link, the other of the pin;"—which view the attorney-general took of the matter on the case being first brought before him, and he was of opinion that there was an union and combination of the two principles, such as entitled the party to a patent, which opinion he afterwards changed. "It is one of those many instances from which conclusion arises from an inapt use of the same term. Each of the things used may be called pins; but because they are so called, are they identical? Fusell's patent varies from the original mode of making chains." His lordship commented upon the two patents at great length, and eventually directed the patent to be sealed, and gave the costs of the proceedings before the attorney-general as well as the other costs. Lord Cottenham, Ch.

(*o*) Crane and Others *v.* Price, supra.

the subject of a patent."(*p*) In the same case it was objected that the quantity of the invention was so small that it could not become the subject of a patent, (*q*) and that a person who had procured a license to use Neilson's patent (hot air blast) had a right to apply it to any matter, whether it were bituminous or stone coal. His lordship, to this objection, answered, that, "in point of law, the labour of thought or experiment, or the expenditure of money, are not the essential grounds of consideration (*r*) upon which the question whether the invention is or is not the proper subject-matter of a patent ought to depend; for if the invention be new and useful, it is not material whether it be the result of long experiments, profound research, or whether of some sudden or lucky thought or mere accidental discovery; (*s*) for it is said (*t*) that where a man, by his own charge, or industry, or wit, or invention, brings a new trade, &c., &c., the king may grant him a monopoly (patent) for a reasonable time." And Parke, B., in another case, said, "The word manufacture must be construed in one of two ways: it may mean the machine when completed, or the mode of constructing the machine."(*u*) In the case of

Quantity of invention.

Consideration in granting a patent.

(*p*) Citing the King *v.* Wheeler, Hill *v.* Thompson, and referring to Hale's, Derosne's, Hill's, and Daniell's Patents.

(*q*) Vide infra, Price's Pat.

(*r*) Inventions are of various kinds; some depend upon the result of figuring, others on mechanism, &c., others depend upon no reason, no theory, but a lucky discovery; water tabbies were discovered by a man spitting upon the floor.—Liardet *v.* Johnson (B. N. P. 76.)

(*s*) In Crane *v.* Price (Webs. Pat. Ca. 402), Sir F. Pollock, *arguendo*, most aptly expressed what kind of invention is particularly the subject of a patent: "The perfection of invention is the simplicity of the means to the end, and the progress of any particular invention is always marked by the adoption of simpler and cheaper methods."

(*t*) Darsy *v.* Allein, 11 Coke's Rep. 84.

(*u*) Morgan *v.* Seaward and Others, 11 M. & W. 558.

Walton *v.* Bateman and Others,(*v*) Cresswell, J., commenting upon the third issue, which was as to whether or not the invention was a new manufacture, within the meaning of the statute, said, he thought there was a new principle carried out and embodied in the mode of using the principle, and which was sufficient to sustain the patent right.

Manufacture, what.

The above decisions may be said to relate to the bare term "manufacture,"(*w*) although that term has been held to include other matters of larger signification (which it will be necessary to discuss); but though they, by the force of construction, have been held to come within the term manufacture, in strictness it is presumed a manufacture cannot be said to be more than an object effected by mechanical means; and, if so, it has no relation to the principle of the construction—the combination of the parts—the method of effecting that combination—of the principle of its action, or the process by which it is effected, all of which it will be here necessary, directly or indirectly, to discuss, and which, by the intendment of the statute, as exemplified by the comments and decisions of learned judges, have been held to be fitting subjects for the grant of letters patent. In Boulton *v.* Watts and Bull,(*x*) Eyre, C. J., said, "there was nothing technical in the composition or language of the Act of Parliament; therefore, in the exposition of the statute, the intention of Parliament is to be the guide." In Russel *v.*

Construction of the statute.

(*v*) Which was an action for the infringing of a patent for a new mode of constructing cards, for the carding of wool, &c.

(*w*) Hornblower *v.* Boulton, in error (8T. R. 95).—It is difficult to conceive that the legislature, in giving power to the crown to grant patents for the sole working or making of any manner of new manufacture, intended to give thereby a power to grant patents for any other purpose than those expressly mentioned by Grose, J.

(*x*) Supra, p. 499.

Cowley (infra), Alderson, B., said, "We ought not to be astute to deprive persons of the benefits to be derived from ingenious and new inventions;" and upon these principles, upon consulting the various matters contained in this work, it will be found the courts act.

PRINCIPLE.

Principle, what.

A principle is an arbitrary assumption, or the result of known attributes, and which is or are adopted as a general rule for effecting any particular object or thing, or arriving at any definite conclusion upon any subject; as all men are presumed to know the law,(*y*)—as metal is opaque, dense, and ductile—such are principles; but such untrue or general propositions cannot be received when applied to manufactures or arts, nor could such a principle form the subject-matter of a patent. The first being unreasonable (in strictness); the last, too general; for it is clear law that the subject of every grant must be certain and defined. (*z*)

Buller, J., (*a*) said, "A patent cannot be maintained for an idea or principle alone; the very statement of what a principle is proves it cannot be a ground for the grant of

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(*y*) Such is a proposition of law, and when applied to the law in its relations with society is most reasonable; for without such a rule all things would be in disorder and confusion, and men, upon committing any fault or infraction of the law, whether of the civil or criminal code, would plead, by way of avoiding the penalty of their wrong or error, ignorance; the allowance of such a plea would be, in effect, to subject the well-ordered and industrious part of the community to the rapacity of the designing and base, to avoid which, the law assumes the proposition in the text as one of its fundamental principles. "*Ignorantia juris non excusat*," 2 Rep. 36.

(*z*) Eyre, C.J. Boulton *v.* Bull.

(*a*) Boulton *v.* Bull (supra), p. 486.

a patent, for it is the elements and rudiments of the arts and sciences; a patent must be for a new production from those elements, and not for the elements themselves." "A principle reduced into practice means a practice founded upon principle, and that practice is a thing done or made, or the manufacture which is invented." Heath, J., in the same case, (*a*) said, "There can be no new patent for a mere principle; but for a principle so far embodied and connected with corporal substances as to be in a condition to act and to produce an effect in any art, trade, &c., a patent may be granted." Grose, J., in another case, (*b*) said, "I am inclined to think a patent cannot be granted for a mere principle; but I think that although in words the privilege granted is to exercise a method of making or doing any thing—yet if that thing is to be made or done by a manufacture, and the mode of making that manufacture is described, it then becomes in effect (by whatever name it may be called) not a patent for a mere principle, but for a manufacture, for a thing to be so made;" and Lawrence, J., (*c*) said, "A principle may mean a mere elementary truth, but it may also mean constituent parts, as where a specification states the invention to consist in the following principles, that is, constituent or elementary parts, viz., a steam-vessel, in which the powers of the steam are to operate so as to be kept as hot as the steam, by a case; a distinct vessel to condense the steam, and pumps to draw off such vapour as is likely to impede the motion of the fire-engine, &c." In the case of Neilson *v.* Harford (*d*) (which appears to carry the law on this point to the furthest limit), on the argument for making the rule absolute to enter a verdict on the 4th issue for the plaintiff, much discussion

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(*a*) Boulton *v.* Bull (supra), p. 496.
(*b*) Hornblower *v.* Boulton, in error, 7 T. R. 105.
(*c*) Ibid. 106. (*d*) Webster's Pat. Cases, 273.

passed as to the claim of the plaintiff. It was urged by Sir Wm. Follett that the claim of the patentee was for every vessel, and every shape of vessel (closed vessel), in which air could be heated between the blowing apparatus and the furnace. To which Alderson, B., replied, "I think that is a principle; if you claim every shape, you claim a principle. There is no difference between a principle to be carried into effect in any way you will, and claiming the principle itself, you must detail some specific mode of doing it."(*e*) It was answered, "The mode is, you must heat the air in its passage from the blowing apparatus to the furnace." Lord Abinger, C.B., "That brings the case to the same as Watts' patent for condensing in another vessel, without describing the shape or size. It appears to me a man might take out a patent for inventing a mode of heating air in a separate vessel without stating the size of it."(*f*) Parke, B., in delivering the judgment of the court on making the rule absolute, said, "that it was after much doubt and hesitation the court had arrived at the conclusion. We think the case must be considered as if, the principle being well known, the plaintiff had first invented a mode of applying it by a mechanical apparatus to furnaces, and his invention then consists in this, by interposing a receptacle for heated air between the blowing apparatus and the furnace; in this receptacle he directs the air to be heated by the application of heat externally to the receptacle, and thus he accomplishes the object of

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(*e*) Boulton *v.* Bull: Buller, J.—The principle was known before, and if it be alone the foundation of the patent, though the addition may be a great improvement, the patent must be void *ab initio*. The mere application or mode of using a thing is not sufficient to support a patent—a man devising means of making double use of a thing before known is not sufficient for a patent.

(*f*) Webs. Pat. Ca. 355, et seq.

applying the blast, which was before of cold air, in a heated state to the furnace." His lordship said at the trial he felt a difficulty as to the wording of the specification, which said *the shape of the vessel was immaterial;* but that his brothers thought such a construction might be put upon it as would support the patent, and he still entertained a doubt whether such a construction was correct, but he was not prepared to say it was not. (*g*)

A very clear exposition of the law of patents upon this head occurs in the address of Lord Chief Justice Clerk Hope: in his address to the jury in the case of the Household Company *v.* Neilson, (*h*) his lordship said, "It is quite true, a patent cannot be taken out solely for an abstract philosophical principle—for instance, for any law of nature or property of 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 law). Stating such a principle in a patent may be a promulgation, but it is no application of the process to any practical purpose; and without that application to a practical object and end, &c., a person cannot appropriate the process in the abstract to himself," which exposition of the law agrees in every particular with the other cases enumerated above.

Application of a principle.

If one person discovers a particular principle, whether it be in mechanics or science, another person may apply that principle to a particular thing, and such application will form a good and valid ground for the grant of a patent; as in the case of Minter *v.* Wells and Another, (*i*) where it was objected the plaintiff claimed a principle, Lord Lynd-

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(*g*) Webs. Pat. Ca. 371, et seq.
(*h*) Ibid. 683. (*i*) 1 C. M. & R.

hurst, C. B., said, "Every invention of this kind must include the application of a principle, which in this case is the application of the lever—the claim is not for the principle, but for the application of it in a certain manner."

METHOD.

Method is a matter very nearly allied to a principle, and may almost be said to be the mode of applying it. Lawrence, J., (*j*) said, "Engine and method were convertible terms, and meant the same thing, and that they might 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 there I think it answers the word method. Some of the difficulties of this case (as to whether the patent was taken out for a principle or method) have arisen from considering the word 'engine' in its popular sense, viz., some mechanical contrivance to effect that to which human strength, without such assistance, would be unequal; it may also signify device, and that the patentee meant to use it in that sense, and the legislature so understood it, is evident from the words engine and method being used indifferently." Rooke, J., in Boulton *v.* Bull (*k*), said, "A new invented method conveyed to his understanding the idea of a new mode of construction, and that patents for a method had been so numerous, that method might be considered as a common expression in instruments of this kind. A particular engine or model is not necessary, provided the patentee so describes his improvement as to enable artists to adopt it when the patent expires." Buller, J., denied that a patent could

Method, what.

(*j*) Hornblower *v.* Boulton, 107, supra. (*k*) Supra.

be obtained for a method only; he said it must be carried into effect, and have produced some new substance. (*k*)

Method, to be the subject of a patent, must be defined.

When a patent is obtained for the invention of a method only (*i.e.*, of an engine, instrument, or organ, to be used for the accomplishment of some purpose), it is not borne out by saying a coffee-roaster, or any thing by which the grains may be kept in motion and turned, may be used. (*l*)

Patent for a method, when good.

In Boulton *v.* Bull (*m*), Eyre, C. J., said, "The patent should not be for an invention, but for the method of preparing it. In the case of a manufacture, it should not be for the method of producing, but for the thing. An invention consisting in the method of disposing of plates of iron so as to produce a given effect, and it being an useful and meritorious one, the patent would be properly granted for the method. It could not be for the effect produced, for it is a mere negative quality, or for making the plates, being a manufacture before known, but for the disposition. So where complicated machinery is used, which is not itself newly invented (but only conducted by the skill of the inventor so as to produce a new effect), the patent cannot be for the machinery."

PROCESS.

Process, what.

The definition of a process (for the purposes of a patent) may be a matter of some difficulty. Abbot, C. J., in the case of The King *v.* Wheeler (*n*), said, "Supposing a new process to be a lawful subject of a patent, the patentee may represent himself to be the inventor of a new process, in which it would seem that the word method may properly be used as

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(*k*) Hornblower *v.* Bull (supra), 486.
(*l*) Rex *v.* Wheeler, supra. (*m*) 2 H. Bl. 493. (*n*) Supra.

synonymous with process; and if the patent be for a process only, such process should be described—as the heat to be used, the length of time it is to be continued: &c., (*n*) saying the proper degree of heat, and the time of exposure, may be easily learnt by experience; the colour of the interior part of the prepared grain affording the best criterion, without mentioning what that colour is to be, would be insufficient, for it would be casting upon the public the expense and labour of experiment and trial." (*o*)

Patent for a process, when not grantable.

In the case of Gibson *v.* Brand and Another,(*p*) (which was a patent for an improved process of manufacturing silk, or silk in connection with other fibrous matters), the jury found the invention was not new, but an improved process, not a new combination. Coltman, J., in commenting upon the finding of the jury, said, "This word process, must be taken in conjunction with the rest of the finding, that there is no novelty of invention or of combination, which merely means there is some improvement in the manipulation. The finding of the jury seems to be, that the plaintiff has made some slight variation in the process, whereby an improved article is produced, without novelty or new combination;"(*q*) and Cresswell, J., said,

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(*n*) Rex *v.* Wheeler (353).

(*o*) Neilson *v.* Harford (Webs. Pat. Ca. 320).—Parke, B., in addressing the jury, said, "I have told you that if experiments are necessary in order to construct a machine to produce some beneficial effect, no doubt this specification is defective. If experiments are only necessary in order to produce the greatest beneficial effect, in that case I think the patent is not void." These observations arose in commenting upon the evidence of a witness, who said, "I should have tried that which produced the greatest heat upon the surface; I might have tried a cylinder, or long box, with a blowing apparatus, without any thing to direct the current of air, in the first instance—I should have made experiments in the first instance—I should at first make it 10 or 15 feet long."

(*p*) 4 Scott, 844. (*q*) Ibid. 884.

"There are dicta in the books, that a process may be the subject of a patent, but it has never been so expressly decided;" and that he had found no case wherein it is said that the mere omission of a part of a process (which this is in substance), has been held enough to form the subject-matter of a patent. (*r*) The Court held that such a finding would not support a patent.

Mere difference of manipulation insufficient to support a patent.

In order to arrive at a thorough understanding of this matter, it will be necessary not only to consider some of the cases wherein patents have been granted for processes, but also the signification of the word. Gibson *v.* Brand and Another has clearly shewn that the mere alteration in the order of the manner of doing a thing with known ingredients, or leaving out a part of the known process, is insufficient to be the subject-matter of a patent.

Process, definition of.

It is conceived that a process can be no more than the manner of effecting a given object, as for instance, macerating a body in water to loosen the flesh for the purpose of cleansing the bones; or flax, to sever it from the vegetable gluten: it is clear the mere immersion could not be the subject of a patent, for it is an operation well known; but if after a short immersion, or an immersion for the usual period, a something else was to be done, and that something and the manner of operating was clearly defined, whereby the cleansing was expedited, and a cleaner bone, or a stronger or more silky thread, was produced, it is apprehended that that additional something would form the proper subject-matter for a patent. The patent, it is apprehended, would not be granted for the improved bone or flax, but for the process or method by which it was obtained; and the observations of Eyre, C. J.,(*s*) when discussing Dr. Haynes's patent for the protection of buildings from fire,

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(*r*) 4 Scott, 889. (*s*) Supra.

seemed to point to such a definition. Dr. Haynes could not have obtained a patent for the manufacture of the plates, for that was already known, but the arrangement of them in a particular manner for the purpose of preventing the communication of heat was a process, and one new and beneficial. Abbot, C. J., in commenting upon the dictum of Eyre, C. J., said, "The description given is not of any thing which can be made. There is nothing corporal, nothing tangible, nothing that can be bought and sold, no instrument by which the supposed benefit is produced, and which might as an article of trade be purchased and used by another person." With all deference for the dictum of so great a judge as Lord Tenterden, it is presumed, if the above definition is correct, that few, if any, patents, unless for machines, could be supported; for it would include not only a principle wherein was a combination, with a defined mode of working it, but every other patent whereby the subject of it was to be effected by chemical affinities or new combinations. The case of Crane *v.* Price (*t*) is directly opposed to the definition in question: the patent in that case was the application of the hot blast to the stone coal; so Heath's patent, which came in question in the case of Heath *v.* Unwin, (*u*) which was for an improved method of making steel by adding thereto when in the crusible carbonet of manganese; neither of which patents were for matters tangible, but for producing given effects by a particular process. So also Neilson's patent. In the first case, neither the hot air or the anthracite were claimed as the subject of the patent; and in the second, the carbonet of manganese was not claimed as the invention, but its application in a particular manner for the production of steel; and in the last, the hot blast

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(*t*) Supra.

(*u*) 9 Jurist, 231.

was not claimed as the subject of the patent, but the particular mode of heating the air, and conducting it to the furnace. So Dr. Haynes's patent was for producing a given result from certain known materials., viz., plates of iron of a particular thickness, disposed in a particular manner, for the purpose of preventing the communication of heat or fire. It is not contended the merely saying plates of iron, of a sufficient thickness, placed one upon another so as to stop the progress of flame, would be a matter for which a patent could be granted; but if the proper thickness was ascertained, and the mode of fixing them, so as to prevent the flame passing beyond, was correctly explained and set out, then such process, it is apprehended, would be the proper subject for a patent.

As a method and a process are said to be convertible terms,(*x*) it follows, all that has been said of a method applies equally to a process.

Patent for a process, when obtainable.

It is submitted that a process, when the manner of its action is particularly set out, and when the result of the process is the production of a new substance, or the exposition of a new mode for effecting a known result in a readier and cheaper manner than was before known, whether it be by the use of new combinations of known materials, or the introduction of new ones to effect a particular purpose, or whether it be by the particular disposition of certain known materials by which a beneficial effect is produced, as the prevention of corrosion in the boilers of steam-engines, or the spreading of fire in the case of the destruction of houses, though acting negatively, such processes may be the subject of a patent, for they are all manufactures within the intendment of the statute (as construed), and are for the benefit of the public. It may be thought the last modifi-

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(*x*) Supra, Lord Tenterden.

cation was introduced to meet Dr. Haynes's patent; but the object in view was, the weaving of asbestos into a species of cloth, whereby a person clothed therein, in consequence of its being so positively a non-conductive medium, might stand amid fire uninjured. In this case both weaving and the substance were known, but had never been applied to the weaving of asbestos, or of forming it into cloth; yet it is apprehended, if thought advisable, a patent could have been obtained therefor.

Having ascertained what is a manufacture within the meaning of the statute, it will now be necessary to consider the next thing essential in order to the obtainment of a patent.

NOVELTY.

Novelty. Discovery and novelty, difference between.

The terms novelty and discovery are distinct terms. Dolland's and Tennant's cases illustrate the distinction: in the former, the question was, who was the original inventor within the meaning of the statute? Dr. Hall made the discovery in his closet, but never made it known, and Dolland's patent was confirmed, which was for the same thing which Hall had discovered, being a new method of making object glasses; the latter, the utility of the invention was proved, and the general ignorance of the bleachers of the subject-matter thereof until after the date of the patent. But it was also proved, that a bleacher, near Nottingham, used the same means of preparing his bleaching liquid five or six years before the date of the patent, and kept his method secret from all but his two partners and two servants concerned in preparing it. It was held that such proof militated against Tennant being the discoverer, and vitiated his patent.

Publication in a book.

If the discovery is mentioned in a book, printed and pub-

lished prior to the issue of the patent, such publication constitutes the discovery, so as to negative the invention by the patentee,(*t*) as in the case of the King against Arkwright,(*u*) where it was proved the beater or breaker of seeds, &c. (which was a wheel with teeth), was described in a well-known book of the period, called Emerson's book. So also in the case of Steed *v.* Williams,(*v*) (which was a case for the infringement of a patent for paving the public streets with wood) in the latter. To negative the patent, a volume of the Transactions of the Society of Arts was given in evidence, containing a letter concerning paving roads, &c. with blocks of wood, as practised at St. Petersburgh; and also a number of the Mechanics' Magazine, where Mr. Head's communication was referred to. Tindal, C. J. (in giving judgment on a motion for a new trial on the ground of misdirection), said, "We think, if an invention has been made public in England by a description contained in a work, whether written or printed, which has been publicly circulated, in such case the patentee is not the first and true inventor within the meaning of the statute, whether he has borrowed his invention from the publication or not, because the public cannot be excluded from the right of using such information as they already possessed at the time the patent was granted. The existence of a single copy of a work, brought from a depository where it had been long kept in a state of obscurity, would afford a very different inference than would the production of an encyclopædia, or other work in general circulation. The question upon the whole evidence is, has there been such a publication as to make the description a part of the public stock of information?" which is a question that should have been submitted to the jury.

With all deference to the decision of the learned judge,

(*t*) Hill *v.* Thompson and Foreman, 2 Moore, 454, 8 Taunt. 375, S. C.

(*u*) Davies, Pat. Ca. 61. (*v*) 13 Law Jour. N. S. C. P. 218.

it would seem that the qualification, and its inference, contained in the latter part of his judgment, as to the information being printed in a work which was not then in circulation, not having such weight as the publication in an encyclopædia, is throwing a difficulty in the way of proof, and drawing a distinction where it is submitted none should exist. It is presumed a book, when it is printed, is printed for the purpose of general circulation; if so, then the contents of the work (saving the rights of the author) are public property; and the inference is, any knowledge which that work imparts becomes immediately the property of the public; and it is more than doubtful, even if the work was printed for private circulation, whether that would at all alter the character of the publication; for, in the first place, the printers must be parties made acquainted with the secret, if secret there be; and, in the next, the very printing for the purpose of circulation amongst a few persons would shew such an animus as would amount to a publication, and would bring the case within, if not go beyond, the limits of Tennant's case (*w*). It is apprehended the contents of the work having once become public property, they would remain so for ever, and the book being out of print, and only to be met with in rare depositaries, does not negative the first publication; for, how is the presumption to be overset that the alleged inventor has not had access to any place wherein the work was kept, or had seen an extract therefrom.(*x*) The existence of the book in a rare collection, and the discovery of the secret by one person in private, are totally distinct; though in the latter case the publication would be negatived, in the former it is presumed it could not be overcome; for whether a day or a century intervened between the publication of the book and the re-issue of the discovery, it would make no dif-

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(*w*) Supra.

(*x*) Vide 2 & 3 Vict. c. 67, s. 2.

ference. The property in the work once having been public, would for ever continue so;(*w*) and it is considered more than doubtful whether in such a case the Privy Council would, under the provisions of the statute of Wm. 4, interfere to confirm the patent unless there were some important additions made to the description contained in the book.(*x*)

Evidence necessary to negative novelty.

The evidence to vacate a patent on the score of want of novelty must be direct in its character; merely inferential evidence will be insufficient, as in the case of Lewis *v.* Marling,(*y*) (which was a patent for a shearing machine). It was proved in evidence that one A. made a machine for shearing from list to list, which was not approved of and never came into use. So also that a model had been sent from America, and exhibited to a few persons, but no machine had been made from it, and that the persons to whom the model belonged purchased machines from the plaintiff; and also that a specification had been brought over from America, and that two persons had been employed to make a machine from it, but which was never completed, and that until the plaintiff's invention, no machine was publicly known or used in England for the purpose of shearing from list to list. Upon this evidence it was left to the jury to say, whether public use had been made of the machine; they found it had not, which verdict Lord Tenterden said

Evidence of prior use.

(*w*) Vide Jones *v.* Berger (Webs. Pat. Ca. 550), per Maule, J. —"I think it is an objection to a patent that it has been published in such a book."

(*x*) Webs. Pat. Ca. 733.—When Soame's patent was under consideration by the Privy Council, Lord Campbell, the discussion being as to a prior publication in a work, said, "I should say, sitting here, if it had been published in a foreign journal, considering whether the patent should be prolonged, I should be influenced by what I saw in a foreign journal, without inquiring when it was known in England; though when sitting in a court of justice, and considering the validity of the patent, I should require that it should be known in England."

(*y*) 10 B. & C. 22.

was right; but if there has been a trial of the invention, and it is known, it is different. In the case of the Household Company *v.* Neilson (which was an appeal from the Court of Session in Scotland), Lord Lyndhurst, Ch., said, "he understood the position of the learned judge (C. J. Hope, who tried the cause) to be this, that if the machine had been made and had been put in trial, unless those trials had gone on and the machines had been used up to the time of granting of the letters patent, it would not be evidence of prior use so as to invalidate the letters patent. Now, I am obliged to say, with all deference to the learned judges of the Court of Session, I think in that respect they are mistaken; and if it be 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 presence of the public—it is not necessary 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."(*z*)

Simultaneous discovery, effect.

Where two persons simultaneously discover the same thing, he who first introduces it to the public under the protection of letters patent becomes the legal inventor and is entitled to the benefit of the discovery.(*a*)

Two patents for the same thing differing in an essential particular.

If there is a material difference between two patents for the same thing, as in the case of Russell *v.* Cowley and Others,(*b*) which was a question of infringement. The in-

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(*z*) Et vide Carpenter *v.* Smith (Webs. Pat. Ca. 542); Cornish *v.* Keene infra. With this observation the Lords Brougham and Campbell concurred; and the case was in consequence sent back to be reheard on the ground of the misdirection.

(*a*) Forsyth *v.* Reviere (Chit. Prerogative of the Crown, 182), Abbot, C. J.; and Bayley, J., in J. W. Lewis *v.* Marling, supra, said, "If I discover a thing for myself, it is no objection that another made the same discovery, if I first introduce it to the public."

(*b*) 1 C. M. & R. 875.

ventions of both parties were for manufacturing tubes, and both patents were held to be good. The first patent (the plaintiff's) described the process of manufacture as by drawing the tubes through rollers, using a mandril in the course of the operation; the latter (the defendant's), by drawing them through fixed dies or holes, but was silent as to the use of the mandril. Lord Lyndhurst, C.B., said the specification of the latter patent claims the invention of welding the pipes without the use of the mandril, which, as he read, is excluded both by the particular and general description, and that the patent was good, as being limited to the welding of pipes without the use of internal support. So in Hullet *v.* Hague,(*c*) which was a patent for certain improvements in evaporating sugar, and applicable to any other purpose. The specification set out the invention. In an action thereon, to rebut the novelty, another specification was put in, which described a similar process to that contained in the specification in question, but effected in a different manner. Lord Tenterden held, that it was no vacation of the patent; and that though the object of the two patents was the same, the mode by which the object was effected was different.

Combination of known materials to form a new manufacture.

Novelty in an invention is not rebutted by proof that some or all the articles which go to form the patented article were in use before, as was shown in the case of Cornish and Another *v.* Keene and Another,(*d*) (which was a patent for improvements in making elastic fabrics applicable to various useful purposes). The specification described the invention to be, first, by the introduction of cords of india-rubber between the stitches of the fabric to form an elastic band around the top of a stocking, &c.; secondly, to manufacture elastic woollen cloth by introducing strands

(*c*) 2 B. & Adol. 370. (*d*) 3 Bing. N. C. 570.

of india-rubber amongst the yarns; thirdly, to produce cloth from cotton and other articles not capable of felting, in which shall be interwoven elastic cords or strands of india-rubber, coated or wound round with a filamentous material—after describing the process, the specification continued—by which a cloth shall be produced which shall afford any degree of elastic pressure according to the proportion of elastic and non-elastic materials. It was shown in evidence that winding the strands round with a filamented material was known.—Tindal, C. J., on a motion for a nonsuit, said, "The question whether a manufacture is new or not new, or whether it is an improvement of an old manufacture, is a question for a jury;" and in commenting upon the evidence, his lordship said, "The use of elastic strands or threads of india-rubber covered with filaments was known before, so also were the non-elastic materials; but placing them alternately side by side as a warp, and combining them by means of a weft, when in extreme tention and deprived of their elasticity, appears to be new, and the result a cloth in which the non-elastic threads form a limit to which the elastic threads may be stretched."(*e*) So in the case of Bickford and Others *v.* Skewes,(*f*) which was an action for the infringement of a patent for the miner's safety fuse for the ignition of gunpowder when used in blasting; the specification set out the process of manufacture, and contained the following clause: "I embrace in the centre of my fuse, in a continuous line throughout its whole length, a small portion or a compressed cylinder or rod of gunpowder, or other proper combustible matter, prepared in the usual pyrotechnic manner for discharging ordnance." It was objected that the plaintiff had failed to show any other material than common gunpowder has ever, &c.; or if used, &c., would answer the

New manufacture or not is a question for the jury.

Specification tending to mislead.

(*e*) 3 Bing. N. C. 587. (*f*) 1 Gale & Davison, 736.

desired purpose. Lord Denman, C. J., said, "The first part of the objection, if true, would be immaterial; the latter part, if true, would be material, because it tends to mislead; and in reading the specification, some knowledge of the pyrotechnical art is necessary. The last objection, that there was a combustible substance prepared and used, as alleged in the specification, which would not answer the purpose, would be fatal; the substance alluded to was port fire, by which formerly cannon were commonly fired. By the language used we have no reason to infer any fraudulent intention to mislead, or to make the application of the invention unnecessarily difficult; gunpowder was the material most relied on and most easily to be procured; the latter words were introduced for the purpose of making it an infringement of the patent to use them during its existence, and directing the attention of the public to them when the invention became public property. The language so used ought not to be astutely construed; the port fire used in the service is a different thing from this fuse, the former being a convenient match, the latter intended to perform the operation of a train; and it (the port fire) cannot therefore interfere with the claim of novelty.(g)

Fraudulent intent in framing specification.

Old process effected by different means.

If the patent or the specification claims without limitation an old method of effecting a certain object, though the invention is useful, and differs in the mode of its application from the old manner, yet such difference will not be deemed a sufficient novelty to support the patent; as where the claim was 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 whatever. At a trial for the infringement of the patent, it was proved that sail-cloth was made with starch at a period

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(g) 1 Gale & Davison, 739.

long anterior, but by a different method to that the subject of the patent; the jury found a verdict for the plaintiff. On a rule to set it aside, the court held, the claim of the patentee was too extensive, which was for making sail-cloth without starch; it is not confined to an improved method of weaving the cloth, but comprehends another mode of proceeding which is not new; and it was held such claim voided the whole patent.(*h*)

Variation of an old principle.

So also the mere variation of an old principle is insufficient to support a patent.(*i*) In a case where a patent had been granted for a newly invented manufacture of lace, and the claim was generally for the invention of mixing silk and cotton thread upon the frame; on the part of the crown (the proceeding being by *scire facias*, to repeal the letters patent), it was shown that, prior to the patent, silk and cotton thread were intermixed upon the same frame; it was held, that as the patent claimed the exclusive liberty of making lace composed of silk and cotton thread, and not of a particular mode of intermixing it, it was void.(*j*)

(*h*) Campion *v.* Benyon, 3 Brod. & Bing. 5.

(*i*) Rex *v.* Cutler, 1 Starkie, 354.—The coals intended to be consumed in the day to be placed in a chamber and introduced into the grate by means of a rack and pinion; the air being excluded, the coals remained unignited, the specification concluded by saying, "My invention consists in this: the fuel necessary for supplying the fire shall be introduced into the lower part of the grate in a perpendicular or oblique direction, as to manner of performing it, set forth in annexed drawing." To disprove novelty, a grate was introduced, wherein the coals for the day were deposited, and carried up by means of a rack and pinion at the discretion of the cook; the lower part of the grate, when the door was shut, represented an enclosed chamber, to which the air had no access, &c.; another grate was introduced with two doors on the same construction:—held, the grates were identical in construction with that described by the specification, which was for a mode of supplying fuel from below.—Patent bad. Ellenborough, C. J.

(*j*) Rex *v.* Else (11 East), *in notis* Buller, J.

Discovery by another, and abandonment; and after-discovery and perfecting of invention.

It is no objection to the novelty of an invention, that another person has used the same thing by way of experiment, which he, finding did not answer, abandoned, and that the patentee invented the same thing and brought it to perfection;(*k*) but where A. invents a machine and finds out the principle, but not the practical purpose, to which B. applies it, who takes out a patent, not for an improvement upon A.'s invention, but for a leverage so described as to include it, the patent cannot be sustained; but it was said, if the invention had been truly set forth, it might not have been fatal.(*l*)

If a patent is taken out for several inventions, and one of the inventions is found not to be new, the patent would be held bad, not for that only, though it was a distinct manufacture, but would extend throughout the whole patent, and would make it void, as well for those things which were new and meritorious inventions, as for that on which the proof failed, as was illustrated in the case of Brunton *v.* Hawkes and Others, (*m*) which was a patent for improvement in the manufacture of chain cables, anchors, and windlasses. It was proved at the trial, that the support within the links of the chain cable was not new, but the method of inserting it was; the old plan being by perforation, the new by the insertion of a bar of iron across the interior of the links, by welding it to the sides, and that the patent cable would resist a much greater strain than those made by the old mode. That the patent mode of manufacturing anchors had never before been applied to ships' anchors, though it had to adze and mushroom an-

Patent for several articles, some of which are not new, held void.

(*k*) Jones *v.* Pearce, cited *per arguendo* in Minter *v.* Mower, 6 Ad. & Ell. 735.

(*l*) Minter *v.* Mower, 6 Ad. & E. 744: Lord Denman, C.J.

(*m*) 4 B. & Ald. 541, et vide Morgan *v.* Seaward and Others, 2 Mee & W. 561, C. P. Vide infra, title "Disclaimer."

chors, which are used only for the purpose of mooring floating lights. The windlasses were admitted to be new. See the reports. Verdict at the trial was for the plaintiff. On argument of the rule to enter a nonsuit, Abbot, C. J., said, "The anchor is not new, because the same process as that claimed is used in the manufacture of the mushroom anchor. A patent for a machine, each part of which was in use before, but in which the combination of the different parts is new, and a new result is produced, is good, because there is a novelty in the combination; but here the case is perfectly different. Formerly, in the manufacture of anchors, three pieces were united together; in the patented article two only are united; and if the union had been effected in a mode unknown before, as applied in any degree to similar purposes, it would have been a good ground for a patent. The particular formation of the stay in the link of the chain cable is an invention sufficiently new to support a patent for that alone. The consideration for the grant of the patent is the entirety of the improvement in the three manufactures for which the patent was granted; and if it be proved that there is no novelty in one of the alleged improvements, the consideration for the grant fails, and the patentee is not entitled to the benefit of the other of his inventions comprised in the letters patent." (*n*) Best, J., in the same case, said, "A patent which is too large is not only void for the excess, but void altogether. I doubt whether the patent could be supported for the mooring chain, for the specification cannot stand as a description of a new combination of known principles. It claims an invention, part of which is not new. The specification states, the form and construction of a link which can convert a lateral into an end strain, by yielding support to the opposite sides of the link, is one that should be preferred, and which is the claim of originality; there is

Patent for a new combination of known parts.

Invention sufficient to support a patent.

Entirety of the consideration.

New combination of old principles.

(*n*) 4 B. & Ald. 550, et seq.

no doubt that links in this particular form were used before."(*o*)

Combination of old means, without claiming a new mode.

Where a patent was claimed for an invention, which invention consisted of old parts, to which there was an addition, but which addition was not noticed in the specification as part of the claim, it being possible to produce the effect by other means, such patent would be insufficient. This position was illustrated in the case of Saunders and Aston, (*p*) where a patent was obtained for the introduction of a flexible material instead of a metal shank, neither of which were new; and the only thing new was the use of a toothed ring, or collet, but which was not stated to be the subject-matter of the invention. It appeared by the specification that the effect might be produced in other modes, which the plaintiff had also used. Lord Tenterden, C. J., held, if there had been no other mode by which the object of the patent could have been accomplished than that in which the collet was used, the patent might have been sustainable.

Claim for an improvement.

Where the claim is for an improvement, it must be mentioned as an improvement (*q*) in the specification, and such parts of the old process or machine as are used must be disclaimed; for without such disclaimer, the new part of the machine or process will be vitiated, in the same way as when the claim is for several articles, one not being new; as where the claim was for a manufacture, the machine for effecting the object consisted of an entire new combination, but the parts composing it were not new: it was put to the jury, that if they thought the combination was new from the beginning, the

New combination of known parts.

(*o*) 4 B. & Ald. 556, et seq. (*p*) 3 Ibid. 881.

(*q*) Boulton *v.* Bull.—If the position that there can be no patent for an addition be true, it would go far to repeal every patent that was ever granted. A patent for an addition is good.

If a patent be confined to the invention, it can give no right to any thing beyond the invention itself; and where it is taken out for an improvement only, the public have a right to purchase that improvement by itself. 490, Buller, J.

patent would be good; but if only from a certain point, then it would be bad: the jury found only from a certain point. On a motion for a new trial, the rule was refused; and Dallas, J., said, if an invention be for an addition, the patent must be for that only (*r*). So where the claim was for certain machinery for spinning flax, and other fibrous matters, by a new process, and by a fixed reach of a certain and specified distance in the spinning machine, the former machines having a shifting reach, varying according to the length of the fibre to be wrought upon, it was proved that a less reach than two-and-a-half inches (the distance specified) was sometimes used in spinning some species of fibre. This proof was held to vitiate the patent (*s*). So where a

Patent for an addition.

(*r*) Bovil *v.* Moore and Others, 2 Marshall, 211. Hill *v.* Thomson and Another, supra. Rex *v.* Arkwright, supra.

(*s*) Kay *v.* Marshall and Others, 5 Bing. N.C. 492.—New invention for spinning flax and other fibrous substances, for which a patent was obtained; the invention claimed was for certain macerating vessels, and the trough of water (described in the specification), and the trough to hold the rovings when taken from the macerating vessels, and placing certain rollers nearer to each other than they ever had been before, say 2¼ inches. An issue was directed by the Master of the Rolls, first, to try whether plaintiff had, before and at the time of making the said letters patent, found out and invented any new machinery as in the specification alleged; and second, whether the said invention was of much or any public utility, as in, &c. The judge trying the cause was to be at liberty to endorse on the postea any special matter. The issue was tried before Parke, B., and a verdict was found for the plaintiff on both the issues, who endorsed the postea, that before the grant of the patent, flax, &c. were spun with machinery with slides, and the reach was varied according to the length of the fibre, &c. to be spun; that there had been a fundamental principle known and used before the grant of the patent, the reach having in various materials differed greatly. Before grant of the patent, it was not known that flax could be spun (by means of maceration, it having a short fibre) at a reach of 2½ inches. Before this time, another person had taken out a patent for the application of moisture in spinning flax, to separate the fibres and to reduce the length

patent was taken out for an improved mode of lighting cities, towns, and villages, it was held the patent could not be sustained by a specification which only treated of a street lamp upon a new and ingenious construction (*t*). So where

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of the staple, and that the machines manufactured in accordance therewith were constructed with a reach of 4¾ inches.—Question for the opinion of the Court was, whether the plaintiff's patent was void in point of law. Held, the patent was not valid in law. "The new machinery appears to be a subject proper for a patent, but the latter part of the patent does not appear to be a subject upon which in law a patent can be taken out. Looking at the whole specification, it is not the use of the troughs, as used by him, on which he (plaintiff) relies, but it is the placing and retaining the respective rollers within 2¼ inches of each other. Whether for such a placing of the rollers under the circumstance stated in the case, a patent can be granted, is the real case between the parties. We think it cannot; for it appears by the indorsement, before the grant of the patent the reach was varied, and in cotton-spinning had been less than 2¼ inches; therefore, the application of a 2¼ inches reach to flax when in a state of maceration does not appear any new invention or discovery, but is the application of a piece of machinery, before in use, to the new macerated state of the flax; so also the application of moisture was not new, though exerted in a different mode. Suppose a patent had been obtained for an entire new method of reducing the fibres of flax to a short staple, we think a second patent could not be taken out for an improved mode of machinery in spinning flax, which consisted of nothing more than spinning of the short staple of flax by a spinning machine of a fixed reach, not less than already in use for spinning cotton, for the effect would be to prevent the patentee of the old machine from using his machine at the proper reach." (500.) Tindal, C. J. (judgment of the Court).

Campion *v.* Benson (supra), Park, J.—A patent for an improvement upon an old discovery may be sustained; but where in addition to the merit of the improvement it claims also the old discovery, it never can be permitted to vest in the patentee an exclusive privilege for the old discovery.

(*t*) Lord Cochrane *v.* Smethhurst, 1 Starkie.—A patent for an improved mode of lighting cities, towns and villages. The specification stated this was to be effected by a lamp of a new and very ingenious and simple construction. Held, the patent could not be maintained, for the patent was not for a new street lamp, but for an

the old and new invention are so intermixed, that it cannot be readily seen which is the old and which is the new invention (*u*).

As a patent may be for an improvement upon a machine or other matter known to the public, and in use; so a patent may also be obtained for an improvement upon a patent; but, of course, in such case the prior right must be respected, and a licence obtained from the prior patentee, or the expiration of his patent must be waited for. In Crane and Others *v.* Price,(*v*) to an objection that a second patent could not be obtained whilst the first was in existence, and which could not be used except by means of the prior invention, Tindal, C. J., replied, "If the second patent claimed as a part of the invention described therein that which was the subject-matter of a patent then in force, it would be void; but here there is an express disclaimer of the hot air, the subject of Neilson's patent; therefore, the validity of the patent cannot be impeached upon that ground. Unless the grantee of letters patent is bound to specify whether such former invention which is excepted,

Patent for improvement upon a patent.

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improved method, &c., to be effected by improvements upon the old street lamp, by a new combination of parts known before. The patent is too general in its terms; it should have been obtained for a new street lamp, not for a new mode of lighting, &c. Le Blanc, J.

(*u*) Macfarlane *v.* Price, 1 Starkie, 199.—A specification should state in what an improvement consists. The description should be by words, if possible, if not, by reference to figures; otherwise it would not be in the wit of man to say what was new or what was old. A description describing the old as well as the new part of a machine is not true; a person ought to be warned by the specification against the use of the particular invention, but it would exceed the wit of man to discover against what he is warned in a case like this—which was a patent for an improvement in an umbrella, &c.; the specification professed to set out the improvement as specified in certain descriptions and drawings annexed. Ellenborough, C.J. (120.)

(*r*) Supra.

was so on the ground of its being generally known, or because it was the subject of a patent, the new patent will be good; but that distinction is as much in the knowledge of the public as of the grantee. If a new patent had been taken out for an improvement or alteration of an invention secured by a former patent, then a greater particularity would be necessary. It was argued, in point of law, no patent can be taken out which includes the subject-matter of a patent still running and in force; no authority was cited in support. The case of Lewis *v.* Davis (*w*) affords a strong inference that the second patent was good. Harmer *v.* Playne (*x*) is a clear authority upon the same point, and on reason and principle there appears no objection; the new patent, on expiration of the old, would be free from objection, and during its existence may be used, by the

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(*w*) Lewis and Another *v.* Davis, 3 Carrington and Payne, 502.—Infringement of a patent machine for shearing cloth, which was an improvement of a former patent. The specification stated:—"We claim as our invention, 1st. The application of a flat spring for directing and pressing the cloth to the cutting edges. 2nd. Application of a triangular steel wire on the cylinder. 3rd. A proper substance to brush the cloth. 4th. To shear with rotatory cutters from list to list in the manner specified." (503.)

The application might have been for a patent for their invention without reference to any thing which had gone before. It is material to show what are the improvements proposed, and it is impossible to know what are improvements upon a given thing without knowing what it was before. (504.) Rotary cutters to cut from end to end were known before, and cutting from list to list, by means of shears, was also known; but cutting from list to list, and doing that with rotary cutters, were not combined. Verdict for plaintiff. Tenterden, C. J.

(*x*) Hamer *v.* Playne, 11 East, 101.—In the case of a patent upon a patent, if the improvements are so valuable, and give such an additional value to the old machine that the public prefer the new machine, paying for the improvements to the old machine, it is in respect to their worth the public abstain from the use of the original machine; but the choice ought always to be left open.

licence of the first patentee; and the probability of the refusal of a licence is so extremely remote, that it cannot enter into consideration as a ground of legal objection (*y*)."

PUBLICATION.

Publication, what.

Any publication of which the public can take advantage will militate against the novelty of an invention.

In the case of Carpenter and Smith (*z*), Lord Abinger, C.B., said an invention could not be considered new which had been in public use; the word public was not equivalent to general, but was distinguished from secret use; and Alderson, B., in the same case, said public use means use in public, so as to come to the knowledge of others than the inventor, contradistinguished from the use of himself (the inventor) in his private chamber. (*a*)

User. What vitiates a patent.

If the user of the invention is secret, it will not be such a publication as will void a subsequent patent, as where, before the patent was obtained, a pair of paddle-wheels were made by a manufacturer, under an express injunction of secrecy, (and under the instruction of the inventor), for him to whom afterwards the patent was assigned, who paid for them when finished, and had them taken to pieces, shipped, and sold to a foreign company, and were used after the date of the patent by the persons to whom they were sold. Parke, B., held such making and selling was not such a publication as would make the patent void. (*b*)

(*y*) Et vide Ex parte Fox, 1 Ves. & Bea. 67.

(*z*) 9 Mee. & Wels. 300.

(*a*) It was proved in evidence that a lock of the same pattern had been received from America, and that several dozens had been made from it and exported, and a lock of the like construction was produced, which had been on a gate in a public road sixteen years.

(*b*) Morgan *v.* Seaward, 2 Mee. & Wels. 559.

Sale in public market.

Where the subject of the patent had been exposed for sale in the public market some time (any time would be sufficient) previous to the obtainment of the letters patent, such sale, or exposure for sale, would invalidate the patent; for if the law were otherwise, the inventor, possibly, might have a monopoly for a time longer than that contemplated and allowed by the statute, and that it was only through fear of the discovery of his secret that the inventor was induced to apply for a patent. (*c*)

Sale of exported goods.

If the user in the market had been by exportation from abroad, and not in consequence of the plaintiff's manufacturing, such an exposure would be subjected to a very different conclusion, for by the introduction of a new trade, a benefit would be conferred upon the community; but the benefit conferred must also be direct in its nature (as by lessening the cost of the article); in such case, the exposure of the imported article would not vitiate the patent obtained for the home manufacture.(*d*)

User in a small degree will vitiate a patent.

If the user, and sale of the article (afterwards patented) was a user, &c., in a very slight degree, there being little or no demand, it will be sufficient to invalidate the patent right;(*e*) it is no matter in what part of the kingdom the user took place, for by the construction of the patent law, user in one part of the United Kingdom is a user in all parts; and a patent obtained subsequent to the user of the thing (sought to be protected), in any part of the United Kingdom, will, therefore, be void. This point was decided by the case of Brown *v.* Annandale,(*f*) which

User in one part of the United Kingdom, applies to the whole kingdom.

(*c*) Wood and Others *v.* Zimmer, 1 Holt, N.P.C. Hastings's case, Webs. Pat. Ca. 6.

(*d*) Dasey *v.* Alleyne, supra. Edgebury *v.* Stephens, 2 Talk. 446. The Smalt Patents, Webs. Pat. Ca. 9 and 14. (*e*) Losh *v.* Hague, supra.

(*f*) Brown *v.* Annandale, Webs. Pat. Ca. 442.—The case came on for trial on the 2nd of February, 1842. Sir F. Pollock and Biggs Andrews for appellant. Kelly and Godson for respondents. The Attorney-General, on opening the case, described the questions simply

was a cause tried before the Court of Session in Scotland, on an appeal in the House of Lords for the infringe- User in England vitiates a Scotch patent.

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to be, whether, according to the laws of England, Scotland, and Ireland, as they now stand, with regard to letters patent for inventions, the condition of novelty inserted in the grants extends beyond those parts of the United Kingdom respectively for which the grants were made—that is, whether it is not sufficient that the invention be new *quoad* the country for which the grant is made, and contended the crown has the same right to grant patents with respect to Scotland as it had before the union of the two kingdoms. "But it has always been considered that the 6th Article of the Union has made the law of Scotland the same as in England with refer e to patents."—Lord Campbell. "All English cases are cited in Scotch patent cases as in England."—Lord Brougham. The Attorney-General continued: "The Crown of Scotland is in the same situation as respects granting patents as the Crown of England." "Then you must contend, that an invention imported from Scotland into England is as equally entitled to be patented as if brought from beyond the seas."—Lord Lyndhurst, Ch. The answer to which was, "I do." (It was admitted the patent was known in England before the grant of the letters patent, but that the patentee, *bonâ fide*, took out his patent without knowing that); and that, looking at the language of the statute and the patent, the consideration of novelty applies only to the country for which the patent was granted, and that was the opinion of all Westminster Hall. The Lord Chancellor said, "The question seemed to turn upon the construction of the Act, the Crown can only grant a patent for what is new; the question is, where new?" and "that it would be a monstrous thing if an invention having full publicity in one part of the kingdom could be made the subject of a patent in another part of it." Adverting to the case of Stirling and Roebuck (infra), Lord Lyndhurst, Ch., said, "If we are to take that case according to the letter, it is a distinct decision upon the point." (Lords Thurlow and Mansfield were present when that judgment was given.) Biggs Andrews—It was contended, that a patent right was a private right, because it is always sealed under the seal of Scotland; if not, one patent would run over both countries; but in practice, they are confined to the country from which it issues. Lord Lyndhurst, Ch.—"Patent rights surely affect the public, and may be given for a part or the whole of the realm; for England without the colonies, or for Scotland, and not England, and, *vice versâ*, they are distinct countries only as to the form and extent of the grant; the sealing has only reference to the

ment of a patented right of making paper. On the plea of denial that the invention was new, it was proposed to give in evidence, user in England, which the presiding judge, Lord Mackenzie, admitted; whereupon the counsel for the *pursuers* tendered a bill of exceptions, which was argued before the first division of Court of Session, and disallowed; whereupon the pursuer appealed to the House of Lords, who confirmed the decision of the Court of Session, and dismissed the appeal with costs. On the argument, much discussion took place concerning the Act of Union, and the general law of user, and reference was repeatedly made to the case of Roebuck *v.* Stirling, which was decided by the House of Lords in 1774.(*g*)

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form of the grant, and the officer who is to superintend the issuing of it." "There might be a patent for one country only."—Lord Brougham. Judgment:—"As far as I am concerned, I feel bound by that decision (Roebuck and Another *v.* Stirling and Another).—Lord Lyndhurst, Ch., with which Lords Brougham and Campbell concurred; Lords Brougham and Campbell added, that without that decision they should have decided as they had done. The appeal was dismissed with costs.

(*g*) Roebuck and Garland, Appellants; Stirling and Son, Respondents, Webs. Pat. Ca. 45.—A patent had been granted to the appellants, for the means of obtaining acid from sulphur and saltpetre in vessels of lead, and likewise of purifying the same also in vessels of lead. The specification, after declaring the process, stated the material discovery to be the use of leaden vessels instead of vessels of glass, in all or any part of the process. In the year 1772, the appellant obtained an injunction to restrain respondent from proceeding with building certain works in which considerable progress had been made; the respondent stated, that the substitution of leaden in the place of glass vessels was not new: that the appellants had carried on the method for twenty years preceding the date of the patent: that at the time of the grant of the patent the process was carried on by many persons in England and Scotland: that the invention was not properly described. It was urged by the appellants, that however invalid the patent right might be in England, it was good in Scotland. The respondents, in rebuttal, relied on the 6th article of the treaty of the Union, that the whole United Kingdom being

It is apprehended, whether the user was by the subsequent patentee himself, or by a stranger, that the user would have the same effect, for in either case it would be a publication, and the public would have a right to take advantage of the knowledge thereby communicated, for the publication, however great may be the merit of an invention, unprotected by a patent, would vest the discovery in the public. Public user.

Mr. Webster, in a note upon the case of Brown *v.* Annale,(*h*) seems to doubt the soundness of this proposition: he says, "And it is to be apprehended that the above decision would not be held to apply to a case in which the true and first inventor in one part of the realm, was the grantee of letters patent in the other part; otherwise, unless letters patent in England, Scotland, and Ireland be sealed as of the same day, there will be a prior publication in law in one or more of the countries, for the specification which relates back to the date of the letters patent is a publication, though it may be doubted how far such publication is evidence of public use and exercise."(*i*) The usual course taken by inventors is, to apply for patents in all three of the kingdoms at one time, whereby an extension

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subject to the same prohibitions, restrictions, and regulations, as to trade, and it being indispensable that the making of the oil of vitriol is free to all men in England, that trade could not be the subject of a monopoly in Scotland. On the report of the Lord Ordinary, the following interlocutor was pronounced:—"In respect it appears, from the proofs adduced, that the art of making oil of vitriol from a mixture of sulphur and saltpetre in vessels of lead was, at the time, and before the date of the letters patent of the appellants, known to, and actually practised by, different persons in England; therefore, the Lords find the letters orderly preceded and decern. On appeal to the House of Lords, the appeal was dismissed, and the interlocutors complained of were affirmed.

(*h*) Webs. Pat. Ca. 454.

(*i*) Referring to Cornish *v.* Keene, in confirmation of the latter sentence.

of the time for specifying is obtained, and the expense very little increased: if the application was for all three of the patents at once, though only one was taken out, it is presumed each would bear the same date. If the application was for an English patent only, the merely applying and obtaining a patent would not be considered as a publication, unless a public user of the patented article was proved; so, there being no user, there can be said to be no publication until the enrolment of the specification; but until that time, it is presumed, the patentee would be at liberty to apply for a patent in Scotland or Ireland, for no act has been done to vitiate the grant. But if the specification be once enrolled, or there be a public user of the patented article, even in the kingdom wherein the patent is obtained, before the application, the enrolment or user would be a publication, and would bar the patentee, as well as any other person, from obtaining a patent for either or both the excepted places.(*j*)

User in the colonies vitiates English patent.

From the observations of their lordships in Brown *v.* Annandale, it would appear that an user in any of the colonies would equally vitiate a patent being obtained for England; and it is presumed, also, for Scotland or Ireland, or any other more limited part of the United Kingdom. (*k*)

(*j*) Vide infra, Obtainment of Patents.

(*k*) Brown *v.* Annandale, House of Lords.—A patent for the colonies is granted by including them in the English patent, or by an order of council extending them to certain colonies (Lord Campbell); and a patent which is found not to be new in the colonies would be void, because they are part of the realm. All became one realm at the Union.—Lord Lyndhurst, Ch. Lord Campbell said there is no separate patent for the colonies, upon which Mr. Webster remarks (Web. Pat. Ca. p. 428, notes), that is to say, there is no great seal for the colonies; but there are several instances of distinct grants for the colonies; such patents pass as English patents under the great seal of the United Kingdom: one such was mentioned (it is presumed in the principal case).

So it is presumed, any act which shows an intention of sale, without the actual sale taking place, as exposure in a public shop (*l*) or market for the purposes of sale, would be a sufficient publication to avoid the patent, and this position is supported by the observation of the Court of Exchequer on an argument upon a demurrer in a very late case: the Court held, that an open exhibition for sale in a shop window was a sufficient publication to avoid the patent.(*m*)

Exposure for sale.

Where there has been a private user of the discovery, for the purposes of commerce, previously to the obtainment of letters patent, it is said, and justly, that such user shall make void the subsequent patent. Upon this point a very nice question arises, viz., would such secret user be accounted a publication, so as to void a patent obtained by a stranger, he having discovered the same or a similar mode of effecting the same object? If the patent was for a pro-

Private user, and after patent, effect.

After patent by a stranger.

(*l*) Richardson, a workman, was employed to make a new construction of spectacles by the inventor, and exposed them for sale previous to the sealing of the patent. Such exposure and sale was deemed a publication, and the invention was thereby to be thrown open to the public. But the case was not completely before the court. It turned out that the supposed invention was not new, and upon that fact the plaintiff failed.

(*m*) Vide Bramah *v.* Hardcastle (Webs. Pat. Ca. 194, note n.)

Smith *v.* Barron and another (Excheq. Trin. Term, 8 Vict. 1845). —Action was for infringement of a patent for iron shutters. The plea alleged that before the grant of the letters patent, so much of the patent as is firstly described in the specification was publicly used and made, and openly exhibited for sale by the defendants; the replication merely traversed the public use, and not the open exhibition for sale. Demurrer for the imperfect traverse. On the argument, the court called upon counsel for plaintiff to support his replication, saying that the open exhibition for sale in a shop window was a sufficient publication to avoid the patent, and that it must be traversed. Plaintiff to amend. In this case the exhibition was not of the article itself in a state fit for sale, but of a pattern from which a person might choose.

cess, that is, for a particular mode of effecting an object, as obtaining sulphuric acid by means of sulpher and salt, and the use of leaden vessels, or other such operation, where the object was effected by means of chemical affinities, and the process could be kept secret; in such a case, it is apprehended that the subsequent patentee would be protected, and such secret user would not be deemed a publication as against the patentee, and this position seems to be confirmed by the observation of Dallas, J., in the case of Hill *v.* Thompson and Foreman,(*n*) and which was admitted to be law by the counsel engaged in the cause, viz., "If a person in secret had done all that the plaintiffs are specified to have done, and had not communicated it to any one, could he be prohibited by the after patent from doing that which he had done before, though known to no one but himself? or could it be considered as new, if practised by only one person, but not communicated to the world?"—and these observations are much strengthened by the dictum of Tindal, C. J., in Cornish *v.* Keene. (*o*) In addressing the jury, his lordship said, "If the defendants could show, that they practised and produced the same results (as in the specification expressed) in their manufactory, before the time the patent was obtained, they cannot be prevented by a subsequent patent by going on with that which they have done."(*p*)

These dicta above cited show, not that the patent would be avoided, but that those persons who had the knowledge of the means by which the patented process was effected, and practised that knowledge in secret, even for the purposes of trade, would be protected in the use of their particular processes after the patent was obtained,

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(*n*) Supra. (*o*) Supra.

(*p*) Ibid. 511. And see also the dictum of Patteson, J., in the case of Jones *v.* Pearce, supra.

which protection must be an admission that there was an user in secret, and such a one as, if made public, *would* destroy the patented right; for it is clear, unless the secret process was like to that specified, there would be no need of protection, for if they differed, no action would hold. Therefore, it is submitted, that a secret user, though for the purposes of commerce, of a particular process, will not vacate a subsequent patent obtained by another person for the same process; for the argument usually applied to the secret user and the after obtainment of letters patent would not apply here; viz., that it would be the possession of a monopoly for a greater period than that allowed by the statute.(*q*) But where the secret user was not of a particular process or manipulation, but of a machine, or the mode of constructing of a machine, for different considerations would be brought to bear upon the subject, for the machine itself could not be a secret from the workmen; so it may be said of a process:—but, in the first case, the entire object is presented to his view; in the latter, only parts. For it may be the secret addition of a drug works through chemical combinations and affinities, the whole change; or that part of the men are employed on one part of the process, and part upon another, and therefore no particular man had a knowledge of the whole process; and as it would be only parts of the process with which they were acquainted, there could be said to be no public user or publication; but as to the case of the person in possession of and practising the secret, a different construction would, of course, apply. In the case of an invention, or manufacture, carried on by the use of a machine, the whole of the machine is presented to the view of the workmen; or, if not, still they would be enabled to see that a certain effect was produced

Secret user of a process will not void a subsequent patent obtained by a stranger.

Secret user of a machine, effect.

(*q*) Morgan *v.* Seaward, supra.

by the use of the machine, and which, to an intelligent or educated mind, would afford a sufficient hint for the construction of a similar machine; therefore, it is presumed, it may be said, if the secret user (that is, an user confined to one manufactory) of a particular object effected by a machine, or (if it were) to make a machine, that such use would be a publication,(*r*) and a sufficient use to vacate any subsequent patent, and that whether it was obtained by the proprietor of the manufactory, or by a stranger.(*s*)

Publication, how judged.

The animus with which the publication is made is the medium through which the act is judged. A private user,(*t*) by way of experiment, would not be deemed a public user; or employing a workman(*u*) to perfect an idea under the direction of the inventor, in order to complete an invention, as to make certain parts of a machine, or even the whole—the inventor having conceived the principle; or to work from a model obtained from abroad;(*v*) but if the party employed suggests any important part of the process, such suggestion(*w*) would invalidate the after patent, unless it was obtained in the joint names of the inventor and the improver; (*x*) but where the improvement was the result of certain suggestions, and was only discovered in the course of the experiment, though made by the employer, but under the inspection of the inventor, in such case, it is conceived, the improvement would be taken to be

Private user, by way of experiment.

Perfecting an invention by the improvement of others.

Suggestion of an important part of the process.

(*r*) Vide J. and W. Marling *v.* Davis, supra.

(*s*) Vide infra, Publication, as to what publication is protected.

(*t*) Gibson *v.* Brand, supra.—An act done in secret (though long before patent) is insufficient to constitute such a practising of an invention or process as will prevent another from afterwards making it the subject of a patent, for it is unknown to the public. (888). Erskine, J.

(*u*) Barker *v.* Shaw, 4 Taunt. 770. Bayley, J.

(*v*) Carpenter *v.* Smith, Webs. Pat. Ca. 536. Abinger, C.B.

(*w*) Tennant's case. (*x*) Infra.

the result of an experiment made by the inventor,(*y*) which position is illustrated by Gauble patent, which was for making paper in continuous sheets. Mr. Dorkin, a celebrated engineer, was professionally engaged to advise means of carrying the principle into practice; some of the mechanical detials for this purpose were of his invention. It was held, such details were but subsidiary and incidental to the main idea, and did not vitiate the patent.

Employment of a person to work out a principle.

When an inventor employs another person for the purpose of making a machine according to his design, or of helping to complete an invention, great care should be taken in making choice of a person for that purpose; for should the invention be disclosed by his means, whether through indiscretion or intentionally, the right to the patent is thereby gone,(*z*) and the invention is open to the public.

Disclosure of the secret.

If the disclosure was to one person only, and he fraudently represented himself to be the inventor, and obtained the patent previously to the true inventor, he would be entitled to the patent, unless the true inventor should show the source whence the invention was derived, and prove the collusion between his employee and the patentee. In such case, it is apprehended, the invention would be thrown open, for such an imparting of the secret would be deemed a publication, and the inventor would be without remedy, unless by an action against his employee for breach of duty. Exhibition in a public room, before the obtainment of a patent, has been deemed a publication.

It has been held, that where a person had a glimpse of a principle, and proceeded to try experiments, the results of which were used in public but were never completed, and finally abandoned by the inventor on the supposition of being

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(*y*) Minter *v.* Wells and Hart, supra. Makepeace *v.* Jackson, 4 Taunt. 770.

(*z*) Vide infra, Caveat.

Experiments by other persons, effect on patent.

useless; another person afterwards conceived the same idea and perfected it, such prior experiments were no publication, so as to invalidate a subsequent patent. (*a*) This position was exemplified by the decision of Tindal, C. J., in the case of Galloway *v.* Bleadon. (*b*) To the jury his lordship said, "A mere experiment, or 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, is not such an invention as should prevent another person, who is more successful, or pursues with greater industry the chain in the line that has been laid out by the preceding inventor, from availing himself of it, and having the benefit thereof." "He may avail himself, as far as his predecessors have gone, of their discoveries, and add the last link of improvement in bringing it to perfection."(*c*)

Prior publication in a specification, notice to the world.

It is scarcely necessary to say, after what has gone before, that matter included in any prior specification would be deemed a publication, for a specification is a matter of record, and is therefore presumed to be known to all persons, for the filing it of record is a notice to all the world.(*d*),

Publication, a question for a jury.

The question of what is a publication and user is one for the consideration of the jury and not of the court.(*e*)

An invention must be useful to support a patent.

It will be gathered from the preceding remarks and cases, that novelty is a most indispensable requisite to the validity of the grant of letters patent, and to novelty

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(*a*) Morgan *v.* Seaward, supra.—It may be doubted whether the question of utility is any thing more than a compendious mode introduced in comparatively modern times of deciding the question whether the patent be void under the Statute of Monopolies.

Claim was for an improvement in steam-engines, and not in the propelling wheels.

(*b*) Webs. Pat. Ca. 525.

(*c*) Et vide The Househill Company *v.* Neilson, supra.

(*d*) Huddart *v.* Grimshaw.

(*e*) Elliott *v.* Aston, supra. Cornish *v.* Keene, supra.

another incident is attached, viz., that it shall be useful. (*f*)

An exclusive privilege for an useless invention would be an inconvenience to the state, by fettering genius and preventing improvements in any particular art or branch of manufacture; for the prior patent, though useless, might stand in the way of improvement either by the comprehensiveness of its title, or some other cause.

Patent for an useless invention.

The existence of the patent in the first instance might prevent the attention of machinists or manufacturers being directed to that particular object; for an after-invention, if it trenches upon the claim of the prior patentee, could not be used without his license; and so if the discovery was the result of accident, still the useless patent would stand in the way, for possibly the patentee might demand such a sum for the use of his invention as would effectually prove a bar to its use.

(*f*) Jones *v.* Pearce, Web. 122.—As for infringing of patent for making carriage-wheels—declaration averred infringing—plea not guilty. At the trial the infringement of the plaintiff's patent was proved. On the part of the defendant it was contended the invention was not new, because wheels according to the alleged infringement were made by C. many years before, and publicly used near Derby for two years; that the wheels so made were put to a cart, which was used to draw great weights (30 cwt.), the spokes got bent, and the box or nave becoming broken, the cart was laid by; and that a pair also were used to a milk-cart. Patteson, J., in summing up, said, "If you are satisfied that C.'s wheel was upon the same principle in substance as plaintiff's wheel, and that it was used openly in public, and continued in use up to the time of taking out the patent, then that would be a ground to say that the plaintiff's invention is not new; but if you are of opinion C.'s was only an experiment, and did not answer, and was abandoned as useless, and *nobody followed it up*, and that plaintiff's invention which came afterwards was his own invention, which he perfected, then you will find for the plaintiff." Jury found for the plaintiff.—Vide Lewis *v.* Marling, supra.

It is apprehended the principle extends to this length: a patent obtained for a machine which was most ingenious in its parts, but entirely useless to effect the proposed object, would be void, even though it wanted, comparatively speaking, a very trifling alteration in its construction to make it a really ingenious and useful invention; the patent, being useless, and therefore void in its supposed perfected state, could have no relation to the after-discovery, and for that, the discoverer, whoever he might be, could take out a patent; but if a beneficial effect could be produced of the smallest kind, it would be a proof of the utility of the prior patent. The case of Neilson *v.* Harford (*g*) is precisely in point; it was proved that a benefit, but not at all to the extent contemplated, could be produced by following the specification, but by an improvement (which might have been patented subject to the prior patent) the principle was carried to perfection; it was held, the use of the improvement without the license of the prior patentee was an infringement of his patent. (*h*)

Patent for an useless invention, effect.

It is submitted that if an invention was proved to be entirely useless without the addition of a something else, the patent might be voided, on the ground of its want of utility, and that a subsequent improver, for his improvement, might take out a patent, taking care, though he uses the prior invention and recites it in his specification, to disclaim that as a part of his claim. (*i*)

(*g*) Supra.

(*h*) Vide infra, Specifications, as to the inutility of parts of an invention.

(*i*) It would not, it is conceived, be necessary that the prior patent should be repealed by *scire facias*, before the latter grant took effect; for on an action by the prior patentee, the utility of the invention could be brought in issue by a plea to that effect, and its utility or non-utility would be a question for the jury.

INTRODUCTION OF A NEW TRADE FROM ABROAD.

Introduction of a new trade from abroad.

The introduction of a new trade from abroad is an invention within the meaning of the statute,(*j*) though the articles, the production of such trade, had been introduced into England before; but there must have been no practising or using of the trade within the realm or its dependencies; so the introduction of a new machine is also an invention within the statute, and can be the subject of a patent.(*k*)

(*j*) Edgebury *v.* Stephens.—A grant of a monopoly (patent) may be to the first inventor, and if the invention be new in England, a patent may be granted though the thing was practised before beyond the sea; for if it be new here, it is within the statute—whether learned by travel or study, it is the same thing.—2 Salk. 446.

(*k*) J. and W. Lewis *v.* Marling, supra.

Bentley *v.* Fleming, 1 C. & K. 587. Case for infringement.—It was proved the invention, a card machine, was lent by the inventor to one N., in order to have its powers tested; the machine was placed in a public room, which was accessible to the workmen employed in the establishment, and that some weeks before its loan to N. it was in complete working condition. Upon this proof, it was submitted the plaintiff should be nonsuited, which the judge refused (Cresswell, J.). It was also submitted, as the machine was complete long before letters patent were taken out, the patent was void. "A man cannot enjoy his monopoly by procuring a patent after having had the benefit of the sale of his invention; but you cannot contend, that if a man were to keep his invention shut up in a room for twenty years, that circumstance merely would deprive him of his right to obtain a patent."—Cresswell J. (584.)

The reporter does not record the verdict, but it is apprehended, that the use in a public room is such an use as would be deemed a publication. If it had been used in a private room, under an injunction of secrecy, and one of the workmen had behaved falsely and pirated the invention, and disseminated a knowledge of its parts before the patent was obtained, such dissemination would, it is conceived, be such a publication as would make void the future patent. If so, with how much greater force would the argument apply to the exposure in a public room, where it was liable to be copied by any person who chose so far to trouble himself.—Vide supra, pages 53, 59, 63; infra, p. 78.

CHAPTER III.

TITLE OF A PATENT AND ITS LEGAL CONSTRUCTION.

Title.

HAVING considered what matters and things may be the subject of a patent, it now becomes necessary to treat of the patent itself. The first thing, therefore, to be done after the discovery of the invention is to entitle it, which is sometimes a matter of much difficulty; for as great care must be taken, in the selection of the title as in the specification, not to make the claim too large, (*a*) *i. e.* include

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(*a*) In the case of Neilson and Others *v.* Harford and Others (Webs. Pat. Ca. 333), Sir John Campbell, A. G., *arguendo*:—"Such of your lordships who have served the office of law officer to the Crown must be fully aware of the constant attempts that are made by those who apply for patents to produce a title that may entirely mislead—that may not give the remotest notion of what they intend, and which may enable them for six months, or whatever period it may be, to gather together whatever they can collect, and to specify it at the end of that period. Great frauds have been committed upon that subject, and it would be a most salutary decision, and most wholesome and beneficial, if your lordships were to lay down a rule that the title of a patent should at least convey some idea of the invention for which the patent is supposed to be granted. Until there is a judicial decision upon that subject, I am afraid that all the efforts which may be made to resist these attempts will be entirely ineffectual." Lord Abinger, C. B., in reply, said, "If the specification is consistent with the title, it would be sufficient." The Attorney-General continued, "It would not be necessary to disclose the mode by which the invention was to be effected, or fraudulent persons who have patents in progress would specify those inventions." Parke, B., said, "It would be for the Crown to adopt that (the suggestion of the Attorney-General), by requiring the specification to be enrolled within a less period than six months."

It would be a great preventive to fraud if it were required that the specification should be enrolled when the patent is obtained.—S. B.

within it matters before known to, or which have been in use by, the public, or to which the invention will not apply.(*b*) Yet, at the same time, care should be taken to have the title sufficiently large to embrace all matters which can fairly be brought within the scope of the invention,(*c*) not only for the purpose of securing the fruits of the invention to the discoverer or introducer, but to prevent infringement by such imitations as the law would not decree to be merely colourable, (*d*) whereby the patentee would be deprived not only of the profits of his invention, but the

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(*b*) Felton *v.* Greaves, infra.

(*c*) Neilson *v.* Harford, supra. Parke, B. (addressing jury).—"It is said the title of the patent renders the patent void, because no one would conclude from that title (a patent for the improved application of air to produce heat in fires, forges, and furnaces) that the invention was the discovery of a process for introducing hot air into a furnace. My opinion is, that the title is not defective, and that it is capable of embracing an alteration by introducing hot air. It will suit one or the other, and the patent and specification together make it clear what it was; it was the introduction of hot air by means of heating it before it was introduced into the furnace between the blowing apparatus and the furnace, and unless this title has been meant to be applied to some other discovery of a quite different nature, and by the specification afterwards applied to this, it does not appear to me that the generality of the title would make the patent void;" and in delivering the final judgment of the Court, after a long argument at bar, his lordship said, "though the title is ambiguous, it is sufficiently explained by the specification, and is not at variance with it."—Ib. 373.

(*d*) As if the title to a patent expressed it to be a patent for certain improvements in watches, the invention being applicable to time-keepers generally, the patent could only be held to extend to watches; and if the specification extended the invention to time-keepers generally, it would be void, as not according with the title; but now, by the operation of the stat. 5 & 6 Wm. 4, the patentee could disclaim the latter part of the specification relating to time-pieces, and the specification would be good for the prior patent.—Vide Disclaimer, infra.

time and money which he may have expended in perfecting the same would be entirely lost.

Vagueness of description.

In the case of the King *v.* Wheeler, the title described the patent to be a new and improved method of drying malt; when the patent, as it appeared by the specification, was for a method of giving to malt when dried a new quality, viz. a power to impart colouring matter, for which misdescription the patent was held to be void on the ground of deceit.(*e*) The case of Cooke *v.* Pearce, in error,(*f*)

(*e*) Rex *v.* Wheeler, 2 B. & Ald. 345.—Malt was an article in common use before the patent, possessing qualities, &c. well known; by the specification the patentee claims to be the inventor, not of a method of drying, &c., but of a method of giving to it when dried some properties which it did not possess before, or only in a very slight degree, viz. qualities of colouring and being soluble in water. (351.)

In general the purpose of a patent need not be mentioned in a grant; but if the mention of the purpose be necessary to explain the words previously used, to shew they are not used in their ordinary and obvious sense, but in a sense limited and confined to that particular purpose; in such case, we think, the purpose ought to be mentioned. (352.)

(*f*) Cooke *v.* Pearse and Another, 13 Law Jour. N.S., 189, Q.B. Error. Case for infringement of patent for improvement in carriages.—The sixth plea set out specification, and alleged, that though in the specification, the invention was called an improvement in carriages, it was not, but only of certain improvements in fixing and adapting German shutters to those carriages in which only German shutters are used, and which was the finding of the jury; and the question was, whether, by reason of the title being too large, the patent was void. The Court below held the finding to be in favour of the defendants, and gave judgment accordingly, on the ground of the title being too general, therefore the patent itself must be void. "This vagueness appears to be an objection, which may well be taken advantage of on the part of the crown, before the grant, but can afford no ground for voiding the patent. Any evidence of design on the part of the inventor, by the choice of a vague and general title to avail himself at the time of enrolling the specification of an invention not discovered by him at the time of taking out the patent, or to prevent others from making or availing themselves of

appears to be directl pposed to the doctrine of Rex *v.* Wheeler. Tindal, C.J., held that vagueness was a matter for objection before the grant of letters patent, but no ground for voiding the patent.(*g*)

In the case of the King *v.* Metcalf, it was held a title describing an invention as a tapering brush, which proved to be an expanding brush, with hairs inserted of unequal height, was a variation, and the description insufficient to support the patent.(*h*)

Title, of what it should consist.

From these observations and cases it will be gathered that the entitling the invention is a matter upon which the greatest care should be bestowed; for the benefit to be derived from the invention is often defeated by a misnomer, and which may arise from ignorance of the meaning conveyed by the terms used, or from an avaricious grasping at

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any discovery, on the ground of falling within the general terms of the title, though differing from that for which the patent was taken out, might afford such proof of fraud and injury as to avoid the patent." Judgment for plaintiff, *non obstante veredicto*.—Tindal, C.J., judgment of, &c.

(*g*) Both these cases were claims of general, instead of particular titles. In the prior case the proceedings were by *scire facias;* in the latter, action on the case for an infringement. It is presumed the distinction is to be traced to the different manner in which the patent law is now construed. Formerly the endeavour was to overset patents as being monopolies, and contrary to the spirit of the common law; the present, that they may, if possible, be upheld.

(*h*) Rex *v.* Metcalf, 2 Starkie, 246.—*Sci. fa.* to repeal a patent for manufacturing of hair brushes, which were described to be tapering brushes. The specification stated the process to differ from the common method, by placing them in the stock in such a manner as to be of unequal length. (250.) If the word tapering is to be used in the general sense of the word (which is converging to a point), the description is defective: if, by the usage of the trade, it have a different meaning, it may be received in its perverted sense (which was not proved). Verdict for the Crown.—Ellenborough, C. J. (248.)

too much, or from an over-care in not claiming a title sufficiently extensive to protect the patent when obtained.

Choice of a title.

It is, therefore, suggested, a sound practical title should be such an one as, without being too restrictive in its terms, would be sufficient to warn the public of the probable object of the invention, but yet not be enough to indicate the mode by which the invention was to be carried into effect.

Protection against fraud, it is trusted, will ever be deemed a sufficient reason for construing any particular point or matter of law with strictness, and perhaps no subject presents such temptations or facilities for fraud as that of the entitling of patents.

Necessity of a strict construction of the title.

The title of a patent, from the great importance of its object, and as being opposed to the common right, is a matter which should be construed with the greatest strictness; for it is only by such a mode of construction the ingenious mechanic or fortunate discoverer (and the public) are protected in that which is on the one hand the produce of his ingenuity and skill, and on the other, though resulting in accident, the adaptation of a chance to a particular use, through analogy and the quickness of intellect. This position was particularly illustrated in the case of the discoverer of the water-tabbies, for doubtless the effect created by placing a hot iron upon a wetted surface had occurred thousands of times to the unobserving and unthinking; but when the effect was accidentally produced before the eye of an intelligent mind, it was a result which was seized upon, and led to the realization of a large fortune.

Vague title.

Where an inventor adopts such a title as may afford a reasonable ground that his intention is to receive and avail himself of any hints which might be presented during the time allowed for the specification, whether such matters were within his intention at the time of applying for the

patent or not,(*i*) it is right that the title should be canvassed with strictness, for it is impossible to distinguish between an intended fraud and a vague title. If a really innocent party, from over anxiety, falls into the dilemma, it is a matter which, though it may be a subject of regret, should not have any effect on the construction of the law, for his misfortune may be said to be the protection of the public.

Evil of adopting a vague title.

By the adoption of a vague or incomprehensive title, an inventor works wrong to himself; for if he had entered a caveat against the grant of another patent upon the particular matter of his invention (the title of which did not embrace, as in the case of Rex *v.* Wheeler, (*j*) the matter he intended to specify for), no notice would be given to him of another application for a patent which was of the same character as his invention, the crown officers having only his title for a guide.

If (in the one case) the title was entered before the invention was complete, and another person applied and obtained a patent for the same subject, the original party would be forestalled; for if his title was incorrect, his caveat would afford him no protection, and he would receive no notice of a matter which really affected him, and he might go on expending his labour and time in experimentalizing, and his money in obtaining a grant, both of which would be thrown away (unless he discovered some really new feature, which of itself was sufficiently important to form the subject of a patent), for, in consequence of his erroneous title, another person may have obtained a patent for the same subject, and which would make his void; so in another view,

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(*i*) An instance of this occurred recently within the knowledge of the author; but as the subject is likely to be a matter of future litigation, it is deemed prudent to be silent.—S. B.

(*j*) Supra.

the vagueness of his title might tend to injustice by leading on other persons to prosecute researches, the subject of which was to constitute the prior patent, but which would not be known until the enrolment of the specification. Good faith, even in the selection of a title to a patent, it will be seen, is a matter which generally conduces to the advantage of the inventor, though a contrary course is sometimes successful.

As the title to a patent is a matter of such great importance, not only as regards the future stability of the right, but also in protecting the inventor in the initiatory proceedings, it therefore should be adopted only upon the nicest deliberation, and under the advice, in all cases, of competent persons, for often the very right to the invention depends upon the title chosen.

A caveat is sometimes entered before the intended title is actually assumed; it will form the subject of the next heading.

CHAPTER IV.

CAVEAT, ENTRY OF—PRACTICE PURSUED UPON NOTICE BEING GIVEN OF AN ANALOGOUS INVENTION—COSTS OF.

A CAVEAT is an instrument which is entered at various stages of the proceedings instituted for the purpose of obtaining a grant of letters patent, and can be entered at any time before it receives the impress of the great seal at the hands of the Lord Chancellor. Caveat, what.

The description of caveat which is in the most common use is that termed the GENERAL CAVEAT; it will be necessary particularly to treat of it, not only because it is usually the first step taken towards the obtainment of the grant, but also on account of the erroneous and often dangerous notions entertained of the security which is obtained by its use. It confers no actual protection; its obtainment does not warrant the public exhibition of an invention, its mere effect being to entitle a person to notice of any application for a patent referring to any object or intention similar to that *expressed by the title* of the invention lodged. It may be renewed as often as required in England, Scotland, or Ireland, and on its issue continues in force twelve months. General Caveat.

When a caveat has been entered, notice is given to the party entering it of any application for a patent for a matter of a similar character, to protect which the caveat was obtained. The course of proceeding is, upon receiving notice to attend at a time appointed for the hearing by the attorney or solicitor general: the respective parties and their agents then meet. The applicant for the patent first shews the Practice.

particulars of the invention for which he seeks a patent; the opposing party then states the nature of his invention, and sets forth the matter upon which he grounds his opposition. If the inventions are similar, the patent applied for is stopped, and the parties are recommended to make terms amongst themselves, or to agree upon taking a joint patent; if the attorney or solicitor general does not recommend a compromise, the practice is usually as follows:—The person seeking the patent deposits with the attorney or solicitor general a clear description of the particulars of the invention for which he seeks to obtain the patent, which, when deposited, is sealed up, and kept by the Crown officer, as a guarantee to the opposing party (*i. e.* he who has lodged the caveat), that the intending patentee will, when his specification is due, specify in accordance with the description deposited at the time of opposition. Without this precaution, great frauds might be practised, as a party might purposely, by the generality of his title, misrepresent the nature of the invention; and when the time to specify came, he might do so in such a manner as to include the invention, to protect which the caveat is lodged; in such case, if the patent obtained did not confer on the person obtaining it the right to the invention, it would, at least, deprive the other of his right; for the specification, when lodged, would be a publication to the world, and it is doubtful whether the caveat would have the same force as a patent to protect the first inventor.

Caveat, where entered.

This caveat is entered at the chambers of the legal advisers of the crown (at the chambers of the attorney or solicitor general), the object being, that they shall not give the report which is necessary in favour of any grant for a similar object or purpose to that stated in the description given in on entering the caveat, without apprising the person entering the caveat of the application made, who may

thereupon attend, and oppose the passing of the patent: and if, on the hearing, it is decided that it interferes with the prior intended patent, it will, unless terms be made, stop the latter altogether.

By putting a hypothetical case, a succinct view may be obtained of the use of a caveat, and the practice thereon. Thus A. has invented *an improvement on the steam-engine*, and he being prevented by circumstances (as want of money, or non-completion of the experiments necessary) from taking direct steps to obtain the grant of letters patent, to prevent any one forestalling him, enters a caveat against the passing of the report in favour of the grant of any letters patent for "improvements in steam-engines;" in the meantime, with the assistance of certain workmen, and others, bound to secrecy, he carries on his experiments in order to test his invention. In a short time he receives a notice, that B., whom he has reason to suppose has become acquainted with his secret, is applying for letters patent for the same object. A. determines to oppose him; he receives notice of an appointment for hearing the matter from the crown officers, at the expiration of *eight* days from the date of his notice, at which time both of the parties appear before the proper officer named therein; then each party state their several reasons for and against the grant, &c. &c.

If the object of the patent is the same, and one of the parties is able to prove that he is the first inventor, the other will then be stopped altogether from proceeding; and, if necessary, bound over not to disclose the invention until the true inventor has obtained his letters patent. This will, on consideration, be found to be a most equitable rule; for it might be, B. was experimentalizing, but did not, for some reason or other—as reliance upon his assistants, or other causes—choose to enter a caveat, and the secret was

course followed by the crown officers.

communicated to A. by some one in the confidence of B.; therefore, if A. merely for entering the caveat was esteemed the true inventor, it would be working a great injustice to B., though he who enters the caveat has doubtless the advantage, if any, because fraud would not be presumed unless such circumstances were adduced as would amount to something more than mere suspicion.

Coalescing.

When the law officers recommend a coalescing, or, as it is termed, interfere, the recommendation may be said to be a command; for on refusal, it is doubtful whether either would obtain the necessary report; for a patent is not a thing which can be claimed as of right, but is a grant *ex gratia domini regis*.

Inventions differing.

If, on the hearing, the improvements are found to be essentially different, then, of course, the party obtains the necessary report.

Caveat, use of.

Though a person has obtained a caveat, he must be as careful of disclosing his invention as though he had none; for if his secret is suffered to transpire, his intended patent would be void for want of novelty. The whole use thereof is to prevent another person obtaining a patent for the same thing over the head of him entering it. It is useful for this reason; there is no other mode of obtaining notice of the application for a patent by another person, the law generally recognizes the title to be the right in him who first *obtains* letters patent—not in him who first *applies* for them.

Costs of entering the caveat.

The cost of entering this caveat is one guinea for each of the three kingdoms, and is in force twelve months, and the cost of opposition is usually 4*l.* 10s.

Opposition, when best to be entered, and the expenses.

The usual and cheapest stage of opposition is at the report, for which the costs are as above, but they may be opposed at later stages; the next is when at the Bill-office. In this case, the opposing party has to pay the ex-

penses on both sides, which in the case of *no interference* (*i. e.* no recommendation) amounts to about 10*l.*; but if there is any interference so as to cause the stoppage of the intended patent, the opposing party has to pay 30*l.*, being the ordinary expenses of opposition on both sides; also the extra fees and expenses incurred by the applicant since the ordinary period of oppositon, which is before the issue of the report by the attorney or solicitor general.

A patent also may be opposed at the Great Seal; (*a*)

(*a*) Fox ex parte, 1 Ves. & Bea. 67. Application for a patent on steam-engines.—A caveat was entered under an existing patent, from which it was alleged the new patent was borrowed, and with which it would interfere; the affidavit of an engineer stated, they were not the same, or in any respect resembled each other. "If petitioners have invented certain improvements on an engine for which a patent has been obtained, and which cannot be used without the original engine; at the end of the period of the original patent, the petitioners could use their patent (taken out upon their improvements), though, before the expiration of the period, they have no right to use the other's substratum. At the end of the time, the public has a choice between the patents; my present opinion is, this patent must go."—Lord Eldon. The costs of the opposition were not allowed, for the jealousy was not unreasonable.

Cutler's Patent, Webs. Pat. Ca. 418.—Proceedings were on petition to the Lord Chancellor to affix the great seal to letters patent (against which a caveat had been lodged), which was for an improved method of constructing chains for suspension-bridges, cables, mining and other purposes, and for an improved method of making the bars, links, and bolts thereof. There had been no opposition on the caveat, and the patent would have been engrossed and sealed on the 12th; on the 11th, notice was received of a caveat having been entered on the 9th, whereby patent was stopped on 12th. A petition was presented that the caveat might be discharged; the opposer filed an affidavit stating he had invented a chain, which he believed petitioner to have pirated. On hearing, Lord Cottenham, Chancellor, directed a reference to the attorney-general, and if he replied the patent ought to issue, then the same should be sealed as of the 12th of March, but not to be sealed until further orders; question of costs to be reserved. At the hearing before the attorney-general, each produced a model; the applicant admitted there was no

the matter then comes under the cognizance of the Lord Chancellor, and is decided upon its merits, the question of costs resting with the Court; but generally, unless in cases of vexatious opposition, both parties have to pay their own costs; and unless the opposing party succeeds in his opposition, the patent is ordered to bear date on the day it would have been dated, had no opposition at the office of the Great Seal been entered. (*b*)

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similarity, but attacked the novelty; the attorney-general decided the patent should be allowed, but required an outline of the specification should be left with him, which was, and he required a further specification, which was supplied by certain drawings. Opponents obtained another hearing before the attorney-general, on statement that the drawing exhibited of the patent which was produced, impeaching the novelty, was not correct; and on examination of the original specification, it appeared the invention for which Cutler applied was old; on hearing this, Cutler had some models made, and requested the attorney-general to see the models before making the report, which he refused to do; he reported the invention should not issue because it was not new and useful, and certified the refusal was upon different ground from that for which the caveat was lodged, and that it was not until the second meeting the party objecting to the said patent was prepared to substantiate the ground of objection thereto. "The first proposition was not supported; but in discussing the matter between the parties, an objection of a general nature is raised not growing out of the patent right, but an objection to the patent on two grounds—First, it is not new; secondly, not useful: if useless, it would interfere with no man's rights—it would be a mere dead letter." His lordship continued: he thought the invention was useful, and directed, after commenting at great length upon the difference of the patents, that the patent should be sealed.—Supra, et vide Ex parte Henson, in re Alcock, 2 Newton's Lond. J. Cong. Ser. 32.

(*b*) In Ex parte Bech (1 Br. Ch. Ca. 578), a caveat had been entered against putting the great seal to a patent bearing date 12th August. Thurlow, Chancellor. His lordship took time to consider, and on the 27th dismissed the caveat, and patentee did not enrol his patent until 18th of December, supposing the patent would bear date from the final order. When he was told the time for the enrolment had elapsed (four months), on application to the Chancellor, he

Opposition may be entered at the Great Seal, not only because the allegation in the petition is that the inventions are the same, but also if the grant is against public policy.

In the time of Lord Chancellor Eldon a case occurred where the patent recited that the specification should not be entered until fifteen months after the grant of the patent, and this was held to be a good ground of petition. (c)

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said, though he was perfectly satisfied the applicant was entitled to the patent, yet he could not, as keeper of the great seal, alter a patent upon an application of this sort, though perhaps on the petitioner applying for a new patent the officers might remit their fees, but that he could give no relief.

(c) Ex parte Heathcote, in re Lacy, Webs. Pat. Ca. 431.—Application prayed the Court would not affix the great seal to a patent which gave a party fifteen months to specify: it was contended the matter was of great importance in a national point of view; his lordship refused, saying, "The patent could not pass without the responsibility of the Great Seal, and if he could bring himself to pass it, he might be called upon in his place in parliament to say why he had extended this privilege to an individual contrary to the usual policy of law."

CHAPTER V.

PATENTS, HOW OBTAINED, AND WHO MAY BE THE GRANTEE.—PRACTICE.

HAVING explained what a patent is, and for what it may be granted, it becomes necessary to explain the way in which it is obtained, and what manner of person is entitled to the privilege.

Patents not demandable as of right; how obtained.

Patents are not matters which are demandable as of right, but may be granted or withheld in the discretion of the Crown, though, if the attorney or solicitor general make the necessary report, the grace is never refused. It is upon the suggestion of the party that the patent is granted: without examination (unless a caveat has been entered against the particular invention), and he of course has to take all risk and to support the patent at all points, viz. that in all things he has complied with the requisites of the law, and that he has not infringed upon the public right. If for any laches, infringement, or other reason, the patent is afterwards avoided, the patentee has no remedy, and the money he has expended in obtaining the grant is forfeited; it therefore behoves a person to examine well the various matters connected with his invention before he applies for a patent.

Persons entitled to apply for patents.

The persons who are entitled to apply for patents are the first inventor and improver upon an invention, who may be said to be an inventor, at least of the improvement; and the introducer of a foreign invention, which last is in virtue of the statute of 21 of Jac. 1. (*a*)

(*a*) Brunton *v.* Hawkes, supra.—Upon an application for a

The quality required, is, that the invention be a manufacture, which may be divided into mechanical contrivance, and the elucidation of a principle, method, or process, embodying them and shewing a mode of applying them to some art or manufacture. The quality of the invention.

The conditions required are—novelty, utility, and an exposition of the mode of effecting the particular invention, all of which have been treated of excepting the latter, for which, see Specification; (*b*) and therefore it will be unnecessary, unless incidentally, to speak more of them. Conditions of the grant.

A patent is a grant, and therefore follows the rules of law relating to grants—a necessary consequence of which is, that if any false or untrue averment be made in the suggestions upon which the grant is made, it (the grant) will be void for deceit. A patent is a grant.

A very common and dangerous custom as far as regards letters patent exists, and is in very general use:—a man who is poor invents, and another having money, but who does nothing to further the process of the invention, joins with him, and the patent is obtained and issues in their joint names, and upon the suggestion that they jointly invented, &c. Such a suggestion not only voids the patent upon the ground of fraud and deceit, but it is presumed would subject the party to an indictment for perjury; for a declaration is made that they are the *first* and *true inventors*. Joinder of the name of a person in the grants, not an inventor, avoids the patent.

This practice is also bad as regards the property itself, and tends only to defeat its very object; as in the case of an infringement, the patent would be unprotected, for the plea that they did not invent would directly put in issue the

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patent, though the thing may be new in every particular, it is in the judgment of the Crown whether it will or not, as a matter of favour, make the grant to the person who made the discovery.—Bailey, J.

(*b*) Infra.

question who were the inventors, and if it was proved that one only invented, the grant being joint, the patent would be void, for the patent is an entire thing, and granted upon a falsehood of which both were cognizant, therefore, ignorance could not be urged in extenuation, and would not be allowed (it is conceived) even on a petition to the Privy Council to confirm the patent, for the office of the council is not to encourage frauds, but to confirm useful inventions of which there has been a prior publication, the inventor being in ignorance thereof. Nor could the action be brought for the infringement in the single name of the true inventor; for the defendant would plead the non-joinder of the other person in abatement, and even if advantage was not taken then, the parties at the trial would be defeated on the ground of a variance.

We have seen in the prior discussion (and shall further when the proceedings upon a *scire facias* come to be discussed), that a patent will be voided if the party is not the true inventor, and that where it is proved he discovered all the process, except one particular and important part, as in the case of Tennant, (*c*) where it was proved a chemist had suggested to him that to perfect his invention it would be necessary to keep the lime-water in motion; it was held such suggestion proved he (Tennant) was not the inventor. If then in the case of an inventor of a greater part of the process, such a suggestion should have weight, how much greater would be its effect in the case of a person who has not invented or forwarded the invention in any way, except by advancing money. It will be admitted the advance was for a meritorious object, viz. the advancement of manufactures, and consequently, commerce, still it would not, and indeed should not be, any shield for duplicity and deceit.

(*c*) Supra.

Persons advancing money in aid of inventions shouid secure themselves by taking an assignment of the patent obtained in the name of the real inventor, and not destroy the property of both by an over anxiety: the advance is secured by the assignment, and by that mode only. Persons advancing money to aid inventors.

PRACTICE.

In applying for a patent, no specific description of the nature of the invention sought to be protected is required, such general information as expresses the object and intention of the invention is sufficient, (*d*) but such object and intention must be clearly expressed. The inventor having fixed upon the title, the first step in the matter is to go before a master in chancery and declare that he is the inventor of the improvement as set forth in the title, and that he believes the same has never been known or practised before; and if the patentee states in his declaration that he intends to apply for patents in Scotland and Ireland (which if he find afterwards would not be to his advantage, he need not take), he will be allowed the full term of six months before he specifies, or otherwise some shorter period, as two months, will be allowed. This declaration has to be annexed to a petition to her Majesty to the same effect. Practice. Declaration.

Though patents in all of the three kingdoms, namely, England, Scotland, and Ireland, are governed by the same law, yet they are conferred by separate instruments, and the practice varies in each of the kingdoms.

In England, the declaration is annexed to a petition to her Majesty praying the grant of her royal letters patent, England.

(*d*) See title, supra.

which is laid before the Secretary of State. This document is obtained again in a few days, with a reference upon it addressed to either of the law officers of the Crown. It is at the option of the applicant for letters patent to whom he will take it. The papers remain in the chambers of the Crown officer for a week, to give an opportunity to those who have entered caveats (*e*) to come in and oppose. Should there be no opposition at the expiration of that period, a report in favour of the grant may be obtained.

The report.

The report, when obtained, is taken to the office of the Secretary of State, for the warrant, which is signed with the Queen's own sign-manual, and sealed with the private signet, (*f*) and countersigned by the Secretary of State.

The warrant.

The warrant is then taken to the proper office for the preparation of the bill (a draught of the letters patent), which is signed by one of the law officers of the Crown.

The bill.

This bill is then taken to the office of the Secretary of State, where it receives the royal sign-manual, and is called the Queen's bill.

The Queen's bill.

The Queen's bill is then taken to the Signet Office; here the signet bill is prepared (a copy of the Queen's bill under the signature of one of the clerks of the signet, sealed with the Queen's signet).

The signet bill.

The signet bill then goes to the Lord Keeper of the Privy Seal, who affixes the privy seal, with a warrant directing letters patent for the same.

(*e*) Vide Caveat, supra.

(*f*) The law notices three seals of the king,—the great seal, the privy seal, and the signet; and if mention be of the king's seal generally, it shall be understood of the great seal, which is in the custody of the Lord Chancellor; the privy seal in the custody of the clerk, or lord keeper of the privy seal; and the signet in the custody of the principal secretary, who has four clerks of the signet.—Com. Dig. Patent, c. 1.

This privy seal bill is taken to the Lord Chancellor's office, which is the final stage; formerly it afterwards went to the Hanaper Office; this is dispensed with, though the fees are still exacted. Privy seal bill.

The date of the letters patent (which is usually the day of sealing the same)(*g*) is the commencement of the right; and here it may be remarked, that in case special circumstances may require it, the Lord Chancellor can cause this document to bear date the day of receiving the privy seal warrant, but not earlier. The date of the letters patent.

If the applicant requires the patent to extend to the Colonies and Channel Isles, he must state the same in the report; the additional expense is about 10*l*. Extension of the patent to the colonies.

(*g*) Russell *v.* Ledsam, 9 Jurist, 557.—In order to decide whether an invention is new, it is necessary to define of what nature it was; and which was decided in the case of Russel *v.* Cowley (1 C. M. & R. 864). The original letters patent were dated 26th Feb. 1825, the second 26th Feb. 1839; the question is, is the day of the date of the first letters patent inclusive or exclusive? The usual course in recent times has been to construe the day exclusively, whenever any thing is to be done in a certain time, after a given event or date; and, consequently, the enrolling a specification within six months, given by the proviso, is reckoned exclusively of the day of the date. (Webb *v.* Fairmaner, 3 M. & W. 473; Young *v.* Heggon, 6 M. & W. 49.) The day of the date of a patent is included, and the patent would expire at midnight on the 25th day of Feb. 1839; for the law never notices fractions of days, unless there are conflicting rights between subjects. A defendant, in order to avail himself of the proviso (7 & 8 Vic. c. 69, s. 7), should have pleaded that the petition was not prosecuted with effect within the term of the first patent; compliance with the condition need not be averred by the plaintiff. The power of renewal is not confined to grantees, but extends to assignees (the defendant doubted the construction put upon the clause by some of the judges, in the case of Spilsbury *v.* Clough (2 Q. B. Rep. 466), viz., that the words referred to the assignee of a foreign invention, who obtains a patent here); the clause, we consider, has been introduced for the sake of removing all doubt as to the title of an assignee of a renewed patent, leaving the question, as to the titles then in litigation, exactly as it stood before.

Time taken to obtain letters patent.

The time taken in obtaining letters patent is from one month to about six weeks, and the expense 110*l.*

Scotland.

In Scotland, the proceedings for obtaining letters patent are commenced in the same way as in England, but the reference is addressed to the Lord Advocate, and must be transmitted to him at Edinburgh, where it rests about ten days; upon receipt of his report it is taken to the Secretary of State's office, and the Queen's warrant is then prepared, which is a substitution for the Queen's bill, and is the warrant for the grant of letters patent, which are passed at Edinburgh under the seal appointed by the treaty of the union to be kept and used in the place of the great seal of Scotland.

Time required, and expense in obtaining a Scotch patent.

The time for passing a Scotch patent is about six weeks, and the expense about 75*l.*

Ireland.

In Ireland the routine of practice is principally performed in Dublin. The first step is a similar petition to the Lord Lieutenant of Ireland, praying him to recommend to the Queen the granting of letters patent. On his report the Queen's letter is granted, which is the corresponding document to the Queen's warrant; this goes back to Ireland, and the letters patent are granted under the great seal of Ireland.

Quære, is not the report made by the solicitor-general of Ireland?

Time required, and expense in obtaining an Irish patent.

The time required for obtaining an Irish patent is from six weeks to about two months, and the expense since the New Stamp Act, 135*l.*

CHAPTER VI.

SPECIFICATION, NECESSARIES TO—CONSTRUCTION IN LAW—ENROLMENT AND AMENDMENT.

Patent a grant.

A PATENT being a grant, it must necessarily proceed from favour, therefore, not being demandable as a right, the Crown, on making the grant, can annex thereto such conditions as it pleases. One of the conditions which the Crown annexes, on making the grant, is that the grantee shall, within a certain period, specify (which period varies according to circumstances), (*a*) *i. e.* enrol in the High Court of Chancery a detail of the process by which the object of the patent is effected, and which must be so clear and explicit (*b*) that an ordinary workman, engaged in the particular trade in or of which the invention is an improve-

Construction of the specification.

(*a*) Supra, Mode of obtaining Patents.

(*b*) Liardet *v.* Johnson, B. N. V. 76.—"The meaning of a specification is that others may be taught to do the thing for which the specification is granted; and if it be false, the patent is void, for the meaning is, that after the term the public may have the benefit of the discovery."

Boulton *v.* Bull; Hill *v.* Thompson, 3 Merev. 630, S. P.—Whether a mechanical improvement is intelligibly specified, a jury must be the judges; whether he calls it a principal invention, or method, or other appellation, we are not bound to consider his term, but the real nature of the improvement, and the description he has given of it. Articles of specification which denote intention only, would not maintain an action, for he cannot anticipate the protection before he is entitled to it by practical accomplishment.

Lewis *v.* Marling, supra.—If he represents several things are necessary to produce a certain effect, and one will answer, it is bad; and if he suppresses any thing which he knows will answer, it is also bad.

ment, may, by means thereof (without first experimentalizing), make the article for which the patent was obtained ;(c) or, if the patent be obtained for a process—carry it out by means thereof; if for a principle—apply it in the mode pointed out by the direction or specification.

Grant of letters patent, what.

The grant of letters patent may, in truth, be considered as a bargain on the part of the Crown, acting for the public and the inventor, that, upon his making a full disclosure of his secret, he shall enjoy a monopoly of his invention, and be protected therein for a period of fourteen years.

Specification, use of.

The specification, "which must embrace two objects—the nature of the invention and the manner in which it must be performed,"(d) is requisite not only for these pur

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(c) Boulton *v.* Bull, supra.—The term manufacture in the statute precludes all nice refinements, and shews the proviso was introduced for the benefit of trade, and that which is the subject of a patent ought to be specified. His lordship, speaking of the patent then under consideration, said, "This patent extends to all machinery that may be made on this principle, so the patentee has taken a patent for more than he has specified ; and as the subject of the patent is an entire thing, the want of a full specification is a breach of the conditions, and avoids the patent ; the patent and specification must contain a full description. If it appeared that a mechanic could not, from the specification, make an engine with equal effect, or if it required experience and experiments before it could be done, either of these facts would avoid the patent."

(d) Per Best, J., Brunton *v.* Hawkes, supra.

Gibson and Another *v.* Brand, Webs. Pat. Ca. 629.—A specification should be so clearly worded, as to lead, without doubt or difficulty, to that result (enabling a person of competent knowledge in the manufacture, to make the article from the specification); because it is the price that the man who takes out his patent pays the public for their being so long kept out of the enjoyment of the commodity or manufacture that is protected. Therefore every man who is an honest man, is bound to pay that price justly and fairly, and to word his specification in such a way as to be clear from all doubt. —Tindal, C. J.

Campion *v.* Benyon, supra.—With respect to patents, every

poses, but also that it may be a record of what matters in the particular art or manufacture have been effected, and to serve as a safeguard to the public, that the inventor is not pirating a privilege which was public property, either by publication, by user, in books, or by specification. (*e*)

By a reference to the words of the letters patent, (*f*) it will be seen that the Crown does not merely provide for the fulfilment of this bargain, but requires the patentee shall give a more full description of his invention than his title contains, and appoints a time for the lodgment thereof, evidently intending to mete out the bounds of the invention and to protect the public in the enjoyment of that which they already possess, (*g*) and to warn future inventors against infringing upon the rights thereby granted.

Period of the invention of the clause for enrolling patent.

The origin of the introduction of the clause into letters patent respecting the specification and its enrolment, is not with any certainty known; in the early patents it is not introduced; but those who were in possession of such an exclusive privilege were compelled to take apprentices, that the art, the subject of the letters patent, might be perpetuated, and that the public might have the advantage thereof. The introduction of the clause seems to take date about the time of the

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patent, being a monopoly, is an infringement of public right. If the instrument contains any ambiguity on a material point, it is a ground on which it may be avoided altogether.—Dallas, C. J.

Lewis [illegible]arling, supra.—To support a patent, specification should ma[illegible] a full and fair disclosure to the public, of all that is known respecting his invention; if it does not, the condition upon which he obtains his patent fails.

(*e*) Supra, Publication. (*f*) Vide Appendix.

(*g*) Gibson *v.* Brand, supra.—A party who obtains a patent is bound clearly to define in his specification what he claims as his invention, that the public may know with certainty what they may or may not do, without incurring risk of an action for the infringement of a patent.—(890) Cresswell, J.

reign of Queen Anne, for from the middle of her reign it appears to have been an usual clause in the letters patent then granted, and has been continued ever since, and is recognized by the statute 5 & 6 Wm. 4, c. 83.

Sufficiency of the specification a matter of the greatest importance.

From what has been said it will be gathered that the sufficiency of the specification is a matter of the very greatest importance, and care must be taken not only fully to set forth the *modus operandi*, but also that no previously known matter is assumed, the difficulty in which respect is aided by the 5 & 6 of Wm. 4, c. 83. (*h*) Still it is a subject of the greatest importance and difficulty, and it is therefore a matter of urgent necessity that the patentee should become acquainted with all which has been done before, or written upon the particular object of his invention; for an idea, which is to him entirely new, may, in various forms, have been the subject of a dozen patents, or may be, or have been, in such use (without being patented) as shall in law be deemed a publication; or it might be that the invention is an addition to something old, or another mode of effecting the object of an existing patent, and be what the law terms a merely colourable difference. (*i*)

Great care necessary in preparing the specification.

It will be seen great care must be taken that the manner by which the object of the patent is effected shall be accurately stated, (*j*) and in sufficient words; where the word

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(*h*) Vide infra, Disclaimer. (*i*) Supra, Infringement.

(*j*) Hill *v.* Thompson and Foreman, 2 Moore, 424, and 1 T. R.—A slight departure from a specification for the purpose of evasion only, would be a fraud on the patent, and the question "would" be whether the mode of working has or has not been essentially or substantially different; and if the mode of effecting a patent be essentially different from the specification, the patent is void. Whenever a patentee brings an action on his patent, if the novelty or effect of the invention be disputed, he must shew in what his invention consists, and that he produced the effect proposed by the patent, in the manner specified. (Aling. 1 T. R. 607, et seq.) Slight defects in the

improvements is used, and it is proved that only *one* improvement is introduced, and it is shewn that the use of the word in the plural instead of the singular number was not for the purposes of fraud, such an objection will be overruled. (*k*) The plainest and easiest words should be chosen, and if a mystery is assumed and a difficulty presented where none really exists, and a difficult process pointed out as necessary to prepare the ingredients to be used, when they in the proper form (that is, in the form necessary to effect the object of the patent) are in common use, and may be purchased at any shop selling the particular character of article, such prolixity or rather mystery will be fatal. (*l*)

Prolixity in a specification.

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specification would be sufficient to vacate the patent; words in a specification directing the public to continue the heat, until the effect was produced, which must necessarily lead to fusion, are insufficient; for the specification should have shewn by what degree of heat the effect was to be produced.

(*k*) Nichols *v.* Haslam and Others, 8 Scott, 97.—Case: infringement of a patent; improvement in manufacturing of plaited fabrics, declaring in usual form. The fifth plea set out the specification, and concluded by stating that the specification and a copy drawing thereunto annexed were all, &c. Verification; to which was a general demurrer.—It was contended that the title of the letters patent was too large; it described them as granted for improvements in the manufacture of plaited fabrics, whereas there is but a single improvement suggested by the specification. "In Cooke and Pearse it was held by the Exchequer Chamber, that mere generality in title will not invalidate the patent, unless it be shewn some fraud has been practised upon the Crown; the objection is, that the title describes the patent as taken out for improvements, and the specification discloses facts which amount only to one improvement; the word improvement would have sufficed, however numerous they might have been; there is no such discrepancy as will invalidate the patent."—Tindal, C. J. (103.)

(*l*) Savory *v.* Price, 1 Ryan & Moody.—A patent was granted for a method of making a neutral salt, called seidlitz powders; the specification enrolled set out three distinct receipts, and described the modes and proportions in which the results were mixed, in order to produce seidlitz powders; proof was, the three products so mixed

An article mentioned in the specification means such as is procurable in England under the name.

The description should also be so clear that it should not at all be calculated to mislead; as saying in general terms a certain end is to be accomplished by the aid of a particular substance freed from certain impurities, the modes of doing which are not known to any scientific men in this country (though the article is in existence here, but in the impure state), though abroad it may be obtained freed from the impurity; in such case, if the article is not obtainable in England, and the inventor knew it was procurable from abroad, he should state the fact on his specification, otherwise the public are not in possession of his knowledge, (*m*)

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answered the purpose professed in the patent, and that the combination was new and useful.

"In a specification the plainest and easiest way should be chosen to make the public acquainted with the mode the patentee adopts; and if a person, on reading the specification, would be led to suppose a laborious process necessary for the production of the ingredient, which might be easily purchased in any chemist's shop, the public are misled. If the production of the receipts, or any of them, can be so purchased, the specification cannot be supported."—Abbot, C. J.

Galloway *v.* Bleaden, Webs. Pat. Ca. 524.—If there is a want of clearness in the specification, so that the public cannot afterwards avail themselves of it, much more if there is any studied ambiguity, so as to conceal from the public that of which the patentee for a time is enjoying the exclusive use, no doubt the patent itself would be completely void; this is a question to be decided by evidence brought before you.—Tindal, C. J.

(*m*) Derosne *v.* Fairlie and Others, Web. Pat. Ca. 154.—Case: infringement; using patent without license. Pleas: not guilty; that first and true inventor did not describe, &c.; did not enrol, &c. Issue on the pleas: the first and second issues were directed to be found for plaintiff.—Lord Abinger, C. B., in addressing the jury, said, "The great question turns on the third and fourth issues. It must be admitted, the specification is obscure: the word baked is used for boiling, and discoloration for discharge from colour. But one would not be disposed from an obscure word, which might be interpreted in favour of plaintiff, taking the specification altogether, to deprive him of his patent. The specific point requiring your attention is as to the

for where an article is mentioned in general terms, the mean-

bituminous schistus, and whether the specification sufficiently discloses the object of the patent. For if he leaves any part of his invention in a state of obscurity, and gives no definite directions how to perform it, he loses the advantage of his patent. The bituminous schistus forms the important part of the invention, of which there are many kinds, and vary very much in the quantity of sulphuret of iron they contain; and Mr. Faraday (an eminent chemist), and others, say, they do not know any process by which the sulphuret of iron may be completely expelled. The plaintiff says it should be expelled, but does not say how nor which of the bituminous schistus he uses. If experiment was necessary to prove which of the bituminous schistus were to be used, the object of specification would be frustrated. If, on the other hand, there are none except those which plaintiff himself supplies; or if he contemplated the use of his own, and hence his general mode of explanation; and that persons being unable to procure it in England, should apply to him, who manufactured it abroad. If such was his intention, that would destroy the patent. The process for its production may be known in France, and plaintiff might suppose it might be found anywhere capable of performing the object; he should have inquired whether this country could produce the same; if he had said that such schistus may be imported from France, his patent would have been good." Verdict for plaintiff. And on a question from the C. B., the jury said, they were satisfied the bituminous schistus obtained in England might be adopted. On argument for a rule nisi for entering a nonsuit, his lordship said, his impression was that plaintiff ought to have been nonsuited, but that he was anxious to prevent further proceedings, so put the case entire to the jury. "An improvement in the final result may be considered to be an improvement in every intermediate stage. Plaintiff should have given some evidence to shew that bituminous schistus, in the state which it is found and known in England, could be used in this process with advantage (vide Sturtz *v.* De la Rue, infra, p. 96); and as he has not done so, defendants are entitled to a nonsuit." Bolland, B., said, "He should have shewn the substance named would have succeeded; shewing that which was procurable from persons selling the article, would have succeeded; he has merely shewn a preparation made by himself (with which we are unacquainted) produced the desired effect." "The specification must state one or more methods which can be followed for the purpose of accomplishing and carrying into effect the invention." Alderson, B. Rule for a nonsuit absolute. No new trial followed, but part of the specification was disclaimed.

ing is, that the substance procurable in the market under that descripion is intended. (*n*)

Omission to state matters within the knowledge of the inventor.

The omission to state the use of any particular article or thing in the knowledge of the inventor by which the object of the invention may be effected in a more expeditious (*o*)

(*n*) Sturtz *v.* De la Rue and Others, 5 Russ. 322. Patent for improvement in copper and other plate printing.—Specification declared nature of invention consisted in putting a glazed or enamelled surface on paper to be used for copper and other plate printing, by means of, &c., whereby the finer lines of the engraving were better exhibited than heretofore, and for polishing same after impression; directions were given for preparation, and an ingredient was described as the finest and purest chemical white lead, previously ground fine; and then description how to be used. An injunction had been obtained, *ex parte;* motion was to dissolve the injunction. (323.) The description in the patent must give, as far as it goes, a true idea of the alleged invention, though the specification may be brought in aid to explain it. If by adding any thing to the surface of the paper more clearness is given to the lines, it is an improvement in copper-plate printing. (325.) It is a principle in the patent law, that there must be the utmost good faith in the specification: it must so describe the invention, that a person of ordinary skill in the trade may carry on the process. The purest and finest chemical white lead must mean the finest and purest white lead usually gotten in the general market for that commodity. (327.) Unless a guard be put upon the words, that which in the ordinary sense of the trade would be called fine and pure would not answer; but that it must be superlatively pure, and prepared in a particular way, and to be gotten only in a particular place. If the article is to be imported, it should say so. It appears the specification does not give that full and precise degree of information, which the public have a right to desire.

(*o*) Wood *v.* Zimmer (Holt's N. P. 60), which was a patent for making "verdigris."—The patentee had been accustomed to put aquafortis clandestinely into the boiler, for the purpose of more quickly dissolving one of the ingredients used, copper, but the verdigris produced was neither better nor cheaper than that made according to the specification. Gibbs, C. J.—A "man who applies for a patent, and possesses a mode of carrying out 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

or more perfect manner (*p*) is also a ground of voidance; or if the effect can be produced by the use of cheaper materials than those mentioned in the specification, which the patentee knew, the suppression of such knowledge would be a fraud upon the public, and vacate the patent. (*q*) So if a certain temperature is necessary for effecting a given object, some guide must be given to enable a person to perform the object with certainty and without the aid of experiment; if the particular temperature cannot be ascertained, or it varies, according to circumstances, then if the object upon which the heat works changes its colour by the application, such colour or change must be described; (*r*) or even not stating at what angle certain matters were to be placed will void the patent; (*s*)

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himself. If any thing, which gives an advantageous operation to the thing invented, be concealed, the specification is void: as if verdigris is made with more labour by the omission of aquafortis, it is a prejudicial concealment.

(*p*) In a patent for trusses for ruptures, the specification omitted to mention a thing which was very material for tempering steel,—rubbing it with tallow; for the omission, Lord Mansfield held the patent was void. (Buller's N. P. 76.) And in Morgan *v.* Seaward (supra), Alderson, B., in commenting upon this case, said, the patentee "ought not to have put people to find out that tallow was useful in carrying into effect the invention of steel trusses. The public should be told so, if it be the best mode of doing it, for the patentee is bound bonâ fide to make a full and candid disclosure.—Vide Rex *v.* Arkwright, in notis infra.

(*q*) Turner *v.* Winter, infra.

(*r*) Rex *v.* Wheeler, supra. Thomson *v.* Forman, supra. S.P.

(*s*) Macnamara *v.* Hulse and Another, 1 Carrington & Marshall, 471.—Defendants cannot go beyond their pleas, be the objections they have detailed what they may. "The statute, I apprehend, does not make the notice of objection stand in the place of pleas." —Abinger, C. J. (474.) If the specification leaves it to experiment to determine what angle is the proper angle, it is not good; but if any angle will be of benefit, it will do. (477.) Any other suitable material, includes words not in contemplation at the time of the

Stating a preference when he knows only that thing will answer the purpose.

so also the stating that the patentee prefers a certain material, knowing that only will effect the purpose, would be fatal to the validity of the patent. (*t*)

Inaccurate use of words.

If words are inaccurately used, but the meaning can be arrived at by taking the whole of the specification together, such error, unless inserted with an evident intention to mislead, will not affect the patent;(*u*) as calling air an imponderable substance, or sulphur a mineral;(*v*) the statement of an error in respect of a matter foreign to an invention, which cannot mislead, will not vitiate the specification. (*w*)

Evidence as to intention to mislead.

In the absence of evidence on the part of the defendant, that persons have been misled by the misstatements, it is sufficient for the plaintiff to call persons who

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patent. (477.) "I may now say, my opinion was against the plaintiff as to the angle not being stated, and that the specification was, in that respect, insufficient."—Abinger, C. J. (478.)

(*t*) Crompton *v.* Ibbotson, 1 Dawson & Lloyd, 33.—Patent for an improved method of drying and finishing paper.—The specification described the invention to consist in conducting paper by means of a cloth or cloths against a heated cylinder, which cloths may be made of any suitable material; but "*I prefer*" it to be made of a linen warp and a woollen weft. It appeared in evidence, that no other medium than that the plaintiff said he should prefer was suitable as a conducting medium; and a nonsuit was against plaintiff, because his specification was uncertain: he should not only have stated what would do, but have excluded that which would not do. Motion was to set aside the nonsuit, on the ground that the important part of the invention did not consist in the material interposed, as the mode of applying the paper to the cylinder.

"The patent was obtained for the discovery of a proper conducting medium. The plaintiff, after repeated trial, found nothing would serve but that which he said he preferred; others, being misled by the terms of this specification, may make experiments, which the plaintiff knows must fail; the public have not the entire benefit of the invention." Rule refused. Lord Tenterden, C. J.

(*u*) Derosne *v.* Fairlie, per Lord Abinger, C.B. Neilson *v.* Harford, supra.

(*v*) Neilson *v.* Harford, Webs. Pat. Ca. 340. (*w*) Ibid. 353.

say that to them the description contained in the specification was clear. (*x*) Where a specification is so worded that it tends to mislead, it will be void as by a misstatement. (*y*) So where a specification, in setting out the mode by which the effect is produced, states that three articles (naming them) are necessary to be used in order to obtain the desired result, and it is found that two of them are sufficient for that purpose; the statement that the three articles were necessary, when it is proved that two are sufficient, will be presumed to be inserted merely for the purpose of misleading. (*z*) So if the representation be that a certain invention is

Specification tending to mislead.

(*x*) Cornish *v.* Keene, supra.

(*y*) Walton *v.* Bateman, Webs. Pat. Ca. 62.

(*z*) Turner *v.* Winter, 1 T. R. 602.—Patent for producing a yellow colour for painting in oil or water, making white lead and separating the mineral alkali from the common salt, all by one process.—The specification gave directions for carrying out the process. For the plaintiff it was proved that some persons had made the colour by the specification, after trying some experiments; for the defendant, it was proved that the patent colour could not be made by following the directions of the process, &c.; that white lead could not be made by following the specification. (603.)

"I think every patent is a monopoly for the patentee, and so far contrary to the principles of law, and would be a reason against it, if it were not for the advantages the public are to derive from it after the expiration of the time limited. The specification of the invention must be in the clearest and most unequivocal terms of which the subject is capable, and if any unnecessary ambiguity be unnecessarily introduced into the specification, or any thing which tends to mislead the public, the patent is void. (605.) Sal gum is the only salt applicable for the purpose; fossil salt, therefore, can be only calculated to raise doubts and mislead. If a process as directed by the specification does not effect the purpose proposed, the patent is void."—Ashhurst, J. "Where the discovery is not fully made, the Court should look with a very watchful eye to prevent imposition upon the public. (606.) Whenever the patentee brings an action on his patent, if the novelty or effect of the invention be questioned, he must shew in what his invention consists, and that he produced the effects proposed in the manner specified. Slight evidence is suffi-

to be carried out by means of one machine, and it is proved the invention is not effected by one, but by several machines, though of the same character, it will be fatal.(*a*) In this case the matter was one of particular hardship; the usefulness of the invention was afterwards acknowledged by a parliamentary grant. If more is sought to be covered by the patent than the patentee is strictly entitled to, it will be bad, not only for the extra claim,(*b*) but for that also to which he is fairly entitled.

Seeking to cover more than patentee is entled to.

Patent for an improvement.

When the patent is for an improvement upon a machine or other matter, the improvement only should be specified;(*c*) but where a person obtained a patent for a machine,

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cient, and then defendant must falsify the specification. If patentee could make the article with two or three of the ingredients specified, and he inserted others which will not answer the purpose, that will avoid the patent. So if he makes the article with cheaper materials than specified, though they will do equally well, the patent is void. (607.) If a patentee by one process says he can produce these things, and fails in any one, the consideration of his merit fails, and the Crown has been deceived." (608.) Buller, J.

(*a*) Bloxam *v.* Elsee, 6 Barnewall & Cresswell, 169.—"Patentee represented to the Crown he was in possession of a machine for making paper in single sheets from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length; on which representation the patent is grounded. The consideration for the grant is the invention of a machine for making paper in sheets varying within the limits designated; if any material parts be not true, the consideration has failed and the grant is void. Length and width are important parts of this representation. (173.) If width is not considered material, length cannot, and the representation will then be, that machines are invented, by the use of several of which paper of various lengths may be made without seam or joining, and this is at variance with the specification, which plainly shews that whatever was to be done, was to be done by one and the same machine. (The patent was extended by Act of Parliament.) If the first grant was void, the subsequent grants by the patent and the statute must fall to the ground, as having nothing to support them."—Abbott, C. J. Vide infra, Pleading. (*b*) See Disclaimer, infra, p. 114.

(*c*) Hill *v.* Thompson and Another, 3 Meriv. 622.—"A specifi-

and afterwards another for an improvement thereon, the specification of which recited the grant of the former patent, and gave a full description of the machine in its improved state, and not of the improvements only, this was held sufficient,(*d*) it is presumed, on the ground of the

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cation must not attempt to cover more than that which, being both a matter of actual and useful discovery, is the only proper subject for the protection of a patent; and if more is sought by the specification than the patentee is strictly entitled to, his patent is thereby rendered ineffectual, even to the extent to which he would otherwise be fairly entitled. There may be a new combination of materials previously in use for the same purpose, or for a new method of applying such materials; but in order to its being effectual, the specification must clearly express that it is in respect of such new combination or application, and of that only. If there be a patent both for a machine, and for an improvement in the use of it, and it cannot be supported for the machine, though it might for the improvement, it is good for nothing altogether, on account of its attempting to cover too much. (629.) The utility of the discovery and the intelligibility of the description are all matters of fact for a jury; but whether the specification is defective in attempting to cover too much is a matter of law."—Eldon, L. C. (630.)

(*d*) Harmer *v.* Plane and Another, 11 East, 101.—A, having obtained a patent for manufacturing a certain machine, of which he duly enrolled the specification, and afterwards obtained another patent for certain improvements in the same machine, in which the grant of the former patent was recited, and the latter patent contained a condition that it should be void if the patentee did not within one month enrol a specification, particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed; it was admitted that the improvements for which the second patent was granted are included in the general description of the improved machine and set forth in the specification, and that it contains a full and proper description of the whole machine in its improved state, but it does not point out or describe in any manner the improvements upon the former machine; the drawing on the second specification is not a drawing of the improvements only, but of the whole machine, and no indication is made by a mark or other means. (106.) "It may not be necessary, in stating a specification of a patent for an improvement, to state precisely

citation of the prior grant in the subsequent specification. The case afterwards came under the consideration of Lord Eldon in the Court of Chancery, where his lordship expressed a doubt as to the goodness of the specification. (e)

Rule of law respecting improvements.

The direct rule of law is, that where a patent is taken out for improvements, the claim in the specification must be for the improvements, and not for the machine or thing in its perfected state; (f) as where a patentee claimed generally the admixture of cotton and silk as an invention, and not any particular mode of effecting it, such claim was held to vacate the patent; (g) so where the claim was for a stove, and the invention consisted only of an improvement by the addition of a pipe to an old stove. (h)

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all the former known parts of a machine, and then apply them to those improvements, but it may be sufficient to refer generally; as in the instance of a common watch, it may be sufficient to say, take a common watch, and add or alter such parts, describing them."— Ellenborough, C.J. (107.) Held, the proviso or condition in the last letters patent has been performed by the enrolment as set forth in the case.

(e) Harmer *v.* Plane, supra.—An argument was held, that where there is a prior patent, and the later specification (for improvements) incorporates the former by reference or repetition, as part of its own description, and proceeds to shew what are the improvements, that would be a good specification. His lordship said, he doubted whether the improvements must not appear in the specification as improvements, and whether they must not be so exhibited as to shew that it is for improvements for which the patent is granted, or it would have a tendency to mislead. (135.) A patent for a machine, with a due specification, having been granted, and a subsequent patent for improvements, his lordship said, "he felt a very considerable doubt whether it is good or competent in law to represent in the specification that the latter patent was granted not for an improvement, but for the machine carrying forward that idea, and describing the invention as one entire machine, not as improvements contradistinguished from the other machine." (136.) Lord Eldon, Ch.

(f) Hill *v.* Thompson, supra. (g) Rex *v.* Elsee, supra.

(h) Williams *v.* Brodie, Webs. Pat. Ca. 75, in notis.

The case of the King against Arkwright (i) did more towards the settlement of the law of patents as regards the

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(i) Davies, Pat. Ca. 61. Webs. Pa. Ca. 66 S. C.

The King *v.* Arkwright, Davies, Ca. 61.—This was a case instituted by the attorney-general by *sci. fa.* to repeal a patent. The proceeding originated in the petty bag in Chancery, and was sent to the King's Bench to be tried. Allegations on writ were: 1. Grant was prejudiced; 2. Invention was not new in England; 3. That it was not invented by Arkwright; 4. That it was not enrolled in the High Court of Chancery, and sufficiently described. "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, and what the art is, and it must put the public in possession of the secret in as ample and beneficial a way as patentee himself uses it; for the patent is the reward which is held out for a discovery, and unless it be true and fair, the patent is void. If the specification in any part be false or defective, the patent is against law, and cannot be supported. If it be such as mechanical men of common understanding can comprehend to make such a machine, it is sufficient. It must be such that mechanics may be able to make a machine by following the directions of the specification without new inventions or additions of their own. (106.) The proof was, the old feeder was made by a person named, but he (witness) could not make a new feeder from the specification. The rollers were made the same as these, but of different kinds of materials. If a material alteration was made, it should be specified in the patent; but it is silent as to the material or the form,—so also of the motion (107)—so also of difference of size. It was proved by various witnesses that a machine could not be made from the specification. (107 et seq.) If things of no use are thrown into the specification merely to puzzle, I have no difficulty in saying, upon that ground alone the patent is void, for it is not that fair and full discovery which the public has a right to demand. (118.) If four things only are necessary instead of ten, the specification does not contain a good account of the invention. (125.) Is this specification such, as with the plan, a machine may be made from it, taking the old machine into its assistance, which, by the bye, the specification has not taken notice of as known? If you think it is not sufficiently described, that alone puts a complete end to his cause. As to the other points, there are two: first, is it a new invention? and next,

specification than perhaps any other case upon record. It was instituted by the attorney-general to repeal letters patent, which it was proved, on the hearing of the case, the

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was it made by the defendant? (128.) In the case of an invention, many parts of a machine may have been known before, yet, if there be any thing material and new, which is an improvement of the trade, it will be sufficient to support the patent; but whether it must be for the new addition only, or for the whole machine, would be another question. 1. The beater or breaker of seeds, &c., is a wheel with teeth, which is admitted is not new, being described in Emerson's book. (128.) 2. An iron frame with teeth working against a lower frame with teeth, which is proved not to be used at all. 'If it had nothing to do with the machine, it is difficult to say how, with a good invention, it ever came into the specification or plan.' (130.) 3. Is the feeder proved not to be new? (131.) 4. Is a crank not new? (134.) 5. The filleted cylinder not new without the stripe, whether it makes any material alteration. Some say it does as well without as with the stripe; if you suppose stripes were never used before, it is not such an invention as will support a patent. (137.) 6. Rollers not new. (138.) 7. The can. Witness says the only difference between the spinning and roving machine is that the latter has a can; if so, it brings the case to a short point indeed; for if nothing else be new, the question is whether it be material or useful (138), and evidence proved, if new, it is useless. Nos. 8 and 9 are admitted to be entirely out of the case, and may be used, says defendant's counsel, instead of No. 7. The question in issue is, the specification does not import that No. 8 or 9 was necessary to be used, and because No. 10 is to be fixed to No. 6, to work Nos. 7, 8, or 9. Now the words of the specification are these: 'No. 8 is a machine for twisting the contents of No. 6, in which is a frame of iron, *d d*; B, a roller, upon which a bobbin is fixed; this is turned the same as No. 7—that is, by a dead pulley or wheel fixed to a wooden frame at *g*; No. 9 is a spindle and flyer fixed to No. 6; *a* is a pulley under the bobbin, which hath a communication by a band to No. 10 at *d d*, it being a conical or regulating wheel, which moves the bobbin quicker or slower as required.' This is the account given of those two, viz. that nothing imports to be used with No. 7, but, on the contrary, that was to be used instead of them—therefore, you may take any one of these things and it will do." Verdict for the Crown. (139.) Buller, J.

patentee had most improperly obtained. The patent was proved to be void on many grounds; it is cited at greater length than usual on account of its great practical importance; it proves that any material alteration made in any existing apparatus or machine should be stated in the specification, with reference to the materials to be employed, the form of the various introductions—the particular speed of certain parts, or their relative dimensions, and that mention of more parts than are needed to effect the purposes of the patent, or prior publication in a book, or by user, would void a patent.

A thing mentioned in the specification, but not stated to be essential and not the subject of a particular claim, unless inserted for the manifest purpose of misleading, will not be sufficient to avoid a patent. (*j*) The claim must not be too large; as if the claim be for effecting several things, and it is found useless for one of them, such failure would be fatal, for the usefulness of the whole was the consideration for the grant, which is entire and cannot be severed. (*k*) So

The claim must not be too large.

(*j*) Lewis *v.* Marling.—"There is no case deciding that a patent for several things, one of which was supposed to be useful, but was found not so, is therefore void; though it has been decided, if a patent be granted for three things, and one is not new, it fails in toto. The restriction by statute is to the new and first inventor of manufactures, which others, at the time of granting the patent, shall not use. The condition imposed by the statute has been complied with when it has been proved to be new."—Parke, J.

(*k*) Felton *v.* Greaves and Another, 3 Carrington & Payne, 611.—Patent for a machine for giving a fine edge to knives, razors, scissors, and other cutting instruments. The specification described a machine for sharping, &c., by passing their edges backwards and forwards in an angle formed by the intersection of two circular files; it also stated that other materials besides steel might also be employed, according to the delicacy of the edge required. The machine proved well adapted for sharpening knives, but not for scissors; for them, one of the rollers should be quite smooth.

"The specification describes both rollers as files. I cannot find that

Description of old modes to effect a patent, and non-claim of a new invention.

if a specification describes certain means of effecting an object, which means are old; if the specification mentions a mode which, if claimed, might have been the subject of a patent, still, not being claimed, it will not be considered as part of the invention; and if the specification is held to be void on the ground of the want of novelty, it will not be

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the scissors sharpener is described as having the rollers different; the specification is insufficient."—Tenterden, C. J. (et vide Title, supra).

Brunton *v.* Hawkes, supra.—"A patent cannot extend beyond the consideration of a patent, and for a new invention in one article the grant could not be for that and another. The patent is granted on recital of improvements in three articles, and that they are new."

Morgan *v.* Seaward, supra.—"If certain inventions are suggested to be improvements, and one is not so, we think the patent would be void, on the ground of fraud upon 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. In the case of Lewis *v.* Marling, that the patent was void for false neglect, was not pressed upon the Court; the decision was, that want of utility of part did not vitiate a patent."

Bickford *v.* Skewes, supra.—"Some knowledge of the pyrotechnic art is necessary in the person who is required to read the specification for the purpose of making the insertions. The specification is addressed not to persons entirely ignorant of the subject introduced, but to artists of competent skill in that branch of manufacture to which it relates, and such persons would be at no loss to select the proper combustible material."—Lord Denman, C. J.

Arkwright *v.* Nightegate, Dav. Pat. Ca.—"The clearness of a patent must be according to the subject-matter of it. It is addressed to persons in the profession having competent skill in the subject, not to men of ignorance; and if it be understood by those whose business leads them to be conversible with such matters, it is intelligible."—Lord Loughborough, C. B. Huddart *v.* Grimshaw (supra), per Lord Ellenborough. Rex *v.* Arkwright (infra), Buller, J. Morgan *v.* Seward (supra), Parke, B. Neilson *v.* Harford (supra). Derosne *v.* Fairlie (supra), S. P.

made valid by the invention, without claim of that which would otherwise have supported the patent.(*l*)

It has been before said, that the specification is not to be read by persons unskilled in the particular art; therefore, if a specification does not mention a particular thing which a workman skilled in the particular manufacture would know to be necessary, such an omission will not void the patent;(*m*)

Omitting to mention in the specification a matter which would be in the knowledge of any workman, effect.

(*l*) Sanders and Aston, supra. Bramah *v.* Hardcastle, Webs. Pat. Ca. 76, in notis. S. P.

(*m*) Crossley *v.* Beverley, 2 Car. & P. 513.—Patent for making an improved gas apparatus. Specification described as follows:—"My improved gas apparatus is for the purpose of extracting inflammable gas by heat from pit-coal tar, or any other substance from which gas or gases capable of being employed for illumination can be extracted by heat, for purifying," &c. &c., and described the machines necessary. "Other substances," coupled with pit-coal tar, mean *ejusdem generis*.—Tenterden, C.J. (514.) It was proved, gas, by the apparatus, could not be made from oil, and that the specification did not include a condenser. "A workman who could make the apparatus, would know that he must put that in." The inventor was called, who stated, he invented some of the mechanical parts of the apparatus at a time subsequent to taking out the patent, but that he had the general idea of the apparatus in his mind. The jury stopped the summing-up, and gave verdict for the plaintiff, on motion for a new trial on the ground that the apparatus described in the specification was invented at a time subsequent to taking out the patent. "The person's mind was directed to the invention, and in the interval between the taking out of the patent and the enrolment of the specification, he perfects it in some mechanical parts—will it make his patent void? Why is any time allowed to an inventor to prepare his specification, unless to allow him to mature the mechanical parts of his invention?"—Tenterden, C.J. (517.)

"It is the duty of an inventor, not only to state what he knew at the time of the patent, but the public have a right to be put in possession of all that he knows at the time of the specification."—Bayley, J.

"The public ought to have advantage of improvements up to the time of specification."—Littledale, J. Parke, J. concurred. (517.) Rule refused.

In a report of the same case (Moody *v.* Malken), Lord Tenterden is

but if it contains any untrue statement, though the jury find that a competent workman would not be misled by the error, the patent would nevertheless be void. (*n*)

Stating any fit and proper material may be used is bad.

Patentees, in their anxiety to prevent an infringement of their patent, by not claiming a sufficiency to protect it, are apt to run into the opposite extreme, and which is as fatal an error; for by too large a claim, as before stated, though in a different sense, the patent would be rendered nugatory. (*o*) A mode of specification which is a very general favourite with inventors, and one which on casual observation does not appear to be fraught with danger, but when examined by what has here been before stated, will be found to be contrary to all the principles upon which patents are granted; for it evidently tends, if not to mislead, at least to experimentalize. The mode in question is, where, after the inventor has stated those matters which he knows will be effectual for the purpose of carrying out his invention, he winds up his claim by saying that any other fit and proper materials may be

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reported to have said, that "oil was not then generally considered such a substance (as that from which gas is to be extracted), and the fact that some experiments were going on at the time with respect to its being so will make no difference; the patentee cannot be required to foresee the success of those speculations, if they have succeeded, but I must consider him, as a practical man, to have spoken of those things which practical men then treated as usable for the purpose."

(*n*) Neilson *v.* Harford, 8 M. & W. 806.—If a specification contain an untrue statement in a material circumstance, of such a nature, that if literally acted upon by a competent workman it would mislead him and cause the experiment to fail, the specification is bad and the patent invalid, although a jury, on the trial of an action for an infringement of the patent, find that a competent workman acquainted with the subject would not be misled by the error, but would correct it in practice.

(*o*) Vide Disclaimer, infra.

used; but if no other material is proper than that stated, the grant is void.(*p*)

Colourable difference in the mode of effecting the object of the patent.

It is by ignorance of the law that inventors fall into this error, for without such a statement the patentee would be protected; for suppose any other matter could be used instead of the one named, if the purpose was carried out in a similar manner, and the process was not cheaper, or produced a more beneficial result than the mode detailed in the specification, it would be an infringement on the patent right, for it would involve the principle of the invention. If the matter used was evidently an evasion, or what the law calls an evasion,(*q*) the party would be punishable by an action for damages, and an injunction might be obtained against a continuance of the process. After what has been written upon novelty,(*r*) it is almost superfluous to say that to support the patent the invention must be new, or the introduction from abroad (*i.e.* from some place not within her Majesty's dominion) of a new trade or manufacture.(*s*)

LEGAL CONSTRUCTION.

Construction of the letters patent.

In enforcing a claim, the patent and specification are taken as one instrument,(*t*) and is construed upon the

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(*p*) Crompton *v.* Ibbotson, supra.

(*q*) Vide infra, Infringement. (*r*) Supra.

(*s*) Campion *v.* Benyon.—"A patent can only be sustained for a new discovery, and the specification must support the patent; if it do not, the king is deceived, and the patent is void."—Burrough, J. (13.)

"The plaintiff must be nonsuited: the patent is taken out for more than he has discovered. If the specification had stated the patentee claimed no merit to the exclusion of the starch, the patent might have been valid."—Richardson, J. (13.)

(*t*) Crossley *v.* Beverley, Russell *v.* Cowling, Neilson *v.* Harford, supra.

principles of good faith. (*u*) The description of the invention is of course to be taken from the specification, for its very object is to set out the process by which the invention is to be accomplished. (*v*) The principle of law is, that the patentee does not claim things which he knows to be in use, unless he makes a distinct claim therefor in the specification, in which case the presumption would be rebutted by the fact. (*w*)

Interpretation to accord with the state of knowledge.

The interpretation of the terms of a specification must be in accordance with the state of knowledge at the time (*x*) (it is presumed) of the enrolment of the specification, and not at the time of the grant of the patent, for a patentee is bound to record in the specification all improvements; and if between the grant of the patent and its enrolment any discovery was made which would affect his invention, and it could be traced to his knowledge, he would be bound to specify it. If it was not his actual discovery, he would then state his discovery and the after-discovery, stating, that since his invention a certain matter was discovered (describing it) by which the process could be effected more expeditiously, or in a cheaper mode; as if the patent was for a process of smelting iron by the aid of a chemical compound, and a cheaper means was found out of making the particular compound; if the patentee knew it, he would be bound to specify it, but without claiming the invention.

Construction of patents.

The construction of all written instruments is for the Court, (*y*) within which rule a specification falls, (*z*) and should be so read as, consistently with the fair import of the language, to make the claim and the actual discovery co-extensive; (*a*) and if words be used contrary to their

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(*u*) Neilson *v.* Harford, supra. (*v*) Rex *v.* Arkwright, supra.
(*w*) Haworth *v.* Hardcastle, supra.
(*x*) Cropley *v.* Beverley, supra. (*y*) Neilson *v.* Harford, supra.
(*z*) Hill *v.* Thompson, supra. (*a*) Haworth *v.* Hardcastle, sup.

usual signification, but the meaning the patentee had in view can be gathered from the specification, it shall be sufficient. (*b*)

If a particular process, or manufacture, or machine is described, and the specification is silent as to a particular part, or a combination of parts, it shall be presumed the claim is not for such parts. (*c*) Silence of a specification as to parts of a machine.

Of the letters patent and the specification the construction is for the Court, but the terms of art and the facts are for the jury. Facts construed by the jury.

ENROLMENT—AMENDMENT, IN WHAT CASES ALLOWED.

By a condition contained in the letters patent, the patentee has to enrol the specification in the High Court of Chancery within the period therein named. The enrolment is a condition, and if not complied with within the time named, the patent is void. In computing the time, the day of the date of the letters patent is not reckoned. (*d*) The time is calculated by calendar and not lunar months; so that if a patent bears date as of the first of a month, enrolment on the first of the next month (if the time of the enrolment be within a month) satisfies the condition. (*e*) Enrolment. Computation of the time.

Any mere clerical error may be amended, (*f*) and when amended, though the amendment be one not in accordance with the statute, it is doubtful if it will, on petition, be expunged; as in a case where, under the 5 & 6 of Wm. 4, c. 83, a patentee had, by the authority of the solicitor- Master of the Rolls' power to amend.

(*b*) Derosne *v.* Fairlie, supra.

(*c*) Carpenter *v.* Smith, supra; Russell *v.* Cowley, supra.

(*d*) Watson *v.* Pearse, 2 Camp. 294. Vide Russell *v.* Ledsam, 9 Jurist, 557, et supra.

(*e*) Derosne *v.* Fairlie, supra. (*f*) In re Edmund, R. 41.

general, entered a memorandum of alteration of the enrolment of the specification: and it was alleged, in a petition to expunge the amendment, that it was not according to the provisions of the above statute, as being an extension of the patent, to the prejudice of a subsequent patentee,—the Master of the Rolls (Lord Langdale) refused to grant the petition, being of opinion that he had no jurisdiction, and dismissed it with costs. (*g*)

Notice of amendment.

If the parties who have amended are not living within the jurisdiction of the Court, service upon the party who acted as their agent in obtaining the amendment will be esteemed a service upon the principals; but an affidavit of service of the petition upon the party amending residing in Scotland will not be esteemed a good service. (*h*)

Amendment when allowed.

In delivering judgment in the above case, the Master of the Rolls (Lord Langdale) said, "In a case before Lord Gifford, the word 'fire' was allowed to be substituted for the word 'wire.' (*i*) In re Redmund (*j*) an erroneous transposition of numbers was amended, by the order of Sir J. Leach, and who in a subsequent case allowed two errors to be amended, by one of which the word *which* was written instead of *wheel*, and the word *increase* had been written *inverse*. "I have had such cases before me, and where it has been plainly intended to amend mere slips or clerical errors, a strict evidence of the error has been required."

Amendment and order.

In order to enable a third party to dispute the validity of the amendment and of the order, it has been directed that the order itself shall be indorsed on the enrolment. (*k*) In Ruberty's patent, the specification recited that the patent was granted in October instead of November, which was allowed to be corrected, and in Whitehouse's patent. (*l*) The petitions stated that in both

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(*g*) Re Sharpe's Patent, B. 245.
(*h*) Ibid.
(*i*) Whitehouse's Patent.
(*j*) 5 Russ. 44.
(*k*) In re Sharpe.
(*l*) Supra.

cases proceedings by *scire facias* had been commenced, to repeal the grant, and in Re Nickel's Patent, (*m*) where a clerical error had been made in the Queen's warrant, which had been copied in the subsequent steps, the Master of the Rolls, on petition, allowed the amendment; the error consisted in the word *recovering* being used instead of the word *covering*. In this case the petitioner had taken proceedings against a party for infringing his patent, and proceedings by *scire facias* had been commenced to annul the patent.

(*m*) 1 T. & P. 36.

CHAPTER VII.

DISCLAIMER—CONFIRMATION.

Disclaimer, what.

In treating of the specification, it has been said, that if a person claims as his invention a something which has been before known to the public, or claims as his inventions several matters, for one of which his patent would be bad, on the ground of the want of novelty, such claim would vitiate his patent, and for which cause the profits of many inventions (some of which were very meritorious) have been lost to the inventors. To aid what appeared to be a defect in the patent laws (for such a claim was often innocently made, from a supposition on the part of the patentee that he was the discoverer) the statute of the 5 & 6 of Wm. 4, c. 83, (*a*) was enacted, and also to confirm patents which would otherwise be void, by a petition to her Majesty in council. (*b*)

5 & 6 Wm. 4, c. 83, sect. 1.

By consulting the digest of the statute (*c*) it will be seen, the first section sets forth consistently its object, which is, that a person, who in a patent has described himself to be the inventor of certain things, part of which he finds are not new, may, by the permission of the law officers of the Crown, disclaim such or any part thereof; but such disclaimer or alteration must not tend to enlarge the right conferred by the grant. The statute states, that a person who may be the grantee or assignee of a patent, may likewise enter a disclaimer.

Grantee, after assignment, right to disclaim.

It has been held that the grantee, after he has assigned a

(*a*) Vide stat. supra. (*b*) Infra.
(*c*) Supra, p. 10.

part of his interest, may enter a disclaimer of any part of the patent. (*d*) Where a patent was originally void, but by the disclaimer of a part, that which would have destroyed it is eradicated, such disclaimer has not a retrospective effect, so as to make a person liable for infringements before the entry of the disclaimer; (*e*) but when the disclaimer

Disclaimer, effect of.

(*d*) Spilsbury and Abbot *v.* Clough and Another, 2 Gale & David. 17.—Patent for improvements in chloride of lime.—The disclaimer was made by the original patentee, when he had not the entire interest in the patent. "I think he had the right to make such disclaimer under the statute."—Denman, C.J. (21.)

"I think the word 'obtained,' in the statute, applies to the person who obtained the letters patent. I do not understand the words 'assignee, or otherwise,' in the first section; in the second it is clear, and I do not see why the word should not have the same meaning in the first section. I think if the grantee had parted with all his interest, he might still enter the disclaimer by permission of attorney or solicitor general."—Patteson, J. (22.)

It must be by permission, and a caveat may be entered against the disclaimer.—Coleridge, J. (23.)

(*e*) Perry and Others *v.* Skinner, 2 Meeson & Welsby, 471.—Disclaimer under 5 & 6 Wm. 4, c. 83.—"The Act is obscurely worded, but it would be unjust if it made a man who was acting consistently with the law at a certain time, subsequently a wrongdoer by relation: such we cannot presume; and that a man would bring an action, after he had disclaimed, for the infringement of a patent, before such disclaimer was thought of. The intention of the Act was, he should not have the benefit of the disclaimer (475) as to infringements gone by before such disclaimer made."—Lord Abinger, C.B. (476.) "That a disclaimer shall be deemed and taken to be part of the original letters patent, would be a manifest injustice; the only construction which can be put on the act is, that it shall be deemed and be taken as a part of the letters patent from thenceforth."—Parke, B. (477.)

Stocker *v.* Waller and Others, 9 Jurist, 136. — Case for infringement.—Declaration set out that plaintiff was the first inventor of certain improvements in pumps—the grant—enrolment of the specification—before committing the grievances complained of, a disclaimer of a part, &c.—breach. Plea: After said grant, and before enrolment of the disclaimer, a patent was granted to W. B. for an improvement in water-closets, &c., and that the grievance alleged in

is made, it becomes a part of the patent. (*f*) And when a disclaimer, or memorandum of alteration, is entered, the Master of the Rolls has no power to remove it from the records of the Court of Chancery. (*g*)

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the declaration was making, &c., in accordance with the patent of W. B. Verification. Demurrer: That it was no answer to an infringement by defendants of the letters patent, that the defendants work under a license from another and subsequent patentee. The points intended to be argued for the plaintiff were, that a license from W. B. could not justify an infringement of the plaintiff's rights; that the plea was bad for argumentativeness and uncertainty, and that it amounted to the general issue. For the defendant: The rights of the plaintiff, if any, date from the entry of the disclaimer and memorandum of alteration, and not from the original grant of the letters patent. That no letters patent were ever granted for the invention of which an infringement is alleged in the declaration. That the declaration was insufficient, and did not shew any cause of action or infraction of the privilege granted to the plaintiff, and that until the entry of the disclaimer, the plaintiff's patent was void. "The plea assumes to be in confession and avoidance. The confession, which I will assume to be good, must amount to an admission of so much of plaintiff's right as remains after the disclaimer; but then there is no sufficient avoidance. It should shew that the plaintiff's patent, as described by the disclaimer, is void in law; there is no express allegation that it is void, unless as arising from the disclaimer or grant to W. B. A disclaimer does not necessarily import the original patent was void, for the object of the statute was not only to enable inventors to set themselves right, when from some cause their patent is void, but to remove doubts and difficulties which hang over the heads of parties bringing actions for infringements. W. B.'s patent was void, as being known to the public by the prior enrolment of the plaintiff's specification. Judgment for plaintiff."—Tindal, C.J. "The true meaning to be given to the first section of the 5 & 6 Wm. 4, c. 83, is that suggested by the Court of Exchequer (Perry *v.* Skinner, 2 M. & W. 471). The effect of that construction is, to hold that from the time of the entry of the disclaimer it shall be taken to be incorporated with the letters patent and the specification, so as to affect all acts done after that period, but it shall not have the effect of making parties wrongdoers by relation."—Cresswell, J.

(*f*) Clarke and Another *v.* Kendrick and Another, 12 M. & W. 221.

(*g*) Re Sharpe's Patent, supra.

In the statute a proviso is also made, that against such disclaimer a person may enter a caveat, which will entitle him to the same right of notice as in the case of the entry of a caveat against the issue of any patent for any improvement in a particular branch of manufactures.(*h*) Caveat against a disclaimer.

CONFIRMATION.

The second section of the act empowers the Privy Council to *confirm any* patent which may be issued, if, in their discretion, they deem it proper. On the hearing, satisfactory affidavits must be produced that the party did not know of the prior invention, and also that no proceedings are taken under the patent; proof of publication in an English book, or in a specification, would be fatal.(*i*) But Confirmation.

(*h*) Vide supra, Caveat.

(*i*) Westrupp and Gibbin's Patent, Webs. Pat. Ca. 554.—Application by assignee of patent; petition stated assignment, and that since the date of the assignment it was discovered that part of the process was known to certain persons, but not publicly known; and that the petitioner believes that the same had never been practised before the date of the letters patent, and that no legal proceedings had been taken upon the patent. Petition was confirmed by surviving patentee; application was opposed upon the ground that part of the patent was old, being published in a book many years before. Sir F. Pollock opposed, and said the parties should have disclaimed the old patent, and made the patent good as to the remainder, provided it was new, and produced two specifications, which he alleged were of the invention in question. Lord Lyndhurst said, "he could not conceive that the act was intended to allow of the confirmation of a subsequent patent, adversely to the rights of prior parties, and that the power conferred upon the Council was discretionary." Lord *Wyndford*: "I apprehend the object of the clause is, if there are any very minute portions which have been used, and the patentee swears he did not know it, in that case the Court would confirm it." The petition was dismissed. On application for costs, Lord Lyndhurst

if the publication is alleged to be a French work, though the work is in England, and it is alleged in the affidavit that the invention is not known in England, such publication will be deemed insufficient to render the patent invalid.

Foreign patent for a similar object.

If it was shewn that there was a foreign patent for a similar invention, the Council would, in such a case, confirm the patent, though they would direct a notice to be sent to the foreign patentee. (*j*) Where persons oppose applications of this kind before the Privy Council, if they are successful in their opposition, costs will be given, upon the ground of public policy. (*k*) In both these cases, if the Crown officer requires it, advertisement must be inserted in such papers as he shall direct.

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said, "If a person entitled to oppose comes and opposes successfully, if we do not give costs, we should discourage persons coming to protect the interests of the public; the costs are given under the general and not under the patent act."—*Dismissed with costs.*

(*j*) Huerteloupe's Patent, Webs. Pat. Ca. 553.—In this case the petitioner stated of what his patent consisted, and that he was not aware that any other person had invented or used the same improvement; but that since the grant of the letters patent, the patentee had discovered that a patent for a similar contrivance had been obtained in France some time before, but which differed in certain particulars from the invention of the petitioner; and that the said invention was known in England only by the means of books printed and published in France, and thence introduced into England. The petition, and that no suit or action had been commenced, was verified, by affidavit, and also by an affidavit of the keeper of the printed books of the British Museum, which stated that twenty volumes of a French work, containing an account of expired patents, had been read at the Museum, in 1832, one volume of which contained the specification. The Council directed a notice to be sent to the French patentee, and an affidavit of sending such notice through the post was held sufficient. The patent was confirmed.

(*k*) In re Westrup and Gibbin's Patent, supra.

CHAPTER VIII.

EXTENSION OF LETTERS PATENT.

Extension of letters patent.

BEFORE the passing of the act of Parliament of the 5 & 6 of William 4, c. 83, any extension of the monopoly granted by letters patent was by a bill passed through the Houses of Parliament, which was an inconvenient and most expensive mode. To remedy the inconvenience and lessen the expense in obtaining such extension, it is provided by the above statute, that her Majesty shall be empowered, on the recommendation of a committee of her Majesty's Privy Council, to extend the period of the original grant, which recommendation is obtained by petition.

Practice.

The parties appear before the Council, by themselves or agents, and prove their rights, and shew they have not benefited to such an extent as will adequately reward them for the ingenuity and cost of the invention.

Practice adopted by the Privy Council.

In hearing and adjudicating upon petitions for an enlargement of the term, the Privy Council are guided, in a great measure, by the rules which were adopted by the House of Lords, when the extension of the time was by bill.

Specification bad.

Where the specification is clearly bad, the patent will not be recommended to be extended; for it is necessary to make out a *primâ facie* case of the goodness of the patent.(*a*) For if a patent which was recommended to be extended, was bad, the vice would extend to the subsequent grant; in such case the extension would be made for the mere pur-

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(*a*) Webs. Pat. Ca. 557, note a.

pose of being vacated, and would only be a source of inconvenience and expense to the patentee. (*b*)

Proceedings instituted to vacate the patent.

In a case where proceedings were pending for the purpose of vacating a patent, which had nearly expired, and application for an extension was made under the 5 & 6 of Wm. 4, their lordships held that such proceedings were no reason why they should not adjudicate upon the matter; (*c*) if the application was under the 2 & 3 of Vict. c. 67, (*d*) it is probable their lordships would wait the event of the proceedings, for the patentee's right would be preserved. The reason of their proceeding in the above case, it is presumed, was, that if they suffered the time of the grant to run out, they would have had no power after that time, and so the adjudication was proceeded with, for the purpose of preserving the patentee's right, and allowing him the benefit of the statute.

Unopposed cases.

In all unopposed cases, it is necessary to give the attor-

(*b*) Kay's Patent, 3 Moore, P. C. R. 24.—Improved machine for preparing and spinning flax.—An objection was made, that the patent was disputed, when it was urged that the patent being near its expiration, unless their lordships adjudicate the right would be gone. Their lordships decided that, the patent being near its expiration, they would proceed, as the prolongation would be of no value, if the Court of Chancery decided against its validity. The usage of the House of Lords has been to grant an extension on the party making out a *primâ facie* case, leaving the validity of the patent for the determination of the courts of law.

(*c*) Webs. Pat. Ca. 557, note a.

(*d*) Vide supra, p. 17, for Digest of Stat.

In Bodmer's Patent, it was objected by the attorney-general, that their lordships could not entertain the application after the expiration of the letters patent; that prosecuting with effect meant something more than the application by presenting the petition, and obtaining a day to be fixed for the hearing must have taken place, to satisfy the provisions in the statute; the 2 & 3 Vict. c. 67, was framed to alleviate the hardships of this case. Their lordships recommended an extension for three years. (2 M. 471.)

ney-general notice of the hearing, that he may attend to protect the interests of the public, though the practice is for him to attend in all cases, whether they are opposed or not.

Recommendation of the Council, how obtained.

In order to obtain the recommendation of the Council, it is necessary, in the first place, to prove the utility of the patent, and also to shew that the patentee has not received any benefit at all adequate to the advantage which has been conferred upon commerce, or society, in consequence of his invention; and that for several years the patent was rendered useless, either by the necessity of testing the invention, (*e*) by reason of undue and improper oppositions, (*f*)

(*e*) Erard's Patent, Webs. Pat. Ca. 557.—Improvements in pianofortes, &c.—The extension was prayed on the ground of the difficulty of perfecting the invention, five years having been necessary to instruct the workmen, and which period had elapsed before a single instrument was ready for sale; and that the outlay in working the patent amounted to 15,000*l.* above the returns. Lord Lyndhurst said, "Upon consideration of the circumstances, the Council would recommend an extension for the term of seven years. In cases of this kind, we expect a very strong case of hardship to be made out, as well as a strong case upon the utility of the invention."

Jones's Patent, Webs. Pat. Ca. 577.—Improvement in wheels for carriages.—The invention had not remunerated the patentee; that it was a matter of great difficulty to perfect the invention, and that was done only within the last five or six years. Extension for seven years recommended.

Wright's Patent, Webs. Pat. Ca. 561.—Improvement in machines, &c., for purposes of bleaching.—The invention took four years to perfect; and when the patent was obtained, the patentee was prevented, by bankruptcy and other circumstances, from benefiting thereby; and that his creditors had reconveyed to him the letters patent. The attorney-general said, he was not aware of any objection, unless that as the patent had not been brought into use, it should be considered as ineffectual, unless the circumstance could be accounted for. Extension for seven years recommended.

(*f*) Robert's Patent, Webs. Pat. Ca. 573.—Improvement to machinery for the purposes of spinning wool, cotton, and other fibrous substances.—The invention has been of great advantage; that the profits realized did not cover the loss of burning the manufactory,

or by circumstances without the control of the inventor: (*g*) where the patent has not been brought into use, unless a sufficient reason is given, it will be an argument, and a great one, against its utility. (*h*)

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supposed to be the act of an incendiary; during the first seven years the patentee got nothing, and during the last three years the invention has been making some return. The term was prolonged for seven years, partly on account of the ingenuity of the contrivance, and partly on account of the peculiar opposition which has been offered.

Stafford's Patent (Webs. Pat. Ca. 563) for improvements in carriages.—The utility of the invention was proved and that the patentee had expended, in his endeavour to introduce the invention, all the money he had, and was greatly embarrassed in consequence, and that the invention had not been productive in consequence of the great opposition which had been made by parties from interested motives. Patent extended seven years.

(*g*) Swaine's Patent, Webs. Pat. Ca. 559.—A method for producing and preserving mineral waters, and the machinery to effect the same. —The ground of the petition was the difficulty of sufficiently making the invention known, and obtaining the public confidence; and that it was not until the last three years the patent had been beneficial to the proprietors, and that much more had been expended in carrying out the object of the patent than had been realized. There was some difficulty as to the evidence: the accounts were produced, but the handwriting of all the entries was not verified. Lord Lyndhurst said, "We are satisfied by reasonable evidence that considerable loss has been sustained, and the period should be enlarged."

(*h*) Sumster's Patent, Webs. Pat. Ca.—Improvement in the manufacturing of cloth, and its application to articles of dress.—No profit had been realized for a long time, and that the profit of the last five or six years had not remunerated the patentee, through opposition, by reports concerning the patent, and vexatious law proceedings. The notice of objections stated the petitioner had compromised the legal proceedings referred to, with a view of prejudicing and deterring other parties known to the petitioner to be infringing the patent, and in consequence of patentee not interfering to stop the infringements, the opponents had embarked a large capital in the manufacturing of the article by steam power; and it was not until the manufacture by steam drove out of the market the manufacture by the loom, that the petitioner amended his patent by disclaimer, with a view to the

Causes deemed insufficient by the Council to recommend an extension.

If a patent be rendered unproductive in consequence of lowering the duty upon certain articles, and by a fluctuation in trade it becomes again productive, such is not a sufficient reason to warrant the interference of the Council, especially if it is proved that there is any difference in the mode used from that recommended by the specification; or if the improvement is introduced from abroad; (*i*) so it is insufficient to state there has been neither profit nor loss; the actual expenses in conducting the patent must be shewn, and the product therefrom. In this case the applicant was an assignee, who had purchased the patent after the death of the patentee, and his only allegation was, that he had purchased the stock of the patentee, and had lost thereby. (*j*)

Rights of assignees, recognition of.

The Privy Council acknowledge in all cases the rights of assignees of patents, (*k*) and regard their petition in the same light as they would that of the original patentee; (*l*)

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present application. Sir W. Follett, on the part of the opponent, stated there was but little novelty in the invention, and that as the public were not benefited, where was the general utility? The slow progress of the sale shewed that the invention was but of small utility, and was in itself an answer to the application; and that the petitioner had slumbered on his rights, and allowed and permitted them to be infringed with impunity. Held, an insufficient case was shewn to warrant the recommendation.

(*i*) Woodruf's Patent.—Proof that patent was a very valuable property, but in consequence of the reduction of duty on a certain class of articles, it ceased to be profitable; but after some time it was applied to silk, and it again became profitable, with an improvement. Opposed on the ground that the improvement was introduced from France, by other persons than the petitioner. Application refused.

(*j*) Quarell's Patent for Improvement in Lamps.

(*k*) In re Galloway, Webs. 725.

(*l*) Wright's Patent, Webs. Pat. Ca. 651.—Application by the assignees of the patent for certain combinations and improvements in making pins.—The deeds of purchase, assignment, and partnership were put in, when it was objected they should be proved in the usual manner. It was answered that no notice of such intention was given in the objec-

but when it appears the assignees have been sufficiently remunerated, though the right has been productive but for a short period, the extension will not be recommended. (*m*)

Smallness of the invention.

In recommending the extension of letters patent, if the subject of the patent be a principle adapted to the purposes of a manufacture, the smallness of the step which led to the result will not influence their lordships; but where the subject of the patent is the mere application of a well-known simple process, which might easily suggest itself to anybody, and which has been employed in respect to other substances, the conclusion will be different, and the difficulty of the process will be a matter which their lordships will consider. (*n*)

Application of a simple mechanical process.

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tions declared in pursuance of the decisions of the Council. Their lordships intimated that the applicants must make out their title. The application was on the ground of the immense cost of the machinery, and delay in carrying it out in consequence of the ill-faith of the patentee. It was prayed, on the part of the opposers, on their lordships intimating an intention of recommending an extension for five years, that they should be remunerated for the expenses they had been occasioned by their connection with Wright, and that they might be declared entitled to the joint use of the new letters patent. Their lordships said they should recommend the extension of the patent in favour of those in whom the legal estate of the patent was vested, leaving to the opposers and the representatives of a deceased partner any claim they might have in law or equity. New letters patent were granted the assignees for five years.

(*m*) Morgan's Patent (Webs. Pat. Ca. 733), which was an application by the patentee in conjunction with the assignees.—The petition was refused, their lordships being of opinion that the assignees had been sufficiently remunerated, and that the patentee was only a nominal applicant, and that though the invention had merit, it seemed of very moderate degree, and that if they granted an extension of the term in this case, they would have to do so in every other. Refused.

(*n*) Soames's Patent (Webs. Pat. Ca. 729) for a new preparation or manufacturing of certain materials produced from a vegetable substance, and the application thereof to the purposes of affording light,

In cases of opposition, where it arises from jealousy, and is needless—the attorney-general attending to protect the interests of the public—costs of the opposition will be allowed, if it is unsuccessful;(*o*) so where a petition has

Costs of opposition.

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and other purposes.—The petition stated the great utility of the invention, and that a large capital was embarked in the manufacturing of the article, and that the return was considerably less than are the ordinary returns on manufacturing capital. In conclusion, the petition stated, as grounds for the extension, the introduction of a new trade and manufacture, the utility and importance of the invention, and the want of remuneration, from the difficulty experienced by the assignees from circumstances over which they had no control. It was objected, the invention was not new, and that only a very small step was necessary to complete the invention. Lord Brougham: "The merit of an importer is less than that of an inventor, and it is an argument against the patent that it was imported and not invented, and that the public benefit is very much reduced if a thing was known before." Lord Campbell: "It is overcoming certain difficulties in separating the stearine and ealine oils for which the patent is taken out. Sir T. Wilde contended, that however small the step, it made all the difference between a worthless commodity, and one most valuable." Lord Brougham in saying the patent would be recommended to be extended in a small degree, said, "It was very fit their lordships should guard against the inference being drawn, from the small amount of any step made in an improvement, that they are disposed to undervalue it in importance, when a new process is found out, and applied so as to become the subject of a patent. However small the advance on the previous knowledge, it is no reason for undervaluing the merits of the discoverer, for the history of science, from the greatest discoveries to the most unimportant, is one continued illustration of the slow progress by which the mind makes its advance in discovery. But such is not the case here, for this is only a new application, which might suggest itself to any person." Patent extended for three years.

(*o*) Downton's Patent, Webs. Pat. Ca. 565.—Improvement in water-closets.—Petition stated difficulties arising from want of capital: the opposition was on account of the high rate of charge, and that the patentee would not allow the trade any advantage. The invention was very useful for ships. A lord: "The fact of a great number of the articles being sold, when the cost is more than four times that of the ordinary article, is a proof of its utility." The proof to

been abandoned, their lordships will grant, on application, costs to the opposing parties. (*p*)

Cause which led to the enaction of the 2 & 3 Vict. c. 67.

In Bodmer's Patent, it was objected that, when the letters patent had expired, their lordships could not, under the statute of William, entertain the petition. This was allowed to be a valid objection, and led to the enactment of the 2 & 3 Vict. c. 67, which saves the right of petitions not adjudicated on before the expiration of the grant, if the petition has been presented six months before the time of its expiration; but the Privy Council will require a sufficient reason to be rendered why a petition was not proceeded with if duly presented.

Delay by misfortune.

It will be seen in this, as in every other branch of the law of patent, that strict equity is the principle on which the decisions are based. It will be seen, from the cases cited, that the Privy Council have regard for the misfortunes of the patentees, and those connected with them, if they are urged as a reason for the non-productiveness of the patent; but in all cases, the subject of the patent must be shewn to be an invention of great utility; and if any delay has occurred in making it productive, that such delay has not arisen from carelessness or inactivity, but from misfortune, or unavoidable circumstances, or the necessity to perfect the invention, or from improper opposition or prejudice, or such reasons; otherwise, the want of energy in the grantees would be made a tax upon the public, instead of their ingenuity and industry; for the prolongation of the term is depriving the public of a right, and is of necessity a tax;

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warrant the extension is this, that the patentee has made nothing for seven or eight years (uniform small profits spread over the period of the grant would be insufficient). Patent extended for five years; the costs of the opposition were allowed; one of their lordships remarking, the attorney-general is here for the public, at all events.

(*p*) Mackintosh's Patent, Webs. Pat. Ca. 739.

for an article protected is only procurable at a greater cost than one which is open to public competition. Where the petitioner had patronized an ingenious invention, and expended large sums of money to bring it to perfection and introduce it, the amount of profit, not having been greater than in ordinary mercantile speculations, would be taken into consideration, and would be a good ground for an extension.

Condition sometimes annexed to extensions.

The Privy Council sometimes annexed a condition, as in the patent of Whitehouse, which was an application for an extension by the assignee. The extension was recommended on condition of the assignee allowing an annuity to the patentee during the period of the new term.(*q*)

Profits, how estimated.

In estimating the profits, the expenses of bringing the patent into use, and the litigation consequent upon maintaining the right, are always to be deducted; and also a manufacturer's fair profit is to be deducted and distinguished from the profits accruing through the monopoly.(*r*)

Rules of evidence adopted by the Privy Council.

The rules of evidence adopted by the Council are those of the common law. In all cases the right of the petitioners must be proved; and also that they have in all things complied with the regulations of the act (as advertising, &c.); and those imposed by the Privy Council, as the delivery of objections to be relied upon by those in opposition.

Cases formerly proper to be extended by Parliament.

All cases which would have been considered proper cases to carry before the Houses of Parliament, for the purposes of an extension, will receive every consideration by the Privy Council acting under the statute.

(*q*) In re Whitehouse, ex parte Russell, 2 Moore, P.V.R. 496.
(*r*) In re Galloway, supra.

Employment of the poor.

In the case of the Lustring Patent, which was the introduction of a new manufacture from abroad,(s) the employment of the poor was one of the grounds urged for an extension. If it had been the only ground, it is doubtful whether the mere employment of the poor would have been considered a sufficient reason for the extension of the time: (it would, it is apprehended, be necessary to shew also an inadequate remuneration, or a case of hardship); for the poor would be equally employed by the invention being thrown open to the public, and, perhaps, to a greater degree; and the absence of the monopoly would create competition, which would have the effect of lessening the price of the protected article, and, by consequence, lead to an increased consumption. But where, as in the case of Lomb's Patent, and in other cases collected in Webster's Patent Cases, it was shewn it required much expense, difficulty, and time to perfect the invention, such matters would be taken into consideration.

(s) Vide Re Morgan, supra.

CHAPTER IX.

THE NATURE OF THE PROPERTY CONFERRED BY THE GRANT OF LETTERS PATENT—RIGHTS OF THE PATENTEE—MEANS OF CONVEYANCE—PARTNERSHIP—BANKRUPTCY—INSOLVENCY.

Grant, nature of, and property conferred.

HAVING, in the previous part of this work, treated upon all the matters necessary to procure or render a patent valid, it becomes our duty to treat of the nature of the property the grantee obtains, and the rights which are incidental to his grant. To arrive at a correct conclusion, we must examine the grant, and its construction, *i. e.* the letters patent. (*a*)

Patent, recital in.

It will be seen, by referring to the form of the grant, that it contains a recital of the motives of the sovereign in making it, and the rights which are thereby vested in the patentee, and also a proviso that it shall be void if it be prejudicial or inconvenient to her Majesty's subjects generally, and also if it be not new; and that the grant shall not create any privilege inconsistent with a prior grant; and also that it shall be void if it becomes vested in, or be held in trust for, more than twelve persons (such proviso does not extend to the granting of licenses). If it be desired that more than twelve persons should be interested in the patent, an act of Parliament for that purpose must be obtained. (*b*)

Licenses, grant of, effect.

Formerly there was much speculation as to the intention of this clause in the grant, as to what class of persons it was

(*a*) Vide Appendix for form.
(*b*) In re Head's Patent, Head *v.* Carey, 6 Law Times.

intended to include; viz. whether it extended to the parties to whom the patent was assigned, and to such persons as they should grant licenses to, or only to the original proprietors of the patent. The case of Protheroe v. May and Others(c) (which was an issue directed by the Court of Chancery) has finally settled the matter. The facts of the case were as follows: A patent was granted to one Dunn, who assigned it to twelve persons, who were from thence to become interested in the profit of the said patent; and they granted licenses to certain persons, amongst others to the said plaintiff, for a particular district, who assigned his license to a company consisting of more than twelve persons; the question was, whether the clause applied to licensees as well as to trustees. The Court decided that the grant of the licenses, and their becoming vested in more than twelve persons, had no effect to render the patent invalid.

Clause in the patent restricting the grant to twelve persons. Construction.

The clause only extends to voluntary assignments, and not to assignments by the operation of the law;(d) as if one of the partners died, and left two executors, or became bankrupt, and his estate vested in two assignees, the executors or the assignees would be considered as only representing one person, such vesting being wrought by the operation of the law; but if one of the partners become a partner with others in his share, in such case, though the partnership would only represent one share, the engagement is a voluntary one; and as it is not necessary that the interests of each person should be equal, to constitute the partnership in the patent, it is apprehended that such person and his partners would be deemed to be partners in the patent. In such case, the patent, being vested in more than twelve persons, would be void: if it were not so, a patent might be divided into any number of shares, and the

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(c) 5 M. & W. 675. (d) Bloxam v. Elsee, 6 B. & C. 169.

vesting the shares in twelve persons would be sufficient to satisfy the provision in the patent, though the property was actually vested in a thousand persons. (*e*) This construction may, at first sight, appear a hardship, as it seems to be giving to any of the associated persons power to defeat, at any time, the object of the partnership, and to make void the patent; but in partnerships it must be recollected that the broad rule of law is, that the act of one of the partners shall bind his fellows. A partnership is not constituted by any construction of law, but by the agreement of the parties themselves, and is entered into with a full knowledge of the consequences, and the powers with which each invests the others. There is no greater risk in the case of a patent than in any other mercantile pursuit; for in all partnerships, an unprincipled associate has power to wreck the scheme and ruin his fellows; besides, the partners, having knowledge of the clause in the patent, could, were they so disposed, bind each other by bond, conditioned in a penalty, not to associate any other person with any member in the scheme. In the case of a partner associating another person with him (in partnership in his share), it perhaps may be urged that, with the others the person associated is not a partner: even so, but it cannot be denied, that to the world he is a partner, and as he participates in the profits, he is liable for the debts of the partnership; if then he, for any purpose, is a partner, he is within the restrictive clause.

Mr. Webster, in a note to Protheroe *v.* May and Others,(*f*) suggests that "some of these consequences might be avoided by a license instead of an assignment, the rent or license dues being reserved by *way of per-centage upon the gross amount of the sales*, instead of by *way of share in*

(*e*) Duvernier *v.* Fellows, 5 Bing. 248; in error, 10 B. & C. 826.
(*f*) Webs. Pat. Ca. 417.

the profits, or per-centage on the net returns," and refers to the cases of Elgie *v.* Webster,(*g*) and Ridgway *v.* Philips.(*h*) With all deference to the suggestion of the learned reporter, it appears doubtful, whether, if the plan could be carried into effect, it would not, in truth, be a grant of a part of the profits, and have to be so pleaded; the rule being, that instruments shall be pleaded according to their effect. If, then, it be a grant, how is the partnership avoided? for in any case it must be a license to participate in the profits to be gathered from the patent. Calling the grant a license would evidently be a merely colourable deviation, and one of which the intention would be too evident to be mistaken. If the suggestion could be effected in the way proposed, and the *licenses* were good as licenses, the participation in the profits, which would be consequent upon them, would constitute a partnership; if so, it would be a vesting of the patent in more than twelve persons, and the effect to make it void. The reserving of the rent or license dues upon the gross amount of the sales, and reserving them by way of share in the profits, seems to amount to the same thing, for in either case it appears to be a participation in the profit to arise from the patent.

License, intention of.

The appointment of a certain district, with power to under-let licenses, would, it is apprehended, amount to the same thing, and be construed to be a mere colourable deviation; for the intention of the saving proviso is not that numbers of persons shall be interested in licenses, with power to sub-let, but that the licensees interested shall be so with the intention of carrying into effect the patent. Protheroe *v.* May proves that a person may assign his license, but not that he may sub-let, for that would be creating an interest in the profits of the patent itself, and not the grant of a mere power to carry out its object, or a

License, intention of.

(*g*) 5 M. & W. 518.
(*h*) 1 Cr. M. & R. 415; 5 Tyr. 131, S. C.

permission of user, which, it is submitted, is the real intention of the power to license.

It is by virtue of the clause contained in the grant that the patentee, or those who represent his rights, have power to grant licenses, and which power is most reasonable; for if the patentee had it not, it might tend to the complete stoppage of the particular trade of which the patent was an improvement, or to create a monopoly in the hands of the patentee, not by prohibiting the sale of all other than the patented article, but it might be that it was made at so much less a cost, as to defy competition, and vest in the hands of the patentee the exclusive trade; and which, if the patent was granted for an article in general use, as for an improvement in the manufacture of iron, by which the cost was lessened one-half, it might tend to the public injury; therefore, it is presumed, the licer sing clause was inserted, that by receiving a sum in the shape of royalty, the patentee might be remunerated. If it was shewn that the patentee refused to grant licenses, and that he was unable fully to exercise his privilege, and importations of a similar commodity (not of the patented article, for that would be equally an infringement upon the exclusive right as manufacturing within the kingdom) were procured from abroad; or, it might be, the invention not being protected abroad, that the patented article was manufactured there, and the foreign markets supplied by foreign produce to the injury of the home trade; it is presumed, under such circumstances, that the patent would be construed to be within the sixth section 21 Jac. c. 3, which provides, that it shall not be to the *hurt of trade*, or a prejudice and general inconvenience to her Majesty's subjects. The patentee in such a case would be recompensed out of the public purse by means of a parliamentary grant.

Refusal to license, effect.

Licenses are of various kinds—as a sole license to use

the invention within the whole extent of the grant, or to use a part thereof, or within a particular district or place; or a common license to use and vend without any restriction against the patentee granting licenses to others in the same place. It is not necessary that the grant of a license should be under seal;(i) but where the license is not under seal, the doctrine of estoppel does not apply, and if the patent is in itself void, a plea putting it in issue would be an answer to an action for the reserved rent. (j)

Estoppel, when it does not apply.

(i) Chanter *v.* Dewhurst, 12 M. & W. 823.—*Indebitatus assumpsit* to recover 31*l.* 10s. for a license to use patent invention.—The license granted was not under seal, but written; patent reciting the licenses granted should be under seal. It was objected, the license not being under seal, was void; and answered, that the defendant having kept and used the license, could not object, and was liable to pay for it. The judge refused to nonsuit, and jury returned a verdict. On motion, "to grant a license not under seal may be a fraud on the Crown, but does not exempt him to whom it is granted, and who derives benefit therefrom, from paying the price of it."—Alderson, B. (825.) The object of the patent is to prevent another from making the article for sale, not to prevent him from using it.—Ib. "The defendants have got all the plaintiff agreed to give, and must pay the stipulated price."—Parke, B. (826.) "If defendants intended to avail themselves of this objection, they should have made it earlier, and not have kept the license."—Alderson, B.

(j) Hayne and Another *v.* Maltby, 3 T. R. 438.—Action of covenant on articles of agreement, which stated a grant by the plaintiff to the defendant to use a patent machine for making stockings in a certain way.—The declaration averred enjoyment, and assigned breaches, using, &c. other machines than those agreed, and also for using engines, &c. resembling the patent; to which were several pleas. Third set forth the patent, and stated, &c., it should be void if specification was not enrolled, &c., and that it was not. Fourth, not a new invention. Fifth, not discovered by patentee, to which plaintiff demurred. Defendant attempted to put in issue matters foreign to the merits of the cause, as by his deed he was estopped from so doing. Held, "the doctrine of estoppel does not apply here, for the very person to be estopped is he who has been imposed upon:" Lord Kenyon, mentioning Oldham *v.* Langmead,

In a case where there were several parties to an agreement, which was for the use of several patent rights, but the subject of the action was for a distinct sum agreed to be paid to one of the parties (the original inventor), who brought the action in his own name: the Court held the non-joinder of the other parties to the agreement, though they had no interest in the particular sum the subject of the action, was a variation between the declaration and the contract. (*k*)

Non-joinder of the parties.

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saying, "The case differed; for there a person assigned his right in the patent, and yet, in violation of his right, infringed the plaintiff's right, and attempted to deny his having any title to convey." (441.)

The plaintiff has not the right he pretended to confer, and therefore the defendant had not the consideration for which he entered into the covenant.—Buller, J. (442.)

(*k*) An information in the nature of a *quo warranto*. (Chanter *v.* Leese, Cussons, and Diggle, 4 M. & W. 295; confirmed in error, 5 M. & W. 698.)—An agreement, not under seal, was entered into by the plaintiff and others, with the defendants, to use certain patent rights in which they were interested, and that they (the defendants), for certain considerations, were to have within a certain district the sole right to use such patent; one of which considerations was, that the defendants should pay the plaintiff 400*l.* a year, by half-yearly payments. The action was brought for 200*l.* Declaration stated agreement, and alleged as breach non-payment. There was also an account stated. Pleas, *non assumpserunt*, letters patent (setting them out); supposed improvement was not a new invention. Verification. Not invented and found out by the plaintiff. Verification. Plaintiff took issue on first plea, and demurred to second and third, assigning same cause of demurrer to each, viz. that the plea contains matter, which, if true, constituted an answer, or defence, to part only of the cause of action in the first count, in this, to wit, that the promise to the defendant in the first count was made in consideration of the right and liberty to use and vend the whole of the said patentee's inventions in the said agreement in the first count set forth; and the defendant attempts to avoid the agreement upon the allegation of matter, which, if true, tends to invalidate only one of the said patents, &c. Joinder in demurrer. Lord Abinger, C. B., delivering judgment of the Court: "We think judgment

Money paid for a license under a void patent.

Though the invalidity of the patent is an answer to the action for the rent, yet the party cannot recover back such moneys as he has paid the supposed patentee for the use of the privilege which the license was intended to confer. (*l*)

Estoppel, when it applies.

Where the licenses are granted by deed (*i. e.* by agreement in writing under seal), the doctrine of estoppel applies, and a person would not be allowed to disavow so solemn an act. (*m*)

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should be for the defendant on demurrer. The declaration is founded on contract; if the person is unable to do what he contracted for, the contract is at an end. The possession of all and each of the said patents being an entire consideration, the plea impeaching that is a good consideration to avoid the whole contract as it appeared on the record. We think that there was a variation between the declaration and the contract in not setting out all the contracting parties." Judgment on demurrer, and rule absolute for a nonsuit.

(*l*) Taylor *v.* Hare, 1 New Rep. 260.—Action for money had and received.—The defendant, supposing himself the inventor of a valuable invention, agreed to let the plaintiff use it, upon consideration of an annual amount, which for several years was paid, and then it was discovered that the defendant was not the inventor. The action was to recover back the money paid. Held: Two persons equally innocent make a bargain, and one agrees to pay the other for the use, and he has it, it is in the nature of a partnership. Plaintiff cannot recover.—Lord Mansfield, C.J.

"We cannot here take an account of the profits."—Heath, J.

(*m*) Bowman *v.* Taylor and Others, 2 Ad. & Ell. 278.—Covenant.—Declaration stated an invention in constructing looms for weaving, termed "power-looms," for which a patent was obtained with power to vend the same, &c. Plaintiff had agreed to permit the defendants to use said invention upon certain considerations set out. Breach, non-payment of consideration, and non-fulfilment of other covenants. Plea, setting out letters patent, &c., and then averred the patent was not a new invention; second, plaintiff was not first and true inventor; third, plaintiff did not specify, &c. To all the pleas there was a demurrer; joinder in the demurrer; there were also issues in fact. Lord Denman, C.J.: "The plaintiff contends these pleas are bad, because the defendant is estopped by his deed from pleading them. As to the doctrine laid down by Lord Coke (Co. Litt. 352*b*), 'that a recital does not conclude because it is no direct

Where the sufficiency of a license by deed is put in issue, and with it is joined an issue in fact, such issue in fact should be left to the jury: if it is not, it will be a ground for a new trial. (*n*)

Sufficiency of a license by deed and motion of fact, question for a jury.

Joint owners of a patent are partners, and are therefore amenable to the laws of partnership; and if one induces a person by fraud to purchase a license which turns out of

Joint owners in patents.

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affirmation,' the authority is a great one; but still, if a party has by his deed recited a specific fact, though introduced by 'Whereas,' it seems impossible to say he shall not be bound by his own assertion so made under seal" (citing Lainson, executor of Griffiths, *v.* Tremere, 1 Ad. & E. 792). Taunton, J.: "The principle of the law of estoppel is where a man has entered into a solemn engagement, by deed under his hand and seal, as to certian facts, he shall not be permitted to deny any facts he has so asserted. This case is distinguished from Haynes *v.* Maltby. Here, there is an express averment that the plaintiff is the inventor of the improvements; there, the articles of agreement merely averred (nothing as to the origin of the invention), but merely stated plaintiffs were assignees of the patent." Patteson, J.: "The deed recites plaintiff invented and obtained a patent for certain improvements, and proceeds to a demise of the subject-matter for which the patent is so granted. I cannot separate these things. The passage in Lord Coke must be taken with some qualification. Lainson *v.* Tremere is a direct authority to shew there may be an estoppel by way of recital."

(*n*) Bowman *v.* Roshon and Others, note b, 2 Ad. & E. 295.—Declaration same as Bowman *v.* Taylor. Pleas, *non est factum*, and same pleas as in Bowman *v.* Taylor; and fifth, a further breach of the conditions of the letters patent. On trial before Lord Denman, C. J., plaintiff put in counterpart of indenture which was executed by defendant. The Chief Justice held the recital to be conclusive as to the second and third pleas, so as to preclude evidence being given in support. The defendants then not insisting on the fourth and fifth pleas, a verdict was taken generally for the plaintiff, leave being given to move for a new trial, on the ground that the inference to be drawn from the deed, as to the truth of the allegations in the pleas, should have been left to the jury. On argument of the rule, Lord Denman said, "We are all of opinion there must be a new trial: a specific issue, in fact, having been joined, and evidence offered on it at trial, which was not received. Both had liberty to amend pleadings, without costs."

no value, if the others are made parties to the contract, they will all be liable to refund the purchase-money so obtained. (*o*)

Agreement conditioned in a penalty.

Where the discoverer of an invention discloses it to another person, who agrees not to avail himself of the secret, under the *penalty* of a sum of money, and he breaks his agreement, such word penalty cannot be read as liquidated damages. (*p*)

Property conferred by a patent.

By the grant of letters patent, the property conferred on the patentee (supposing his patent to be valid) is of as

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(*o*) Joint owners of a patent are considered as partners; and where a party had been induced by the fraud of one of such joint owners to purchase from him, by an agreement, to which all were parties, the use of a patent right, which turned out to be of no value, it being proved to be a mere, but old, speculation: Held, that each of the parties to the contract, one of whom had no interest in the patent at the time of the contract, was liable to refund the whole of the purchase-money fraudulently obtained.—Lovell *v.* Hicks, 2 Y. & C. 481; on rehearing, see S. C. 2 Y. & C. 58.

Quære, as to effect on right of plaintiff to recover the whole from each, had it proved that he knew that three of the parties to the contract were, by special agreement, entitled in severalty to different proportions of the profits of the patent, and that one of them had no interest in it whatever.—S. C.

(*p*) Smith *v.* Dickenson, 3 Bos. & Pul. 630.—Assumpsit.—Declaration stated plaintiff had invented certain improvements in a saddle, and confiding in defendant's promise, plaintiff told defendant the secret, but the defendant wrongfully obtained letters patent therefor. It was proved, at the trial, plaintiff had invented the spring apparatus, and that defendant being desirous to know the secret, had bound himself in 1,000*l.* not to avail himself of the knowledge which defendant should communicate. On obtaining the knowledge, defendant entered a caveat against any other person taking out a patent for the same thing, and took out patent himself; and that defendant being unable to make out the specification alone, was assisted by plaintiff on condition of their sharing the invention. Jury found a special verdict, damages, &c. The Court held, the word penalty excluded the notion of liquidated damages. It was held, the subsequent meeting did not vacate the original, but the fraud practised upon the plaintiff was only a continuation of it.

absolute a nature as any other property, and which he may by way of sale assign (*q*) or mortgage, and his transfer will vest in the assignee as absolute a right as he (the patentee) had before the assignment. It may also be made the subject of a trust, which doctrine was formerly doubted,(*r*) but now it is the constant practice to make patents the subject of trusts.

Patentee, bankruptcy of, effect.

Being a recognized property, it is, of course, amenable to the bankrupt laws, and would pass to the assignees as well as any other property. But if the invention is still in embryo, and not made the subject of a patent until after the bankrupt has obtained his certificate, the assignees would have no right to the invention, for until it becomes patented, the invention cannot be said to be property ;(*s*)

Insolvency of.

and so the right and interest an insolvent has in letters patent will pass under the assignment of the effects of the insolvent to the provisional assignee. Future patents will be subjected to those rules which govern any future property an insolvent may acquire, and it follows they may be seized in execution, and sold by the sheriff under a writ of *fieri facias*.

(*q*) Cartwright *v.* Amatt, 2 B. & P. 43.

(*r*) Ex parte O'Reilley, 1 Ves. jun. 129. Lord Thurlow.

(*s*) Hesse *v.* Stevenson, 3 Bos. & Pul. 577.—"The schemes which a man has in his head before he obtains his certificate, or the fruits which he may make of such schemes, do not pass to the assignees, nor could they require him to assign them over, provided he does not carry them into effect until after he obtains his certificate; but if he avails himself of his knowledge and skill, and thereby acquires a beneficial interest which may be the subject of assignment, why should not that interest pass in the same manner as any other property acquired by his personal industry? We are, therefore, of opinion, that the interest in letters patent is an interest of such a nature as to be the subject of assignment by the commissioners"—(Lord Alvanley, C. J., 578 and 579)—"and if the patent be conferred by Act of Parliament, it is the same."—Ib.

Alien enemy, trust for.

A doubt has been raised whether a patent can be held in trust for an alien enemy. From the general policy of the law, it would be presumed it could not, and the trustee would not be bound to execute the trust, for the proceeds thereof might be employed against the country. It is clear, no action could be prosecuted with effect by such alien enemy, but an action by the trustee for an infringement of the patented right would be governed by entirely different considerations; but whether an action could, under such circumstances, be maintained by a trustee, is a fair subject for doubt.

Clause to supply government.

The patent sometimes contains a clause that the patentee shall supply the government with the invention at reasonable prices; in such case, where the government have been supplied with the invention, a mandamus will not be issued to compel the particular department of the government to which the supply appertains to fix the price; (*t*) the only remedy would appear to be upon the contract.

(*t*) Ex parte Perring, 4 Ad. & E. 949.—Patent for constructing anchors, which contained a proviso to void the same, unless patentee supplied the dock-yards, at the times and at such prices as should be settled by the Lords Commissioners of the Admiralty for the time being.—Motion was for a mandamus to command the Lords of the Admiralty to settle the price. The affidavit stated the patent; that the Admiralty had anchors so constructed, and refused to give the patentee the proper remuneration. The claim seems to be in the nature of a *quantum meruit* for the use of the patent. Littleton, J.: "The claim, if valid, must be founded upon a contingeney. We cannot grant a mandamus to a public board, ordering them to carry a contract into effect."

CHAPTER X.

PROTECTION OF THE PATENTEE IN THE ENJOYMENT OF HIS RIGHTS —INFRINGEMENT—INJUNCTION—PROCEEDINGS AT LAW.

Remedy for wrong.

THE next subject of consideration will be, to what protection is the patentee entitled, and in what way can he enforce his rights, which may be divided into two heads: the summary jurisdiction of the Lord Chancellor, which is by injunction; and the enforcement of the claim by an action at the common law and the recovery of damages; but, before entering upon these heads, it will, in the first place, be necessary to shew what is an infringement of a patent right.

INFRINGEMENT.

Infringement.

The forms in which infringements present themselves are various, and must depend upon the nature of the invention. In a process, it will be by imitation; in a machine, by its manufacture or use; in a vendible article, by making and selling. The mere exposure to sale is not a selling, and would be insufficient to satisfy the word vend in the prohibitory part of the patent.(*a*)

Vending, what.

(*a*) Minter *v.* Williams, 4 Ad. & E. 251.—Case for infringing patent by making and vending chairs in imitation of the said invention.—"The prohibitory part of the patent does not mention vending; the word generally used is 'sell.' There is a great distinction between vending and exposing to sale."—Patteson, J. (255.) "The prohibitory part of the patent forbids all persons 'to make, use, or put into practice the said invention, or to counterfeit, imitate, or resemble the

Similarity of structure.

Similarity of structure to the patented article, until the contrary is shewn, would be presumptive evidence of the two articles being of the same construction, and of the imitation being a piracy. (*b*)

Principle, construction.

In the case of a principle, however great may be the improvement introduced, if the adaptation is in the same mode as that suggested by the specification, the difference being in the form by which the principle is applied, it will be held to be an infringement; (*c*) for identity of purpose and not of name is the criterion by which the infringement is to be judged. (*d*)

Equivalent, use of.

Where a patent specifies for the use of a particular article, the use of some well-known equivalent would be an infringement; but when certain articles are used without intending to infringe the patent, and the party using them does so in ignorance that he is thereby infringing the patent, especially if it is unknown to science that the particular compound would be produced by using the articles which were well known, such use would be no infringement; (*e*) but, after

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same, or to make any addition thereunto or subtraction therefrom, &c.' The count alleges, that the defendant, without the plaintiff's license, exposed to sale certain chairs, intending to imitate, &c., and which did, &c., his invention. Do these words necessarily import the vending spoken of in the granting part of the patent? I think it means the habit of selling and offering for sale. A mere exposure to sale with intent, &c. is not equal to a sale; the word vend we ought to read only so as to give the meaning which would effectuate the purpose of the patent, viz. the prevention of acts injurious to the patenee, with as little restraint on the public as possible. I cannot say a mere exposure to sale is injurious to the patentee, it might be beneficial."—Coleridge, J.

(*b*) Huddart *v.* Grimshaw, supra.

(*c*) Neilson *v.* Harford, supra.

(*d*) Cutler's Pat. infra. Russell *v.* Cowley, Webs. Pat. Ca. 462.

(*e*) Heath *v.* Unwin, 9 Jurist, 231.—Case for infringement of patent for improvements in the manufacture of iron and cast-steel, to which, amongst other pleas, defendant pleaded not guilty.—The

an action, it is presumed, the nature of the articles would be a publication to the world, and then user of the same things would be held to be an infringement of the patent. So a

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plaintiff obtained a patent for improvements in the manufacture of iron and steel, and in his specification mentions several. The question here arises, upon the claim to use carburet of manganese for the conversion of iron into steel. The specification mentioning the use of the oxide of manganese, describes the part of the process alleged to be 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, and its carbonaceous matter, along with 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 use of any such mixture of cast and malleable iron and malleable iron and carbonaceous matter, as any part of my invention, but the use of carburet of manganese in any process for the conversion of iron into cast-steel;" and, in summing up his claims, he states the third to be the employment of oxide of manganese alone in producing of cast-iron; and the one in question, the employment of carburet of manganese in preparing an improved cast-steel (carburet of manganese is formed by the fusion of black oxide of manganese and carbonaceous matter). It was proved the defendant did not put the carburet of manganese, but the oxide of manganese and carbon, into the crucible together with the steel; and evidence was given, that before combining with the steel, the ingredients would form carburet of manganese, which the jury found to be true; and, also, that the quantity of carburet so formed would be less than one per cent. of the weight of the steel in the crucible. The patent was obtained for the use of a peculiar combination of carbon and manganese, called carburet of manganese. The question then is, is this a mere colourable variation? If the defendant substitutes for part of plaintiff's invention some well-known equivalent, whether chemical or mechanical, it would be a mere colourable variation. It is clear, from the evidence, defendant never meant to use carburet of manganese, and we do not consider the defendant can be deemed guilty of an indirect infringement of the patent, for neither he nor any one else, prior to this investigation, knew that carburet of manganese would be found in the crucible in a state of fusion; and even then, it is a mere speculative opinion,—though, after the verdict, we must assume it to be a correct opinion amongst men of science.

Colourable deviation.

mere colourable deviation would be an infringement of the patent. (*f*)

Improvements.

Where improvements are claimed, they must also be shewn to be new: an imitation of any part of the invention is suf-

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(*f*) Walton *v.* Potten, 4 Scott, 91.—The jury found on all the issues for the plaintiff. After commenting upon the whole of the issues, his lordship said: "There is only one or material issue, whether sheet cards or top cards were material or not, according to the mode of adaptation described in plaintiff's specification. The jury found for plaintiff, the evidence being the actual user of sheet and top cards and the trial of experiments (though, perhaps, since the action was brought): on the part of the plaintiff the evidence was positive, opposed by judgment and belief on the part of the defendant."—Tindal, C. J.

"'I confine my claim, &c. to the application of India-rubber as the fittest, &c., in which the dents or teeth are to be set together in the manufacture of cards, obtaining thereby a superior elasticity.' It appears to me to involve not a mere simple claim to the use of caoutchouc, but its adaptation for the reception of the teeth, by putting at the back of it a linen cloth, which is proved to be an essential part of the manufacture, though it be afterwards removed." (142.) Being more elastic, it facilitates the insertion of the teeth. (143.) Coltman, J.

"The plaintiff's card is formed by the insertion of the dents or teeth in a fillet or sheet composed of a slice of caoutchouc, cut from the block as imported into this country, or as improved by being made more compact by a chemical or mechanical process, cemented to a piece of linen or brown Holland, an additional elasticity being given to the teeth by the India-rubber in which they are imbedded. The defendant's card is made by inserting the dents or teeth in a mixed fabric that has been previously saturated or impregnated with a solution of India-rubber, and made compact or firm by rolling, after the solvents have been evaporated by exposure to the atmosphere, the object being the attainment of a greater degree of elasticity, through the medium of the India-rubber, than the cloth would possess without. The principle of both methods is the same; they differ only in the manner of applying the India-rubber. I think the verdict of the jury affirming the infringement was right."—Erskine, J. (159.)

"By defendant's specification, the claim is of a new material for forming the backs of cards, and explains it thus: &c., &c., producing the same result as plaintiff's by a circuitous mode."—Maule, J. (151.)

ficient to maintain the action. It need not be shewn that the perfected article imitated in all its parts the original invention; (*g*) for the substance of the invention and its principle, and not the mere form, are to be looked at. (*h*)

The sale of a pirated article is sufficient to constitute an infringement of a patent. (*i*) Sale of a pirated article.

A licensee, in cases of infringement, is a competent witness to prove the infringement; (*j*) but in all cases the question of infringement is a question of fact for the jury. (*k*) Licensee a competent witness.

INJUNCTION.

Proceeding by injunction is the mode which patentees usually select; for in that case the infringement is stayed immediately, or, if allowed to be continued, which it is under special circumstances, an account is directed to be kept. Injunction. Account.

(*g*) In an action for the infringement of a patent for improvements in a cabriolet, the defendant pleaded—1, not guilty; 2, that the improvements were not new; 3, that the plaintiffs were not the true and first inventors of the improvements:—Held, 1st, that on these pleadings it could not be contended that the patent was illegal as a monopoly; 2nd, that though all the improvements claimed must be shewn to be new, it need not be shewn that the defendant's cabriolet was an imitation of all of them—an imitation of one was sufficient to maintain the action; 3rd, that the validity of the patent might be considered to have come in question, so as to entitle the plaintiff to a certificate to that effect under the 5 & 6 Wm. 4, c. 83, s. 3.—Gillett *v.* Wilby, 9 C. & P. 334; et vide Jones *v.* Pearse, supra.

(*h*) Morgan *v.* Seaward, supra.

(*i*) Cornish *v.* Keene, supra; Gibson *v.* Brand, supra. S. P.

(*j*) Derosne *v.* Fairlie, 1 M. & Rob. 457.

(*k*) Boulton *v.* Bull, supra; Hale *v.* Boot, Webs. Pat. Ca. 101; Heath *v.* Unwin, supra.

Injunction, how obtained.

An injunction is obtainable upon *ex parte* evidence. In the bill, the patentee or assignee, as the case may be, must set forth his title and make out a sufficient *primâ facie* case; the infringement must be distinctly alleged. In the case of Stultz *v.* De la Rue,(*l*) Lord Lyndhurst, Ch.,

Injunction.

said, "When a party comes for an injunction against the infringer of a patent, he ought to state that he believes at the time he makes the application that the invention is new, or had never been practised in this kingdom at the date of the patent. It is not enough that he believed it to be new at the time when the patent was taken out;" and that he is the true inventor,—mere belief will not be sufficient.

Injunction, when granted of course.

An injunction is always granted immediately if the patentee has been in possession of his rights for some time.(*m*)

Answer to bill, when put in.

If the defendant intends to dispute the right the patentee claims, from some informality in the grant, or other reason, he puts in an answer to the bill; on the hearing, if the Court thinks the objection to the patent is one which is sustainable, they will sometimes dissolve the injunction and direct an issue at law; the defendant in the meantime to

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(*l*) 5 Russ. 329.

(*m*) Hill *v.* Thompson and Another, 3 Meriv. 622.—Injunction.—Where a patent has been granted, and an exclusive possession of some duration has been had under it, the Court will interpose by injunction, without compelling the party previously to establish the validity of his patent by an action at law; but when new, and in opposition it be endeavoured to be shewn that there is no good specification, the Court will not act upon its presumed validity without a previous trial. (624.)

Harmer *v.* Plane, 14 Ves. 130.—Injunction.—Where the patentee has been a reasonable time in possession of his grant, on infringement, the Court have granted an injunction until the legal question be tried, because there is less inconvenience in granting the injunction than in dissolving it at hazard, because it may prove that the grant of the Crown was valid. (133.)

keep an account of the articles he manufactures by the the patented process.

An injunction is obtainable not only during the time of the existence of the patent, but may also be obtained afterwards, to restrain the sale of machines piratically made during the existence of the patent.(*n*) Where the pirated article is part of the private effects of a person, an injunction will not be granted to restrain the sale of it.(*o*) The injunction is intended to protect the patentee in the property of his invention, and prevent its use by other persons during the continuance of the grant for the purposes of sale or manufacture by the patented process. Where a patentee has looked on and allowed the defendant to incur great expenses, by the erection of works for the purposes of carrying on the particular process, an injunction, if it has been obtained, will not be continued, but an account will be directed;(*p*) but if the defendant had entered into a contract with the patentee, and paid the rent reserved under the contract, the injunction would be continued, unless he (the defendant) pays into court the money which became due before he gave the patentee notice that he intended to discontinue the use of the license; for by ceasing to pay, he exposes himself to the consequent stoppage of his works.(*q*)

An injunction may be obtained after the lapse of the patent.

Injunction, when not granted.

Injunction, intention of.

It is usual when the Court grants an injunction, to impose on the plaintiff the terms of bringing an action to try his title;(*r*) sometimes the Court directs a specific time for the delivery of the declaration,(*s*) or provides that the cause shall be tried within a certain period.(*t*) The fact that an

Imposition of terms.

(*n*) Crossley *v.* Beverley, supra.
(*o*) Universities of Oxford and Cambridge *v.* Richardson.
(*p*) Neilson *v.* Thompson, supra.
(*q*) Neilson *v.* Fothergill, Webs. Pat. Ca. 289.
(*r*) Wilson *v.* Tindal, supra.
(*s*) Russell *v.* Cowling, supra.
(*t*) Russell *v.* Barnsley, supra; Hill *v.* Thompson, supra.

action is pending against another person is an insufficient reason for the continuance of an *ex parte* injunction, without compelling the plaintiff to bring an action against the new defendant.(*u*) When the validity of the patent is established at law, the injunction is of course revived.(*v*)

Proceedings, when they should be commenced.

In a suit to restrain the infringement of a patent, the plaintiff is not precluded from obtaining an injunction at the hearing, because he did not apply for one on motion; but it will not be granted to him on a *primâ facie* case, made out by the help of the facts proved in the cause, in order to give him further time to establish his title at law; and *semble*, that he must make out such a case as would entitle him to a perpetual injunction.(*w*) Where a person is aware of an infringement being made upon his grant, he should proceed immediately, and not lie by, and then come in for the purpose of claiming a share of the profits made by the piratical use of the patent.(*x*) Where an injunction has been obtained, and the jury finds there has been no infringement, there would be no justice in continuing it (the injunction). The Court has no power to make the plaintiff pay the defendant damages because the injunction has been continued too long.(*y*) In taking an account in a late case, it was held the proper measure of damages would be the amount for which the engines sold, and the profit derived therefrom.(*z*) So though a party does not make any direct profit by his infringement, yet if he makes an indirect one, such profit would be the subject of an account.(*a*)

Damages sustained in consequence of an injunction. Taking an account.

(*u*) Russell *v.* Barnsley, supra. (*v*) Neilson *v.* Harford, supra.

(*w*) Bacon *v.* Spottiswoode, Bea. 382.

(*x*) Crossley *v.* Beverley, supra.

(*y*) Morgan *v.* Seaward, Shadwell, V.C.; Beckford *v.* Skewes; Neilson *v.* Harford.

(*z*) Morgan *v.* Seaward, supra; Neilson *v.* Thompson, supra.

(*a*) *Semble*, that a party infringing a patent, though he does not make any direct profit from the sale of the subject of the patent, is liable

Demurrer to bill.

Where the bill alleges that the plaintiff is the patentee of an invention, stating its nature generally, but referring for greater certainty to a specification in which it is set forth and described at large; and alleges also, that the plaintiff has been for ten years in the exclusive enjoyment of such patent, and has established his legal title by repeated actions, a general demurrer, on the ground of the invalidity of the patent as stated in the bill, will be overruled; and for the purpose of determining the validity of a plaintiff's title as the patentee of an invention, the Court will not make an order, upon demurrer, directing the bill to be retained, with liberty to the plaintiff to bring an action. (*b*)

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to account to the patentee for a collat[illegible] profit arising to him from the use of the patent article by his cu[illegible]ners, as where the result of the invention is to diminish the amount of gas supplied to them.—See Crossley *v.* The Derby Gas Light Company, 4 M. & K. 72; Bacon *v.* Spottiswoode, Bea. 382.

(*b*) Kay *v.* Marshall, 4 M. & G. 193, note a.—The plaintiff filed a bill for an injunction after the time for demurrer had elapsed. Special application was made for leave to demur, which Shadwell, V. C., refused, but was granted by Lyndhurst, Ch. The demurrer was filed; on argument, ordered to stand over twelve months, plaintiff in meantime to be at liberty to bring action. On application to Lord Cottenham, Ch., the order was dismissed, and the demurrer overruled. (1 Mylne & Craig, 373.) Application was then made to the Master of the Rolls (1 Keene, 190) to file a double plea to plaintiff's bill, which was granted—first, by denial of invention of new machinery; secondly, alleged invention was not of public benefit. On the case coming on for argument, plaintiff consented to waive all objections in point of form, if the defendant would consent to the trial at law of the pleas, without first going into evidence in equity, which was agreed to, and a decree made to that effect. The cause was tried before Parke, B., at York, when a verdict for plaintiff was found on both issues. The defendant applied to the Master of the Rolls for a new trial or special case, on the ground that the learned baron had taken an erroneous view of the case. On hearing, at the suggestion of the Master of the Rolls, with acquiescence of both parties, award was made, that a case should be stated for the opinion of the Court. A certificate thereto

Such are the remedies afforded to patentees in a court of equity, where it is best at first to institute proceedings; though at law if an action be determined against an infringer, a court of equity will on application, if the wrongful act be continued, grant an injunction.

Injunction, effect of.

The practice of the court is, never to grant an injunction without annexing a condition, which is to try the cause some time within a given period. An injunction, when obtained, restrains the parties from proceeding with the infringement, and takes effect immediately, and if not dissolved, is perpetual—*i.e.* to the end of the patented [illegible]t; a person proceeding in its despite would commit a contempt, which the Court would notice, and punish by fine or imprisonment.

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was returned, that the patent was not valid in law. On the question coming on for further directions, it was ordered plaintiff's bill should be dismissed with costs. Plaintiff appealed to the House of Lords, which appeal was dismissed.

Westhead *v.* Keene, Bea. 287.—Where a bill to restrain the infringement of a patent did not set forth the specification, but contained an extract from it, and alleged that all had been done by the specification which was required by the terms of the patent, and that the drawings, and a full description of them, could not be set out in the bill, and charged that the invention was new: Held, upon the authority of Kay *v.* Marshall (3 M. & C. 373), (but with some doubt expressed by the Court) that the bill was not demurrable.

CHAPTER XI.

PROCEEDINGS AT LAW TO ENFORCE PATENTEE'S RIGHT.

Action at law.

HAVING shewn the nature of an injunction, and the benefits attending such a mode of proceeding, it becomes necessary to treat of that which is often auxiliary to the suit in equity, viz. the action at law. The proceedings are the same whether the action is directed to be brought by the Court of Equity, or are commenced, in the first instance, at law; the same steps have to be gone through, and the same description of evidence (*a*) has to be produced, excepting when the parties admit certain things, and agree to a case, which is called a special case. Then the particular points to be submitted for the decision of the judges are determined by the parties, and the facts all agreed, such an issue is an issue in law, to be determined by the judges of the court to which it is sent.

Special case, what.

Facts, when in issue.

In cases where there is or are a particular fact, or facts, undetermined, and upon the determination of that fact, or the facts, depends the decree in equity, the trial is by jury; for it is a rule that the questions of law are for the Court, but the facts are for the "country."

Person to bring the action.

The party to bring the action is he in whom the legal interest is vested; if in more than one person, then the action must be brought in their joint names, or it is liable to be abated for the nonjoinder of the parties.

Nature of the action.

The action to be brought for an infringement of a patent is an action on the case. Parties, whose rights have been

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(*a*) Supra, Evidence.

Declaration necessary to.

infringed, must shew their title in the declaration. An allegation must be made that the patent was granted under the great seal, and the letters patent must be set out (profert is made, but being of matters of record, oyer is never allowed); (*b*) and then follow the breaches complained of. (*c*)

Venue.

The venue is transitory, and may be laid in any county; but if it is laid in Middlesex, it cannot be changed; for the substratum of the action, the letters patent, being tested at Westminster, the necessary affidavit cannot be truly made that the cause of the action arose wholly in another county. (*d*) In Beckford *v.* Skewes, (*e*) which was an issue directed by the Vice-Chancellor, it was attempted to be made part of the order, that the cause should be tried in Cornwall, which his Honour refused; the venue was laid in London, and changed, by Mr. Justice Coleridge, at chambers, to Devon, with a condition that the jury was to be summoned from Exeter. So in Brunton *v.* White, (*f*) on motion, it was refused to allow the venue to be changed from London to Lancaster.

Not guilty.

Before the new rules, (*g*) by a plea of not guilty, the defendants put in issue the whole of the declaration, and the plaintiff was obliged to support the grant in all its parts; but, since then, the defendant has to plead all his defences, and deliver with his pleas notice of the objections upon which he intends to rely at the trial. (*h*)

Pleadings, nature of.

If the plaintiff joins issue upon the pleas, the record is taken down to trial; if not, then follows another pleading, called the replication, the reply to which is called

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(*b*) Rex *v.* Amery, 1 T. R. 149. (*c*) Infra, Pleadings.

(*d*) Cameron *v.* Grey, 3 T. R. 363; vide Rex *v.* Huire, 2 Cox, 235.

(*e*) Supra. (*f*) 7 D & R. 103.

(*g*) H. T. 4 Wm. (*h*) Vide infra, Objections.

a rejoiuder; so the pleadings continue until one or other of the parties join issue.

Demurrer, when.

For any thing which would afford in law an insufficient rebuttal of the matter alleged, the opposite party may demur. If the insufficiency is such that the statement is wholly insufficient in law, then a general demurrer will hold; but if of mere form, then the demurrer must be special.

Loss of an action, right to bring another.

It does not follow because a patentee loses one action that he is thereby debarred from bringing another action against another party, or against the same party, for a fresh infringement; for it may be, the failure of the action was not because of the intrinsic demerits of his patent, but from some insufficiency of pleading, or failure of proof. In such cases of failure, it would be proper for the patentee to persevere; for, if the failure was on account of his claim being too large, a disclaimer would cure the defect. The patent right continues in force until either the right is gone, by the time having run out, or until it is repealed by a proceeding called a *scire facias*.

SCIRE FACIAS, PROCEEDINGS BY.

Scire facias, what.

The writ of *scire facias* is an original writ, so called from its commencing words, and proceeds out of the Court of Chancery (because, in patents, the matter for which it issues is filed of record in that court).

On what founded, and when it issues.

The writ of *scire facias* must be founded upon some matter of record, (*i*) and issues when the Crown has unadvisedly granted any thing by letters patent which ought not to have been granted, or where the patentee has done an act (or ab-

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(*i*) 4 Inst. 88.

By whom it may be brought.

stained from doing an act) which amounts to the forfeiture of a grant. It may be brought either on the part of the King, to resume the thing granted; or if the grant be injurious to a subject, by the subject, in which case the King is bound of right to permit him (upon petition) to use his royal name for repealing the patent by *scire facias*.(*j*) This applies to cases where there are two patents for the same thing, as two markets, and where individuals are affected.

Scire facias to repeal letters patent for an invention.

Where a patent has been granted for an invention, the only cause for which the writ can be asked, is that the Crown is deceived. In this case the writ is not due *ex debito justitiæ*, but is in the discretion of the Crown. As the Crown is bound to see that the public are not unduly vexed by a monopoly, it is also bound to protect the patentee against unnecessary litigation.(*k*) Sir W. Follett stated the practice for the obtainment of a *scire facias* to be as follows: "When a *scire facias* is applied for, the Queen's warrant, directed to the attorney-general, is obtained upon petition, and the attorney-general may or may not grant his fiat, just as it should appear to that law officer whether the Crown should interfere or not. The theory is perfectly clear. The Crown, it is said, has been induced to do a wrong; the remedy provided for a case of that sort is a petition for a process. The Crown refers the matter to its law officer, and if the law officer thinks fit to advise the Crown not to interfere, the subject has no remedy. The proceeding goes upon the notion that it is a complaint against the Crown, except in cases where the controversy lies between two grants of the Crown—that is, when the question is, which of the two grants shall prevail?—and then it is a

Practice.

(*j*) 3 Blac. Com. 260, et seq., per Coleridge, J.; 2 Saund. 72, u, ed. 1844.

(*k*) Sir Wm. Follett, *arguendo* Regina *v.* Neilson.

matter exclusively between subject and subject, and in that case only is the writ said to be granted *ex debito justitiæ*. In all other cases it falls under the rule of our law, which does not permit a complaint to be made against the Crown, except with the permission of the Crown. If so, the attorney-general has a right, if he chooses, to refrain from issuing his fiat, without which no proceeding can be taken."

Caveat against the issue of a scire facias.

A practice has, of late, been introduced, of entering a caveat against the issue of the writ of *scire facias* at the chambers of the attorney-general, upon which the parties come before him.

Scire facias, when it issues ex debito justitiæ.

It has been said, that in a case where there have been two patents granted for the same thing, the writ issues *ex debito justitiæ*. The application of this rule appears to have been confined to cases where a market or fair has been granted, to the prejudice of an ancient market or fair.(*l*)

Upon this point a question arises: if two patents for inventions are granted for the same thing, has the prior patentee *a right* to the writ of *scire facias?*

Mr. Webster,(*m*) in a note, says, "In the case of an invention, how is it to be determined they are the same?— and if the same, the first patent may be equally invalid." It is clear, if the latter specification claims the same rights as the prior one, or if it be proved that the two patents were identical, that the latter could be repealed by a proceeding upon *scire facias*; but the doubt the reporter seems to have, is whether the writ is demandable by the first patentee as of right. The argument in the case of Regina *v.* Neilson was, whether or not the Lord Chancellor (the writ having issued) had power to stop the proceedings or quash the writ; the argument only turned incidentally upon the right the

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(*l*) Saund. Rep. 72, u, ed. 1844.
(*m*) Webs. Pat. Ca. 667.

patentee had to demand the issue of the writ. His lordship gave no opinion thereon, but directed the proceedings to stay, until after a case, pending between the parties, had been heard in the House of Lords.

It is submitted, that in the case of an invention, the writ is not demandable by the prior patentee as of right, but it is apprehended it would be granted in all cases where sufficient grounds were shewn for its issue. The reasons which appear to determine this subject are as follow: In the case of a market, &c., the after-grant infringes upon the private rights of an individual; and though its allowance may be a convenience to a particular district, yet it is also to the prejudice of that wherein the ancient market existed. But in the case of a patent upon a patent for an invention, a much more extensive infringement arises. In this case it cannot be said to be merely in prejudice of the rights of an individual, but of the community generally; for, by an undue extension of the time for which the monopoly was granted, it is an usurpation or assumption on the part of the Crown in contradiction to the rights conceded to the public by the Statute of Monopolies, and by consequence an infringement of the general rights of the community. In which case, the proceedings must be said to be such as concern the Crown (for its prerogatives are brought into question), and the rule of law mentioned by Sir W. Follett would apply, and the second patent being a wrong wrought to the community generally, one individual more than another would have no right to the writ; therefore, any proceeding which might be allowed, must be considered as a proceeding *ex gratiâ*. In the former case, the infringement is immediately of an individual right, and the party aggrieved would be the person who has a right to institute the inquiry, though mediately the rights of a particular district are concerned. In the latter case, the pa-

tentee and the public are immediately concerned, for the public, after the lapse of the period of the original grant (unless under particular circumstances),(*n*) have a right to the use of the invention, and the second grant would be a perpetuation of that monopoly to the prejudice of the public. In any other case of infringement than that first mentioned, the writ cannot be demandable by an individual, for no particular, but a general, right is infringed; and it appears necessary that an individual right must have been infringed to make the writ demandable as of right.(*o*)

Application for a scire facias by a subsequent patentee.

It is said that the last patentee cannot apply for a *scire facias* for the purpose of repealing the prior patent,(*p*) but in the case of a patent for inventions, such a proceeding can be had, on the ground of its invalidity, whether for deceit, inaccuracy of specification, or other sufficient reasons. The application is not made as being the application of a subsequent patentee, but as one of the public, any member of which may apply to the attorney-general for the purpose, but cannot demand the writ as a right; and this is a very usual mode of annoyance adopted against patentees; as where a *scire facias* is applied for by the first patentee, on the ground of the second patent being merely colourably different, the after patentee, out of revenge, applies for the abrogation of the prior patent, as for want of novelty, or some such defect, as in the cases of Rex *v.* Hadden, and Rex *v.* Lister, and Rex *v.* Daniels, and Rex *v.* Furnell.(*q*)

Proceedings upon a scire facias.

The proceedings upon a *scire facias* originate in the Petty Bag Office in Chancery. After the permission of the attorney-general has been obtained, instructions are given for the draft of the writ, which, after having been first settled by

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(*n*) Vide Extension.
(*o*) Saund. Rep. 72, u.
(*p*) Saund. 72, u.
(*q*) Reported in Godson's Pat. Ca. 274.

the counsel for the prosecution, is taken to the attorney-general, who grants his fiat; but before he does so, the prosecutor and two sureties have to enter into a bond for 1,000*l.*,(*r*) conditioned to be void upon the payment of the defendant's costs (in event of the patents being confirmed), to be taxed as between attorney and client; and treble costs, if the defendant is entitled thereto, under the statute of 5 & 6 Wm. 4, c. 83, s. 3. This provision was enacted to protect the patentee against vexatious proceedings, the enactment being, if the patent right has before been brought into question, and the judge, whether in Chancery or at common law, certifies that fact, then the patentee shall be entitled to treble costs. (*s*)

Fiat, when granted.

When the fiat is granted, a summons is sent to the defendant, whereby he is informed that the writ is issued against him, and directs him to appear. (*t*) When he has appeared, he may then either plead in bar or abatement. The usual defence is the general issue, which compels the prosecutor to prove all the allegations.

Demurrer.

If the matter be insufficient in law, as in the case of pleading in a common action, the defendant may demur; (*u*) in which case, the whole record is sent to a court of common law, which decides as well the demurrer as the issue in fact.

Default by not appearing.

If the patentee, after having been warned twice, does

(*r*) The reason why a security is required for costs is, that in cases where the Crown is concerned, costs are neither given nor received; and unless a bond was exacted, the patentee would bear his own costs, and might, if successful, perhaps from malice of disappointed or envious men, be continually subjected to such proceedings, but which the bond is calculated to stop.

(*s*) Vide supra, p. 13, for stat.

(*t*) The *scire facias* form recites the patent, and states the grounds upon which it is meant to be impeached.

(*u*) Com. Dig. Pat. F. 8.

not appear, judgment to annul the patent may be had by default. If no defence is made, the judgment is by *nil dicet.*(v)

The issue on the *scire facias* is allowed to be tried at bar only upon very particular reasons being given; otherwise, the trial is at *nisi prius*. At the trial, the patentee must be prepared most strongly to rebut every allegation in the writ. Trial, when at bar.

If the verdict is against the patentee, a new trial will be granted, if he can shew that his case has not had the fullest investigation; but the matter for which it will be granted must be material—as the admission of improper evidence, going into matters not contained in the objections detailed, or some other weighty reason. An affidavit by the patentee, alleging surprise, on the ground that on a prior trial the sufficiency of the specification was the only matter gone into by the Court, and he therefore did not think that the novelty of the invention would be impeached, and which he did not come prepared to meet, such an objection was held insufficient.(w) New trial, when granted.

When the judgment is for the Crown, it is that the letters patent of our lady the Queen be revoked and the enrol- Judgment for the Crown.

(v) Com. Dig. Pat. F. 8.

(w) Motion for a new trial on affidavit of Mr. Arkwright, that on the first and second trials the sufficiency of specification was the only motion gone into by the Court, and on the *scire facias* being brought, he supposed it was only to procure in another shape a revision of the same question, and that he did not expect the origin of invention would be attacked, and that he could disprove the weight of the evidence adduced. That the supposed immaterial articles in specification were necessary when the machine was employed on wool, and it was therefore necessary to insert them. New trial refused. There are two questions to be tried, the specification and the origin of the invention, and this proceeding is brought finally to conclude the motion, for it is a *scire facias* to repeal letters patent. The questions to be tried are stated upon record; there is no colour to try the cause again. (144.) Lord Wynford, C.J. Dav. Pat. Ca.

Cancelling in law.

ment cancelled;(x) it is doubtful whether the defendant can be compelled to deliver them up to be cancelled. (y) The entry of a *vacatur* upon the enrolment of the patent is a sufficient cancelling in law.

Scire facias, what a sufficient foundation for.

Any thing which goes to the validity of a patent, and would be a defence in an action at law for an infringement, would be a sufficient matter whereon to found a proceeding by *scire facias*; the failure of an action through insufficiency of evidence, or for matters purely technical, would afford no ground.

Scire facias pending an action.

The issue of a *scire facias* is no ground for preventing the trial of an action for an infringement of a patent;(z) but where a motion is for a nonsuit,(a) or where there

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(x) Com. Dig. Pat. F. 8.

(y) In a very late case (The Queen *v.* Newton, reported in Newton's Repertory, vol. xxvi. p. 361), where a proceeding was instituted in the Chancery court, to compel the production of the letters patent, in order to their cancellation by erasure and breaking off the great seal, and that the non-production of them by the defendant should be declared a contempt, the Lord Chancellor (Lord Lyndhurst) said he had no power to compel the defendant to produce them; and he (the defendant), by his counsel, denied that the patent was his, and that he had transmitted the letters patent to his client, who resided abroad, and had no power over them. After some further discussion upon the point, it was decided that the enrolment of the patent should be cancelled, that a *vacatur* should be entered upon the roll, and that the defendant should undertake to bring no writ of error, or make any assignment of the patent.

(z) Muntz *v.* Foster, 1 D. & L. 942; 7 Scott, 898, S. C.—Rule *nisi* to shew cause why proceedings in action should not stay until after trial of a *scire facias* to repeal which had been sued out, and which according to the ordinary business in the Queen's Bench, should have been tried before this, but owing to circumstances over which the prosecutors had no control, the matter was postponed. "As a general rule, plaintiff has a right to have his cause go to trial according to the ordinary course of business. This is not a sufficient case for the Court to interfere."—Tindal, C.J. Haworth *v.* Hardcastle, L.B.

(a) Haworth *v.* Hardcastle, supra.

has been a verdict for the Crown, with leave to move, in such case the Court will stay the proceedings until the question upon the *scire facias* is settled.(*b*) So in proceedings on a *scire facias* where the writ is returnable after the expiration of the patent, and there is an appeal pending in the House of Lords, the Lord Chancellor will stay the proceeding until the decision of the appeal.(*c*)

Statement on a writ of scire facias.

The writ of *scire facias* must not in general terms state that the matter of the patent is prejudicial to her Majesty's subjects, it must state positively in what way it is prejudicial ;(*d*) and if there are any suggestions in the writ which are informal and improper, the attorney-general will enter a *nolle prosequi* thereto.

(*b*) Smith *v.* Upton, 6 Scott, 804; 6 M. & G. 251, S. C.—Action for infringement of a patent; venue in Middlesex; cause carried down by proviso.—A *scire facias* had been brought to repeal letters patent; a verdict was given for the Crown on all the material issues, with leave for the defendant to move to enter verdict for him. Motion had been made, and rule was pending in Queen's Bench. Upon affidavit of these facts, stating defendant on the record was the moving party in the *scire facias*, and that the questions intended to be raised were substantially the same as were involved in the inquiry in the other court, a rule *nisi* was granted for postponement until next sittings after Michaelmas Term. "Rule made absolute on payment by defendant of any costs plaintiff may have been put to in preparing for trial for sittings after this Term."—Vide Haworth and Hardcastle, S.P.

(*c*) Regina *v.* Neilson, Webs. Pat. Ca. 665.—Petition to stay proceedings on a writ of *scire facias* to repeal letters patent.—The petition set forth the letters patent and the invention, and stated suit against infringers, and pressed injunction granted thereon, &c., and that a writ of *scire facias* was issued, &c., and was not returnable until after the extension of the patent. Petition prayed the writ might be set aside, and all proceedings thereon to be stayed. His lordship directed the proceedings to stay until the House of Lords had given judgment in a case then pending before them between the parties.

(*d*) Rex *v.* Arkwright, supra.

Two persons cannot have a *scire facias* to repeal the same patent.(e)

(e) Sir F. Pollock, *arguendo*, Regina v. Neilson, supra.—Every person in the realm is interested in the continuance of the letters patent. The English are interested in the Scotch patents, and the Scotch in the English patents. After one person has sued out a *scire facias*, another cannot do it.

CHAPTER XII.

PLEADINGS—DECLARATIONS: FORMS—PLEAS: FORMS.

In a prior part of this work, some general remarks were made upon pleadings in actions upon patents, it will therefore be unnecessary to repeat them—this chapter being devoted to the more technical consideration of the matter, and also to set out the various forms of pleading.

Defeat of patentee in a prior action.

It is no bar to an action that the patentee has been defeated in a prior action,(*a*) for until the patent has been repealed by *scire facias*, or lapsed by the expiration of the grant, a right is presumed to be in the patentee, and his remedy for an infringement of his right is by an action upon the case. The person to bring the action is he who at the time of the infringement had the right to the property. Mr. Godson says, (*b*) "That when the patentee has assigned, the assignee may sue alone, or the patentee may join in the action" (citing 2 Wilson, 423, 2 Saund. 115-16, a). This appears to be doubtful, for it must be presumed the assignor has parted with the whole of his interest; and the rule seems to be, that a person cannot join in an action for damages (which an action for the infringement of a patent essentially is, though the damages taken are often nominal, the plaintiffs being anxious to have their rights confirmed by the verdict of a jury), unless the damages when recovered would accrue to them jointly, for which reason tenants in common

Remedy for infringement.

Assignee, suit by.

(*a*) Arkwright *v.* Nightingale, Dav. Pat. Ca. 52.
(*b*) Godson on Patents, 237.

Assignee, suit by.

cannot join in real and mixed actions. (*c*) In such an action the assignee should set out the mode by which the assignment was made, and not merely aver that the letters patent became duly assigned, without shewing how, though a declaration containing such an averment would be good after verdict. (*d*) The safe way would appear to be, to declare in the name of the assignee only. The patent must be set forth, and that it was made under the great seal, and profert must be made; but oyer is never allowed, being matters of record. Then the breach must be alleged. (*e*) If the defendant be the public officer of a company, an allegation must be made to that effect in the declaration. (*f*)

Necessary allegations in the declaration.

Action against a public officer.

(*c*) Wilkinson *v.* Hall, 1 Bing. N. C. 713.

(*d*) Cornish *v.* Keene, in error, supra.

(*e*) Gibson *v.* Braud, supra. Tindal, C. J.—An allegation in a declaration, that the defendant infringed the patent by making, using, and putting in practice the plaintiff's invention, is supported by proof that an order was given and executed in England for making articles by the same mode for which the plaintiff obtained his patent, and which articles were afterwards received by the defendant, and is sufficient "to satisfy an allegation that he made those articles, for he that causes and procures to be made may be well said to have made them himself."

(*f*) Galloway and Routledge *v.* Bleadem, public officer, 1 M. & G. 247.—Declaration stated invention of certain paddle-wheels, for which a patent was granted, &c. Breach. Covenant—made paddle-wheels in imitation of said invention, and sold, &c., without, &c. Pleas—not guilty; not first and true inventor; nature of invention and manner of performance not particularly described and ascertained according, &c.; not new invention. Replication joined issue on the three first pleas, and took issue on the fourth, asserting the invention was a new invention, &c., and had not been publicly practised and used, &c.; admissions were made by the defendant's attorney, in the whole of which the company are mentioned as defendants. At the trial, the jury found a verdict for the plaintiff on all the issues, with nominal damages. Application was made to the judge to give a certificate, under 5 & 6 Wm. 4, c. 83, s. 5, and to certify for a special jury. The judge reserved the question as to the certificate, but certified for special jury. In Hilary Term a rule was obtained,

FORMS OF DECLARATION.

DECLARATION FOR THE INFRINGEMENT OF A PATENT.

In the Queen's Bench,

the day of , in the year of our Lord, 18

Middlesex, to wit. } A. B. (the plaintiff in this suit), by E. T., his attorney, complains of C. D. (the defendant in this suit), who has been summoned to answer the said plaintiff in an action upon the case. For that whereas the said A. B., before and at the time of making and obtaining of the letters patent, and of committing the grievances of the defendant, as hereinafter mentioned, was the first and true inventor of a certain [*describe the invention*], and thereupon our lady the Queen, heretofore, to wit, on [*date of letters patent*], by her letters patent, bearing date at Westminster, the day and year aforesaid, under the great seal of England, and which said letters patent the plaintiff now brings into court, reciting that [*set forth the recital—grant of the patent, condition of enrolment of the specification, and the clauses prohibiting the exercise of it by others*], as by the said letters patent, reference being had thereunto, will fully and more at large appear. And the plaintiff further saith, that he did afterwards, to wit, on [*day of enrolment of the specification*], in pursuance of the said proviso and of the said letters patent, by an instrument in writing, under his hand and seal, particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed and executed, and did afterwards, within [*time for specifying*] calendar months, next and immediately after the date of the said letters patent, to wit, on the [*day of enrolment*], cause the said instrument in writing to be enrolled in her Majesty's High Court of Chancery, at Westminster, in the county of Middlesex, as by record of the said instrument in writing, now remaining of record in the said High Court of Chancery, more fully appears. And the plaintiff further says, that he did always from the time of making the said letters patent as aforesaid, by himself, servants, deputies, and agents in that behalf, make, use, exercise, and vend his said invention. Yet the defendant, well knowing the premises, but continuing and wrongfully and injuriously intending to injure the plaintiff, and to deprive him of the profit he

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calling on the plaintiff to shew cause why judgment should not be arrested for an insufficiency in the declaration, it not being therein alleged that Bleadem was a registered officer of a company, and a rule also was obtained, calling on the plaintiff to shew cause why the *nisi prius* record should not be amended, by inserting, &c. The Court refused to allow amendment unless plaintiff would pay costs of the rule for arresting judgment, and of the application, and forego the costs of the action. Declaration should state (when action is against public officer) the fact.—7 Wm. 4 & 1 Vict. c. 73, s. 3.

would otherwise acquire by the exercise and use and sale of the said invention in the said letters patent mentioned, and within the said term of years therein mentioned, to wit, on (*some day before the service of the writ after the grant of the letters patent*), and on divers other days and times between that day and the commencement of this suit, and within, &c. [*state the breach*], whereby the plaintiff hath been, and is, greatly injured, and deprived of a great part of the profits and advantages which he might and would otherwise have derived and acquired from the same invention. To the damage of the plaintiff in

and thereupon he brings his suit, &c.

ACTION FOR INFRINGEMENT OF A PATENT BY AN ASSIGNEE.

For that whereas X. Y. (*the patentees*), before and at the time, &c. &c. [*as in the form above, immediately after the averment of the filing of record, &c.*] And the plaintiff further says, that the said X. Y. afterwards, and before the committal of the several grievances hereinafter mentioned, to wit, on the [*date of assignment*], by a certain indenture made between the said X. Y., of the one part, and the said A. B., plaintiff herein, of the other part, which said indenture, sealed with the seals of the said parties respectively, the plaintiff now brings into court, the day of the date whereof is the day and year last aforesaid, for the consideration therein mentioned, did, amongst other things, assign and transfer unto the said A. B. [*state the words of the assignment*], as by the said indenture, reference being had thereunto, will more fully and at large appear. And the plaintiff further says, the said X. Y. did always, from the time of the making the said letters patent as aforesaid until the making of the said indenture, by himself, &c. [*as in form above*], and that he, the plaintiff, hath always, from the time of making the said indenture, hitherto, by himself, his deputies, servants, and agents, made, used, exercised, and vended the said invention, to their great advantage and profit; yet the defendant, &c. &c. [*proceed as in the form above*].

ACTION FOR AN INFRINGEMENT WHERE THE PLAINTIFF HAS DISCLAIMED PART OF THE INVENTION.

For that whereas [*as in the form supra, p.* 165] was the first and true inventor of so much of certain improvements in [*state the invention*] mentioned in the said letters patent hereinafter stated, as is not hereinafter mentioned to have been disclaimed by him [*then proceed as in the first form, after stating the enrolment of the letters patent*]. And further the plaintiff saith, that afterwards, and before committing any of the grievances by the defendant as is hereinafter mentioned, and after passing the statute of the fifth and sixth of Wm. 4, c. 83, to wit, on the 1st day of March, in the year of our Lord 1844, the plaintiff, pursuant to the said statute, and by the leave of the then attorney-general, entered with the clerk of the patents of England a disclaimer of part of the said specification which has been so enrolled as aforesaid, and also a memorandum of alteration of part of the specification, and of the title of the said invention in the said letters patent men-

tioned, which said disclaimer and memorandum of alteration were in writing, under the hand and seal of the plaintiff, and bore date the day and year last aforesaid; and the plaintiff did therein and thereby state the reason of the said disclaimer and alteration, pursuant to the said statute; and that the said disclaimer and memorandum of alteration did not extend the exclusive right granted by the said letters patent; and the plaintiff says, that the said disclaimer and memorandum of alteration were afterwards, to wit, on the 5th day of March, in the year last aforesaid, filed by the said clerk of patents, and enrolled with the said specification, according to the form and by virtue of the said statute, as by the record of the said specification and disclaimer and memorandum of alteration, remaining of record in the said High Court of Chancery, will fully appear; and that the title of the said invention, as altered by the said disclaimer and memorandum of alteration, was and is as follows, that is to say [*state the title*]; and the plaintiff says that, after making the said letters patent, and entering, filing, and enrolling the said disclaimer and memorandum of alteration as aforesaid, and within the term, &c., set out breach, &c. &c. (*f*)

PLEAS.

Pleading requirement by the new rules.

By the new rules, (*g*) the defendant must specially plead any defence he may have to the declaration; formerly the plea of not guilty put in issue the whole of the declaration, but it now only puts in issue the particular infringement complained of; and with the pleas it is necessary to deliver a list of the objections intended to be relied upon at the trial. (*h*)

Requirement by statute.

Annexing drawings to pleadings.

In several cases, instead of describing the invention in words, after setting out the specification, copies of drawings were annexed to the pleadings, describing the invention. In a late case, on an application to a judge at chambers to strike out the drawings, his lordship refused to make an order, whereon an application was made to the Court and

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(*f*) Vide Chitty's Forms (vol. ii. p. 577-8) for various counts in declarations, for making imitations, counterfeiting, &c.

(*g*) Hil. Term, 4 Wm. 4.

(*h*) 5 & 6 Wm. 4, c. 83, s. 5. Vide supra, Objections.

Annexing drawings to pleadings.

a rule *nisi* granted, so the matter will possibly be argued in the next Term.(*i*) Considering the nature and intention of the pleading, and how gradually the system grew, it seems impossible to conceive that drawings can be admitted in the place of words; for if allowed in patent cases, it from analogy would grow into a practice, and must necessarily be allowed in other cases; especially in those where it was necessary to set out boundaries, resort would be had to plans, which would only have the effect of introducing confusion. Words are understandable by every person, and it is easy to discover whether they describe the matter intended to be presented; but if resort were had to plans, it is more than doubtful whether even the truth would be elicited.

Introduction of drawings into pleadings, contrary to the spirit of pleading.

It is apprehended the plan of introducing drawings into pleading upon patents cannot be supported, being contrary to the very spirit and intention of pleading, which requires the utmost particularity. All matters of objection to a patent must be set forth with the greatest nicety.

Not a manufacture.

If the objection is, that the patent is granted for a matter

(*i*) Lealey *v.* Browne and Another, 9 Jurist, 537.—Case for infringing a patent.—The third plea set out the whole of the specification, and annexed to it certain drawings, purporting to be copies of the drawings annexed by the plaintiff to his specification; the sixth plea averred that the plaintiff had enrolled no other plea than that set forth in the third plea; and application had been made to Williams, J., at chambers, to strike out the third and sixth pleas, or the drawings contained or referred to in them, on which application no order was made. Application was now made to Williams, J., in court, to strike out the third and sixth pleas, on the ground that they were insensible, except by reference to certain drawings; or why not strike out the drawings as surplusage, and contrary to the rules of pleading? Williams, J.: "Can the plea be intelligible without the design to aid the eye?" The rule *nisi* was granted on the ground that as the drawings had been before used in pleadings without objection, it would be preferable to have the matter argued in full court.

not within the statute of Jac. 1, it must be expressly set forth, and in the language of the statute,(*j*) for the plea

Not a manufacture within, &c.

(*j*) Spilsburry and Abbott *v.* Clough, 2 Gale & Dav. 17.—Plea—that the said invention in the said letters patent mentioned was not, at the time of making the said letters patent, a new manufacture within this realm, within the true intent and meaning of the act of Parliament in that case made and provided; to which there was a demurrer: "That it does not appear with certainty whether it is intended to dispute that the invention is new or that it is a manufacture within the meaning of the statute; and although in the plea it is alleged that the said invention was not at the time of making the letters patent a new manufacture, yet it is not stated, nor does it appear thereby, whether the said defendant intends to rely upon the fact, that the invention was at the time of making the said letters patent publicly known, or that the said invention was not new to the inventor, and also that the plea attempts to put in issue matter of law, viz. whether the invention is a manufacture within the meaning of the statute." Notice was also given that the declaration would be objected to. The declaration was held to be good, *as to the goodness of the plea.* "Suppose the words of the statute had been followed, then I think it would have fallen within that rule of law which allows of a complicated position, though consisting of several facts. But the words of the statute are not followed; which are, 'the sole working or making of any manner of new manufacture within this realm.' Therefore, being used in the ordinary sense, it is left doubtful whether the objection is that the invention is not new, or that it is not a manufacture within the statute of James. The plea is bad."—Lord Denman, C.J. "If the plea had omitted the words 'within this realm,' it might have been good; but, as it stands, it applies those words to the invention, whereas the Act applies them to the working or making."—Wightman, J.

Walton *v.* Potter and Horsfall, Webs. Pat. Ca. 598.—Pleas—that the invention was not, at the time of making the said letters patent, a new invention, as to the public use and exercise thereof within England; setting out specification, and averring that the said invention was unfitted and useless for the construction of sheet-cards and top cards, as therein described. Under these pleas, it was contended, that the objection that the invention was not the subject-matter of letters patent, being the application of a known substance to a purpose, and in a manner well known, was open to the defendant. (On motion in arrest of judgment), the matter was not expressly

Must not be ambiguous.

must set forth the matter of the defence, and not be so framed as to leave the plaintiff in doubt as to the defence intended to be adopted.

Title larger than the specification.

If the objection be that the title is larger than the invention, it must be directly raised; an averment that the specification is insufficient does not raise the question.(*k*)

For a principle.

So where the objection is, that the patent is for a principle, it must be made the ground of a substantive plea, and is not put in issue by a plea that the invention is not new.(*l*)

Denial of utility.

When the objection is, that the invention is not useful, a plea merely denying the utility is insufficient; "it should, as in Arkwright's case, positively say it is prejudicial."(*m*) Parke, B., in the case of Morgan *v.* Seaward, (*n*) said, "The grant of a monopoly for an invention which is altogether useless may be well considered as mischievous to the state—to the hurt of trade, and generally inconvenient within the meaning of the statute of James 1, and that it might be the proper form (in such a case) to use the words of the statute, and not to plead the want of utility. So the utility of an invention cannot be put in issue by a plea that the plaintiff is not the first inventor."(*o*)

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decided, the Court being of opinion that this objection upon the pleas was not open to the defendants. Third issue only raises the question whether, being a manufacture, it was in public use and exercise at the time the patent was granted or not, and not whether it was a manufacture within the meaning of the stat. of Jac. 1. (661.)

(*k*) Derosne *v.* Fairlie, supra.

Neilson *v.* Harford, Webs. Pat. Ca. 312.—Pleas—not guilty, not true invention, invention not new; setting out specification, and traversing compliance with the rule, as to the description, enrolment, &c.; not useful. Parke, B., in addressing the jury, held that, under these pleas, the title to the patent was not put in issue.

(*l*) Household Company *v.* Neilson, Webs. Pat. Ca. 667; Jupe *v.* Pratt and Another, ibid. 161.

(*m*) Per Alderson B., Jupe *v.* Pratt, supra. (*n*) Supra.

(*o*) Household Company *v.* Neilson, Webs. Pat. Ca. 690.

When the objection is, that the specification does not sufficiently describe the invention, it must be directly put in issue, for many slips in pleading are cured after verdict; for it is a rule of pleading, that if an issue could have been material, the Court, after verdict, ought to intend it so (*p*) In the case of Morgan *v.* Seaward,(*q*) a plea was, "that the said invention was not an improvement in steam-engines." The Court said, "On reference to the specification and by what appears upon the record, it is by no means clear that the patentee does not claim an improvement in steam engines unconnected with machinery, and if he does so the plea would be probably bad on demurrer, as it is uncertain whether the plea does not deny the invention to be an improvement in steam-engines unconnected with machinery." So under the issues of infringement and denial of the originality of the invention, an objection founded upon the vagueness of the specification is not raised.(*r*)

Not sufficiently describe the invention.

Infringement and denial of originality.

When there is a confession of an infringement, the avoidance must be plain and direct, and some matter of law must be shewn whereby the patent is rendered void; an averment in a plea that the defendant was under a license obtained from another and assignee is insufficient.(*s*) So where the declaration stated the enrol-

Confession and avoidance.

(*p*) Kemp *v.* Crewes, 1 Ld. Raym. 187. *Vide supra.*

(*r*) Russell *v.* Crichton, Webs. Pat. Ca. *in notis* 497.

(*s*) Stocker *v.* Waller and Others, 9 Jurist, 1850. Case for infringing patent for certain improvements in pumps.—Declaration set out patent and enrolment, and entry of a disclaimer; and alleged that after making letters patent and entry of disclaimer, the defendant made and sold certain, &c., in imitation of the said invention. Plea—after grant of letters patent, and before declaration, her Majesty did grant to B. letters patent for a certain invention of improvements in water-closets and stuffing-boxes applicable to pumps and cocks, and the defendants say the said patent is still in force, and is not void; and that by license of the said B., use said invcn-

Enrolment. Specification.

ment of a specification, and a plea setting forth the proviso, and averring that no other specification was enrolled, is bad, for it does not traverse the averment in the declaration; and if intended as a traverse, it is circuitous and bad, and amounts to an argumentative denial.(*t*) A plea denying that the grantee of letters patent ascertained and described the nature of his invention should conclude to the country; if it is concluded with a verification, it is bad upon special demurrer.(*u*)

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tion, so far as relates to stuffing-boxes applicable to pumps; and that they have used said invention, &c. Verification. Demurrer, for that it is no answer to an infringement, by default of the letters patent, that the defendants work under a license from another and subsequent patentee, and other points. Tindal, C. J.: "I consider the plea to be bad: it assumes to be in confession and avoidance of the cause of action alleged in the declaration; the confession, which I will assume to be good, must amount to an admission of an infringement of that portion of plaintiff's patent which remains after effect is given to the disclaimer. But there is no sufficient avoidance; it ought to shew that the patent of the plaintiff, as diminished by the disclaimer, is void in law. The fact of disclaimer does not necessarily import the original patent was void, for the object of the statute was not only to enable inventors to set themselves right when their patents would have been void, but to remove doubts which otherwise hang over the parties bringing actions for infringements, by enabling them to disclaim a part of the specification.

(*t*) Muntz *v.* Foster, 7 Scott, N. R. 471; 1 D. & L. 737.

(*u*) Bentley *v.* Gouldthorpe and Another, 4 Law Times, 414.—Declaration set out letters patent for making cards for carding cotton, and enrolment of specification, and that patentee assigned to A., who assigned to B. Breach—making, using, &c. said invention; making, using, putting in practice said invention; making, using, and putting in practice part of said invention; counterfeiting, imitating, and recently making, &c. divers additions, &c. and pretending to be inventors. Plea—patentee did not ascertain, &c., according to meaning, &c. of letters patent. Verification. Demurrer. Plea neither traverses nor confesses any material averment of declaration, and is ambiguous as not averring patentee did particularly describe, &c., and uncertain whether such plea intends to traverse averment in

declaration, or to confess and avoid the same by virtue of some new matter. If former, it should have concluded to the country; if latter, defendant should have set out new matter, by force, &c.: defendant seeks to avoid averments in declaration, and should have concluded to the country. Tindal, C. J., in delivering judgment said, "The question is, whether seventh plea should have concluded to the country, which depends whether averment in declaration, which the plea in terms denies, was a material averment. If so, it should have concluded to the country. We are of opinion the averment was material. The meaning of the condition is (specifying) that if specification be not enrolled within six months, patent is void; if not from date of patent, at all events from the end of six months. It is alleged in the plea, that the grantee of the letters patent did not particularly describe and ascertain the notification of his invention, according to the meaning of the letters patent, referring to the declaration; it alleges filing of specification, so in substance the plea seems to have denied the averment *modo et formâ*. We think plea should have concluded to the country."

Stead *v.* Carey, 5 Law Times, 74.—Declaration stated grant of patent for wood-paving, and that a specification should be enrolled in four months, which was not enrolled until six months, and then averred an act of Parliament was obtained to form a company to carry out patent, and that specification enrolled six months after should be as effectual as if enrolled within time named in letters patent. Declaration then assigned breaches, several infringements of patents. Pleas—seventh, title was too large. Verification. Eighth, reciting act to establish a company, and that the persons in the said act mentioned had not purchased said letters patent, or carried on trade, &c., and no company, &c., and said act become inoperative. Ninth recited, before passing said act, and after the expiration of the four months, a patent was granted defendant, setting out, and justified infringement of plaintiff's patent, by using invention of defendant. To seventh plea, letters patent in declaration stated was granted for, &c. General demurrer to eighth plea; special demurrer to ninth. The objection was, that the word *of* making and paving, &c., and not *for* making, &c., was used, which Tindal, C. J., held, "was got rid of by the allegation, in manner and form as the defendant has above thereof alleged," which we see, on looking at the plea, the traverse is good; it says he did not take out the letters patent by that description. "By the act, Stead's patent was confirmed in substance as well as in words."—Tindal, C. J.

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FORMS.

PLEA, NOT GUILTY.

In the Queen's Bench.

The day of , in the year of our Lord 18 .

C. D. } The defendant, by J. B., his attorney, says that he is not, nor was,
a t s } guilty of the said alleged grievances above laid to his charge, or
A. B. } any or either, or any part thereof, in manner and form as the plaintiff hath above thereof complained against him, and of this he puts himself upon the country.

PLEA, THAT THE PLAINTIFF WAS NOT THE FIRST INVENTOR.

And for a further plea in this behalf, the defendant says, that the plaintiff was not at the time of the making of the said letters patent the true and first inventor of the said [*set out the invention*], in manner and form as the plaintiff has in the declaration in that behalf above alleged, and of this the defendant puts himself upon the country.

THAT THE PLAINTIFF IS NOT THE FIRST INVENTOR OF PART OF THE INVENTION CLAIMED.

And for a further plea in that behalf, as to so much of the said alleged invention and improvements in the said letters patent mentioned, and in the said specification firstly described, the defendant says that the plaintiff was not, at the time of the granting of the said letters patent in the said declaration mentioned, the true and first inventor of the said supposed improvements or inventions in manner and form as the plaintiff has in the said declaration in that behalf alleged —country, &c.

THAT PART OF THE INVENTION WAS PUBLICLY USED AND KNOWN.

And for a further plea in this behalf, the defendant says, the said alleged inventions and improvements in the said letters patent mentioned, and in the said specification firstly described and ascertained, were not at the time of making the said letters patent, or of the presenting of the said petition therein mentioned, a new invention or improvement, but part thereof, to wit, so much of the same as is firstly described in the said specification, had been and was long before the said petition and grant of the said letters patent, publicly used and made, and openly exhibited for sale, to wit, by the defendant, in that part of the United Kingdom of Great Britain called England, nor was nor were the said alleged improvements and inventions invented or found out by the plaintiff; by reason whereof the said letters patent were wholly void; and this the defendant is ready to verify.

THAT THE PLAINTIFF DID NOT SPECIFY THE NATURE OF HIS INVENTION.

And for a further plea in that behalf the defendant says, that the plaintiff did not, by any instrument in writing, particularly describe and ascertain the nature of his said invention, and set forth in what manner the same was to be performed, in manner and form as the plaintiff has in that behalf above alleged—*country*, &c.

THAT THE PLAINTIFF DID NOT ENROL THE SAID SPECIFICATION.

And for a further plea in this behalf, the defendant says the plaintiff did not cause any instrument in writing particularly describing and ascertaining the nature of the said invention, and in what manner the same was to be performed, in manner and form as the plaintiff has in the declaration in that behalf above alleged; and of this, &c.—country.

THAT THE INVENTION IS NOT USEFUL.

And for a further plea in this behalf, as to the said improvements and discoveries in the said declaration mentioned, the defendant says that they were not, at the time of granting the said letters patent, nor have been, nor are, from thence hitherto, of any public or general use, or benefit, or advantage whatsoever, nor were nor are the same, in fact, any improvement whatever, or in any manner beneficial to the public; by reason whereof the said letters patent were, and still are, wholly void and of no effect; and this—verification, &c.

THAT HER MAJESTY DID NOT GRANT THE LETTERS PATENT, &c.

And for a further plea in this behalf, the defendant says that our lady Queen Victoria did not grant in manner and form as in the said declaration alleged; and of this, &c.—country.

THAT THE INVENTION WAS NOT THE PROPER SUBJECT OF A PATENT.

And for a further plea on this behalf, the defendant says that the said supposed inventions, improvements, or discoveries in the said letters patent in the said declaration mentioned, and in the said specification described, were not, at the time of making the said letters patent, or of presenting the said petition, nor are nor ever have been from thence henceforth, a manufacture properly and lawfully the subject of letters patent, according to the form and within the intent and meaning of the statute in such case made and provided—(and this—verification).

THAT THE INVENTION WAS NOT NEW.

And for a further plea in this behalf, the defendant says, that the said alleged invention or discovery in the said letters patent and instrument in writing mentioned, described, and ascertained, was not, at the time of making the said letters patent, a new invention as to the public use and exercise thereof in the United

Kingdom, nor was the same invented or found out by the plaintiff; by reason whereof the said letters patent were and are wholly void; and this, &c.—verification.

THAT THE LETTERS PATENT WERE OBTAINED BY FRAUD.

And for a further plea in this behalf, the defendant says, that the letters patent in the said declaration mentioned were procured through and by reason of the fraud and misrepresentation of the plaintiff, and of others in collusion with him; and this—verification, &c.

LEAVE AND LICENSE.

And for a further plea in this behalf, the defendant says, that he committed the said grievances in the declaration mentioned, at the time in the declaration in that behalf mentioned, by the leave and license of the plaintiff, to him first given and granted for that purpose, as he lawfully might, for the cause aforesaid; and this, &c.—verification, &c.

CHAPTER XIII.

NOTICE OF OBJECTIONS.

Benefit of the 5 & 6 Wm. 4.

BEFORE the statute 5 & 6 of Wm. 4, c. 83, patentees, upon bringing actions against the infringers of their rights, were put to great and often needless expenses, by not knowing upon what particular part of their invention the defendant would ground his defence, or by what particular defect he would endeavour to extenuate, or rather to justify, his infringement. In order to guard the plaintiff against such needless expenses, the above statute was enacted.(*a*) Before that time, the plaintiff was obliged to be armed with proof at all points to support his patent, but now his attention is directed only to particular points, and on examination, if he finds he cannot rebut, he can abandon the action without incurring the great expense its prosecution would occasion him.

Objections, intention of.

By the 5th section of the statute,(*b*) it is directed the defen-

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(*a*) Fisher *v.* Dewick, 4 Bing. N. C. 716.—The object of the statute was not to limit the defence, but the expense, and more particularly to prevent the patentee from being upset by some unexpected turn of the evidence, it was intended the defendant should give an honest statement of the objections on which he meant to rely. (710.) "The protection of the patentee was the object of the statute, as particulars so general afford no assistance."—Park, J. (710.) "And let the patentee know what objections he had to meet."—Vaughan, J. (711.) "The Court should see that the objections are stated in a definite and intelligent form before trial; the defendant may bring forward any number of objections, but he must state with precision what they are."—Coltman, J. (711.)

(*b*) Supra, p. 15.

dant shall deliver with his pleas a notice of the objections to the patent upon which he intends to rely, (*i. e.*) to shew in what the patent is defective, and if he succeeds in proving his objections, his use of the protected manufacture would be justified, and the verdict would be against the patentee. But even this provision is not in all cases a sufficient guard. Mr. Justice Cresswell proposed to extend the rule farther than the statute directed. In the case of Walton *v.* Bateman and Others,(*c*) his lordship said, "I cannot help thinking that it would be a very good rule to establish, that with the notice of objections the defendant should be compelled to say under which plea he means to bring forward the different objections." No case which the author has met with has gone as far as the observation of his lordship pointed; and it will be found, by a perusal of the cases cited under this heading of the subject, that their lordships are careful, upon the matter being submitted to them, that no vague or indefinite objections are allowed, and which vigilance goes far to obviate the necessity of the step suggested by his lordship above, to cure the evils to which he adverted as prompting his observation. (*d*)

Stringency of the construction of the notice of objections.

Effect of non-delivery of notice of objection.

The objections are demandable by the force of the statute, and their delivery would be compelled, on application, by a rule of court granted for that purpose. If the defendant fails to deliver them, it is apprehended the plaintiff could not treat pleas delivered without them as a nullity, and sign judgment as for want of a plea; though it is said

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(*c*) Webs. Pat. Ca. 616.

(*d*) "I fear that in this case and in others, objections so drawn, without any specific statement as to the plea under which they are to be given in evidence, instead of serving to help us in the due administration of justice, may serve as traps and pitfalls for judges and juries to be caught in."—Coltman, J. And see further observations in note d, Webs. Pat. Ca. 268.

the objections are a part of the case,(e) and without them the defendant could not proceed with his justification, for the words of the statute are express,—"and no objection shall be allowed to be made in behalf of such defendant, unless he shall prove the objections stated in such notice."(f) The words of the statute upon a default would appear to point to a judgment of *nil dicet*. It is presumed, on refusal, the Court would act summarily and grant an attachment against the defendant, his attorney, or both, for contempt. One case only appears upon record wherein the pleas were delivered without notice of objections, and which occurred almost immediately after the statute came into operation; in that, the Court directed the objections to be delivered, and the pleas pleaded to stand, on the assumption of the defendant's having pleaded *de novo*. (g)

Objections must be definite.

The objections must be more definite than the pleas (though there may be cases in which the language of the pleas might be sufficient in every respect to satisfy the intention of the statute).(h) They must particularly state the matters which militate against the stability of the patent.(i) Yet, at the same time, they must not go beyond

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(e) Neilson *v.* Harford and Others, vide Webs. Pat. Ca. 309, *in notis*.—The objections being read, do not give the right to a reply; for they are a part of the case, and should be read when the pleadings are read.

(f) 5 & 6 Wm. 4, c. 80, s. 5; supra, pp. 15, 16.

(g) Losh *v.* Hague, Webs. Pat. Ca. note a, 205.

(h) Neilson *v.* Harford, supra.—Case. "But it may be that the plea itself is sufficiently explicit, then the words of the plea would be sufficient."—Alderson, B. In delivering the judgment of the Court, in the case of Neilson *v.* Harford, Parke, B., said, "The objection may be so fully and completely expanded upon the record, that a mere transcript of the plea itself may be sufficient; in other cases the plea may be so general in its language, as to be insufficient as a notice, if transcribed from the plea merely. Each case must depend upon its peculiar circumstances."—Ibid.

(i) Jones *v.* Berger, 5 M. & G. 208; 6 Scott, 208, S.C.—Case—

the pleas; (*i. e.*) they must not include matters to which

Infringement of a patent for a mode of treating farinaceous matters for the purpose of obtaining starch and other products, and in manufacturing starch. Pleas—Not guilty; not first inventor; did not particularly describe and ascertain nature of said invention; that said invention was in use at and before the time of obtaining the patent. Objections—That Jones was not first and true inventor, the invention having been made public in two prior specifications of patents (naming persons), and also by other persons, and in other books and writings; that said specification does not sufficiently distinguish between what is old and what new; that the process is not beneficially applicable for obtaining starch from all farinaceous matter, and that patentee did not state in said specification the most beneficial manner with which he was acquainted for obtaining the same; that the directions are not such as would enable any ordinary workman to make starch of a quality suitable for the general purposes of commerce, and the specification is in other respects insufficient, and calculated to mislead; that said invention was in use before, particularly as applied to rice and rice-flour, was known and in use, and practised by persons engaged in the manufacture of lace, and such fabrics, and in clear-starching. "The new rules of pleading were promulgated in Hilary Term, 1834; the new Patent Act, 1836 (5 & 6 Wm. 4, c. 83). We are not therefore at liberty to say the legislature were not aware of the new rules under which the plea of not guilty in actions on the case was so materially abridged; and when we find the legislature directed the defendant shall give the plaintiff a notice of the objections on which he intends to rely, it is reasonable to think they must have meant to require something more particular than the pleas. What degree of particularity is required, it may be difficult to define. I think it would be a more fair compliance with the statute, that the objection should disclose the names of the authors, or specify the books upon which the plaintiff means to rely. No hardship is imposed upon the defendant; he can add the names of other publications to his notice, any time before the trial, by applying to a judge at chambers (215); that 'elsewhere' be struck out, and if 'other places' are found therein, add, &c.; the words 'and elsewhere,' are too general, and might mislead" (distinguishing this case from Fisher *v.* Dewick). A particular of objections delivered by the defendant in an action for infringing a patent right must be precise and definite. It is not sufficient to say that the improvements, or some of them, have been used before; the defendant should point out which.—Tindal, C. J.

the pleas do not relate,(*j*) so they must not tend to mislead. (*k*)

The notice of objections is not conclusive upon the defendant at his peril; but the Court, under its general jurisdiction, may order a further and fuller notice; but where the notice sufficiently points to the matter intended to be relied upon as a defence, the Court will not interfere; as where the objection alleged that certain persons have used the invention claimed, and that therefore the invention is not new, the Court will not direct that the names of such persons shall be furnished;(*l*) and so, where it was stated Sufficiency of.

(*j*) Macnamara *v.* Hulse, 1 C. & M. 471.

(*k*) To a declaration for the infringement of a patent, the defendant pleaded that the nature of the invention, and the manner in which it was performed, were not particularly described in the specification; and also, that the invention was not new; and the objections delivered with the pleas, under 5 & 6 Wm. 4, c. 83, s. 5, stated, first, that the specification did not sufficiently describe the nature of the invention, and the manner in which it was to be performed; and secondly, that the invention was not new, and had been wholly or in part used and made public before the obtaining of the letters patent:—Held, that the first of these objections was sufficient, but that the second was bad, and ought to have pointed out what portions of the alleged invention were previously in use.—Heath *v.* Unwin, 10 M. & W. 684; 2 D. P. C., N. S. 482.

(*l*) Bulnois *v.* Mackenzie, 4 Bing. N. C. 127.—"I think the act of Wm. 4, c. 83, comes within the same construction as the statutes of set-off. It is doubtful whether, under the words 'notice of objections,' we can require the names of those persons who are alleged to have used the plaintiff's invention, and therefore, so much of the order is rescinded, and the judge at N. P. will admit or reject evidence as to those persons, according as he may deem them to fall within the terms of the notice."—Tindal, C. J. "The act was intended to afford the plaintiff more specific information than was given by the defendant's plea; and I think the present notice insufficient."—Vaughan, J. "I think the order goes too far in requiring the names of all the other persons who are alleged to have used the invention."—Bosanquet, J. "It would be throwing too great a difficulty upon the defendant to require him to disclose

in the objection, that articles similar to those patented were made by the defendant and others several years before the date of the letters patent, and their sale *to divers persons*, and, amongst others, to one A. B., the Court, on application, refused to strike out the words "divers persons," or direct a description of the other persons to be given;(*m*) but in other cases such words have not been allowed.(*n*) When the objection is that the matter has been before specified, or that the description has appeared in a certain book or books, and the patents wherein the specifications have been enrolled were not named, nor the

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the name and address of all the persons who are alleged to have been using the plaintiff's invention."—Coltman, J.

Regina *v.* Walton, 2 Q. B. 969.—Patent for carding wool.—Proceedings on *sci. fa.* were instituted. Supposed invention was not new as to the public use in England, and that before the grant of the letters patent, parts had been used by others in England. Notice of objection was filed, stating another patent of A. claimed part of the invention, but neither declaration nor objections specified the names of any persons supposed to have used parts of such invention. Application was made to the Master of the Rolls to direct the names of such persons to be given, but it was refused. The record was brought into this court, and cause set down. Lord Denman, C. J., refused to make a rule *nisi* absolute for such particulars, saying, "We agree with the Master of the Rolls rather than the Court of Common Pleas, and think the particulars should not be ordered."

Bentley *v.* Keighley, 1 D. & L. 944.—The notice of particulars of objection, delivered by the defendant in pursuance of the 5 & 6 Wm. 4, c. 83, s. 5, stated, amongst other grounds of objection, that the invention was known "to A. B. and others," who were the true inventors thereof, and had first used and exercised the same in England:—Held, that the defendant was not bound to specify the names of the other parties. Tindal, C. J., said, "I am not prepared to say 'and others' should be struck out; it is not imputed the words are inserted for the purposes of fraud, and defendant may not know the names of the others."

(*m*) Carpenter *v.* Walker, Webs. Pat. Ca. note 8, 298.

(*n*) Vide Fisher *v.* Dewick, Galloway *v.* Bleadon, Heath *v.* Unwin.

names of the authors of the books, in both cases the notice of objection will be directed to be amended by such addition.(*o*) So if the objection is, that the patent, or the extension of the patent, was obtained by fraud, it must be stated wherein the fraud consisted.(*p*) Stating that the invention is not sufficiently set forth in the specification is sufficient,(*q*) so that the plaintiff did not state the best mode of effecting the object of the patent with which he was acquainted.(*r*)

Proof of objections required.

The Court are particular in confining the proofs to the letter of the notice of objections, and their being too large is an error as fatal as if they did not put a matter sufficiently important in issue; for if the notice of objection is, "that the invention was used by many persons, and the proof is that it was only used by one, the objection is not proved."(*s*)

Amendment of notice of objection.

Provision is made in the statute for the amendment of the notice of objection by the addition of other objec-

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(*o*) Vide Jones *v.* Berger, supra. Tindal, C. J.

(*p*) Russell *v.* Ledsam, 11 M. & W. 647; 3 D. P. C., N. S. 347.—To an action for the infringement of a patent, the defendant pleaded—1, That the patentee was not the true and first inventor; 2, That the invention was not, when the letters patent were granted, a new invention; 3, That the report of the Judicial Committee of the Privy Council, and the letters patent thereupon, were procured by fraud, covin, and misrepresentation:—Held, first, that the notice of objection delivered under the 5 & 6 Wm. 4, c. 83, s. 5, need not state who the first inventor was, or under what circumstances the invention had been previously used.

Secondly, that if the defendant objects that the patent is not new, he should specify whether he objects to the patent generally on that ground, or to part only; and if so, to what part.

Thirdly, that the notice ought to state the species of fraud, covin, and misrepresentation by which the patent was procured, on which he intends to rely.

(*q*) Heath *v.* Unwin, supra. (*r*) Jones *v.* Berger, supra.

(*s*) Per Erskine, J. Jones *v.* Berger, Webs. Pat. Ca. 547.

tions; (*t*) and the Court has decided that, in accordance with its practice, it has power to amend particular objections, and which amendments will be made at any time before the trial of the cause, and therefore any plea which the plaintiff may have to urge, as to the generality of the objections of which notice is given, must be proceeded with before trial, for at the trial it would be too late, and his complaint would not be attended to. (*u*)

Direction of a specimen of the invention to be declared.

The Court will not generally direct a specimen of the invention to be given to the defendant, in order to aid him in the preparation of his defence, the specification being, unless in very particular cases, sufficient.(*v*) But when there is any intricacy as to which of the patented articles the complaint relates, the patent having been granted for several articles of a similar character, the Court will direct that the plaintiff shall deliver to the defendant such a description of the articles presumed to be pirated as may direct him in his defence. (*w*)

(*t*) Section 5.

(*u*) If the notice of objections, delivered by a defendant with his pleas in an action for the infringement of a patent, pursuant to the stat. 5 & 6 Wm. 4, c. 83, s. 5, be not sufficiently specific, the plaintiff's course is to apply to a judge at chambers for an order for the delivery of a more specific notice; but if he omit 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.—Neilson *v.* Harford, 8 M. & W. 806; Bulnois *v.* Mackenzie, supra.

(*v*) Crofts *v.* Peach, 2 Hodges, 110.—The Court will not direct a specimen of plaintiff's invention to be delivered to the defendant in order to his ascertaining whether the invention is new; to put the novelty in issue, he can plead the invention is not new, the specification giving every necessary information as to the invention.

(*w*) Perry *v.* Mitchel, Webs. Pat. Ca. 269.—Where the patent was granted for a number of articles of the same character (steel pens), on an action being brought for an infringement, the Court (Exchequer) directed that a notice of the particular articles in-

In Scotland the object of the statute is obtained by means of the closed record, therefore the statute does not apply to cases prosecuted in the Scotch courts.

Scotland, rule in.

CERTIFICATE OF THE JUDGE.

Another effect of the statute of the 5 & 6 of Wm. 4, c. 83, is to prevent a patentee being needlessly vexed and put to expenses by being continually compelled to defend his *rights*: the statute enacts, that if any action at law or suit in equity be brought for an alleged infringement of the patent, or *scire facias* to repeal it, it shall be lawful for the judge to certify upon record, under his hand, that the validity of the patent came into question before him, which record being given in evidence in any other suit, and a verdict pass for the patentee, &c., he shall receive treble costs in the suit, to be taxed at three times the taxed costs, unless the judge trying the issue certifies against such treble costs.(*a*) The certificate should not be directed to the pleas, but to the notice of objections delivered with them,(*b*) and where the plaintiff recovers a verdict, with nominal damages only, in order to render the certificate

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fringed sho[illegible]e given by the plaintiff, which he did, referring to the particular pens by diagrams and numbers.

(*a*) Vide supra, 5 & 6 Wm. 4, c. 80, s. 3 ; supra, pp. 13, 14.

(*b*) Losh *v.* Hague, 5 M. & W. 387 ; 7 D. P. C. 495.—The certificate given by a judge under the Patents Act, 5 & 6 Wm. 4, c. 83, s. 5, should be as to the determination of each objection of which notice has been given, and not as to the issues.

Where a defendant, in an action for the infringement of a patent, succeeds on the plea which goes to the whole action, he will be entitled to the general costs of the cause, deducting the costs of the objections on which the plaintiff has succeeded, and of the issues found for him.

under 5 & 6 Wm. 4 available, he must also obtain a certificate under 3 & 4 Vict. c. 24, s. 2, that the action was brought to try a right,(c) and the certificate should be applied for before another cause is called on; for Parke, B., in the case of Gillet *v.* Green,(*d*) expressed a doubt whether the judge had power to grant it then: after the taxation of the costs the Court expressly decided it could not be granted. The statute applies only to causes actually tried. In a late case, where issue had been joined and the cause called on, and the defendant consented to a verdict against him for nominal damages, the judge (Erskine, J.) refused to give the certificate (the pleas were—not guilty, alleged invention not new, specification did not, &c.), because the interests of a third person are concerned, and such consent might have been fraudulent by the collusion of the parties.(*e*) In order to obtain the certificate it is not necessary that the validity of the patent should be put directly in issue; a plea which puts it partially in issue, as that the invention is not new, is sufficient.(*f*)

(*c*) Gillett *v.* Green, 7 M. & W. 347; et vide Thompson *v.* Gibson and Another, 6 Jurist, 390; Page *v.* Pearse, 9 Dowl. P. C. 815. —In cases where the patentee has obtained a verdict and a certificate that the validity of the patent came into question, in a subsequent trial, if the plaintiff recovers only nominal damages, unless the judge certifies that the action was brought to try a right, the plaintiff, by the operation of the 3 & 4 Vict. c. 24, s. 2, will be deprived of his treble costs, under the statute of the 5 & 6 Wm. 4, c. 83, s. 3; and Parke, B., said, "That the words of the act being 'where damages are under 40s., unless the judge shall immediately certify' that the action, &c., that it might be a question whether the judge could grant a certificate, even after another cause was called on."

(*d*) Supra.

(*e*) Stocker and Another *v.* Rodgers and Another, 1 C. & K. 98.

(*f*) Gillett and Another *v.* Welby, 9 C. & P. 334.

PLEAS ALLOWED TO BE PLEADED TOGETHER.

When it is desirable for the defendant to plead several pleas, care must be taken that a distinct ground of answer or defence is intended to be established in respect of each one proposed to be pleaded; otherwise, upon application to a judge at chambers, they will be ordered to be struck out: but in all cases a rule (order) must be obtained where the defendant wishes to plead two or more pleas;(*a*) for if they are pleaded without such rule, the plaintiff may sign judgment;(*b*) that is, where two or more pleas are pleaded to the same part of the declaration,(*c*) which in actions for infringement of patents is usually the case.

Where a disclaimer has been entered under a patent, the defendant will not be allowed to plead similar pleas to the whole invention and to the undisclaimed part.(*d*) In a case where it is doubtful, from the language of the specification (which described six inventions), whether each improvement was described separately as the invention protected by the letters patent; on application, a plea was allowed to be added, which denied that two parts of the invention were not new manufatures within the meaning of the statute of James, there being already a plea upon the record denying that the invention was a new manufacture within the meaning of the statute of Jac. 1.(*e*) Pleas—that the articles in respect of which the patent was granted were generally known previously to the grant of the patent; that the alleged improvements were not an invention in respect of which a patent could lawfully be granted; and

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(*a*) Archbold's Attorney's Guide, vol. i. p. 284.
(*b*) Hockey *v.* Sutton, 2 Dowl. 701.
(*c*) Archer *v.* Garrard, 2 M. & W. 63.
(*d*) Clarke *v.* Kendrick, 3 D. P. C. (N.S.) 332.
(*e*) Bentley *v.* Knightly, 1 D. & L. 944.

a similar plea as to part of the alleged invention, in addition to a plea that the invention was not a new manufacture within the meaning of the statute of Jac. 1, were not allowed. Tindal, C. J., in refusing to allow the two preceding pleas, said, "It seems to me the defence which the defendants are desirous of setting up under the fourth and fifth pleas may be well set up in the third (which is the last plea above); that plea involves as well the question of novelty, as whether or not the alleged invention is a manufacture within the statute of James."(*f*)

CASES OMITTED OR REPORTED AFTER THE PRECEDING MATTER WENT TO PRESS.

Haworth *v.* Hardcastle and Others, 1 Bingham's N.C. 190.—Patent for machinery, &c. to facilitate the operation of drying calicoes, &c. &c.—Specification stated mode in which the operation was to be performed, &c., and for removing the same, &c. by means of which, &c., and then followed the claim with respect to the novelty.

Machine not useful in some cases.

The evidence was in some measure conflicting, and the machine failed to take up certain cloths stiffened with clay for deceptious purposes. The jury found the invention was new and useful; the specification sufficient for a mechanic, properly instructed, to make a machine from; that there had been an infringement upon the patent, and that the machine was not useful in some cases. (187.)

Scire facias cannot be obtained for declaration.

The verdict was entered for plaintiff, with leave for the defendant to move to enter a nonsuit. "If a machine is useful in general, because some cases occur in which it does not answer, we think it would be much too strong a conclusion to hold the patent void; we think we should act with great hazard and precipitation if we were to hold that the plaintiff ought to be nonsuited upon the ground that his machine was altogether useless for one of the purposes described in his specification." (190.)—Tindal, C. J.

Mandamus to enforce rights of patentee.

(Mandamus to enforce rights of patentee.)—In a patent for an invention, it was stipulated that the patentee should apply for his Majesty's service so much of the invented article as should be re-

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(*f*) Walton *v.* Bateman and Others, 4 Scott, 397; vide Walton *v.* Potter, 4 Scott, 91; Webs. Pat Ca. 598, note h.

quired, at such reasonable prices and terms as should be settled for that purpose by the Admiralty. The patentee allowed the article to be made at the royal dock-yards, and, at the request of the Navy Board, gave instructions for the guidance of the smiths there, without stipulating for any recompense for the use of the patent:—Held, that a mandamus would not lie to the Admiralty to fix a price to be paid to the patentee.—Ex parte Pering, 6 N. & M. 472.

A patent obtained before patent which publishes before enrolment.

Cornish *v.* Keene, supra.—A new patent, sealed in 1832 and enrolled in May, 1833, is no answer to an action for the infringement of a patent not enrolled until June, 1833, the patentees having, in March and April preceding, publicly sold and supplied the London market. The mere fact of the enrolment of Desgrand's specification after the plaintiff's patent was sealed and his discovery known upon the market, does not of itself alone afford any proof whatever of the want of novelty in the manufacture made under the plaintiff's patent. (589.)—Tindal, C. J.

Agreement to purchase consequent upon a patent.

Hill *v.* Croll, 9 Jurist, 645.—C., the owner of two patents, agreed, in consideration of 200*l.*, to purchase of the plaintiff (and of another person, with his consent), at stipulated prices, all articles of a particular description which he should require for working his patents, and sell to the plaintiff, at certain stipulated prices, the products of certain processes of the patents, and to no one else, without his consent; plaintiff, on his part, agreed to supply the patentee, and to purchase from him the said products. On filing a bill for the specific performance of the agreement, it was held, that, as the Court had no power to compel the plaintiff to supply the articles in question, it could not decree the specific performance of the agreement, either in whole or in part.

Counsel's fee.

Neckells *v.* Haslam, 9 Jurist.—In this case, which was for an injunction, objection was made to the allowance of the Master, on the taxation of the costs, of a retainer of 55*l.* and a fee of 30 guineas to the attorney-general. "The objection is to the fee, and not to the counsel. A most serious blow would be aimed at the liberties of the people of this country, as represented by counsel, if I were to interfere in the way this petition asks. Every person has a right to choose his own counsel, and it is for him to determine whom he will have. If the plaintiff having in contemplation, as I have no doubt he had, the trial which would take place, and thought proper to employ the first counsel, in either event he had a right to do so."—Vice-Chancellor of England. Objection overruled with costs.

King's printers in Scotland.

The King, by letters patent, granted to two persons, their heirs and assigns, the office of king's printers in Scotland for forty-one

years, to use and enjoy its profits and privileges, so far as the same were consistent with the articles of the Union; and especially the sole privilege of printing, in Scotland, Bibles, New Testaments, the psalms, prayer-books, confessions of faith, and the greater and lesser catechisms in English. The patent prohibited all other persons from printing in, or importing into, Scotland from any parts beyond the seas, any of the books, without authority from the patentees, under pain of confiscation:—Held, that the patentees had the exclusive right of printing these books in Scotland, and that the English Bible could not be sold in Scotland.—Manners, App., Blair, Resp., Bligh, 391.

Plea of non concessit.

Bedells and Another *v.* Massey, 2 D. & L. 322.—Channell, Serjt., shewed cause, citing Morgan *v.* Leaward, Co. Litt. 260, a; Baddeley *v.* Sepangwell; Hyndi's case; Eden's case. Case for infringement of patent. Declaration made profert of letters patent, but did not set them out verbatim. Defendant, who was under terms to plead issuably, delivered abstract of pleadings; amongst others, *non concessit*, invention was of no importance, no use to public.—"The objection to the plea of *non concessit* is, not that it is at variance with the abstract delivered, but that it is no plea at all. It seems to me to be the only one by which a defendant can dispute the effect of letters patent, and shew the plaintiffs claim one thing, whereas the letters patent grant another. No inconvenience can result; the plaintiff will have to produce at the trial the exemplification of the letters patent, and shew they agree with the declaration, and the plea will be answered.—Tindal, C. J. (325.) *Non concessit* is an issuable plea, and within the terms under which defendant was to plead issuably.—Maule, J.

CHAPTER XIV.

SECURING PROPERTY BY REGISTRATION, (a)

UNDER THE 5 & 6 VICT. C. 100; AND 6 & 7 VICT. C. 65.

Registration of designs.

THE expense of procuring patents, and the exceeding difficulty under the rigid construction of law adopted, prevented the inventor of many useful improvements in manufactures from exclusively enjoying, for such a period as would recompense him for his trouble, the fruits of his ingenuity; so that it was only in matters of great importance (and of a particular character) that persons could afford to apply for the grant of letters patent.

Statutes affording a partial protection.

From time to time, commencing from the twenty-seventh year of Geo. 3 (1787), acts have been passed which have afforded manufacturers in particular trades a partial protection. The acts of the 5 & 6 Vict. c. 100, and 6 & 7 Vict.

(a) The first idea of protecting inventions for a short period by registration seems to have been given by the Designs Act, 2 Vict. c. 17, which, though intended for the protection of ornamental designs and patterns, did not exclude those for articles of utility, and many such were registered under its provisions; but in 1842 it was thought fit to make an alteration in this law, by admitting to protection in the same manner other articles which did not then fall within its scope, for which end the act 5 & 6 Vict. c. 100, was passed, which applies to ornamental designs exclusively, thus shutting out most of those articles which had been registered under the previous act; and so great a deprivation was this felt by many who had availed themselves of its protection, that the author of this work was induced to memorialize the Board of Trade, who, after considering the matter, informed him that they had some idea of ameliorating the law in this respect, and in a short time a bill was brought into Parliament, and passed—the present act. (A. P.)

c. 65, in conjunction, have extended the benefit to every branch of manufacture, whereby an impulse has been given to artistic and mechanical ingenuity; and so important has the subject seemed in the eyes of manufacturers, that a school of design has been established for the encouragement and protection of artistic merit, in connection with manufactures.

5 & 6 Vict. c. 100, Digest and Construction of the Act.

Statute to come into operation 1st Sept. 1842.

Sect. I. This act to come into operation 1st of September, 1842, and the then acts 27 Geo. 3, c. 38, 29 Geo. 3, c. 19, 24 Geo. 3, c. 23, 2 Vict. c. 13, and the 2 Vict. c. 17, from thence are repealed.

Duration of copyright.

II. Any copyright granted by virtue of the said acts, to continue in force until its lawful expiration, and all offences thereunder to be subjected to the remedies therein provided.

Copyright, for what obtainable.

III. New and original designs (except for such things as are contained within the provisions of the statute of 38 Geo. 3, c. 71, and 54 Geo. 3, c. 56, which statutes principally related to works of art), whether applicable to the ornamenting any article of manufacture, or any substance, artificial or natural, or partly so, whether applicable for the pattern, or shape, or ornament, or two or more such purposes, and whether effected by printing, painting, embroidery, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means, manual, mechanical, or chemical, separate, or combined. The proprietor of such design, it not having been before published in the United Kingdom of Great Britain and Ireland, or *elsewhere*, (*b*) shall have the right solely to apply such design

(*b*) The design must be new: the words here used are restrictive. An introduction from abroad would not, it is apprehended, be protected, as in the case of the introduction of a new invention under the 21 of James 1, c. 21.

to any article of manufacture, or substance aforesaid, provided the same be done (*c*) in the United Kingdom of Great Britain and Ireland, for the terms hereinafter mentioned, which terms will be computed from the registration of the designs.

In respect of the application of any such design to ornamenting any article of manufacture contained in the first, second, third, fourth, fifth, sixth, eighth, or eleventh of the classes following, for the term of three years:

In respect of the application of any such design to ornamenting any article of manufacture contained in the seventh, ninth, or tenth of the classes following, for the term of nine calendar months:

In respect of the application of any such design to ornamenting any article of manufacture or substance contained in the twelfth or thirteenth of the classes following, for the term of twelve calendar months:

Class 1.—Articles of manufacture composed wholly or chiefly of any metal or mixed metals:

Class 2.—Articles of manufacture composed wholly or chiefly of wood:

Class 3.—Articles of manufacture composed wholly or chiefly of glass:

Class 4.—Articles of manufacture composed wholly or chiefly of earthenware:

Class 5.—Paper hangings:

Class 6.—Carpets, floor and oil cloths: (*d*)

(*c*) It is apprehended, if the design is not used, that the certificate would be void—or, at all events, unless the proprietor could shew user, or an intention of user (manifested by some decided steps), he would not be entitled to the penalties imposed by the act for an infringement of the design—for the act being, in many of its enactments, strictly penal, that mode of construction would be adopted which is most in favour of the liberty of the subject, regard being at the same time had to the evident intendment of the legislature.

(*d*) Vide 6 & 7 Vict. c. 65, s. 5.

Class 7.—Shawls, if the design be applied solely by printing, or by any other process by which colours are or may hereafter be produced upon tissue or textile fabrics:

Class 8.—Shawls not comprised in Class 7:

Class 9.—Yarn, thread, or warp, if the design be applied by printing, or by any other process by which colours are or may hereafter be produced:

Class 10.—Woven fabrics, composed of linen, cotton, wool, silk, or hair, or of any two or more of such materials, if the design be applied by printing, or by any other process by which colours are or may hereafter be produced upon tissue or textile fabrics; excepting the articles included in Class 11:

Class 11.—Woven fabrics, composed of linen, cotton, wool, silk, or hair, or of any two or more of such materials, if the design be applied by printing, or by any other process by which colours are or may hereafter be produced upon tissue or textile fabrics, such woven fabrics being or coming within the description technically called furnitures, and the repeat of the design whereof shall be more than twelve inches by eight inches:

Class 12.—Woven fabrics, not comprised in any preceding class:

Class 13.—Lace, and any article of manufacture or substance, not comprised in any preceding class.

Registration, necessaries to.

IV. The design to be protected must be registered before publication, and, at the time of the registration, applied to some article in the above-mentioned classes,(*d*) by specifying the number of the class. The name of the person registering must be registered as the proprietor of the design; and after publication, the name of the proprietor shall appear upon the article to which his design applies: if the manufacture be a woven fabric, by printing upon one end; if another substance, at the edge, or upon any convenient parts, the letters R^d, with the number or letter,

Name of the person to be put upon the registered article.

(*d*) Vide Sec. III. supra.

or number and letter, corresponding with the date of the registration. The mark may be put upon the manufacture, by making it on the material itself, or by attaching thereto a label containing the proper marks.

V. The author of the design is to be considered the proprietor thereof, unless he has executed the design for another person, *for a good or valuable consideration;* then such other person shall be considered the proprietor, and shall *alone* be entitled to register it; but his right to the property shall only be co-extensive with the right which he may have acquired; for, it may be, he has not the exclusive right, but a right of application in conjunction with another person. Who allowed to register.

VI. A person acquiring, by purchase or otherwise, a right to the entire or partial use of a design (*i. e. registered design*), may enter his title in the register provided by the act; and any writing purporting to be a transfer of such design, and signed by the proprietor of the design, shall operate as an effectual transfer; and the registrar, on the production of the writing, or if the right be acquired by any other mode than purchase, by producing evidence thereof to his satisfaction, shall insert the name of the new proprietor. Assignment of the design.

FORM OF TRANSFER.

I, A. B., author [*or* proprietor] of design No. , having transferred my right thereto, [*or, if such transfer be partial,*] so far as regards the ornamenting of [*describe the articles of manufacture or substances, or the locality with respect to which the right is transferred*], to B. C., of do hereby authorize you to insert his name on the register of designs accordingly.

FORM OF REQUEST TO REGISTER.

I, B. C., the person mentioned in the above transfer, do request you to register my name and property in the said design as entitled [*if to the entire use*] to the entire use of such design, [*or, if to the partial use,*] to the partial use of such design, so far as regards the application thereof [*describe the articles of manufacture, or the locality in relation to which the right is transferred*].

FORM OF REQUEST WHEN THE PROPERTY DEVOLVES UPON A PERSON BY ANY OTHER MODE THAN BY TRANSFER.

I, C. D., in whom is vested by [*state bankruptcy or otherwise*] the design No. [*or if such devolution be of a partial right*, so far as regards the application thereof] to [*describe the articles of manufacture or substance, or the locality in relation to which the right has devolved*].

Infringement of design.

VII. If during the existence of the right (whether it be of the entire or partial use of such design), any person, without the *license in writing* of the registered proprietor, shall apply such design, or a fraudulent imitation thereof, to the ornamenting of any article of manufacture, &c. for the purposes of sale, or publish, sell, or expose for sale any article of manufacture, &c. to which such design, or fraudulent imitation thereof, shall have been applied, after having received a verbal or written notice from any other person than the proprietor that his (the proprietor's) consent has not been given to such application, or has been served with or had left at his premises, a written notice signed by

Summary remedy.

the proprietor or his agent to that effect, (*d*) shall for every offence forfeit a sum of not less than five pounds and not exceeding thirty pounds, to the proprietor of the design. The penalty may be recovered as follows:—

England.

In England, by an action of debt, or on the case, against the offender, or by a summary proceeding before two justices, having jurisdiction in the district wherein the offender resides.

Any justice acting for the county, riding, division, city, or borough wherein the offender resides, may act; but he must not be concerned in the sale or manufacture of the article, or in the property of the design.

The appearance of the offender is compelled by a summons, appointing a time and place; which time must not be less than eight days from the date of the summons.

Service to be made on the person or at the residence of the offender.

(*d*) Sec. VIII. in continuation.

On appearance of the party, or on his default, two justices, as above, may hear the complaint, and on proof by the confession of the offender, or by the oath of one or more credible witnesses (to be administered by the justices), they may convict the offender in the penalty aforesaid for each offence—the aggregate amount of the penalties up to the time of the institution of the proceedings not to exceed 100*l.* against one person.

If the amount of the penalty and the costs attending the conviction are not paid, then the amount of the penalty, of the costs, and the costs of the distress and sale, shall be levied by distress upon the goods, &c. of the offender, wherever he may happen to be in England, and the justices before whom the conviction was had, or any two justices acting for any county, &c. wherein the goods of the offender may happen to be, may grant a warrant of distress and sale; any overplus to be delivered to the offender on demand.

FORM OF INFORMATION.

Be it remembered, That on the , at , in the county of , A. B., of , in the county of [or C. D., of in the county of , at the instance and on behalf of A. B., of , in the county of] cometh before us and , two of her Majesty's justices of the peace in and for the county of and giveth us to understand that the said A. B., before and at the time when the offence hereinafter mentioned was committed, was the proprietor of a new and original design for [*here describe the design*], and that within twelve calendar months last past, to wit, on the , at , in the county of , E. F., of , in the county of , did [*here describe the offence*], contrary to the form of the act passed in the year of the reign of her present Majesty, intituled, "An Act to consolidate and amend the Laws relating to the Copyright of Designs for ornamenting Articles of Manufacture."

FORM OF CONVICTION.

Be it remembered, That on the day of , in the year of our Lord , at , in the county of , E. F., of , in the county aforesaid, is convicted before us

and , two of her Majesty's justices of the peace for the said county, for that he the said E. F., on the day of , in the year , at , in the county of , did [*here describe the offence*], contrary to the form of the statute in that case made and provided; and we the said justices do adjudge that the said E. F., for his offence aforesaid, hath forfeited the sum of to the said A. B.

In Scotland. In Scotland, by action before the Court of Session in the ordinary form, or by summary conviction before sheriff of the county wherein the offence was committed; the proceeding as in England, but according to the Scotch form.

In Ireland. In Ireland, by action in the superior court, or by civil bill in the civil bill court of the county or place wherein offence was committed.

Proprietor may elect between the summary remedy and an action at law. IX. Or the proprietor, if he so elects, may bring an action for the damages he has sustained by the application or imitation of the design for the purpose of sale, or by the publication and exposure to sale, against any person so offending, he (the offender) knowing that the proprietor of the design had not given his consent to such application.

Wrongfully registering and applying to the courts of equity. X. If a person wrongfully gets himself registered as the proprietor of a design, the rightful owner may institute a suit in equity against him, and the judge having cognizance of such suit may, if it appears to him that the design has been registered in the name of a wrong person, in his discretion, either direct the registration to be cancelled (in which case it will from thence be wholly void), or direct that the name of the lawful proprietor shall be substituted for the name of the wrongful proprietor in the register, and make such direction as to the costs as he may think fit. The registrar, on the service of the order or decree, and on paying of the proper fee, shall comply with the same.

Continuing the marks after the expiration of the certificate, XI. The marks denoting a registered design must not be applied to any article not registered, or to any article the

registry of which has expired, or any marks similar thereto. A person applying such marks, or selling articles so marked, knowing them to be unlawfully applied, shall forfeit for every offence a sum not exceeding 5*l.*, to be recovered in the way directed to recover the penalty.(*e*) and applying them to unregistered articles.

XII. Proceedings for offences and injuries under this act to be brought within twelve months from the commission of the offence, and not after. Persons proceeding under the act to recover their full costs. Limitation of proceedings.

XIII. In cases of summary proceedings, the justices may award costs to the party prevailing, and grant a warrant to enforce the payment against the summoning party. Power to award costs.

XIV. The appointment of the officers, &c. to be in the lords of the Committee of the Privy Council for the consideration of all matters of trade, &c.; the appointments to be during pleasure; the salary of the officers to be fixed by the Commissioners of the Treasury; the lords of the Privy Council to make rules, &c. Appointment of officers.

XV. The registrar is to register no designs, in respect of any application thereof to the ornamenting manufactures, &c., unless he is furnished, in respect of each application, with two copies (drawings or prints) of such design, accompanied with the name of the person who shall claim as proprietor, or of the style of the firm under which he may be trading, with his place of abode, or place of carrying on business, or other place of address, and the number and class in respect of which the registration is made; he must register all such copies, &c., from time to time successively as they are received by him for that purpose, and on every such copy, &c. affix a number corresponding to such succession. He shall retain and file one copy, &c., and return the other to him from whom he receives it, and class such copies, &c., and keep an index of them. Mode of registering.

(*e*) Supra, Sec. VIII. page 196.

Duty of the registrar.

XVI. On the copy returned to the person registering, the registrar shall notify, under his hand, that the design has been registered, date of registration, name of the registered proprietor or firm, place of abode, &c., with the number of such design, with the number or letter employed by him to denote or correspond with the registration: such evidence of a registration certificate made on any original design, or copy, &c. purporting to be signed by the registrar, or deputy registrar, purporting to have the seal of the office affixed, in the absence of evidence to the contrary, be sufficient proof of the design—of the name of the proprietor —of the registration—of the commencement and period of registry—of the person named as proprietor being proprietor —of the originality of the design, and of compliance with the provisions of the act.

The writing (purporting to be such certificate), in absence of proof to the contrary, shall be received as evidence without proof of the signature or of the office seal.

Inspection of the designs, when allowed.

XVII. Any person, on payment of the appointed fee, to be at liberty to inspect any design whereof the copyright had expired; of such of which the copyright has not expired, no inspection shall be allowed, unless by the proprietor of the design, or by a person appointed by him, in writing, or by the special authority of the registrar, and then only in his presence, or in that of a person holding an appointment under this act; and in no case shall a copy be allowed to be taken. The registrar, on a person producing a design, having thereon the registration mark, or the registration mark only, may give him a certificate stating whether there be existing any copyright of such design, and to what particular manufacture such copyright applies—the term of the copyright—date of registration, and the name and address of the registered proprietor.

Appointment of the office fees.

XVIII. The Commissioners of the Treasury to appoint the fees to be paid for the service of the registrar, &c. &c.

XIX. If the registrar, or any person employed under him, shall demand or receive any fee or gratuity, &c., other than the remuneration authorized by the Commissioners of the Treasury, he shall forfeit for every offence 50*l.*, to be recovered in an action of debt in the Court of Exchequer at Westminster, and be rendered incapable of holding, &c. Excess of duty.

XX. And for the interpretation of this act, be it enacted, that the following terms and expressions, so far as they are not repugnant to the context of this act, shall be construed as follows; (that is to say) the expression "Commissioners of the Treasury" shall mean the Lord High Treasurer for time being, or the Commissioners of her Majesty's Treasury for the time being, or any three or more of them; and the singular number shall include the plural as well as the singular number; and the masculine gender shall include the feminine gender as well as the masculine gender.

XXI. And be it enacted, that this act may be amended or repealed by any act to be passed in the present session of Parliament.

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6 & 7 Vict. c. 65.

Sec. I. Reciting 5 & 6 of Vict., and the extension of the benefits by this act to come into operation on the 1st of September, 1843. Extending the benefit.

II. The proprietor of a new and original design for an article of manufacture, having reference to some purpose of utility, so far as it shall extend to its shape and configuration, whether for the whole shape or for only a part, it not having been previously published in Great Britain and Ireland or *elsewhere*, (*f*) shall have the sole right to such design, to be computed from the time of registration according to the act; this act not to extend to the 38 Geo. 3, c. 71, and 54 Geo. 3, c. 56. Shape.

(*f*) Supra, p. 192, *in notis*.

Registration of the design.

III. (*f*) The design must be registered before its publication, in accordance with the provisions of this act, and after such registration, the article to bear the word registered and the date.

Using marks unlawfully.

IV. (*g*) A person placing the word registered upon an unregistered article, or upon an article the copyright of which has run out, or advertise the same for sale as a registered article, or unlawfully sell, publish, or expose for sale such article, shall forfeit for every offence a sum not less than 1*l.* and not exceeding 5*l.*, to be recovered. (*h*)

V. (*i*) Floor and oil cloths to be included in Class 6.

VI. The provisions of the 5 & 6 Vict., when not repugnant, to extend to this act in certain cases.

VII. Provision as to the appointment of the registrar, &c. (*j*)

Registration.

VIII. The registrars not to receive, &c.; (*k*) and every drawing, &c., together with the title and the description of the design, with the name and address of the proprietor, shall be on a sheet of paper or parchment, and on the same side thereof; the size of the sheet not to exceed 24 in. by 13 in., and on one side of the sheet shall be left, on the side where the drawing is, a blank space of the size 6 in. by 4 in., for the certificate to be written; the prints or drawings to be upon a proper geometric scale, and the parts of the design which are not new to be set forth; such drawings to be registered, as in. (*l*)

Power of registrar to refuse registration.

IX. The registrar empowered to refuse to register such designs as do not appear to him to be within the intention of the act, and of the 5 & 6 Vict. c. 100, as of a thing not

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(*f*) Vide 5 & 6 Vict. c. 100, ss. IV., XV.
(*g*) Vide 5 & 6 Vict. c. 100, s. XI.
(*h*) Vide s. VIII., supra, 196. (*i*) Supra, p. 193.
(*j*) Same as s. 14, 5 & 6 Vict. c. 100, supra, p. 199.
(*k*) Same as s. XV., 5 & 6 Vict. c. 100, supra, p. 199. (*l*) Ibid.

intended to be applied to an article of manufacture, but only as a wrapper, label, or covering, in which an article might be exposed for sale—or where the design is contrary to public morality or order; with power of revision of his decree by the lords of the Privy Council.

X. Every person to be at liberty to inspect the index of the titles of the designs, not being ornamental designs, and to take copies from the same; the permission not to apply to designs the copyrights of which have not expired.

XI. The interpretation, as in 5 & 6 Vict. c. 100, Sec. XX.

XII. Power to amend, &c., as in Sec. XXI.

OBSERVATIONS UPON THE STATUTE FOR REGISTERING DESIGNS.

Benefit introduced.

By consulting these acts,(*m*) it will be seen that the benefit of protection is extended to matters which formerly were not in any way protected. The first act (5 & 6 Vict. c. 100) applies protection to ornamental designs, the latter (6 & 7 Vict. c. 65), to any useful article of manufacture, as far as its shape and configuration is concerned, no limitation being made in the statute whether such configuration was applicable to the external or internal structure, or both.

Intention of the statute.

The words in the act, "*purpose of utility*," would seem to imply that any improvement in a manufacture which was effected by the peculiar shape of any part of it, whether external or internal, was a proper subject for protection.

In the case of Milligen *v.* Picken,(*n*) in which the invention termed the "sylphide parasol" was discussed, it was attempted to raise the question, under the plea of not the inventor or proprietor of the design, &c., whether such a manufacture as the one in dispute was an article of

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(*m*) Supra, pp. 192, 201. (*n*) In the C. P. 5 Law Times, 216.

manufacture within the meaning of this statute. Their lordships held, that under the plea the issue was not raised, and the question was not decided.

It is apprehended, if the object is effected by the particular configuration of the parts, that it is within the intention of the statute, but only so far as the configuration is concerned: if the same results could be effected by means of another shaped machine, which was *not merely colourably different*, though thereby the same result was produced, it would be no infringement of the prior design.

Expense of registration.

The expense of obtaining registration in most cases does not exceed fifteen pounds, which charge includes the preparation of all the necessary drawings, &c., being to the manufacturing world, for purposes to which the act applies, a great boon; for though the protection extends at most but to a period of three years, yet the right is spread over the whole of her Majesty's dominions, and is obtainable by the proprietor of the design, whether his right is by the invention or by the purchase of the design.(*o*)

Persons wrongfully obtaining registration.

Persons wrongfully obtaining registration of the design are punishable by being condemned in the costs consequent upon a suit in equity to abrogate the registration.(*p*)

How obtained.

The registration of the design is obtained by a simple application,(*q*) which is a great feature in favour of this method, and, on the registration, becomes an available property; whereas a patent, though it is really the property of the patentee, is obliged to stand the test of an action at law before its validity is completely established; but the great advantage of this method is, that a stop may be immediately put to any infringement of the right by the sum-

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(*o*) 5 & 6 Vict. c. 100, s. 5, supra, p. 195; 6 & 7 Vict. c. 65, supra, p. 201.

(*p*) 5 & 6 Vict. c. 100, s. 10, supra, p. 198.

(*q*) 5 & 6 Vict. c. 10, s. VI., supra, p. 195.

mary jurisdiction which the statute vests in two justices of the peace;(r) and whilst the act allows the jurisdiction of the justices, it does not restrict the proprietor of the design from proceeding at law (at his election), but he cannot adopt both remedies for the same offence. Summary jurisdiction.

It is necessary that the design should be original (an introduction from abroad would be insufficient), and that it has not been before published.(s) The articles made under the protection of the statute must be marked in the way directed by the act,(t) which mark must be discontinued when the copyright has expired. Design, necessaries to.

We have enumerated the principal advantages obtainable under these acts; yet, in order that this mode may not obtain an undue advantage, it will be necessary to point out some of the defects of the mode in question, and to shew the superiority, in some respects, of the patents over the copyrights. Advantages and disadvantages of the act.

The shortness of the time for which the copyright exists may be considered as the greatest defect, and would, in some cases, be an effectual bar to the adoption of the benefits proposed; for it is found that fourteen years,(u) in many cases, is too short a period to afford to the inventor a remunerating profit, and applications are frequently made to the Privy Council, under the 5 & 6 Wm. 4, c. 83, and 2 & 3 Vict. c. 67, for an extension of the original period of the grant;(v) but then it must, on the other hand, be considered that there are very many articles for which the exclusive right for three years would yield such a return as would well repay the inventor or proprietor for his trouble or the outlay of his capital; and in these cases,

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(r) 5 & 6 Vict. ss. 7, 8, supra, p. 196. (s) Supra, p. 192, note.

(t) 5 & 6 Vict. c. 100, sec. XI.; and 6 & 7 Vict. s. 4, supra, pages 198, 202.

(u) Supra, p. 119, et infra. (v) Title Extension.

it should be recollected, articles, at comparatively a nominal sum, are protected, which before were liable to be *pirated* immediately upon their publication. The other great objection is, the confined character of the grant, extending as it does only to the form of the article, leaving open the door for its unprincipled adoption by a *material* alteration in the shape; and this is indeed a very weighty objection, since it will be admitted that the essence of many inventions consists in the general idea of working out some abstract principle, or in some mechanical action, independently of the peculiar means represented for effecting the same, and that this may be equally well carried out under various shapes or configurations; but though this is generally true, yet there are many cases in which the peculiar shape or configuration is the essence of the invention, and can receive full protection under these acts; as paddle-wheels, stern-propellers, railway-bars, chairs, sleepers, wood pavements, and many other articles of utility.

APPENDIX OF FORMS.

PATENT.

PETITION FOR A PATENT.

The humble petition of , of, &c.,

Sheweth,

That your petitioner hath invented [*here state the title of the invention*].

That he is the first and true inventor thereof; and that the same hath never been practised or used by any other person or persons whomsoever, to his knowledge or belief.

Your petitioner, therefore, humbly prays that your Majesty will be graciously pleased to grant unto him, his executors, administrators, and assigns, your royal letters patent, under the great seal of the United Kingdom of Great Britain and Ireland, for the sole use, benefit, and advantage of the said invention, within that part of your Majesty's United Kingdom of Great Britain and Ireland called England, your dominion of Wales, and town of Berwick-upon-Tweed, [in the Islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all your Majesty's colonies and plantations abroad,] for the term of fourteen years, pursuant to the statute in that case made and provided. And your petitioner shall ever pray, &c.

DECLARATION TO SUPPORT A PATENT.

I, A. B. of in the county of (profession)

do solemnly and sincerely declare that I have invented

That I am the first and true inventor thereof, and that the same hath never been practised by any other person or persons whomsoever, to my knowledge or belief. *And I further declare that it is my intention to solicit letters patent in Scotland and Ireland.* 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 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 184 Before me, A Master in Chancery.

THE PATENT.

Victoria, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith, to all to whom these presents shall come, greeting. Whereas A. B., of , hath, by his petition, humbly represented unto us, that [*invention, &c.*] The petitioner, therefore, most humbly prayed we would be graciously pleased to grant [*prayer of the petitioner*]. 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 A. B., his executors, administrators, and assigns, our especial license, full power, sole privilege and authority, that he, the said A. B., his executors, administrators, and assigns, and every of them, by himself and themselves, or by his and their deputy or deputies, servants or agents, or such others as he, the said A. B., 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 that part of our United Kingdom of Great Britain and Ireland called England, our dominion of Wales, and town of Berwick-upon-Tweed [*if for the Channel Isles, Colonies, &c., state same*], in such manner as to him, the said A. B., his executors, administrators, and assigns, or any of them, shall, in his or their discretion, seem meet. And that he, the said A. B., 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 said term of years herein mentioned, To have, hold, exercise, and enjoy the said license, powers, privileges, and advantages, hereinbefore granted, or mentioned to be granted, unto the said A. B., his executors, administrators, and assigns, for and during, and unto the full end and term of fourteen years from the date of these presents next and immediately ensuing, and fully to be complete and ended, according to the statute in such case made and provided. And to the end that he, the said A. B., his executors, administrators, and assigns, and every of them, may have and enjoy the full benefit, and

the sole use and exercise of the said invention, according to our gracious intention hereinbefore declared: We do, by these presents, for us, our heirs and successors, require and strictly command all and every person and persons, bodies politic and corporate, and all other our subjects whatsoever, of what estate, quality, degree, name, or condition soever they be, within that said part of the United Kingdom of Great Britain and Ireland called England, our dominion of Wales, and town of Berwick-upon-Tweed, [*colonies, &c.*] aforesaid, that neither they, nor any of them, at any time during the continuance of the said term of fourteen years hereby granted, either directly or indirectly, do make, use, or put in practice the said invention, or any part of the same, so attained unto, by the said A. B. 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 license, consent, or agreement of the said A. B., his executors, administrators, or assigns, in writing, under his or their hands and seals, first had and obtained 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 A. B., his executors, administrators, and assigns, according to law, for his and their damages thereby occasioned. And moreover we do by these presents, for us, our heirs and successors, will and command all and singular the justices of the peace, mayors, sheriffs, bailiffs, constables, headboroughs, and all other officers and ministers whatsoever of us, our heirs and successors, for the time being, that they or any of them do not, nor shall at any time hereafter, during the said term hereby granted, in any wise molest, trouble, or hinder the said A. B., his executors, administrators, or assigns, or any of them, or his or their deputies, servants, or agents, in or about the due and lawful use or exercise of the aforesaid invention, or any thing relating thereto. Provided always, and these our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted it shall be made to appear to us, our heirs or successors, or any six or more of our or their Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention, as to the public use and exercise thereof, in that said part of our United Kingdom of Great Britain and Ireland called England, our dominion of Wales, and town of Berwick-upon-Tweed, [*colonies*] aforesaid, *or not invented or found out by the said A. B.* as aforesaid (if the invention is introduced from abroad then, *or not first introduced therein by the said, &c.*); then upon signification thereof, to be made by us, our heirs or successors, under our or their signet or privy seal, or by the lords and others of our or their Privy Council, or any six or more of them, under their hands, these our letters patent shall forthwith cease, determine, and be utterly void, to all intents and purposes, any thing hereinbefore contained to the contrary thereof in any wise notwithstanding. Provided also that these our letters patent and any thing hereinbefore contained, shall not extend, or be construed to extend, to give privilege

unto the said A. B., his executors, administrators, or assigns, or any of them, to use or imitate any invention or work whatsoever which hath heretofore been invented or found out by any other of our subjects whatsoever, and publicly used or exercised in that said part of our United Kingdom of Great Britain and Ireland called England, the dominion of Wales, and town of Berwick-upon-Tweed [*colonies*] aforesaid, unto whom our like letters patent or privileges have been already granted, for the sole use, exercise, and benefit thereof; it being our will and pleasure that the said A. B., his executors, administrators, and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practise their several inventions, by them invented or found out, according to the true intent and meaning of the said respective letters patent, and of these presents. Provided likewise, nevertheless, and these our letters patent are upon the express condition, that if at any time hereafter these our letters patent, or the liberties and privileges here by us granted, shall become vested in or in trust for more than the number of twelve persons, or their representatives, at any one time, as partners, dividing, or entitled to divide, the benefit or profit obtained by reason of these our letters patent, reckoning executors or administrators as and for the single person whom they represent, as to such interest as they are or shall be entitled to, in right of their testator or intestate. And also, that if the said A. B. 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 hand and seal, and cause the same to be enrolled in our High Court of Chancery, within [*time for specifying*] calendar months next and immediately after the date of these our letters patent. And also, that if the said A. B., his executors, administrators, or assigns, shall not supply, or cause to be supplied for our service, all such articles of the said invention as he or they shall be required to supply, by the officers or commissioners administering the department of our service for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said officers or commissioners so requiring the same, that then these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine, and become void, any thing hereinbefore contained to the contrary thereof in any wise notwithstanding. Provided that nothing herein contained shall prevent the granting of licenses, in such manner, and for such considerations, as they may, by law, be granted. And, lastly, we do by these presents for us, our heirs and successors, grant unto the said A. B., his executors, administrators, and assigns, that these our letters patent, or the enrolment or exemplification thereof, shall be in and by all things good, firm, valid, sufficient, and effectual in the law, according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favourable and beneficial sense, for the best advantage of the said A. B., his executors, administrators, and assigns, as well in all our courts of record as elsewhere, and by all and singular the officers and ministers whatsoever of us, our

heirs and successors, in that part of our said United Kingdom of Great Britain and Ireland called England, our dominion of Wales, and town of Berwick-upon-Tweed [*colonies*] aforesaid, and amongst all and every the subjects of us, our heirs and successors, whatsoever and wheresoever, notwithstanding the not full and certain describing the nature or quality of the said invention, or of the materials thereto conducing and belonging.

In witness whereof, we have caused these our letters to be made patent. Witness ourselves at Westminster, this of , in the year of our reign.

By writ of Privy Seal.

FORM OF SPECIFICATION.

To all to whom these presents shall come, I, A. B., of [*&c.*] send greeting. Whereas her most excellent Majesty Queen Victoria, by her letters patent, under the great seal of the United Kingdom of Great Britain and Ireland, bearing date at Westminster, the day of , in the year of her reign, did for herself, her heirs and successors, give and grant unto me, the said A. B., her especial license, sole privilege and authority, that I, the said A. B., my executors, administrators, and assigns, and such others as I, the said A. B., my executors, administrators, and assigns, should at any time agree with, and no others, from time to time, and at all times during the term of years therein expressed, should and lawfully might make, use, exercise, and vend, within England, Wales, and the town of Berwick-upon-Tweed, [*within the Islands of Jersey, Guernsey, Alderney, Sark, and Man, and also within all her Majesty's colonies and plantations abroad,*] my invention of [*here describe the invention in the words of the patent*]. In which said letters patent there is contained a proviso, obliging me, the said A. B., by an instrument in writing, under my hand and seal, particularly to describe and ascertain the nature of my said invention, and in what manner the same is to be performed; and to cause the same to be enrolled in her Majesty's High Court of Chancery, within calendar months next and immediately after the date of the said in part recited letters patent, as in and by the same, reference being thereunto had, will more fully and at large appear. Now know ye that, in compliance with the said proviso, I, the said A. B., do hereby declare that the nature of my said invention, and the manner in which the same is to be performed, are described and ascertained by the drawing hereunto annexed and forming part hereof, and the words following; that is to say [*here are stated the particulars*]. In witness whereof, I, the said A. B., have hereunto set my hand and seal, the day of , in year of our Lord one thousand eight hundred and forty.

A. B. (L. S.)

Taken and acknowledged by the above-named A. B., at the Public Office, Southampton Buildings, Chancery-lane, this day of one thousand eight hundred and forty, before me,

DISCLAIMER AND ALTERATIONS.

PETITION TO THE ATTORNEY OR SOLICITOR GENERAL.

The petition of A. B., of , in the county of profession

Sheweth,

That your petitioner obtained her Majesty's royal letters patent, bearing date at Westminster, the day of in the year of her reign, for [*here is inserted the title of the invention*]. And whereas your petitioner duly enrolled a specification of his said invention. [*Here set forth some of the particulars, sufficient to lead to the nature of the claims of invention, then set forth the disclaimer or alterations, and the reasons for the same.*] Your petitioner therefore prays leave of her Majesty's Attorney or Solicitor General, certified by his fiat and signature, as by the statute in such case made and provided, to enter with the clerk of the patents of England, the said disclaimer and memorandum of alteration, a copy of which, signed by your petitioner, is left herewith, in the form in which your petitioner is desirous the same should be entered as aforesaid.

DISCLAIMER.

[*Recite so much of the Specification as recites the grant of the patent by her Majesty.*]—And whereas I am desirous, for good and sufficient reasons hereinafter mentioned, to enter a disclaimer of that part of the title of my said invention hereinafter next mentioned, and have obtained for that purpose the leave of her Majesty's Attorney-General, certified by his fiat and signature, according to the form of the statute in such cases made and provided: Know ye, therefore, that I do hereby disclaim the following part of the title of my said invention; that is to say. [*State the part disclaimed.*] And I, the said A. B., do further declare that my reasons for making the above disclaimer are as follows; that is to say. [*State them.*] And I, the said A. B., further declare and protest, that the above disclaimer does in no wise extend, or purpose to extend, the exclusive right granted to me by the said letters patent.

In witness whereof, &c.

PROLONGATION OF THE TERM OF A PATENT.

NOTICE.

I, A. B. of [*description*], Gentleman, do hereby give notice that I intend forthwith to apply to her Majesty in Council for a prolongation, for the further term of seven years, or such other term, not exceeding seven years, as her Majesty shall please, of the right of sole using and vending my, the said A. B.'s, invention of [*state invention*], granted to him, the said A. B., by certain letters

patent, bearing date the day of in the [*date*] year of her reign, within that part of the United Kingdom of Great Britain and Ireland called England, the dominion of Wales, and town of Berwick-upon-Tweed; and I, the said A. B., do hereby give further notice, that I intend to apply on the day of next, to the Right Honourable the Lords, comprising the Judicial Committee of her Majesty's Honourable Privy Council, for a time to be fixed for hearing the matters of the said petition for such prolongation of the said term as hereinbefore mentioned. And all persons desirous of being heard in opposition to this the prayer of the said petitioner are hereby required to enter caveats at the Privy Council Office on or before the said day of next.

Signed by the Patentee.

Witnessed by the Solicitor.

PETITION.

To the Queen's most excellent Majesty in Council.

The humble petition of A. B., of

Sheweth,

That your petitioner, after much labour and considerable expense, invented . That your Majesty, by letters patent, dated the day of in the year of your reign, granted to your said petitioner, his executors, administrators, and assigns, the sole use and exercise of his said invention within that part of the United Kingdom of Great Britain and Ireland called England, the dominion of Wales, and the town of Berwick-upon-Tweed, in the Islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all your Majesty's colonies and plantations abroad, for the term of fourteen years from the date of the said letters patent, which term has not yet expired. That your petitioner—[*State the special circumstances warranting the application.*] That your petitioner hath advertised in the *London Gazette* three times, and three times in the *Times*, the *Morning Herald*, and the *Morning Post*, being three London papers: and three times in the *Manchester Guardian*, being a country paper, published in the town of Manchester, where your said petitioner resides and carries on the manufacture of his said invention; that it his intention to apply to your Majesty in council for a prolongation of his said term of sole using and vending his said invention. Your petitioner therefore humbly prays your Majesty to grant to him new letters patent for the sole use and exercise of his said invention, within that part of your Majesty's United Kingdom of Great Britain and Ireland called England, the dominion of Wales, and town of Berwick-upon-Tweed, for a term of seven years after the expiration of the said term of fourteen years first above mentioned, according to the form of the statute in such case made and provided.

And your petitioner shall ever pray, &c.

PETITION FOR THE CONFIRMATION OF A PATENT.

To the Queen's most excellent Majesty in Council.

The humble petition of A. B., of

Sheweth,

That your petitioner, having after great labour and considerable expense invented [*state invention*], which invention is of general benefit and advantage, your Majesty was graciously pleased in consideration thereof to grant to your petitioner, his executors, administrators, and assigns, your royal letters patent, under the great seal of Great Britain, for the sole use and exercise of his said invention, within that part of your Majesty's United Kingdom of Great Britain and Ireland called England, your dominion of Wales, and town of Berwick-upon-Tweed, which said letters patent bear date upon the day of in the year of your Majesty's reign. That it hath since been proved and specially found by the verdict of the jury, in a certain action brought by your petitioner against C. D., and tried before the Right Honourable Thomas Lord Denman, the Chief Justice of your Majesty's Court of Queen's Bench, at Westminster, on the day of in the year of our Lord , that your petitioner was not the *first* inventor of the said by reason of one B. C. having invented the same before the date of the said letters patent. That the said B. C. never at any time before the date of the said letters patent published or made known the said invention; and that your said petitioner was until, and long after, the date of the said letters patent, wholly ignorant that the said B. C. had invented the said or any part thereof, but verily believed himself to be the *first* and true inventor thereof. Your petitioner therefore humbly prays that your Majesty will be graciously pleased to confirm the said letters patent, and make the same available to give your petitioner the sole right of using, making, and vending the said invention, as against all persons whatsoever, within that part of your Majesty's said United Kingdom of Great Britain and Ireland called England, the dominion of Wales, and town of Berwick-upon-Tweed.

And your petitioner shall ever pray, &c.

CAVEATS.

Caveat against any person taking out Letters Patent for any improvement relating to without notice being first given to A., of, &c.

Under 5 & 6 Will. 4, c. 83, s. 1.—Caveat against any person entering a disclaimer or alteration in a title or specification relating to without notice to

Under Id. s. 4.—Caveat against A. B. having any extension of his patent dated the day of 184 , for certain improvements in without notice to

NOTICE OF OBJECTIONS.

In the

A. B. or C. D.

Take notice that on the trial of this cause the defendant (*or* plaintiff) will insist on the following objections to the validity of the patent mentioned in the declaration :—

1st. That, &c. [*State the objections in order.*] Dated the day of 184 .

Signed C. D., attorney for the { defendant / *or* / plaintiff.

To Mr. R. R., the { plaintiff's attorney / *or* / defendant's

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NOTICES ISSUED BY THE REGISTRAR OF DESIGNS.

COPYRIGHT OF DESIGNS.

Office of Registrar of Designs, 35, Lincoln's Inn Fields.

By the Consolidated Designs Copyright Act, 5 & 6 Vict. c. 100, commencing its operation the 1st September, 1842, a copyright or property is given to the authors or proprietors of original designs for ornamenting any article of manufacture or substance, for the various terms specified in the following classes :—

CLASS. ARTICLE.	COPYRIGHT.
1. Articles in Metal	3 years.
2. Articles in Wood	3 „
3. Articles in Earthenware	3 „
4. Articles in Glass	3 „
5. Paper Hangings	3 „
6. Carpets, Floor Cloths, and Oil Cloths	3 „
7. Shawls (patterns printed)	9 months.
8. Shawls (patterns not printed)	3 years.
9. Yarn, Thread, or Warp (printed)	9 months.
10. Woven Fabrics, not Furnitures (patterns printed)	9 „
11. Woven Fabrics, Furnitures (patterns printed)	3 years.
12. Woven Fabrics (pattern not printed)	12 months.
13. Lace and all other articles	12 „

The rights conferred upon the authors or proprietors of original designs are subjected to the following conditions :—

1st. The design must be registered.

2nd. After registration, every article of manufacture published by the proprietor on which such design is used, must have thereon a particular MARK, which will be exhibited on the certificate of registration.

These conditions being observed, the right of the proprietor is protected from piracy by a penalty of from 5*l.* to 30*l.* for each offence, each individual illegal application or sale of a design constituting a separate offence. This penalty may be recovered by the aggrieved party either by action in the superior courts, or by a summary proceeding before two magistrates.

If a design be executed by the author on behalf of another person, for a valuable consideration, the latter is entitled to be registered as the proprietor thereof; and any person purchasing either the exclusive or partial right to use the design is in the same way equally entitled to be registered, and for the purpose of facilitating such transfers, a short form is given in the Act.

A penalty of 5*l.* is imposed in the case of any person using the registration mark on any design not registered, or the copyright of which has expired, or when the design has not been applied within the United Kingdom.

All designs of which the copyright has expired may be inspected at the Registrar's Office, on the payment of the proper fee; but no design, the copyright of which is existing, is in general permitted to be seen. Any person, however, may by application at the office, and on production of the registration mark of any particular design, be furnished with a certificate of search, stating whether the copyright be in existence, and in respect to which article of manufacture it exists; also the term of such copyright and the date of registration, and the name and address of the registered proprietor. Any party may also, on the production of a piece of the manufactured article with the pattern thereon, together with the registration mark, be informed whether such pattern, supposed to be registered, be really so or not.

DIRECTIONS FOR REGISTERING.

All persons wishing to register a design must bring or send to the Registrar's Office two copies thereof, together with the proper fees. These copies may consist, either of portions of the manufactured articles, when such can conveniently be done (as in the case of *Paper Hangings*, *Calico Prints*, &c.), or else of prints or drawings, which, whether coloured or not, must be correct representations of the design. These must be accompanied with the name and address of the proprietor or proprietors, or with the title of the firm under which he or they may be trading, and the place of carrying on business, and *also with the number of that one of the above classes*, in respect of which such design is intended to be registered. After the design has been registered, one of the two copies will be filed at the office, and the other returned to the proprietor, with a certificate annexed, on which will appear the mark to be placed on each article of manufacture on which the design is used.

A design may be registered in respect of one or more of the above classes, according as it is intended to be employed in one or more species of manufacture, but separate copies must be furnished, and a separate fee paid on account of each separate class, and all such registrations must be made at the same time.

All communications with the office for the registration of designs may be made either through the general post or any other mode of conveyance, provided the carriage be paid; and if the proper fees, or an order for payment, be inclosed, the designs will be duly registered, and the certified copies returned to the proprietor free of expense.

The Registrar's Office will be open every day on and after the 1st September, 1842, between the hours of ten in the morning and four in the afternoon, and designs and transfers will be registered from eleven until three, and the following are the fees ordered to be paid by the Treasury :—

TABLE OF FEES.

Registering Designs:—

	£.	s.	d.
Class 1	3	0	0
Class 2	1	0	0
Class 3	1	0	0
Class 4	1	0	0
Class 5	0	10	0
Class 6	1	0	0
Class 7	0	1	0
Class 8	1	0	0
Class 9	0	1	0
Class 10	0	1	0
Class 11	0	5	0

	£.	s.	d.
Class 12	0	5	0
Class 13	0	5	0
Transfer	1	0	0
Certifying design same as registration fee, but for class 1	1	0	0
Cancellation or Substitution	1	0	0
Search	0	2	6
Inspection of designs of which the copyright has expired, each class ...	0	1	0

DESIGNS FOR ARTICLES OF UTILITY.

DESIGNS OFFICE, 35, Lincoln's Inn Fields.

By the act 5 & 6 Vict. c. 100, a copyright is given for such designs for articles of manufacture as are of an ornamental character only; by the new act 6 & 7 Vict. c. 65, commencing its operation on the 1st of September, 1843, a copyright of THREE YEARS is given to the author or proprietor of any new and original design for the shape or configuration either of the whole or of part of any article of manufacture having reference to some purpose of utility, whether such article be made in metal or any other substance.

To obtain this protection, it is necessary—

1st.—That the design should be registered before publication.

2nd.—That after registration, every article of manufacture published by the proprietor, and made according to such design, or on which such design is used, should have upon it the word "REGISTERED," with the date of registration.

In case of Piracy of a design so registered, the same remedies are given, and the same penalties imposed (from 5*l.* to 30*l.* for each offence), as under the act 5 & 6 Vict. c. 100, and all the provisions contained in the latter act relating to the transfer of ornamental designs, in case of purchase or devolution of a copyright, are made applicable to those useful designs registered under this act.

In addition to this, a penalty of not more than 5*l.* nor less than 1*l.* is imposed upon all persons marking, selling, or advertising for sale any article as "registered," unless the design for such article has been registered under one of the above-mentioned acts.

DIRECTIONS FOR REGISTERING AND SEARCHING.

Persons registering a design for purposes of utility must bring or send to the Registrar's Office two exactly similar drawings or prints thereof, made on a proper geometric scale, together with the name and address of the proprietor or proprietors, or the title of the firm under which he or they may be trading; also the title of the design, and such description in writing as may be necessary, either to make it intelligible or to explain which parts may not be new or original. These two drawings or copies must, together with the title, name, &c., be on two separate sheets of paper or parchment, only one side of which must be written or drawn upon. Each of these sheets must not exceed in size 24 inches by 15 inches, and on the same side as the drawings, &c., there must be left a blank space, of the size of 6 inches by 4 inches, upon which the certificate of registration will be placed.

After the design has been registered, one of the drawings will be filed at the office, and the other returned to the proprietor duly stamped and certified.

In case of the transfer of a registered design, a copy, on one sheet of paper, with a blank space left for the certificate, must be transmitted to the registrar, together with the forms of application (which may be procured at the office), properly filled up and signed; the transfer will then be registered, and the certified copy returned.

Certified copies of designs registered under this act will not be delivered before three o'clock the day following that on which they are brought to the office.

Proprietors of designs and agents are expected to examine their certificates previous to leaving the office, as no error can afterwards be rectified.

An Index of the titles and proprietors of all the registered designs for articles of utility is kept at the Registrar's Office, and may be inspected by any person, and extracts made from it.

All such designs, the copyright of which is expired, may be seen and copied at the office.

Any such design, the copyright of which is unexpired, may also be inspected, but copies are not allowed to be taken from them.

All communications for the registration of designs, either for ornamental or useful

purposes, may be made either through the general post, directed to the "Registrar of Designs, Designs Office, London" (and letters or parcels so sent are not restricted in weight to 16 oz.), or by any other mode of conveyance; and provided the carriage be paid, and the proper fees, or a post office order for the amount payable to the Registrar of Designs be inclosed, the designs will be duly registered, and the certified copies returned to the proprietor, free of expense.

The Registrar's Office, 35, Lincoln's Inn Fields, is open every day, between the hours of ten in the morning and four in the afternoon, when inquiries and searches may be made. Designs and transfers are registered from eleven until three.

TABLE OF FEES.

	Stamp. £.	s.	d.	Fee. £.	s.	d.	Total. £.	s.	d.
Registering design	5	0	0	5	0	0	10	0	0
Certifying former registration	5	0	0	1	0	0	6	0	0
Registering and certifying transfer	5	0	0	1	0	0	6	0	0
Cancellation or substitution		—		1	0	0	1	0	0
Inspecting index of titles...		—		0	1	0	0	1	0
Inspecting designs (expired copyrights) each vol.		—		0	1	0	0	1	0
Taking copies of ditto, each design		—		0	2	0	0	2	0
Inspecting designs (unexpired copyrights), each design		—		0	5	0	0	5	0

Directions for registering ornamental designs under the act 5 & 6 Vict. c. 100, may also be procured at the office.

NOTICE.

Designs Office, 9th September, 1843.

As the act 6 & 7 Vict. c. 65, applies only to the shape or configuration of articles of utility, and not to any mechanical action, principle, contrivance, or application (except in so far as these may be dependent upon, and inseparable from, the shape or configuration), no design will be registered the description of which shall contain a claim for any such mechanical action, principle, contrivance, or application.

With this exception, all designs, the drawings and descriptions of which are properly prepared and made out, will be registered, without reference to the nature or extent of the copyright sought to be thereby acquired; which consideration must be left entirely to the judgment and discretion of the proprietor of the design.

Parties are strongly recommended to read the act before determining to register their designs, in order that they may be satisfied as to the nature, extent, and comprehensiveness of the protection afforded by it, of which the registration will not constitute any guarantee.

By order of the registrar,
J. H. BOWEN, Clerk.

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