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# PATENTEE'S MANUAL

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## A TREATISE

ON THE

## LAW AND PRACTICE OF LETTERS PATENT

ESPECIALLY INTENDED FOR THE USE OF

## PATENTEES AND INVENTORS

BY

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# PREFACE TO THE SECOND EDITION.

IN PREPARING the Second Edition of this little work for the press, the whole has been subjected to very careful revision. The latest Statutes and Decisions of the Courts have been noticed in the proper places, and several new Chapters on matters not touched upon in the First Edition have been added. The work in its present shape is consequently much longer, and, it is to be hoped, more useful than in its previous form. Moreover, an entirely new feature appears in the present edition, viz., a summary of the Patent Laws of various foreign States, and such of our Colonies as possess Patent Laws of their own.

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# PREFACE TO THE THIRD EDITION.

A THIRD EDITION of this work having been called for, the whole has been again subjected to careful revision, and the latest Decisions of the Courts have been noticed in their proper places. Additions have also been made to the Acts of Parliament and Abstracts of Foreign Patent Laws placed in the Appendix.

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# EXPLANATION OF ABBREVIATIONS.

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|---|---|
| Ad. & El. | Adolphus & Ellis' Reports |
| B. & A. | Barnewall and Adolphus' Reports |
| B. & Ald. | Barnewall & Alderson's Reports |
| B. & C. | Barnewall & Cresswell's Reports |
| Bea. | Beavan's Reports |
| B. & S., or Best & Sm. | Best & Smith's Reports |
| Bing. N. C. | Bingham's New Cases |
| Bos. & Pul. | Bosanquet & Puller's Reports |
| C. B. | Common Bench Reports |
| C. B. N. S. | Common Bench Reports, New Series |
| C. & K. | Carrington & Kirwan's Reports |
| C. & P. | Carrington & Payne's Reports |
| C. L. | Common Law Reports |
| Carp. Rep. | Carpmael's Reports of Patent Cases |
| Coop. C. C. | Cooper's Chancery Cases |
| Cr. M. & R. | Crompton, Meeson, & Roscoe's Reports |
| Dav. P. C. | Davis' Patent Cases |
| De G. F. & J. | De Gex, Fisher & Jones' Reports |
| De G. & J. | De Gex & Jones' Reports |
| De G. M. & G., or De G. Mac. & Gord. | De Gex Macnaghten & Gordon's Reports |
| De. G. J. & S. | De Gex, Jones & Smith's Reports |
| Dr. & Sm. | Drewry & Smale's Reports |
| E. & B., or El & Bl. | Ellis & Blackburn's Reports |
| Ell. Bl. & Ell. | Ellis, Blackburn & Ellis' Reports |
| Ell. & Ell. | Ellis & Ellis' Reports. |
| Eq. Rep. | Equity Reports |
| Exch. Rep. | Exchequer Reports |
| Giff. | Giffard's Reports |
| H. Bl. | H. Blackstone's Reports |
| H. & M. | Hemming & Miller's Reports |
| H. L. C. | House of Lords Cases |
| Holroyd | Holroyd on Patents |
| Holt N. P. C. | Holt's Nisi Prius Cases |
| Hurlst. & Norm. Ex. Rep., or H. & N. | Hurlstone & Norman's Exchequer Reports |
| Johns. | Johnson's Reports |
| Jur. N. S. | Jurist, New Series |
| K. & J. | Kay & Johnson's Reports |
| L. J. N. S. Ch. | Law Journal Reports, New Series, Chancery |
| L. J. N. S. Q. B. | Ditto, ditto, Queen's Bench |
| L. J. N. S. C. P. | Ditto, ditto, Common Pleas |
| L. J. N. S. Ex. | Ditto, ditto, Exchequer |

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| Law Rep. Ch. Ap. | The Law Reports, Chancery Appeals |
| Law Rep. Eq. | Do. Equity Cases |
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| L. T. | Law Times Reports |
| L. T. N. S. | Do. New Series |
| Macr. P. C. | Macrory's Patent Cases |
| Mac. & Gord. | Macnaghten & Gordon's Reports |
| M. & G. | Manning & Grainger's Reports |
| M. & W. | Meeson & Welsby's Reports |
| Mer. | Merivale's Reports |
| Moore P. C. | Moore's Reports of Cases in the Privy Council |
| Moore P. C. C. N. S. | Ditto, New Series |
| Myl. & Cr. | Mylne & Craig's Reports |
| N. R. | The New Reports |
| Newton's Lond. Jour. | Newton's London Journal |
| Pract. Mech. Jour. | Practical Mechanic's Journal |
| Russ. | Russell's Reports |
| Ry. & Moo. | Ryan & Moody's Reports |
| Scott C. B. R. | Scott's Common Bench Reports |
| Stark. R. | Starkie's Reports |
| T. R. | Term Reports |
| V. & B. | Vesey & Beames' Reports |
| W. P. C. | Webster's Reports of Patent Cases |
| W. R. | The Weekly Reporter |
| Y. & C. | Young & Collier's Reports |

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# ADDENDA.

Page 22, line 21, *add*—See also *Dangerfield* v. *Jones* (13 L.T., N.S. 142).
„ 61, *add to foot-note*—See the remarks of *Wood, V.C.*, on *Jones* v. *Pearce* in *Tangye* v. *Stott* (Weekly Notes, vol. i., p. 68; *S.C.*, Pract. Mech. Jour. vol. i., 3rd *ser.*, p. 365).
„ 96, line 19, *add*—Any part of the provisional specification may be omitted in the complete specification, if there be no fraud, and the effect of the remainder is not altered by the omission. (*Thomas* v. *Welch*, 1 Law Rep., C.P. 192).
„ 116, „ 19, *add*—In *Thomas* v. *Welch* (1 Law Rep., C.P. 192), it was held that all the claiming clauses may be struck out by disclaimer, if there remain sufficient in the body of the specification to distinguish the invention.
„ 133, „ 18, *add*—*Thomas* v. *Welch* (1 Law Rep., C.P. 192).
„ 183, „ 10, *add*—*Dangerfield* v. *Jones* (13 L.T., N.S. 142); *Thomas* v. *Welch* (1 Law Rep., C.P. 192).
„ 148, „ 8, *add*—But this will not be done after undue lapse of time. (*Re Diamond*, 3 L.T., N.S. 800.) Whether the Lord Chancellor has power under 15 & 16 Vict. c. 83, s. 15, to correct clerical errors *quære* (*ibid.*).
„ 155, „ 10 from bottom, *add*—All the claiming clauses may be struck out by disclaimer, if there remain in the body of the specification sufficient to distinguish what the invention is (*Thomas* v. *Welch*, 1 Law Rep., C.P. 192).
„ 150, „ 11 from bottom—*Ralston* v. *Smith* is now reported: 11 H.L.C. 223.
„ 172, „ 17, *add*—When a prolongation of a patent term has once been granted, the jurisdiction of the Judicial Committee is exhausted, and they have no power to entertain an application for a further extension. (*Goucher's Patent*, 2 Moore, P.C.C., N.S. 582.)
„ 183, „ 8 from bottom, *add*—But after the determination of the license, a licensee is not estopped from contesting the validity of the patent. (*Dangerfield* v. *Jones*, 13, L.T., N.S. 142.)
„ 193, „ 11 from bottom, *add*, after the reference,—*Bovill* v. *Crate* (1 Law Rep., Eq. 388).
„ 197, „ 14, *add*—Particulars of objections, stating the use of the alleged invention, 'in the following *among other instances*,' were held sufficient; but the insertion of such words is in general undesirable. (*Penn* v. *Bibby*, 1 Law Rep., Eq. 548.)
„ 198, note,—*Bovill* v. *Crate* is now reported: 1 Law Rep., Eq. 388.
„ 220, line 5 from bottom, *add*—A patentee who has once obtained this certificate may have his full costs in any subsequent action for infringement, even although the validity of the patent may not have been questioned in such action. (*Davenport* v. *Rylands*, 1 Law Rep., Eq. 308, *S.C.* 35, L.J., N.S., Ch. 204).
„ 235, *for* 15 and 16 Vict., ch. 115, *read*—16 and 17 Vict., ch. 115.

# THE LAW

OF

# PATENTS FOR INVENTIONS.

## CHAPTER I.

### PRELIMINARY.

THAT the Crown has the power, in certain cases, of granting to inventors the privilege of a monopoly in working their inventions for a certain number of years, is probably known to every reader before he opens this volume. During that period the entire community is precluded from making use of the invention, except by the permission of the inventor, or the person representing him; the law declaring that the privileged person shall derive the exclusive benefit, whatever that may be, of the invention for the specified time.

This privilege is secured to the inventor by letters patent passed under the Great Seal, and the person to whom the privilege is granted is termed in common parlance the patentee.

For the purposes of the present treatise, there is no need that we should enter upon any historical disquisition as to the common-law right of the Crown in matters of patent privileges. It will be sufficient to state that the right of the Crown to grant privileges

by letters patent to subjects obtaining its favour, was exercised in very early times, and it was only disputed when exclusive rights to sell various commodities, such as salt, iron, and coal, had been granted to certain persons, to the great grievance of their fellow-subjects, and to the oppression of trade. The Statute of Monopolies passed in the twenty-first year of James I., was levelled at the abuses which an undue exercise of prerogative had produced, and being, says Sir Edward Coke, forcibly and vehemently penned for their suppression, cut off all claim on the part of the Crown to the right of granting monopolies and exclusive privileges, whereby the subjects of the realm could be aggrieved and inconvenienced.*

* 'The King had undoubtedly, by the ancient laws of the realm, large powers for the regulation of trade: but the ablest judges would have found it difficult to say what was the precise extent of those powers. . . . In addition to his undoubted right to grant special commercial privileges to particular places, he long claimed a right to grant special commercial privileges to particular societies and to particular individuals; and our ancestors, as usual, did not think it worth their while to dispute this claim till it produced serious inconvenience. At length, in the reign of Queen Elizabeth, the power of creating monopolies began to be grossly abused; and as soon as it began to be grossly abused, it began to be questioned. The Queen wisely declined a conflict with a House of Commons backed by the whole nation. She frankly acknowledged that there was reason for complaint: she cancelled the patents which had excited the public clamours; and her people, delighted by this concession and by the gracious manner in which it had been made, did not require from her an express renunciation of the disputed prerogative. The discontents which her wisdom had appeased were revived by the dishonest and pusillanimous policy of her successor, called King-craft. He readily granted oppressive patents of monopoly. When he needed the help of his Parliament, he as readily annulled them; and as soon as the Parliament had ceased to sit, his Great Seal was put to instruments more odious than those he had recently cancelled. At length that excellent House of Commons which met in 1623, determined to apply a strong remedy to the evil. The King was forced to give his assent to a law which declared monopolies established by royal authority to be null and void.' (Macaulay's History of England, iv. 127.)

That statute (*see the Appendix*) declared that all monopolies, grants, and letters patent, for the sole buying, *selling, making, working, or using* of anything within the realm, were contrary to the laws, and void. But it excepted from the operation of this enactment all letters patent and grants of privilege of the *sole working or making of any manner of new manufactures which others at the time of making such letters patent and grants should not use*, so they be not contrary to law, nor mischievous to the state, by raising prices of commodities at home, or hurt of trade, or generally inconvenient. It was afterwards declared that these excepted grants of privilege should have the same validity that they had previous to the passing of the statute, but no other. Hence, when the validity of a monopoly comes into question, the first point to consider is, whether it is rendered void by the statute; and secondly, if it should not be thereby avoided, whether it is a privilege permitted by the common law.*

In this treatise, however, we restrict ourselves to a consideration of Letters Patent for inventions. It is not every kind of discovery that can be protected by letters patent. For example, no valid patent could be obtained for a new game of skill or chance; or for a new method of calculation; or for a newly-discovered grain suitable for food; or for a newly-discovered natural substance suitable for manure, such as guano, or mineral phosphate of lime. These would not be inventions within the meaning of the statute of James I. and the decisions of our courts of law, which require a patentable invention to be referable to some *manner*

* See this subject carefully examined in *Feather* v. *The Queen*, (Pract. Mech. Jour., vol. 9, 2nd series, 321.)

*of manufacture*, in addition to the possession of the qualities of *utility* and *novelty*.

Nor is it every one who may succeed in obtaining from the Crown a grant of letters patent for an invention that is able to sustain it in a court of law. Letters patent are only valid in the hands of the first and true inventor, (the language of the statute of James,) or in the hands of those who have duly succeeded to his rights.

Again, a patent privilege cannot be granted *in perpetuum;* it must not endure for more than a limited number of years.

We shall take these things in order, and shall proceed to inquire in the following chapters—

1. What is the subject-matter or nature of a patentable invention, and what are the incidents that must by law accompany it.

2. To whom patent privileges may legally be granted.

3. What is the possible duration of such privileges, and the territory over which they may extend.

These matters being disposed of, there will still remain for consideration the very important topic of a *Specification*—the document which the law requires every patentee to draw up and make public before or soon after he obtains his letters patent. Chapters on some collateral subjects, such as *Disclaimers*, the *Assignments* of letters patent, their *Prolongation*, and the *Infringements* of patent rights, will then close this treatise.

# CHAPTER II.

## THE SUBJECT-MATTER OR NATURE OF A PATENTABLE INVENTION.—NO PATENT FOR A BARE PRINCIPLE.—PROCESSES.—CLASSES OF INVENTIONS.—AMOUNT OF INVENTION.

In proceeding to consider the subject-matter or nature of the inventions which may legally be made the subject of patent privileges, it is proper to premise that no general definition can be given which shall exactly mark out what can and what cannot be included in a valid patent. Where the invention is not one of a well-known class, it will be much better for the inventor to consult some one conversant with such matters,—some one whose practical experience comes in aid of general principles, and who is bound by his profession and standing in society to the utmost secrecy, —than to rely altogether upon what is stated in books, or upon a narrow range of precedent. It is the more important that the inventor's attention should be drawn to this point previous to his incurring expense, since a patent is taken out entirely at the risk of the inventor, the Crown in no degree guaranteeing the validity of its grant, which, if contested, must be judged by the abstract rules of law applicable to the case.

We believe it will be found, on examination of the cases, that the inventions which have received the sanction of judicial decision may be classed under one or other of the following heads:—

1. *Vendible articles, the result of chemical or me-*

*chanical processes, such as medicines, felt, waterproof cloth, etc.*

2. *Machines, or improvements in machines.*

3. *Processes, in some cases requiring, in others not requiring, special machinery.*

We need not enter into further detail as to the inventions which fall under the first two heads; but with regard to those comprehended under the third head, we shall make some remarks, after disposing of the cases relating to scientific principles, or the laws of nature.

It has been repeatedly laid down by the Courts that

BARE PRINCIPLES ARE NOT PATENTABLE.

A principle may be of the utmost value in the eyes of philosophers; its discovery may lead to highly important consequences, and form the germ of a striking advance in civilization; yet unless its discoverer can show at least one application of it to a useful purpose, —unless he can point out the means of gaining therefrom some immediate material advantage, he is not permitted to exclude his fellow-subjects from turning it to any account they like. "I rather think it would be difficult (said Lord Kenyon, in *Boulton* v. *Hornblower*) to form a specification of a philosophical principle; it would be something like an idea without a substratum."

In the much-debated case of *Neilson* v. *Harford* (W. P. C. 1. 295) a great deal was said as to the point now before us. Neilson took out his patent in 1828 for the improved application of air to produce heat in furnaces, and in his specification declared that his invention consisted in passing a blast of air from the

blowing-apparatus into an air-vessel kept heated to a considerable temperature, to a red-heat or nearly so, and from that vessel, by means of a pipe, into the furnace; that the size of the vessel must depend on the blast, and on the heat necessary to be produced, but that the form of the vessel was immaterial to the effect, and might be adapted to the local circumstances or situation. The defendants, who were alleged to have infringed this patent, contended that it was void, as being for a principle. The Court of Exchequer admitted that it was very difficult to distinguish it from the specification of a patent for a principle; but after full consideration they thought that the plaintiff did not merely claim a principle, but a machine embodying a principle. They thought that 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 the invention then consisted in this—the interposition of a receptacle for heated air between the blowing-apparatus and the furnace. In the course of the argument, on motions subsequent to the trial, various observations were made by the learned judges on the bench, to which we shall draw the reader's attention. *Alderson, B.*, said, "The blowing-apparatus was perfectly well known; the heating of air was perfectly well known; the tuyere was perfectly well known as applicable to blast furnaces; then what he really discovered is, that it would be better to apply air heated up to red-heat, or nearly, instead of cold air. That is the principle—that is the real discovery; but in order to take out a patent, you must have an embodiment of the principle; and his embodiment of the

principle is the heating of air in a separate vessel, intermediately between the blowing-apparatus and the point where it enters the furnace. Then he says, "I do not mean to claim any shape in which it is done; it may be done in a vessel of any shape, provided only you have such a vessel of such a shape, and fire so applied as that, in the intermediate space between the blowing-apparatus and the furnace, the air arrives at the red-heat." And again, in reply to the argument of the plaintiff's counsel that he claimed every vessel and every shape of closed vessel in which air could be heated between the blowing-apparatus and the furnace: "Then I think that is a principle, if you claim every shape. If you claim a specific shape, and go to the jury and say that which the other people have adopted is a colourable imitation, then I can understand it. If you claim every shape, you claim a principle. There is no difference between a principle to be carried into effect in any way you will, and claiming the principle itself. You must detail some specific mode of doing it."

The words of *Lord Chief Justice Hope*, in the case of the *Household Company* v. *Neilson* (W. P. C. 1. 683), may also be cited in support of the same point, and afford a commentary upon it. "A patent cannot be taken out solely for an abstract philosophical principle—for instance, for any law of nature or any 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 the patent-law sense of the term. Stating such a principle in a patent may be a promulgation of the principle, but it is no application of the principle to any

practical purpose. And *without that application of the principle to a practical object and end, and without the application of it to human industry or to the purposes of human enjoyment, a person cannot in the abstract appropriate a principle to himself.* But a patent will be good, though the subject of the patent consists in the discovery of a great general and most comprehensive principle in science or law of nature, if that principle is by the specification applied to any special purpose, so as thereby to effectuate a practical result and benefit not previously attained. . . . It is no longer an abstract principle. It comes to be a principle turned to account to a practical object, and applied to a special result. It becomes then not an abstract principle, which means a principle considered apart from any special purpose or practical observation, but the discovery and statement of a principle for a special purpose, that is, a practical invention, a mode of carrying a principle into effect. . . . The instant that the principle, although discovered for the first time, is stated in actual application to, and as the agent of, producing a certain specified effect, it is no longer an abstract principle; it is then clothed with the language of practical application, and receives the impress of tangible direction to the actual business of life." "Undoubtedly (said *Eyre, C. J.*, in *Boulton* v. *Bull*, 1 Carp. 149) there can be no patent for a mere principle; but for a principle so far embodied and connected with corporeal substances as to be in a condition to act and to produce effects in any art, trade, mystery, or manual occupation, I think there may be a patent. . . . It is not (referring to the case before him) that the patenteo has conceived an *abstract* notion that the con-

sumption of steam in fire-engines may be lessened, but he has discovered a practical manner of doing it, and for that practical manner of doing it he has taken his patent. Surely this is a very different thing from taking a patent for a principle; it *is not for a principle, but for a process.* Again, the substance of the invention is a discovery that the condensing the steam out of the cylinder, and protecting the cylinder from the external air, and keeping it hot to the degree of steam-heat, will lessen the consumption of steam. This is no abstract principle; it is in its very statement clothed with practical application.

Again, in the above-cited case of *Neilson* v. *Harford* (W. P. C. 1. 295) *Alderson, B.*, said (p. 342), "I take distinction between a patent for a principle and a patent which can be supported is, that you must have an embodiment of the principle in some practical mode, described in the specification, of carrying the principle into actual effect; and then you take out your patent, not for the principle, but for the mode of carrying the principle into effect. In Watt's patent, which comes the nearest to the present of any you can suggest, the real invention of Watt was, that he discovered that by condensing steam in a separate vessel, a great saving of fuel would be effected by keeping the steam cylinder as hot as possible, and applying the cooling process to the separate vessel, and keeping it as cool as possible; whereas before, the steam was condensed in the same vessel; but then Mr. Watt carried that practically into effect by describing a mode which would effect the object. The difficulty which presses on my mind here is, that this party has taken out a patent, in substance like Watt's, for a principle, that

is, the application of hot air to furnaces; but he has not practically described any mode of carrying it into effect. If he had, perhaps he might have covered all other modes as being a variation."

Minter's patent was for the invention of an improvement in the constructing of chairs, and such invention was declared to consist in the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counterbalance to the pressure against the back. The patentee having obtained a verdict at the trial of an action for the infringement of the patent, it was contended, on a motion for a nonsuit, that the patentee had claimed for a *principle*, and not any particular means of carrying the principle into effect. Now, to a principle he was not entitled; and as to the particular means which he in fact adopted, the defendant had not used the mechanical means of the plaintiff. The plaintiff, it was further argued, had appropriated by his specification one of the first principles in mechanics, viz. the lever. But, said *Lyndhurst, C. B.*, it is not a leverage only, but it is a self-adjusting leverage; and it is not a self-adjusting leverage only, but it is a self-adjusting leverage producing a particular effect, by means of which the weight on the seat counterbalances the pressure on the back of a chair. And *Parke, B.*, said, For the application of a self-adjusting leverage to a chair, cannot he patent that? He claims the combination of the two, no matter in what shape or way you combine them; but if you combine the self-adjusting leverage, which he thus applies to the subject of a chair, that is an infringement of the patent. *Lord Lyndhurst* went on to say that the application of a

self-adjusting leverage producing the effect constitutes the machine, and the patentee claims that machine, and the right to make it, by the application of a self-adjusting leverage producing a particular effect. (W. P. C. 1. 134.)

In the case of the *Electric Telegraph Company* v. *Brett* (10 C. B. R. 838), it was argued that the giving of duplicate signals at intermediate stations was not the proper subject of a patent,—being an idea or principle only, and not a new manufacture. But it was held by the Court, that as the patentees had not only communicated the idea or principle, but showed how it might be carried into effect, viz. by appropriate apparatus at each station, the patent was valid.

So, also in *Hills* v. *London Gas Light Company* (5 Hurlst. & Norm. 369), an action upon a patent for the purification of coal gas by the use of hydrated oxides of iron, it was argued that as the property which these oxides possess of combining with sulphuretted hydrogen, the deleterious part of unpurified coal gas, was a perfectly well-known property, the mere application of the oxides to remove sulphuretted hydrogen from gas could not be the subject of a patent. The Court of Exchequer held that if a man were simply to say that he claimed the use of hydrated oxides of iron for the purification of gas, without saying how they were to be applied, the objection might possibly be well founded; but as the patentee had shown how the oxides were to be used, the objection failed. (Comp. *Ormson* v. *Clarke*, 13 C. B. N. S. 337; in error, 14 C. B. N. S. 475; *S. C.* 10 Jur. N. S. 128.)

In *Newall* v. *Elliott*, 10 Jur. N. S. 954; (*S. C.* more fully reported, 13 W. R. 11,) the patent was for "Im-

provements in apparatus employed in laying down submarine telegraph wires;" and the specification, after describing the apparatus, concluded with the following claim :—"First coiling the wire or cable round a cone; secondly, the supports placed cylindrically outside the coil round the cone; thirdly, the use of the rings in combination with the cone as described." It was objected the invention thus claimed was merely a mode of coiling and paying out cables, and was not a new manufacture, and could not therefore be the subject-matter of a patent. The Court, however, overruled the objection, and held the patent valid.



It will have been observed, that what the statute excepts from the operation of the invalidating first clause is the privilege of the *sole working or making of any manner of new manufactures*. Now it seems to have been at one time doubted whether or no a new process of manufacturing a known article was embraced by these words of the statute. *Perhaps*, said *Lord Tenterden*, in the case of *Rex* v. *Wheeler* (2 B. & A. 350), the statute of James "may extend to a new process to be carried on by known implements, or elements acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or of a better and more useful kind." The current of decision since Lord Tenterden's time has converted what he put in a doubtful way into a certainty; for the books are full of cases which prove beyond doubt that a process is patentable. The patent contested in *Gibson* v. *Brand* (W. P. C. 1. 631) was for a new or improved process or manufacture

of silk. *Tindal, C. J.*, said that as the matter turned upon another point, it was not necessary to go into the question whether a patent could be granted for a process in the strict or proper sense of the term or not, but that undoubtedly there was strong reason to suppose that such a patent might be good in law. Such certainly was the opinion of *Chief Justice Eyre* in *Boulton* v. *Bull* (which opinion we shall quote at length immediately), and such also appears to have been the opinion (carefully guarding against any abuse of the doctrine) of *Lord Tenterden* in *Rex* v. *Wheeler*.

It has been said that the doubt as to whether a process is patentable has been needlessly raised, and that it is a misuse of terms to speak of a patentable process at all. The subject-matter of the patent, it is urged, is in reality a *manufacture according to a new process*, and this is therefore a new manufacture. For example, in *Crane* v. *Price*, the subject of the patent was, according to this view, the manufacture of iron by means of a new process, viz. the combination of a hot-air blast and anthracite in the furnace. In *Gibson* v. *Brand* it was the manufacture of silk by a new process.

We are told by *Pollock, C. B.*, (*Stevens* v. *Keating*, W. P. C. 2. 182,) that "the real invention may be, not so much the thing when produced, as the mode in which it is produced; and its novelty may consist, not so much in its existence as a new substance, as in its being an old substance, but produced by a different process. In one sense, an old substance produced by a new process is a new manufacture; of that there cannot be a doubt; and therefore, although the language of the Act has been said to apply only to manufactures and not to processes, when you come to

examine, either literally, or even strictly, it appears to me the expression 'manufacture' is free from objection, because, though an old thing, if made in a new way, the very making of it in a new way makes it a new manufacture. Therefore, although I think this is a patent for the process rather than the product, I think it may be a patent for the product." Again, *Coleridge, J.*, said, in *Bush* v. *Fox* (Macr. Pat. Ca. 176), "manufacture includes both process and result."

Allowing this explanation its full force, it will not extend to many cases wherein it has been decided that bare processes are patentable, or to cases where patents for mere applications have been supported. For example, in *Forsyth* v. *Riviere* (1 Carp. Rep. 401), the application of a known detonating powder to the discharge of known kinds of firearms was held to be a patentable invention. But how could this be a manufacture? Again, in the case of *Hartley's Patent* (W. P. C. 1. 54), it was held that the application of metal plates, made in the ordinary way, to ships and buildings, with the view of protecting them against fire, by preventing the access of air, was a patentable invention. In neither of these cases was any new substance produced, nor any new machinery employed.*

The observations of *Chief Justice Eyre*, on delivering judgment in the famous case of *Boulton* v. *Bull* (Watt's patent), are so important, that we shall lay them, with little abridgment, before the reader. "It

* "Most certainly the exposition of the statute, as far as usage will expound it, has gone very much beyond the letter" (*Eyre, C. J.*, in *Boulton* v. *Bull*, 1 Carp. R. 146); and *Lord Chief Justice Tindal's* remarks in *Cornish* v. *Keene* (W. P. C. 1. 508) show the latitude of interpretation which is given to the word 'manufactures' in the Act of Parliament. "It has a very wide and extended meaning. You may call it almost *invention*."

was admitted in the argument at the bar that the word 'manufacture' in the statute was of extensive signification; that it applied not only to things made, but to the *practice of making*, to principles carried into practice in a new manner, to new results of principles carried into practice. Let us pursue this admission. Under things made, we may class in the first place, new compositions of things, such as manufactures in the ordinary sense of the word; secondly, all mechanical inventions, whether made to produce old or new effects, for a new piece of mechanism is certainly a thing made. Under the practice of making, we may class all new artificial manners of operating with the hand, or with instruments in common use, *new processes* in any part producing effects useful to the public. When the effect produced is some new substance or composition of things, it should seem that the privilege of the sole working or making ought to be for such new substance or composition, without regard to the mechanism or process by which it has been produced, which though perhaps also new, will be only useful as producing the new substance. If Dr. James's powders had been for his method of preparing his powders, instead of for the powders themselves, that patent would have been exceptionable. When the effect produced is a substance or composition of things, the patent can only be for the mechanism, if new mechanism is used, or for the process, if it be a new method of operating, with or without old mechanism, by which the effect is produced.

"The effect produced by Hartley's invention for securing buildings from fire is no substance or composition of things; it is a mere negative quality—the

absence of fire. This effect is produced by a new method of disposing iron plates in buildings. In the nature of things, the patent could not be for the effect produced. I think it could not be for the making the plates of iron, which, when disposed in a particular manner, produce the effect; for those are things in common use. But the invention consisting in the method of disposing those plates of iron so as to produce their effect, and that effect being a useful and meritorious one, the patent seems to have been very properly granted to him for his method of securing buildings from fire. And this compendious analysis of new manufactures mentioned in the statute, satisfies my doubt whether anything could be the subject of a patent but something organized and capable of precise specification. In Hartley's method, plates of iron are the means which he employs; but he did not invent those means. The invention wholly consisted in the new method of using, or, I would rather say, of disposing a thing in common use, and which thing every man might make at his pleasure; and which, therefore, could not, in my judgment, be the subject of the patent. In the nature of things it must be that, in the carrying into execution any new invention, use must be made of certain means proper for the operation. Manual labour, to a certain degree, must always be employed; the tools of artists frequently; often things manufactured but not newly-invented, such as Hartley's iron plates; all the common utensils used in conducting any process; and so up to the most complicated machinery that the art of man ever devised. Now, let the merit of the patent be what it may, it is evident that the patent in almost all these cases cannot be

granted for the means by which it acts, for in them there is nothing new, and in some of them nothing capable of appropriation. Even where the most complicated machinery is used, if the machinery itself is not 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. In Hartley's case, it could not be for the effect produced, because the effect is merely negative, though it was meritorious. In the list of patents with which I have been furnished, there are several for new methods of manufacturing articles in common use, where the sole merit and the whole effect produced are the saving of time and expense, and thereby lowering the price of the article, and introducing it into more general use. Now, I think these methods may be said to be new manufactures, in one of the common acceptations of the word; as we speak of the manufacture of glass, or of any other thing of that kind. The advantages to the public from improvements of this kind are, beyond all calculation, important to a commercial country, and the ingenuity of artists who turn their thonghts towards such improvements is in itself deserving of encouragement; and in my apprehension it is strictly agreeable to the spirit and meaning of the statute 21 James I., that it should be encouraged; and yet the validity of these patents in point of law must rest upon the same foundation as Hartley's. The patent cannot be for the effect produced, for either it is no substance at all, or, what is exactly the same thing as to the question upon a patent, no new substance, but an old one produced advantageously for the public. It cannot be for the mechanism, for there is no new mechanism employed;

it must, then, be for the method; and I would say, in the very significant words of *Lord Mansfield*, it must be for method detached from all physical existence whatever; and I think we should well consider what we do in this case, that we may not shake the foundation upon which all patents stand. Probably three-fourths of all patents granted since the statute passed are for methods of operating and manufacturing, producing no new substances, and employing no new machinery. . . . If we wanted an illustration of the possible merit of a new method of operating with old machinery, we might look at the case now before the Court. If we consider into what general use fire-engines [steam-engines] are come—that our mines cannot be worked without them—that they are essentially necessary to the carrying on many of our principal manufactures—that these engines are worked at an enormous expense in coals, which, in some parts of the kingdom, can with difficulty be procured at all in large quantities—it is most manifest that any method found out for lessening the consumption of steam in these engines, which, by necessary consequence, lessens the consumption of coals expended in working them, will be of great benefit to the public as well as to the individual who thinks fit to adopt it. And shall it now be said, after we have been in the habit of seeing patents granted in the immense number in which they have been granted, for methods of using old machinery to produce substances that were old, but in a more beneficial manner, and also for producing negative qualities by which benefits result to the public, by a narrow construction of the word 'manufacture' in this statute, that there can be no patent for

methods producing this new and salutary effect, connected, and intimately connected, with the trade and manufactures of the country?" (1 Carp. 146–149).

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The inventions for which valid patents have been granted may be roughly divided into the following classes:—

1. *New contrivances applied to new objects or purposes.*
2. *New contrivances applied to old objects or purposes.*
3. *New combinations of old parts, the subject-matter consisting either of material objects or of processes.*
4. *New methods of applying an old thing.*
5. *Processes or methods differing from old processes or methods only by the omission of a step.*

The reader may like to have some illustrations of these classes of inventions, and we shall proceed to offer the following:—

1. *Of a new contrivance applied to a new object or purpose*, the following is an instance:—

Lace made from cotton had the defect of being covered with a kind of down, which injured its appearance and diminished its value. A similar defect was removed from muslin by passing it over rollers of heated iron, and from mits and stockings by the action of flame, fed by oil or alcohol. It occurred to Mr. Hall that the flame of gas might be employed in the manufacture of cotton lace; and after some failures, he succeeded in inventing a method for removing the unsightly fibres by the flame of gas. A patent obtained for this invention was held good. (*Hall* v. *Jarvis*, W. P. C. 1. 100).

2. *A new contrivance employed to effect a well-known*

*object*—to make, for instance, an article previously made in a different way—is also patentable, provided that the new contrivance is attended with some degree of utility; for example, that it accomplishes the result more cheaply than the old contrivance. This is perhaps the largest class of patented inventions. "There may be a valid patent" (said *Lord Eldon* in *Hill* v. *Thompson*, W. P. C. 1. 237) "for a new combination of materials previously in use for the same purpose, or for a new method of applying such materials."

3. *The simple combination of two or more known things has been held a patentable invention*, when the combination is new, and the result is the production of something better, or of something at a lower cost, than before. It was held in *Crane* v. *Price* (W. P. C. 1. 408) that the combination of the hot-air blast with stone coal in the smelting of iron (the hot-air blast and stone coal having been separately in use before, but the combination being previously unknown) was an invention intended by the statute, and such as might well become the subject of a patent. It was said by *Tindal, C. J.*, that there were numerous instances of patents where the invention consisted in no more than in the use of things already known, and acting with them in a manner already known, and producing effects already known, but producing those effects so as to be more economically or beneficially enjoyed by the public.

That the novel combination of old parts having a useful result may form the subject of a valid patent has been again and again decided. (*Lister* v. *Leather*, 8 E. and B. 1004; *Newall* v. *Elliott*, 10 Jur. N. S. 954; *S. C.* 13 W. R. 11).

4. *A new mode of applying a known thing may be the*

*subject of a patent, provided that some ingenuity, some novelty, is exhibited in the mode of making that application*, and that the application is attended by some useful result. In Watt's patent for a new method of lessening the consumption of steam and fuel in steam-engines, the enclosing of the cylinder in a case of wood, or any other material that transmits heat slowly, was claimed, and allowed to be a patentable invention. (*Boulton and Watt* v. *Bull*). In Forsyth's patent, for a method of discharging fire-arms, the patentee claimed the *use* and application of certain known fulminating compounds for this purpose. It was contended that, since the properties of detonating powder were well known for other purposes, the using of such materials to discharge fire-arms was not a new manufacture for which a patent could be supported. But *Abbott, C. J.*, stated that if the invention (*i. e.* this particular application of detonating powder) were new, it was such an one as might be secured by patent. The jury having found the invention to be a new one, the patentee had a verdict. (*Forsyth* v. *Riviere*, 1 Carp. 404.)

Charcoal had been used in refining sugar previously to Derosne's patent; but the old method was to mix charcoal powder with the syrup, and the new was to pass the syrup through beds of charcoal constructed in a particular manner. By the old process a considerable quantity of charcoal was taken up by the syrup, and this was an injury to the sugar. In Derosne's process this objection did not arise; and, moreover, it was applicable not only to the refinement of coarse sugar, but to the original manufacture of sugar out of cane-juice. In an action brought for infringing the patent, the originality of the invention was held not

to be impeached by showing that there had been an earlier use of charcoal in the refinement of sugar. No evidence was given that any other person, before the date of the plaintiff's patent, ever applied in use the *particular mode* of filtering syrup which the patent was intended to introduce: and in the absence of such evidence, *Lord Abinger* directed the jury to find for the plaintiff. (*Derosne* v. *Fairie*, W. P. C. 1, 154.)

In the case of *Cornish* v. *Keene*, a patent for improvements in the manufacture of elastic fabrics was contested. The patentee's object was to produce cloth from cotton flax, or other suitable material, not capable of felting, in which should be interwoven elastic cords of India-rubber coated with filamentous material. He described the mode of effecting this object to be by introducing into the fabric threads of India-rubber, applied as warp or weft, or as both, according to the direction of the elasticity required—the India-rubber threads having been stretched to their utmost tension and rendered non-elastic before being introduced into the fabric, and then being rendered elastic by the application of heat. It was contended that this was not a new manufacture; that it was neither a new manufacture, nor an improvement of an old manufacture, but was merely the application of a known material, in a known manner, to a purpose known before. "That it is a manufacture" (said *Tindal, C. J.*, delivering the judgment of the Court of Common Pleas,) "can admit of no doubt; it is a vendible article, produced by the hand and art of man. Whether it is new or not, or whether it is an improvement of an old manufacture, was one of the questions for the jury, upon the evidence before them; but that it came within

the description of a manufacture, and so far is an invention which may be protected by a patent, we feel no doubt whatever. The materials, indeed, are old, and have been used before; but the combination is alleged to be, and if the jury are right in their finding, is new; and the result or production is equally so. The use of elastic threads or strands of India-rubber, previously covered by filaments wound round them, was known before; the use of yarns of cotton, or other non-elastic material, was also known before: but the placing them alternately side by side together as a warp, and combining them by means of a weft when in extreme tension, and deprived of their elasticity, appears to be new; and the result, viz., a cloth in which the non-elastic threads form a limit up to which the elastic threads may be stretched, but beyond which they cannot, and therefore cannot easily be broken, appears a production altogether new. It is a manufacture at once ingenious and simple." (W. P. C. 1. 517.)

It must be carefully kept in mind, that unless there is some display of ingenuity, a patent for the application of an old contrivance to a new object will not be valid. But it is impossible to lay down any general rule as to the amount of ingenuity which is essential to support a patent. In nice cases, there can be no certainty previous to a judicial decision on the point whether any given patent is or is not impeachable on the ground of want of ingenuity; which phrase cannot be regarded, perhaps, as different from want of novelty. All that can be done is to study the decisions already made, and to be guided by those cases which approach nearest to the one about which doubt may be felt. Some of the decisions, indeed, seem to conflict with

others; and it will require a good deal of acute discrimination on the part of those who are called on to advise inventors, to distinguish the line which separates what is patentable from what is not patentable. In the case of *Kay* v. *Marshall, Lord Cottenham* said, in the House of Lords, "that if Kay had discovered any means of using the machine (*i.e.* the ordinary spinning machine) which the world had not known before, the benefit of that he had a right to secure to himself by means of a patent; but if this mode of using the spinning machine was known before, then he could not deprive them of having the benefit of that which they enjoyed before" (2 W. P. C. 82). The reader will see how nearly such a proposition conflicts with the case of *Bush* v. *Fox*. (Macr. P. C. 152.)

5. *A mode of manufacturing differing in nothing from an old process, except in the omission of a step, may also form the subject of a patent,* as was decided in the case of *Russell* v. *Cowley* (W. P. C. 1. 459). A patent had been obtained for an invention for manufacturing iron tubes, by welding them without the use of a mandril, or internal support; and its validity being contested, it was held good. The process, from first to last, consisted in turning up the edges of a flattened metal plate until they nearly met; in heating the plate, so prepared; and in drawing it when at a welding heat through dies having a conical hole. In passing from the broader to the narrower end of the hole, the edges were compressed against each other, and were welded together; the tube was thus formed without having recourse to the old process, which required a mandril, whereon the overlapping edges of the metal plate were welded by means of hammers. It being contended that

welding by pressure was not a new invention, *Lord Lyndhurst* read the specification as claiming only the manufacture of tubes without a mandril. By the new process, tubes could be made of greater length, of greater uniformity, and considerably cheaper, than before.

Again, it was held in *Booth* v. *Kennard* (Hurlst. & Norm. Ex. Rep. 1. 527), that to obtain gas by the direct distillation of oleaginous seeds was a patentable invention, although gas had been previously obtained by the distillation of oil expressed from oleaginous seeds.

### AMOUNT OF INVENTION REQUIRED TO SUPPORT A PATENT.

In contesting the validity of a patent, it is often objected that there had been no exercise of ingenuity on the part of the alleged inventor in arriving at his invention, and that mere accident or good luck is not entitled to a patent privilege. Where, however, the utility of the invention is great, and the novelty undoubted, these facts will come in aid of an apparent want of ingenuity on the part of the inventor. "In point of law (said *C. J. Tindal*, in *Crane* v. *Price*, W. P. C. 1. 411), the labour of thought or experiment, and the expenditure of money, are not the essential grounds of consideration on which the question whether the invention is or is not the subject-matter of a patent ought to depend; for if the invention be new and useful to the public, it is not material whether it be the result of long experiment and profound search, or whether by some sudden and lucky thought, or mere accidental discovery." In either of the two last cases, the practical realization of a good idea must be considered a sufficiently meritorious consideration for the exclusive privilege granted to the inventor, although the actual amount of thought

expended in making the invention is trifling. The case of water-tabbies, so often mentioned in Westminster Hall, is a case in point. The invention (according to *Mr. Justice Buller*, in *Boulton* v. *Bull*) first owed its rise to the accident of a man's spitting on a floor-cloth, which changed its colour, whence he reasoned, had his patent, and made, it is said, a considerable fortune by it.

The making of iron gas-tubes without the use of a mandril, viz. by welding them without striking them on a solid surface, "seems to be a very simple invention" (said *Lyndhurst, C. B.*, in *Russell* v. *Cowley*); "but it has been productive of great advantages, inasmuch as it has enabled the manufacturer to construct pipes of lengths much beyond what could be done previously to this discovery" (W. P. C. 1. 467). Hence the utility of the invention was apparent from the important consequences that flowed from it, and the patent was supported.

The case of *Lewis* v. *Davis* (W. P. C. 1. 488) is usually cited to show that a small degree of invention suffices to sustain a patent, provided it be attended with useful results. The object of the patent was the shearing of cloth from *list to list* by means of rotatory cutters. Now a rotatory cutter to shear from *end to end* was known, and cutting from list to list by *means of shears* was also known. "However" (said *Tenterden, C. J.*, to the jury, on the trial of an action for the infringement of the patent, in which the question of novelty was raised), "if before the plaintiffs' patent the cutting from list to list, and the doing that by means of rotatory cutters, *were not combined*, I am of opinion that this is such an invention by the plaintiffs as will entitle them to maintain the present action."

# CHAPTER III.

## THE INCIDENTS OF UTILITY AND NOVELTY WHICH MUST BY LAW ACCOMPANY PATENTABLE INVENTIONS.

THE two chief incidents which are required by law to attend every invention that claims the protection of letters patent, are Utility and Novelty.

If a material part of the alleged invention should turn out to be either not useful or not novel, the patent is altogether void, the legal maxim *utile per inutile* being here disregarded. (See *Crossley* v. *Beverley*, W. P. C. 1. 106; *Hill* v. *Thompson*, W. P. C. 1. 249; *Manton* v. *Parker*, Dav. P. C. 327; *Bloxam* v. *Elsee*, 1 Carp. 444). And in like manner, where several distinct inventions are included in one patent, of which some only are useful or novel, the useless or old invention or inventions will invalidate the whole patent. (*Turner* v. *Winter*, Dav. P. C. 145; 1 T. R. 602; *Bloxam* v. *Elsee*, 6 B. & C. 178; *Morgan* v. *Seaward*, W. P. C. 1. 196; *Kay* v. *Marshall*, 2 W. P. C. 71). The Crown having been misled as to the extent of the invention, the grant of letters patent in respect of it is void. It was on this principle that the Court, in deciding *Morgan* v. *Seaward*, looked at the cases of *Hill* v. *Thompson* (W. P. C. 1. 237), and *Brunton* v. *Hawkes* (4 B. & A. 541); in which a patent for several inventions was held to be altogether void, because one was not new. The want of *novelty* is a fatal defect by the express wording of the statute, so far as relates to that

which is old; and the whole patent is rendered void by the construction that the consideration for the grant is the novelty of all the parts, which consideration failing, or as it is sometimes expressed, the Crown being deceived, the patent is void.

The questions as to the utility and novelty of the inventions, in respect of which a patent is sought, or has been granted, are consequently of the utmost importance, and it will be necessary to go into the matter at some length. And first, as to the question of

### UTILITY.

If an invention contains no degree of usefulness whatever, over and above inventions already known, then the patent is void. (*Manton* v. *Parker*, Dav. P. C. 327.)

A patent for a useless invention is thought by some to be void at common-law; by others, by force of the Statute of Monopolies, which renders void grants of privileges which tend to the hurt of trade, or are generally inconvenient. For, if a monopoly were allowed in a useless invention, other persons would be prevented from improving it, or turning it to any account whatever, so that combinations of utility might be impeded. It would stand in the way of real inventors, and hence be mischievous to the public generally. (See the observations of *Parke, B.*, in *Morgan* v. *Seaward*, W. P. C. 1. 196.) On the trial of *Palmer* v. *Wagstaff*, at Nisi Prius (Newton's Lond. Journ. vol. xliii. p. 131), *Chief Baron Pollock* said that, in legal language, it is a fraud on the law of patents for any person to take out a patent with a view to the obstruction of improvements. The evidence showed that the plaintiff's patent, which

it was alleged the defendant had infringed, had never been worked; no attempt had been made to bring the candles of the patented construction before the public; and the patent was only then brought into play, for the purpose of stopping the defendant from a course of improvement.

It is to be observed that the recital of the Crown's willingness "to give encouragement to all arts and inventions which may be for the *public good*," clearly points to the quality of utility as one of the considerations for the grant, which failing, the patent will be invalid.

It is for the jury, not the Court, to decide the question of utility when the point has been raised by appropriate pleadings;* and the question will go before them in the general shape of utility or no utility. They have not to consider to what extent the invention is useful, but only whether it is of any use at all. *Mr. Baron Parke*, in *Neilson* v. *Harford* (W. P. C. 314), speaking of a patent for the use of hot-blasts in furnaces, laid it down, that if the apparatus were an improvement, so as to be productive, practically, of some beneficial result, no matter how great, provided it is sufficient to make it worth while (the expense being taken into consideration) to adapt such an apparatus to the ordinary machinery in all cases of forges, cupolas, and furnaces, where the blast is used, then

* That the patentee must go into proof of the utility of his invention in case that issue is raised is shown by what fell from the Judges in the cases of *Rex* v. *Arkwright*, Dav. P. C. 138; *Manton* v. *Parker*, Dav. P. C. 327; *Manton* v. *Manton*, Dav. P. C. 333; *Bovill* v. *Moore*, Dav. P. C. 399; *Bruston* v. *Hawkes*, 4 B. & Ald. 541; *Russell* v. *Cowley*, W. P. C. 1. 467; *Hill* v. *Thompson*, W. P. C. 1. 237; *Minter* v. *Wells*, W. P. C. 1. 129; *Crane* v. *Price*, W. P. C. 1. 411.

that there would be utility sufficient to support the patent. The *quantum* of improvement (should an improvement be in dispute) is not a material point; it is enough that they can find *any* improvement. (*Alderson, B.*, in *Morgan* v. *Seawàrd*, W. P. C. 1. 172, 186.) In other words, in order to quash a patent on this ground, a jury must expressly find that the invention is of no use.

But it must be kept in mind, that it is the *invention* which is required to possess utility, not merely the thing produced. As *Pollock, C. B.*, remarked, on trying the case of *Palmer* v. *Wagstaff* (above cited), it is not sufficient for the maintaining of a patent to prove that the article produced under it is useful; it must be the invention that effects the utility. Thus a patented manufacture should be either better in quality, or cheaper in cost, than that which it is intended to supplant.

The uselessness of part of an invention, however, will not be allowed to vitiate the patent, unless that part is described as something essential. The case of *Lewis* v. *Marling* (W. P. C. 1. 488), arose out of a patent for an improved machine for shearing woollen cloths, in which the patentee claimed, amongst other things, the use of a brush for raising the wool on the surface of the cloth to be shorn, but not as an essential part of the machine. Before any machine was made for sale, this part of the invention was discovered to be useless, and no machines were ever sold with the brush attached. It was contended that this uselessness of part vitiated the whole, but *Lord Tenterden* said, "If the patentee mentions that as an essential ingredient in the patent article which is not so, nor even useful, and whereby

he misleads the public, his patent may be void; but it would be very hard to say that this patent should be void, because the plaintiffs claim to be the inventors of a certain part of the machine not described as essential, and which turns out not to be useful." *Bayley* thought that if the patentee had known the brush to be unnecessary, the patent would be bad, on the ground that this was a deception; but if he believed it to be proper, and only by a subsequent discovery found out that it was not necessary, it would form no ground of objection.

In the case of *Haworth* v. *Hardcastle* (W. P. C. 1. 480), the jury found specially that the invention was useful upon the whole, but that the machine was not useful in some cases. The judges of the Court of C. P. held that this finding of the jury did not negative the utility of the machine in the generality of cases, but rather led to the inference that in the generality of cases it was useful, in which event the patent would be valid, and it was accordingly supported.

One good test of the utility of an invention is afforded by showing that an improvement of the trade (using these words in their commercial sense) has taken place in consequence of it. The invention patented by Lord Dudley consisted in substituting pit-coal for charcoal in the manufacture of iron. Neilson patented a process of smelting iron by blowing the furnace with hot in place of cold air. Crane smelted iron by means of anthracite instead of ordinary fuel, and combined the hot-blast with this. All these processes were productive of great improvements in the manufacture of iron, and the patents were all supported by the Courts.

Brunton took out a patent for an improvement in

chain cables, which consisted in making the links with straight sides and circular ends, in place of twisted links, and in substituting a cast-iron stay with broad ends embracing the sides of each link for a wrought-iron stay formerly fixed across the middle of the opening of the link to prevent it collapsing. The combination of a link with a stay of those particular forms was considered so far new, although the form of the link had been previously known, that the inventor would have had the benefit of his patent, upon his showing that the combination operated beneficially, if the patent had been obtained for this combination alone (*Brunton* v. *Hawkes*, Carp. R. 1. 412).

It has been said from the Bench, that the fact of a published invention not meeting with public acceptance, is some presumption against its utility. It is something for a jury to take into consideration, when the question of utility is raised before them, that a machine has not been called for by the public (*Morgan* v. *Seaward*, W. P. C. 1. 186).

We now turn to the question of

### NOVELTY.

The statute of James declares excepted from the invalidating clause "all letters patent and grants of privilege of the sole working or making of any manner of *new* manufactures to the true and first inventor of such manufactures, *which others at the time of making such letters patent and grants should not use.*" Moreover, letters patent invariably contain a clause, avoiding the grant in case the invention "is not a *new* invention as to the public use and exercise thereof." Two distinct issues on the point of novelty are usually raised

upon the pleadings when a patent is in controversy—1st, Whether the patentee is the 'true and first' inventor of the patented invention; and 2nd, Whether the subject-matter of the patent is a new invention as to the public use and exercise thereof. "Sometimes" (said *Tindal, C. J.*, in *Cornish* v. *Keene*, W. P. C. 1. 507) "it is a material question to determine whether the party who got the patent was the real and original inventor or not; because these patents are granted as a reward, not only for the benefit that is conferred upon the public by the discovery, but also to the ingenuity of the first inventor; and though it is proved that it is a new discovery so far as the world is concerned, yet if anybody is able to show that although that was new, that the party who got the patent was not the man whose ingenuity first discovered it, that he had borrowed it from A or B, or taken it from a book that was printed in England, and which was open to all the world, then, although the public had the benefit of it, it would become an important question whether he was the first and original inventor of it.'

It cannot, however, be objected to a patent that the invention is wanting in novelty, because something, with a similar object, has already been made the subject of a patent; provided that the means by which the object is attempted to be accomplished are substantially different in the two cases.

Neither is a patent rendered invalid by the fact that the invention includes the subject-matter of a patent previously obtained, and not yet expired (*Crane* v. *Price*, W. P. C. 1. 413; *Ex parte Fox*, 1. V. and B. 67). Of course, the second patentee must obtain the first patentee's licence before working his own patent, or he

will lay himself open to an action for an infringement as long as the earlier patent remains in force; and, of course, there must be some amount of new invention in addition to the previous invention, otherwise there is nothing to afford a foundation for a patent.

In *Minter* v. *Mower* (W. P. C. 1. 140), it appeared that the plaintiff had taken out a patent for an improvement in reclining chairs, consisting in the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counterbalance to the pressure against the back. Mower, the defendant, made chairs in imitation of Minter's chair, and contended, in an action for infringing the patent, that the plaintiff was not the first and true inventor, alleging that one Brown had, previous to the patent, made chairs embodying a similar principle. It appeared, however, that although Brown's chair contained a similar principle to that patented, it was incumbered with machinery which rendered it a very different thing from the plaintiff's. *Lord Denman* said that, supposing Brown's chair to have been a chair with a self-adjusting leverage (*i. e.* a chair similar to the plaintiff's), if the incumbering additional part had been away, "then the question is, whether the principle of self-adjustment was at all discoverable or thought of at that time. Because, it seems to me, if that principle might have been deduced from the machinery of the chair that was made, but it was so encumbered and connected with other machinery that nobody did make that discovery, or ever found out that they could have a chair with a self-adjusting leverage, by reason of that or any other defect in the chair actually made; it seems to me that does not prevent this from being a

new invention, when the plaintiff says, I have discovered, throwing aside everything but this self-adjusting leverage itself, that will produce an effect, which I think a very beneficial one."

The case of *Losh* v. *Hague* (W. P. C. 1. 202) may be advantageously compared with that of *Minter* v. *Mower*. Losh's patent was for improvements in the wheels of railway-carriages, and these improvements consisted in constructing the pieces composing the entire wheel of malleable iron, and then welding them together. It was contended by the defendant that the invention was not new, inasmuch as one Paton had, previous to the date of Losh's patent, and under a patent of his own, specified a mode of constructing wheels, not, however, for railways, since railways did not then exist, which wheels were of wrought iron, and differed little, if at all, from those patented by Losh; moreover, that although the first wheel made under Paton's patent was riveted, all Paton's other wheels, thirty pairs in number, were made with the circumference of the inner rim entirely of wrought iron, and then welded into one piece. "The question you have to try," said *Lord Abinger* to the jury, "on the originality of Losh's invention, is not whether Paton's patent contains that perfect periphery that is required in this case, but whether wheels have been publicly made on this principle." (The jury by their verdict found that wheels had been previously made on the same principle as Losh's wheels.) "If," continued his lordship, "the wheels had been made and sold to any one individual, the public's not wanting them because there were no railways, their not being adapted to any particular use, which at that time was open to the public to apply

them to, makes no difference. You have it in evidence that these wheels were made in the first instance; that thirty pairs were made with a complete continuous circumference all round. If they were so made and sold, or used at all, though not for any purpose that then made them popular or desirable, still they are made with that particular advantage which is claimed by Losh's patent, namely, a periphery made of one continuous piece of wrought iron, as well as the spokes. But that is not all the evidence; there are two parties from Manchester. One Horsfall says that he remembers, nearly twenty-eight years ago, in the year 1810, when he came into the employ of his present employers, that there were three trucks, having each three wheels, and those wheels were made of wrought iron spokes in a wrought iron circumference, and there is one exhibited before you which was actually in use at that time; the other, Roberts, confirms that, and has stated that they existed for many years, and that they have been used."

In *Lewis* v. *Marling* (W. P. C. 1. 496), *Bayley, J.*, said, "If I make a discovery, and am enabled to produce an effect from my own experiments, judgment, and skill, it is no objection that some one else has made a similar discovery in his mind, unless it has become public." And *Parke, J.*, said, "There is no case in which a patentee has been deprived of the benefit of his invention because another had also invented it, unless he had also brought it into use." Again, in the case of *Hill* v. *Thompson* (W. P. C. 1. 244), *Dallas, J.*, said, "It is not enough to have discovered what was unknown to others before, if the discovery be confined to the knowledge of the party having made it; but it

must have been communicated more or less, or it must have been more or less made use of, so as to constitute discovery as applied to subjects of this sort."

The evidence given in *Lewis* v. *Marling*, to impugn the patentee's claim of novelty, was that several years previously a similar machine was in use at New York, and that a specification had been sent over in 1811 to a person residing at Leeds, who employed two engineers *to manufacture a machine from it, which was never* finished, in consequence of disturbances amongst the populace. The specification was shown to several persons; but the machine was never brought into use. In 1816, a model of a machine for shearing from list to list, by means of a rotatory cutter, was brought over from America, and shown to two or three persons in the manufactory of the importer; but no machine was ever made from it, nor was it publicly known to exist. Moreover, one Coxon, many years previously, had made a machine to shear from list to list, and this was tried by a person called as a witness; but he did not think it answered, and soon discontinued the use of it. *Lord Tenterden* told the jury that if it could be shown that the patentee had seen the model or specification, that might rebut the claim of invention; but there was no evidence of that kind; and he left it to them to say whether the invention had been in public use and operation before the granting of the patent. They found that it had not; and on the motion for a new trial, the Judges thought there was no reason to find fault with the verdict.

In charging the jury assembled to try the action of *Cornish* v. *Keene* (W. P. C. 1. 508), *Tindal, C. J.*, said, that "if the invention was at the time the letters

patent were granted in any degree of general use; if it was known at all to the world publicly, and practised openly, so that any other person might have the means of acquiring the knowledge of it as well as the person who obtained the patent, then the letters patent are void. Now it will be a question for you to say whether, upon the evidence which you have heard, you are satisfied that the invention was or was not in public use and operation at the time the letters patent were granted. It is obvious that there are certain limits to that question; the bringing it within that precise description which I have just given, must depend upon the particular facts which are brought before a jury. A man may make experiments in his own closet for the purpose of improving any art or manufacture in public use; if he makes these experiments, and never communicates them to the world, and lays them by as forgotten things, another person who has made the same experiments, or has gone a little further, or is satisfied with the experiments, may take out a patent and protect himself in the sole making of the article for fourteen years; and it will be no answer to him to say that another person before him made the same experiments, and therefore that he was not the first discoverer of it, because there may be many discoverers starting at the same time, many rivals that may be running on the same road at the same time, and the first that comes to the Crown and takes out a patent, it not being generally known to the public, is the man who has the right to clothe himself with the authority of the patent and enjoy its benefits. That would be an extreme case on one side; but if the evidence, when properly considered, classes

itself under the description of experiment only, and unsuccessful experiment, that would be no answer to the validity of the patent. On the other hand, the use of an article may be so general as to be almost universal. In a case like that you can hardly suppose that any one would incur the expense and trouble of taking out a patent. That would be a case where all mankind would say, 'You have no right to step in and take that which is in almost universal use, for that is, in fact, to create a monopoly to yourself in this article without either giving the benefit to the world of the new discovery, or the personal right to the value of the patent, to which you would be entitled from your ingenuity and from your application.' Therefore it must be between these two limits that cases will range themselves in evidence; and it must be for a jury to say whether, supposing those points to be out of the question in any particular case, the evidence which has been brought before them convinces them that the subject of the patent was in public use and operation at that time, at the time when the patent itself was granted by the Crown. If it was in public use and operation, then the patent is a void patent, and amounts to a monopoly; if it was not, the patent stands good."

*Hancock* v. *Somervell* (reported in Newton's L. J., vol. 39, p. 158) is a recent case in which peculiar circumstances were adduced in evidence for the purpose of rebutting the claim to novelty. Hancock's patent was for improvements in the preparation of caoutchouc, and the invention consisted in combining sulphur with the caoutchouc, which rendered it elastic at all temperatures. The defendants imported from America

shoes made of caoutchouc, which, when analyzed, were found to contain sulphur along with oxide of lead and other ingredients. In an action for an infringement of the patent it was proved in evidence, that previous to the date of the plaintiff's patent specimens of caoutchouc prepared by sulphur were sent to England by Goodyear, of New York, and were shown to Hancock, but the secret of the manufacture was not communicated to him. Negotiations were commenced for the sale of the invention to Hancock, but never completed. It was stated in evidence that Goodyear's agent left specimens with Hancock, supposing that it would not be possible for him to discover the process by which it was prepared. However, Hancock made experiments, and discovered that sulphur endowed caoutchouc with the property of elasticity at all temperatures, and he then took out his patent. *Mr. Justice Williams* left it to the jury to say whether, supposing the shoes to have been manufactured in England, they could have been made without infringing the plaintiff's patent; and then he proceeded to make these remarks upon the novelty issues:—"The defendants do not deny that Hancock is to be considered the inventor, notwithstanding Goodyear had previously made the discovery, provided the invention had not been published or in use in this country before the date of the patent. The defence consists of this—not only had Goodyear discovered the invention first, but also that the invention had been substantially published, and was in use, not in secret use, but in public use before the date of the patent; that the material being in public use, the ready means of the invention were also necessarily before the public; because it is said the

article presented in itself such means of knowledge to the public as to enable any one of ordinary competence to reproduce the article. If you should be of opinion that the material was in use before the date of the patent, then the question resolves itself into this: what is your opinion as to whether the publication of the material was substantially a publication of the invention? If you should find that the material was in public use, but that, notwithstanding, the invention remained still a matter to be discovered, in my opinion the plaintiff's case would not be affected by the circumstance of the material being in public use. If, on the other hand, you should think not only that the material was in public use (and I should here say that I do not think it is necessary the use should be actual sale—if it were in public use it need not be sold; it would be sufficient, for instance, if it were in use, handing about the country for the purpose of attracting customers); if you should think, also, that the material being so in use, it was so palpable how you could make it, when you got the material, that substantially the disclosure of the material was a disclosure of the means of making it;—if you do not think that, then I think the plaintiff's case is unaffected by the circumstance of the material being before the public in the way I have been describing." The jury found a verdict for the plaintiff.

On the trial of *Muntz* v. *Foster* (2 W. P. C. 103–108), *Tindal, C. J.*, said to the jury, with reference to the issue as to the novelty of the invention—"I look upon the invention to consist in this, that Muntz has by an experiment ascertained that a certain mixture of the alloy of zinc with copper will have the effect of pro-

ducing a better sheathing, by reason and by means of its oxydating just in sufficient quantities—that is, not too much, so as to wear away and impair the sheathing and render the vessel unsafe, but enough, at the same time, to keep by its wearing the bottom of the vessel clean from those impurities which before attached to it. That I consider to be the meaning of the patent, and the object with which it was taken out. And I cannot think, that if it was shown (as possibly it might be) that sheets had been made of metal before, in the same proportion which he had pointed out—that if this hidden virtue or quality had not been discovered or ascertained, and consequently the application never made, I cannot think the patent will fail on that ground. I look upon it that there is as much merit in discovering the hidden and concealed virtue of a compound alloy of metal, as there would be in discovering an unknown quality which a natural earth or stone possessed. We know, by the cases that have been determined, that where such unknown qualities have, from the result of experiments, been applied to useful purposes of life, that such application has been considered as the ground, and the proper ground, of a patent; and, therefore, when I come to that part of the case in which they seek to show this is not so, because these metal plates have been invented before—that is, persons have used them before—in my judgment it will not go far enough, unless they can show there has been some application of them before to this very useful purpose. . . . I do not think that the circumstance of showing that the combination of these two materials in a metal plate will of itself destroy this patent, when no attention at the time was paid to the

purpose for which this patent was taken out, and it was made merely in the ordinary course of melters of metals for the various and ordinary purposes of life. I do not think that the circumstances of showing, that in the long time that has passed before us in the different, and I may say infinitely varying, combinations that must have been made for the various purposes for which brass and other metal was manufactured for ordinary and common purposes of life—to call a workman to show that on some occasion or occasions he had combined them in those proportions for another and different purpose; it does not appear to me that such destroys the patent."

The existence of a patent for a certain application of a given thing (which thing is not new) will not vitiate a subsequent patent for another application of the same thing, provided that the two applications are perfectly distinct, and that the second application is not in any way embraced by the specification under the first patent. One Vaucher took out a patent for an improvement in packing hydraulic and other machines by means of a lining of soft metal, whereby certain parts of the machines were rendered air-tight and water-tight. It was subsequently discovered by one Newton, that the same material, soft metal, could be usefully employed in diminishing the friction of machinery in rapid motion, and in preventing the generation of heat, by applying it to the surfaces in contact. It was held, in an action for an infringement of Vaucher's patent, that the two applications of soft metal were essentially different, and consequently that Newton's invention was new, and his patent good (*Newton* v. *Vaucher*, 6 Exch. Rep. 859).

Under a patent for the purification of gas, Mr.

Croll specified for the use of oxides of iron, which expression was held to mean both hydrated and anhydrous oxides of iron. Hills afterwards obtained a patent for the use of anhydrous oxide of iron for the same purpose; but it was said, in an action which he brought for the infringement of his patent, that he had been anticipated by Croll. On his part it was argued that as it was a fact that some oxides would answer the object in view, and some would not, it became a subject for investigation and experiment to ascertain what oxides it would be proper to employ, and that when he had made the discovery he was entitled to a patent in respect of it. The Court of Exchequer held that this discovery might properly be the subject of a patent. (*Hills* v. *London Gas Light Co.*, 5 Hurlst. and Norm. 312.)

In the case of *Betts* v. *Menzies* (10 H. L. C. 117; *S. C.* 9 Jur. N. S. 29), it was held that a general description in a prior specification or in a published book, even if suggesting information or involving some speculative theory pertinent to the invention in question, is not to be considered as anticipating, and therefore avoiding for want of novelty, a subsequent patent involving a practical invention productive of beneficial results, unless it is ascertained that the antecedent publication involves the same amount of practical and useful information. Betts' patent was for the production of a material capable of application to many useful purposes by combining plates of lead and tin by means of pressure. It appeared that as far back as 1804 one Dobbs had patented a process for making a new material by combining lead and tin by pressure, but he did not with any precision define the relative thicknesses of the plates of metal nor the degree of

pressure to be applied, whereas Mr. Betts entered minutely into those points. Moreover, it was not shown that the earlier process had ever been carried into practice. Under these circumstances, the House of Lords held that Betts' invention had not been anticipated. See also the observations of *Wood, V. C.*, in the subsequent case of *Betts* v. *De Vitre* (11 L. T. N. S. 445), in which the validity of the same patent was in question.

A patent is not deprived of the attribute of novelty because in the interval between its date and the date of the specification the invention has been made public. One Desgrands took out a patent in November, 1832, and enrolled his specification in May, 1833. Sievier's patent was dated in January, 1833, and his specification in July of the same year; but the article made under this patent was publicly manufactured and largely sold in the intervening March and April. Assuming the invention in these two patents to be the same, it was contended that the latter patent was void for want of novelty; but after argument in the Court of C. P., it was held that the facts did not warrant such a construction. (*Cornish* v. *Keene*, W. P. C. 1. 519).

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When the pleadings in an action upon a patent raise the issue of the novelty of the invention, the use in public of that invention, prior to the date of the patent, may be given in evidence; and if this can be proved to the satisfaction of the jury, the patent is void. The previous use of an invention may have been open, notorious, and general; or it may have been practised only by one or two persons, under circumstances which leave it doubtful whether the user was a public user. It therefore becomes necessary to inquire

### WHAT IS PUBLIC USER?

One of the first cases which the books contain was decided in 1798. Tennant brought an action for an infringement of a patent which he had obtained for a method of using calcareous earths instead of alkaline substances in bleaching. It was proved, on the one hand, that bleachers were generally ignorant of the patented bleaching liquor until after the date of the patent. On the other hand, it was proved that a certain bleacher had used the same method of preparing bleaching-liquor for five or six years previous to the date of the patent; and that the method had been kept secret from all except his two partners, and two servants employed in preparing the liquor. On this evidence the plaintiff was nonsuited, the previous user being held to render the patent invalid (Dav. P. C. 429).

The case of *Carpenter* v. *Smith* (W. P. C. 1. 530) arose out of an alleged infringement of a patent for an improved lock. "I think," said *Lord Abinger* to the jury, "that what is meant by 'public use and exercise' is this: a man is entitled to a patent for a new invention, and if his invention is new and useful, he shall not be prejudiced by any other man having invented that before, and not made any use of it; because the mere speculations of ingenious men, which may be fruitful of a great variety of inventions, if they are not brought into actual use, ought not to stand in the way of other men equally ingenious, who may afterwards make the same inventions and apply them. A great many patents have been taken out, for example, upon suggestions made in a celebrated work by the Marquis

of Worcester, and many patents have been derived from hints and speculations by that ingenious author. But yet, as he never acted upon them, as he never brought out any machines whatsoever, those patents are good. So that the meaning of these words, 'public use,' is this: that a man shall not, by his own private invention, which he keeps locked up in his own breast, or in his own desk, and never communicates it, take away the right which another man has to a patent for the same invention. Now 'public use' means this: that the use of it shall not be secret, but public. If a man invents a thing for his own use, whether he sells it or not,—if he invents a lock, and puts it on his own gate, and has used it for a dozen years, that is a public use of it. If it were otherwise, see what the consequence would be. If Mr. Davies has a lock which he has directed to be made (we may suppose that to be the case) and put on his gate some twenty years ago—sixteen years ago, at least; if that was not a public use which prevented a man from taking out a patent, any man might go and take a model of that lock and get a patent for it. How can he be the inventor of it? Because to obtain a patent a man must be the inventor; and if it has been once in public use, that is, used in a public manner, not used by the public, yet if it has been used by half-a-dozen individuals, or one,* in a public manner, any

* "If a person" (asked *Dallas, J.*, *Hill* v. *Thompson*, W. P. C. 1. 240) "had done precisely all that is specified to be done in this specification, and had not communicated it to any one, could he be prohibited by the 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 *Tindal, C. J.*, in *Cornish* v. *Keene* (W. P. C. 1. 511), observed that "if the defendants had shown that

man having access to it, how can he be said to be the inventor, if by merely gaining access to that he takes out a patent? For recollect that the words of the statute show that the patentee is to be the inventor. And one of the questions you have to try is, whether he is the inventor, as well as whether there is any novelty in the invention. A man cannot be said to be the inventor of that which has been exposed to public view, and which he might have had access to if he had thought fit." The same judge subsequently said, in the same case, "If you are of opinion (not that they were generally adopted by the public and used by the public, for that, in my opinion, is a perfect fallacy) that the use of them is public, and the exercise of the invention was public, and not kept secret so that the public might have no benefit from it, then I think that part of the issue you ought to find for the defendant." The learned judge summed up the evidence as to a public user, in this way:—Twenty-six years ago, Freer, a trader living in Birmingham, who is much connected with the American trade, produced to Tilsley, who is a factor, and also a manufacturer of hardware goods, a model of a lock, and desired him to make six dozen like it, and afterwards a dozen-and-a-half. Tilsley employed Walker to execute the order, and gave him the model. The locks were made, and Freer paid for them. "Here you have an article manufactured by an English manufacturer, and sold; and in my opinion, if it was sold even for the assumed purpose of being sent to America, they practised it (*i. e.* the patented invention), and produced the same result in their factory before the time the patent was obtained, they cannot be prevented by the subsequent patent from going on with that which they have done."

I cannot but think that that would be a destruction of the novelty of the plaintiff's invention. I do not mean to say, that if a man in America employs an agent, to see if he can get an article manufactured in England by a particular model, and chooses to take out a patent for it himself, but not with the view of making it public at all,—I do not mean to say that that man is to be considered as not entitled to the invention afterwards, because he employs a workman to assist him in it, or that if he had failed entirely, that some other man might make the invention in England; but when a model is sent to a workman, who sells seven-and-a-half dozen, and sells them for a certain price, I must say I think the invention was used and publicly exercised. There is no secrecy in the manufacture of them; it is not shut up in the closet of the workman who makes them, but the man who makes them gives directions to another workman; he sells them for his own profit. And I think it would be the hardest thing in the world if the Walkers were now to use that model, and make locks of the same description, if they were to be told to-day, 'You cannot do that without violating Carpenter's patent, although you did it twenty-six years ago, and made a profit by your manufacture of it.'"

These observations of *Lord Abinger* were made at the trial of an action which terminated in favour of the defendant. On the motion for a new trial, on the ground of misdirection, the Judges of the Court of Exchequer expressed themselves satisfied with his lordship's view of the law, and refused a rule, *Alderson, B.*, saying that "public use means a use in public, so as to come to the knowledge of others than the in-

ventor, as contradistinguished from the use of it by himself in his chamber."

At the trial of *Hancock* v. *Somervell* (reported in Newton's London Journal, vol. 39, p. 158), *Mr. Justice Williams* told the jury, that in order to rebut the patentee's claim of novelty, it was not necessary that the alleged invention should have been used by the public; it was sufficient if it were shown to have been in use in public, in contradistinction to secret use.

The point as to public use was again raised in an action for infringing a patent for paving streets with wooden blocks. It was shown at the trial, that some time before the date of the patent, the carriage-way of the porch of Sir W. Worsley's dwelling-house in Yorkshire had been laid with blocks of wood, on a system apparently similar to the plaintiff's. *Cresswell, J.*, told the jury, that if they thought the plaintiff's method of constructing the wooden pavement was the same as that adopted at Sir W. Worsley's, there was an end of the case; for the invention must be deemed to have been made public. It had been publicly used, and made known to all persons who went to the house, so far as ocular inspection could acquaint them with it. Whether it had been used by one or used by five, the learned judge thought made no difference. (*Stead* v. *Williams*, 2 W. P. C. 136.)

In another action for infringing the same patent brought against another defendant, it was proved that the pavement at Sir W. Worsley's was on a different principle from the plaintiff's. *Parke, B.*, told the jury, that if the mode of forming and laying the blocks at Sir W. Worsley's had been precisely similar to the plaintiff's, that would have been a sufficient user to

destroy the plaintiff's patent, though put in practice in a spot to which the public had not free access. (*Stead* v. *Anderson*, 2 W. P. C. 149.)

The question of public user arose in the case of *Heath* v. *Smith* (2 W. P. C. 268). The patent was one out of which much litigation arose. The invention claimed was an improved method of making cast-steel, by fusing carburet of manganese along with common iron or steel. The pleadings in an action for an infringement of this patent having raised the question of the novelty of the invention, it was proved at the trial that five manufacturers of steel had used substantially the process patented by the plaintiff before the date of his patent, not by way of experiment, but in the way of their trade, and to the extent of hundreds of tons. Two of the manufacturers had kept the process a secret. The other three had openly practised it; but it had not become generally known, and the trade was not made acquainted with it until the plaintiff took out his patent. It was held, after argument, by the Court of Queen's Bench, that there had been a public use of the process, and that the patent was therefore invalid. One of the judges pointed out this consequence of an opposite decision, that a man who made a discovery would be obliged to take out a patent for it in order to free himself from liability to action in the event of another man making the same discovery and procuring a patent. The process adopted by the five manufacturers was to place iron, manganese, and carbon in a crucible. The application of heat, according to the scientific witnesses, made first a carburet of manganese, and then made that substance unite with the iron. Now the Court of Exchequer Chamber had

previously held that this process was an infringement of the patent, the specification of which claimed "the use of carburet of manganese in any process for the conversion of iron into cast-steel;" for although the plaintiff only mentioned carburet as a well-known substance which he put into the crucible, his patent was held to cover every mode of operating whereby carburet of manganese, however formed, was made to act upon iron. The result by the two processes was identical. The process used by Smith, the defendant in this action, was similar to that of the five manufacturers. If it was the same as the plaintiff's, he had a good defence; for the process was not new, and the plaintiff's patent was invalid: if it was not the same as the plaintiff's, then there was no infringement.

The point whether prior *secret* user is sufficient to vitiate a patent has never been judicially decided; but we have a dictum of Mr. Justice Erle, uttered in the above case of *Heath* v. *Smith*—"If one party only," said that learned judge, "had used the process, and had brought out the article for profit, and kept the method entirely secret, I am not prepared to say that then the patent would have been valid."

It may here be stated that when previous public user of the invention is relied upon as ground of the invalidity of a patent, it is not necessary to show that such user continued up to the time of the patent being granted. Even if discontinued, the patent will be invalidated. (*House of Lords, The Househill Co.* v. *Neilson*, W. P. C. 1. 709.) Their lordships, however, in delivering judgment in this case, expressly left it an open question, whether, if an invention had been formerly used and abandoned many years before, and the whole

thing had been lost sight of, the patent would or would not stand.

### PRIOR USER BY INVENTOR.

We now come to a series of cases which declare the law with regard to a user of the patented invention before the date of the patent—not by other persons than the patentee, but by the patentee himself. If such a user by the patentee be tantamount to a publication of the invention, then the patent is just as invalid as if the invention had been publicly exercised by others. What, then, is the kind of user which will have this fatal effect upon the patent privilege?

In *Bramah* v. *Hardcastle* (Holroyd, 81), which was an action for infringing a patent for a water-closet, it appeared that the patentee had made two or three of these machines before he obtained his patent; but it was admitted that this fact would not of itself invalidate the patent.

If, however, the article has been manufactured for sale and offered for sale, although not sold, this will be such a user of the invention as will render a subsequently obtained patent bad. (*Oxley* v. *Holden*, 8 C. B. N. S. 666.)

But where delay occurs in the issue of a patent without the patentee's fault, the manufacture of articles before the date of the patent for the purpose of being sold after the date will not render the patent invalid. (*Betts* v. *Menzies*, 4 Jur. N. S. 477.)

In *Wood* v. *Zimmer* (Holt, N. P. 57), it appeared in evidence that a great quantity of verdigris made according to the patented process had been sold by the inventor in the course of four months before the patent

was obtained, and *Gibbs, C. J.*, held that "the public sale of that which is afterwards made the subject of a patent, though sold by the inventor only, makes the patent void."

In *Morgan* v. *Seaward* (W. P. C. 1. 194), an action which arose out of Galloway's patent for improvements in machinery for propelling vessels, which consisted in an improved method of constructing paddle-wheels, it was given in evidence that before the date of the patent, Curtis, an engineer, made for Morgan, the managing director of the Venice and Trieste Company, two pairs of wheels, upon the principle mentioned in the patent, at his own factory. Galloway, the patentee, gave instructions to Curtis under an injunction of secrecy, because he was about to take out a patent. The wheels were completed and put together at Curtis's factory, but not shown or exposed to the view of those who might happen to come there. After remaining a short time, the wheels were taken to pieces, packed up in cases, and shipped in the month of April on board a vessel in the Thames, and sent for the use of the Venice and Trieste Company, which carried on its transactions abroad, but had shareholders in England. Curtis deposed that they were sold to the company, without saying by whom, which may mean that they were sold by Curtis to Morgan for the company, and Morgan paid Curtis for them. Morgan and Galloway employed an attorney, who entered a *caveat* against any other patent on the 2nd of March, and afterwards solicited the patent in question, which was dated the 22nd of July, 1829, granted to Galloway, the inventor, and assigned by him to Morgan. Upon these facts it was contended, in an action against Seaward and others,

for an infringement of the patent, that the invention, at the date of the letters patent, was not new, in the legal sense of that word. *Parke, B.*, delivered the judgment of the Court of Exchequer, before whom the point was argued, in these words:—"The word 'manufacture' in the statute must be construed in one of two ways: it may mean the machine when completed, or the mode of constructing the machine. If it mean the former, undoubtedly there has been no use of the machine, as a machine, in England, either by the patentee himself or any other person; nor, indeed, any use of the machine in a foreign country before the date of the patent. If the term 'manufacture' be construed to mean 'the mode of constructing the machine,' there has been no use or exercise of it in England, in any sense which can be called 'public.' The wheels were constructed under the direction of the inventor, by an engineer and his servants, with an injunction of secrecy, on the express ground that the inventor was about to take out a patent, and that injunction was observed; and this makes the case, so far, the same as if they had been constructed by the inventor's own hands, in his own private workshop, and no third person had seen them whilst in progress. The operation, indeed, was disclosed to the plaintiff Morgan; but there is sufficient evidence that Morgan at that time was connected with the inventor, and designing to take a share in the patent. A disclosure of the nature of the invention to such a person under such circumstances must surely be considered private and confidential. The only remaining circumstance is, that Morgan paid for the machines, with the privity of Galloway, on behalf of the steam company; but there

was no proof that he paid more than the price of the machines, as for ordinary work of that description; and the jury would also be well warranted in finding that he did so with the intention that the machine should be used abroad only by this company, which, as it carried on its transactions in a foreign country, may be considered as a foreign company; and the question is, whether this solitary transaction, without any gain being proved to be derived thereby to the patentee or to the plaintiff, be a use or exercise in England of the mode of construction in any sense which can be deemed a use by others, or a public use, within the meaning of the statute and the patent. We think not. It must be admitted that if the patentee himself had, before his patent, constructed machines for sale, as an article of commerce, for gain to himself, and been in the practice of selling them publicly—that is, to any one of the public who would buy—the invention would not be new at the date of the patent. This was laid down in the case of *Wood* v. *Zimmer*, and appears to be founded on reason; for if the inventor could sell his invention, keeping the secret to himself, and when it was likely to be discovered by another, take out a patent, he might have practically a monopoly for a much longer period than fourteen years. Nor are we prepared to say that if such a sale was of articles that were only fit for a foreign market, or to be used abroad, it would make any difference; not that a single instance of such a sale, as an article of commerce, to any one who chose to buy, might not be deemed the commencement of such a practice, and the public use of the invention, so as to defeat the patent. But we do not think that the patent is defeated on the ground

of the want of novelty, and the previous public use or exercise of it, by a single instance of a transaction such as this, between the parties connected as Galloway and the plaintiff are, which is not like the case of a sale to any individual of the public who might wish to buy; in which it does not appear that the patentee has sold the article, or is to derive any profit from the construction of his machine, nor that Morgan himself is; and in which the pecuniary payment may be referred merely to an ordinary compensation for the labour and skill of the engineer actually employed in constructing the machine; and the transaction might, upon the evidence, be no more in effect than that Galloway's own servants had made the wheels; that Morgan had paid them for the labour, and afterwards sent the wheels to be used by his own copartners abroad. To hold this to be what is usually called a publication of the invention in England, would be to defeat a patent by much slighter circumstances than have yet been permitted to have that effect."

Adamson invented certain machinery whilst engaged in the execution of a contract for the erection of a pier. This machinery he used on the works for some months before he applied for a patent, and during this time the public had access to it. It was held that there had been public user, and that he was not entitled to a patent. (*Re Adamson's patent*, 6 De Gex, Mac. & Gord. 420; *S. C.* 25 L. J. Ch. 456.)

From these cases it is evident that an inventor intending to patent his invention should be extremely cautious how he deals with his invention previous to his obtaining the patent. An inventor may, it seems, safely deposit his invention in a public room, with a

view to having its qualities tested. (*Bentley* v. *Fleming*, 1 C. & K. 587.)

It was decided by the House of Lords, in the case of *Brown* v. *Annandale* (W. P. C. 1. 433), affirming the decision of *Roebuck* v. *Stirling* (W. P. C. 1. 45), that the public use of an invention in England, prior to the date of letters patent in Scotland, renders such letters patent void, although the invention was new as regards Scotland. If this decision were followed out to its logical consequences, the public use of an invention in any one of our colonies, however remote or obscure, would invalidate a patent subsequently granted to an original inventor in England in respect of a similar invention. Previous to the Patent Law Amendment Act, 1852 (15 & 16 Vict. c. 83), separate letters patent were required for each of the three kingdoms of England, Scotland, and Ireland, when it was intended to secure invention throughout the United Kingdom. By the usual practice, such letters patent were seldom, if ever, dated the same day, whilst the law declared that the specifications, constituting the publication of the invention, should relate back to the date of the letters patent. Hence it was sometimes doubted whether two of the letters patent were not invalidated by reason of their being dated after the first. But now, by the 18th section of that statute, it is enacted that all letters patent passed in conformity with the provisions of that Act shall extend to the whole of the United Kingdom of Great Britain and Ireland, the Channel Islands, and the Isle of Man, and, if the royal warrant directs, to the Colonies.

Where an English patent was dated in 1849 and Scotch and Irish patents for the same invention in 1853,

an objection that the Scotch and Irish patents were rendered void by the user in England, was held insufficient (having regard to the enactment above mentioned) to induce the Judicial Committee of the Privy Council to abstain from granting a prolongation of the three patents. (*Bovill's patent*, 1 Moo. P. C. C. N. S. 349.)

### EXPERIMENTS.

But it is well-settled law, that when the disclosure of the secret took place only during the course of trying experiments, with a view to improve and test the invention, this will not vitiate the inventor's right to a patent. Nor will the previous experiments of other persons have that effect, if such experiments did not result in the realization of the discovery. Few patents, indeed, could be sustained if previous experiments, approaching the patented invention, were held to vitiate them. In almost every case experiments of some kind or other have been made in the same track, and many beneficial inventions have been but a step beyond what has before been reached by experiments which seemed fruitless, and were abandoned.

In *Galloway* v. *Bleaden* (W. P. C. 1. 525), *Tindal, C. J.*, said, "A mere experiment, or a mere course of experiments, for the purpose of producing a result which is not brought to its completion, but begins and ends in uncertain experiments, that is not such an invention as should prevent another person, who is more successful, or pursues with greater industry the chain in the line that has been laid out for him by the preceding inventor, from availing himself of it and having the benefit of it." His lordship, with reference to the case before him, afterwards remarked, "that

there had been many experiments made upon the same line, and almost tending, if not entirely, to the same result, is clear from the testimony you have heard; and that these were experiments known to various persons. But if they rested on experiment only, and had not attained the object for which the patent was taken out, mere experiment, afterwards supposed by the parties to be fruitless, and abandoned because they had not brought it to a complete result, that will not prevent a more successful competitor who may avail himself, so far as his predecessors have gone, of their discoveries, and add the last link of improvement in bringing it to perfection." See also the observations of the same learned judge in *Cornish* v. *Keene* (W. P. C. 1. 508).

In *Jones* v. *Pearce* (W. P. C. 1. 124), an action brought for an infringement of a patent for an improved construction of carriage-wheels, it was contended, on behalf of the defendants, that the invention was not new, wheels similar in principle to those for which a patent had been obtained having been invented by a Mr. Strutt several years previously, made under his orders, and used in a cart employed to convey heavy loads of stones on the public roads for upwards of a year. These wheels were afterwards laid by, the spokes having occasionally got bent. *Pattcson, J.*, told the jury, that if Strutt's wheel was, in substance, the same wheel as the patentee's, and if it had been "used openly in public, so that everybody might see it, and had continued to use the same thing up to the time of taking out the patent,* undoubtedly, then, that would

* This part of the learned judge's charge cannot be considered law since the decision of the House of Lords in *The Househill Co.* v. *Neilson.* (*ante* p. 53.)

be a ground to say that the plaintiff's invention is not new. But if, on the other hand, you are of opinion that Mr. Strutt's was an experiment, and that he found it did not answer, and ceased to use it altogether, and abandoned it as useless, and nobody else followed it up, and that the plaintiff's invention, which came afterwards, was his own invention, and remedied the defects of Mr. Strutt's wheel, then there is no reason for saying that the plaintiff's patent is not good."

The question whether the evidence amounts to proof of public use, or whether it only proves that abandoned experiments had been made, is frequently of considerable delicacy; since, as it has been remarked from the Bench, a slight alteration in the effect of the evidence will establish either the one proposition or the other, and the only proper mode of deciding it is by leaving it to the jury. (*Cornish* v. *Keene*, W. P. C. 1. 519.)

On the trial of an action for infringing a patent for improvements in cards for carding fibrous substances, which improvements consisted in using caoutchouc as a substitute for leather as an elastic bed in which the teeth were fixed, it was given in evidence, in support of a plea denying the novelty of the invention, that a certain material, called Hancock's patent leather, had been made and sold previous to the patent; and it was suggested, rather than proved, that this material was substantially the same thing as the elastic bed in which the carding teeth were fixed. It appeared that the patent leather had been supplied to certain manufacturing firms, during the space of about a year and a half, several years before the date of the patent, and that it had been used in the construction of cards, but had not been employed for that purpose since that

time. "Supposing," said *Cresswell, J.*, to the jury, "that the article (Hancock's patent leather) did embody the principle of the plaintiff, so as to present to persons using it the properties, qualities, and advantages in principle of that article which the plaintiff makes, the question for you will be, whether that user is not to be considered rather in the nature of an experiment than of any public use of the article, so as to deprive the plaintiff of the fruit of his discovery in respect of this manufacture" (*Walton* v. *Bateman*, W. P. C. 1. 619).

At the trial of *Stead* v. *Williams* (2 W. P. C. 135), *Cresswell, J.*, said to the jury, "I take it that there is a great difference between the knowledge of an invention as a thing that would answer and was in use, and the knowledge of it as a mere experiment that had been found to be a failure, and thrown aside. If a person has had a scheme in his head and has carried it out, but after a trial has thrown it aside, and the thing is forgotten and gone by, then another person re-introducing it may, within the meaning of the Act, be the inventor and the first user of it, so as to justify a patent."

Where an experiment performed in the presence of others is not only successful, but is actually of benefit to the inventor, it will not necessarily be held that he has given the invention to the world. But if on subsequent occasions he uses his invention and needlessly delays his application for a patent, then it will be supposed that he has dedicated it to the public. (*Re Newall* and *Elliot*, 4 C. B. N. S. 269; *S. C.* 4 Jur. N. S. 562.)

In *Hills* v. *London Gas Light Co.* (5 Hurlst. and Norm. 312), it appeared that one Croll had purified many thousand feet of gas by a mode for which Hills

subsequently obtained a patent, and this gas was sold. The jury, on the trial of an action brought by Hills for the infringement of his patent, found that this was by way of experiment, and the Court refused to disturb the verdict. In delivering judgment on the defendants' rule for a new trial, the Court said, "the word 'experiment,' in the cases referred to, has been used, not as the sole test upon a matter of this sort, but as indicating a class of practice, and for the purpose of showing that if there has been a user of an invention not of a substantial character, but in the character of an experiment, then, although the thing has been done before, it does not preclude a person from taking out a patent for it; so that although what Croll did may not have been strictly in the nature of an experiment, still the jury have so found it, and we cannot grant a new trial."

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We will now adduce some instances of patents which were adjudged bad on the ground of want of novelty in the invention generally.

Brunton took out a patent for (amongst other things) an alleged improvement in anchors. The two flukes were made in one, and had such a thickness of metal in the middle, that they might there be pierced with a hole for the insertion of the shank. Previously, the two flukes had been joined by welding them to the shank. It came out on a trial in Court, that the real improvement was in the avoidance of welding, and that this was done by means perfectly well-known in other cases. There *was no proof that the anchors made by the new process were better than those previously made*, and since the invention seemed to be nothing more than the

adoption of a known operation practised in analogous cases, it was held not patentable. (*Brunton* v. *Hawkes*, 4 B. & Ald. 540.) "Now" (said *Abbott, C. J.*, in his judgment) "a patent for a machine, each part of which was in use before, but in which the combination of different parts is new and a new result is produced, is good, because there is novelty in the combination. But here the case is perfectly different: formerly three pieces were united together; the plaintiff (Brunton) only unites two; and if the union of these two had been effected in a mode unknown before, as applied in any degree to similar purposes, I should have thought it a good ground for a patent; but unfortunately the mode was well known and long practised. I think that a man cannot be entitled to a patent for uniting two things instead of three, where that union is effected in a mode well known and long practised for a similar purpose." (*Brunton* v. *Hawkes*, 1 Carp. Rep. 410.)

In the case of *Kay* v. *Marshall* (2 W. P. C. 34–84), it appeared that Kay had procured a patent for new and improved machinery for preparing and spinning flax, and the invention was declared in the specification to consist of new machinery for macerating flax previous to drawing and spinning it, which is called preparing it; and also for improved machinery for spinning the same after having been so prepared. If the patent had been confined to the new machinery for macerating, it was allowed that it would have been perfectly good; but, as to the second part of the invention, it appeared that the improved machinery was nothing more than the placing of certain portions of a machine well known and in common use within two

inches and a half of each other, instead of at a greater distance. It was shown that the distances between the parts in question had not been fixed in previous machines, but had been varied according to circumstances; and, further, that the reach used in *cotton* spinning had actually been less than two inches and a half. It was held by the Court of Common Pleas, that the adoption of a particular distance, viz. two inches and a half, under these circumstances, did not constitute such an invention as would support a patent. "Suppose," said *Tindal, C. J.*, on delivering judgment —"suppose a patent to have been first obtained for some entirely new method, either chemical or mechanical, of reducing the fibres of flax to a short staple, we think that a second patent could not be taken out for an improved mode of machinery in spinning flax which consisted of nothing more than the spinning of short staple of flax by a spinning machine of a reach of a given length, not less than that already in use for the spinning of cotton, the effect of which would be to prevent the first patentee from working his invention with the old machine at the proper reach." Or, as *Lord Cottenham* put it in the House of Lords, if the plaintiff (Kay) has a right to tell the rest of the world that they shall not use the common spinning machine with rollers at two and a half inches' distance, then the existence of the patent deprives all the rest of the world of the right of using the ordinary spinning machine in the form in which they had a right to use it before the patent was granted.

In the process of calendering woven fabrics the use of a roller and a bowl, and the means of regulating the relative speed of their motions, were well known.

In the process of *calendering*, the roller was smooth, and the speed of the roller and bowl was unequal. In *embossing*, the roller had a pattern upon it, and the relative speed of the roller and bowl was equal. A patent was taken out for a combination of a patterned roller with a roller and bowl moving at unequal speeds. The invention was held not to be a 'new manufacture' which could be the subject of a valid patent. (*Ralston* v. *Smith*, 9 C. B. N. S. 117; affirmed by the *House of Lords*, 13 L. T. N. S. 1.)

The casting of tubular boilers in one piece, similar boilers having been previously made in several pieces which were afterwards fastened together by means of cement, was held not to be an invention for which a valid patent could be obtained, although the result was useful and beneficial to the public. It was only the application of a well-known article by a well-known process to the production of a well-known article, to which that article and process had not before been applied. (*Ormson* v. *Clark*, 13 C. B. N. S. 337; *S. C.* in error, 14 C. B. N. S. 475; 10 Jur. N. S. 128.)

Again, the application of double-angle iron (a well-known article of commerce already applied to a variety of purposes) to the construction of hydraulic joints of telescopic gas-holders, instead of making them of two pieces of *single*-angle iron attached to a plate, was held not to be patentable. It was not a claim for a new article or for an improved article, but only for a cheaper way of using known materials. (*Horton* v. *Mabon*, 12 C. B. N. S. 437; *S. C.* in error, 16 C. B. N. S. 141.)

From what was said in *Mackelcan* v. *Rennie* (13 C. B. N. S. 61), it would appear that the court considered that the application in the construction of a known ap-

paratus of a material not before used for that purpose, for example, iron instead of timber in the construction of floating docks, was not an invention for which a valid patent would be obtained. (See also *Thompson* v. *James*, 32 Beav. 570.)

In the case of *Losh* v. *Hague* (W. P. C. 1. 202), the question was reduced to this—Is a man who finds a particular construction of wheel already in use on ordinary roads entitled to a patent for applying it to a railway, such application not having been previously made? *Lord Abinger* remarked, in deciding that he was not entitled to a patent for such an application, that you cannot have a patent for applying a well-known thing, capable of being applied to fifty thousand different purposes, to an operation which is exactly analogous to what was done before. His lordship put this case—"Suppose a man invents a pair of scissors to cut cloth with; if the scissors were never invented before, he could take out a patent for it. If another man found he could cut silk with them, why should he take out a patent for that?" Again—"It would be a very extraordinary thing to say, that after all mankind have been accustomed to eat soup with a spoon, that a man could take out a patent because he says you might eat peas with a spoon."

In an action brought by the assignee of a patent for improvements in separating the fibres of cocoa-nut husks, for an alleged infringement, it was shown that the principal part of the invention consisted in passing the split husks between crushing rollers, and that, for some time previous to the date of the patent, similar rollers had been employed in treating hemp. *Lord Campbell*, who presided at the trial, told the jury that

the use of the crushing rollers having been thus anticipated, no claim for their application to the crushing of cocoa-nut husks would hold good. (*Hyde* v. *Trent*, Newton's Lond. Jour. vol. 45, p. 135.)

So, in the case of the *Queen* v. *Cutler* (Macrory's Pat. Ca. 124–138), it was held by two judges on different occasions, that the mere application of a known article to a new use, the mode of application not being new, but having been previously used in applying analogous articles to the same purpose, cannot be made the subject of a patent. In this case the patent was for improvements in the construction of the tubular flues of steam boilers. The specification claimed the application of iron tubes coated with copper or brass to this purpose. This kind of tube was not new; nor was there any novelty in the way the patentee applied the tubes in the formation of flues, uncovered tubes having been previously used in a similar way.

In *The Bottle Envelope Co.* v. *Seymour* (5 C. B. N. S. 164; *S. C.* 5 Jur. N. S. 174), it was held that the use of a model or mandril in the form of a bottle in making envelopes for bottles out of rushes or straw, could not be the subject of a patent, this being merely the application of a well-known tool to work previously untried materials or to produce new forms. And in *Tetley* v. *Easton* (2 C. B. N. S. 706) it was decided that the discovery that a particular advantage may be obtained by the use of a known machine used in a known manner cannot be made the subject of a patent.

On the trial at *Nisi Prius* of *Bush* v. *Fox* (Macrory's Pat. Ca. 163), it appeared that the invention, for an infringement of which the action was brought, consisted in the new application of a machine previously known

and applied to another purpose. "I think that an invention" (said *Pollock, C. B.*, to the jury) "must be a production of something that can be used or sold, or made use of for some purpose, or some method which results in something of the same sort. And I think that a man cannot, if he has applied—supposing this to be a *new* application—an old invention, or part of an old invention, to a new purpose, obtain a patent for such an invention. Both the plaintiff and the other witness say that the invention consists in the application, and not in the novelty of the thing itself—in other words, that the only novelty is in the application of the apparatus. I think that a patent cannot be taken out for such an application. If a man were to take out a patent for a telescope to be used to make observations on land, I do not think any one could say, 'I will take out another patent for that telescope to be used for making observations on the sea.'" When the legal points raised at the trial were argued in the Exchequer Chamber, *Maule, J.*, said, "Assuming that the machine itself is old, the learned judge held that a mere new application is not a new manufacture, and therefore not the subject of a patent; and my present opinion is, that, on the evidence, he was right in so directing the jury" (Macrory's Pat. Ca. 175). The case having been taken to the House of Lords (Macr. P. C. 179), it was there held that the judge who tried the case had rightly decided that the invention was not a patentable one. The Lord Chancellor (*Lord Cranworth*) added, that the judge who tried the case might, simply by comparison, and on his own construction of the specifications, without other evidence, have directed a verdict for the defendant.

In *Brook* v. *Aston* (8 E. and B. 478), the plaintiffs had obtained a verdict at *Nisi Prius* in an action for an infringement of their patent granted in February, 1856, for improvements in finishing yarns of wool and hair, and in the finishing of woollen fabrics and piece goods; but the defendant obtained leave to move to enter the verdict in his favour if the court should be of opinion that the patent was invalid. It appeared that the plaintiff had obtained a patent in November, 1853, for a process precisely similar except that it was applicable to the finishing of cotton and linen yarns. After argument, the court held that this being only the application of an old machine to a new purpose, there had been no improvement or discovery for which a patent could be obtained. The alleged invention under the second patent was destitute of novelty, being merely the application to woollen and hair yarn of the machine previously patented and then applied to cotton and linen yarn. This decision was affirmed by the Court of Exchequer Chamber (5 Jur. N. S. 1025).

The case of *Harwood* v. *The Great Northern Railway Company* (2 B. & S. 194; affirmed by the *House of Lords*, 12 L. T. N. S. 771), may also be consulted with reference to the same point. In this case a patent for the application of "fishes" to iron rails for railways, for the purpose of securing them, was held invalid, because a similar contrivance had been applied to fasten pieces of timber together in the construction of bridges, and had also been used in various articles of machinery.

So, in *Calvert* v. *Ashburn* (Prac. Mech. Jour., vol. 7, 2nd ser., 97), it was held that the application of

caustic alkalies for the purpose of dissolving the gluten contained in flour employed in the manufacture of *size* could not be the subject of a patent, inasmuch as caustic alkalies had been previously used for the purpose of dissolving gluten in the manufacture of *starch*.

It would seem, however, from the case of *Young* v. *Fernie* (5 Giff. 597, 612), that the doctrine above laid down is not necessarily applicable to all patents for chemical inventions. In that case, which was a suit for an injunction to restrain the infringement of a patent for obtaining paraffin oil by the distillation of bituminous *coals*, it was proved that previously to the plaintiff's invention paraffin oil had been extracted from bituminous *shale* by distillation, and it was argued for the defendants, on the authority of *The Queen* v. *Cutler*, *Brook* v. *Aston* and such cases, that bituminous shale being a substance analogous to bituminous coal, the invention of the plaintiff was not in law the subject of a patent. But *Stuart, V. C.*, said that there seemed to be no analogy between the cases cited and the present one, because, if the doctrine laid down there were to be adopted implicitly as to chemical subjects, it would be impossible to foretell results. And in giving judgment in favour of the validity of the patent, his Honour observed, "The principle on which the present case should be decided is, to my mind, so clear that it is unnecessary to examine the cases cited by the defendant's counsel. Inventions in mechanics are as widely different from inventions in economical chemistry as the laws and operations of mechanical forces differ from the laws of chemical affinities, and the results of analysis and experiment in the comparatively infant science of chemistry with its bound-

less field of undiscovered laws and undiscovered substances. This observation as applied to reported cases will strike the mind of every lawyer who has even a slight elementary knowledge of both sciences."

In an action for an infringement of plaintiff's patent for a method of paving streets with blocks in the form of two solid rhombs placed one in front of the other in opposite directions, so that each side of a block was bevelled both inwards and outwards, it was proved that the defendant used blocks, each consisting of a single solid rhomb, and then fastened two together by pins, so that two of the defendant's blocks thus fastened exactly resembled one of the plaintiff's blocks. This was the infringement complained of. The defendant, at the trial, put in the specification of an expired patent, obtained by one M'Arthy, for a pavement in which each block had two bevels inwards and two outwards on the same side. If M'Arthy's block were cut into two, it would make two blocks similar to the plaintiff's; if cut into four, it would make four blocks similar to the defendant's. Both judge and jury thought that, under these circumstances, the plaintiff's invention was destitute of novelty. The plaintiff asserted that the defendant had infringed his patent by cutting his block into two. Granting this to be an infringement, the defendant showed that the plaintiff, in forming his block, had only cut M'Arthy's block into two. The plaintiff, in support of his own patent, was bound to contend that M'Arthy's invention and his own were distinct; but then it followed that his own and the defendant's were likewise distinct, in which case there was no infringement (*Macnamara* v. *Hulse*, 2 W. P. C. 128).

### TRUE AND FIRST INVENTOR.

Having so far examined the decisions which bear upon the question of the *novelty* of the *invention*, we may now turn to those which have reference to the *patentee*, who must, as we have seen, be the *true and first inventor*, or he will not be entitled to hold his patent. A discovery may be both useful and quite new to the world at large; yet if the person who has attempted to secure the benefit of it by patent should not be the inventor, and the first and true inventor, his patent is not saved from the clause in the statute of James, which declares that all monopolies are invalid. Let us therefore inquire what construction the courts have put upon the words, "first and true inventor."

One of the earliest cases on this subject is that of Dollond, the optician, who brought an action for an infringement of his patent for a new method of making the object-glasses of refracting telescopes. It was alleged, on the part of the defendant, that Dollond was not the true and first inventor of the method, inasmuch as Dr. Hall had made the discovery before him. But it was holden that as Dr. Hall had confined it to his closet, and had not communicated it to the public, Dollond was to be considered the first and true inventor as required by the statute. This decision has been frequently mentioned in subsequent cases, and always with approval.

The case was not reported, and our knowledge of it is derived from the mention made of it in the subsequent case of *Boulton* v. *Bull* (2 H. Bl. 469). Dollond's case was decided in 1766, and it was followed by nu-

merous cases, the result of which may be thus stated: —If two persons make the same invention about the same time independently of each other, he who first obtains a patent has an exclusive right to the invention; and he will be held the first inventor, although, in point of fact, the date of his invention was subsequent to that of the other person. This rule, however, will not hold where there was such a use of the invention previous to the patent as amounted to what is technically called "public use."

"A man may publish to the world," said *Tindal, C. J.*, in *Gibson* v. *Brand* (W. P.C. 1. 628), "that which is perfectly new in all its uses, and has not before been enjoyed, and yet he may not be first and true inventor; he may have borrowed it from some other person; he may have taken it from a book; he may have learnt it from a specification; and then the legislature never intended that a person who had taken all his knowledge from another, from the labours and assiduity or ingenuity of another, should be the man who was to receive the benefit of another's skill."

There are many substances which have been produced by chemists in their laboratories in small quantities, which, if they could be produced in large quantities so as to be merchantable commodities, would be highly valuable. An inventor who succeeds in doing this will not be considered to have been forestalled because the substance has been already produced on a small scale as a chemical curiosity. He will be held to have been the first and true inventor, and his patent will be supported because he has introduced a new manufacture. "What the law looks to," said *Stuart, V. C.*, in the great case of *Young* v. *Fernie* (5 Giff. 611;

*S. C.* Pract. Mech. Journal, vol. 9, 2d ser., p. 102), "is the inventor and discoverer who finds out and introduces a manufacture which supplies the market for useful and economical purposes with an article which was previously little more than the ornament of a museum. The plaintiff is an inventor of this class, and his patent is entitled to the protection of the law. I find that he has ascertained by a course of laborious experiment a particular class of materials among many, and a particular process among many, which has enabled him to create and introduce to the public a useful manufacture, which amply supplies the market with that which, until the use of the materials and processes and temperature indicated by him, had never been supplied for commercial purposes. At the date of his patent something remained to be ascertained which was necessary for the useful application of the chemical discovery of paraffin and paraffin oil. This brings it within the principle stated by *Westbury, L. C.*, in the case of *Hills* v. *Evans*.* The manufacture with the materials and process indicated by him according to the sense in which I understand the word 'manufacture' to be used in the statute, was a new manufacture not in use at the date of his patent."

It may happen that a given invention results from the combined operation of two minds, in which case it is necessary that the letters patent should be taken out in their joint names. Patents have sometimes been disputed on the ground that the patentee owed a material part of the invention to another person; and if this can be made out on satisfactory evidence, it is fatal. It must, however, be taken to be undoubted

* Reported 8 Jur. N. S. 525.

law, that the suggestions of workmen employed by the inventor to carry out his ideas will have no such effect. An inventor is entitled to something more than the mere manual labour of the persons he employs. If the substantial part and leading idea, the principle of an invention, belong to one person, he may properly call in the assistance of another to work it out and perfect it; and after enjoying the benefit of that assistance, he may legally procure a patent for the invention. The observations of *Alderson, J.*, to the jury on trying *Minter* v. *Wells* (W. P. C. 1, 132), will throw light upon this point. "Minter [the patentee] and Sutton [a workman employed by Minter] were together about the time the invention took place: which of the two suggested the invention, and which carried it into effect, is a question for you to decide. If Sutton suggested the principle to Minter, then he would be the inventor. If, on the other hand, Minter suggested the principle to Sutton, and Sutton was assisting him, then Minter would be the first and true inventor, and Sutton would be a machine, so to speak, *which Minter uses for the purpose of enabling him to* carry his original conception into effect. You will judge which is the more probable of the two. Minter makes out his *primâ facie* case; he is the person who takes out the patent. If Sutton has received a compensation, nothing would have been more simple and easy that he should have taken out the patent, and still Mr. Minter might have had the same benefit to-day; and there is no apparent reason why Sutton should not have taken out the patent which Minter has taken out, unless they were both desirous to ruin the invention; for, suppose two persons are engaged on an in-

vention of this description, they know perfectly well between themselves who is the real inventor of it, and who is the workman to carry into effect the conception; but they would destroy the value of it to both, if they did not take it out in the name of the right person."

In *Bloxam* v. *Elsee* (Carp. Rep. 1. 434), an action brought for an infringement of a patent for making paper in sheets very much larger than had previously been made, it was objected that many of the improvements set out in the specification were invented, not by the patentees, but by Mr. Donkin, and without them the invention was useless. Mr. Donkin was called, and proved that he was employed by the patentees to bring the machine to perfection, was paid by them for so doing, and was acting as their servant. It was contended, in reply, that these were the patentees' inventions, and that Mr. Donkin was employed by them to carry their ideas into effect in the best manner. This view of the case seems to have been that of the Judge presiding at the trial, and that of the Judges before whom the motion for a nonsuit was argued; for although the patent was declared invalid, it was on other grounds, nothing being said on this point.

In arguing the case of *Jupe* v. *Pratt* (W. P. C. 1. 144) it was asked by the patentee's counsel—"Is it to be said that if a man has discovered a principle, and goes to a mechanic, and says, 'I think you might do it thus and thus,' is it to be said that that person, who had merely supplied, you might say, the tools or the materials, has a right to claim such invention? Suppose a man not skilled in mechanics were to per-

ceive some obvious inconvenience in any of the common articles of life—a carriage, a vessel, a ship used for particular purposes; and he were to go to a mechanical man, and say, 'I have for some time had an idea of something that would be an improvement, if such a matter could be achieved. I do not understand mechanics, but the invention is mine.' Will any man tell me that a man so applied to, and assisting the party in one mode of the hundreds, could be considered as preventing the inventor from taking out a patent with his perfect concurrence?"

"It would be difficult," said *Tindal, C. J.*, in *Allen* v. *Rawson* (1 C. B. 551), "to define how far the suggestions of a workman employed in the construction of a machine are to be considered as distinct inventions by him, so as to avoid a patent incorporating them taken out by his employer. Each case must depend upon its own merits. But when we see that the principle and object of an invention are complete without it, I think it is too much that a suggestion of a workman employed in the course of the experiments, of something calculated more easily to carry into effect the conceptions of the inventor, the use of such a suggestion will not render the patent void." And some observations of *Cresswell, J.*, in the same case, are relevant to this subject. "The improvement claimed by Shaw was something clearly and palpably subordinate to the invention of the patentee. The object was to obtain a bat of an even and sufficient thickness, and of sufficient length, to be felted into cloth fit for commercial purposes. The patentee had obtained a bat sufficiently even and of sufficient substance, and he ascertained that by ex-

tending the compound apron he could obtain the required length. The suggestion of Shaw was of a mere mode of using the extended apron in a more compact and convenient form."

This is a very different case, however, from that where the patentee has no closer connection with the invention than that of being the employer of the inventor. Thus, in Arkwright's case, it appeared that Arkwright, the patentee, had been told of a particular roller, part of the machinery by Kay, and that, perceiving the value of the invention, he took Kay into his service for two years, during which time he employed him to make models, and subsequently claimed the invention as his own, making it the foundation of a patent. Arkwright adopted in the same way a crank invented by Hargrave. In the face of this evidence, Arkwright's claim to be the first and true inventor fell to the ground. (*The King* v. *Arkwright*, Dav. P. C. 61; W. P. C. 1. 64.) The case of *Barker* v. *Shaw* (W. P. C. 1. 126) touches the same point. In an action for the infringement of a patent for an improvement in making hats, a witness proved that he had made the improvement whilst employed in the patentee's workshop, whereupon the plaintiff was nonsuited.

In these cases, it was clear that the patentee was not the first and true inventor, since the source of the invention could be traced elsewhere. Whenever this can be done (except in the case of an invention imported from abroad, and acknowledged to be such), the patentee's right to his patent fails. It is so, as we have seen, although the real inventor should be in the service of the patentee; and, *à fortiori*, will it be

so, where there is still less connection between them. In Tennant's case, it was proved that, before the grant of the patent, conversations had taken place between Tennant (the patentee) and a chemist, who had suggested to Tennant the basis of the patented improvement. This piece of evidence, in addition to slight evidence of user, induced the Court to nonsuit the plaintiff. (Dav. P. C. 429.)

### PUBLICATION IN PRINTED BOOKS.

It has been repeatedly held that an inventor's claim to novelty is destroyed by showing the previous publication of the invention in some printed book in use in Great Britain, or in the specification of a previous patent. *Mr. Justice Buller*, in *King* v. *Arkwright* (W. P. C. 1. 72), said :—"It is admitted that this is not a new discovery; for Emmerson's book was produced, which was printed a third time in the year 1773, and that is precisely the same as this." If, prior to his obtaining a patent, any part of that which is of the substance of the invention has been communicated to the public in the shape of a specification of any other patent, he cannot claim the benefit of his patent. (*Lord Ellenborough*, in *Huddart* v. *Grimshaw*, W. P. C. 1. 86.) "Although" (said *Tindal, C. J.*, in *Cornish* v. *Keene*, W. P. C. 1. 507) "it is proved that the invention is a new discovery, so far as the world is concerned, yet if anybody has been able to show, that although that was new—that the party who got the patent was not the man whose ingenuity first discovered it, that he had borrowed it from A. or B., or taken it from a book printed in England, and which was open to all the world—then it would become an

important question whether he was the first and original inventor of it." In *Jones* v. *Berger* (W. P. C. 1. 550), it had been alleged that the principle of the invention was not new, having been the subject of former patents, and contained in published books; whereupon *Maule, J.*, remarked, "I think it is an objection to a patent, and not evidence simply of an objection, that there has been a previous patent and specification enrolled containing the invention. In the same way, I think it is an objection to a patent that it has been published in such a book." In the course of the argument of the case of *The Househill Company* v. *Neilson* (W. P. C. 1. 673), an appeal from the Court of Session in Scotland to the House of Lords, *Lyndhurst, L. C.*, asked, "If the machine is published in a book, distinctly and closely described, corresponding with the description in the specification of the patent, though it has never been actually worked, is not that an answer to the patent? It is continually the practice, on trials for patents, to read out of printed books, without reference to anything that has been done." And *Lord Brougham* added, "It negatives being the true and first inventor. It must not be a foreign book, but published in England." (W. P. C. 1. 718.)

The law, however, has been since interpreted somewhat differently from what is laid down in this last sentence. If the foreign book, containing a description of an invention, has been circulated in England (*Reg.* v. *Steiner*, Newton's Lond. Jour. vol. 40, p. 71), or even if the foreign book is sent over to a bookseller in this country, and is by him simply offered for sale (*Lang* v. *Gisborne*, 31 Beav. 133), a patent subsequently obtained by an independent inventor is invalid.

It seems from *Hcurteloup's Patent* (W. P. C. 1. 553), to have been thought that the deposit of a foreign work in the British Museum, which work contained the specification of a French patent for an invention, in great part the same as that for which a patent had subsequently been obtained in England, was sufficient to vitiate the latter patent on the ground of want of novelty.

It may be inferred from some of the preceding cases, that when the validity of a patent is contested on the ground of the invention having been previously in public use, or communicated to the world by a book, it is not necessary to show that the patentee derived his knowledge of the invention from such user, or book. And it was expressly decided, in *Stead v. Williams* (2 W. P. C. 142), that if the invention has been already made public by any 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 himself borrowed his invention from such publication or not; because the public cannot be precluded from the right of using such information as they were already possessed of at the time the patent was granted. The application of this principle must depend upon the particular circumstances which are brought to bear upon each particular case. The existence of a single copy of the work, though printed, if brought from a depository where it has long been kept in a state of obscurity, would afford a very different inference from the production of an encyclopædia or other work in general circulation. The question will be, whether, upon the whole evidence, there has

been such a publication as to make the description a part of the public stock of information.

### PUBLICATION IN THE SPECIFICATION UNDER A PRIOR PATENT.

The law as regards the publication of the invention in the specification under a prior patent, is precisely the same as that with reference to a publication in a printed book. The invention has been deprived of its requisite attribute of novelty if it has been described in a previous specification, whether the patent has or has not expired. But if the prior inventor has not shown how the invention is to be practically carried out, and an independent inventor does this and fully explains the mode in which the result is obtainable, his patent will be held good. It will be considered that he has been the first to carry the invention to a useful result, although his patent was granted after another one by which a similar object was sought to be effected. (*Betts* v. *Menzies*, 10 H. L. C. 117, *S. C.* 9 Jur. N. S. 29. See also *Betts* v. *De Vitre*, 11 L. T. N. S. 445.)

The antecedent exposition of an invention which will have the effect of depriving a subsequently patented invention of the attribute of novelty, must (according to *Westbury, L. C.*, in *Hills* v. *Evans*, 8 Jur. N. S. p. 529) "be such that a person of ordinary knowledge of the subject would at once perceive, understand, and be able practically to apply the discovery, without making experiments for the purpose of gaining further information, before the invention can be made useful. If anything remains to be ascertained which is necessary for the useful application of the discovery, that affords sufficient room for another valid patent. . . . The information as to the alleged in-

vention given by the prior publication must, for the purposes of practical utility, be equal to that given by the subsequent patent. The invention must be shown to have been before made known. Whatever therefore is essential to the invention must be read out of the prior publication. If specific details are necessary for the practical working and real utility of the alleged invention, they must be found substantially in the prior publication. Apparent generality, or a proposition not true to its full extent, will not prejudice a subsequent statement which is limited, accurate, and a specific rule of practical application." And in the above-cited case of *Betts* v. *Menzies* the same learned judge said (10 H. L. C. 152), "Even if there is identity of language in two specifications, and (remembering that those specifications describe external objects) even if the language is *verbatim* the same, yet if there are terms of art found in the one specification, and also terms of art found in the other specification, it is impossible to predicate of the two with certainty, that they describe the same identical external object, unless you ascertain that the terms of art used in the one have precisely the same signification, and denote the same external objects at the date of the one specification as they do at the date of the other."

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The hardship of depriving a *bonâ fide* inventor of the benefit of his patent, by merely showing that some other individual had invented or used the invention before the date of the patent, seemed so great that the Legislature interposed, by the 2nd sect. of the 5th and 6th Will. IV. c. 83, of which we shall speak more fully in the chapter on the Confirmation of Letters Patent.

# CHAPTER IV.

## WHO MAY BE A PATENTEE.

THE reader has already been made acquainted with the fact, that the law requires the grantee of letters patent to be the true and first inventor of the thing in respect of which they were obtained; and we have discussed, in preceding pages, the question—Who is to be considered a true and first inventor? The strict letter of the statute has been so far relaxed as to allow persons simply importing an invention from a foreign country into this realm to obtain a patent in respect of it, provided that such an invention is new and useful, which words are to be interpreted in precisely the same way, whether it is imported, or whether it is discovered within the limits of the British empire. In other words, the administrators of the law always read the word "inventor," in the statute, as embracing an importer.

In *Carpenter* v. *Smith* (W. P. C. 1. 535), *Lord Abinger* said, "A man has a right to a patent, not only for his own original invention, but he has a right to a patent, if he is the first person who brings into England an invention which is used abroad and not known in England; if, therefore, any person was to import from America a machine, and have that machine used in England, and was to buy considerable quantities of them, no other person could take out a patent for that, because it is a machine used abroad, and a man

might have a patent taken out for it, if he is the original inventor of it."

Whilst a patent taken out by a British subject for an invention communicated by a foreigner residing abroad is perfectly unobjectionable, there seems reason to doubt whether a patent taken out by a British subject, in respect of an invention derived from an alien permanently domiciled in Britain, would be held valid. It has been decided that an alien, subject of a country with which we are at amity, may well be the grantee of a patent privilege, and that the grant may either be taken in his own name or in the name of another in trust for him. (*Beard* v. *Egerton*, 3 C. B. Rep. 97.) It has now become a very common practice to grant patents to British subjects resident in Great Britain in respect of inventions communicated from abroad. If the grantee is the agent for the foreign inventor, the letters patent are subsequently assigned to the latter or his nominee.

If a patentee has stated in his petition that he was the true and first inventor, when in reality the subject-matter was communicated to him by a British subject resident abroad, the patent is void. (*Milligan* v. *Marsh*, 2 Jur. N. S. 1083.) So also when an invention is partly original and partly communicated from abroad, it seems that the latter part should be distinguished in the specification. (*Renard* v. *Levinstein*, 10 L. T. N. S. 177.)

When two contending applicants for a patent claim to be independent contemporaneous discoverers, the law-officer usually refuses to allow the grant to issue to either separately, but offers it to the two jointly. However, in a case where two persons were engaged

in making experiments with regard to the propulsion of vessels, and something occurred which suggested an improvement to both, whereupon they communicated their ideas to each other, and at the end of two years one of them applied for a patent, which was opposed by the other; it was held by *Lord Cranworth, C.*, that the first applicant could not be prevented by the other from obtaining a patent, although there was no doubt that it might be repealed by *scire facias*. (*Lowe's Patent*, 25 L. J. Ch. 454.)

Where it appeared that a master and his foreman had severally invented certain improvements for which the former applied for a patent, the grant being opposed by the foreman, it was held that the patent should only issue upon the master undertaking to hold the same as trustee for both. (*Re Russell's Patent*. 2 De G. & J. 130.) In the same case it was said that where a matter is in much doubt, the court, rather than withhold the Great Seal from a patent, will run the risk of putting the party opposing to the costs of opposing ulterior proceedings, since the one course might cause an irremediable injury, the other a remediable one. See also *Re Spence's Patent* (32 L. T. 326), where *Lord Chelmsford, C.*, said he would not refuse to seal a patent unless it could be shown that it would certainly be bad. And see *Re Tolson's Patent* (6 De G. M. & G. 422).

Where a patent is granted to two or more persons, each may work the invention for his own benefit without being liable to account to the others. (*Mathers* v. *Green*, 1 Law Rep. Ch. Ap. 29.)

The 21st section of the Patent Law Amendment Act, 1852, provides that where the applicant for letters

patent dies during the continuance of the provisional protection, or the protection by reason of the deposit of a complete specification, as the case may be, such letters patent may be granted to the executors or administrators of such applicant at any time within three months after his death, whether the time of provisional protection has expired *or* not; and the executors or administrators of a patentee who did not file a complete specification along with his petition, and died before the filing of the specification required by the letters patent, are permitted to file a specification under the clause usually contained in letters patent which embraces the inventor's executors and administrators.

# CHAPTER V.

## THE TITLE.

WHEN an inventor prepares his petition to the Crown, praying for a grant of letters patent, he describes, in general terms, the nature of his invention; and this description, being transferred into the letters patent, is called the Title of the patent.

It is of great importance that the inventor should rightly frame his title, as many patents have been lost by inattention in this particular. Though the rules of the Commissioners of Patents require that the title should point out distinctly and specifically the nature and object of the invention, it is advisable to disclose the invention in as general terms as may be allowed, for two reasons: First, lest other persons who were about to specify should obtain a clue to it, and frame their specification so as to deprive the real inventor of the priority and the reward which are his right. Secondly, that the title may not disclose to any rival inventor, or manufacturer, information which may be used to the prejudice of the inventor, should his application for the patent be opposed. Instances of the nature referred to are not, it is true, of common occurrence; but they have occurred, and it is most desirable that an inventor should be cautious as to the language he uses. If the title is too general,—that is to say, if it extends to matters not included by the invention;—the patent is bad; and if, on the other hand,

it is too narrow, it excludes, by its very terms, something which the inventor had a right to secure the monopoly of.

The inventor must carefully avoid the use of language which will mislead. If the title bears evidence upon its face of an intention to deceive the public as to the subject-matter of the invention, this is a point which may be urged before a jury with fatal effect, for their opinion may be taken as to the existence of such an intention. (*Cook* v. *Pearce*, 8 Q. B. 1044.)

To show the importance of framing an accurate title, we will cite a few instances where patents were vitiated by a blunder at the very beginning.

The title of the invention spoke of a *tapering* brush; the specification disclosed the invention of a brush, in which the bristles were of an unequal length, but there was no tapering to a point. The patent was held bad. (*Rex* v. *Metcalf*, 2 Stark. R. 249.)

The title was, "A new and improved method of drying and preparing malt;" but the invention specified was a process of producing a colouring-matter for beer, by submitting malt, prepared in the ordinary manner, to a high temperature. This patent was likewise held bad. (*Rex* v. *Wheeler*, 2 B. & Ald. 345.)

A patent was obtained for an improved method of lighting cities, towns, and villages; but it appeared that the invention consisted in the improvement of an old street-lamp. The title was held too general in its terms, and the patent could not be supported. (*Cochrane* v. *Smethurst*, 1 Stark. 205.)

Another patent held bad, by reason of having too general a title, was that contested in the case of *Campion* v. *Benyon*, (1 Carp. Rep. 418). The patent was for

"a new and improved method of making canvas and sailcloth with hemp and flax, or either of them, without any starch whatever"; but the invention proved really to be a new method of preparing hemp and flax, with a view to its being woven into canvas and sailcloth.

The title of Felton's patent described the invention as a machine for giving an edge to knives, razors, scissors, and other cutting instruments; but the invention appeared, from the specification, not to be applicable to scissors, and the patent was adjudged to be void. (*Felton* v. *Greaves*, 3 C. & P. 611.)

In *Newall* v. *Elliott* (10 Jur. N. S. 955; *S. C.* 13 W. R. 11), *Pollock, C. B.*, stated he had, when Attorney General, refused an application for a patent for "An improvement in locomotion," such a title being too general.

On the other hand, the titles in the following cases were held sufficiently certain:—"Improvements in the manufacture of plated articles," when there was only a single improvement (*Nickels* v. *Haslam*, 8 Scott, N. R. 97). "A *new or improved* method of obtaining the reproduction of all the images received in the focus of the camera obscura," leaving it a matter of doubt whether the method was altogether a new one, or only an improvement (*Beard* v. *Egerton*, 3 C. B. 97). A process for more distinctly showing the finer lines of an engraving by means of a glazed surface on the paper designed to receive the impression, was held sufficiently described by the words, "Certain improvements in copper and other plate-printing" (*Sturtz* v. *De La Rue*, 5 Russ. 322). Title, "Improvements in Carriages:" the specification described improvements in adapting

German shutters to carriages. But as such shutters can only be applied to covered carriages, and the title spoke generally of carriages, it was contended that it was too large. After argument, it was held a sufficiently accurate title; *Tindal, C. J.*, observing, that it would endanger the validity of very many patents which have hitherto been free from exception, if the mere fact that their titles were given in such terms as to be capable of comprising other inventions besides that contained in the specification were sufficient to avoid them, in the absence of any proof of intention to commit a fraud on the Crown, or to deceive or mislead the public. (*Cook* v. *Pearce*, 8 Q. B. 1044.)

The title of a patent was for "Certain Improvements in the Doors and Sashes of Carriages." The patentee, in his specification, said, "I have shown my invention as applied to railway carriage-doors and windows, although they are equally applicable to the doors and windows of any other description of carriage or in any position where doors and windows are subject to jar and vibration." This was held not to extend his claim beyond the title (*Oxley* v. *Holden*, 8 C. B. N. S. 707). See also *Newall* v. *Elliott*, (10 Jur. N. S. 954).

The title and specification must be read together; and if the former should be ambiguous, the latter may explain it. Thus the title of Neilson's patent was an invention "for the improved application of air to produce heat in furnaces where bellows or other blowing-apparatus are required." The invention disclosed by the specification was the introduction into the furnace of air heated between the blowing-apparatus and the furnace; and it was held that this answered sufficiently well to the title. (*Neilson* v. *Harford*, W. P. C.

1. 312, 373.) But a specification will not be allowed to comprise more than can be fairly found in the letters patent, and a claim in the specification of something not included in the grant renders the patent void. Thus, in *Croll* v. *Edge* (9 Scott, C. B. R. 479), the patent was granted for "certain improvements in the manufacture of gas, and in the apparatus used when transmitting and measuring gas." The specification contained a claim of an improved mode of making retorts; but as the claim fell neither under the head of manufacture of gas, nor apparatus used in transmitting or measuring gas, the patent was declared void.

Under sections seven and eight of the Patent Law Amendment Act, 1852, every petition for letters patent is referred to one of the law officers for approval; and it is the duty of the law officer to examine the title and the provisional specification (treated of in the next chapter), and to certify that they are correct and in proper form. It may be considered that, when a title has passed this ordeal, and a certificate of the law officer's approval of it has been given, no further question can arise upon its sufficiency. But from the results of the actual working of the law, we consider it highly desirable that an inventor should not place too great reliance upon this, but should adopt every means in his power to make both the title and the provisional specification perfectly correct, and in accordance with the spirit of the law, that they may, if at any time disputed, be held good upon their own merits.

# CHAPTER VI.

## THE SPECIFICATION.

THE sixth section of the Patent Law Amendment Act, 1852, enacts, that every petition for the grant of letters patent for an invention shall be left at the office of the Commissioners, accompanied by a statement in writing, called the provisional specification, signed by, or on behalf of, the applicant for letters patent, describing the nature of the invention. The rules issued under that Act require that the provisional specification shall state distinctly and intelligibly the whole nature of the invention, so that the law officer may be apprised of the improvement, and of the means by which it is to be carried into effect. But a general description of the invention fairly showing its real nature is sufficient. Minute details as to the manner of carrying out the invention need not be given. (*Re Newall and Elliott*, 4 C. B. N. S. 269; *S. C.* 4 Jur. N. S. 562.)

There is no need to illustrate the provisional specification with drawings though this is not unfrequently done.

By the ninth section of the statute it is enacted, that the applicant, instead of leaving with the petition a provisional specification, may, if he think fit, file with it an instrument in writing, under his hand and seal, to be called a complete specification, particularly describing and ascertaining the nature of the invention, and in what manner the same is to be performed. The object of the provisional specification is to provide

against the introduction into the complete specification of any matters of invention differing from those for which the letters patent were granted. The patentee is not to be prevented including in his complete specification those improvements in practical details which may occur in carrying out the invention, provided that those improvements require the use of the original matter of invention which is set forth in the provisional specification, for which the patent is granted.

The provisional specification is not intended to ascertain the *entirety* but the *identity* of the invention. (Per *Pollock, C. B.*, in *Newall* v. *Elliott*, 10 Jur. N. S. 955; *S. C.* 13 W. R. 11.) In this case the invention described in the claim cited *ante* (p. 13), was held to have been sufficiently disclosed by the provisional specification, although the latter made no mention of the third part of the invention as described and claimed in the complete specification. (See also *Foxwell* v. *Bostock*, 3 N. R. 546.)

It sometimes happens that after a provisional specification has been lodged, an inventor thinks it desirable to abandon it and lodge another in a different form. It has been doubted whether a patent obtained upon the latter provisional specification is valid, but in the case of *Oxley* v. *Holden* (8 C. B. N. S. 666), it was held that a provisional specification does not become public by the mere fact of abandonment. It does not become public until published by the Patent Office, under the authority of the 2nd sect. of the 16 and 17 Vict. cap. 115. Furthermore, though the first provisional specification may afford an objection at the office to the receiving of the second, or to the granting of a patent for the invention after the first specification

has expired, yet there is no principle of law and no enactment, making a patent void if so granted. A patent usually bears date the day the provisional specification is lodged, and the 24th section of the 15 & 16 Vict. c. 83 enacts that patents bearing date as of any day prior to the day of the actual sealing thereof, shall have the same validity as if they had been sealed the day they bear date.

It must be remarked that under the thirteenth section of the Patent Law Amendment Act, 1852, the law officer may object to the form of the complete specification, if left at the patent office along with the petition and declaration, and he may order the language to be altered before the patent is sealed. A complete specification filed after the sealing of the patent is not submitted to any examination of this kind.

If a provisional specification only shall have been left with the petition, the letters patent contain a clause making them void, in case the patentee shall not describe and ascertain the nature of the invention, and the manner in which the same is to be performed, by an instrument in writing under his hand and seal, and cause the same to be filed within six calendar months next after the date of the letters patent. But if a complete specification shall have been filed along with the petition, then in place of this clause another is substituted, making the letters patent void, in case such complete specification does not particularly describe and ascertain the nature of the invention, and in what manner the same is to be performed. It must be understood that in our subsequent remarks we refer only to the complete specification, or to the specification filed subsequent to the grant of the patent, and

not to the provisional specification, which need be no more than a mere sketch or outline of the perfect instrument.

The Crown has power, under the sixteenth section of the Patent Law Amendment Act, 1852, to direct any complete specification, which may have been filed previous to the sealing of a patent, to be cancelled, whereupon the protection obtained by the filing of such complete specification will cease.

The 22 Vict. c. 13, empowering the Secretary of State for War to purchase the benefit of patentees' inventions relating to munitions of war, contains provisions enabling the Secretary of State to prevent the publication of such inventions. (See the statute in the Appendix.)

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It has generally been considered that letters patent are founded upon an implied compact between an inventor and the public.* The latter, through the Crown, secures to the former the monopoly of the invention, with all the advantages flowing therefrom, for a given period of time; and the inventor, on his part, undertakes to tell the community what his invention really is, and to teach them how it may be practised and

* The existence of this implied compact has however been recently denied by high judicial authority. In the great case of *Feather* v. *The Queen*, Pract. Mech. Jour. vol. 10. 2nd ser. p. 324, where the Court of Queen's Bench decided that Letters Patent granted no exclusive right as against the Crown, *Cockburn, C. J.*, in delivering the judgment of the Court said: "It appears to us that the assumption of a contract between the Crown and the patentee is fallacious. The grant of a patent is a simple exercise of the prerogative; in which, as the ground on which alone the grant of a monopoly is justifiable, that the invention shall be made available to the public, the Crown annexes a condition of the grant that the true nature of the invention and the manner in which it can be used shall be fully and unreservedly disclosed."

carried into effect when the monopoly shall have ceased. It is by this instrument that the public is made acquainted with the inventor's secret, and he is bound, in return for the privilege granted to him, to describe it clearly and fully, with the view of enabling others, when the proper time comes, to work the invention, if they desire to do so. In the meantime, the public are entitled to know what it is they are prohibited from using, that they may not unawares incur liability.

In describing his invention, a patentee may, if he think proper, make use of plans and diagrams to be annexed to the specification (*Ex parte Fox*, 1 V. & B. 67); and those who are called upon to interpret the instrument must look both at the words and the drawings, with the view of making them explain each other, and of arriving at the patentee's meaning. Many inventions can be explained perfectly well without any drawings; but wherever machines are the subject of, or connected with, the invention, drawings should always accompany the specification, for in such a case the visual representation of the parts will be clear at once, when a verbal description would be utterly unintelligible. Care must be taken that the patentee does not bind himself to the particular form given in the drawing, when he does not so intend. It may be that only a particular form is required to be secured, because no other form will effect the proposed result. In such a case, if the form is not copied, the invention is not made use of. But in most cases it is more than one form which is sought to be protected by patent, and the form given in the drawing is only to be taken as an illustration. This fact ought to be distinctly shown in the specification.

It seems that a patentee will not be allowed, in an action brought by him for an infringement, to read the provisional specification with a view to explain the complete specification. (*Mackelcan* v. *Rennie*, 13 C. B., N. S. 52.)

The construction of a specification belongs to the Court alone, as soon as the attendant circumstances and the true meaning of the technical phrases, if there be any, have been ascertained by the jury. (*Neilson* v. *Harford*, W. P. C. 1. 370; *Bovill* v. *Pimm*, 11 Exch. Rep. 718.) "Where novelty or infringement" (said *Lord Campbell*, in *Seed* v. *Higgins*, 8 H. L. C. 561) "depends merely on the construction of the specification, it is a pure question of law for the judge; but where the consideration arises how far one machine imitates or resembles another in that which is the alleged invention, it generally becomes a mixed question of law and fact which must be left to the jury." It is also for the Court to decide the question as to the identity of inventions described in two nearly contemporaneous specifications, when such question can be determined by a simple comparison of the specifications. (Per *Coltman, J.*, in *Allan* v. *Rawson*, 1 C. B. 571; per *Pollock, C. B.*, in *Tetley* v. *Easton*, at Nisi Prius, Macr. P. C. 68; and per *Erle, J.*, in *Bush* v. *Fox*, Macr. P. C. 168; *Booth* v. *Kennard*, 2 Hurlst. & Norman, 84; *Thomas* v. *Foxwell*, 6 Jur. N. S. 271; *Hills* v. *London Gas Light Company*, 5 Hurlst. & Norm. 312. See, however, the observations of *Tindal, C. J.* in *Muntz* v. *Foster*, W. P. C. 2. 105.) But if anything more than simple comparison is required to determine the identity or dissimilarity of two inventions, the question must be submitted to the decision of the jury. "If there be

two specifications to be compared (said *Lord Westbury, C.*, in *Hills* v. *Evans*, 8 Jur. N. S. 528), in order to arrive at a conclusion of fact, the right of drawing the inference of fact from the comparison belongs to the jury, and is a question of fact, and not a question of law."

The most important case decided of late years with reference to the interpretation of specifications is that of *Betts* v. *Menzies*, in the House of Lords (10 H. L. C. 117; *S. C.*, Pract. Mech. Journ. vol 7. 2nd ser. p. 98), in which it was held that even where there is an identity of language in two specifications, if such identity consist merely in technical terms, it must be considered impossible for the judge to predicate what exact meaning the first patentee attributed to such terms, if any long interval of time, such as the interval from 1804 to 1848, elapsed between the two specifications. Under these circumstances the judge ought not to take upon himself to decide as to the identity of the inventions, guided only by the similarity of language. He cannot assume that the inventions are substantially the same because the expressions employed are similar. The identity or dissimilarity is a fact which the jury must be called on to decide from the evidence laid before them; and in a subsequent case on the same patent, *Wood, V.C.*, appears to have considered that it is no ground of proof of the effect of an anterior patent that scientific persons of the present day, with all the superior knowledge and intelligence obtained by the advance of science, can depose that they could produce the same results by the process disclosed by the anterior patent, as that designated by the subsequent one. (*Betts* v. *De Vitre*, 11 L. T. N. S. 445.)

Steiner obtained a patent, in 1843, for a new manu-

facture of a certain colouring-matter called garancine. This is extracted from madder-root, and is extensively used in dyeing. This colouring-matter was formerly extracted by simply boiling in water, and the refuse matter, termed "spent madder," was thrown aside as useless, although it was known still to contain a considerable quantity of colouring-matter which boiling would not extract. Various plans had been suggested for extracting the remainder of the garancine, previous to the date of Steiner's first patent, in 1832. His process was the employment of diluted sulphuric acid of a given strength, and he proposed to apply it to the extraction of the colouring-matter from both fresh and spent madder. So weak a solution of sulphuric acid had, however, little effect upon the spent madder; and in 1843 Steiner took out another patent, the one contested on this occasion. A much stronger solution of sulphuric acid was now used, and heat was employed. The process was specially applicable to the extraction of garancine from spent madder, and he thus obtained a large portion of the garancine which had previously remained attached to the woody fibre. *Pollock, C. B.*, at the trial of an action brought for an infringement of the latter patent (*Steiner* v. *Heald*, 2 Car. & Kir. 1033), thought that the process was substantially the same as that described in the specification under the first patent. "It appears to me that this is precisely the same as if you applied a process to grapes already imperfectly squeezed, by which you squeeze a little more juice out of them than was formerly done." Believing the invention to be destitute of novelty, he directed the jury that, in point of law, the alleged invention (viz. the one under the second

patent) was not any manner of manufacture for which letters patent could be lawfully granted. The jury gave their verdict in favour of the defendant, in conformity with the judge's direction; and a rule having been obtained by the plaintiff to set the verdict aside, and for a new trial, on the ground of misdirection, the Court of Exchequer made it absolute, and ordered a *venire de novo* to issue. The judge, it will have been observed, treated the conclusion to be drawn from the evidence as matter of law; whereas he ought to have left it to the jury to say, whether fresh and spent madder had different properties, chemical or otherwise, or whether they were the same thing, with the difference only that part of the colouring-matter had been already extracted. If the properties of the two substances were different, the invention was a new manufacture; but if the two things were the same, except that one was more charged with colouring-matter than the other, in that case the invention claimed would simply have been the application of a process already known, producing a known result. The object to which the process was applied not being different from that to which it had been formerly applied, in which case there would have been no new invention, it was for the jury to say, upon the evidence, whether the invention was a new manufacture or not. (*Steiner* v. *Heald*, 6 Exch. Rep. 607.)

It is the duty of the judge, at the trial, where a specification comes into question, to explain to the jury what that instrument directs to be done, and it is for the jury to say, whether, upon the evidence, the promised result will be accomplished by pursuing those directions. (Per *Cresswell, J.*, in *Beard* v. *Egerton*.)

Formerly there was a disposition in the Courts to take part against patentees, under the impression that monopolies were not to be encouraged (attaching the old odious sense of the term to the phrase indicating a patent privilege for an invention); but of late years specifications have been liberally construed, with a disposition to read them fairly, so often as the patentee himself acts in a fair way towards the public, which he undertakes to instruct. (*Huddart* v. *Grimshaw*, W. P. C. 1. 85; *Elliot* v. *Aston*, W. P. C. 1. 222.) "A specification" (said *Pollock, C. B.*, in *Sellers* v. *Dickinson*, 5 Exch. Rep. 324) "is to be read with candour and indulgence." "It is to be construed" (said *Martin, B.*, in *Betts* v. *Menzies*, 1 Ell. and Ell. 1024) "with the view of supporting the patent, if it can fairly be done."

The first thing that a patentee about to specify must bear in mind is, that he is bound to act with *good faith*. He must not attempt to keep anything secret; he must make a full disclosure of his invention; and his whole specification must be fair, open, and honest. If he acts in any other manner, it will bear hardly with him when his specification comes to be examined in a court of justice.

The next point to be attended to is the accurate definition of the invention, so that the reader may clearly understand in what it consists, and how it may be distinguished from what is old or what is another man's invention. In the case of *Macfarlane* v. *Price* (1 Stark. 199), *Lord Ellenborough* said that the patentee in his specification ought to inform the persons who consult it what is new and what is old. "He should say, My improvement consists in this; describing it by words if he can, if not by reference to figures. But

here the improvement is neither described in words nor by figures; and it would not be in the art of man, unless he were previously acquainted with the construction of the instrument, to say what was new and what was old. A person ought to be warned by the specification against the use of the particular invention, but it would exceed the wit of man to discover from what he is warned in a case like this." "Every party" (said *Cresswell, J.*, in *Gibson* v. *Brand*, W. P. C. 1. 640) "is bound to tell the public clearly by his specification what he claims, and what they may do or not do without risk of an action for infringing his patent." As to the necessity of distinguishing the new parts of a machine or apparatus described in the specification from the old parts, see *Holmes* v. *London & N. W. R. Co.* (Macr. P. C. 4); *Smith* v. *London & N. W. R. Co.* (2 E. & B. 69); *Tetley* v. *Easton* (Macr. P. C. 48); *Foxwell* v. *Bostock* (10 L. T. N. S. 144). It seems that when the invention is partly original and partly communicated from abroad, the latter part should be defined in the patent and specification. (*Renard* v. *Levinstein*, 10 L. T. N. S. 177.)

The patentee should take care not to claim more in his specification than he is strictly entitled to, since a failure in part (provided that part is a material part) is a failure altogether, and that which he has a just right to will fall along with that which does not belong to him. To use *Lord Eldon's* illustration—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, although it might for the improvement merely, it is good for nothing, on account of its attempting to cover too much. In the specification under the patent

which formed the ground of dispute in *Hill* v. *Thompson* (W. P. C. 1. 239), the patentee claimed not only the use of a particular quantity of lime in smelting iron, but the discovery of the usefulness of lime in that process generally. It appeared, however, that lime had been previously used for the purpose, and the patent was accordingly held bad, although, if the patentee had restricted his claim to the particular proportions of lime and metal, it might have been sustained. Again, the specification under Minter's patent, for an improvement in the construction of chairs, was faulty for a similar reason; its claim was too extensive. The improvement consisted in applying a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acted as a counterbalance to the pressure against the back. It was proved that one Brown had previously invented a chair on the same principle, but his application of it was encumbered with additional machinery. If Minter had restricted his claim to the particular mode in which he effected the thing, his patent would have been valid; but since the specification went generally to the application of a self-adjusting leverage to the given purpose, it claimed more than he was entitled to; and if the patent had been held good, Brown could not have continued to make his chair without infringing it. (*Minter* v. *Mower*, W. P. C. 1. 138.) The older case of *The King* v. *Elsee* (W. P. C. 1. 76) affords another instance of the same error. The specification claimed in effect the exclusive right of combining silk and cotton thread, and then of making lace of the combined material. It was proved that silk and cotton thread had previously been combined in some mode or other; and although the ma-

terial so constructed was unfit for making lace on account of its coarseness, yet as the patentee did not confine himself to any particular mode of combining the two, his claim was held to extend to every mode, and was therefore bad. We may refer to the cases of *Saunders* v. *Aston* (3 B. & Ald. 886), *Rex* v. *Cutler* (1 Stark, 354), *Haworth* v. *Hardcastle* (W. P. C. 1. 484), and *Thomas* v. *Foxwell* (5 Jur. N. S. 37; 6 Jur. N. S. 271), as further illustrations of this point.

A patentee will not be allowed to make large, grasping, speculative claims to matters of which he was ignorant at the date of his patent. In the specification under a patent for improvements in machinery for raising water, the patentee said, "If any gases or elastic media other than atmospheric air are used, with which to charge the case [part of the machinery], I claim the sole right to do so." *Pollock, C. B.*, who tried an action brought for infringing this patent, remarked upon this passage, that he had no hesitation in saying that, in point of law, the patentee had no right to make such a claim, and he went on to state that the law would not permit a patentee to claim more than he has invented. "It will permit him to claim that which he has invented by means of successful experiments or otherwise, and which he has given to the public, but not that which is the mere subject of his speculation or imagination, or of his endeavouring to grasp more than he is entitled to. I think we are bound to give, as far as possible, the fullest effect to an invention; but, on the other hand, I think we are also bound to oppose the endeavours to make a patent grasp at and embrace a number of matters that were never in the head of the inventor."

In another part of the specification, the patentee described a wheel with straight arms, and then he said, "I propose to construct the wheel of every variety of configuration, so long as it is constructed with a channel in the interior." The defendant had made use of a wheel with *bent* arms, and the patentee treated this as an infringement, although he admitted that at the time he obtained his patent he had never thought of bent arms, and also that curved arms almost trebled the effect of the machine. The judge told the jury that the patentee's claim to every shape of arm would not stand. To hold that it was good, would be to reward a man who had rashly and ignorantly taken out a patent on a subject he had not appreciated. The same learned judge, when presiding at the trial of *Stevens* v. *Keating* (W. P. C. 2. 184),—an action for infringing a patent for processes for combining materials to form cements,—said, with reference to that part of the specification which was held to claim the use, not only of a particular acid, but of all acids which might succeed, that no patentee could be allowed to make such a claim, and to say, Whereas other substances will succeed, I claim them all. See also *Crossley* v. *Potter* (Macr. P. C. 246).

A perusal of these cases will show that it is safer for a patentee to restrict his claim to the use of those processes, or those materials, which he has found by actual trial to answer the purpose, than to extend it to matters of which he has no accurate knowledge; since, in doing this, he may either claim something which will not answer the object in view, something which is not new, or something which he does not sufficiently describe. The law will aid him, without any general claim

in his specification, in repressing infringements which are an illegal imitation of his process behind a colourable variation, or by means of mechanical or chemical equivalents.

"The safest course for patentees to adopt" (said *C. B. Pollock* to the jury on the trial of *Crossley* v. *Potter*, Macr. P. C. 256) "in framing their specifications is, instead of including everything, to confine themselves specifically to one good thing, and a jury will always take care that if that be a real invention, no man under colour of improvement shall be allowed to interfere with that which is the offspring of their genius."

Since the specification is to be read along with, and is always considered as part of, the letters patent, the two must not be inconsistent. The invention referred to in the patent must be the invention described in the specification. Instances of the fatal effect of an inconsistency here have been already noticed in our last chapter.

It will be a fatal defect if the specification omit to mention anything which is essential to the carrying into effect of the invention. In a patent for trusses, the patentee omitted to state that the steel of which they were made was to be tempered with tallow, and *Lord Mansfield* held it void. (*Liardet* v. *Johnson*, W. P. C. 1. 53.) When a patent was granted to Dr. James for fever powders, he stated in his specification the materials of which they were composed, but omitted to describe the quantity of the ingredients. This being the case, said *Lord Mansfield*, he never durst bring an action for infringement, and it was certainly wise in him not to do so, as no patent could stand on such a specification. (W. P. C. 1. 54.) The speci-

fication of Neilson's patent omitted all mention of water-twires; if the apparatus (said *Parke, B.*) would not be beneficial without them, then it is of no use to the public as it is described in the specification, and the specification would be bad. (*Neilson* v. *Harford*, W. P. C. 1. 317.) When a patentee prepared the specification of his invention of spinning machinery, he said nothing as to the difference in the velocity of certain rollers. Having brought an action for an infringement, and gone into evidence to show what his invention was, *Buller, J.*, remarked, "The man comes to give an account of the invention, and says, I had calculated, and the difference of the velocity was to be as five to one. Now he has not said a word of that in his specification. In that, he has kept back the knowledge he had as to the size of the rollers and their velocity, and it is left to people to find it out as chance may direct." The patent was accordingly held bad. (*Rex* v. *Arkwright*, W. P. C. 1. 70.) Again, under a patent for improvements in steam-engines and paddle-wheels, a difference which had to be made in the lengths of certain rods was not given in the specification, and it was attempted to explain this by saying that the difference in the length, being small, would not be very material. "But the whole question" (said *Alderson, B.*) "is small, therefore it ought to have been specified; and if it could not be ascertained fully, it should have been so stated. . . . The small adjustment of these different lengths may have been made for the purpose of making the machine work more smoothly; if so, it is just as much necessary that it should be stated in the specification as that the tallow (referring to the case of *Liardet* v. *Johnson*) should be mentioned." (*Morgan* v. *Seaward*, W. P. C. 1. 182.)

A patent was obtained for improvements in floating docks. In an action for an infringement it was proved that the construction of floating docks was not new, but the plaintiff alleged that his invention consisted in the application of iron so as to form air-tight and water-tight chambers. Now there was no mention of iron in the specification, and it was held both by the judge on the trial and by the Court of Common Pleas that if this were so, the plaintiff had not complied with the conditions of the letters patent, which required him duly to describe the nature of the invention and in what manner it was to be carried out. (*Mackelcan* v. *Rennie*, 13 C. B. N. S. 52.)

But it would seem from *Crossley* v. *Beverley* (3 C. & P. 515), that in construing a specification, the state of the particular manufacture at the date of the patent must be kept in view. In this case, in describing a gas-apparatus, no directions were given as to a condenser; but since a workman capable of constructing a gas-apparatus knew that he would have to put it in, the specification was held sufficient. The patent in *Russell* v. *Cowley* (W. P. C. 1. 459) was for a method of manufacturing iron tubes without the use of a mandril. The specification gave no directions as to leaving out the mandril; but it was held that an intelligent workman would sufficiently understand, from the purport of the specification, that a mandril was not to be used. So, in *Beard* v. *Egerton* (8 C. B. R. 165), it was held that a competent operator would perceive, on perusing the whole specification, that it would be necessary to interpose an operation at a certain stage in the process of daguerreotyping.

A patentee is bound to describe the most advan-

tageous method within his knowledge for carrying his invention into effect; and he ought to put the public in possession of his secret in as ample and beneficial a way as he himself uses it. In *Wood* v. *Zimmer* (Holt, N. P. 57) a patent for a method of making verdigris was contested. It seemed that verdigris was made by the process set forth in the specification; but that the patentee was in the habit of secretly putting aquafortis into the boiler. The copper, forming one of the ingredients, was thereby more rapidly dissolved; but the verdigris produced was neither better nor cheaper than that made according to the specification. *Gibbs, C. J.*, considered this a prejudicial concealment, and a breach of the terms which the patentee made with the public.

Letters patent were obtained for a mode of making a medicine, composed of three salts, commonly sold in the shops under certain well-known names. The specification, instead of describing these salts by their names, described the processes by which they were produced, and then pointed out the proportions in which the salts were to be combined in order to form the medicine the subject of the patent. The methods of producing the separate salts were not essential to the combination, and formed no part of the invention. It was held at *Nisi Prius* that the specification was bad, *Abbott, C. J.*, saying that it is the duty of any one to whom a patent is granted to point out in his specification the plainest and most easy way of producing that for which he claims a monopoly; and to make the public acquainted with the mode which he himself adopts. If a person would be led to suppose a laborious process necessary to the production of any

one of the ingredients, when in fact he might go to a chemist's shop and buy the same thing as a separate simple part of the compound, the public are misled. (*Savory* v. *Price*, 1 Ry. and Moo. 1.)

If anything that gives an advantageous operation to the thing invented be concealed, the patent is void. In *Turner* v. *Winter* (W. P. C. 1. 81), *Buller, J.*, said, that if the patentee make the article for which the patent is granted of cheaper materials than those which he has enumerated, although the latter may answer the purpose equally well, the patent is void, because he does not put the public in possession of his invention, or enable them to derive the same benefit as he himself does. In *Sturtz* v. *De la Rue* (1 Carp. Rep. 463), it appeared that the patentee had mentioned in his specification a certain substance, under the name of the *finest and purest chemical white lead*, which was to be used in giving paper a glaze, preparatory to its receiving an impression from an engraved plate. He himself imported from Germany, for this purpose, a preparation called *Kremnitz white*; but he said nothing about this in his specification. It was shown that there was no article known in the chemists' shops in London which answered to the patentee's name, and that the purest white lead which could be purchased there did not answer the purpose. It was held, on these facts, that the patentee had not made that full disclosure which he ought to have made; and his patent was adjudged void. "A man has no right" (said *Pollock, C. B.*, in his address to the jury on the trial of *Tetley* v. *Easton*, Macr. P. C. 76) "to patent a principle, and then to give the public the humblest instrument that can be made from his principle, and reserve to himself

all the better part of it." (See also *Derosne* v. *Fairie*, W. P. C. 1. 158.) In *Walton* v. *Bateman* (W. P. C. 1. 622), *Cresswell, J.*, laid down this rule:—If a man knows a better mode than that which he states to the public, his patent will be vitiated.

If the patentee knows of any circumstance which conduces to the advantage of his manufacture or process, he is bound to mention it in his specification. In *Neilson* v. *Harford* (W. P. C. 1. 321), the judge told the jury, that if the patentee believed that certain internal partitions in the hot-blast apparatus were useful, the patent would be void, since he had omitted to say anything about them in the specification.

On the other hand, an inventor who obtains a patent for the useful application of a principle is not to be called on to set forth every mode of applying it. It is sufficient if he shows some of its useful applications, those applications being the best illustrations of the invention known to him. See what fell from *Lord Abinger* in *Neilson* v. *Harford* (W. P. C. 1. 356). But it must be borne in mind, that a patentee cannot, by making a general claim, cover improvements of which he was ignorant at the date of his specification (*Tetley* v. *Easton*, Macr. P. C. 77).

Nor is it obligatory on a patentee, when referring to materials and ingredients to be used in carrying his invention into effect, to enter into minute details as to such materials and ingredients, if they are known in the shops, and can be readily purchased under the names which he gives them (*Mackintosh* v. *Everington*, 2 Carp. Rep. 191). So also a person who takes out a patent for an invention consisting of the use of known materials in new proportions is not bound to limit his

claim to the precise proportions recommended by him in his specification (*The Patent Type Founding Company* v. *Richard*, Johns. 381). The names of articles mentioned in a specification must be taken to be used in their ordinary commercial sense. (*Sturtz* v. *De la Rue*, W. P. C. 1. 83; *Stevens* v. *Keating*, 2 W. P. C. 183, 187; *Muntz* v. *Foster*, 2 W. P. C. 104.) Whether or not a specification describes with sufficient accuracy the material out of which an article is to be made, is a question for the jury. (*Bickford* v. *Skewes*, W. P. C. 1. 214; *Derosne* v. *Fairie*, W. P. C. 1. 154; *Elliot* v. *Turner*, 2 C. B. 446; *Wallington* v. *Dale*, 7 Exch. 888.)

The patentee ought to state whether his invention consists of the useful application of a principle, or whether it lies in a particular form or arrangement or combination of parts. A number of old and well-known things, such as implements, machines, or parts of machines, may be combined so as to form a new and useful instrument or machine; and a patent obtained for such combination will be valid, care being taken that the specification does not claim the old parts as well as the novel combination. "If," said *Gibbs, C. J.*, to the jury, on trying the case of *Bovill* v. *Moore*, "a patentee has in his specification asserted to himself a larger extent of invention than belongs to him—if he states himself to have invented that which was well known before—then the specification will be bad." . . . "If a patentee has only invented an improvement, then his specification by which he claims the whole will be bad. If, on the other hand, he has invented an engine which consists of a perfectly new combination of parts, although all the parts were used before,

yet he will be entitled to support his patent for a new machine." . . . "If a combination of a certain number of these parts existed up to a given point before the date of his patent, and if the patentee's invention sprung from that point, and added other combinations to it, then his specification, stating the whole machine as his invention, is bad." (Dav. P. C. 404, 412, 413.)

It may be that all the parts of an invention, taken separately, are old, the patent being obtained only for a novel combination of them. In preparing his specification for such an invention, the patentee must be careful to separate what is old from what is new. He must limit his claim to the new combination, and to prevent misconstruction it is desirable, though not absolutely necessary, that he should distinctly disclaim the old parts. (*Lister* v. *Leather*, 3 Jur. N. S. 811; *S. C.* in error, 8 E. & B. 1004; *Seed* v. *Higgins*, 8 H. L. C. 550.) The case of *Kay* v. *Marshall* (2 W. P. C. 71) deserves attention with reference to this rule. The inventions claimed in the specification were two. First, certain new machinery for macerating flax; and secondly, improved machinery for spinning flax. The first invention would very well have supported the patent separately considered. It was that part of the specification which described the second invention that broke down. The so-called improved machinery, considered in itself, and apart from its application, was shown to be wanting in novelty, and hence the patent fell to the ground. Had Kay, instead of claiming the invention of improved machinery, claimed only the invention of a combination of a known process of wetting flax, with the use of known machinery for spin-

ning the same, certain parts of such machinery being at a given distance from each other, the patent would, doubtless, have been held good. The combination was new, although the process and the machinery were old. The invention was one of great value, and if the specification had been rightly framed, the patentee might have had the benefit of it, without suffering the anxiety and expense of litigation in the common law courts, the Court of Chancery, and the House of Lords.

The case of *Tetley* v. *Easton* (Macr. P. C. 48) went three times before a jury, and on two of the occasions the plaintiff failed by inattention to this rule. His patent was for improvements in machinery for raising and impelling water. The specification described a great number of mechanical contrivances tending to effect the object in view, and concluded by claiming, as the patentee's invention, the several contrivances, "both when all used in combination, and when used severally." It was shown, on the trial of the first action for an infringement, that several of these contrivances were old; and with regard to one in particular, which the defendants were charged with infringing, that a person named Hales had previously procured a patent for something substantially the same. The jury thereupon found a verdict for the defendants upon issues which raised the question of the novelty of the plaintiff's invention. Subsequently to this trial, the plaintiff entered a disclaimer as to several parts of his specification, and brought another action against the same defendants. The jury again returned a verdict for the defendants. A rule to set aside the verdict, and for a new trial, having been obtained, the

legal questions came on for argument before the full court. It appeared that the amended specification described a centrifugal pump, composed of a hollow wheel, revolving within a case, furnished with pipes for conveying the water. This wheel was not stated to be old, nor was it disclaimed. The specification claimed generally the machinery for raising and impelling water. It also claimed the application of the inventions before mentioned, "both when all used in combination, and when used severally." It was held that the hollow revolving wheel was thereby claimed, and as this was an old invention, the specification was bad, for the patentee had described the wheel as part of his own apparatus, and if he had not intended to claim it, he ought to have disclaimed it. By a second disclaimer the patentee's claims were reduced to the single one of "the means of increasing the action of the machine by causing the liquid to enter the wheel at both sides;" and he then brought a third action for the infringement of his patent. Unfortunately it was shown that previous inventions had embraced a contrivance for the admission of the water on both sides of the wheel; and the learned judge (*Willes*) directed the jury to find for the defendant, for the reason that, although the wheel had been previously combined with apparatus which made the combination useless, yet that the contrivance in question had been made public property, and could not of itself be made the subject of a patent. The Court on the argument of a rule for a new trial on the ground of misdirection said, that the use of a wheel known before, in a manner known before, could not be deemed an invention capable of sustaining a patent, and held that the judge was right,

and the defendant consequently retained his verdict. (2 C. B. N. S. 706.)

The specification under a patent for an improved turning-table for railway purposes, after describing the machinery, claimed as new "the improved turning-table as hereinbefore described." This was held to be a claim of the parts, as well as of the combination forming the improved turning-table. For if parts are described, and the invention of them is not disclaimed, they will be considered as claimed (*Tetley* v. *Easton*, Macr. P. C. 87). When a patentee is preparing his specification, it is of great importance that he should keep this proposition in mind. Now, it appeared, on the trial of an action for an infringement, that no part of the machinery was new, except certain suspending rods. It was held that the specification was defective, by reason of its not distinguishing what was old from what was new. "Every patentee," said *Jervis, C. J.*, "must, in his specification, describe the nature of his invention in such a way as that those who read it with common, ordinary understanding, and fairly read it, may see and understand what is new and what is old" (*Holmes* v. *London and N. W. Railway Co.*, Macr. P. C. 26).

In the case of *Foxwell* v. *Bostock* (3 N. R. 546; *S. C.* 10 L. T. N. S. 148) *Lord Westbury, C.*, laid down the rule to be that in a patent for an improved arrangement or new combination of machinery, the specification must describe the improvement and define the novelty, otherwise and in a more specific form than by the general description of the entire machine. "On both principle and authority it is most necessary that the specification should ascertain the improvement,

when the patent is for an improved, that is, a new combination. At the date of this patent many machines for sewing and stitching by a needle and shuttle were known and used. If in that state of things a patent is taken out for an improved arrangement or combination, the patentee is surely bound to show in what the improvement consists, and how it is to be effected. But this obligation is not discharged by a description of the entire machine which embodies, but does not distinguish the improvement, and thereby renders it undiscoverable, except upon a minute comparison and collation of all existing combinations with the new combination that is claimed. A specification so framed has the effect of concealing rather than of disclosing the invention." The plaintiff's counsel stated that the improvement consisted of an arrangement of three cams on one shaft, by the direct action of which the three principal movements in a needle and shuttle machine were effected. The plaintiff's evidence went to show that this arrangement formed the novelty and utility of the machine. "But this clear and simple statement is not to be found anywhere in the specification. It is true that the cams and shafts are described indiscriminately with the rest of the machine in the specification, but there is nothing to indicate that it is this addition which constitutes the improved arrangement or the new combination." The specification was therefore held to be defective and the patent invalid.

The specification under a patent for certain improvements in valves or plugs described three things as the improvements for which the patent had been obtained, without claiming the combination. Now, it appeared

that the three things separately considered were old, although the combination was new; and it was argued that the specification was bad. The Court said they thought there was much weight in the objection to the validity of the specification; but the question was not decided, because it did not arise upon the pleadings (*Bateman and Moore* v. *Gray*, Macr. P. C. 115).

A patentee sometimes obtains a second patent for improvements upon an invention which formed the subject-matter of a previous patent, and the second specification usually refers to the first. Care should be taken in preparing the second specification to make it distinguish clearly the later improvements from the earlier invention; for notwithstanding the case of *Harmer* v. *Playne* (11 East. 101), there is reason to suppose that unless it can be seen on reading the second instrument, after the expiration of the earlier patent, of what the later invention consists, as something distinguishable from an old part, the second patent would be pronounced invalid.

The fatal effect of ambiguous language in a specification is illustrated by the case of *Hastings* v. *Brown* (17 Jur. 648; *S. C.*, 1 E. & B. 454). Charles Johnstone obtained the grant of a patent on the 21st December, 1844, for an invention of "certain improved arrangements for raising ships' anchors, and other purposes." The specification claimed as the invention "a cable holder to hold without slipping a chain cable of any size," but it could not be gathered from it whether the inventor claimed a cable holder to hold a chain cable of any *one* size, or to hold chain cables of different sizes. Now, a cable holder to hold a chain cable of any one size was already known at the date of the

patent. "The patentee," said *Lord Campbell*, when the case was argued before the Court of Q. B., on a motion to enter a nonsuit, "ought to state distinctly in his specification what is his invention, and to describe the limits within which he is to enjoy a monopoly. That is not done in this case with respect to the nature of the cable holder. What is claimed [in the pleadings] is a right to construct a capstan which will raise chain cables of different dimensions. Does the plaintiff disclose in his specification that he claims that invention? If it is only claimed with regard to one cable, then there is no infringement of the patent. The vice of the specification is, that it is quite equivocal what the claim is. There is nothing in the title which at all assists us; and when we look to the description in the specification, which speaks of 'a chain cable of any size,' I think that the proper construction to be put upon the words is that they mean 'one chain cable.' At all events, they are capable of that meaning; and if the specification is equivocal, it is bad." The rule for a nonsuit was accordingly made absolute.

The specification under a patent for certain methods of making cements, described a method of making cement from gypsum, in the course of which an alkali, neutralized by an acid, was directed to be used; sulphuric acid and potash being stated to be the best acid and alkali for the purpose. Another method for making cement from limestone and chalk was then described, and consisted also in the use of alkali, neutralized by an acid. An action was brought for an infringement of this patent. The infringement complained of was the use of borax in making cement,

borax being composed of an acid (boracic acid) and an alkali (soda). The patentee, however, failed, on account of his defective specification. If he confined himself to sulphuric acid and potash, then the defendant was not liable, seeing that he had used neither; if he claimed the use of all acids and alkalis, his claim was bad, because it was proved that there are some acids and alkalis which would not answer the purpose; and if he claimed only those acids and alkalis which were proper and suitable, he was bound to state what they were, otherwise experiments would have been necessary to discover what were suitable and what were not. (*Stevens* v. *Keating*, 2 W. P. C. 194.) See also *Muntz* v. *Foster* (2 W. P. C. 109).

Hills, in the specification under his patent for the purification of gas, claimed the use of "hydrated *or* precipitated oxides of iron." Now, if this meant all hydrated oxides of iron, the claim would have been too large, inasmuch as some of them would not effect the purpose, and the defendant, in an action for an infringement of the patent, argued that this was the meaning. The Court of Exchequer, however, although admitting that the language was not accurate, held, in their desire to uphold the specification, that the patentee meant to refer to such hydrated oxides as were precipitated (*Hills* v. *London Gas Light Co.*, 5 Hurlst. & Norm. 368).

If the specification contains language calculated to mislead as to an important part of the patented process, as where it contains positive misdirections as to the mode of operating, the patent will likewise be void.

On the trial of *Palmer* v. *Wagstaff* (Newton's Lond.

Jour. vol. 43, p. 131), in an action brought by a candle manufacturer for an infringement of a patent for improvements in the manufacture of candles, it was alleged that the specification contained a positive misdirection as to the position in which the wicks were to be placed in the process of manufacture. The object proposed was the production of a candle requiring no snuffing, by using two or more plaited wicks, arranged in such a manner that they would separate and bend outwards as the candle was burned. Now, it was shown that if the directions of the specification were followed, the candle would require lighting at the bottom, instead of the top. If lighted at the top, the wicks converged, instead of diverging, and produced a long snuff. The judge (*Pollock, C. B.*) told the jury that this was a serious mistake, and though the verdict was given against the plaintiff upon other points than those connected with the validity of the specification, there is reason to suppose that this instrument could not have been supported. See also *Savory* v. *Price* (1 Ry. and Moo. 1); *Bickford* v. *Skewes* (W. P. C. 1. 218); *Simpson* v. *Holliday* (13 W. R. 577).

It has also been decided, that if two methods of doing a thing are described in the specification, and by one of these it cannot be done, the specification is bad. (*The Queen* v. *Cutler*, Macr. P. C. 137.)

Medlock's specification of his invention for making red and purple dyes from aniline commenced the description of the process thus, "I mix aniline with dry arsenic acid and allow the mixture to stand for some time, *or* I accelerate the operation by heating it to or near its boiling point until it assumes a rich purple colour, and then I mix it with boiling water and allow

it to cool: when cold it is filtered and decanted." The Lord Chancellor (*Lord Westbury*) on the construction of the whole specification held that two processes, a hot and a cold process, were described, and as it was proved that only the hot process was effective, his lordship held the specification bad and the patent consequently invalid. It was urged that every person well informed on the subject could see that the cold process was ineffective, but "this," said his lordship, "would be to correct the specification by the superior intelligence of the reader." (*Simpson* v. *Holliday*, 13 W. R. 577.)

In *Booth* v. *Kennard* (2 H. & N. 84), an action brought for the infringement of a patent for improvements in the manufacture of gas, the specification was held bad, because it claimed generally the exclusive privilege of making oil directly from oleaginous seeds; and, instead of describing particularly how this was to be done, only stated that the mode of using the materials might be "the same as in the apparatus used in the ordinary mode of making gas from coal." The Court deemed such a description too vague and general, when coupled with a sweeping claim like that above mentioned. And the Court came the more readily to this conclusion, when it appeared that the principle or leading idea of the alleged invention was not new.

Then as to the general tenor of the specification, the language must be clear and precise; the explanation must be intelligible to a person of ordinary skill and ability, acquainted with the particular subject; and the directions such that, by pursuing them, he would produce without difficulty the result which the patentee describes. (*Tindal, C. J.*, in *Gibson* v. *Brand*,

W. P. C. 1. 631.) *Lyndhurst, L. C.*, said, in *Sturtz* v. *De La Rue* (W. P. C. 1. 83), that the specification must describe the invention in such a way, that a person of ordinary skill in the trade should be able to carry on the process. And *Lord Denman*, in *Bickford* v. *Skewes* (W. P. C. 1. 218), said that the specification is addressed, not to persons entirely ignorant of the subject-matter, but to artists of competent skill in that branch of manufactures to which it relates. The persons whom the specification ought to be designed for are persons of *ordinary* skill and ability; not those of special and unusual practice, knowledge, and capacity; not persons at the head of their profession. (*Morgan* v. *Seaward*, W. P. C. 1. 178; *Neilson* v. *Harford*, W. P. C. 1. 371; *Household Co.* v. *Neilson*, W. P. C. 1. 692.)

But when placed in the hands of a person of ordinary skill and intelligence, the specification must be able to show him how the invention is to be carried into effect without further assistance, and without needing corrections or fresh invention on his part. There must be no necessity to try experiments in order to accomplish the end promised by the patentee. In *The King* v. *Arkwright* (W. P. C. 1. 66), *Buller, B.*, said that the specification must be such that mechanical men of common understanding (the validity of a patent for a machine being in dispute) must be able to make the machine by following its directions, without any new additions or inventions of their own. And *Parke, B.*, in *Neilson* v. *Harford* (W. P. C. 1. 371), said that to be valid, a specification should be such as, if fairly followed out by a competent workman, without addition or invention, would produce the machine for

which the patent is taken out. It had been previously laid down in *The King* v. *Wheeler* (2 B. & Ald. 349), that a specification which casts upon the public the expense and labour of experiments and trial is undoubtedly bad. It would, however, seem, that if any degree of benefit can be produced by complying with the directions of the specification, and without having recourse to experiments, that would be sufficient to save the patent; it is not necessary that the maximum degree of benefit should be produced (W. P. C. 1. 318). In an action for *infringing a patent for an improved* mode of paving streets with blocks, so shaped that each side of a block was bevelled both inwards and outwards, it was objected by the defendant that the specification gave no direction as to the angle at which the bevels were to be made. The judge who tried the case (*Lord Abinger*) told the jury, that if any angle would be of some use, the specification was good; but if some particular angle was essential, then, as the specification left that to be discovered by experiment, it was deficient and bad (*Macnamara* v. *Hulse*, W. P. C. 2. 129). But *Mr. Justice Bayley* said (in the case of *Crompton* v. *Ibbotson*, 1 Carp. Rep. 462), that a patentee, knowing that given materials will not answer the purpose, is bound so to word his specification as to prevent others from trying experiments on that which he knows will not answer. In this case a patent for an improved method of dyeing and finishing paper came into question; the specification described the paper as being conducted to a heated cylinder by means of cloth, "which cloth may be made of any suitable material, but I prefer it to be made of linen warp and woollen weft." Now the patentee had

ascertained from repeated trials that no other substance would answer the purpose. It was held that the public had not the full benefit of the inventor's discovery, and persons misled by the specification might be induced to make experiments which the patentee knew would fail. This, however, must be considered an extreme case.

In connection with this subject the following observations of *Lord Westbury, C.*, are worthy of attention, "When it is stated that an error in a specification which any workman of ordinary skill and experience would perceive and correct will not vitiate a patent, it must be understood of errors which appear on the face of the specification or the drawings it refers to, or which would be at once discovered and corrected in following out the instructions given for any process or manufacture, and the reason is, because such errors cannot possibly mislead. But the proposition is not a correct statement of the law if applied to errors which are discoverable only by experiment and further inquiry. Neither is the proposition true of an erroneous statement in a specification amounting to a false suggestion, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject. For example, if a specification describes several processes or several combinations of machinery, and affirms that such will produce a certain result which is the object of the patent, and some one of the processes or combinations is wholly ineffectual and useless, the patent will be bad although the mistake committed by the patentee may be such as would at once be observed by an ordinary workman." (*Simpson* v. *Holliday*, 13 W. R. 577.)

It may be inferred from the case of *Huddart* v. *Grimshaw* (W. P. C. 1. 85), that the assertion in the specification of something being important, when in point of fact it is not, will vitiate the patent, because there is evidence of an attempt to deceive. In *Turner* v. *Winter* (W. P. C. 1. 80), *Ashurst, J.*, said that if there is any unnecessary ambiguity affectedly introduced into the specification, or anything which tends to mislead the public, the patent is void. And it was laid down in *Galloway* v. *Bleaden* (W. P. C. 1. 524), that if there is a want of clearness in the specification, so that the public cannot afterwards avail themselves of the invention, much more if there is any studied ambiguity in it, so as to conceal the invention from the public, no doubt the patent would be completely void. Again, if anything is said to be immaterial which is in reality material, this will be a fatal defect. Thus in *Neilson* v. *Harford* (W. P. C. 1. 313), *Parke, B.*, said, "The patentee states that the size and form of the vessel in which the air is heated, previous to its being driven into the furnace, are immaterial. Now, my strong opinion is that the clause is an incorrect statement and that, being untrue, vitiates the specification, and prevents the patent from being a good patent." See also *Simpson* v. *Holliday* (13 W. R. 577).

Simple mistakes, being merely words used in an inaccurate sense, which words are often used, and are explained by the context, or by the drawings annexed, will not avoid the patent. Thus, in *Bloxam* v. *Elsee* (1 Carp. Rep. 439), the specification made use of the expressions, *vis de pression*, *vis de répulsion*, and *vis de réaction*, for different screws; but the context and the

drawings showed what was meant, and the objection taken on this ground was not sustained. In another specification the word "discolour" was used, with the meaning "discharge the colour." This, though a mistake in translating the French word "décolorer," was held not important enough to vitiate the instrument. A court of law will not insist upon accuracy in minute and unimportant matters; it will not insist upon strict logical correctness; it will overlook such evident errors as the mention of "imponderable substances." (*Pollock, C. B.*, in *Tetley* v. *Easton*, at Nisi Prius, Newton's Lond. Jour. vol. 42. p. 58.) All it requires is, that the patentee shall make his meaning clear, and that his language shall be intelligible to the persons to whom it is addressed.

It may here be remarked, that where there is doubt as to the meaning of particular expressions, and there is some question for the jury, competent persons may be called for the purpose of explaining the matter; but evidence is not admissible to explain or alter the plain and precise words of a specification, or to correct mistakes in it. (*Neilson* v. *Harford*, W. P. C. 1. 313.) In *Elliot* v. *Turner* (2 C. B. 446), it was held that the words of a specification are to be construed according to their ordinary and proper meaning, unless there be something in the context (which may be explained by evidence) to show that a different construction ought to prevail. Of course it is allowable to call persons of skill in the department of practical art to which the invention belongs, for the purpose of saying whether or not they understand the specification, and whether or not they could execute its directions, so as to produce a useful result. The persons composing

juries are drawn indiscriminately from the general public, and it cannot be expected that they should of their own knowledge be competent to say whether the specification is one that fulfils its chief object,—that of instructing artists or workmen of ordinary competency to execute the invention. Hence it obvious that in forming their opinion they ought to have the assistance of persons answering this description. See *C. J. Tindal's* remarks in *Walton* v. *Potter* (W. P. C. 1. 595).

It sometimes happens that, between the grant of letters patent and the filing of the specification, the patentee discovers that his original invention is capable of material improvement. The intervening period is allowed the patentee for the very purpose of perfecting his invention; and therefore, if he fails to communicate to the public the best information he possesses at the time of filing the specification, it will be void. In *Crossley* v. *Beverley* (W. P. C. 1. 117), it was objected that the patentee had added something to the invention between these two periods; but, said *Bayley, J.*, "I think that if between taking out the patent and filing the specification the inventor makes discoveries which will enable it better to effectuate the thing for which the patent was obtained, not only that he is at liberty to introduce them into his patent, but that it is his bounden duty so to do, and that it is not sufficient for him to communicate to the public the knowledge he has obtained before the specification." It must, however, be understood that the additions must strictly relate to the invention as it stood at the time of the grant of the patent. It is not competent for a patentee to introduce new heads into the specification,

or in any way to extend the subject-matter of the invention. (*Crossley* v. *Potter*, Macr. P. C. 240.) And assignees of a patent should know that the specification itself is not conclusive evidence of the invention; for the inventor may be called to state in court what his invention really was, and he may show that it was something different from that specified. (*Bateman* v. *Gray*, Macr. P. C. 111; *Crossley* v. *Potter*, Macr. P. C. 255.)

It is usual for a patentee to insert at the close of his specification certain clauses, which are known as "claims." The insertion of these claims is not insisted on by the law, but they offer an opportunity for the patentee to sum up his invention, and to set forth in a brief form what he considers the pith and essence of it. When the claims refer to the invention in very short terms, and introduce the words, "as hereinbefore described," this will render an examination of the previous description necessary, in order to ascertain what the invention really is. In drawing the claims in a specification which refers to a machine or apparatus, consisting of many old and new parts, it is desirable to introduce a general claim to the entire machine as a combination, and then separate claims to the new parts. An observance of this rule will be attended with useful results, in case there should arise any necessity to disclaim part of the invention. *Cottenham, L. C.*, said in *Kay* v. *Marshall* (W. P. C. 2. 39), "The claim is not intended to aid the description, but to ascertain the extent of what is claimed as new. It is not to be looked to as the means of making a machine according to the patentee's improvements. If, therefore, the specification containing the descrip-

tion be sufficiently precise, it cannot be of any consequence that expressions are used in the claim which would be too general if they proposed to be part of the description." See also *Lister* v. *Leather* (3 Jur. N.S. 811; *S. C.* in error, 8 E. & B. 1004).

On the other hand, where the description in a specification was in the first instance too general, but the inventor afterwards in describing his invention referred to certain figures in drawings annexed to the specification, and the claim was for the invention *described with reference to those figures* the specification was held sufficient. (*Daw* v. *Eley*, 14 W. R. 126.) See also *Russell* v. *Cowley* (W. P. C. 1. 465).

The following decisions have reference to the interpretation of "claims:"—*Palmer* v. *Wagstaff* (9 Exch. 494); *Macalpine* v. *Manynall* (3 C. B. 496); *Templeton* v. *Macfarlane* (1 H. L. C. 595); *Sellers* v. *Dickinson* (5 Exch. 312); *Seed* v. *Higgins* (8 H. L. C. 550); *Thomas* v. *Foxwell* (6 Jur. N.S. 271).

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The address of *Mr. Baron Alderson* to the jury, on the trial of the case of *Morgan* v. *Seaward* (W. P. C. 1. 170), touches on so many of the preceding points, and is so full of instruction, that we shall place a large part of it before the reader.

"Has Mr. Galloway (the patentee) sufficiently described the steam engine so as to enable any one to know what he has invented, and so as to enable a workman of competent skill to carry the invention into effect? *Mr. Justice Buller*, in the case of *The King* v. *Arkwright*, lays down as the criterion, that a man, to entitle himself to the benefit of a patent of monopoly, must disclose his secret and specify his invention

in such a way, that others of the same trade, who are artists, may be taught to do the same thing for which the patent is granted, by following the directions of the specification, without any new invention or addition of their own. That is reasonable and proper; for people in trade ought to be told the manner in which the thing may be done in respect of which the patent is granted. How? Not by themselves becoming inventors of a method of carrying it into effect, but by following the specification, without making a new invention or making any addition to the specification. If the invention can only be carried into effect by persons setting themselves a problem to solve, then they who solve the problem become the inventors of the method of solving it; and he who leaves persons to carry out his invention by means of that application of their understanding, does not teach them in his specification that which, in order to entitle him to maintain his patent, he should teach them—the way of doing the thing—but sets them a problem which, being suggested to persons of skill, they may be able to solve. That is not the way in which a specification ought to be framed. It ought to be framed so as not to call on a person to have recourse to more than those ordinary means of knowledge—not invention—which a workman of competent skill in his art and trade may be presumed to have. You may call upon him to exercise all the actual existing knowledge common to the trade, but you cannot call upon him to exercise anything more. You have no right to call upon him to tax his ingenuity or invention. Those are the criteria by which you ought to be governed; and you should apply them without prejudice either one way or the other;.

for both parties stand, so far as this objection is concerned, on a footing of perfect equality. The public, on the one hand, have a right to expect that the specification shall be fair, honest, open, and sufficient; and, on the other hand, the patentee should not be tripped up by captious objections which do not go to the merits of the specification. Now, applying those criteria to the evidence in the cause, if you shall think that this invention has been so specified that any competent engineer, having the ordinary knowledge which competent engineers possess, could carry it into effect by the application of his skill, and the use of his previous knowledge, without any inventions on his part, and that he could do it in the manner described in the specification, and from the information disclosed in the specification, then the specification would be sufficient. If, on the other hand, you think that engineers of ordinary and competent skill would have to set themselves a problem to solve, and would have to solve that problem before they could do it, then the specification would be bad.

"Further, if a patentee is acquainted with any particular mode by which his invention may be most conveniently carried into effect, he ought to state it in his specification. . . . The specification must not merely suggest something that will set the mind of an ingenious man at work, but it must actually and plainly set forth what the invention is, and how it is to be carried into effect, so as to save a party the trouble of making experiments and trials. The Court, in the case of *The King* v. *Wheeler*, said that a specification that casts upon the public the expense and labour of experiments and trials is undoubtedly bad. Here, in

this case, the defendants take that line of argument: they say that experiments and trials are necessary. If it be said that all these matters will be well or easily known to a person of competent skill (and to such only the patentee may be allowed to address himself), then the invention will not in reality have given any useful or valuable information to the public.

"Now let us apply the principle of that case to the present, and see whether or not the patentee here has given that full information by the specification and drawing which, being addressed to persons of competent skill and knowledge, would enable them, from that specification and drawing, to carry the invention into effect. On that subject there is, undoubtedly, contradictory evidence; but you see a specification is addressed to all the world, and therefore all the world —at least those possessed of a competent skill—ought to be able to construct the machine by following that specification. It is not fair to you or to me, if we be less inventive than our neighbours, that we should be prevented from constructing these machines by reason of the specification not giving a clear exposition of the way in which it is to be done. In the case of the steam-engine, there was put in on the part of the defendants a model, made, it was said, according to the specification, which model would not work. The model was a copy of the drawing, and would not work because one part happened to be a little too small, whereas if it had been a little larger it would have worked. Now, a workman of ordinary skill, when told to put two things together so that they should move, would, of course, by the ordinary skill and knowledge he possesses, make them of sufficient size to move.

Then he would have to bring to his assistance his knowledge that the size of the parts is material to the working of the machine. That is within the ordinary knowledge of every workman. He says—'I see this will not work because it is too small;' and then he makes it a little larger, and finds it will work. What is required is, that the specification should be such as to enable a workman of ordinary skill to make the machine. With respect to that, therefore, I do not apprehend you will feel much difficulty, but with respect to the other there is a good deal more difficulty."

The second invention to which the learned judge proceeded to refer consisted, so far as it is now necessary to notice, in an improvement on paddle-wheels for propelling vessels, whereby, it was said, the float-boards or paddles would enter and come out of the water at positions the best adapted for giving full effect to the power applied. Connecting-rods were attached at one of their ends to the bent stems of the float-boards, and at the other to the disc. "The only observation" (continued the judge) "is, that he gives no dimensions. He fixes no points either for the centre of the eccentric or for the crank to which the eccentric centre is attached. Therefore, if those can only be ascertained by experiments subsequently to be made, then the specification is bad. The whole, in some degree, turns upon the length of the rods and the position of the centre of the eccentric. . . . Now, you cannot treat the actual picture which is given in the drawing as any guide to the particular angle or to the particular position of the eccentric; and for this simple reason—if that were the criterion, then the substance of the invention would be the particular angle

contained in the particular drawing: and in order to show an infringement, they ought to have shown that Mr. Seaward's wheel entered the water at the same angle as the angle described by the drawing; and, therefore, in that case, you would be bound to find the first issue for the defendant, viz. that there was an infringement. If, however, you treat the drawing as only an illustration of the invention, and not as confining the invention to the particular angle there described, then you ought to find in the specification some directions which should enable you to construct the machine in a new form; or you ought to be satisfied that without any instructions a workman of ordinary and competent skill and knowledge would be able to do it. Mr. Brunel says, 'I have read the specification, and I think I could construct by it a machine at any required angle without difficulty.' But whether Mr. Brunel could do it or not is not the point. I dare say, Mr. Brunel, the inventor of the block machinery, could invent anything of the sort the moment it was suggested to him; but that is not the criterion. The question is, whether a man of ordinary knowledge and skill, bringing that ordinary knowledge and skill to bear upon the subject, would be able to do it. The evidence of Mr. Park is much more material. He says, 'I could, without any difficulty, make the machine so that the paddles could enter the water at any angle.' He prepared the models which have been used. Now the criterion is, whether at the time the specification was introduced into the world Mr. Park would have been able to construct the machine with his ordinary skill and knowledge, without the peculiar knowledge he has since obtained upon the subject, from being

employed to make the models for Mr. Morgan; because it would not be at all fair to allow your verdict to be influenced by knowledge so acquired. But he says, with his ordinary knowledge and skill he could, without difficulty, construct a wheel so that the paddles should enter the water at any angle. He says, if the diameter of the wheel is given, which it is fair should be given, and the immersion of the float, and that is also fair to be given, he could do it. Those are reasonable data for him to require; and if with his ordinary skill and knowledge, and without that peculiar knowledge which he has obtained in consequence of his connection with the plaintiff and with his cause, he could do it, that would be evidence on which you would be entitled to place reliance. Then he tells you how he could do it. Now, I do think it would have been a vast deal better if the specification had given us the same information, for that is what a specification ought to do.

"The specification ought to contain a full description of the way in which it is to be done. The question really is, whether, upon the whole evidence, you are of opinion that the specification does fairly and fully and properly give to the public that information which the public are entitled to receive, that is to say, whether it tells them, without having recourse to experiments, how to do it, or whether it even tells them what is the course their experiments ought to take—to what point their examinations and experiments should be directed. He says he could do it with the skill he possesses; and he has described the manner in which he proposes to do it. He says, 'I have seen this drawing.' Then he produces a drawing, and he

says, 'This represents my plan of drawing it. An engineer of competent skill would have no difficulty in doing it.' His doing it himself I do not consider so material; but he says any engineer of competent skill would have no difficulty in doing it. That is material.

"Then when that drawing was shown, some of the gentlemen appearing on behalf of the defendants drew an angle upon it as the angle of entering, and asked him how that could be done. No doubt his principle would enable him to work out any angle; but there is a set of angles which would cause the centre of the eccentric to go beyond the wheel itself, which, therefore, it is impossible to carry into effect; but those angles are such as would not be required in ordinary practice by any persons. You should discard on both sides all exaggerated cases, and look to the substance of the thing. If you think in substance that the information really communicated would be enough in all ordinary cases, or in such cases as are likely to occur, then that would do; but if it is not a clear statement, and if it does not give such information as will render it unnecessary for parties to make experiments, then the specification would, in that respect, be insufficient. It is most important that patentees should be taught that they are bound to set out fully and fairly what their invention is; for, suppose a person were to make an invention, and get a right of making it for fourteen years, to the exclusion of all other persons, it would be a very great hardship upon the public if he were allowed to state his specification in such a way that, at the expiration of the term of his patent, he might laugh at the public, and say, 'I have

had the benefit of my patent for fourteen years, but you, the public, shall not now carry my invention into effect, for I have not shown you how it is to be done; I have got my secret, and I will keep it.' . . . Mr. Morgan, in practice, makes his rods of different lengths; and he must necessarily do that in order that the floats may follow at the same angle as the driving float enters the water. If so, he should have said in his specification, 'I make my rods of different lengths, in order that the rest of my floats may enter at the same angle; and the way to do that is so and so.' Or he might have said, 'It may be determined so and so.' But the specification is totally silent on the subject. Therefore, a person reading the specification would never dream that the other floats must be governed by rods of unequalled length; the least of all could he ascertain what their lengths should be until he had made experiments. Therefore it is contended that the specification does not state, as it should have stated, the proper manner of doing it. He says, 'If they are made of equal lengths, though the governing rod would be vertical at the time of entering, and three would be so when they arrived at the same spot, yet the fourth would not come vertical at the proper point, nor would the fifth, sixth, or seventh.' Then they would not accomplish that advantage which professes to be acquired. The patentee ought to state in his specification the precise way of doing it. If it cannot be completely done by following the specification, then a person will not infringe the patent by doing it. If this were an infringement, it would be an infringement to do that perfectly which, according to the specification, requires something else to be done to make it perfect.

If that be correct, you would prevent a man from having a perfect engine. He says, 'Practically speaking, the difference in the length of the rods would not be very material, the difference being small.' But the whole question is small, therefore it ought to have been specified; and if it could not be ascertained, it should have been so stated. Now, this is the part to which I was referring when I cited the case before *Lord Mansfield*, on the subject of the introduction of tallow, to enable the machine to work more smoothly. There it was held that the use of the tallow ought to have been stated in the specification. This small adjustment of these different lengths may have been made for the purpose of making the machine work more smoothly; if so, it is just as much necessary that it should have been so stated in the specification, as it was that tallow should have been mentioned. The true criterion is this: has the specification substantially complied with that which the public has a right to require? Has the patentee communicated to the public the manner of carrying his invention into effect? If he has, and if he has given to the public all the knowledge he had himself, he has done that which he ought to have done, and which the public has a right to require from him. . . .

"The question on this part of the case resolves itself into this: Do the witnesses on the plaintiff's side satisfy you that the patentee has, in his specification, given to the public the means of making a machine which shall enter and leave the water at any angle that may be ordered; that is, if a man ordered a machine at an angle likely to be required for entering and going out, and to be vertical at the bottom, could an ordinary

workman, with competent skill, execute that order by following the directions given in this specification? If you think he could, then the specification would be sufficient. If, on the other hand, you think he would not be able to execute the order unless he sat down and taxed his invention to find out a method of doing that which has not been sufficiently described in the specification, then the specification would be bad."

# CHAPTER VII.

## THE LETTERS PATENT: THEIR DURATION AND EXTENT.

The form in which letters patent are usually issued is given in the Appendix to this volume. On reference thereto, it will be seen that the Crown, with a superabundance of words and formality, grants unto A.B., his executors, administrators, and assigns, especial licence, full power, sole privilege and authority, that he, the said A.B., his executors, &c., from time to time, and at all times thereafter during the term of years thereinafter expressed (viz. fourteen years), shall and lawfully may make, use, exercise, and vend his invention within the United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, in such manner as to the said A.B., his executors, &c., shall in his or their discretion seem meet; and that the said A.B., his executors, &c., shall have and enjoy the whole profit, benefit, commodity, and advantage from time to time coming, growing, accruing, and arising by reason of the said invention, for and during the term of years therein mentioned. Then "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," are strictly commanded not to infringe the patent. It is, however, provided that, if it shall be made to appear to the

Crown or the Privy Council that the grant is contrary to law, or prejudicial or inconvenient to the subjects of the realm in general, or that the invention is not a new invention as to the public use and exercise thereof within the United Kingdom, etc., or that the said A. B. is not the first and true inventor thereof within the realm, the patent shall be void.

There are also other provisoes, the two most important of which are—firstly, that declaring the grant to be void if the said A. B., his executors or administrators, shall not particularly describe and ascertain the nature of the invention, and in what manner the same is to be performed, by an instrument in writing (to wit, the specification), under his or their hands and seals, and cause the same to be filed in the Great Seal Patent Office within six calendar months next after the date of the letters patent*; and, secondly, that which declares the patent to become void at the expiration of three years or seven years, in case the stamp duty of £50 is not paid to the Commissioners of Patents before the expiration of the third year, and the stamp duty of £100 before the expiration of the seventh year.

The questions arising as to the novelty of the invention, and as to whether the patentee is the first and true inventor, have been considered in previous chapters, and those relating to the sufficiency of the specification have also been considered.

It has been recently decided by the Court of Queen's Bench in the important case of *Feather* v. *The Queen*

* This proviso is modified to meet the case of a complete specification being filed, instead of a provisional specification, along with the petition and declaration. See the Form in the Appendix.

(Pract. Mech. Jour., vol. 9. 2nd Ser. 321), that letters patent in the form above mentioned are not valid as against the Crown, and that the Crown is entitled, notwithstanding the grant, to use the invention without the assent of the patentee.

The law officer has power, under the fifteenth section of the Patent Law Amendment Act, 1852, to direct all such restrictions, conditions, and provisoes, as he may deem usual and expedient or necessary, in pursuance of the provisions of the Act, to be inserted in the letters patent. Moreover, under the sixteenth section of the same Act, the Crown has power, by warrant under the sign-manual, to direct the law officer to withhold his warrant, or to direct that any letters patent for the issuing whereof he may have issued a warrant shall not issue, or to direct the insertion in any letters patent of any restrictions, conditions, or provisoes which the Crown may think fit, in addition to or in substitution for any restrictions, conditions, or provisoes which would otherwise be inserted therein under the Act. Of course, these powers will only be exercised on very special occasions.

By the 22nd Vict. c. 13, the Secretary of State for War is empowered to acquire by purchase or gift, the benefit of any inventions of improvements in munitions of war, and of any letters patent obtained for the same, and to prevent the disclosure of such inventions. (See the statute at length in the Appendix.)

It is imperative that the patent should be issued during the continuance of the provisional protection, or the protection by reason of a deposit of a complete specification. The only exceptions allowed are—firstly, where the application to seal was made in due

time, and the sealing was delayed by reason of the delivery of notice of objection, or an application to the Lord Chancellor in relation to the sealing of the patent (15 & 16 Vict. c. 83, s. 20); secondly, where the delay in sealing has arisen from accident, and not from the wilful neglect or default of the applicant (16 & 17 Vict. c. 115, s. 6). The Chancellor, in either case, may extend the time for sealing, but not for longer than a month. The practice upon applications to extend the time is governed by the Chancellor's rule of the 17th July, 1854—for which see the Appendix.

In the case of the applicant dying during the continuance of protection, whether under a provisional or complete specification, the patent may be issued to the executors or administrators during the continuance of such provisional or other protection, or at any time within three months after the death of the applicant (15 & 16 Vict. c. 83, s. 21). In this case a petition is presented to the Lord Chancellor, setting forth the facts, and requesting his order that the letters patent may issue to the executors or administrators. The petition must be supported by an affidavit verifying its allegations, and the probate or letters of administration must be produced.

Letters patent are usually dated as of the day of the application for the same; but the Lord Chancellor, or the law officer, has power to cause them to bear date as of the day of the sealing, or of any other day between the day of the application or provisional registration, and the day of the sealing (15 & 16 Vict. c. 83, s. 23). The term for which patents may be granted is limited, by the statute of James, to fourteen years, and it is usual to make the grant for

the whole of this term. The time runs from the day of the date of the patent, including that day; for instance, a patent for fourteen years, dated 26th February, 1825, was held to expire at twelve o'clock on the night of the 25th February, 1839 (*Russell* v. *Ledsam*, 14 M. & W. 574). In case clerical errors should have been made in letters patent, the Court of Chancery has power to correct them. (*Re Nickels' Patent*, 4 Bea. 563.)

The Patent Law Amendment Act, 1852, introduced new regulations as to the payment of fees and stamp-duties in respect of letters patent; and instead of retaining the old plan of making the whole expenses payable at the time of taking out the patent, the burden of them is now postponed to the eve of the expiration of the third and the seventh year after the date of the patent. This is a convenient arrangement for patentees, who, in place of paying a heavy sum for what may turn out an unremunerating invention, have now an opportunity of practically testing its commercial value before the heaviest part of the expense is incurred. In order to insure payment of the postponed sums, the statute 16 Vict. c. 5, s. 2, enacts that all letters patent shall be made subject to the condition that the same shall be void at the expiration of three years and seven years, respectively, from the date thereof, unless there be paid, before the expiration of the said periods, the stamp-duties mentioned in the schedule of the Act; and we have seen accordingly that such a clause is inserted in letters patent.

It is a sufficient compliance with the statute if the duty is paid on the third anniversary of the date. Thus, where letters patent were dated on the 26th February, 1855, and the three years' stamp-duty was paid on the

26th of February, 1858, it was held to have been paid in due time. (*Williams* v. *Nash*, 28 Beav. 93.)

With regard to letters patent, obtained in the United Kingdom, for foreign inventions patented abroad, the 25th section of the Act of 1852 declares that they shall expire (whatever may be the term limited in such letters patent) at the expiration of the term during which the patent obtained abroad shall continue in force, or in case of several foreign patents at the expiration of the first.

It was formerly the practice to issue separate letters patent for the three kingdoms, upon three separate applications of the inventor; but now, by the Act of 1852, it is provided that letters patent shall extend to the whole of Great Britain and Ireland, the Channel Islands, and the Isle of Man; and, in case the Queen's warrant shall so direct, such letters patent shall be made applicable to our colonies, or such of them as shall be mentioned in the warrant. The letters patent thus granted are declared to be as valid and effectual throughout all the territories just mentioned, as the letters patent formerly granted were separately valid in the three kingdoms respectively.

The Commissioners of Patents have, for some time past, refused to extend the grants to the colonies; and our colonies are now gradually acquiring patent laws of their own.

In case of the destruction or loss of letters patent, others of the like tenor and effect, and sealed and dated the same day, may be issued under the authority of the warrant, in pursuance of which the original letters patent were issued (15 & 16 Vict. c. 83, s. 22). The practice is to present a petition to the Lord

Chancellor, setting forth the facts, accompanied by an affidavit in support. The duplicate letters patent are impressed with a stamp of £5.

As to the mode of applying for a prolongation of letters patent, and the principles which guide the Privy Council in deciding upon the application, we must refer the reader to a subsequent chapter.

# CHAPTER VIII.

## DISCLAIMERS.

It has been already shown that a patent which includes two inventions, of which one is not new or not useful, is altogether invalid; and that if the patent is confined to a single invention, any material part of which has either of these defects, the patent is likewise invalid. The fatal effect of an inconsistency between the title and the specification has also been pointed out. To remedy a law which in very many cases bore unjustly upon patentees, a clause was introduced into the Act 5 & 6 Wm. IV. c. 83, by which a patentee is empowered (by leave of the Attorney or Solicitor General, in case of an English patent; or of the Lord Advocate or the Solicitor-General for Scotland, in case of a Scotch patent; or of the Attorney or Solicitor General for Ireland, in case of an Irish patent, certified by his fiat and signature), to enter a disclaimer of either the title of the invention or of the specification, stating the reason for such disclaimer; or with the like leave to enter a memorandum of any alteration in the title or specification (not being such disclaimer or alteration as shall extend the exclusive right granted by the said letters patent); and such disclaimer or memorandum being filed with the specification, is then to be deemed part of the letters patent, or of the specification, in all

courts. It is, however, expressly provided that the disclaimer, or memorandum of alteration, shall not be receivable in evidence in any action or suit pending at the time it was filed, except in a proceeding by *scire facias*.

The effect of this clause has been to check the bringing of the action of *scire facias* to repeal patents, except where the vice complained of goes to the essence of the invention, and to every part of it. The patentee being enabled not only to amend the title and specification by disclaimer, but to put his disclaimer in evidence at the trial, it may be that the prosecutor's case will be altogether cut away from him. In such event he may be called upon to pay the patentee's costs, the payment of such costs being the condition of the bond given by him at the commencement of the suit, in case the patent shall not be cancelled by means of the writ of *scire facias*, or proceedings thereunder. Leave to put the bond in suit must, however, be first obtained from the Master of the Rolls or the Attorney-General; and neither functionary is likely to grant such leave, when the prosecutor stayed his proceedings as soon as he received notice of the disclaimer by which the invalidity of a patent was cured. See what fell from the judges in *The Queen* v. *Mill* (10 C. B. 379.)

It might have been considered as authoritatively decided, prior to the passing of the Patent Law Amendment Act, 1852—1st, That a disclaimer could be given in evidence in an action brought for an infringement committed previous to the filing of the disclaimer; that is to say, at a time when the patent was invalid, when the action was commenced after the filing. And, 2nd, that a disclaimer might be given in evidence in a pro-

ceeding by *scire facias*, whether it was filed before or after the issue of the writ. However, as two courts of equivalent authority had given adverse decisions upon one of these questions, the legislature thought proper to interpose. By the 39th section of the Patent Law Amendment Act, 1852, the provisions of the 5 & 6 Wm. IV. c. 83, and of 7 & 8 Vict. c. 69, as to disclaimers and memoranda of alteration, are directed to apply to patents under that Act. The same section declares that no action shall be brought upon any letters patent which, or the specification of which, has been altered by disclaimer or memorandum, in respect of any infringement committed prior to the filing of the disclaimer or memorandum, without the express permission of the law officer. It is further declared, that the filing of any disclaimer or memorandum of alteration, in pursuance of the law officer's leave, shall, except in cases of fraud, be conclusive as to the right of the party to enter such disclaimer and memorandum.

The judges of the Court of Queen's Bench having decided, in the case of *Holmes* v. *London and North-Western Railway Company*, that a patent for an improved turn-table for railway purposes was invalid, because the patentee had not limited his claims to the combination of the parts of the machine, but had described, and was therefore considered to have claimed, the several parts, some of which were old, the assignee of the patent applied to the Solicitor-General for leave to enter a disclaimer of the separate parts of the turn-table, so as to confine the claim of invention to the combination of parts forming the whole apparatus. The Solicitor-General (1853), after hearing counsel in opposition, as well as for the applicant, granted the leave

sought for, upon the terms of the applicant undertaking not to bring or prosecute any action or suit against certain parties, in respect of any turn-tables made or used by them before the date of the disclaimer. (Macr. P. C. 31.) See also, in the matter of *Smith's patent* (Macr. P. C. 232).

The principle of the above cases has lately received considerable extension in *Re Medlock's patent*, the facts of which are stated in an article in Newton's Lond. Jour. vol. 22, N. S. 69. This was an application for leave to enter a disclaimer of a patent for preparing a red or purple dye by treating aniline with dry arsenic acid. The patent had been the subject of considerable litigation, which had resulted in its being declared invalid on the ground that two alternative processes were described in the specification, of which confessedly only one would answer (see *Simpson* v. *Holliday*, 13 W. R. 577, cited *ante*, p. 125). The present application was opposed by several chemical manufacturers, several of whom had been defendants in the various suits instituted by the owners of the patent. After hearing counsel on both sides, *Collier, S. G.*, granted the leave sought for, but only on the terms that the applicants should bring no action against the opposers "for any infringement of the patent by the use or continued use, *during the continuance of the patent*, of any processes for manufacturing red and purple dyes *in use by them at the present time*." The applicants refused to accept this condition, and the Solicitor-General consequently disallowed the disclaimer.

The law officer, however, will not always insist upon the patentee giving an undertaking of this nature. He may think it right that the past infringement of the

patent should be paid for. (*Re Lucas's Patent*, Macr. P. C. 234.)

In the matter of *Bateman and Moore's patent* (Macr. P. C. 116), an application was made (1854) to *Bethell, S. G.*, for leave to alter the specification, so as to make it disclaim all the parts of the invention, and claim only the combination. The Solicitor-General said, that he should require to see from the specification itself that it had not been intended to claim the separate parts, but their combination only. Finding some indication of an intention to claim the apparatus as a whole, he gave the patentees permission to reject certain words in the claiming part of the specification which were inconsistent with such a construction. When some distinct and separate part of the invention is clearly old or useless, then there is no difficulty in excising it from the specification by a disclaimer. But where this is not the case, the entry of a disclaimer before a trial at law is a matter of doubtful policy. In the reported cases of the allowance of disclaimers, trials at law had previously taken place, wherein the difficulties and objections to be obviated had been pointed out.

Every disclaimer which will have the effect of extending the exclusive right granted by the patent will be void by the language of the Act. For example, if the specification showed that the parts were claimed, and not their combination, then a disclaimer which sought to reject the parts, and to insert a claim for the combination alone, would be bad, inasmuch as this would be an attempt to extend the original privileges of the patent. The operation of a disclaimer was considered in the case of *Seed* v. *Higgins* (8 E. & B. 755). The

patentee described in his specification, and illustrated by drawings, some machinery for preparing cotton, and after saying that the apparatus so described represented one particular and practicable mode of carrying out the invention he proceeded to state that he did not intend to confine himself to this particular method, but claimed as his invention the application of the law or principle of centrifugal force for a certain purpose. He afterwards disclaimed his claim to the application of the law or principle, except only the application of centrifugal force acting in a certain manner as described in the specification. This was held to be a limitation of his claim to the particular apparatus described, whereby the principle was applied in a certain way, and afforded no ground for contending that the disclaimer described a different invention from that described in the specification. This view was also taken on appeal by the Court of Exchequer Chamber (8 E. & B. 771) and by the House of Lords (8 H. L. C. 550). But in the case of *Ralston* v. *Smith* (11 C. B. N. S. 471) it was decided by the Court of Exchequer Chamber, and afterwards by the House of Lords (13 L. T. N. S. 1), that a disclaimer is bad which is in effect an attempt to turn a specification for an impracticable generality into a grant for a specific process, comprised within the generality in one sense, but not to be discovered there without going through the same course of experiment which led to the discovery of the specific process in the disclaimer.

By the fifth section of the 7 and 8 Vict. c. 69, the right to enter a disclaimer or to amend is given to an assignee who has acquired the whole interest in the patent. When the patentee has assigned part of his

interest only, the patentee and assignee must join in making any disclaimer or alteration.

Under the language of that part of the section which enacts that "no objection shall be made, in any proceeding whatsoever, on the ground that the party making such disclaimer or memorandum of alteration had not such authority in that behalf," it was held that the disclaimer of a patentee who had assigned all his interest in the patent could not be objected to (*Wallington* v. *Dale*, 7 Exch., 888). Mere clerical errors may be amended by the order of the Lord Chancellor or Master of the Rolls without the necessity of filing a memorandum of alteration (*Re Sharp's Patent*, 3 Beav. 245; *Re Redmund*, 5 Russ. 44; *Re Rubery's Patent*, W. P. C. 1. 649; *Re Dismore*, 18 Beav. 538).

The M. R. refused to cancel a memorandum of alteration made under 5 and 6 Wm. IV. c. 83, when application was made to him for that purpose, on the ground that it extended the patentee's privilege, and infringed the petitioner's patent rights, for he held he had no jurisdiction (*Re Sharp's Patent*, 3 Beav. 245).

The application for leave to enter a disclaimer or memorandum of alteration, with respect to patents granted subsequent to the Amendment Act of 1852, must be made at the Patent Commissioners' Office, and it is then referred to the proper law officer. The petition must be impressed with the stamp of £5. Persons having adverse interests may lodge caveats (requiring a £2 stamp) at the office, and they are then entitled to notice when the application is heard by the law officer. Leave having been obtained, and the law officer's fiat issued, the disclaimer or memorandum of alteration is simply filed at the office, no enrolling being now required.

There appears to be no appeal from the decision of the law officer granting or refusing leave to file a disclaimer. In the case of *Medlock's patent* cited above (p. 154) the owners of the patent, after the Solicitor-General had refused his fiat, presented a petition to the Commissioners of Patents, submitting that the law officer having once granted his fiat it could not be recalled, and praying that the disclaimer and fiat might be filed, so that the validity of the conditions imposed might be tried in a court of law, or that the disclaimer might be referred to the Commissioners of Patents, or that the Commissioners would require a fuller statement of the case, and that the petitioners might be heard before them. The petition was, however, returned, endorsed with the word "refused." (Newton's Lond. Jour., vol. 22. N. S. 70, 71.)

# CHAPTER IX.

## CONFIRMATION OF LETTERS PATENT.

It sometimes happens that a patentee, who, when he applied for his letters patent, believed himself to be the first and original inventor of that for which he obtained the patent, afterwards discovers that some other person had invented or used the same invention, or part thereof, before the date of his patent, although it had not been publicly and generally used. Previous to the passing of the 5 & 6 Wm. IV. c. 83, such a patentee was in an unfortunate position, for his patent was altogether invalid. But the second section of that Act enacts, that if in any suit or action it shall be proved, or specially found by the jury, that any patentee was not the first inventor of the invention patented, or of some part thereof, by reason of some other person having invented or used the same before the date of the patent, or if such patentee or his assigns shall discover that some other person had, unknown to such patentee, so invented or used the same, it shall be lawful for such patentee or his assigns to petition the Queen in Council to confirm his patent, or to grant a new patent; and the Judicial Committee of the Privy Council 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 the patent, may report to the Queen their opinion that the prayer of the petition ought to be complied with, whereupon the Queen may, if she think fit, grant such prayer. The provisions of this Act are made applicable to the patents granted under the Patent Law Amendment Act, 1852 (see sect. 40.)

If the petitioner knows the name of the person whose previous use of the patented invention had invalidated it, the name must be mentioned in the petition; and if his name is unknown, the fact must be stated. (*Re Lamenaude's Patent*, W. P. C. 2. 164.) The Act provides that any person opposing such petition is entitled to be heard before the Judicial Committee; and that any person, party to any former suit or action touching such letters patent, is entitled to have notice of such petition before it is presented. The Committee requires some evidence of the patentee's belief, that at the time he applied for the patent he was the first inventor (*Re Card's Patent*, W. P. C. 2. 1 1).

The words of the statute are very general, but a discretion is clearly given to the Judicial Committee by the language of the Act; and the following cases will show the principles upon which they have proceeded in their decisions :—

In *Hanibal's case* it was said that the jurisdiction to confirm letters patent should be very cautiously and sparingly exercised (9 Moore, P. C. C. 452).

Previous to the Patent Law Amendment Act, 1852, it was the practice to issue separate letters patent for the three kingdoms; and it was decided by the House of Lords, in the case of *Brown* v. *Annandale* (W. P. C. 1. 433), that the public use of an invention in England

rendered invalid a patent subsequently obtained for the same invention in Scotland. One Robinson, after obtaining a patent in England, obtained one for the same invention in Scotland, and then assigned the patents to one Pow, who, finding that, according to the decision of *Brown* v. *Annandale*, the latter patent was invalid, he petitioned the Privy Council for a confirmation. It was held, however, that the case did not fall within the terms of the Act, since the petitioner could not allege that "some other person" had used the same invention before the date of the Scotch patent, the user in question having been the patentee's or his assignee's. (*Pow's Patent*, W. P. C. 2. 5.)

Baron Heurteloup obtained a patent in 1834 for certain improvements in fire-arms. He subsequently discovered that part of his invention had been embraced by a patent granted in France in 1821, and that there existed a printed book in the British Museum containing a description of the French invention. The petitioner's affidavit, in support of his petition to the Privy Council, stated, that he believed himself to be, at the time of the grant, the true and first inventor of the patented improvements; and further, that he believed the French invention had never been brought into use in France or elsewhere, and that it was not known in England, otherwise than by the introduction of books printed in France, containing a description of the invention. Notice of the day of hearing had been sent through the post-office, addressed to the French patentee. Under these circumstances, their lordships reported that the case was a proper one for confirmation. (*Heurteloup's Patent*, W. P. C. 1. 553.)

There are other cases which show that the Privy

Council will not grant a confirmation where the previous user of the invention, which is alleged to invalidate a patent, and to call for the aid of the statute, continues up to the date of the patent. In order to afford ground for the interposition of the Crown, acting on the recommendation of the Privy Council, it must be shown that the previous user was not only not general, but that it had ceased, and was non-existent at the date of the patent, in which case a confirmation does injury to no one. On an application to confirm *Card's Patent* for improvements in the manufacture of candle-wicks (W. P. C. 2. 161), it appeared that another candlemaker had adopted the same method of making wicks before the date of the patent, and that he and his brother had practised it in different parts of the same country. It appeared, moreover, that one of them, and the assignees of the other, had continued to make wicks in that way up to the time of the hearing of the petition. The method had been mentioned by them to other people, and there was ground for supposing that another candlemaker had adopted it. The Judicial Committee considered that this was not such a case as the legislature had in contemplation when they passed the Act, and they refused the application.

Lamenaude obtained a patent on the 18th of July, 1848, for an invention of a method of fixing letters upon glass without wire or iron. It turned out, that somewhere between the 12th and 15th of the same month of July, some letters had been fixed upon glass by this very method by another person. This was sufficient to vitiate the patent, and an application was made to the Privy Council for a confirmation. It was argued that, although the invention had been publicly

used, it had not been generally used previous to the date of the patent, and it was proved that the person who had so used it was a consenting party to the application; but it was held that the statute did not apply to such a case as this, where the invention had already got into use, and was actually in use at the date of the patent. (*Lamenaude's Patent*, W. P. C. 2. 164.)

The Act was held not to apply to a case in which it was proved that two patents had been previously procured for substantially the same invention as that covered by the patent which it was sought to confirm, although the previous patents had expired. (*Westrupp and Gibbin's Patent*, W. P. C. 1. 554.)

Application was made for the confirmation of a patent granted in 1838 to Mr. Porter, for an improvement in the construction of anchors. It appeared that, after obtaining the patent, Mr. Porter had called on several anchorsmiths in various parts of the country, for the purpose of introducing his invention to their notice; and that when he called upon Messrs. Logan of Liverpool, they directed his attention to an anchor which they had invented in 1826. The construction of their anchor was similar to that of Porter's, and they had sold a few of that make to various shipowners. Notwithstanding this, Porter continued to work his patent, and when it was about to expire, he applied for and obtained an extension for six years. An alleged infringement having taken place, an action was brought by Porter's assignee, and on the trial the facts as to Logan's anchor came out. Porter's assignee then applied to the Privy Council for a confirmation of the extended patent; but it was held, that as the evidence

showed that not only Porter was not the original inventor, but that he was aware of the fact at the time he applied for an extension, this was not a proper case for the Crown to grant a confirmation, and the application was refused. "It is not easy," said *Mr. Pemberton Leigh*, on giving judgment, "to define the exact meaning of the expression, 'publicly and generally used' in the Act of Parliament. Their lordships would not consider the use of the invention on board a single ship, however public, or for whatever length of time, as a general user. They were satisfied that the invention had not been publicly used at the date of the original letters patent. Although Porter believed himself to have been the original inventor at the time when the original patent was taken out, it was clear that he could not think so at the time of the extension. Seeing that he was not the original inventor, the patent ought never to have been granted, and the prayer for extension should not have been listened to." (*Honibull's Patent*, 3 Eq. Rep. 225; *S. C.* W. P. C. 2. 201.)

# CHAPTER X.

## EXTENSION OR PROLONGATION OF LETTERS PATENT.

NOTWITHSTANDING the merit and utility of his invention, a patentee sometimes finds himself nearly at the expiration of the term for which his patent was granted, without having reaped the reward which he was fairly entitled to expect. This may have happened from various causes. To perfect the invention, to work it out, and to bring it before the public, may have been attended with great expenses, which were never repaid. It sometimes occurs that the public are slow to acknowledge the merit of an invention of real value, and the patentee's privilege is on the point of expiring before they can be brought to extend their patronage to it. It may be that the patentee's monopoly has been infringed, and that large costs have been incurred in enforcing or defending his just rights. Or it may be that the patentee did not himself possess the means, and was never fortunate enough to meet with a capitalist to advance what was necessary to work the invention. From some one of these causes, or from several of them combined, it not unfrequently occurs that a patentee fails to derive any benefit, even if he escapes loss, from an invention of sterling merit and utility. Previous to the passing of the statute 5 & 6 Wm. IV. c. 83, there was no mode of obtaining the extension of a patent privilege except an Act of Parliament, which was attended with considerable cost.

But a much less expensive mode was provided by the fourth section of that Act, namely, by petition to the Queen in Council; and her Majesty was empowered, after report from the Judicial Committee, to grant new letters patent, for a term not exceeding seven years after the expiration of the first term. In case the patentee believes that a further term of seven years will not suffice for his reimbursement and remuneration, then he may proceed, under the second section of the 7 & 8 Vict. c. 69, and apply for a longer period of extension, which cannot, however, exceed fourteen years. The benefit of these enactments is extended, by the fourth section of 7 & 8 Vict. c. 69, to the assignee of a patentee; and the provisions of these Acts, and of the Act 2 & 3 Vict. c. 67 (to be noticed hereafter), are extended to patents granted under the Patent Law Amendment Act, 1852, by the fortieth section of that Act, and the seventh section of 15 & 16 Vict. c. 115. An assignee is allowed to apply for an extension, but he does not stand altogether in the same favourable position as the patentee. It is chiefly with the view of rewarding the inventor that the extension of a patent is to be considered. If, however, the assignee be a person who has assisted the inventor with funds to enable him to perfect the invention and bring it into use, this will be looked at by the Privy Council as a favourable feature of a petitioning assignee's case, (*Norton's Patent*, 1 Moore, P. C. C. N. S. 339; *S. C.* 9 Jur. N. S. 419) in which case the petitioners, who were a public company, were refused a prolongation which they applied for after the death of the inventor. See also the case of *Napier's Patent* (13 Moore, P. C. C. 543).

The proceedings commence by the insertion of advertisements in the public prints, giving notice of the patentee's intention to apply for a prolongation of his patent, and a petition setting forth the facts must then be presented to her Majesty in Council. Any person is entitled to enter a caveat, and to be heard in opposition when the case is entered upon before the judicial committee of the Privy Council (*Lowe's Patent*, 8 Moore, P. C. C. 1).* Not more than two barristers will be heard on each side; that is to say, two in support of the applicant's case, and two in opposition. Where, however, more parties than one oppose, and they have separate and independent grounds of opposition, each will be allowed two counsel. All facts material to the petitioner's title must be stated in the petition. In one case when such facts were omitted the hearing was postponed, and the petition directed to be amended (*Hutchison's Patent*, 14 Moore, P. C. C. 364).

The petitioner must be prepared at the hearing with evidence to show that there is an invention; that the invention possesses utility and is a benefit to the public; and if his case is that he has never been reimbursed his expenses, he must give reasonable evidence of the amount of his loss. If, however, there is a balance of profit, but to an extent incommensurate with his fair expectations, he will be required to show what the real profit has been. The accounts must be clear, unreserved, and properly proved (*Re Hills' Patent*, 1 Moore, P. C. C. N. S. 258; *S. C.* 9 Jur. N. S. 1209). The profit, year by year, must be shown (*Perkin's Patent*, W. P. C. 2. 6). If books of account are not forthcoming,

*As to the right of an alien living abroad to be heard in opposition to a prolongation of Letters Patent, see *Schlumberger's Patent* (9 Moore, P. C. C. 1)

the petitioner will be required to explain their absence. (*Markwick's Patent*, 13 Moore, P. C. C. 310.) In taking an account of the profits and loss, the patentee is entitled to charge for loss of time in endeavouring to bring the invention into use. (*Newton's Patent*, 14 Moore, P. C. C. 156.) Law expenses incurred by the patentee in maintaining his rights are in general allowed in deduction of profits, but this will not be done when the patentee has compromised suits and given up costs to which he had an apparent title (*Hill's Patent*, 1 Moore, P. C. C. N. S. 258; *S. C.* 9 Jur. N. S. 1209). If the invention has not been brought into use, that circumstance which will be taken as a thing presumptive of inutility must be explained; and the petitioner must shew that the parties interested had done all in their power to bring the invention into public use (*Wright's Patent*, W. P. C. 1. 575; *Woodcroft's Patent*, W. P. C. 2. 29; *Markwick's Patent*, 13 Moore, P. C. C. 310).

It is open to those who oppose the patentee's application, to go into evidence for the purpose of showing that the invention is wanting in novelty, or that it is imperfect; and they may likewise point out defects in the specification.

The fact of improvements having been made by other persons in the patentee's invention after the date of his patent, does not afford any ground of opposition to an application for an extension, if the invention has a merit of its own, and if the patentee has not reaped a benefit in proportion to that merit (*Galloway's Patent*, W. P. C. 1. 727). Where a patent seems deserving of prolongation only in respect of one head of invention out of several, the prolongation will be granted solely with reference to that head (*Bodmer's Patent*,

8 Moore, P. C. C. 282; *Lee's Patent*, 10 Moore, P. C. C. 226).

Where the ground of opposition to a patentee's application is frivolous, costs have been awarded to him; on the other hand, costs of opposition have been given against a petitioner who abandoned his application (*Mackintosh's Patent*, W. P. C. 1. 739).

The second section of 2 & 3 Vict. c. 67, directs that the petition for an extension of letters patent shall be presented at least six calendar months before the expiration of the original term. If the petition shall not have been prosecuted with effect before the expiration of that term, from other causes than the neglect or default of the petitioner, the committee of the Privy Council is empowered to entertain the application, and to report thereon, although the original term may have expired before the hearing of the application. But sufficient reason must be shown to the satisfaction of the committee for the omission to prosecute with effect the application before the expiration of the original term. The new letters patent bear date the day after the expiration of the original term. If any one should use the invention in the interval between the expiration of the original term and the grant of the new patent, he is not liable for an infringement. Moreover, those who may have invested capital in working it during that interval may attend before the committee, and oppose the application, or prefer a claim to have their acts protected, and their expenditure made good (*Russell* v. *Ledsam*, 14 M. and W. 574).

If litigation, involving the question of the validity of the patent, should be going on at the time of the application for a prolongation, the committee will not go

into the question, but will assume the patent to be valid (*Betts' Patent*, 1 Moore, P. C. C. N. S. 49; *S. C.* 9 Jur. N. S. 137; Pract. Mech. Journ. 2nd ser. vol. 7, 270), unless the invalidity is beyond all reasonable doubt, in which case they will not grant an extension (*Woodcroft's Patent*, W. P. C. 2. 30; *Hills' Patent*, 1 Moore, P. C. C. N. S. 258; *S. C.* 9 Jur. N. S. 1209). If a competent tribunal should, after the grant of a new patent, decide that the original patent was invalid, the new patent will share its fate, and will be invalid likewise (*Kay's Patent*, W. P. C. 1. 571). On the hearing of the application to extend the term of *Honiball's Patent*, (3 Eq. Rep. 230; *S. C.* W. P. C. 2. 208), it was said that the grant of an extended term is to be considered as a new grant by new letters patent, subject to the same conditions, open to the same objections, and in ordinary cases entitled to the same advantages as the original grant. So that in point of fact, the extension decides nothing, one way or other, as to the validity of the patent. And therefore, where it is only a matter of doubt as to the validity of the patent,—as, for example, where the evidence is conflicting,—the extension will be granted, if there appear good grounds *aliunde* for that course. When it appeared that a patentee had agreed by deed with a public company to grant them an exclusive license, and also covenanted with them to obtain at the expiration of the term a prolongation of the patent for the same purpose, the application for a prolongation was refused by the Privy Council on the ground that the agreement was contrary to public policy, and repugnant to the spirit of the statute 5 & 6 Wm. IV. c. 83 (*Cardwell's Patent*, 10 Moore, P. C. C. 488).

Intentional delay for a prolonged period on the part of an inventor in attempting to bring his invention into use is a good reason for refusing to grant an extension (*Norton's Patent*, 1 Moore, P. C. C. N. S. 339; *S. C.* 9 Jur. N. S. 419).

In the case of a patent obtained for an invention imported from abroad, which invention had been patented in a foreign country, application was made to the Privy Council for an extension after the expiration of the foreign patent; but it was held that the application could not be entertained, inasmuch as an extension of the British patent would be invalid, by virtue of the twenty-fifth section of 15 & 16 Vict. c. 83, and the seventh section of 16 & 17 Vict. c. 113 (*Aube's Patent*, 9 Moore, P. C. C. 43).

The policy of these enactments is to prevent in the case of inventions made and patented in a foreign country the continuance of a monopoly in this country by virtue of any patent subsequently granted here beyond the time when the discovery shall have become public property in the foreign country, and this policy will guide the Judicial Committee in the exercise of their discretion even when the case does not fall strictly within the Act; as, for instance, when the patent sought to be prolonged was granted before the Act was passed, and a foreign patent, which would shortly expire, had been granted before the date of the English patent (*Hills' Patent*, 1 Moore, P. C. C. N. S. 258; *S. C.* 9 Jur. N. S. 1209).

But these sections do not apply to a patent first granted in the United Kingdom (*Re Betts' Patent*, 1 Moore, P. C. C. 49; *S. C.* 9 Jur. N. S. 137), except in those cases where the foreign patent is dated only a

short time after the British patent. To grant a prolongation in such cases would be acting contrary to the spirit of the Act (*Newton's Patent*, 14 Moore, P. C. C. 156; *S. C.* 9 Jur. N. S. 109).

Patentees applied for a prolongation of their patent, and obtained a recommendation from the Judicial Committee of the Privy Council, upon which an order was drawn up for a prolongation. A petition was afterwards presented to the Crown, seeking to revoke this order, and this being referred to the Judicial Committee, it was held that this committee has authority, under 3 & 4 Wm. IV. c. 4, s. 4, to entertain such a petition, and to recall the warrant for sealing the letters patent. The Crown can at any time before the great seal is affixed countermand the warrant for sealing, upon a proper case being made out (*Schlumberger's Patent*, 9 Moore, P. C. C. 1).

The jurisdiction conferred upon the Judicial Committee by the legislature is an extraordinary one, and is to be exercised, as remarked in the Council Chamber, only on the most special grounds alleged and proved in reference to each case. In coming to a decision, they seek to meet the justice of the case with regard to the adequacy or inadequacy of the patentee's remuneration. If he has met with loss, as the total result of his transactions under the patent, there is good *primâ facie* ground for an extension; but if a certain amount of profit has been derived from working the patent, a decision is less easily found. The main question, however, remains the same:—Has the patentee been adequately rewarded? It is obvious that the merit of the invention is now an element to be considered, since £100 may very well reward an invention of small utility,

whilst £1000 may be an inadequate payment for a discovery of great public benefit. The degree of inventive power may also very well be taken into consideration, and the more or less time and trouble expended by the inventor in making experiments, either previous to his discovery, or in testing it, or in carrying it out. It is not, however, to be assumed, that because the step in improvements taken by an inventor is small, his merit is likewise small, and his invention unimportant. A very small addition or alteration may have altogether escaped notice, until seized and turned to account by an acute mind, and its adoption may lead to most important consequences in the manufacture with which it is connected. The reward of such an invention ought not to be made proportionate to its apparent insignificance. Common justice dictates that the benefit an inventor has conferred on the public ought to be regarded; and the advisers of the Crown, acting under this idea, will give him the opportunity of reaping a recompense in some degree commensurate with the value of the result. In delivering judgment on an application to the Privy Council for an extension of *Soames' Patent* (W. P. C. 1. 729), *Lord Brougham* used these words:—"The whole history of science, from the greatest discoveries down to the most unimportant—from the discovery of the system of gravitation itself, and the fractional calculus itself, down to the most trifling step that has ever been made—is one continued illustration of the slow progress by which the human mind makes its advance in discovery. It is hardly perceptible, so little has been made by any one step in advance of the former state of things, because generally you find that just before there was

something very nearly the same discovered or invented." His lordship proceeded to say, that in the case of a new principle or a novel invention—for instance, a new process—the smallness of the step did not furnish any argument against its importance. But when a new application only is under consideration, such an application as might easily suggest itself to any person—a new application of a well-known simple process, which had been employed with respect to other substances—then, when a patentee comes to apply for an extension of his patent, the smallness of the step involved in the patented invention will be taken into consideration in determining the length of the extension. In this case, the invention consisted in an application of mechanical pressure to separate the solid and fluid constituents of cocoa-nut oil. The invention having been of moderate benefit to the public, the moderate extension of three years was granted to the patentee. (See also *Hills' Patent*, 1 Moore, P. C. C. N. S. 258; *S. C.* 9 Jur. N. S. 1209.)

We shall proceed to mention a few cases of applications for extension of letters patent, which will illustrate what has been said. On an application for an extension of a patent granted to James Kay, for improved machinery for preparing and spinning flax, it was shown that the patentee had expended £500 in experiments, £500 in obtaining his patent, £2200 in law expenses, and that he had made about £6800 profit. The invention was one of great utility, was used by nearly all the flax-spinners in the kingdom; but looking at the sum already cleared by the patentee, it was thought that a prolongation for three years would satisfy the justice of the case. (*Kay's Patent*, W. P. C. 1. 568.)

Richard Roberts obtained a patent for improvements in spinning-jennies, the value of which was so great, that during the last three or four years of the original term, £5000 a year had been made by the patentee. In consequence, however, of piracies, of combinations amongst workpeople, but chiefly of a fire, supposed to have been the act of an incendiary, which destroyed the patentee's premises, and entailed a loss of £10,000 beyond the insurance, the profits did not reach the amount of loss by several thousand pounds. The committee of the Privy Council, guided by the ingenuity of the invention, and the peculiar character of the resistance to its introduction, were of opinion that seven years' prolongation was merited. (*Roberts' Patent*, W. P. C. 1. 573.)

L. W. Wright applied for an extension of his patent for improvements in bleaching apparatus, and gave evidence before the committee of his pecuniary embarrassments, and the disputes which had arisen out of his partnership with various persons; which embarrassments and disputes had prevented the introduction of the invention to the trade. He showed that the invention had been successfully practised by several bleachers, but that he had hitherto derived no benefit whatever from it. The committee reported that it would be proper to prolong the term for seven years. (*Wright's Patent*, W. P. C. 1. 575.)

A patent for a new method of preparing iron plates for tinning was granted in 1839 to Thomas Morgan, who, being unable to work the invention, had sold his patent right for £200 to persons who applied, in conjunction with the patentee, for an extension of the term. The assignees had made a profit of about £1000

a year for three years, and the patentee, in addition to the sum received from them, was making about £2 a week out of the patent. The invention appearing to possess only a moderate degree of merit, the committee thought that the benefit received by the patentee and his assignees was a sufficient reward, and they refused the application. (*Morgan's Patent*, W. P. C. 1. 737).

A patent for printing yarns of any fibrous materials was granted in 1828 to Bennet Woodcroft, who, on the expiration of the original term, applied for an extension. The patented process gave to cloth made of yarn, printed by it, a peculiariy clouded appearance, and the invention gave rise to the manufacture of clouded silks and fabrics. During the first four years of the patent, £7000 were realized under it. Certain duty, however, was taken off other goods, and from this cause and others a large capital invested in working the patent ceased to be profitable, and the patent right became of small value. At a subsequent time, the invention, under an improved form, was stated to have become of considerable value, and it was thought proper to apply for an extension of the patent. But the committee, having regard to the amount of profit already realized, and to the fact that the invention, in its improved and valuable form, was introduced from abroad by other persons than the patentee, refused the application.

In 1840, Orlando Jones obtained a patent for improvements in the manufacture of starch. His method consisted in applying a weak solution of caustic alkali to rice. It was shown, at the hearing of an application for an extension of the patent, that the principle

of the invention had been discovered by another person prior to the date of Jones' patent, although Jones was not aware of the fact. The invention being thus shown to have no novelty, the application was refused, and costs to the amount of £100 were decreed against the petitioner.

On the application for an extension of Derosne's patent, for improvements in refining sugar, it appeared that the patentee's net profit had been about £3300. But the benefit to the public was so great, being appreciable in every pound of sugar consumed, that an extension of six years was granted. (*Derosne's Patent*, W. P. C. 2. 1.)

G. F. Muntz applied for an extension of his patent, for improvements in the manufacture of sheathing for ship bottoms, and showed that he had made £55,000 by the manufacture during the existence of the patent. The applicant contended that this sum did not represent his profit as an inventor and patentee, but his profit as a manufacturer. But the Committee of the Privy Council said it was impossible to sever these two heads of profit. It was by means of the patent that he had made the profit. It had given him a monopoly preference; because, as patentee, he was enabled to sell and trade in a manner which, but for his invention and his patent, he could not have done. The application for a prolongation of the patent was refused (*Muntz's Patent*, W. P. C. 2. 113). See also *Hills Patent* (1 Moore P. C. C., N. S. 258; *S. C.* 9 Jur., N. S. 1209).

A. M. Perkins obtained a patent in 1831 for improvements in an apparatus for heating air in buildings, heating fluids, etc. He applied, in 1845, for an extension of the patent, on the ground that he had been

inadequately rewarded. The ingenuity of the invention, and its application to a great number of purposes, having been shown, the accounts were investigated, when it appeared that there had been a profit of £15,176 upon gross receipts to the amount of £64,920. The patentee claimed further to reduce the sum representing his profits, by deducting £500, the cost of experiment, £2700 interest at five per cent. on the average amount of capital employed, and £5400 for an allowance of £400 a year to the patentee for his personal superintendence of the business. These sums reduced the profits to £6576 net. An extension of five years was granted, the invention being ingenious and useful. (W. P. C. 2. 7.)

An application for the extension of a patent for improvements in the manufacture of steel was opposed on the ground that, whereas the patented process consisted in the addition of carburet of manganese to the crucible, it had been subsequently discovered that a better process of making steel was to place carbonaceous matter and manganese separately in the crucible, and this process obtained generally in practice. The Privy Council thought that the merit of the original invention was not thereby materially detracted from, and they granted an extension for seven years. In granting so long a time, the litigation going on in the courts of law was taken into account, as it was thought probable that some time would elapse before the litigation would terminate, and the patentee's representatives have the benefit of the extension granted. (*Heath's Patent*, W. P. C. 2. 257.)

Whitehouse, an ingenious mechanic, procured a patent for improvements in the manufacture of iron tubes,

which he assigned to his master, Russell, who laid out £14,000 in works to carry out the manufacture. The tubes were in great demand, being applicable to a variety of new purposes; but, as the manufacture was simple, many expedients were resorted to to evade the patent, and Mr. Russell was involved in much litigation, in consequence of which, combined with the loss incurred by surreptitious manufacture and sale, his profits were very considerably reduced. On these grounds he applied for a prolongation of the patent, and produced evidence before the committee to show the value and importance of the invention, the losses he had suffered from infringements, and the great reduction that would take place in the value of the premises and machinery (much of which was fitted only for the particular manufacture) if the patent were thrown open. He further showed that his life had been endangered by the anxiety of certain law proceedings. One witness stated that, if the manufacture were thrown open, it would hardly be worth following; the process was so beautifully simple, that it would almost be within the reach of any person of capital. The net profits amounted to about £13,000; but this was shown to be not much greater than the ordinary profits on stock without the protection of a patent. Taking all this into consideration, seeing that the invention was of extraordinary merit, and that Mr. Russell had suffered greatly from the annoyance and anxiety occasioned by the litigation to which he had been subjected, the committee thought the patent ought to be extended for six years, the original patentee receiving £500 a year out of the profits for that time. (*Whitehouse's Patent*, W. P. C. 1. 473.)

A patent for forging and shaping small articles in metal was obtained by Mr. Ryder in 1841; when he applied for an extension, he pleaded that though the profits had been £7000, they had only been made during the last four years. This, however, was held to be no ground for the application in the face of the large sum realized, and the petition was dismissed. (*Ryder's Patent*, Pract. Mech. Jour., vol. 7, p. 238.)

It will have been remarked, that the maximum period of extension in these cases was seven years. To induce the Judicial Committee to recommend an extension for fourteen years, a case of the strongest kind must be made out.

In *Ruthven's Patent* (Pract. Mech. Jour., 2d series, vol. 8, p. 159), which was a patent for improvements in the propulsion of vessels, the invention was proved to have been of very great merit, and to have failed in being brought into general use through circumstances altogether independent of the will and without the fault of the inventor, who had not merely derived no profit but had suffered considerable loss from his patent. It was shown, moreover, that the Admiralty had then lately instituted experiments with a view to the adoption of the invention, and that several friends of the inventor were willing to embark large capital in working the invention, should a prolongation be obtained. Evidence was also given that from the nature of the invention it would necessarily be a long time before its merit could be properly brought before the public. Under these circumstances the Judicial Committee (stating that they considered the case exceptional) granted a prolongation for the unusual period of ten years.

Where the invention is one of great merit, and the patentee has assigned his interest in it to another person for a sum which, looking at the profits likely to be derived from working the invention, appears an inadequate consideration, the Privy Council will see that the patentee receives further reward. With this view, a condition is sometimes introduced into the new patent, making it void in case a fixed annual sum, or a certain share in the profits, be not paid to the patentee by the assignee. (*Whitehouse's Patent*, W. P. C. 1. 473; *Hardy's Patent*, 6 Moore P. C. C. 441.) So also where a patentee had mortgaged his patent, and he and his mortgagees asked for a prolongation, it was granted to the patentee alone. (*Bovill's Patent*, 1 Moore P. C. C. N. S. 348.) Other special conditions are sometimes inserted in the new letters patent; for example, that the patented article should be sold to the public at a certain price (*Hardy's Patent*, 6 Moore P. C. C. 441); or that the Admiralty should have the privilege of using the invention (in this case, an improved propeller for steam and other vessels) without licences from the patentee (*Pettit Smith's Patent*, 7 Moore, P. C. C. 133). In the cases of *Lancaster's Patent* (2 Moore, P. C. C. N. S. 189), and *Carpenter's Patent* (*ibid.* 191), however, the Judicial Committee refused to insert this latter condition; and it would seem to be now unnecessary since the recent case of *Feather* v. *The Queen* (Pract. Mech. Jour. vol. 10, N. S. 321), where it was held that notwithstanding the grant of Letters Patent, the Crown has power to use the invention without the assent of the patentee. For instances of other special conditions introduced into the new letters patent, see *Bodmer's Patent* (8 Moore, P. C. C. 282); *Normandy's Patent* (9 Moore, P. C. C. 452).

# CHAPTER XI.

## ASSIGNMENTS OF LETTERS PATENT AND LICENCES.

Power both to assign and to license is by implication given to the patentee by the letters patent. To be a valid instrument, an assignment ought to be a deed under hand and seal. Previous to the Patent Law Amendment Act, 1852, letters patent contained a clause avoiding them, in case they became vested in more than twelve persons at the same time. But the 36th section of that Act declares that, notwithstanding any proviso that may exist in former letters patent, it shall be lawful for a larger number than twelve persons, hereafter, to have a legal and beneficial interest in such letters patent. In case of the death of the patentee before the expiration of the letters patent, they pass to his executors or administrators, and not to his heir.

It is usual to introduce into assignments covenants on the part of the patentee, that he is the first and true inventor, and that the patent is a valid one; and it may be well to make the patentee covenant to do what is necessary, in the event of an application to the Privy Council for a confirmation of the patent.

It is no answer to an action to enforce a contract for the purchase of a patent for a stipulated sum (*Hall* v. *Conder*, 2 C. B. N. S. 22), nor to an action to enforce payment of a royalty under a licence (*Smith* v. *Scott*, 5 Jur. N. S. 1356), to plead that the patent is wholly

worthless and of no utility, and that the subject-matter of the patent was not the novel invention of the plaintiff, there being no proof of fraud, and no express warranty. Such a contract was held merely to have the effect of placing the purchaser in the same situation as the seller was with reference to the patent, and the purchaser is bound to take it with all its faults. This being so, it is desirable to consider whether or not an express warranty of the patent should not be introduced into contracts of this nature. See also *Smith* v. *Neale* (2 C. B. N. S. 67).

A licensee during the continuance of the licence cannot set up as a defence to an action for the royalty that the invention was not new or that the patentee was not the first inventor. (*Noton* v. *Brooks*, 7 H. & N. 499; *Trotman* v. *Wood*, 16 C. B. N. S. 479.) But when in such a case the claim in the specification is susceptible of two constructions, one of which would make the specification bad and the other and more natural one would make it good, the licensee may insist that the latter is the true construction. (*Trotman* v. *Wood*, 16 C. B. N. S. 479.) Even where no formal licence has been executed, a person who has paid money in the nature of a royalty will not be allowed to dispute the validity of the patent. (*Crossley* v. *Dixon*, 10 H. L. C., 293; *S. C.* 9 Jur. N. S. 607.) Neither will a patentee after assigning all his interest in a patent for a valuable consideration be allowed, in an action against himself for an infringement, to raise the question whether the patent is void for want of novelty (*Walton* v. *Lavater*, 8 C. B. N. S. 162, 187); and see also *Chambers* v. *Crichley* (33 Bea. 374). Furthermore, a licensee will not be permitted to use the invention

without payment of the royalties he has covenanted to pay, even after the patent has been found invalid in proceedings between other parties. (*The Grover and Baker Sewing Machine Company* v. *Millard*, 8 Jur. N. S. 713.) But where judgment was given by consent before declaration filed in an action by a patentee against the members of a partnership firm for an alleged infringement, and the defendants immediately took a licence to use the invention, and the patentee subsequently instituted a suit to restrain infringement against the defendants at law and two fresh partners, it was held that the defendants in equity were not estopped from disputing the validity of the patent. (*Goucher* v. *Clayton*, 11 Jur. N. S. 107.)

Bearing in mind the decision in *Wallington* v. *Dale* (*ante*, p. 157) it may be well to insert in an assignment a covenant binding the assignor not to enter a disclaimer or file a memorandum of alteration without the written authority of the assignee.

Licences have various intents. In their most general form, they are tantamount to an assignment of the patentee's whole rights. But usually they are for a term shorter than that mentioned in the patent, and sometimes they do not extend to the whole of the invention. A licence may be restricted, likewise, to a particular district. What is called an exclusive licence is one by which the patentee binds himself not to empower any other person to exercise the patent privilege, either at all or within a given district.

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

The consideration for the grant of a licence is usually

an immediate money-payment, or a periodical payment, which may be either of a certain amount, or dependent upon the extent to which the licensee uses the invention. In the last case, care should be taken not to create a partnership when no partnership is contemplated. See *Ridgway* v. *Philip* (1 Cr. M. & R. 415); *Elgie* v. *Webster* (5 M. & W. 518).

In preparing licences, the following points should be attended to:—The patentee ought to covenant that the patent is valid, and that he has a right to grant the licence. The licensee should covenant to pay any sums, the payment of which is postponed to a future time. Where the payments are to vary with the extent to which the licensee shall use the invention, there ought to be covenants, on the part of the licensee, to render properly verified accounts, and to allow periodical inspections of books, machinery, stock, etc. If it be intended that the licensee should not be permitted to question the validity of the patent, or the sufficiency of the specification, recitals should be introduced affirming these points, or express covenants debarring the licensee from raising the question. But recitals can only affirm the facts as they stood at the time of the execution of the deed; covenants may be made to apply to all future time. Recitals, however, will have the effect of stopping the parties from disputing the facts recited. (*Bowman* v. *Taylor*, 2 Ad. & El. 278; *Hills* v. *Laming*, 9 Exch. 256.) In the absence of such recitals or covenants, a licensee, when sued for money reserved by the licence, may set up, as a defence, that the patent is void, where the contract is executory, or where there is the taint of fraud (*Hayne* v. *Maltby*, 3 T. R. 438); and see *Pidding* v. *Franks*,

(1 Mac. and Gord. 56). On the other hand, refer to the case of *Lawes* v. *Purser* (6 Ell. and Bl. 930). This was an action brought by a patentee upon an agreement whereby the defendant contracted to pay a certain sum per ton of an article manufactured and sold by him, by permission of the plaintiff to him given at his request, the sole manufacture and sale of such article being the subject of the plaintiff's letters patent. The invention having been used by the defendant, he refused to pay the stipulated sum, pleading that the letters patent were void, and that he had a right to make and sell the article without licence. It was held that the defendant was not entitled to set up such a defence, the contract having been executed, and no fraud being alleged. But one of the judges thought that if the defendant had given notice that he disputed the validity of the patent, and would in future use the invention in his own right, such notice would change the position of the parties; for after it, the patentee might sue the defendant for an infringement of his patent for any subsequent user; and, perhaps, in an action on the agreement for the price of such subsequent user, the invalidity of the patent might be a defence.

It may be prudent to insert a clause giving the patentee power to render the licence void, in case of non-payment of royalties or other sums reserved, or on non-performance of any of the covenants.

It seems that a licence is not assignable to a third person in the absence of an express or implied power to assign, such as where the licence is granted to the licensee, his executors, administrators, or assigns.

In the case of an exclusive licence, it is desirable that the licensee should covenant to pay a certain

minimum sum at stated periods in the shape of royalty; and it is the usual practice to insert covenants on the part of the patentee to proceed against persons infringing the patent, or to permit the licensee to proceed in the patentee's name. In the absence of such a stipulation, the licensee would be without any remedy at law for an infringement. The Court of Chancery will, however, grant an injunction at the suit of exclusive licensees. (*Renard* v. *Levinstein*, 13 W. R. 382.)

It has been decided that money paid in consideration of a licence cannot be recovered by action when the patent turns out to be void (*Taylor* v. *Hare*, 1 Bos. and Pul. N. R. 260); except where fraud is proved (*Lovell* v. *Hicks*, 2 Y. and C. 472). To meet this case, it will be prudent to have a covenant in the licence, under which the parties may re-adjust their accounts in the event of the patent proving void or voidable.

When a patent is granted to two or more persons, each may use the invention without being liable to account to the other (*Mathers* v. *Green*, 1 Law Rep. Ch. Ap. 29, before *Lord Cranworth, C.*). See, however, the earlier case of *Hancock* v. *Bewley* (Johns. 601), as to the rights of parties where letters patent are vested in trustees for two or more persons as tenants in common.

The assignee of part of a patent separate from other parts may bring his action for an infringement of such part without joining as plaintiffs those persons who have distinct interests in the other parts, but have no interest in the damages sought to be recovered. (*Dunnicliff* v. *Mallet*, 7 C. B. N. S. 209.) This decision was mentioned with approval by the Court when delivering judgment in the case of *Walton* v. *Lavater* (8 C. B. N. S. 184), where it was unsuccessfully contended that the assignee of two several moieties of a

patent had not a sufficient legal interest to sue for its infringement.

A simple licence, not containing covenants, need not be under seal (*Chanter* v. *Dewhurst*, 12 M. and W. 823); nor does it require a stamp when there is no pecuniary consideration (*Chanter* v. *Johnson*, 14 M. and W. 408). Otherwise a stamp of £1. 15s. must be impressed.

The 35th section of the Patent Law Amendment Act requires all assignments of letters patent, and of any interest therein, and all licences to be registered, and provides that until such registration, the grantee of the letters patent shall be deemed the sole proprietor of the exclusive privileges thereby given.

Under this clause it has been held that an assignee cannot bring an action for an infringement until his assignment has been registered; and this applies to patents granted previous to October, 1852, if the assignment was made subsequent to that time. (*Chollett* v. *Hoffman*, 7 E. & B. 636; *S. C.* 3 Jur. N. S. 935.) When the executors of a patentee obtained probate of their testator's will and assigned his patent, but the probate was not registered till after the assignment, it was held that the assignment was valid. (*Ellwood* v. *Christy*, 10 Jur. N. S. 1079; *S. C.* 11 L. T. N. S. 342.)

It is the practice of the Patent Office to register all instruments presented to them relating in any manner to patents which have been completed, on payment of a fee of five shillings upon each instrument; but the office declines to register any instrument relating to inventions only provisionally protected.

The office will register deeds of trust if presented for that purpose; but it is not the general practice to register such documents.

# CHAPTER XII.

## INFRINGEMENTS.

WHEN a patentee's rights have been infringed, it becomes matter for consideration whether he should proceed at law, or in equity, or in the courts both of law and equity at the same time. Formerly, he could at law only obtain damages for past acts of infringements; but in a court of equity he could always, on making out a proper case, obtain an injunction against future infringements, as well as a decree for an account of sales and profits. The powers both of Courts of Common Law and Equity in relation to these matters have, however, received considerable additions by recent legislation, and a patentee may now at law obtain an injunction, an inspection, or an account, as well as damages, while in equity he may have an inquiry as to damages, in addition to the ordinary remedies given to him by that Court.

These new powers were first conferred on the Courts of Common Law by the Patent Law Amendment Act (15 & 16 Vict. c. 83), the 42nd section of which enacts that the Court in which any action for the infringement of letters patent may be pending, or a judge of the court if the Court be not sitting, may make an order for an injunction, inspection, or account, on the application of either party. The following cases have been decided on this section of the Act:—*Vidi* v. *Smith* (3 E. and B. 969); *Holland* v. *Fox* (3 E. and B. 977); *Shaw* v.

*Bank of England* (22 L. J. N. S. Ex. 26); *Amies* v. *Kelsey* (22 L. J. R. N. S. Q. B. 84); *The Patent Type Founding Company Limited* v. *Lloyd* (5 H. and N. 192).

An injunction may also be ordered by a court of common law under the Common Law Procedure Act, 1854 (17 & 18 Vict. c. 125, s. 79), and at any stage of the cause (s. 82); but in *Gittins* v *Symes* (24 L. J., C. P. 48), it was held that the Court would in the first instance only grant a rule *nisi*, and on cause being shown would give such directions as would be given by a Court of Equity.

It is, however, in the Court of Chancery that the recent alterations in practice are most felt. That Court would not as a general rule interfere by injunction, unless the plaintiff had established his title in a court of law. Where, however, that had been done, and there had been no attempt to disturb the verdict, then an equity judge would and still will, almost as a matter of course, assist the patentee by an injunction, with a decree for an account. The Court, however, could not give damages for past infringements. But now, by the 21 & 22 Vict. c. 27 (commonly called *Sir Hugh Cairns'* Act), the Court of Chancery is empowered in injunction cases to award damages to the injured party in addition to other relief, and the same Act enables it to cause the amount of such damages to be assessed, and any question of fact arising in the suit to be tried either by a jury before the Court itself, or before the Court itself without a jury. And by the 25 & 26 Vict. c. 42 (known as *Mr. Rolt's* Act), the Court is bound itself to try every question of law and fact arising in any cause pending before it, subject only to the proviso that issues may be directed to try questions

of fact at the assizes, when it appears to the judge that the matter may be more conveniently tried there.

This latter Act received a judicial construction in the case of *Young* v. *Fernie* (1 De G. J. and S. 353). In this case, which related to a patent for the production of paraffin oil, a suit for an injunction had been instituted in the Court of Chancery, and *Stuart, V. C.*, under the proviso above mentioned, had ordered certain issues as to the validity of the patent to be tried in the Court of Common Pleas. On appeal *Lord Westbury, C.*, reversed this order, and directed the trial to take place in the Court of Chancery. His Lordship made the following observations, which will probably govern the future practice of this Court:—"I construe the statute as laying down the rule for the future, that these things shall be heard and determined in this court. The proviso operates by way of exception only to the rule, and in order to bring a case within the proviso the Court must be satisfied that the administration of justice in the *particular suit* may be more conveniently exercised and promoted by directing issues to be tried by a jury at the assizes or at any sitting in London or Middlesex for the trial of issues in the Common Law Courts than by completing the hearing and the inquiry before itself. In a patent case particularly, and in this case having regard to the nature of the questions raised, I do not think that anything more inconvenient can be suggested than that where there are mixed questions of law and fact, the one bound up with the other and scarcely capable of being separated, an attempt should be made to cut the cause in halves and to send one half of it to be tried by a jury in a court of common law, reserving the other half for determina-

tion in this court. . . . Nothing to my mind is more to be deprecated than to divide a patent case and to send issues of this nature for trial by a jury at common law."

The result, therefore, is that every question of law and fact, or of mixed law and fact, arising in a patent cause instituted in the Court of Chancery is now determined wholly in that Court.

It has, however, always been and still is the practice of the Court, when the plaintiff can make out a *primâ facie* case, to grant an interlocutory injunction—that is, an injunction before the hearing of the cause, without requiring the previous verdict of a jury. "The principle on which the Court acts," said *Lord Eldon*, in *Hill* v. *Thompson* (3 Mer. 622), "in cases of this description is the following:—Where a patent has been granted, and an exclusive possession of some duration under it, the Court will interpose its injunction, without putting the party previously to establish the validity of his patent by an action at law. But where the patent is but of yesterday, and, upon an application being made for an injunction, it is endeavoured to be shown in opposition to it that there is no good specification, or otherwise that the patent ought not to have been granted, the Court will not, from its own notions respecting the matter in dispute, act upon the presumed validity or invalidity of the patent, without the right having been ascertained by a previous trial, but will send the patentee to law, and oblige him to establish the validity of his patent in a court of law, before it will grant him the benefit of an injunction."

But although it is the general course of the Court not to grant an injunction unless the validity of the patent has been established, or the patent has been

long undisputed, the circumstances of the case may be such as to induce the Court to depart from the rule. (*Renard* v. *Levinstein*, 10 L. T. N. S. 94, affirmed on appeal, *ibid.* p. 177; *Clark* v. *Ferguson*, 5 Jur. N. S. 1155.)

When it can be shown that the patentee has had undisturbed possession for many years, or that the defendant has acknowledged the validity of the patent, or that the plaintiff has obtained the verdict of a jury in an action to which the defendant was a party (it not being likely that the verdict will be disturbed), or that the defendant, not being a party to the action, had yet assisted in the defence; in any of these cases, the Court of Chancery will grant an interlocutory injunction. So also where the patent has been the subject of several suits, all of which have terminated in favour of the patentee, an interlocutory injunction will be granted, notwithstanding a fresh fact is brought forward tending to impeach the novelty of the invention. (*Newall* v. *Wilson*, 2 De G. M. & G. 282.) But if, on the other hand, the plaintiff has shown negligence in prosecuting his rights, even though his patent has been established against another defendant (*Bridson* v. *Benecke*, 12 Bea. 1), or if either the plaintiff's title or the fact of infringement is matter of doubt, an injunction will be refused until after a trial at law; and even then, if there is ground for supposing that a new trial will be obtained. (*Collard* v. *Allison*, 4 My. & Cr. 487; *Electric Telegraph Co.* v. *Nott*,* 2 Coop. C. C. 41, and the other cases collected by the reporter.) To grant an injunction in cases where

* In this case, *Cottenham, C.*, said, that the Court will not grant an injunction where the legal right is disputed, unless it is satisfied that the legal right will eventually be established; nor where the legal right is disputed,

the patentee's title is doubtful would often prove to be a great hardship on the defendant; since the patent may, on examination, prove to be invalid, and the Court has no power to decree a recompense to him in case of injury resulting from the injunction. In many cases, however, the Court thinks it right, when it postpones the consideration of the injunction, to order the defendant to keep an account until the plaintiff has had an opportunity of testing the validity of his patent at law.

For a further statement of the general principles on which the Court acts in granting or withholding injunctions see *Bacon* v. *Jones* (4 My. & Cr. 434); *Bridson* v. *M'Alpine* (8 Bea. 229.)

The Court, however, being now empowered to try the validity of the patent, and having the control of the proceedings, and being, consequently, able to prevent any undue delay, is less disposed than formerly to grant an interlocutory injunction, but will generally content itself with giving directions to insure an immediate trial of the questions at issue between the parties, and order the motion for the injunction to stand to the hearing of the cause, adding, when necessary, a direction for the defendant to keep an account. The cause may then proceed to a hearing in the ordinary way.

It is, however, open to either party to move that issues may be settled, raising the various questions of fact in the cause, and that these issues may be tried unless satisfied that the acts complained of are a violation of it. Where, however, the sole question is the validity of the patent, and there has been exclusive enjoyment under it for a reasonable time, the Court will interpose, by injunction, until the invalidity has been established at law; but the injunction will be refused if there is conflicting evidence as to the infringement.

under the powers conferred by the two Acts above mentioned, by a jury, or by the Court itself without a jury. In a patent case the issues usually are, whether the invention be new, whether it be useful, whether it was a new manufacture, whether the patentee was the first and true inventor, whether the specification be sufficient, and whether the defendant has infringed; but, of course, these may be varied as circumstances require.

It is not a matter of course for the Court to grant issues, and they are sometimes refused, (*Davenport* v. *Goldberg*, 2 H. & M. 282; *Davenport* v. *Phillips*, 5 N. R. 485; *Bovill* v. *Goodier*, 1 Law Rep., Eq., 36); and a reference to a jury will, in general, not be allowed where the issues proposed have been already determined in a suit between the plaintiff and other parties. If, however, it appear that there is really a doubtful question at issue, the Court will not decide it for itself if either party desire a jury. (*Davenport* v. *Goldberg*, 2 H. & M. 282.) In this case the plaintiffs had established their patent at law in a suit against one *Rickard*, and afterwards filed a bill against one *Jepson*, in the Court of Chancery. The usual issues were tried before *Wood, V.C.*, when the jury disagreed, and were discharged without giving a verdict. The issues were again tried before another jury, when the defendant did not appear, and a verdict was taken for the plaintiffs, and ultimately a decree for an injunction was made against *Jepson*. The plaintiff now filed a bill against a third infringer, who, by his answer, put in issue all the points disputed in *Davenport* v. *Jepson*, and moved to have the issues tried before a jury. *Wood, V.C.*, refused the application, except as to the

issue of infringement, and made the following observations:—

"In what position would a patentee be placed if he is to try his right *ab initio* against every separate infringer *in infinitum?* That certainly is a view of his rights which has never been adopted by this Court. If the defendant thinks that he can get rid of the patent, he had better proceed by *scire facias* to repeal or annul it; if he does not choose to take that course, but simply disregards it, and stands on his defence, I must take the validity of the patent as already sufficiently established against him." See also *Davenport* v. *Phillips* (5 N. R. 485).

By the Patent Law Amendment Act, 1852, section 41, the plaintiff in any action for the infringement of letters patent is required* to deliver particulars of the breaches complained of in the action, and the defendant in pleading thereto is to deliver particulars of the objection to the patent on which he means to rely; and no evidence is to be allowed at the trial in support of any alleged infringement or objection to the patent not contained in these particulars. This practice has been adopted by the Court of Chancery in cases where the trial of issues is directed, and the order for the trial of such issues always provides for the delivery of particulars of breaches and notices of objection by the

*At common law it is held that the objections cannot go beyond the pleas; they are merely to state more particularly what the pleas state generally. (*Macnamara* v. *Hulse*, W. P. C. 2. 128.) As to other points bearing upon this subject at common law, see *Palmer* v. *Wagstaffe* (8 Exch. Rep. 840); *Palmer* v. *Cooper* (9 Exch. Rep. 231); *Hull* v. *Bollard* (1 H. & N. 134); *Lister* v. *Leather* (3 Jur. N. S. 810); *Greaves* v. *Eastern Counties Railway Company*, (1 Ell. & Ell. 961; *S. C.* 5 Jur. N. S. 733); *Talbot* v. *Laroche* (15 C. B. 310); *Electric Telegraph Company* v. *Nott* (4 C. B. 462).

plaintiff and defendant respectively. But where issues have not been directed and replication has been filed, the cause will be left to come to a hearing in the ordinary way, and particulars of breaches and notices of objection will not be required. (*Bovill* v. *Goodier*, 1 Law Rep. Eq. 35.)

If the particulars delivered are insufficient, further and better particulars may be required. In *Needham* v. *Oxley* (1 H. & M. 248), it was held by *Wood, V.C.*, that particulars of breaches are sufficient if, *taken together with the pleadings*, they give the defendant full and fair notice of the case made against him. See, however, the subsequent case of *Curtis* v. *Platt* (8 L. T. 657), before the same learned judge.

A defendant in a suit for injunction has been permitted, during the trial of the case, and after the plaintiff's case was concluded, to amend his particulars of objection, by stating a prior publication of the invention, and give evidence in support of such new objection, on payment of the costs occasioned by the application. The practice of the Court in such cases appears to be to refuse the evidence when tendered, but to give leave to make a special motion that it may be received. (*Renard* v. *Levinstein*, 13 W. R. 229; 11 L. T. N. S. 505; *Daw* v. *Eley*, 1 Law Rep. Eq. 38.)

When a plaintiff files several bills at one time against separate infringers, the Court will, on the application of the several defendants, order the validity of the patent to be tried in one of the suits, and will, in the meantime, stay proceedings in the other suits; but this order will not be made until the defendants have given full discovery of the machines used by them and

alleged to be infringements. (*Foxwell* v. *Webster*, 2 Dr. & Sm. 250; *S. C.* on appeal, 10 Jur. N. S. 137.)*

Where two patents were granted to different persons for the same invention, *Kindersley, V. C.*, refused to interfere by injunction and left them to try the legal right by *scire facias*, being prevented by the 25 & 26 Vict. c. 42, s. 1 (*Mr. Rolt's* Act), from directing a case for the opinion of a court of law. (*Copeland* v. *Webb*, 11 W. R. 134.)

From the case of *Daw* v. *Eley* (14 W. R. 49), it appears that where the Court is trying questions of fact as well as questions of law, the practice as to hearing counsel is, during the trial of the questions of fact, the same as in a trial at common law; but as to the points of law arising in the case, counsel will be heard according to the ordinary practice of the Court of Chancery.

In connection with the subject of trials before the Court without a jury it may be useful to remember that the Court looks with distrust on experiments conducted for the express purpose of manufacturing evidence for the cause. (*Young* v. *Fernie*, 5 Giff. 577.)

The new powers of the Court of Chancery as to awarding damages in patent suits have been under consideration in some recent cases. Thus, in *Needham* v. *Oxley* (8 L. T. N. S. 604), it has been held by *Wood, V. C.*, where the bill prayed in the alternative for an inquiry as to damages or an account of the defendant's

* It was said by *Wood, V. C.*, in the case of *Bovill* v. *Crate*, reported in the 'Times,' December 20th, 1865, that when the infringers are very numerous, the proper course for a plaintiff to pursue before filing separate bills against all the infringers is to select one as a defendant, and write to the others, and ask if they object to be bound by the proceedings against that one and have the case tried once for all.

profits, but no issue as to damages was submitted to the jury, the Court would not refer an inquiry to assess damages to chambers, but would grant the alternative. When the account is a simple one, as where licences have been granted, and royalties received, the Court will itself assess the damages. Where, however, there is extreme difficulty in such an assessment, as, for instance, where no licences have been granted, a jury is the proper tribunal for ascertaining what damages have been sustained by the plaintiff. (*Betts* v. *De Vitre*, 11 Jur. N. S. 9.) In such a case the plaintiff will be allowed to waive the account and bring an action at law for damages. (*Hills* v. *Evans*, 8 Jur. N. S. 525, 531.) It appears, however, from a report of further proceedings in *Betts* v. *De Vitre* (11 Jur. N. S. 217), that an inquiry as to damages was in that case ordered in *addition* to the account of profits.

In estimating the amount of damages sustained by a plaintiff in respect of an infringement of his patent, the Court adopts a form of inquiry different from that which it employs in the analogous case of an imitation of a plaintiff's trade mark. In the latter instance the Court will not assume in the absence of evidence that the plaintiff would have sold all the articles which the defendant has wrongfully sold. (*The Leather Cloth Company* v. *Hirschfeld*, 1 Law Rep. Eq. 299.) But every sale without licence of a patented article must be a damage to a patentee, and therefore the inquiry in a patent case will extend to the sale by the defendant of *any* articles made by him since the infringement was commenced. (*Davenport* v. *Rylands*, 1 Law Rep. Eq. 308.)

In *Smith* v. *London and S. W. R. Co.* (Macr. P. C.

209), *Wood, V.C.*, decided that the right to a decree for an account of the profits made, in respect of articles manufactured and used in infringement of a patent, is ancillary to the injunction to restrain future infringements; it follows, therefore, that when the Court cannot interfere by injunction, as where the patent has expired before the suit comes to a hearing, the right to an account will fail. (*Price's Patent Candle Company* v. *Bauwen's Patent Candle Company*, 4 K. & J. 727.) In such a case, however, if the plaintiff can show that at the filing of the bill he was entitled to an injunction, the Court will at the hearing grant an inquiry as to damages, under *Sir Hugh Cairns'* Act. (*Davenport* v. *Rylands*, 1 Law Rep. Eq. 302.)

It is a rule of the Court not to interfere until the patentee's rights have been actually violated. The case of *Crossley* v. *Beverley* (W. P. C. 1. 119) shows how far the Court will go in aiding a patentee to repress infringements. It appeared that the defendants had been secretly manufacturing gas-meters, which were copies of those protected by the plaintiff's patent, their object being to pour them into the market as soon as the patent expired. A few days before the expiration of the patent, the plaintiff having discovered what had been done, filed his bill, and obtained an injunction to restrain the using of the articles so made even after the patent expired.

The Court has power to order the destruction of machines made in violation of a patent. However, where the patent was for a combination and the defendant might still use for other purposes the several parts of the machine, *Wood, V.C.*, refused to order the machines to be destroyed, but directed them to be

marked so as to prevent their being used at any future time in such a way as to continue the infringement. (*Needham* v. *Oxley*, 8 L. T. N. S. 604.)

The Court of Chancery will also assist a plaintiff suing in respect of an infringement of his patent by directing the defendant to permit an inspection of the processes used or the articles made by him in alleged violation of the rights of the plaintiff. (*Brown* v. *Moore*, 3 Bligh. 180; *Morgan* v. *Seward*, W. P. C. 1. 169; *Russell* v. *Cowley*, W. P. C. 1. 457). In this last case, however, the order was by consent. In the case of *The Patent Type Founding Company* v. *Walter* (Johns. 727), the defendant, a printer, who used types alleged to be made in colourable imitation of the type patented by the plaintiffs, was ordered on motion to deliver a sample of type to the plaintiffs for analysis.*

But where in a suit for an injunction to restrain the infringement of a patent for a sewing machine an application was made for an inspection of *all* the machines of every kind on the defendant's premises, the Court declined to make the order in the terms asked for, but (following what was stated to be the practice at common law) directed the defendant to verify on affidavit the several kinds of sewing machines which he had sold or exposed for sale since the date of the plaintiff's last disclaimer, and to produce at his solicitor's office one of each class for inspection by the plaintiff's solicitor and two of their scientific witnesses.

* A similar application having been made to the Court of Exchequer was refused by the Court, their lordships doubting whether the Patent Law Amendment Act, 1852, sect. 42. extended to enabling them to order a portion of the article to be given up for analysis. (*The Patent Type Founding Company, Limited*, v. *Lloyd*, 5 H. & N. 192; *S. C.* 6 Jur. N. S. 1 53.)

(*The Singer Manufacturing Company* v. *Wilson*, 13 W. R. 560; *S. C.* 5 N. R. 505.)

In a suit for an injunction a defendant denying infringement may be compelled to answer whether he used the plaintiff's materials, whether he makes any addition to them, and whether such addition makes any difference. (*Renard* v. *Levinstein*, 10 L. T. N. S. 94.) As to the discovery which a defendant in such a suit may obtain from the plaintiff as to his patent, see *Renard* v. *Levinstein* (11 L. T. N. S. 79).

When directors of a limited company are active parties in an infringement of a patent by the company, they may be made parties to a suit against the company, and may be ordered personally to pay the costs of suit. (*Betts* v. *De Vitre*, 11 Jur. N. S. 9.)

But a patentee frequently proceeds at law independently of the direction of a court of equity to recover damages for the injury he has sustained, in other words, he brings an action for the infringement of his patent privilege. In doing this, he subjects his rights to a searching examination; for the defendant, by putting the appropriate pleas on the file, may compel him not only to prove that the defendant has infringed his alleged rights, but to substantiate the various points connected with his title. He may be compelled to give evidence that he was the first and true inventor, and that the invention is both useful and novel; and he will have to take the opinion of the Court whether or not his invention is properly the subject of a patent, and whether or not his specification is sufficient in point of law. The question of infringement or not is for the jury not the judge, although there is no question with respect to whether the defendant has or has

not used the particular machine or process which is alleged to be an infringement. (*De la Rue* v. *Dickenson*, 7 E. & B. 738.) With respect to the question of infringement, it is often a difficult one for a jury to determine. The invention, as set forth in the specification and the process practised by the defendant may, in addition to points of resemblance, have differences to such an extent that it is not easy to say whether the two are substantially the same or not. The witnesses may, with perfect sincerity, take opposite views, and give conflicting opinions; and the question may go before the jury with the testimony on one side balancing that on the other. In such an event, the opinion of the presiding judge has naturally great weight.

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The question of infringements has already been, in part, incidentally discussed in a preceding chapter in connection with the question of the novelty of an invention. We shall now give some further illustrations of the subject.

Kneller obtained a patent for an apparatus for the evaporation of liquids and solutions at a low temperature. The apparatus consisted of pipes or tubes, along which air was forced nearly to the bottom of the vessel containing the liquid to be evaporated, which air, passing through small holes in the submerged tubes, traversed the liquid and carried off the aqueous particles. The invalidity of this patent was attempted to be proved by showing that an invention having a similar object in view had been previously patented. But when it appeared that this invention consisted in propelling a quantity of heated air into the lower part

of the vessel containing the liquid, and causing such air to pass through the liquid in streams, by *means of a perforated coil of pipe or colander*, the jury found that, although the substance of both inventions consisted in forcing air in finely-divided streams through a fluid, for the purpose of facilitating evaporation, yet the modes by which this was effected in the two cases were sufficiently distinct as to acquit the latter invention of being a piracy of the former; and that the latter patent was not invalidated by reason of want of novelty in the invention. The Court was of the same opinion, upon the application for a rule to set this verdict aside. (*Hullett* v. *Hague*, 1 Carp. Rep. 501.)

On the other hand, to make a colourable alteration in a patented invention, or to arrive at the same result by means which are substantially the same, although independently discovered, will be an illegal infringement of the patent; and if a patent should be obtained for the latter invention, it will be invalid. A person will not be allowed to deprive an inventor of the fruits of his discovery by substituting a well-known equivalent, either chemical or mechanical, for some part of the patented invention. Where the question arises as to the infringement of the patent for a machine, the substance and not merely the form of the invention will be looked at in a court of justice. Therefore, where it is shown that two machines are alike in principle, and that the constructor of the second machine has carried the principle of the first into effect, by substituting one mechanical equivalent for another, here it will be held that there has been an infringement. (See *Morgan* v. *Seaward*, W. P. C. 1. 171.)

Walton took out a patent for making cards for card-

ing textile materials with the aid of caoutchouc, the object being to obtain an increased degree of elasticity and durability. The wire teeth were described as inserted in a foundation of slices of caoutchouc, on the back of which a piece of brown holland, or other similar cloth, was cemented. The claim was not confined to the use of caoutchouc in slices, but he claimed the exclusive right of making cards by fixing the teeth in caoutchouc as the fillet, or sheet, or medium. After the date of this patent, Potter and Horsfall took out a patent for a new material for forming the backs of cards; and they described their mode of preparing it thus—*viz.*, by repeatedly passing a woven fabric of a peculiar construction through, and saturating it with, a solution of caoutchouc, and then drying it to evaporate the solvents, and leave the fabric impregnated and coated with caoutchouc, the object being to render the fabric so dealt with extremely elastic in the direction of the thickness of the fabric, so as to impart elasticity to the wire teeth when set. It was held (*Walton* v. *Potter*, W. P. C. 1. 585) that Potter's process fell within the generality of Walton's claim, and was an infringement of his patent. At the trial, *Tindal, J.*, told the jury that, "when a party has obtained a patent for a new invention made by his own ingenuity, it is not in the power of any other person, simply by varying in form or in immaterial circumstances the nature or subject-matter of that invention, to obtain either a patent for it himself, or to use it without the leave of the patentee, because that would be in effect and in substance an evasion of the right; and therefore what you have to look at upon the present occasion is not simply whether in form or in circumstances

—that may be more or less immaterial—that which has been done by the defendants varies from the specification of the plaintiff's patent, but to see whether in reality, in substance, and in effect, the defendants have availed themselves of the plaintiff's invention, in order to make that fabric, or to make that article which they have sold in the way of their trade". Then referring to a card purchased from the defendants, which was produced to the jury, he said, "Now, what you have to say is, whether you are satisfied that the card produced is a specious variation in form only, an ingenious alteration in the mode of adaptation, or whether it is really and substantially a new discovery on the part of the defendants. In the one case it would be an infringement of the patent; in the other it would not. . . . There can be no doubt whatever that, although one man has obtained a patent for a given object, there are many modes still open for other men of ingenuity to obtain a patent for the same object; there may be many roads leading to one place; and if a man has, by dint of his own genius and discovery, after a patent has been obtained, been able to give to the public, without reference to the former one, or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent for that purpose. But he has no right whatever to take, if I may so say, a leaf out of his neighbour's book, for he must be contented to rest upon his own skill and labour for the discovery, and he must not avail himself of that which has been before granted exclusively to another; and therefore the question again comes round to this, whether you are of opinion that the subject-matter of

this second patent is perfectly distinct from the former, or whether it is virtually bottomed upon the former, varying only in certain circumstances which are not material to the principle and substance of the invention."

In the case of *Neilson* v. *Harford* (W. P. C. 1. 295), *Parke, B.*, told the jury that if the plaintiff's patent was a good patent, and if the specification was to be understood in the sense claimed by the plaintiff, the invention of heating the air between its leaving the blowing-apparatus and its introduction into the furnace, in any way, in any close vessel which is exposed to the action of heat, there was no doubt that the defendant's machinery was an infringement of that patent, because it was the application of heated air; and although what the defendants had done was a great improvement upon the machinery or apparatus constructed under the plaintiff's patent, still it would be an infringement of it.

In *Muntz* v. *Foster* (W. P. C. 2. 101), it appeared that the plaintiff's invention consisted in the making of ships' sheathing from an alloy of the purest copper and the purest zinc that could be purchased in the market. The defendants, who were sued for an infringement, alleged that their sheathing was made of ordinary copper and zinc. It was proved that ordinary copper would not produce the result, and be attended with the properties which the plaintiff had taken out his patent for. It was, therefore, matter of consideration for the jury, whether there had not been some contrivance on the part of the defendants to give the copper the necessary degree of purity during the process of manufacture. "If it were so," said *Tindal, C. J.*, to the jury, "that would be a contrivance, and an

evasion of the direct letter and description in the patent. Although the patent describes the copper must be of the purest quality, yet, if persons could take an inferior kind of copper, and by dressing it up, and by some particular way of melting and refining it, give it exactly the same effect as the best kind of copper would have done, it must be for you to say whether, in that case, they intended to imitate and evade the patent." The making of ten tons of metal sheathing, apparently for sale, although no sale was proved, was held to be an infringement.

It is much less difficult to determine the question of the identity or difference of alleged mechanical equivalents, than of chemical equivalents. In mechanics it is easy, in most cases, to say beforehand what will be the effect of substituting one mechanical power for another; but it is frequently impossible to foretell the effect of substituting one acid for another, or one alkali for another. In *Stevens* v. *Keating*, (W. P. C. 2. 188) it was a question whether the use of borax (a compound of boracic acid and soda) was not an infringement of a patent, the specification of which claimed the use of acids and alkalis in the preparation of cements. Both *Lord Cottenham* and *Pollock, C.B.*, held that it was an infringement.

In *Hancock* v. *Moulton* (June, 1852), an application to the Court of Chancery for an injunction to restrain the manufacture by the defendant of vulcanised or cured caoutchouc, alleged to be an infringement of the plaintiff's patent, it appeared that this patent was for obtaining a certain useful product by subjecting a mixture of sulphur and caoutchouc to heat. The mixture was first made mechanically, and then, by the opera-

tion of heat, the character of the caoutchouc was changed so that it ceased to be liable to stiffen from cold, it was not decomposed by heat, and it was improved in elasticity. The patent extended to the incorporation of sulphur, and of sulphur only, with the caoutchouc by means of heat. The defendant subsequently obtained a patent for the combination of hyposulphate of lead and artificial sulphuret of lead with caoutchouc; that combined mass, acted upon by heat, was alleged by the defendant to produce more beneficial results, but the results were of the same character as those which were produced by the plaintiff's patent. "Assuming," said *Turner, V. C.*, "the materials thus used by the defendant to be different, the process of the defendant would *per se* be no infringement of the plaintiffs' patent. The plaintiffs confined their patent to sulphur; the defendant had used hyposulphate of lead and artificial sulphuret of lead. But it was alleged by the plaintiffs that the materials were not in truth different, or at least that the materials which produce the result are the same. It was said that the sulphate and sulphuret of lead do not of themselves produce the change, but that the change is produced by the sulphur which they contain, and which forms one of their several constituent parts; and that those parts being decomposed by *heat*, the sulphur combined with the caoutchouc and left a residuum of lead, which had no operation in the change which was effected. If the qualities conferred upon the caoutchouc by the process were imparted by the sulphur, it would no doubt be an infringement of the plaintiffs' patent." The judge's opinion, after examining the evidence, was, that the evidence preponderated very considerably in favour of the plaintiffs.

The case of *Talbot* v. *Laroche* deserves attentive study, for the questions raised in it as to the substitution of one chemical equivalent for another. The plaintiff was the inventor of the photographic process, for which he obtained a patent in 1841. The specification claimed, amongst other things, the employment of gallic acid or tincture of galls, in conjunction with a solution of silver, to render paper more sensitive to the action of light; and also the making visible photographic images upon paper by washing them with liquids (meaning only, as other parts of the specification showed, gallo-nitrate of silver), which act upon those parts which had been previously acted on by light. Subsequently to the date of this patent, the collodion process was discovered, and the defendant having practised it, the plaintiff brought this action, alleging that this process was an illegal copy of his process. It was argued by the defendant—firstly, that the plaintiff had claimed only the rendering of *paper* more sensitive to light; whereas collodion, the substance he employed, was a different thing, being a solution of gun-cotton in ether; secondly, that when the collodion was put into the camera, it contained no gallic acid, a material essential to the plaintiff's process; thirdly, that in developing the image, he employed pyrogallic acid, and not gallic acid. Several scientific persons gave evidence that collodion was not only a different material from paper, calling into play processes not needed when paper was employed, but that it possessed peculiar photographic properties, as was proved by the fact, that no gallic acid was required to render it sensitive, as in the case of paper; also, that pyrogallic acid was much more rapid in its action

than gallic acid, and that it was, in many respects, a different thing from gallic acid. The questions submitted by the judge to the jury upon this part of the case were these: Is the use of collodion with nitrate of silver and iodide of potassium the same as the use of paper prepared with nitrate of silver, iodide of potassium, and gallic acid? Is pyrogallic acid the same as, or a chemical equivalent for, gallo-nitrate of silver? The jury returned a verdict implying that, in practising the collodion process, the defendant had not infringed the plaintiff's process.

The difficulty that sometimes exists in determining whether one chemical process is, in contemplation of law, distinct from, or an illegal copy of another, is exemplified in the history of the case of *Heath* v. *Unwin*.

Under a patent for improvements in the manufacture of iron and steel, the patentee claimed "the use of carburet of manganese in any process whereby iron is converted into cast-steel;" and his specification stated, that the invention consisted in adding from one to three per cent. of the carburet to iron or blistered steel whilst in the crucible. The carburet of manganese was separately prepared, by subjecting oxide of manganese and carbonaceous matter to a strong heat, and the resulting carburet was then added to the crucible containing the metal to be converted into cast-steel. Upon the trial of an action for an infringement, it appeared that the defendant did not use any substance answering to the description of carburet of manganese; but he placed in the crucible, containing the iron or blistered steel, some oxide of manganese and carbonaceous matter. These two substances would form during the process of conversion, and before actual union with the melted

iron, carburet of manganese in a state of fusion; but the quantity of the carburet so formed was less than one per cent. of the weight of iron in the crucible. It was held by the Court of Exchequer, that since the defendant had not contemplated the use of carburet of manganese, and had not known, prior to the investigation that took place in consequence of the action, that the result of his adding the oxide and carbon was to produce the carburet—since, moreover, the patentee had expressly stated his invention to be the addition of the substance called carburet of manganese to the crucible, there was no infringement on the part of the defendant, for there was no imitation of the patentee's process behind a colourable variation. The specification was construed as claiming the use of one particular combination of carbon and manganese, namely, the carburet of that metal; and a particular mode of using that combination, namely, by putting a certain quantity by weight, in an unmelted state, into the crucible.

*Heath* v. *Unwin* subsequently went before the Court of Exchequer Chamber. A majority of the judges of that court held that, inasmuch as the plaintiff had not limited his claim to the particular mode of using the carburet described in his specification, the defendant's process was an infringement of the patented invention, since it effected the manufacture of cast-steel by the employment of either carburet of manganese, or a chemical equivalent. A minority of the judges thought that the defendant had not infringed the patent; for, though he had used a chemical equivalent for the carburet of manganese—viz. its component parts—it was not known at the date of the patent that such component parts were equivalent to the carburet, in such

special applications of it as were described in the specification, and for the purposes there mentioned. Moreover, they thought that the defendant's process was an improvement upon the plaintiff's, for the same quality of steel was made at less expense, one crucible and one heating effecting the desired result.

When this extraordinary case came before the House of Lords, the judges were called upon to attend the argument, and give their opinions. Eleven judges attended, seven of whom concurred with the Court of Exchequer Chamber, and four disagreed. Notwithstanding this large majority, the two law lords who heard the case (*Lord Cranworth and Lord Brougham*) gave judgment for the plaintiff in error, thereby deciding that Heath's patent had not been infringed. "I think," said *Lord Cranworth*, "that the use of substances thus producing carburet of manganese in a state of fusion was no violation of the patent. The substance for the use of which (*inter alia*) the patent was granted was a solid metallic substance, capable of being broken into fragments, and weighed, so that certain definite quantities might be put into the crucible with the steel. There is no evidence whatever tending to prove that, at the date of the patent, it was known to persons acquainted with the subject of manufacturing steel, that coal-tar and oxide of manganese would be a chemical equivalent for the carburet of manganese claimed by Heath. Indeed it is obvious that the discovery of such an equivalent was made after the use of the carburet, as a distinct metallic substance, had been some short time in operation. It was itself a most valuable discovery, and would have legitimately formed the subject of a new patent. The costly nature

of the substance claimed in the patent might, and probably would, have prevented its use altogether; and if, at the date of the specification, it was known to Heath, that by the use of two common substances, well known in commerce, more than one hundredfold cheaper than carburet of manganese, the same results precisely would be obtained, as by the use of that material, the specification would have been bad, as not truly disclosing the invention. On the short ground, therefore, that the invention claimed is for the use of a particular metallic substance, viz. carburet of manganese in certain definite proportions, according to the weight of the steel under fusion, and that no such substance, nor any equivalent for it, known to be such at the date of the specification, was used by the defendant, I think that there was no evidence of infringement." (5 H. L. C. 505, 543.)

On the trial of *Muntz v. Foster* (W. P. C. 2. 96), an action brought for the infringement of a patent for an improved manufacture of metal plates for sheathing the bottoms of ships, it appeared that the patentee claimed the invention of an alloy of 60 per cent. of copper and 40 per cent. of zinc—the copper and zinc being of the best quality—which alloy could be rolled at a red heat into sheets that furnished a sheathing for ships which was more durable, under the corrosive action of salt water, than copper sheathing; whilst it oxydated sufficiently to keep the ship's bottom clean from barnacles, and other things that impeded the ship's progress. A patent had been obtained in 1800, by one Collins, for an invention of a preparation or application of sundry articles or materials, to be used chiefly for the preservation of shipping or marine purposes, the specification

of which described, amongst other things, a mixture of 100 parts copper and 80 parts zinc—*i. e.* 55½ per cent. of copper and 44½ per cent. of zinc—which was to be extended into proper form by rolling. The two inventions, on their faces, seemed to be substantially the same; but the following arguments were used to prove a difference. Collins stated that other metallic substances might be added to the alloy compounded of copper and zinc; whereas Muntz alleged that foreign ingredients would destroy the value of his composition. Collins stated that a good composition might be made of 55½ per cent. of copper and 44½ per cent. of zinc; whereas Muntz alleged, that 60 per cent. of copper and 40 per cent. of zinc were the precise proportions required to produce the best metal for sheathing, and that a variation of one or two parts of copper or zinc, on one side or the other, made a very material difference in the result. Again, it was alleged on the part of Muntz, that, at the time of Collins' invention, neither copper nor zinc existed of the purity required for the successful production of an alloy as suitable as Muntz's for ship-sheathing; and that before his invention it was not possible to obtain a metal which would roll hot or cold, and could at the same time serve for sheathing. The defendants alleged, that the sheathing made by them was the result of following the directions of Collins' specification. Lord Lyndhurst, on the hearing of an appeal from an order of Vice-Chancellor *Knight Bruce*, said he was satisfied that the object could not be accomplished by uniting ordinary copper and zinc according to Collins' process. The defendants must, therefore, have originally used, not the ordinary, but the purest quality of the two metals, or they must have

purified them in the course of the process, by some mode not suggested in Collins' specification. In one case, the invasion of Muntz's invention was plain and direct; in the other, it was colourable and indirect. Furthermore, witnesses stated that no person could make the compound material by following Collins' directions. The jury found a verdict for the plaintiff, the judge having taken a favourable view of Muntz's case in his address to the jury. (W. P. C. 2. 94, 112.)

When a mode of carrying a principle into effect has been invented, and the principle itself is new, then a patent can be obtained for securing, not only that particular mode, but every other mode of carrying the principle into effect. "When you have invented some mode of carrying the principle into effect," said *Alderson, B.*, in *Jupe* v. *Pratt* (W. P. C. 1. 146), "you are entitled to protect yourself from all other modes of carrying the same principle into effect."

"There never were two things to the eye more different" said *Alderson, B.*, (W. P. C. 1. 146), commenting upon the case of *Crossley* v. *Beverley*, "than the plaintiff's invention of a gas-meter, and what the defendant had done in contravention of the patent-right. The plaintiff's invention was different in form, different in construction; it agreed with it only in one thing, and that was, by moving in the water, a certain point was made to open, either before or after, so as to shut up another, and the gas was made to pass through this opening; passing through it, it was made to revolve it. The scientific men, all of them, said, the moment a practical scientific man has got that principle in his head he can multiply, without end, the forms in which that principle can be made to operate."

And it has been held, that a patent for improvements in a known process secures those improvements to the patentee, whether applied to the process as known at the date of the patent, or to the same process altered and improved by discoveries not known at that time, so long as that process remains essentially the same. (*Electric Telegraph Company* v. *Brett*, 10 C. B. 881.)

But when the principle is not new, any patent taken out for a method of carrying it into effect is substantially confined to that method, and cannot be extended to other methods obviously different, because they involve some common principle applied to the common object, and may apparently be described by the same general phrase. For example, it had been long known, that if grain were kept cool during the process of grinding, the flour was of superior quality. To effect this desideratum various contrivances had been adopted, and several patents had been obtained for them, before Bovill obtained one for an invention consisting of the application of ventilating vanes or screws at the centre of the grinding-stones, by which means air was supplied between the grinding surfaces. A portable ventilating machine, blowing in a screw vane, which caused a flow of air parallel to the axis of the vane, was attached externally to the eye of the upper millstone. When the screw vane was set in motion, air was compelled to pass through the eye of the upper millstone into the centre of the two stones, and found its way out between them. Pimm subsequently took out a patent for improvements in grinding wheat. His plan for keeping the grain cool whilst grinding consisted in the removal from the centre of both stones of a large

circular portion, and in the space thus obtained to place a fan, by the rapid rotation of which a centrifugal motion was given to the air, and it was driven between the stones. It was held that the latter method was no infringement of Bovill's; the two inventions were deemed independent original improvements, and each inventor was entitled to protection in respect of the method disclosed in the respective specifications, but could not claim beyond the method actually described and given to the public. (*Bovill* v. *Pimm*, 11 Exch. Rep. 718); and see *Curtis* v. *Platt* (11 L. T. N.S. 245).

So also in *Barber* v. *Grace* (1 Exch. 339) it was held that a mode of pressing woollen goods by a set of rollers, heated within by steam, was not an infringement of a patent for a mode of pressing similar goods by two cast-iron boxes filled with steam. The jury found that the former was not a colourable variation of the latter process, and the Court, after argument, approved of the finding.

If a patent is obtained for a general arrangement of parts, some old and some new, the whole forming a new apparatus or machine, it is not open to the public to select one of the new parts of such apparatus, and apply it to a machine *similar* in object and construction to that for which the patent was taken out. "In order to ascertain the novelty," said *Pollock, C. B.*, in the case of *Newton* v. *Grand Junction Railway Company* (5 Exch. 334), "you take the entire invention, and if, in all its parts combined together, it answers the purpose by the introduction of any new matter, by any new combination, or by a new application, it is a novelty entitled to a patent." "In considering whether the invention is new," said *Alderson, B.*, in the same

case, "the proper mode is to take the specification altogether, and see whether the matter claimed as *a whole* is new. Now the whole which may be new, as claimed, may consist in some degree of old parts, and in some degree of new parts. The question of novelty, however, will depend on whether the whole taken together is new, though it may in part consist of old parts, provided the patentee does not claim the old parts, but only the combination of them and the new. As to the infringement, the question is altogether altered; because, where the invention consists partly of what is old, and partly of what is new, the combination is the subject of the patent. Therefore, a person *cannot infringe that part of the patent* which is old, because the public cannot be prevented from using that which they had before used in that state.* If the invention consists of something new, and a combination of that with what is old, then, if an individual takes for his own, and uses that which is the new part of the patent, that is an infringement of it." See also *Smith* v. *London and South-Western Railway Co.*, (Macr. P. C. 203.) Nor, in the case of a patent for a process consisting of several parts, some old and some new, is any one entitled to use some one material part of the compound process, omitting the rest. (*Smith* v. *London and North-Western Railway Company*, 2 E. & B. 69.) And in the case of *Bovill* v. *Keyworth* (7 E. & B. 725; *S. C.* 3 Jur. N. S. 817) the Court said, "Supposing the patent to be for a combination consisting of several parts for one process, we are of opinion that the defendants are liable in this action".

* See also observations of *Martin, B.*, in *Newall* v. *Elliott*, (10 Jur. N. S. 954; *S. C.* 13 W. R. 11).

(which was brought for an alleged infringement of the plaintiff's patent), "for having used a material part of the process, which was new, for the *same* purpose as that mentioned in the specification, although they did not at the same time use all the parts of the process as specified." See also *Lister* v. *Leather* (8 E. & B. 1004; *S. C.* in error, *ibid.* 1032).

But the application of a new and material part of the combination to a purpose *different* from that for which it is applied in the patented combination does not infringe the patent. (*Lister* v. *Eastwood*, 9 L. T. N. S. 766.)

In the case of *Sellers* v. *Dickenson* (5 Exch. Rep. 312), *Pollock, C. B.*, said—"The argument addressed to us was, that this is a patent for a combination of old and new mechanism, and the defendant not having used the combination, there can be no infringement. But that is not so. There may be an infringement by using so much of a combination as is material; and it would be a question for the jury, whether that used was not substantially the same thing. . . . I think it may be laid down as a general proposition . . . that if a portion of a patent for a new arrangement of machinery is in itself new and useful, and another person, for the purpose of producing the same effect, uses that portion of the arrangement, and substitutes, for the other matters combined with it, another mechanical equivalent, that would be an infringement of the patent."

The cases of *Lister* v. *Leather* (3 Jur. N. S. 811; *S. C.* 8 E. & B. 1004; *S. C.* in error, *ibid.* 1032; 4 Jur. N. S. 947) and *The Bottle Envelope Company* v. *Seymour* (5 Jur. N. S. 174) may also be referred to in support of the

proposition that a patent for one entire combination gives protection to every new and material part without any express claim for particular parts and notwithstanding that parts of the combination are old.

In *Newall* v. *Elliott* (10 Jur. N. S. 954; *S. C.* 13 W. R. 11) a patent for an invention of improvements in apparatus employed in laying down submarine telegraph cables which consisted of an internal cone placed in the eye of the coil of cable, an external cylinder round the coil and rings suspended over it (see the claim, *ante*, p. 13) was held not to have been infringed by an apparatus in which the cable was coiled round a cylinder and prevented from slipping by means of a cylinder placed outside, it being found that this had been done before for the purpose of safe carriage, and there being no evidence that the defendants used their apparatus now for any other purpose.

It has been held that to construct a patented machine simply as an amusement or as a model is not an infringement of the patent (*Jones* v. *Pearce*, W. P. C. 1. 125), and if a person makes use of a patented process and obtains the product not for the purpose of commercial profit, he is not guilty of infringing the patent. Thus, Higgs obtained a patent for precipitating animal and vegetable matters from sewage water, with a view to their use as manures. Godwin employed the process, but solely for the purpose of purifying the sewage water, and he derived no profit from the product. It was held that the patent had not been infringed. (*Higgs* v. *Godwin*, Ell. Bl. & Ell. 529; *S. C.* 27 L. J. N. S. 421, Q. B.)

Proof of the *sale* of an article, made in the same way as that for which a patent has been taken out, such sale

being without the leave, express or implied, of the patentee, is *primâ facie* evidence of an infringement. (*Gibson* v. *Brand*, W. P. C. 1. 630.) But a licence to A to manufacture a patent article is an authority to his vendees to vend it without the consent of the patentee. (*Thomas* v. *Hunt*, 17 C. B. N. S. 183.)

The mere exposure for sale of a patented article will not be held an infringement. An actual sale must be proved. (*Minter* v. *Williams*, W. P. C. 1. 137.)

The sale of articles imported from abroad is an infringement of a patent. (*Walton* v. *Lavater*, 8 C. B. N. S. 162.)

So also is the user in this country of a patented article made abroad, even when such user is merely passive and takes place in the course of transit from one foreign country where the articles have been made to another to which they are consigned. (*Betts* v. *Neilson*, 6 N. R. 221, affirmed on appeal, *ibid.* 361; *S. C.* fully reported on the appeal, 11 Jur. N. S. 679.) In this case, bottles of beer sent from Scotland protected by capsules contravening an English patent were transhipped for convenience of exportation to India in an English port. It was held, first, by *Wood*, *V.C.*, and afterwards by the Court of Appeal, that as the capsules were necessary for the preservation of the beer there had been a user of the invention in England, and an injunction was granted. But his Honour said he could well conceive a case in which there would be no user in England, as, for instance, foreign tools infringing an English patent, packed up in boxes and lying inert, or transhipped in course of transit in an English harbour (6 N. R. 222). See also *Caldwell* v. *Van Vlissengen* (9 Hare. 415. 428), where the user was

an active use; and on the general question of infringement by user, *The Universities of Oxford and Cambridge* v. *Richardson* (6 Ves. 689); *Minter* v. *Williams* (W. P. C. 1. 137.)

When a patent is for a new combination of machinery every part being old, it may be that the manufacture of such parts in this country, and the exportation of them abroad, will be no infringement; but it is clearly otherwise when the part so made and exported is new and is claimed as new. (*Goucher* v. *Clayton*, 11 Jur. N. S. 462, 465.)

A patent for the United Kingdom, the Channel Islands, and the Isle of Man, will not be infringed by acts done on board a British vessel at Malta or on the high seas. (*Newall* v. *Elliott*, 10 Jur. N. S. 954; *S. C.* 4 N. R. 429.)

Every part of an invention comprised in a patent is protected, and an infringement of any part will render the person infringing it actionable. (*Gillett* v. *Wilby*, W. P. C. 1. 271; *Crane* v. *Price*, W. P. C. 1. 411; *S. C.* 4 M. & Gr. 606.)

In the case of interfering patents, the following rule was laid down by *Pollock, C. B.*, in *Bush* v. *Fox* (Macr. P. C. 165):—"Whenever it appears that the use of a prior patent invention would be an infringement of a subsequent patent, the second patent cannot be sustained." See also *Thomas* v. *Foxwell* (5 Jur. N. S. 39) and *Betts* v. *Menzies* (1 Ell. & Ell. 1020; *S. C.* 6 Jur. N. S. 1290). But a patent for an improvement on an invention which is already the subject of a patent is not an infringement of the former patent, provided the second patent is confined to the improvement. (*Lister* v. *Leather*, 3 Jur. N. S. 813; *S. C.* 8 E. & B. 1017.)

Palmer had a patent for improvements in the manufacture of candles, and under this patent he made candles with plaited wicks, in the manner described in the specification. On the trial of an action for an infringement, a candle with a plaited wick, made by the defendant, was produced to the jury, as evidence that he had infringed the patent. It was held that, as the patent was not for the candle itself, but for the mode of manufacturing it, the mere production of a candle similar to the plaintiff's was no evidence that it had been made by his patented method. It should have been shown how the candle had been made, seeing that it was quite possible the same result had been produced by a different method. (*Palmer* v. *Wagstaff*, 9 Exch. 494; 8 Exch. 840.)

A patent was obtained for a process of purifying coal gas by means of hydrated oxide of iron, and the method of obtaining that material artificially was described in the specification. The use of a natural substance called bog ochre, containing oxide of iron, was held not to be an infringement of the patent. The specification also described and claimed a mode of revivifying the artificial oxide for subsequent use in the same way. *Lord Westbury, C.*, granted an injunction to restrain the user of the natural substance after it had been revivified by the process described in the patent. (*Hills* v. *Liverpool Gas Company*, 9 Jur. N. S. 140.)

In the case of *Stead* v. *Anderson* (W. P. C. 2. 156), *Wilde, C. J.*, delivering the judgment of the Court of Common Pleas, laid down the rule that the defendant's intention is immaterial in determining the question of infringement, and remarked upon the judgment of the

Court of Exchequer, in the case of *Heath* v. *Unwin*, in these words:—"It may be observed that, in the action of *Heath* v. *Unwin*, the Court of Exchequer seems to have deemed it material to consider the intention of the defendant, in determining whether he had infringed a patent. But, in that case, the evidence negatived any such intention, and the other circumstances of the case were not such as to show an infringement; so that there was no evidence as to what the effect of such intention would be, and we think it clear that the action is maintainable in respect of what the defendant does, not what he intends." And *Shadwell, V. C.*, said, in *Heath* v. *Unwin* (15 Sim. 553), "I am at a loss to see how the want of intention can be any answer where the act complained of is an injury. The party complaining of the act is not the less prejudiced by it because it was committed unintentionally."

In the event of one of two assignees of a patent dying, the surviving assignee may bring actions for infringements committed in the lifetime of his co-assignee, and can recover the whole damages. (*Smith* v. *London & N. W. R. Co.*, 2 E. & B. 69; *S. C.* Macr. P. C. 207.) An injunction will be granted by the Court of Chancery at the suit of exclusive licensees, to restrain infringement of a patent (*Renard* v. *Levinstein*, 13 W. R. 382).

By the twenty-sixth section of the Patent Law Amendment Act, 1852, the use of an invention for which British letters patent have been obtained in any foreign vessel, or for the navigation of any foreign vessel, which may be in any port of the Queen's dominions, or in any of the waters within the jurisdiction of any of the Queen's courts, shall not be deemed an infringe-

ment of such letters patent, where such invention is not used for the manufacture of any commodities to be vended within or exported from the Queen's dominions.

The seventh section of the statute 5 and 6 Will. IV., cap. 83, imposes a penalty of £50 upon any person marking on things made, used, or sold by him, the name, or any imitation of the name, of the patentee, without leave in writing from him or his assigns. A like penalty is imposed on a person marking such thing with the word "patent," the words "letters patent," or the words "by the king's patent," not having purchased it from or under the patentee, or not having obtained his licence in writing so to do; and a person imitating or counterfeiting the stamp, mark, or device of a patentee is subjected to a like penalty. See *Myers* v. *Baker* (3 H. & N. 802).

By the 43rd section of the Patent Law Amendment Act, 1852, the judge is empowered on the trial of any action for infringement to certify that the validity of the letters patent came in question in the action; and this certificate being given in evidence in any future suit or action for infringement will entitle the plaintiff therein to his full costs, taxed as between attorney and client. This certificate may be given in suits in the Court of Chancery as well as in actions at common law. (*Needham* v. *Oxley*, 8 L. T. N. S. 604; *Davenport* v. *Rylands*, 1 Law Rep. Eq. 308.) As to what is a sufficient certificate to enable the Court to direct the costs to be taxed as above mentioned, see *Betts* v. *De Vitre* (11 Jur. N. S. 11), *Bovill* v. *Hadley* (17 C. B. N. S. 435; *S. C.* 10 L. T. N. S. 650).

# CHAPTER XIII.

## THE ACTION OF SCIRE FACIAS.

A FEW words of explanation must be afforded as to the action of *scire facias*—those words of fear so displeasing to the ear of a patentee.

This action is one brought in the name of the Crown, for the purpose of repealing a grant of letters patent, and its name is derived from two Latin words, contained in the original writ, when that langunge was employed in legal proceedings. Sir Edward Coke tells us, in his fourth Institute, that "when the king granteth anything that is grantable upon a false suggestion, the king, by his prerogative *jure regio*, may have a *scire facias* to repeal his own grant;" and that "when the king doth grant anything which by law he cannot grant, he *jure regio* (for the advancement of justice and right) may have a *scire facias* to repeal his own letters patent." And, now, not only is the Crown entitled to move in such a matter of its own will, but any one of the public has the right to call for the issue of the writ, in the name of the Crown, since a void or illegal patent is a wrong to the community.

The proceedings by *scire facias* commence and terminate in the Court of Chancery; for as the object in view is the repeal of a document to which the great

seal has been attached, the Lord Chancellor only has the power to cancel so important a document, and to remove the seal therefrom. At a certain stage of the proceedings, however,—that is to say, when issues of fact have been raised, which require to be decided by a jury—they are shifted into the Court of Queen's Bench, and the trial takes place, either at bar, or more usually before a judge at Nisi Prius. The original writ contains the "suggestions" of the prosecutor, or his legal reasons for seeking to repeal the patent; and the defendant either allows judgment to go against him by default, whereupon the patent is avoided, or he files pleas which raise the issues to be decided by a trial. The proceedings at the trial are, for the most part, similar to the proceedings in other actions where the validity of letters patent is in dispute—with this important exception, however, that whereas, in the action for an infringement, the defendant can put the patentee to *primâ facie* proof of his case, in the case of an action of *scire facias*, the burden of *primâ facie* proof lies upon the prosecutor, who must begin the trial by showing the truth of the suggestions of the writ, *e. g.* that the patentee is not the true and first inventor, that the invention was not new at the date of the patent, etc. If the Crown obtains judgment, the letters patent become wholly void, and must be produced to the Court of Chancery to be cancelled.

The prosecutor, before being allowed to obtain the writ of *scire facias*, must give a bond conditioned to pay the defendant his costs if he shall obtain a verdict and judgment in the action.

In case the patentee has assigned the patent, the writ must issue against the assignee. It must be kept

in mind that a patentee or assignee is entitled to file a disclaimer of any part of his specification after the issue of the writ of *scire facias*, and to put the disclaimer in evidence at the trial. (See the chapter on Disclaimers.)

# CHAPTER XIV.

## THE COMMISSIONERS OF PATENTS AND THEIR OFFICE.

PREVIOUS to the passing of the Patent Law Amendment Act of 1852, the business relating to patents was transacted at several government offices. To the great convenience of the public it is now wholly transacted at one, namely, the office of the Commissioners of Patents, with which is combined that branch of the Court of Chancery termed the Great Seal Patent Office. The Commissioners of Patents themselves were called into existence by the same Act. They consist of the Lord Chancellor, the Master of the Rolls, the Attorneys-General for England and Ireland, the Lord Advocate, and the Solicitors-General for England, Scotland, and Ireland. Any three of them (the Lord Chancellor or Master of the Rolls being one) may act in the name and with the powers of the whole. The Commissioners have a seal of office, whereof all courts and judges are to take notice. They have power to make rules and regulations respecting the business that comes before them, and they have annually to present a report of their proceedings to Parliament. A library, consisting of the scientific and mechanical works of all nations, has been established in connection with the office, and this is open to the public. From the same

office issues, twice a week, a publication, called *The Commissioners of Patents' Journal.* It contains a reprint of the notices relating to patents which have appeared in the *London Gazette*, and other matters connected with the business of the office.

Two very useful registers, accessible to the public on payment of a shilling, are kept at the office of the Commissioners for Patents. One is called the Register of Patents, wherein is recorded, in chronological order and with the dates, all patents granted under the recent Act, as well as the deposit or filing of specifications, disclaimers, memoranda of alterations, amendments, confirmations, and extensions, and the expiry, vacating, and cancelling of patents. The other register is called the Register of Proprietors. It contains entries of the assignments of patents, or of any share or interest therein; and of licences, mentioning the districts to which they relate, with the names of persons having shares or interests in patents and licences, and the dates of such shares or interests being acquired by such persons. Copies of entries, certified by the Commissioners, may be obtained on payment of small fees, such certified copies being directed to be received in evidence in all courts and in all proceedings, and to be taken as *primâ facie* proof of the assignment, etc., as therein expressed. It is provided by the Act of 1852, that until such entry shall have been made, the grantee of the patent shall be deemed and taken to be the sole and exclusive proprietor of the patent (sect. 35). Entries may be expunged, vacated, or varied by a judge's order under sect. 38. The making false entries in the Register of Proprietors, the forging of any writing purporting to be a

copy of any entry in such register, and the tendering in evidence of any such forged writing by any one who knows it to be forged, are made misdemeanors, punishable by fine and imprisonment, by sect. 37 of the Patent Law Amendment Act, 1852.

Printed copies of all the specifications, filed under the Patent Law Amendment Act, 1852, are purchaseable for a small sum at the Commissioners' Office, with lithographed outline copies of the drawings accompanying such specifications. Disclaimers and memoranda of alteration are likewise directed to be printed and published, by the thirtieth section of the Act of 1852.

Chronological and alphabetical indexes of all the specifications of patents enrolled in Chancery, from 1617 to the latest available date, have been published under the authority of the Commissioners, and supplemental indexes will continue to be published annually. An index, arranging the specifications according to the subject matter, has also been published. Another index, called the "Reference Index of Patents," points out the office in which each enrolled or filed specification of a patent may be consulted; the books in which specifications, law proceedings, and other subjects connected with inventions, have been noticed; also, such specifications as have been published under the Commissioners' authority. These indexes are of great service in tracing the history of inventions. There is a very useful clause in the 15 & 16 Vict. c. 115, as to the proof of patent documents in courts of justice. The fourth section of that Act directs that printed or manuscript copies or extracts, certified and sealed with the seal of the Commissioners, of letters

patent, specifications, disclaimers, etc., recorded and filed in the Commissioners' office, or in the office in Chancery, shall be received in evidence in all courts, without further proof or production of the originals.

In addition to the office of the Commissioners in London, the Act directs that they shall have offices at Edinburgh and Dublin, to which copies of all specifications, etc., shall be transmitted for the inspection of the public. (Sect. 39, Patent Law Amendment Act, 1852.) Certified duplicates of all entries made in the Register of Proprietors are directed by sect. 35 to be sent to these offices for public inspection.

Transcripts of letters patent are transmitted to the Director of Chancery in Scotland, to be recorded in the records of Chancery there; and extracts from the same are procurable, on payment of certain fees, which extracts are receivable in evidence in all courts of Scotland, to the like effect as the letters patent themselves. (Sect. 18.) Similar transcripts are sent to Dublin, for enrolment in the Irish Court of Chancery. When this has been done, the transcript or exemplification has the like effect as if the original letters patent had been enrolled there. (Sect. 29.)

Certified printed copies, under the seal of the Commissioners, of all specifications, and complete specifications, and *fac simile* printed copies of the drawings accompanying the same, also of disclaimers, etc., filed under the Patent Law Amendment Act, are directed (sect. 5 of 15 & 16 Vict., c. 115) to be sent to the office of the Director of Chancery of Scotland, and to the enrolment office of the Irish Court of Chancery, within twenty-one days of the filing; and certified copies, or extracts from such documents, are procur-

able by any person on payment of certain fees. Such copies or extracts can be given in evidence in all courts in Scotland and in Ireland respectively, in proceedings relating to patents for inventions, without further proof or production of the originals.

# APPENDIX.

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## PART I.

## STATUTES, RULES, AND FORMS.

### Statutes.

21 JAMES I. CH. 3.
5 & 6 WILLIAM IV. CH. 83.
2 & 3 VICTORIA, CH. 67.
7 & 8 VICTORIA, CH. 69.
15 & 16 VICTORIA, CH. 83.
15 & 16 VICTORIA, CH. 115.
16 VICTORIA, CH. 5.
22 VICTORIA, CH. 13.

# APPENDIX.

## PART I.

## STATUTES.

### 21 Jac. I. c. 3. [A.D. 1623.]

*An Act concerning Monopolies and Dispensations with Penal Laws, and the Forfeitures thereof.*

Monopolies, etc., contrary to the laws of the realm.

Forasmuch as your most excellent Majesty, in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did in the year of our Lord God 1610, publish in print to the whole realm, and to all posterity, that 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 Majesties laws, which your Majesties 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 Majesties subjects, contrary to the laws of this your realm, and contrary to your Majesties most royal and blessed intention so published, as aforesaid; for avoiding thereof, and preventing of

the like to come, may it please your excellent Majesty, at the humble suit of the Lords Spiritual and Temporal, and the Commons in this present Parliament assembled, that it may be declared and enacted, and be it declared and enacted by authority of this present Parliament, that all monopolies, and all commissions, grants, licences, charters, and letters patents heretofore made or granted, or hereafter to be made or granted to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of anything within this realm, or the dominion of Wales; or of any other monopolies, or of power, liberty, or faculty to dispense with any others, or to give licence or toleration to do, use, or exercise anything against the tenour or purport of any law or statute; or to give or make any warrant for any such dispensation, licence, or toleration to be had or made, or to agree or compound with any others for any penalty or forfeitures limited by any statute, or of any grant or promise of the benefit, profit, or commodity of any forfeiture, penalty, or sum of money, that is or shall be due by any statute, before judgment thereupon had, and all proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things whatsoever, any way tending to the instituting, erecting, strengthening, furthering, or countenancing of the same, or any of them, are altogether contrary to the laws of this realm, and so are, and shall be utterly void and of none effect, and in no wise to be put in use or execution.

Monopolies, etc., shall be tried by the common laws of this realm.

2. And be it further declared and enacted by the authority aforesaid, that all monopolies, and all such commissions, grants, licences, charters, letters patents, proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things tending, as aforesaid, and the force and validity of them, and every of them, ought to be, and shall be for ever hereafter examined, heard, tryed, and determined by and according to the common laws of this realm, and not otherwise.

All persons disabled to use monopolies, etc.

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

The party grieved by pretext of a monopoly, etc., shall recover treble damages and double costs.

4. And be it further enacted by the authority aforesaid, that if any person or persons at any time after the end of forty days next, after the end of this present session of parliament, shall be hindred, grieved, disturbed, or disquieted, or his or their goods or chattels any way seized, attached, distrained, taken, carried away, or detained, by occasion or pretext of any monopoly, or of any such commission, grant, licence, power, liberty, faculty, letters 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 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 an 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 hindred, grieved, disturbed, or disquieted, or against him or them by whom his or their goods or chattels shall be so seized, attached, distrained, taken, carried away or detained, wherein all and every such person and persons which shall be so hindred, grieved, disturbed, or disquieted, or whose goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained, shall recover three times so much as the damages which he or they sustained, by means or occasion of being so hindred, grieved, disturbed, or disquieted, or by means of having his or their goods or

chattels seized, attached, distrained, taken, carried away, or detained, and double costs; and in such suits, or for the staying or delaying thereof, no essoin, protection, wager of law, aid, prayer, privilege, injunction, or order of restraint, shall be in any wise prayed, granted, admitted or allowed, nor any more than one imparlance: And if any person or persons shall, after notice given that the action depending is grounded upon this statute, cause or procure any action at the common law, grounded upon this statute, to be stayed or delayed before judgment, by colour or means of any order, warrant, power, or authority, save only of the court wherein such action, as aforesaid, shall be brought and depending, or after judgment had upon such action, shall cause or procure the execution of or upon any such judgment to be stayed or delayed by colour or means of any order, warrant, power, or authority, save only by writ of error or attaint, that then the said person and persons so offending, shall incur and sustain the pains, penalties, and forfeitures ordained and provided by the statute of provision and præmunire, made in the sixteenth year of the reign of King Richard the Second.

He that delayeth an action grounded upon this statute incurs a *præmunire*.

St. 16 R. ii. c. 5.

Letters patents to use new manufactures, saved.

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

from the date of the first letters patents and grants thereof made, shall be of such force as they were or should have been, if the same had been made but for term of one and twenty years only, and as if this Act had never been had or made, and of none other.

6. Provided also, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patents and grants of privilege for the term of fourteen years or under, hereafter to be made, of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patents and grants shall not use, so as also they be not contrary to the law, nor mischievous to the state, by raising prices of commodities at home, or hurt of trade, or generally inconvenient: the said fourteen years to be accompted 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.

Grants confirmed by Act of Parliament, saved.

7. Provided also, and it is hereby further intended, declared, and enacted by authority aforesaid, that this Act, or any thing therein contained, shall not in any wise extend, or be prejudicial to any grant or privilege, power or authority whatsoever heretofore made, granted, allowed, or confirmed by any Act of Parliament now in force, so long as the same shall so continue in force.

Warrants granted to justices, saved.

8. Provided also, that this Act shall not extend to any warrant or privy seal, made or directed, or to be made or directed by his Majesty, his heirs or successors, to the justices of the Courts of the King's Bench, or Common Pleas, and barons of Exchequer, justices of assize, justices of oyer and terminer, and gaol delivery, justices of the peace, and other justices for the time being, having power to hear and determine offences done against any penal statute, to compound for the forfeitures of any penal statute, depending in

suit and question before them, or any of them respectively, after plea pleaded by the party defendant.

Charters granted to corporations, saved.

9. Provided also, and it is hereby further intended, declared, and enacted, that this Act, or anything therein contained, shall not in any wise extend or be prejudicial unto the city of London, or to any city, borough, or town-corporate within this realm, for, or concerning any grants, charters, or letters patents to them, or any of them, made or granted, or for, or concerning any custom or customs used by or within them, or any of them, or unto any corporations, companies, or fellowships of any art, trade, occupation, or mystery, or to any companies or societies of merchants within this realm, erected for the maintenance, enlargement, or ordering of any trade or merchandise; but that the same charters, customs, corporations, companies, fellowships, and societies, and their liberties, privileges, powers, and immunities, shall be and continue of such force and effect as they were before the making of this Act, and of none other; anything before in this Act contained to the contrary in any wise notwithstanding.

Letters patents that concern printing, saltpetre, gunpowder, great ordnance, shot, or offices, saved.

10. Provided also, and be it enacted, that this Act, or any declaration, provision, disablement, penalty, forfeiture, or other thing before mentioned, shall not extend to any letters patents, or grants of privilege heretofore made, or hereafter to be made, of, for, or concerning printing, nor to any commission, grant, or letters patents heretofore made, or hereafter to be made, of, for, or concerning the digging, making, or compounding of saltpetre or gunpowder; or the casting or making of ordnance; or shot for ordnance; nor to any grant or letters patents heretofore made, or hereafter to be made, of any office or offices heretofore erected, made, or ordained, and now in being, and put in execution, other than such offices as have been decried by any 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 maintain-

ing, strengthening, or furtherance of the same, or any of them, shall be and remain of the like force and effect, and no other, and as free from the declarations, provisions, penalties, and forfeitures contained in this Act, as if this Act had never been had nor made, and not otherwise.

This Act shall not extend to commissions for alum mines.

11. Provided also, and be it enacted, that this Act, or any declaration, provision, disablement, penalty, forfeiture, or other thing before mentioned, shall not extend to any commission, grant, letters patents, or privilege, heretofore made, or hereafter to be made, of, for, or concerning the digging, compounding, or making of alum or alum mines, but that all and every the same commissions, grants, letters patents, and privileges, shall be and remain of the like force and effect, and no other, and as free from the declarations, provisions, penalties, and forfeitures contained in this Act, as if this Act had never been had nor made, and not otherwise.

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## 5 & 6 WILL. IV. c. 83.

### *An Act to amend the Law touching Letters Patent for Inventions.*

10*th Sept.*, 1835.

WHEREAS it is expedient to make certain additions to and alterations in the present law touching letters patent for inventions, as well for the better protecting of patentees in the rights intended to be secured by such letters patent, as for the more ample benefit of the public from the same: Be it enacted by, etc., 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 Ire-

Disclaimer of any part of specification, or a memorandum of any alteration therein.

* See 15 & 16 Vict. c. 83, s. 39, *post*.—*Eds.*

land, respectively, as the case may be, having first obtained the leave of his Majesty's attorney-general or solicitor-general in case of an English patent, of the lord advocate or solicitor-general of Scotland in case of a Scotch patent, or of his Majesty's attorney general or solicitor-general for Ireland in case of an Irish patent, certified by his fiat and signature, a disclaimer* of any part of either the title of the invention or of the specification, stating the reason for such disclaimer, or may, with such leave as aforesaid, enter a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent; and such disclaimer or memorandum of alteration being filed by the said clerk of the patents, and enrolled with the specification, shall be deemed and taken to be part of such letters patent or such specification in all courts whatever: Provided always, that any person may enter a caveat, in like manner as caveats are now used to be entered, against such disclaimer or alteration; which caveat being so entered shall give the party entering the same a right to have notice of the application being heard by the attorney-general, or solicitor-general, or lord advocate, respectively: Provided also, that no such disclaimer or alteration shall be receivable in evidence in any action or suit (save and except in any proceeding by *scire facias*) pending at the time when such disclaimer or alteration was enrolled, but in every such action or suit the original title and specification alone shall be given in evidence, and deemed and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted: Provided also, that it shall be lawful for the attorney-general, or solicitor-general, or lord advocate, before granting such fiat, to require the party applying for the same to advertise his disclaimer or alteration in such manner

Caveat.

Disclaimer not to affect actions pending at the time.

Attorney-general may require the party to advertise his disclaimer.

* It is sufficient to file a *copy* of the disclaimer. (*Wallington* v. *Dale*, 6 Exch. 284)—*Eds.*

as to such attorney-general, or solicitor-general, or lord advocate shall seem right, and shall, if he so require such advertisement, certify in his fiat that the same has been duly made.

Mode of proceeding where patentee is proved not to be the real inventor, though he believed himself to be so.*

2. And be it enacted, that if in any suit or action it shall be proved, or specially found by the verdict of a jury, that any person who shall have obtained letters patent for any invention or supposed invention, was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same, or some part thereof, before the date of such letters patent, or if such patentee or his assigns shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof, before the date of such letters patent, it shall and may be lawful for such patentee or his assigns to petition his Majesty in council to confirm the said letters patent, or to grant new letters patent, the matter of which petition shall be heard before the judicial committee of the privy council: and such committee, upon examining the said matter, and being satisfied that such patentee believed himself to be the first and original inventor, and being satisfied that such invention or part thereof had not been publicly and generally used before the date of such first letters patents, may report to his Majesty their opinion that the prayer of such petition ought to be complied with, whereupon his Majesty may, if he think fit, grant such prayer; and the said letters patent shall be available in law and equity to give to such petitioner the sole right of using, making, and vending such invention as against all persons whatsoever, any law, usage, or custom to the contrary thereof notwithstanding: Provided, that any person opposing such petition shall be entitled to be heard before the said judicial committee: Provided also, that any person, party to any former suit or action touching such first letters patent, shall be entitled to have notice of such petition before presenting the same.

If a verdict pass for the patentee,

3. And be it enacted, that if any action at law or any suit

* See 15 & 16 Vict. c. 83, s. 40, *post*.—*Eds*.

the judge may grant a certificate, which being given in evidence in any other suit, shall entitle the patentee, upon a verdict in his favour, to treble costs.*

in equity for an account shall be brought in respect of any alleged infringement of such letters patent heretofore or hereafter granted, or any *scire facias* to repeal such letters patent, and if a verdict shall pass for the patentee or his assigns, or if a final decree or decretal order shall be made for him or them, upon the merits of the suit, it shall be lawful for the judge before whom such action shall be tried to certify on the record, or the judge who shall make such decree or order to give a certificate under his hand, that the validity of the patent came in question before him, which record or certificate being given in evidence in any other suit or action whatever touching such patent, if a verdict shall pass, or decree or decretal order be made, in favour of such patentee or his assigns, he or they shall receive treble costs in such suit or action, to be taxed at three times the taxed costs, unless the judge making such second or other decree or order, or trying such second or other action, shall certify that he ought not to have such treble costs.

Mode of proceeding in case of application for the prolongation of the term of a patent.†

4. And be it further enacted, that if any person who now hath or shall hereafter obtain any letters patent as aforesaid, shall advertise in the *London Gazette* three times, and in three *London* papers, and three times in some country paper published in the town where or near to which he carried on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carried on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town,‡ that he intends to apply to his Majesty in council for a prolongation of his term of sole using and vending his invention, and shall petition his Majesty in council to that effect, it

* See 15 & 16 Vict. c. 83, s. 43.—*Eds.*

† See 2 & 3 Vict. c. 67, s. 2; 7 & 8 Vict. c. 69, ss. 2, 3, 4; 15 & 16 Vict. c. 83, s. 40; 16 & 17 Vict. c. 115, s. 7.—*Eds.*

‡ Where the petitioner resides abroad, and has no manufactory in England, he will sufficiently comply with this part of the section if he insert advertisements in the newspapers published in the towns or county where his licensees are resident. (*Derosne's Patent*, 4 Moore P. C. C. 416; *S. C.* W. P. C. 2. 2.)—*Eds.*

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.*

In case of action etc., notice of objections to be given.

5. And be it enacted, that in any action brought against any person for infringing any letters patent, the defendant on pleading thereto shall give to the plaintiff, and in any *scire facias* to repeal such letters patent the plaintiff shall file with his declaration, a notice of any objections on which he means to rely at the trial of such action, and no objection shall be allowed to be made in behalf of such defendant or plaintiff respectively at such trial, unless he prove the objections stated in such notice: Provided always, that it shall and may be lawful for any judge at chambers, on summons served by such defendant or plaintiff on such plaintiff or defendant respectively, to show cause why he should not be allowed to offer other objections whereof notice shall not have been given as aforesaid, to give leave to offer such objections, on such terms as to such judge shall seem fit.†

* See 2 & 3 Vict. c. 67, s. 2, *post*.—*Eds.*

† This section is impliedly repealed by 15 & 16 Vict. c. 83, s. 34, *post*.—*Eds.*

As to costs in actions for infringing letters patent.

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

Penalty for using, unauthorized, the name of a patentee, etc.

7. And be it enacted, that if any person shall write, paint, or print, or mould, cast, or carve, or engrave or stamp, upon anything made, used, or sold by him, for the sole making or selling of which he hath not or shall not have obtained letters patent, the name or any imitation of the name of any other person who hath or shall have obtained letters patent for the sole making and vending of such thing without leave in writing of such patentee or his assigns, or if any person shall upon such thing, not having been purchased from the patentee or some person who purchased it from or under such patentee, or not having had the licence or consent in writing of such patentee or his assigns, write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word "patent," the words "letters patent," or the words "by the king's patent," or any words of the like kind, meaning, or import, with a view of imitating or counterfeiting the stamp, mark, or other device of the patentee, or shall in any other manner imitate or counterfeit the stamp or mark or other device of the patentee, he shall for every such offence be liable to a penalty of 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

* This section is impliedly repealed by 15 & 16 Vict. c. 83, s. 43, *post*.—*Eds.*

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.

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## 2 & 3 VICT. c. 67.

*An Act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled An Act to amend the Law touching Letters Patent for Inventions.*

*24th August*, 1839.

WHEREAS by an Act passed in the fifth and sixth years of the reign of his Majesty King William the Fourth, intituled *An Act to amend the Law touching Letters Patent for Inventions*, it is amongst other things enacted, 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 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

5 & 6 W. IV. c. 83.

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:

Repealing provision as to presenting petition for extension before the expiration of the patent.

Be it therefore enacted by, etc., 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.

Term may be extended though the application for extension be not prosecuted with effect before the expiration thereof.

2. And be it further enacted, that it shall be lawful for the judicial committee of the Privy Council, in all cases where it shall appear to them that any application for an extension of the term granted by any letters patent, the petition for which extension shall have been referred to them for their consideration, has not been prosecuted with effect before the expiration of the said term from any other causes than the neglect or default of the petitioner to entertain such

application, and to report thereon as by the said recited Act provided, notwithstanding the term originally granted in such letters patent may have expired before the hearing of such application; and it shall be lawful for her Majesty, if she shall think fit, on the report of the said judicial committee recommending an extension of the term of such letters patent, to grant such 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*, 1839, unless such petition shall be presented six calendar months at the least before the expiration of such term, nor in any case unless sufficient reason shall be shown to the satisfaction of the said judicial committee for the omission to prosecute with effect the said application by petition before the expiration of the said term.

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## 7 & 8 VICT. C. 69.

*An Act for amending an Act passed in the fourth year of the reign of his late Majesty, intituled An Act for the better Administration of Justice in his Majesty's Privy Council; and to extend its Jurisdiction and Powers.*

*6th August*, 1844.

WHEREAS the Act passed in the fourth year of the reign of his late Majesty, intituled *An Act for the better Administration of Justice in His Majesty's Privy Council*, hath been found beneficial to the due administration of justice: And

3 & 4 Wm. IV. c. 41.

5 & 6 Wm. IV. c. 83.

whereas another Act, passed in the sixth year of the said reign, intituled *An Act to amend the Law touching Letters Patent for Inventions*, hath been also found advantageous to inventors and to the public: And whereas the judicial committee, acting under the authority of the said Acts, hath been found to answer well the purposes for which it was so established by Parliament, but it is found necessary to improve its proceedings in some respects, for the better dispatch of business, and expedient also to extend its jurisdiction and powers. [*The remainder of the preamble, and subsequent clause, do not relate to patents.*]

On petition, her Majesty may grant an extension of patent term in certain cases.

2. And whereas it is expedient, for the further encouragement of inventions in the useful arts, to enable the time of monopoly in patents to be extended in cases in which it can be satisfactorily shown that the expense of the invention hath been greater than the time now limited by law will suffice to reimburse; but be it enacted, that if any person, having obtained a patent for any invention, shall, before the expiration thereof, present a petition to her Majesty in council, setting forth that he has been unable to obtain a due remuneration for his expense and labour in perfecting such invention, and that an exclusive right of using and vending the same for the further period of seven years, in addition to the term in such patent mentioned, will not suffice for his reimbursement and remuneration, then, if the matter of such petition shall be by her Majesty referred to the judicial committee of the Privy Council, the said committee shall proceed to consider the same after the manner and in the usual course of its proceedings touching patents; and if the said committee shall be of opinion, and shall so report to her Majesty, that a further period greater than seven years' extension of the said patent term ought to be granted to the petitioner, it shall be lawful for her Majesty, if she shall so think fit, to grant an extension thereof for any time not exceeding fourteen years, in like manner and subject to the same rules as the extension for a term not exceeding

seven years is now granted under the powers of the said Act of the sixth year of the reign of his late Majesty.*

Extension may be for a lesser term than that prayed.

3. Provided always, and be it enacted, that nothing herein contained shall prevent the said judicial committee from reporting that an extension for any period not exceeding seven years should be granted, or prevent her Majesty from granting an extension for such lesser term than the petition shall have prayed.

As to extension of term where patentees have assigned their patent rights.

4. And whereas doubts have arisen touching the power given by the said recited Act of the sixth year of the reign of his late Majesty in cases where the patentees have wholly or in part assigned their right; be it enacted, that it shall be lawful for her Majesty, on the report of the judicial committee, to grant such extension as is authorized by the said Act and by this Act, either to an assignee or assignees, or to the original patentee or patentees, or to an assignee or assignees and original patentee or patentees conjointly.†

Disclaimer and memorandum of alteration notwithstanding original patentee may have assigned his patent right.

5. And be it enacted that in case the original patentee or patentees hath or have departed with his or their whole or any part of his or their interest by assignment to any other person or persons, it shall be lawful for such patentee, together with such assignee or assignees, if part only hath been assigned, and for the assignee or assignees, if the whole hath been assigned, to enter a disclaimer and memorandum of alteration under the powers of the said recited Act; and such disclaimer and memorandum of such alteration, having been so entered and filed as in the said recited Act mentioned, shall be valid and effectual in favour of any person or persons in whom the rights under the said letters patent may then be or thereafter become legally vested; and no objection shall be made in any proceeding whatsoever on

* When a prolongation of the Patent term has once been granted under this section, the jurisdiction of the Judicial Committee is exhausted, and they have no power to entertain an application for a further extension. (*Goucher's Patent*, 2 Moore, P.C.C. N. S. 532).

† As to this section see *Napier's Patent* (13 Moo. P. C. C. 543); *Hutchison's Patent* (14 Moo. P. C. C. 361); and the cases cited *ante*, Chap. X.

the ground that the party making such disclaimer or memorandum of such alteration had not sufficient authority in that behalf.

Disclaimer and memorandum of alteration already made to be deemed valid.

6. And be it enacted, that any disclaimer or memorandum of alteration before the passing of this Act, or by virtue of the said recited Act, by such patentee with such assignee or by such assignee as aforesaid, shall be valid and effectual to bind any person or persons in whom the said letters patent might then be or have since become vested; and no objection shall be made in any proceeding whatsoever that the party making such disclaimer or memorandum of alteration had not authority in that behalf.

New letters patent granted under 5 & 6 Wm. IV., to assignees before passing of this Act declared valid.

7. And be it enacted, that any new letters patent which before the passing of this Act may have been granted, under the provisions of the above-recited Act of the sixth year of the reign of his late Majesty, to an assignee or assignees, shall be as valid and effectual as if the said letters patent had been made after the passing of this Act, and the title of any party to such new letters patent shall not be invalidated by reason of the same having been granted to an assignee or assignees: provided always, that nothing herein contained shall give any validity or effect to any letters patent heretofore granted to any assignee or assignees where any action or proceeding in *scire facias* or suit in equity shall have been commenced at any time before the passing of this Act, wherein the validity of such letters patent shall have been or may be questioned.

Proviso.

Judicial committee may appoint clerk of Privy Council to take proofs in matters referred to them.

8. Provided always, and be it enacted, that in the case of any matter or thing being referred to the judicial committee, it shall be lawful for the said committee to appoint one or other of the clerks of the Privy Council to take any formal proofs required to be taken in dealing with the matter or thing so referred, and shall, if they so think fit, proceed upon such clerk's report to them as if such formal proofs had been taken by and before the said judicial committee.

## 15 & 16 VICT. c. 83.

*An Act for amending the Law for granting Patents for Inventions.*

1st *July*, 1852.

WHEREAS it is expedient to amend the law concerning letters patent for inventions: Be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:—

Certain persons constituted Commissioners of patents for inventions, three of whom may act, the Chancellor or Master of the Rolls being one.

1. The Lord Chancellor, and Master of the Rolls, her Majesty's Attorney-General for England, her Majesty's Solicitor-General for England, the Lord Advocate, her Majesty's Solicitor-General for Scotland, her Majesty's Attorney-General for Ireland, and her Majesty's Solicitor-General for Ireland, for the time being respectively, together with such other person or persons as may be from time to time appointed by her Majesty, as hereinafter mentioned shall be Commissioners of Patents for Inventions; and it shall be lawful for her Majesty from time to time, by warrant under her royal sign-manual, to appoint such other person or persons as she may think fit to be a Commissioner or Commissioners as aforesaid; and every person so appointed shall continue such Commissioner during her Majesty's pleasure; and all the powers hereby vested in the Commissioners may be exercised by any three or more of them, the Lord Chancellor or Master of the Rolls being one.

Seal of the Commissioners.

2. It shall be lawful for the Commissioners to cause a seal to be made for the purposes of this Act, and from time to time to vary such seal, and to cause to be sealed therewith all the warrants for letters patent under this Act, and all instruments and copies proceeding from the office of the Commissioners, and all courts, judges, and other persons

whomsoever shall take notice of such seal, and receive impressions thereof in evidence, in like manner as impressions of the great seal are received in evidence, and shall also take notice of and receive in evidence, without further proof or production of the originals, all copies or extracts, certified under the seal of the said office, of or from documents deposited in such office.

Power to Commissioners to make rules and regulations, which shall be laid before Parliament.

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

Commissioners to report annually to Parliament.

Treasury to provide offices.

4. It shall be lawful for the Commissioners of her Majesty's Treasury to provide and appoint from time to time proper places or buildings for an office or offices for the purposes of this Act.

Commissioners, with consent of the Treasury, to appoint clerks, etc.

5. It shall be lawful for the Commissioners, with the consent of the Commissioners of the Treasury, from time to time to appoint, for the purposes of this Act, such clerks and officers as the Commissioners may think proper; and it shall be lawful for the Commissioners from time to time to remove any of the clerks and officers so appointed.

Petition and declaration to be accompanied with a provisional specification.

6. Every petition for the grant of letters patent for an invention, and the declaration required to accompany such petition, shall be left at the office of the Commissioners, and there shall be left therewith a statement in writing, hereinafter called the provisional specification,* signed by or on

* See Rule X. of the second set of rules of the Patent Commissioners.—*Eds.*

behalf of the applicant for letters patent, describing the nature of the said invention; and the day of the delivery of every such petition, declaration, and provisional specification shall be recorded at the said office, and endorsed on such petition, declaration, and provisional specification, and a certificate thereof given to such applicant or his agent; and all such petitions, declarations, and provisional specifications shall be preserved in such manner as the Commissioners may direct, and a registry there of and of all proceedings thereon kept at the office of the Commissioners.

Every application to be referred to one of the law officers.

7. Every application for letters patent made under this Act shall be referred by the Commissioners, according to such regulations as they may think fit to make, to one of the law officers.

The provisional specification to be referred to the law officer, who, if satisfied, may give a certificate of his allowance, which shall be filed.

8. The provisional specification shall be referred to the law officer, who shall be at liberty to call to his aid such scientific or other person as he may think fit, and to cause to be paid to such person by the applicant such remuneration as the law officer shall appoint; and if such law officer be satisfied that the provisional specification describes the *nature of the invention, he shall allow the same*, and give a certificate of his allowance, and such certificate shall be filed in the office of the Commissioners, and thereupon the invention therein referred to may, during the term of six months from the date of the application for letters patent for the said invention, be used and published without prejudice to any letters patent to be granted for the same, and such protection from the consequences of use and publication is hereinafter referred to as provisional protection: Provided always, that in case the title of the invention or the provisional specification be too large or insufficient, it shall be lawful for the law officer to whom the same is referred to allow or require the same to be amended.

Inventor may deposit, in lieu of a provisional

9. The applicant for letters patent for an invention, instead of leaving with the petition and declaration a pro-

specification, a complete specification, such deposit to confer for a limited time the like rights as letters patent.

visional specification as aforesaid, may, if he think fit, file with the said petition and declaration an instrument in writing under his hand and seal (hereinafter called a complete specification), particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed, which complete specification shall be mentioned in such declaration; and the day of the delivery of every such petition, declaration, and complete specification shall be recorded at the office of the commissioners, and endorsed on such petition, declaration, and specification, and a certificate thereof given to such applicant or his agent; and thereupon, subject and without prejudice to the provisions hereinafter contained, the invention shall be protected under this Act, for the term of six months from the date of the application, and the applicant shall have during such term of six months the like powers, rights, and privileges as might have been conferred upon him by letters patent for such invention, issued under this Act, and duly sealed as of the day of the date of such application; and during the continuance of such powers, rights, and privileges under this provision, such invention may be used and published without prejudice to any letters patent to be granted for the same; and where letters patent are granted in respect of such invention, then in lieu of a condition for making void such letters patent in case such invention be not described and ascertained by a subsequent specification, such letters patent shall be conditioned to become void if such complete specification, filed as aforesaid, does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed: and a copy of every such complete specification shall be open to the inspection of the public, as hereinafter provided, from the time of depositing the same, subject to such regulation as the Commissioners may make.

Letters patent granted to the first inventor not

10. In case of any application for letters patent for any invention, and the obtaining upon such application of pro-

visional protection for such invention, or of protection for the same by reason of the deposit of a complete specification as aforesaid, in fraud of the true and first inventor, any letters patent granted to the true and first inventor of such invention shall not be invalidated by reason of such application or of such provisional or other protection as aforesaid, or of any use or publication of the invention subsequent to such application, and before the expiration of the term of such provisional or other protection.

to be invalidated by protection obtained in fraud of the first inventor.

11. Where any invention is provisionally protected under this Act, or protected by reason of the deposit of such complete specification as aforesaid, the Commissioners shall cause such provisional protection or such other protection as aforesaid to be advertised in such manner as they may see fit.

Commissioners to cause protections to be advertised.

12. The applicant for letters patent, so soon as he may think fit, after the invention shall have been provisionally protected under this Act, or where a complete specification has been deposited with his petition and declaration, then so soon as he may think fit after such deposit, may give notice at the office of the Commissioners of his intention of proceeding with his application for letters patent for the said invention, and thereupon the said Commissioners shall cause his said application to be advertised in such manner as they may see fit; and any persons having an interest in opposing the grant of letters patent for the said invention shall be at liberty to leave particulars in writing of their objections to the said application at such place and within such time and subject to such regulations as the Commissioners may direct.

Application for letters patent to be advertised, and also oppositions to the same.

13. So soon as the time for the delivery of such objections shall have expired the provisional specification or complete specification (as the case may be) and particulars of objection (if any) shall be referred to the law officer to whom the application has been referred.

Specifications and objections to be referred to law officer.

14. It shall be lawful for the law officer to whom any ap- Power to law officer to order

By or to whom costs shall be paid.

plication for such letters patent is referred, if he see fit, by certificate under his hand, to order by or to whom the costs of any hearing or inquiry upon any objection, or otherwise in relation to the grant of such letters patent, or in relation to the provisional (or other) protection acquired by the applicant under this Act, shall be paid, and in what manner and by whom such costs are to be ascertained; and if any costs so ordered to be paid be not paid within four days after the amount thereof shall be so ascertained, it shall be lawful for such law officer to make an order for the payment of the same; and every such order may be made a rule of one of her Majesty's superior courts at Westminster or Dublin, and may be recorded in the books of council and session in Scotland, to the effect that execution may pass thereupon in common form.

Power to law officer to cause a warrant to be made for sealing of letters patent.

15. It shall be lawful for such law officer, after such hearing, if any, as he may think fit, to cause a warrant to be made for the sealing of letters patent for the said invention, and such warrant shall be sealed with the seal of the Commissioners, and shall set forth the tenor and effect of the letters patent thereby authorized to be granted, and such law officer shall direct the insertion in such letters patent of all such restrictions, conditions, and provisoes as he may deem usual and expedient in such grants, or necessary in pursuance of the provisions of this Act; and the said warrant shall be the warrant for the making and sealing of letters patent under this Act according to the tenor of the said warrant: Provided always, that the Lord Chancellor shall and may have and exercise such powers, authority, and discretion in respect to the said warrant, and the letters patent therein directed to be made under this Act, as he now has and might now exercise with respect to the warrant for the issue under the great seal of letters patent for any invention, and with respect to the making and issuing of such letters patent;* and the writ of *scire facias* shall lie for the repeal

Chancellor to have same powers in respect to warrant, etc., as he now has.

Writ of *scire facias.*

* No caveat against the sealing of letters patent is to be lodged without the

of any letters patent issued under this Act, in the like cases as the same would lie for the repeal of letters patent which may now be issued under the great seal.

Nothing to affect the prerogative of the crown in granting or withholding grant of letters patent.

16. Provided also, that nothing herein contained shall extend to abridge or affect the prerogative of the crown in relation to the granting or withholding the grant of any letters patent; and it shall be lawful for her Majesty, by warrant under her royal sign-manual to direct such law officer to withhold such warrant as aforesaid, or that any letters patent for the issuing whereof he may have issued a warrant as aforesaid shall not issue, or to direct the insertion in any letters patent to be issued in manner herein provided of any restrictions, conditions, or provisoes which her Majesty may think fit, in addition to or in substitution for any restrictions, conditions, or provisoes which would otherwise be inserted therein under this Act; and it shall also be lawful for her Majesty, by like warrant, to direct any complete specification which may have been filed under the provisions hereinbefore contained, and in respect of the invention described, in which no letters patent may have been granted, to be cancelled, and thereupon the protection obtained by the filing of such complete specification shall cease.

Letters patent to be made subject to avoidance on nonfulfilment of certain conditions.

17. All letters patent for inventions granted under the provisions hereinbefore contained shall be made subject to the condition that the same shall be void, and that the powers and privileges thereby granted shall cease and determine, at the expiration of three years and seven years respectively from the date thereof, unless there be paid, before the expiration of the said three and seven years respectively, the sum or sums of money and stamp duties in the schedule to this Act annexed; and the payment of the said sums of money and stamp duties respectively shall be endorsed on the warrant for the said letters patent; and such officer of

express leave of the Lord Chancellor. (*Re Heathorn's Patent*, 10 Jur. N. S. 810.) Affidavits in opposition to a patent must be filed before the morning of hearing. (*Re McKean's Patent*, 1 De G. F. & J. 2.)

the Commissioners as may be appointed for this purpose shall issue under the seal of the Commissioners a certificate of such payment, and shall endorse a receipt for the same on any letters patent issued under the authority of the said warrant; and such certificate, duly stamped, shall be evidence of the payment of the several sums respectively. [*Repealed by Act* 16 *Vict. cap.* 5.]

Letters patent issued under the great seal to be valid for the whole of the United Kingdom, the Channel Islands, and the Isle of Man.

18. The Commissioners, so soon after the sealing of the said warrant as required by the applicant for the letters patent, shall cause to be prepared letters patent for the invention, according to the tenor of the said warrant, and it shall be lawful for the Lord Chancellor to cause such letters patent to be sealed with the great seal of the United Kingdom, and such letters patent so sealed shall extend to the whole of the United Kingdom of Great Britain and Ireland, the Channel Islands, and the Isle of Man; and in case such warrant so direct, such letters patent shall be made applicable to her Majesty's colonies and plantations abroad, or such of them as may be mentioned in such warrant; and such letters patent shall be valid and effectual as to the whole of such United Kingdom, and the said islands and isle, and the said colonies or plantations, or such of them as aforesaid, and shall confer the like powers, rights, and privileges as might, in case this Act had not been passed, have been conferred by several letters patent of the like purport and effect passed under the great seal of the United Kingdom, under the seal appointed to be used instead of the great seal of Scotland, and under the great seal of Ireland respectively, and made applicable to England, the dominion of Wales, the town of Berwick-upon-Tweed, the Channel Islands, and Isle of Man, and the said colonies and plantations, or such of them as aforesaid, to Scotland, and to Ireland respectively, save as herein otherwise provided:

Nothing to give effect to any letters patent granted in any colony.

Provided always, that nothing in this Act contained shall be deemed or taken to give any effect or operation to any letters patent to be granted under the authority of this Act

in any colony in which such or the like letters patent would be invalid by the law in force in the same colony for the time being: Provided always, that a transcript of such letters shall, so soon after the sealing of the same and in such manner as the Commissioners shall direct, be transmitted to the Director of Chancery in Scotland, and be recorded in the records of Chancery in Scotland, upon payment of such fees as the Commissioners shall appoint, in the same manner and to the same effect in all respects as letters patent passing under the seal appointed by the treaty of union to be used in place of the great seal of Scotland have heretofore been recorded, and extracts from the said records shall be furnished to all parties requiring the same, on payment of such fees as the Commissioners shall direct, and shall be received in evidence in all courts in Scotland to the like effect as the letters patent themselves.

No letters patent to be issued after three months from date of warrant.

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

No letters patent (except in lieu of those lost, etc.) to be issued after expiration of protection given by this Act.

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

* Under special circumstances the Lord Chancellor will order a patent to be sealed

Letters patent may be granted to personal representatives of the applicant during the term of protection, or within three months after applicant's decease.

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

If letters patent be destroyed or lost, other letters patent may be issued.

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

Letters patent may be dated as of the day of the application.

23. It shall be lawful (the Act of the eighteenth year of King Henry the Sixth, chapter one, or any other Act, to the contrary notwithstanding) to cause any letters patent to be issued in pursuance of this Act to be sealed and bear date as of the day of the application for the same, and in case of such letters patent for any invention provisionally registered under the "Protection of Inventions Act, 1851," as of the day of such provisional registration, or where the law officer to whom the application was referred, or the Lord Chancellor, thinks fit and directs, any such letters patent as aforesaid may be sealed and bear date as of the day of the sealing of such letters patent, or of any other day between the day of such application or provisional registration, and the day of such sealing.

24. Any letters patent issued under this Act, sealed and

though the case does not fall within the strict letter of this section. (*Re Mackintosh's Patent*, 2 Jur. N. S. 1242.)

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

Letters patent where antedated to be of the same validity as if sealed on the day of the date.

25. Where, upon any application made after the passing of this Act, letters patent are granted in the United Kingdom for or in respect of any invention first invented in any foreign country, or by the subject of any foreign power or state, and a patent or like privilege for the monopoly or exclusive use or exercise of such invention in any foreign country is there obtained before the grant of such letters patent in the United Kingdom, all rights and privileges under such letters patent shall (notwithstanding any term in such letters patent limited) cease and be void, immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in such foreign country shall continue in force;* or where more than one such patent or like privilege is obtained abroad, immediately upon the expiration or determination of the term which shall first expire or be determined of such several patents or like privileges: Provided always, that no letters patent for or in respect of any invention for which any such patent or like privilege as aforesaid, shall have been obtained in any foreign country, and which shall be granted in the said United Kingdom, after the expiration of the term for which such patent or privilege was granted, or was in force, shall be of any validity.

Letters patent obtained in United Kingdom for patented foreign inventions not to continue in force after the expiration of the foreign patent.

* This provision applies only to patents granted in the United Kingdom subsequent to the passing of the statute. (*Bodmer's Patent*, 8 Moore's P. C. Cases, 282.)—See the cases on this section *ante*, p. 171.

Letters patent not to prevent the use of inventions in foreign ships resorting to British ports;

26. No letters patent for any invention (granted after the passing of this Act) shall extend to prevent the use of such invention in any foreign ship or vessel, or for the navigation of any foreign ship or vessel, which may be in any port of her Majesty's dominions, or in any of the waters within the jurisdiction of any of her Majesty's courts, where such invention is not so used for the manufacture of any goods or commodities, to be vended within or exported from her Majesty's dominions:* Provided always, that this enactment shall not extend to the ships or vessels of any foreign state, of which the laws authorize subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British ships or vessels, or in or about the navigation of British ships or vessels, while in the ports of such foreign state, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture of goods or commodities, to be vended within or exported from the territories of such foreign state.

except ships of foreign states in whose ports British ships are prevented from using foreign inventions.

Specifications to be filed instead of being enrolled.

27. All letters patent to be granted under this Act (save only letters patent granted after the filing of a complete specification) shall require the specification thereunder to be filed in the High Court of Chancery, instead of requiring the same to be enrolled, and no enrolment shall be requisite.†

Specifications, etc., to be filed in such office as Lord Chancellor shall direct.

28. Every specification to be filed in pursuance of the condition of any letters patent, shall be filed in such office of the Court of Chancery as the Lord Chancellor shall from time to time appoint,† and every provisional specification and complete specification left or filed at the office of the Commissioners on the application for any letters patent, shall

* This clause was introduced in consequence of the decision of the Court of Chancery in *Caldwell* v. *Van Vlissengen*, (9 Hare, 415.)—*Eds.*

† Specifications are to be filed at the great seal patent office (see *Lord St. Leonards'* Orders, Oct. 1st, 1852), and this branch of the Court of Chancery is combined with the office of the commissioners of patents: see No. 6 of the First Set of Rules.—*Eds.*

forthwith after the grant of the letters patent, or if no letters patent be granted then immediately on the expiration of six months from the time of such application, be transferred to and kept in the said office appointed for filing specifications in Chancery: and in case reference is made to drawings in any specification deposited or filed under this Act, an extra copy of such drawings shall be left with such specification. [*The latter part of this section was repealed by Act* 16 *and* 17 *Vict. cap.* 115, *sect.* 1.]

As to filing extra copies of drawings.

29. The Commissioners shall cause true copies of all specifications (other than provisional specifications),* disclaimers, and memoranda of alterations filed under or in pursuance of this Act, and of all provisional specifications after the term of the provisional protection of the invention has expired, to be open to the inspection of the public at the office of the Commissioners, and at an office in Edinburgh and Dublin respectively, at all reasonable times, subject to such regulations as the Commissioners may direct; and the Commissioners shall cause a transcript of the said letters patent to be transmitted for enrolment in the Court of Chancery, Dublin, and shall cause the same to be enrolled therein, and the transcript or exemplification thenceforward shall have the like effect to all intents and purposes as if the original letters patent had been enrolled in the Court of Chancery in Dublin, and all parties shall have all their remedies by *scire facias*, or otherwise, as if the letters patent had been granted to extend to Ireland only.

Copies of specifications to be open to inspection at office of commissioners, and at Edinburgh and Dublin.

30. The Commissioners shall cause to be printed, published, and sold, at such prices and in such manner as they may think† fit, all specifications, disclaimers, and memoranda of alterations, deposited or filed under this Act, and such

Specifications and other documents to be printed and published.

* Provisional specifications are now open to the inspection of the public, after the period of provisional protection has expired, by virtue of the 2nd section of 16 and 17 Vict. c. 115.—*Eds.*

† The 22 Vict. c. 13 (*post*, p. 299), enables the Secretary of State for War to prohibit the publication of specifications of inventions relating to munitions of war purchased by him under that Act.

specifications (not being provisional specifications), disclaimers, and memoranda respectively, shall be so printed and published as soon as conveniently may be after the filing thereof respectively, and all such provisional specifications shall be so printed and published as soon as conveniently may be after the expiration of the provisional protection obtained in respect thereof; and it shall be lawful for the Commissioners to present copies of all such publications to such public libraries and museums as they may think fit, and to allow the person depositing or filing any such specification, disclaimer, or memorandum of alteration, to have such number, not exceeding twenty-five, of the copies thereof so printed and published, without any payment for the same, as they may think fit.

As to presenting copies of publications to public libraries, etc.

Enrolments, etc., may be removed to the office for specifications.

31. It shall be lawful for the Lord Chancellor and the Master of the Rolls to direct the enrolment of specifications, disclaimers, and memoranda of alterations, heretofore or hereafter enrolled or deposited at the Rolls Chapel office, or at the petty bag office, or at the enrolment office of the Court of Chancery, or in the custody of the Master of the Rolls, as keeper of the public records, to be transferred to and kept in the office appointed for filing specifications in Chancery under this Act.

Commissioners to cause indexes to be made to old specifications, etc.; such specifications, etc., may be printed and published.

32. The Commissioners shall cause indexes to all specifications, disclaimers, and memoranda of alterations heretofore or to be hereafter enrolled or deposited as last aforesaid to be prepared in such form as they may think fit, and such indexes shall be open to the inspection of the public at such place or places as the Commissioners shall appoint, and subject to the regulations to be made by the commissioners, and the Commissioners may cause all or any of such indexes, specifications, disclaimers, and memoranda of alterations to be printed, published, and sold in such manner and at such prices as the commissioners may think fit.

Copies of specifications, etc., as printed by

33. Copies, printed by the printers to the Queen's Majesty, of specifications, disclaimers, and memoranda of alte-

rations, shall be admissible in evidence, and deemed and taken to be *prima facie* evidence of the existence and contents of the documents to which they purport to relate in all courts and in all proceedings relating to letters patent.— [*Repealed by Act* 16 *&* 17 *Vict. cap.* 115, *sect.* 1: *see sect.* 4 *of that Act.*]

Queen's printers to be evidence.

34. There shall be kept at the office appointed for filing specifications in Chancery under this Act a book or books, to be called "The Register of Patents," wherein shall be entered and recorded in chronological order all letters patent granted under this Act, the deposit or filing of specifications, disclaimers, and memoranda of alterations filed in respect of such letters patent, all amendments in such letters patent and specifications, all confirmations and extensions of such letters patent, the expiry, vacating, or cancelling such letters patent, with the dates thereof respectively, and all other matters and things affecting the validity of such letters patent as the Commissioners may direct, and such register, or a copy thereof, shall be open at all convenient times to the inspection of the public, subject to such regulations as the Commissioners may make.

Register of patents to be kept.

35. There shall be kept at the office appointed for filing specifications in Chancery under this Act a book or books, entitled "The Register of Proprietors," wherein shall be entered, in such manner as the Commissioners shall direct, the assignment of any letters patent, or of any share or interest therein, any licence under letters patent, and the district to which such licence relates, with the name or names of any person having any share or interest in such letters patent or licence, the date of his or their acquiring such letters patent, share, and interest, and any other matter or thing relating to or affecting the proprietorship in such letters patent or licence; and a copy of any entry in such books, certified under such seal as may have been appointed or as may be directed by the Lord Chancellor to be used in the said office, shall be given to any person requiring the same, on payment of the fees hereinafter provided; and such copies so certified

A register of proprietors to be kept at the office for filing specifications.

shall be received in evidence in all courts and in all proceedings, and shall be *primâ facie* proof of the assignment of such letters patent, or share or interest therein, or of the licence or proprietorship, as therein expressed: Provided always,* that until such entry shall have been made the grantee or grantees of the letters patent shall be deemed and taken to be the sole and exclusive proprietor or proprietors of such letters patent, and of all the licences and privileges thereby given and granted; that certified duplicates of all entries made in the said register of proprietors shall forthwith be transmitted to the office of the commissioners in Edinburgh and Dublin, where the same shall also be open to the inspection of the public; and any writ of *scire facias* to repeal such letters patent may be issued to the sheriff of the county or counties in which the grantee or grantees resided at the time when the said letters patent were granted; and in case such grantee or grantees do not reside in the United Kingdom, it shall be sufficient to file such writ in the petty bag office, and serve notice thereof in writing at the last known residence or place of business of such grantee or grantees; and such register or a copy shall be open to the inspection of the public at the office of the commissioners, subject to such regulations as the commissioners may make: Provided always, that in any proceeding in Scotland to repeal any letters patent, service of all writs and summonses shall be made according to the existing forms and practice; provided also, that the grantee or grantees of letters patent to be hereafter granted may assign the letters patent for England, Scotland, or Ireland respectively as effectually as if the letters patent had been originally granted to extend to England or Scotland or Ireland only, and the assignee or assignees shall have the same rights of action and remedies,

* It was held by the Court of Queen's Bench in *Chollet* v. *Hoffman* (7 Ell. & Bl. 686), that under this clause an assignee cannot bring an action for an infringement until his assignment has been registered; and that this applies to patents granted previous to October, 1852, if the assignment was made subsequent to that time. See also *ante*, p. 188.

and shall be subject to the like actions and suits, as he or they should and would have had and been subject to upon the assignment of letters patent granted to England, Ireland, or Scotland before the passing of this Act.

Power for more than twelve persons to have a legal interest in letters patent.

36. Notwithstanding any proviso that may exist in former letters patent, it shall be lawful for a larger number than twelve persons hereafter to have a legal and beneficial interest in such letters patent.

Falsification or forgery of entries a misdemeanor.

37. If any person shall wilfully make or cause to be made any false entry in the said register of proprietors, or shall wilfully make or forge, or cause to be made or forged, any writing falsely purporting to be a copy of any entry in the said book, or shall produce or tender, or cause to be produced or tendered, in evidence, any such writing knowing the same to be false or forged, he shall be guilty of a misdemeanor, and shall be punished by fine and imprisonment accordingly.

Entries may be expunged.

38. If any person shall deem himself aggrieved by any entry made under colour of this Act in the said register of proprietors, it shall be lawful for such person to apply, by motion, to the Master of the Rolls, or to any of the courts of common law at Westminster in term time, or by summons to a judge of any of the said courts in vacation, for an order that such entry may be expunged, vacated, or varied; and upon any such application the Master of the Rolls, or such court or judge respectively, may make such order for expunging, vacating, or varying such entry, and as to the costs of such application, as to the said Master of the Rolls or to such court or judge may seem fit; and the officer having the care and custody of such register, on the production to him of any such order for expunging, vacating, or varying any such entry, shall expunge, vacate, or vary the same, according to the requisitions of such order.*

* The Master of the Rolls under this section ordered the registry of a second assignment of a patent to be expunged on the application of the assignees under a prior assignment, which had not been registered until after the second, as it appeared

Provisions of 5 & 6 Wm. IV. c. 83, and of 7 & 8 Vict. c. 69, as to disclaimers and memoranda of alterations to apply to patents under this Act.

39. All the provisions of the Acts of the session holden in the fifth and sixth years of King William the Fourth, chapter eighty-three, and of the session holden in the seventh and eighth years of her Majesty, chapter sixty-nine, respectively, relating to disclaimers and memoranda of alterations in letters patent and specifications, except as hereinafter provided, shall be applicable and apply to any letters patent granted and to any specification filed under the provisions of this Act: Provided always, that all applications for leave to enter a disclaimer or memorandum of alteration shall be made, and all caveats relating thereto shall be lodged at the office of the commissioners, and shall be referred to the respective law officers in the said first-recited Act mentioned: Provided also, that every such disclaimer or memorandum of alteration shall be filed in the office appointed for filing specifications in Chancery under this Act, with the specification to which the same relates, in lieu of being entered or filed and enrolled as required by the said first-recited Act, or by the Act of the session holden in the twelfth and thirteenth years of her Majesty, chapter one hundred and nine, and the said Acts shall be construed accordingly: Provided also, that such filing of any disc[illegible]mer or memorandum of alteration, in pursuance of the leave of the law officer in the first-recited Act mentioned, certified as therein mentioned, shall, except in cases of fraud, be conclusive as to the right of the party to enter such disclaimer or memorandum of alteration under the said Acts and this Act; and no objection shall be allowed to be made in any proceeding upon or touching

Applications for disclaimers and caveats to be at office of commissioners.

that the second assignment had been executed for a fraudulent and improper purpose. (*Re Green's Patent*, 24 Bea. 145.) In another case, the Master of the Rolls said, that if there were two deeds assigning the patent *simpliciter* to two different persons, and the second was registered before the first, and if it were clearly proved that the second deed was executed with full and complete notice of the prior one, though subsequently registered, he conceived he should have power to direct an entry to be made upon the register, stating the facts. It is the duty of the Court, under this section of the Act, to insert on the register any facts relating to the proprietorship but not the legal inferences to be drawn from them. (*Re Morey's Patent*, 25 Bea. 581.)

such letters patent, specification, disclaimer, or memorandum of alteration, on the ground that the party entering such disclaimer or memorandum of alteration had not sufficient authority in that behalf: Provided also, that no action shall be brought upon any letters patent in which or on the specification of which any disclaimer or memorandum of alteration shall have been filed in respect of any infringement committed prior to the filing of such disclaimer or memorandum of alteration, unless the law officer shall certify in his fiat that any such action may be brought, notwithstanding the entry or filing of such disclaimer or memorandum of alteration.

Provisions of 5 and 6 Wm. IV. c. 83; 2 & 3 Vict. c. 67; and 7 & 8 Vict. c. 69, as to confirmation and prolongation, to apply to patents under this Act.

40. All the provisions of the said Act of the fifth and sixth years of King William the Fourth, for the confirmation of any letters patent, and the grant of the new letters patent, and all the provisions of the said Act, and of the Acts of the session holden in the second and third years of her Majesty, chapter sixty-seven, and of the session holden in the seventh and eighth years of her Majesty, chapter sixty-nine, respectively, relating to the prolongation of the term of letters patent,* and to the grant of new letters patent for a further term, shall extend and apply to any letters patent granted under the provisions of this Act, and it shall be lawful for her Majesty to grant any new letters patent, as in the said Acts mentioned; and in the granting of any such new letters patent her Majesty's order in council shall be a sufficient warrant and authority for the sealing of any new letters patent, and for the insertion in such new letters patent of any restrictions, conditions, and provisions in the said order mentioned; and the Lord Chancellor, on the receipt of the said order in council, shall cause letters patent, according to the tenor and effect of such order, to be made and sealed in the manner herein directed for letters patent issued under the warrant

* See the explanation of this section given by the seventh section of 16 & 17 Vict. c. 115.—*Eds.*

of the law officer: Provided always, that such new letters patent shall extend to and be available in and for such places as the original letters patent extended to and were available in: Provided also, that such new letters patent shall be sealed and bear date as of the day after the expiration of the term of the original letters patent which may first expire.

In actions for infringement of letters patent, particulars to be delivered, and no evidence allowed not mentioned therein.

41. In any action in any of her Majesty's superior courts of record at Westminster or in Dublin for the infringement of letters patent, the plaintiff shall deliver with his declaration particulars of the breaches complained of in the said action, and the defendant, on pleading thereto, shall deliver with his pleas, and the prosecutor in any proceedings by *scire facias* to repeal letters patent shall deliver with his declaration, particulars of any objections on which he means to rely at the trial in support of the pleas in the said action or of the suggestions of the said declaration in the proceedings by *scire facias* respectively; and at the trial of such action or proceedings by *scire facias*, no evidence shall be allowed to be given in support of any alleged infringement or of any objection impeaching the validity of such letters patent which shall not be contained in the particulars delivered as aforesaid: Provided always, that the place or places at or in which and in what manner the invention is alleged to have been used or published prior to the date of the letters patent shall be stated in such particulars: Provided also, that it shall and may be lawful for any judge at chambers to allow such plaintiff or defendant or prosecutor respectively to amend the particulars delivered as aforesaid, upon such terms as to such judge shall seem fit: Provided also, that at the trial of any proceeding by *scire facias* to repeal letters patent the defendant shall be entitled to begin and to give evidence in support of such letters patent; and in case evidence shall be adduced on the part of the prosecutor impeaching the validity of such letters patent, the defendant shall be entitled to the reply.

Courts of common law may

42. In any action in any of her Majesty's superior courts

of record at Westminster and in Dublin for the infringement of letters patent, it shall be lawful for the court in which such action is pending, if the court be then sitting, or if the court be not sitting, then for a judge of such court, on the application of the plaintiff or defendant respectively, to make such order for an injunction, inspection, or account, and to give such direction respecting such action, injunction, inspection, and account, and the proceedings therein respectively, as to such court or judge may seem fit.* grant injunction in case of infringement.

43. In taxing the costs in any action in any of her Majesty's superior courts at Westminster or in Dublin, commenced after the passing of this Act, for infringing letters patent, regard shall be had to the particulars delivered in such action, and the plaintiff and defendant respectively shall not be allowed any costs in respect of any particular, unless certified by the judge before whom the trial was had to have been proved by such plaintiff or defendant respectively, without regard to the general costs of the cause; and it shall be lawful for the judge before whom any such action shall be tried to certify on the record that the validity of the letters patent in the declaration mentioned came in question;† and the record, with such certificate, being given in evidence in any suit or action for infringing the said letters patent, or in any proceeding by *scire facias* to repeal the letters patent, shall entitle the plaintiff in any such Particulars to be regarded in taxation of costs.

* Under this clause application was made to the Court of Exchequer for liberty for the plaintiffs in an action for the infringement of a patent for making printer's type of a certain combination of metals to inspect type, and if necessary to take specimens for the purpose of being analyzed, in order to ascertain if it was an infringement of the patent. The application was refused, the Court saying, 1st, that it was very doubtful whether it had power to grant such an application under any circumstances; 2nd, that even if it had such power, it must be clearly shown that there had been an infringement; and 3rd, that an order for simple inspection would not be granted unless the case were such that a court of equity would grant an injunction (*Patent Type Founding Co.* v. *Lloyd*, 6 Jur. N. S. 103); see also *Holland* v. *Fox* (3 Ell. & Bl. 977). For the practice as to inspection in Chancery see *ante*, p. 201.

† This certificate may be given on a trial in the Court of Chancery, (*Needham* v. *Oxley* (8 L. T. N. S. 604); *Davenport* v. *Rylands* (1 Law Rep. Eq. 308).

suit or action, or the defendant in such proceeding by *scire facias*, on obtaining a decree, decretal order, or final judgment to his full costs, charges, and expenses, taxed as between attorney and client,* unless the judge making such decree or order, or the judge trying such action or proceeding, shall certify that the plaintiff or defendant respectively ought not to have such full costs: Provided always, that nothing herein contained shall affect the jurisdiction and forms of process of the courts in Scotland in any action for the infringement of letters patent, or in any action or proceeding respecting letters patent hitherto competent to the said courts: Provided also, that when any proceedings shall require to be taken in Scotland to repeal any letters patent, such proceedings shall be taken in the form of an action of reduction at the instance of her Majesty's advocate, or at the instance of any other party having interest, with concurrence of her Majesty's advocate, which concurrence her Majesty's advocate is authorized and empowered to give upon just cause shown only.

Payments and stamp duties on letters patent to be as in schedule.

44. There shall be paid in respect of letters patent applied for or issued as herein mentioned, the filing of specifications and disclaimers, certificates, entries and searches, and other matters and things mentioned in the schedule to this Act, such fees as are mentioned in the said schedule; and there shall be paid unto and for the use of her Majesty, her heirs and successors, for or in respect of the warrants and certificates mentioned in the said schedule, or the vellum, parchment, or paper on which the same respectively are written, the stamp duties mentioned in the said schedule; and no other stamp duties shall be levied, or fees, except as hereinafter mentioned, taken in respect to such letters patent and

* As to what is a sufficient certificate to enable the Court to direct the costs to be thus taxed, see *Betts* v. *De Vitre* (11 Jur. N. S. 11); *Bovill* v. *Hadley* (17 C. B. N. S. 435; *S. C.* 10 L. T. N. S. 650). A patentee who has once obtained this certificate may have his full costs in any subsequent action for infringement, even although the validity of the patent may not have been questioned in such action. *Davenport* v. *Rylands* (1 Law Rep. Eq. 308; *S. C.* 35 L. J. N. S. Ch. 204).

specifications, and the matters and things in such schedule mentioned. [*Repealed by Act* 16 *Vict. cap.* 5.]

Duties to be under management of commissioners of Inland Revenue.

45. The stamp duties hereby granted shall be under the care and management of the Commissioners of inland revenue; and the several rules, regulations, provisions, penalties, clauses, and matters contained in any Act now or hereafter to be in force with reference to stamp duties shall be applicable thereto. [*Repealed by Act* 16 *Vict. cap.* 5.]

All moneys received to be paid to the Consolidated Fund.

46. The fees to be paid as aforesaid shall from time to time be paid into the receipt of the exchequer, and be carried to and made part of the consolidated fund of the United Kingdom. [*Repealed by Act* 16 *Vict. cap.* 5.]

Not to prevent payment of fees to law officers in cases of opposition, etc.

47. Provided always, that nothing herein contained shall prevent the payment as heretofore to the law officers in cases of opposition to the granting of letters patent, and in cases of disclaimers and memoranda of alterations, of such fees as may be appointed by the Lord Chancellor and Master of the Rolls as the fee to be paid on the hearing of such oppositions and in the case of disclaimers and memoranda of alterations respectively, or of such reasonable sums for office or other copies of documents in the office of the Commissioners as the Commissioners may from time to time appoint to be paid for such copies; and the Lord Chancellor and Master of the Rolls, and the Commissioners, are hereby respectively authorized and empowered to appoint the fees to be so paid in respect of such oppositions, disclaimers, and memoranda of alterations respectively, and for such office orother copies.*

Fees and salaries of officers.

48. It shall be lawful for the Commissioners of her Majesty's treasury from time to time to allow such fees to the law officers and their clerks (for duties under this Act, in respect of which fees may not be payable to them under the provisions lastly hereinbefore contained), as the Lord Chancellor and Master of the Rolls may from time to time ap-

* See the Order of St. Leonards and Sir John Romilly, of the 1st Oct., 1852.—*Eds.*

point, and to allow such salaries and payments to any clerks and officers to be appointed under this Act and such additional salaries and payments to any other clerks and officers in respect of any additional duties imposed on them by this Act, as the said Commissioners of the treasury may think fit.

Sums for defraying salaries and expenses under this Act to be paid out of moneys to be provided by Parliament.

49. It shall be lawful for the Commissioners of her Majesty's treasury to allow from time to time the necessary sums for providing offices under this Act, and for the fees, salaries, and payments allowed by them as aforesaid, and for defraying the current and incidental expenses of such office or offices; and the sums to be so allowed shall be paid out of such moneys as may be provided by Parliament for that purpose.

Power to Treasury to grant compensation to persons affected by this Act.

50. And whereas divers persons, by virtue of their offices or appointments, are entitled to fees or charges payable in respect of letters patent as heretofore granted within the United Kingdom of Great Britain and Ireland, or have and derive in respect of such letters patent, or the procedure for the granting thereof, fees or other emoluments or advantages: it shall be lawful for the said Commissioners of the treasury to grant to any such persons who may sustain any loss of fees, emoluments, or advantages, by reason of the passing of this Act, such compensation as, having regard to the tenure and nature of their respective offices and appointments, such Commissioners deem just and proper to be awarded; and all such compensations shall be paid out of such moneys as may be provided by Parliament for that purpose: Provided always, that in case any person to whom any yearly sum by way of compensation shall be awarded and paid shall, after the passing of this Act, be appointed to any office or place of emolument under the provisions of this Act, or in the public service, then and in every such case the amount of such yearly sum shall in every year be diminished by so much as the emoluments of such person for such year from such office or place shall amount to, and provision in that behalf shall be made in the award to him of such yearly sum.

51. An account of all salaries, fees, allowances, sums, and compensations to be appointed, allowed, or granted under this Act shall, within fourteen days next after the same shall be so appointed, allowed, or granted respectively, be laid before both Houses of Parliament, if Parliament be then sitting, or if Parliament be not then sitting, then within fourteen days after the next meeting of Parliament.

Account of salaries, fees, and compensation allowances to be laid before Parliament.

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

Not to extend to patents applied for before commencement of Act.

53. Where letters patent for England or Scotland or Ireland have been granted before the commencement of this Act, or are, in respect of any application made before the commencement of this Act, hereafter granted, for any invention, letters patent for England or Scotland or Ireland may be granted for such invention in like manner as if this Act had not been passed: Provided always, that in lieu of all the fees or payments and stamp duties now payable in respect of such letters patent, or in or about obtaining a grant thereof, there shall be paid in respect of such letters patent for England or Scotland or Ireland on the sealing of such respective letters patent a sum equal to one-third part of the fees and stamp duties which would be payable according to the schedule to this Act in respect of letters patent issued for the United Kingdom under this Act, on or previously to the sealing of such letters patent, and at or before the expiration of the third year and the seventh year respectively of the term granted by such letters patent for England or Scotland or Ireland, sums equal to one-third part of the fees and stamp duties payable at the expiration of the third year and the seventh year respectively of the term granted by letters patent issued for the United Kingdom under this Act; and the condition of such letters patent for England or Scotland or Ireland shall be varied accordingly; and such fees shall be paid to such persons as

As to letters patent granted before commencement of this Act for England, Scotland, or Ireland.

the Commissioners of her Majesty's treasury shall appoint, and shall be carried to and form part of the said consolidated fund. [*Repealed by Act 16 Vict., cap.* 5.]

Forms in schedule may be used.

54. The several forms in the schedule to this Act may be used for and in respect of the several matters therein mentioned, and the Commissioners may where they think fit vary such forms as occasion may require, and cause to be printed and circulated such other forms as they may think fit to be used for the purposes of this Act.

Interpretation of terms.

55. In the construction of this Act the following expressions shall have the meanings hereby assigned to them, unless such meanings be repugnant to or inconsistent with the context; (that is to say,)

The expression "Lord Chancellor" shall mean the Lord Chancellor or Lord Keeper of the Great Seal, or Lords Commissioners of the Great Seal:

The expression "The Commissioners" shall mean the Commissioners for the time being acting in execution of this Act:

The expression "Law Officer" shall mean her Majesty's Attorney-General or Solicitor-General for the time being for England, or the Lord Advocate, or her Majesty's Solicitor-General for the time being for Scotland, or her Majesty's Attorney-General or Solicitor-General for the time being for Ireland:

The expression "Invention" shall mean any manner of new manufacture the subject of letters patent and grant of privilege within the meaning of the Act of the twenty-first year of the reign of King James the First, Chapter Three:

The expressions "Petition," "Declaration," "Provisional Specification," "Warrant," and "Letters Patent" respectively, shall mean instruments in the form and to the effect in the schedule hereto annexed, subject to such alterations as may from time to time be made therein under the powers and provisions of this Act.

56. In citing this Act in other Acts of Parliament, instruments, and proceedings, it shall be sufficient to use the expression "The Patent Law Amendment Act, 1852." Short title

57. This Act shall commence and take effect from the first of October, one thousand eight hundred and fifty-two. Commencement of Act.

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*The Schedule to which this Act refers.*—[*See Sect.* 44.]

[The first part of this Schedule, defining the fees and stamp duties to be paid, was repealed by Act 16 Vict. cap. 5, and a schedule of stamp duties thereto annexed substituted for the part so repealed.]

FEES TO BE PAID.

| | | | |
|---|---|---|---|
| On leaving petition for grant of letters patent | £5 | 0 | 0 |
| On notice of intention to proceed with the application | 5 | 0 | 0 |
| On sealing of letters patent | 5 | 0 | 0 |
| On filing of specification | 5 | 0 | 0 |
| At or before the expiration of the third year | 40 | 0 | 0 |
| At or before the expiration of the seventh year | 80 | 0 | 0 |
| On leaving notice of objections | 2 | 0 | 0 |
| Every search and inspection | 0 | 1 | 0 |
| Entry of assignment or licence | 0 | 5 | 0 |
| Certificate of assignment or licence | 0 | 5 | 0 |
| Filing application for disclaimer | 5 | 0 | 0 |
| Caveat against disclaimer | 2 | 0 | 0 |

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STAMP DUTIES TO BE PAID.

| | | | |
|---|---|---|---|
| On warrant of law officer for letters patent | 5 | 0 | 0 |
| On certificate of payment of the fee payable at or before the expiration of the third year | 10 | 0 | 0 |
| On certificate of payment of the fee payable at or before the expiration of the seventh year | 20 | 0 | 0 |

## FORMS.*

No. PETITION.

To the Queen's most excellent Majesty.

The humble petition of [*here insert name and address of petitioner*] for, &c., showeth,

That your petitioner is in possession of an invention for [*the title of the invention,*] which invention he believes will be of great public utility; that he is the true and first inventor thereof; and that the same is not in use by any other person or persons, to the best of his knowledge and belief.

Your petitioner therefore humbly prays, that your Majesty will be pleased to grant unto him, his executors, administrators, and assigns, your royal letters patent for the United Kingdom of Great Britain and Ireland, the Channel Islands, the Isle of Man, [*Colonies to be mentioned, if any,*] for the term of fourteen years, pursuant to the statutes in that case made and provided.

And your petitioner will ever pray, &c.

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No. DECLARATION.

I, A. B., of, &c., do solemnly and sincerely declare, that I am in possession of an invention for, &c., [*the title as in petition,*] which invention I believe will be of great public utility; that I am the true and first inventor thereof; and that the same is not in use by any other person or persons, to the best of my knowledge and belief; [*where a complete specification is to be filed with the petition and declaration, insert these words:*—"and that the instrument in writing under my hand and seal, hereunto annexed, particularly describes and ascertains the nature of the said invention, and the manner in which the same is to be performed;"] and

* These forms may be varied by the Commissioners of Patents, as the occasion may require: 15 & 16 Vict. c. 83, s. 54.—*Eds.*

I make this declaration conscientiously believing the same to be true, and by virtue of the provisions of an Act made and passed in the session of Parliament held in the fifth and sixth years of the reign of his late Majesty King William the Fourth, entituled "An Act to repeal an Act of the present Session of Parliament, entituled '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 A.D.
before me,

A Master in Chancery,
*or* Justice of the Peace,

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No. PROVISIONAL SPECIFICATION.

I, A.B., do hereby declare the nature of the said invention for [*insert title as in petition*] to be as follows: [*here insert description.*]

Dated this day of A.D.

(*To be signed by applicant or his agent.*)

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REFERENCE.

(*To be endorsed on the petition.*)

Her Majesty is pleased to refer this petition to to consider what may be properly done therein.

Clerk of the Commissioners.

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WARRANT.

In humble obedience to her Majesty's command referring

to me the petition of A. B., of, &c., to consider what may be properly done therein, I do hereby certify as follows: That the said petition sets forth that the petitioner [*allegations of the petition*].

And the petitioner most humbly prays [*prayer of the petition*].

That in support of the allegations contained in the said petition the declaration of the petitioner has been laid before me, whereby he solemnly declares, that [*allegations of the declaration*].

That there has also been laid before me [a provisional specification signed A. B., and also a certificate, ,] *or* [a complete specification, and a certificate of the filing thereof,] whereby it appears that the said invention was provisionally protected [*or* protected] from the day of A.D. in pursuance of the statute:

That it appears that the said application was duly advertised:

Upon consideration of all the matters aforesaid, and as it is entirely at the hazard of the said petitioner whether the said invention is new or will have the desired success, and as it may be reasonable for her Majesty to encourage all arts and inventions which may be for the public good, I am of opinion, that her Majesty may grant her royal letters patent unto the petitioner, his executors, administrators, and assigns for his said invention within the United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, [*Colonies to be mentioned, if any,*] for the term of fourteen years, according to the statute in that case made and provided, if her Majesty shall be graciously pleased so to do, to the tenor and effect following:—

[*See next form.*]

Given under my hand, this day of A.D.

(Seal of the commissioners.)

### LETTERS PATENT.*

Victoria, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, defender of the faith: To all to whom these presents shall come, greeting:

Whereas A. B. hath by his petition humbly represented unto us that he is in possession of an invention for , which the petitioner believes will be of great public utility; that he is the first and true inventor thereof, and that the same is not in use by any other person or persons, to the best of his knowledge and belief: The petitioner therefore most humbly prayed that we would be graciously pleased to grant unto him, his executors, administrators, and assigns, our royal letters patent for the sole use, benefit, and advantage of his said invention within our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, for the term of fourteen years, pursuant to the statute in that case made and provided:† And we, being willing to give encouragement to all arts and inventions which may be for the public good, are graciously pleased to condescend to the petitioner's request: Know ye, therefore, that we, of our especial grace, certain knowledge, and mere motion have given and granted, and by these presents, for us, our heirs and successors, do give and grant unto the said A. B., his executors, administrators, and assigns, our especial licence, full power, sole privilege, and authority, that he the said A. B., his executors, administrators, and assigns, and every of them, by himself and themselves, or by his and their deputy or deputies, servants, or agents, or such others as he the said A. B., his executors, administrators or assigns, shall

* The above form, being the one in actual use, has been substituted for the form given in the schedule to the Act. See Section 54.—*Eds.*

† In case a complete specification has been filed in the first instance, the letters patent will contain this recital, "And whereas the said A. B. hath particularly described and ascertained the nature of the said invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and has caused the same to be filed in the Great Seal Patent Office."—*Eds.*

at any time agree with, and no others, from time to time and at all times hereafter during the term of years herein expressed, shall and lawfully may make, use, exercise, and vend his said invention within our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, in such manner as to him the said 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 term of years herein mentioned; to have, hold, exercise, and enjoy the said licences, powers, privileges, and advantages herein-before 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 day of the date of these presents next and immediately ensuing, according to the statute in such case made and provided; and to the end that he the said 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 our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, that neither they nor any of them, at any time during the continuance of the said term of fourteen years hereby granted, either directly or indirectly do make, use, or put in practice the said invention, or any part of the same, so attained unto by the said A. B. as aforesaid, nor in anywise counterfeit, imitate, or resemble the same, nor shall make or cause to be made any

addition thereunto or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, devisor or devisors thereof, without the consent, licence, 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 their 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 during the said term hereby granted, in anywise 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 anything relating thereto: Provided always, and these our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted it shall be made appear to us, our heirs or successors, or any six or more of our or their privy council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, or that the said A. B. is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith cease, determine, and be utterly void to all intents and purposes, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided also, that these our letters patent, or anything herein

contained, shall not extend or be construed to extend to give privilege unto the said A. B., his executors, administrators, or assigns, or any of them, to use or imitate any invention or work whatsoever which hath heretofore been found out or invented by any other of our subjects whatsoever, and publicly used or exercised within our United Kingdom of Great Britain and Ireland, the Channel Islands, or Isle of Man, unto whom our like letters patent or privileges have been already granted for the sole use, exercise, and benefit thereof: It being our will and pleasure that the said 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 and found out, according to the true intent and meaning of the same respective letters patent and of these presents: Provided likewise nevertheless, and these our letters patent are upon this express condition, that if the said A. B., his executors or administrators, shall not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, by an instrument in writing under his or their or one of their hands and seals, and cause the same to be filed in the Great Seal Patent Office within six calendar months next and immediately after the date of these our letters patent;* and also if the said A. B., his executors, administrators, or assigns, shall not pay the stamp duty of fifty pounds, and produce these our letters patent stamped with a proper stamp to that amount at the office of our commissioners of patents for inventions before the expiration of three years from the date of these our letters patent, pursuant to the provisions

* In a case complete specification shall have been filed along with the petition and declaration, the preceding proviso will be modified thus—"That if the said instrument in writing, filed as aforesaid, does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed."—*Eds.*

of the Act of the sixteenth year of our reign, chapter 5; and also if the said A. B., his executors, administrators, or assigns, shall not pay the stamp duty of one hundred pounds, and produce these our letters patent stamped with a proper stamp to that amount at the said office of our said Commissioners before the expiration of seven years from the date of these our letters patent, pursuant also to the said Act; and also if the said 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 requiring the same: that then and in any of the said cases these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted: And lastly, we do by these presents, for us, our heirs and successors, grant unto the said A. B., his executors, administrators, and assigns, that these our letters patent, on the filing thereof, shall be in and by all things good, firm, valid, sufficient, and effectual in the law according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favourable and beneficial sense for the best advantage of the said 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 of us, our heirs and successors, in our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, and amongst all and every the subjects of us, our heirs and successors,

whatsoever and wheresoever, notwithstanding the not full and certain describing the nature or quality of the said invention, or of the materials thereunto conducing and belonging. In witness whereof we have caused these our letters to be made patent, this one thousand eight hundred and fifty- , in the year of our reign, and to be sealed as of the said one thousand eight hundred and fifty-

By Warrant. EDMUNDS.

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SPECIFICATION.

To all to whom these presents shall come;

I, A. B., of send greeting:

Whereas her most excellent Majesty Queen Victoria, by her letters patent bearing date the day of A.D , in the year of her reign, did for herself, her heirs and successors, give and grant unto me, the said A. B., her special licence that I the said A. B., my executors, administrators, and assigns, or 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 thereafter during the term therein expressed, should and lawfully might make, use, exercise, and vend, within the United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, [*Colonies to be mentioned, if any,*] an invention for [*insert title as in letters patent*] upon the condition (amongst others) that I, the said A. B., by an instrument in writing under my hand and seal, should particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, and cause the same to be filed in within calendar months next and immediately after the date of the said letters patent: Now know ye, that I, the said A. B., do hereby declare the nature of my said invention, and in what manner the same is to be performed,

to be particularly described and ascertained in and by the following statement: (that is to say,)

[*Describe the invention.*]

In witness whereof I the said A. B. have heretofore set my hand and seal, this day of A.D.

A. B.

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## 16 VICT. c. 5.

*An Act to Substitute Stamp Duties for Fees on passing Letters Patent for Inventions, and to provide for the Purchase for the public use of certain Indexes of Specifications.*

[21*st February*, 1853.]

WHEREAS it is expedient that the fees payable in respect of letters patent for inventions under the Patent Law Amendment Act, 1852, and mentioned in the schedule to such Act, be converted into stamp duties: Be it enacted, therefore, by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows: 15 and 16 Vict. c. 83.

1. Sections seventeen, forty-four, forty-five, forty-six, and fifty-three of the said Patent Law Amendment Act, 1852, and so much of the schedule to the said Act as relates to fees and stamp duties to be paid under the said Act, shall be repealed. Sections 17, 44, 45, 46, and 53, and part of schedule, of recited Act repealed.

2. All letters patent for inventions to be granted under the provisions of the said Patent Law Amendment Act, 1852, (except in the cases provided for in the fourth section of this Act), shall be made subject to the condition that the same shall be void, and that the powers and privileges thereby granted shall cease and determine, at the expiration of three years and seven years respectively from the date thereof, unless there be paid before the expiration of the Letters patent to be made subject to avoidance on non-payment of stamp duties expressed in schedule to this Act annexed.

said three years and seven years respectively the stamp duties in the schedule to this Act annexed, expressed to be payable before the expiration of the third year and of the seventh year respectively, and such letters patent, or a duplicate thereof, shall be stamped with proper stamps showing the payment of such respective stamp duties, and shall, when stamped, be produced before the expiration of such three years and seven years respectively at the office of the Commissioners; and a certificate of the production of such letters patent or duplicate so stamped, specifying the date of such production, shall be endorsed by the clerk of the Commissioners on the letters patent or duplicate, and a like certificate shall be endorsed upon the warrant for such letters patent filed in the said office.

Stamp duties mentioned in the schedule to this Act to be payable.

3. There shall be paid unto and for the use of her Majesty, her heirs and successors, for or in respect of letters patent applied for or issued under the provisions of the said Patent Law Amendment Act, 1852, warrants, specifications, disclaimers, certificates, and entries, and other matters and things mentioned in the schedule to this Act, or the vellum, parchment, or paper on which the same respectively are written, the stamp duties mentioned in the said schedule; and no other stamp duties shall be levied in respect of such letters patent, warrants, specifications, disclaimers, certificates, entries, matters, and things; and the stamp duty mentioned in the said schedule on office copies of documents shall be in lieu of such sums as by the said Patent Law Amendment Act, 1852, are authorized to be appointed to be paid for such office copies.

As to payment of stamp duties on letters patent for England, Scotland, or Ireland respectively.

4. Where letters patent for England or Scotland or Ireland have been granted before the commencement of the said Patent Law Amendment Act, 1852, or have been since the commencement of the said Act, or hereafter may be granted for any invention, in respect of any application made before the commencement of the said Act, letters patent for England or Scotland or Ireland may be granted for such

invention in like manner as if the said Act had not been passed: Provided always, that in lieu of all fees or payments and stamp duties which were at the time of the passing of the said Act payable in respect of such letters patent as last aforesaid, or in or about obtaining a grant thereof, and in lieu of all other stamp duties whatsoever, there shall be paid in respect of such letters patent as last aforesaid on the sealing thereof stamp duties equal to one-third part of the stamp duties which would be payable under this Act in respect of letters patent issued for the United Kingdom under the said Patent Law Amendment Act, 1852, on or previously to the sealing of such letters patent as last aforesaid, and before the expiration of the third year and the seventh year respectively of the term granted by such letters patent for England, Scotland, or Ireland, stamp duties equal to one-third part of the stamp duties payable under this Act before the expiration of the third year and the seventh year respectively of the term granted by letters patent issued for the United Kingdom under the said Patent Law Amendment Act, 1852, and the condition of such letters patent for England or Scotland or Ireland shall be varied accordingly.

Duties to be under the management of the Commissioners of Inland Revenue;

5. The stamp duties hereby granted shall be under the care and management of the Commissioners of Inland Revenue; and the several rules, regulations, provisions, penalties, clauses, and matters contained in any Act now or hereafter to be in force, with reference to stamp duties shall be applicable thereto.

who are to provide the proper stamps for the purpose.

6. The said Commissioners of Inland Revenue shall prepare stamps impressed upon adhesive paper, of the amounts following—that is to say, twopence, fourpence, eightpence, and one shilling, to be used only in respect of the stamp duties on the office copies of documents, and on the certificates of searches and inspections mentioned in the schedule to this Act; such adhesive stamps of proper amounts to be affixed by the clerk of the commissioners of patents for

inventions to such office copies of documents and certificates of searches and inspections as aforesaid; and immediately after such affixing he shall obliterate or deface such stamps by impressing thereon a seal to be provided for that purpose, but so as not to prevent the amount of the stamp from being ascertained; and no such office copy or certificate shall be delivered out until the stamps thereon shall be obliterated or defaced as aforesaid.

Conditions of letters patent already granted under recited Act to be satisfied by payment of stamp duties, etc., under this Act.

7. The condition contained in any letters patent granted under the said Patent Law Amendment Act, 1852, and before the passing of this Act, for making such letters patent void at the expiration of three years and seven years respectively from the date thereof, unless there be paid, before the expiration of the said three years and seven years respectively, the sums of money and stamp duties by the said Patent Law Amendment Act, 1852, required in this behalf, shall be deemed to be satisfied and complied with by payment of the like stamp duties as would have been required if such letters patent had been granted after the passing of this Act, and had been made subject to the condition required by this Act in lieu of the said condition therein contained; and the provision hereinbefore contained concerning the endorsement on the letters patent or duplicate, and on the warrant for the same letters patent, of a certificate of the production of the letters patent or duplicate properly stamped, shall be applicable in the case of such letters patent granted before the passing of this Act.

Power to commissioners to purchase the indexes of existing specifications prepared by Mr. Woodcroft.

8. And whereas by the said Patent Law Amendment Act, 1852, the Commissioners are directed to cause indexes to all specifications heretofore or hereafter to be enrolled or deposited to be prepared in such form as they may think fit, which indexes are to be open to the inspection of the public: and whereas the existing specifications so directed to be indexed as aforesaid are in number fifteen thousand and upwards, and it would require some years to make indexes thereof on a proper arrangement and classification: and

whereas Mr. Bennett Woodcroft has already made complete indexes of such specifications, which the commissioners have examined and approved of, and it is expedient that such indexes be purchased for the use of the public: it shall be lawful for the Commissioners, with the consent of the commissioners of her Majesty's treasury, to purchase the said indexes of the said Bennett Woodcroft for a sum not exceeding one thousand pounds, and to pay the purchase money for the same out of the moneys in their hands which have arisen from fees received in respect of letters patent under the said Patent Law Amendment Act, 1852, and directed by the said Act to be put into the receipt of the exchequer; and after the purchase of such indexes the provisions of the said Act shall be applicable thereto as if such indexes had been prepared under the said recited enactment.

As to the word "duplicate."

9. The word "duplicate" shall be construed to mean in this Act such letters patent as may be issued under the twenty-second section of the Patent Law Amendment Act, 1852, in case of any letters patent being destroyed or lost.

This Act and 15 and 16 Vict. c. 83 to be construed together.

10. This Act and the Patent Law Amendment Act, 1852, shall be construed together as one Act.

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*The Schedule of Stamp Duties to be paid to which this Act refers.*

| | | | |
|---|---|---|---|
| On petition for grant of letters patent . . . . | £5 | 0 | 0 |
| On certificate of record of notice to proceed . | 5 | 0 | 0 |
| On warrant of law officer for letters patent . . | 5 | 0 | 0 |
| On the sealing of letters patent . . . . . | 5 | 0 | 0 |
| On specification . . . . . | 5 | 0 | 0 |
| On the letters patent, or a duplicate thereof, before the expiration of the third year . . | 50 | 0 | 0 |
| On the letters patent, or a duplicate thereof, before the expiration of the seventh year | 100 | 0 | 0 |
| On certificate of record of notice of objections . | 2 | 0 | 0 |

| | | | |
|---|---|---|---|
| On certificate of every search and inspection . | 0 | 1 | 0 |
| On certificate of entry of assignment or licence . | 0 | 5 | 0 |
| On certificate of assignment or licence . . . . | 0 | 5 | 0 |
| On application for disclaimer . . . . . | 5 | 0 | 0 |
| On caveat against disclaimer . . . . . | 2 | 0 | 0 |
| On office copies of documents, for every ninety words . . . . . | 0 | 0 | 2 |

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## 16 & 17 VICT. c. 115.

*An Act to amend certain Provisions of the Patent Law Amendment Act, 1852, in respect of the Transmission of Certified Copies of Letters Patent and Specifications to certain Offices in Edinburgh and Dublin, and otherwise to amend the said Act.*

[*20th August*, 1853.]

15 & 16 Vict. c. 83.

WHEREAS it is expedient to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act: Be it therefore enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Section 33 and part of section 28 of recited Act repealed.

1. Section thirty-three of the said Act, and such part of section twenty-eight of the said Act as directs that in case reference is made to drawings in any specification deposited or filed under the said Act an extra copy of such drawings should be left with such specification, shall be repealed.

Copies of provisional specifications to be open to inspection at

2. The commissioners shall cause true copies of all provisional specifications left at the office of the commissioners to be open to the inspection of the public, at such times,

after the date of the record thereof respectively, as the commissioners shall by their order from time to time direct.* the commissioners' office.

3. A true copy under the hand of the patentee or applicant, or agent of the patentee or applicant, of every specification and of every complete specification, with the drawings accompanying the same, if any, shall be left at the office of the commissioners on filing such specification or complete specification. A copy of every specification, etc., under the hand of the patentee or applicant, to be left at commissioners' office.

4. Printed or manuscript copies or extracts, certified and sealed with the seal of the commissioners, of letters patent, specifications, disclaimers, memoranda of alterations, and all other documents recorded and filed in the commissioners' office, or in the office of the Court of Chancery appointed for the filing of specifications, shall be received in evidence in all proceedings relating to letters patent for inventions in all courts whatsoever within the United Kingdom of Great Britain and Ireland, the Channel Islands, and the Isle of Man, and her Majesty's Colonies and Plantations abroad, without further proof or production of the originals. Copies or extracts of letters patent, etc., certified and sealed, filed at commissioners' office, to be received in evidence.

5. Certified printed copies, under the seal of the commissioners, of all specifications and complete specifications, and facsimile printed copies of the drawings accompanying the same, if any, disclaimers, and memoranda of alterations filed or hereafter to be filed under the said Patent Law Amendment Act, shall be transmitted to the office of the Director of Chancery in Scotland and to the enrolment office of the Court of Chancery in Ireland within twenty-one days after the filing thereof respectively, and the same shall be filed in the office of Chancery in Scotland and Ireland respectively, and certified copies or extracts from such documents shall be furnished to all persons requiring the same, on payment of such fees as the commissioners shall direct; Certified printed copies of specifications, etc., under seal of commissioners, to be transmitted to the Director of Chancery in Scotland, and to the Court of Chancery in Ireland, which shall be evidence, without production of originals.

* The public is not allowed to have access to provisional specifications until the time for proceeding under the patent has expired. An application for an inspection of a provisional specification on the ground that the subject-matter was the same as that for which the applicant had obtained a patent, was refused by *Cranworth, L. C.* (*Tolson's Patent*, 6 De G. M. & G. 422.)—*Eds.*

and such copies or extracts shall be received in evidence in all courts in Scotland and in Ireland respectively in all proceedings relating to letters patent for inventions, without further proof or production of the originals.

Lord Chancellor, in certain cases, may seal letters patent after the expiration of provisional protection.

6. Where letters patent have not been sealed during the continuance of the provisional protection on which the same is granted, provided the delay in such sealing has arisen from accident, and not from the neglect or wilful default of the applicant, it shall be lawful for the Lord Chancellor, if he shall think fit, to seal such letters patent at any time after the expiration of such provisional protection, whether such expiration has happened before or shall happen after the passing of this Act, and to date the sealing thereof as of any day before the expiration of such provisional protection, and also to extend the time for the filing of the specification thereon; and where the specification, in pursuance of the condition of any letters patent, has not been filed within the time limited by such letters patent, provided the delay in such filing has arisen from accident, and not from the neglect or wilful default of the patentee,* it shall be lawful for the Lord Chancellor, if he shall think fit, to extend the time for the filing of such specification, whether the default in such filing has happened before or shall happen after the passing of this Act: Provided always, that, except in any case that may have arisen before the passing of this Act, it shall not be lawful for the Lord Chancellor to extend the time for the sealing of any letters patent, or for the filing of any specification, beyond the period of one month.

Removing doubts as to provision of 15 & 16 Vict. c. 83, respecting the making and sealing of new letters patent for a further term.

7. And whereas doubts have arisen whether the provision of the Patent Law Amendment Act, 1852, for the making and sealing new letters patent for a further term, in pursuance of her Majesty's order in council, in the cases

* Proper directions for the filing of a specification were forwarded by post by a patentee to his agent in due time, but the letter did not arrive until it was too late to act on the instructions. Under these circumstances the L. C. gave leave to file the specification. (*Re Harris*, 25 L. T. 90.) See the L. C.'s rule of the 17th July, 1854.—*Eds.*

mentioned in section forty of the said Act, extends to the making and sealing of new letters patent in the manner by such Act directed where such new letters patent are granted by way of prolongation of the term of letters patent issued before the commencement of the said Act: And whereas it is expedient that such new letters patent granted by way of prolongation shall be granted according to the provisions of the said Patent Law Amendment Act: Be it declared and enacted, that where her Majesty's order of council for the sealing of new letters patent shall have been made after the commencement of the said Act, the said provision of the said Act for making and sealing in manner aforesaid of new letters patent shall extend, and shall as from the commencement of the said Act be deemed to have extended, to the making and sealing in manner aforesaid of new letters patent for a further term, as well where the original letters patent were made before as where such original letters patent have been issued since the commencement of the said Act.

8. This Act, and the Patent Law Amendment Act, 1852, shall be construed together as one Act.

15 & 16 Vict. c. 83 and this Act to be construed as one Act.

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## 22 VICT. C. 13.

*An Act to amend the Law concerning Patents for Inventions with respect to Inventions for Improvements in Instruments and Munitions of War.*

[8th *April*, 1859.]

WHEREAS in some cases of inventions for improvements in instruments of munitions of war it may be important to the public service that the nature of the invention should not be published, and it is therefore expedient to amend the law concerning letters patent for inventions: Be it enacted

by the Queen's most excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Improvements in instruments or munitions of war may be assigned by inventors to secretary of state for war.

1. Any inventor of any improvement in instruments or muuitions of war, or the executors, administrators, or assigns of such inventor, may, for valuable consideration or without, assigu to her Majesty's principal secretary of state for the war department, on behalf of her Majesty, all the benefit of the invention, and of all letters patent obtained or to be obtained for the same, and such secretary of state may be a party to the assignment, aud such assignment shall be effectual to vest the benefit of such invention and of such letters patent in the said secretary of state for the time being, on behalf of her Majesty, at law and in equity; and the benefit of such invention and of such letters patent shall be deemed property acquired by the said secretary of state on behalf of her Majesty; and all covenants and agreements contained in such assignment for giving full effect thereto, and for keeping the invention secret, and otherwise in relation thereto, shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced and proceeded upon by the said secretary of state for the time being accordingly, and all actions, suits, and proceedings in relation thereto may be instituted and conducted by such secretary of state for the time being, who shall have all such rights, privileges, and prerogatives in relation thereto as by law provided in the case of actions, suits, and proceedings concerning property under his care, control, and disposition.

Foregoing enactment to extend to assignments already made.

2. The foregoing enactment shall extend to render valid and effectual, and be otherwise applicable to and in respect of any such assignment as aforesaid made before the passing of this Act, and the covenants and agreements contained in such assigument, as well as any such assignment to be made thereafter, and the covenants and agreements therein contained.

Secretary of state for war may certify to commissioners of patents that the invention should be kept secret.

3. Where any such assignment as aforesaid has been made to the said secretary of state he may, at any time before the filing of the petition for the grant of letters patent for the invention, or after the filing of such petition and before publication of the provisional specification (if any), if he think it for the benefit of the public service that the particulars of the invention, and of the manner in which the same is performed, should be kept secret, certify the fact of such assignment having been so made, and his opinion to the effect aforesaid, in writing under his hand to the commissioners of patents for inventions.

Where the secretary of state for war has so certified, petition for letters patent, etc., to be left with the clerk of the patents in a packet under seal of secretary of state.

4. Where the said secretary of state certifies as aforesaid the petition for letters patent for the invention, the declaration accompanying such petition, and the provisional Specification or complete specification (as the case may be) filed or left therewith, and any specification to be filed in pursuance of the condition of any letters patent for such invention, and all disclaimers and memoranda of alterations to be filed in relation to such letters patent, and any drawings accompanying any of the documents aforesaid, and any copies of any such documents or drawings, or, where the said secretary of state so certifies after the said petition has been filed, such of the said documents and drawings as may be filed after his so certifying, and the copies thereof shall, in lieu of being filed or left in the ordinary manner in the office of the commissioners, or in the office appointed for that purpose under "The Patent Law Amendment Act, 1852," be delivered to the clerk of the patents in a packet sealed with the seal of the said secretary of state.

Such packet to be kept so sealed, or under the seal of the commissioners.

5. Such packet shall at all times after the delivery thereof to the clerk of the patents, until the expiration of the term or any extended term for which letters patent for the invention may be granted, be kept by him sealed up as aforesaid, or under the seal of the commissioners, save when it may be necessary to have access to the documents therein contained, or any of them, for the purpose of recording and

endorsing the day of the filing thereof, or for the purpose of any reference to one of the law officers, either in relation to the same or any other invention; but in any such case as aforesaid the clerk of the patents shall not part with the care or custody of the said packet, or any of the said documents, save as may be required by one of the law officers for the purposes of any such reference, and shall use such precautions as may be necessary to prevent the contents or particulars of any such documents being improperly disclosed.

Such sealed packet to be delivered, on demand, to secretary of state, or by order of lord chancellor.

6. Such sealed packet shall be delivered at any time during the continuance of any such letters patent to the said secretary of state, or to any person having authority to receive the same on his behalf, on demand in writing under the hand of the said secretary of state, or to such person as the Lord Chancellor may order, and shall, if and when the same is returned to the commissioners, be again sealed up and kept under seal as aforesaid.

At the expiration of letters patent sealed packet to be delivered to secretary of state.

7. Such sealed packet as aforesaid shall, at the end of the term or extended term for which any letters patent for the invention to which the documents in such packet relate, be delivered up to the said secretary of state or to any person having authority to receive the same on his behalf.

Where secretary of state certifies after filing of petition, documents already filed to be put into a sealed packet.

8. Where the said secretary of state certifies as aforesaid after the filing of the petition, and before the publication of the provisional specification (if any), such petition, and the declaration accompanying such petition, and the provisional specification and drawings relating to the invention which may have been filed or left in any such office as aforesaid, and all copies thereof in any such office, shall be forthwith placed in a packet sealed with the seal of the commissioners; and every such packet shall be subject to all the provisions of this Act concerning any sealed packet delivered to the clerk of the patents.

Copy of specification, etc., not to be sent to

9. No copy of any specification, or other document or drawing by this Act required to be kept under seal, shall be

transmitted to *Scotland* or *Ireland*, or be printed, published, or sold, or be open to the inspection of the public; but, save as in this Act otherwise directed the provisions of the Patent Law Amendment Act, 1852, and any Act amending the same, shall extend and be applicable to and in respect of every such specification and other document and drawing as aforesaid, and the letters patent and invention to which the same relates, and this Act and the Patent Law Amendment Act, 1852, shall be construed together as one Act.

Scotland or Ireland, or published, but otherwise provisions of Patent Acts to apply.

10. It shall not be lawful for any person to take proceedings by *scire facias* or otherwise to repeal any letters patent for any invention in relation to which the said secretary of state has certified as aforesaid.

No *scire facias* to be brought.

11. The secretary of state may, at any time by writing under his hand, waive the benefit of this Act with respect to any particular invention, and the documents and matters relating thereto shall be thenceforth kept and dealt with in the ordinary way.

Secretary of state may waive the benefit of this Act as respects any invention.

12. The communication of any invention for any improvement in instruments or munitions of war to the said secretary of state, or to any person or persons authorized by him to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any letters patent for the same.

Communication of invention to secretary of state, etc., not to prejudice letters patent.

13. In the construction of this Act "Her Majesty's Principal Secretary of State for the War Department" shall mean her Majesty's principal secretary of state for the time being to whom her Majesty shall think fit to intrust the seals of the war department.

Construction of "Secretary of State."

# RULES AND REGULATIONS

*Made by the Commissioners of Patents for Inventions, and by the Lord Chancellor and the Master of the Rolls, under the Acts* 15 *&* 16 *Vict. cap.* 83, *and* 16 *&* 17 *Vict. cap.* 115.

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FIRST SET OF RULES AND REGULATIONS UNDER THE ACT 15 & 16 VICT. CAP. 83, FOR THE PASSING OF LETTERS PATENT FOR INVENTIONS.

By the Right Honourable Edward Burtenshaw Lord St. Leonards, Lord High Chancellor of Great Britain, the Right Honourable Sir John Romilly, Master of the Rolls, Sir Frederic Thesiger, her Majesty's Attorney-General, and Sir FitzRoy Kelly, her Majesty's Solicitor-General, being four of the Commissioners of Patents for Inventions under the said Act.

WHEREAS a commodious office is forthwith intended to be provided by the Crown as the Great Seal Patent Office; and the Commissioners of her Majesty's Treasury have, under the powers of the said Act, appointed such office as the office also for the purpose of the said Act:

1. All petitions for the grant of letters patent, and all declarations and provisional specifications, shall be left at the said commissioners' office, and shall be respectively written upon sheets of paper of twelve inches in length by eight inches and a half in breadth, leaving a margin of one inch and a half on each side of each page, in order that they may be bound in the books to be kept in the said office.

2. The drawings accompanying provisional specifications shall be made upon a sheet or sheets of parchment, paper,

or cloth, each of the size of twelve inches in length by eight inches and a-half in breadth, or of the size of twelve inches in breadth by seventeen inches in length, leaving a margin of one inch on every side of each sheet.

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

4. Every invention protected by reason of the deposit of a complete specification shall be forthwith advertised in the *London Gazette*, and the advertisement shall set forth the name and address of the petitioner, the title of the invention, the date of the application, and that a complete specification has been deposited.

5. Where a petitioner applying for letters patent after provisional protection, or after deposit of a complete specification, shall give notice in writing at the office of the commissioners of his intention to proceed with his application for letters patent, the same shall forthwith be advertised in the *London Gazette*, and the advertisement shall set forth the name and address of the petitioner and the title of his invention; and that any persons having an interest in opposing such application are to be at liberty to leave particulars in writing of their objections to the said application at the office of the commissioners within twenty-one days after the date of the *Gazette* in which such notice is issued.

6. The Lord Chancellor having appointed the Great Seal Patent Office to be the office of the Court of Chancery for the filing of specifications, the said Great Seal Patent Office and the office of the commissioners shall be combined; and the clerk of the patents for the time being shall be the clerk of the commissioners for the purposes of the Act.

7. The office shall be open to the public every day, Christmas-Day and Good-Friday excepted, from ten to four o'clock.

8. The charge for office or other copies of documents in the office of the commissioners shall be at the rate of twopence for every ninety words.

(Signed) ST. LEONARDS, *C.*
JOHN ROMILLY, *M.R.*
FRED. THESIGER, *A.G.*
FITZROY KELLY, *S.G.*

Dated the 1st Oct., 1852.

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By the Right Honourable Edward Burtenshaw Lord St. Leonards, Lord High Chancellor of Great Britain, and the Right Honourable Sir John Romilly, Master of the Rolls.

Ordered, that there shall be paid to the law officers and to their clerks the following fees:—

By the person opposing a grant of letters patent.

| | | | |
|---|---|---|---|
| To the law officer | £2 | 12 | 6 |
| To his clerk | 0 | 12 | 6 |
| To his clerk for summons | 0 | 5 | 0 |

By the petitioner on the hearing of the case of opposition.

| | | | |
|---|---|---|---|
| To the law officer | £2 | 12 | 6 |
| To his clerk | 0 | 12 | 6 |
| To his clerk for summons | 0 | 5 | 0 |

By the petitioner for the hearing, previous to the fiat of the law officer allowing a disclaimer or memorandum of alteration in letters patent and specification.

| | | | |
|---|---|---|---|
| To the law officer | £2 | 12 | 6 |
| To his clerk | 0 | 12 | 6 |

By the person opposing the allowance of such disclaimer or memorandum of alteration, on the hearing of the case of opposition.

| | | | |
|---|---|---|---|
| To the law officer | £2 | 12 | 6 |
| To his clerk | 0 | 12 | 6 |

By the petitioner for the fiat of the law officer allowing a disclaimer or memorandum of alteration in letters patent and specification.

To the law officer . . . . . £3 3 0
To his clerk . . . . . 0 12 6

(Signed) ST. LEONARDS, *C.*
JOHN ROMILLY, *M.R.*

Dated the 1st Oct., 1852.

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Ordered by the Right Honourable Edward Burtenshaw Lord St. Leonards, Lord High Chancellor of Great Britain.

1. All specifications in pursuance of the condition of letters patent, and all complete specifications accompanying petitions and declarations before grant of letters patent, shall be filed in the Great Seal Patent Office.

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

3. The drawings accompanying such specification shall be made upon a sheet or sheets of parchment, each of the size of twenty-one inches and a half in length by fourteen inches and three-fourths of an inch in breadth, or upon a sheet or sheets of parchment, each of the size of twenty-one inches and a half in breadth by twenty-nine inches and a half in length, leaving a margin of one inch and a half on every side of each sheet.

4. The charge for office or other copies of documents in the Great Seal Patent Office shall be at the rate of twopence for every ninety words.

(Signed) ST. LEONARDS, *C.*

Dated the 1st Oct., 1852.

NOTE.—*It is recommended to applicants and patentees to make their elevation drawings according to the scale of one inch to a foot*

## Second Set of Rules and Regulations under the Act 15 & 16 Vict. cap. 83, for the passing of Letters Patent for Inventions.

By the Right Honourable Edward Burtenshaw Lord St. Leonards, Lord High Chancellor of Great Britain, the Right Honourable Sir John Romilly, Master of the Rolls, Sir Frederic Thesiger, her Majesty's Attorney-General, and Sir FitzRoy Kelly, her Majesty's Solicitor-General, being four of the Commissioners of Patents for Inventions under the said Act.

1. The office of the Directory of Chancery in Scotland, being the office appointed by the Act for the recording of transcripts of letters patent, shall be the office of the commissioners in Edinburgh for the filing of copies of specifications, disclaimers, memoranda of alterations, provisional specifications, and certified duplicates of the register of proprietors.

2. All such transcripts, copies, and certified duplicates shall be bound in books, and properly indexed, and shall be open to the inspection of the public at the said office, every day from ten to three o'clock.

3. The charge for office copies of such transcripts, copies, and certified duplicates, recorded and filed in the said office, shall be at the rate of twopence for every ninety words.

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4. The enrolment office of the Court of Chancery in Dublin, being the office appointed by the Act for the enrolment of transcripts of letters patent, shall be the office of the commissioners in Dublin for the filing of copies of specifications, disclaimers, memoranda of alterations, provisional specifications, and certified duplicates of the register of proprietors.

5. All such transcripts, copies, and certified duplicates shall be bound in books, and properly indexed, and shall be open to the inspection of the public at the said enrolment

office every day, Christmas-day and Good-Friday excepted, from ten to three o'clock.

6. The charge for office copies of such transcripts, copies, and certified duplicates, enrolled and filed as aforesaid, shall be at the rate of twopence for every ninety words.

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7. No warrant is to be granted for the sealing of any letters patent which contains two or more distinct substantive inventions.*

8. A provision is to be inserted in all letters patent in respect whereof a provisional and not a complete specification shall be left on the application for the same, requiring the specification to be filed within six months from the date of the application.

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

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

(Signed) St. Leonards, *C.*
John Romilly, *M.R.*
Fred. Thesiger, *A.G.*
FitzRoy Kelly, *S.G.*

Dated the 15th Oct. 1852.

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Ordered by the Right Honourable Edward Burtenshaw Lord St. Leonards, Lord High Chancellor of Great Britain.

Every application to the Lord Chancellor against or in relation to the sealing of letters patent shall be by notice, and such notice shall be left at the Commissioners' office,

* This rule was rescinded by the Third Set of Rules of 12th December, 1853.—*Eds.*

and shall contain particulars in writing of the objections to the sealing of such letters patent.

(Signed) St. Leonards, *C.*

Dated the 15th Oct., 1852.

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THIRD SET OF RULES AND REGULATIONS UNDER THE ACT 15 & 16 VICT. CAP. 83, FOR THE PASSING OF LETTERS PATENT FOR INVENTIONS, AND UNDER THE ACT OF THE 16 & 17 VICT. CAP. 115.

By the Right Honourable Robert Monsey Lord Cranworth, Lord High Chancellor of Great Britain, the Right Honourable Sir John Romilly, Master of the Rolls, Sir Alexander James Edmund Cockburn, her Majesty's Attorney-General, and Sir Richard Bethell, her Majesty's Solicitor-General, being four of the Commissioners of Patents for Inventions under the said Act of the 15 & 16 Vict. cap. 83.

It is ordered as follows:—

Rule 7. of the Second Set of Rules and Regulations of the Commissioners, dated the 15th October 1852, is hereby rescinded.

1. Every application for letters patent, and every title of invention and provisional specification, must be limited to one invention only, and no provisional protection will be allowed or warrant granted where the title or the provisional specification embraces more than one invention.

2. The title of the invention must point out distinctly and specifically the nature and object of the invention.

3. The copy of the specification, or complete specification, directed by the Act 16 & 17 Vict. cap. 115, sect. 3, to be left at the office of the Commissioners on filing the specification or complete specification shall be written upon sheets of brief or foolscap paper, briefwise, and upon one side only of each sheet. The extra copy of drawings, if any, left with the same, must be made as heretofore, and according to the directions contained in Rule III. of the Lord Chancellor, dated the 1st October, 1852.

4. The copy of the provisional specification to be left at the office of the Commissioners on depositing the same shall be written upon sheets of brief or foolscap paper, briefwise, and upon one side only of each sheet. The extra copy of drawings, if any, left with the same, must be made as heretofore, and according to the directions contained in Rule II. of the Commissioners, dated the 1st October, 1852.

5. All specifications, copies of specifications, provisional specifications, petitions, notices, and other documents, left at the office of the Commissioners, and the signatures of the petitioners or agents thereto, must be written in a large and legible hand.

6. In the case of all petitions for letters patent left at the office of the Commissioners after the 31st day of December, 1853, the notice of the applicant of his intention to proceed for letters patent for his invention shall be left at the office of the Commissioners eight weeks at the least before the expiration of the term of provisional protection thereon, and no notice to proceed shall be received unless the same shall have been left in the office eight weeks at the least before the expiration of such provisional protection; and the application for the warrant of the law officer and for the letters patent must be made at the office of the Commissioners twelve clear days at the least before the expiration of the term of provisional protection, and no warrant or letters patent shall be prepared unless such application shall have been made twelve clear days at the least before the expiration of such provisional protection: Provided always, that the Lord Chancellor may, in either of the above cases, upon special circumstances, allow a further extension of time, on being satisfied that the same has become necessary by accident, and not from neglect or wilful default of the applicant or his agent.

(Signed) CRANWORTH, *C.*
JOHN ROMILLY, *M.R.*
A. E. COCKBURN, *A.G.*
RICHARD BETHELL, *S.G.*

Dated the 12th of Dec., 1853.

## RULE IN RESPECT OF APPLICATION TO THE LORD CHANCELLOR TO EXTEND THE TIME FOR SEALING LETTERS PATENT.

By the Right Honourable Robert Monsey Lord Cranworth, Lord High Chancellor of Great Britain.

Whereas by the Act 16 & 17 Vict., cap. 115, the Lord Chancellor is empowered to extend the time for the sealing of letters patent for an invention, and for the filing of the specification thereon, limited to the period of one month after the expiration of the six months of provisional protection of such invention, provided the delay in sealing such letters patent and in filing such specification has arisen from accident, and not from the neglect or wilful default of the applicant.

It is ordered as follows:—

Every petition addressed to the Lord Chancellor, praying for the extension of time for the sealing of letters patent, and for the filing of the specification thereon, under the provisions of the Act of the 16 & 17 Vict., cap. 115, and the affidavit accompanying the same, shall be left at the office of the Commissioners of Patents. And in every case where the delay in sealing such letters patent and in filing such specification is alleged to have been caused by adjourned hearings of objections to the grant of such letters patent before the law officer to whom such objections may have been referred, the petitioner, before leaving his petition as aforesaid, shall obtain the certificate of such law officer, to the effect that the allegations in respect of such adjourned hearings and causes of delay are in the opinion of such law officer correct, and that the delay arising from such adjourned hearings has not been occasioned by the neglect or default of the petitioner. And such certificate shall be written at the foot of or shall be annexed to such petition.

(Signed) CRANWORTH, *C.*

Dated this 17th day of July, 1854.

## Rule as to Inventions Communicated from Abroad.

I. In any application for a patent which is stated to be a communication, the declaration must state the name and address of the party from whom it has been received in the following manner:—

No. 1. When declaration is made in the United Kingdom—"That it has been communicated to me from abroad by (here insert name and address in full)."

No. 2. In other cases—"That it is a communication from (*A. B.*) a person resident at (here insert address in full)."

II. All provisional specifications must be written on one side only of each sheet.

FitzRoy Kelly.
H. M. Cairns.

Dated 23rd Feb., 1859.

# APPENDIX.

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## PART II.

### PATENT LAWS OF FOREIGN COUNTRIES:

AMERICA, U. S. OF.
AUSTRIA.
BAVARIA.
BELGIUM.
BRAZIL.
DENMARK.
FRANCE.
HANOVER.
HOLLAND.
ITALY.
MEXICO.
POLAND.
PORTUGAL.
PRUSSIA.
ROMAN STATES.
RUSSIA.
SAXONY.
SPAIN (AND CUBA).
SWEDEN AND NORWAY.
WURTEMBERG.

GERMAN ZOLLVEREIN.

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### PATENT LAWS OF BRITISH COLONIES:

BRITISH GUIANA.
CANADA.
CAPE OF GOOD HOPE.
CEYLON.
INDIA.
JAMAICA.
NEWFOUNDLAND.
NEW SOUTH WALES.
NEW ZEALAND.
QUEENSLAND.
TASMANIA.
TRINIDAD.
VICTORIA.

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# APPENDIX.

## PART II.

### FOREIGN PATENTS.

The field for enterprise in this respect is so large, that it behoves the inventor, who is not satisfied with that afforded him at home, to consider well the countries in which his invention is likely to come into use, and also his own personal prospects of pushing his invention abroad.

It is well known that a very large sum of money is annually spent upon foreign patents without the slightest return; and this arises, not so much from the fact that the inventions patented abroad are not of value or suited to the requirements of the countries in which they are patented, but that the inventors having once obtained patents, not only do not attend to the requirements of the several States as to the acts to be done or duties paid, but do not take the slightest trouble to obtain a commercial introduction of their inventions, and seem to think that, contrary to the general experience at home, nothing more than the possession of the patent is requisite for the purpose of obtaining a return for the invention.

There are many rules with respect to foreign patents which differ from our British regulations: for instance, it is nearly universally necessary that the inventor should himself apply for the patent, and that the inventions patented should be put into practice within a certain definite period from the grant, and should continue in use year by year during the

term. Annual and other duties have to be paid, and in some States the patented articles must be made in the country itself, and cannot be imported. It should also be borne in mind that any publication at home is a bar to obtaining a patent afterwards in most foreign States.

It must also be remembered that in many foreign countries the patent for an imported invention expires with the determination of the grant in that country from which the invention has been imported.

With these preliminary observations we will now proceed to discuss the laws of the most important foreign States separately.

## THE UNITED STATES OF AMERICA.

The existing law of patents in the United States is principally regulated by an Act of Congress of March, 1861, one great feature of which was the abolition of the large difference formerly existing in the fees paid by citizens and foreigners.

Probably in no country in the world are the rights of inventors more cherished than in the United States: the number of inventions, particularly of the class termed "labour-saving," protected annually by patents, is immense; and at the same time, the number of British patents applied for by citizens of the United States is proportionately large.

The facilities for obtaining patents have been increased of late years, and no patent for an invention possessing any features of novelty is refused.

The following particulars will be found, we believe, to give all the information an inventor can require as to the patent laws of the United States:—

All inventors, whether native or foreign, or their legal assignees, may obtain patents. An inventor who has already patented abroad has a period of six months allowed him from the date of his foreign patent to take out an American patent.

Beyond this period he can still obtain a patent, provided his invention has not been introduced into the States, although it may have been published.

Only an American inventor, or a foreigner who has resided for one year in the United States, or has declared on oath his intention of becoming a naturalised citizen of the States, can deposit a caveat.

New and useful arts, new machines, new chemical compounds, useful implements unknown or not used by others prior to the date of the demand, and of which the products have not been introduced into commerce, are patentable. A new application of a known mechanism or process cannot be patented. All patented articles must bear the date of the patent. Any patentee who, by mistake, shall have claimed some parts, the novelty of which cannot be supported, may, by means of a disclaimer, abandon such parts, but no addition to the patent can be made: the improvements on an invention can only be secured by a new patent.

Patents are granted for seventeen years. Patents for inventions previously patented abroad expire with the foreign patent.

On the application for a patent a tax of 15 dollars is to be paid, and on the delivery of the patent the further tax of 20 dollars.

The tax on entry of a disclaimer is 30 dollars.

No prolongations are granted.

Applications for patents are submitted to the examination of special commissioners, who reject all those which are irregular, and those which claim more than is new. Demands so rejected may be again presented after having been modified. In the case of a fresh rejection by the first examiners, the petitioner may appeal to the chief examiners, and in case of their rejection he may appeal to the Commissioner of Patents. These proceedings create delay, and involve considerable expense.

After the deposit of the demand, an extract of the specification is published by the Patent Office. The patents are after-

wards published in full by the Government, and may be inspected by the public, who may also obtain copies on a small payment.

The petition to the Patent Commissioners must be accompanied by a receipt for the tax, a description or specification setting forth clearly the nature and principle of the invention, drawings in duplicate, a model not exceeding 1 cubic foot in size, or a specimen of the product, and a power of attorney legalised by the Consul.

Patents become void: 1. If the invention has been publicly used before the application (the personal use of a machine, process, &c., by another within the two years only preceding the patent, does not nullify the same, but the continued use by such person cannot be prevented). 2. When it has been obtained to the damage of the true inventor. 3. If the specification filed does not truly set forth the invention, and if it claims part not new.

The cost of a patent, including drawings and specification, but not including model, averages about £31 10*s*.

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## AUSTRIA.

The patent law of this empire was remodelled by an imperial decree, dated the 15th August, 1852, which established the following regulations throughout the empire:—

Patents are not allowed for alimentary preparations, beverages, or medicines, nor for discoveries, inventions, or improvements which are contrary to public health, public welfare, morality, or the interest of the State. With this exception, patents are granted for every new discovery, invention, or improvement, having for its object (*a*) a new industrial product, (*b*) a new means of producing, or (*c*) a new method of producing—that is to say, new within the empire.

An invention is deemed new when, up to the moment the

patent was applied for, the same had not been put into operation, or been made public in the empire.

Foreigners, as well as Austrian subjects, may be patentees; but with regard to inventions made by foreigners not resident in Austria, patents are only granted when a patent has been obtained in the country where they were made, and then only to the original patentee, or his legal assignee.

Two or more inventions cannot be included in a single patent, unless they refer to the same subject-matter, as essential parts of it.

The petition for a patent may be made either by the inventor, or by his legal attorney. It must state the exact title of the invention, and the number of years for which it is desired the patent should last. The maximum duration of a patent is fifteen years, which length of time cannot be exceeded, except by special imperial authority.

The amount of Government tax is as follows:—For the first five years, 20 florins (£2) a-year; sixth year, 30 florins; seventh year, 35 florins; eighth year, 40 florins; ninth year, 45 florins; tenth year, 50 florins; eleventh year, 60 florins; twelfth year, 70 florins; thirteenth year, 80 florins; fourteenth year, 90 florins; fifteenth year, 100 florins; or for the entire fifteen years, 700 florins (£70). In addition to these taxes, there are also others in the nature of town dues, payable upon patents. Previous to, or at the time of lodging the petition, the tax must be paid for the entire number of years for which the patent is applied for.

A description must accompany the petition, and this must contain a full, clear, and minute explanation of the invention; if drawings, samples, or models are required for the full comprehension of the description, they must be supplied.

A patentee is entitled to establish workshops or factories, to employ the workpeople he may find requisite to carry out the object of the patent to its fullest extent, and consequently to form establishments, stores, and warehouses for the manufacture, within the entire empire. He may sell and dispose

of the proceeds, and license others to use his invention, take partners, and dispose of his patent right by assignment or in any way whatsoever.

When the original term of a patent is less than fifteen years, the patentee may apply to have it prolonged for the full period of fifteen years. He must make application before the term originally limited has expired, and he must pay the entire tax for the term of prolongation.

A patent will be cancelled on proof that the legal requisites for a patent do not exist, or that the description does not fulfil the prescribed conditions, or that the invention is not new, or being an importation from abroad, that the patentee is not the real owner of the foreign patent, or that the object of the patent is contrary to law, or to the health or morality of the public, or the interest of the State.

A patent will expire not only by efflux of the term, but also in case the patentee should fail to bring his discovery into operation within a year from the date of the patent, or in case he should entirely suspend working the same for the space of two years.

The cost of a patent in this empire for one year varies from £15 to £25.

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## BAVARIA.

By a royal ordinance, dated September 11, 1825, new discoveries, inventions, and improvements in trades, or such as have not yet been used in the kingdom, may, if required, be protected by special exclusive privileges granted under certain conditions, and for a fixed period of fifteen years at most, at the expiration of which the discovery, invention, or improvement becomes public property. And by certain rules for the execution of the organic law regulating trades, dated 17th December, 1853, the following regulations were established :—

Letters patent may be granted for discoveries, inventions,

or improvements in arts and trades, whether they concern a new article, a new means, or a new process of manufacturing:—1. Whenever the object itself is new and original, or whenever the alteration contains a new and peculiar feature; and 2. Whenever the said object is of such an importance as to give to the invention or improvement a character of public utility.

Patents of importation may also be granted for a discovery, invention, or improvement made abroad, when the same is protected by a patent abroad. In general, subjects of foreign States granting reciprocal advantages shall be treated like Bavarian subjects in the granting of letters patent.

No patent of importation can endure beyond the period of the expiration of the foreign patent.

A patent may be annulled whenever the invention is proved not to be new and original, or to have already been carried into execution (except in the case of the existence of a foreign patent), or whenever the invention has already been described in published works of the country or of foreign countries, whether they be written in German or foreign languages, in such a manner as to enable any competent person to work the invention. The petition for a patent must give a correct title to the invention, and must state the number of years for which the patent is demanded.

The petition must be accompanied by a full and complete description of the invention, and of the process employed. Drawings, plans, models, or patterns must be produced when necessary.

A petition for a patent of importation must be accompanied by an official copy of the letters patent obtained abroad.

Letters patent will be refused whenever it is shown—1. That the preparation of the new manufacture, or the application of the new means or process of manufacturing, cannot be permitted for sanitary reasons, or because they endanger the commonweal, or, finally, because they are contrary to existing laws and regulations. 2. That the object to

be patented is not new and original. 3. That the invention does not fulfil the requirements of great public utility. 4. That the grant would be contrary to the provision relating to the subject of a Zollverein State.* 5. That the same invention had already been patented previously in Bavaria.

No patent can be granted for a longer period than fifteen years. In case of its having originally been granted for a shorter period, a prolongation may be obtained to the full extent of fifteen years.

The taxes to be paid are:—25 florins† for one year; 30 florins for two years; 40 florins for three years; 50 florins for four years; 60 florins for five years; 70 florins for six years; 90 florins for seven years; 110 florins for eight years; 130 florins for nine years; 150 florins for ten years; 175 florins for eleven years; 200 florins for twelve years; 225 florins for thirteen years; 250 florins for fourteen years; 275 florins for fifteen years.

In extending a patent granted for a short period, the taxes to be paid are calculated according to the progressive rate of the later years.

The taxes, together with the stamp duty of 3 florins, must accompany the petition for a patent or a prolongation.

Letters patent do not give a right to prohibit and limit—1. The importation of articles corresponding with the patent article; or, 2. the sale and disposal of the same; or, 3. to interdict the use of such articles whenever they have not been procured from the patentee, or from other parties, without his consent, unless the object of the invention be a new manufacturing process, a new means of manufacturing, or a new machine, or a new instrument for manufacturing and industrial purposes, in which case letters patent grant an unlimited right to prohibit the use of the patent method or means, or patent machines or tools, to such parties as have not acquired the right thereto from the patentee, or procured the patent article from him.

* See the Zollverein Regulations.

† A florin = 1*s.* 8*d.*

Patentees are entitled to erect any number of industrial establishments, and to engage workmen, for the exercise of their patent rights, with a due observance of existing laws, ordinances, or police regulations.

Patentees may assign their patents or form partnerships with others, with a due observance of the existing laws and ordinances.

Patents become void if the invention is proved to be not new, or whenever the specification is incomplete, or whenever the patentee does not work the invention within three years, or in case of the patent being granted for less than six years, within the first half of that term, or whenever the owner of a patent of importation does not work it within one year, and the working has not been proved before the Ministry of Commerce and Public Works, or whenever the works have been suspended for two years.

The cost of a patent in Bavaria for one year varies from £15 to £25.

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## BELGIUM.

An Act bearing date the 24th May, 1854, and a royal decree of the same date, and an amending law of the 27th March, 1857, determine the law of patents in this kingdom.

Patents are granted without previous examination, at the sole risk of the applicants.

The duration of patents is fixed at twenty years, except in the case of inventions previously patented in some other country. Such patents will expire at the same time as the foreign patent.

Patents are subject to an annual and progressive tax, viz.:—first year, 10 frs. (8s.); second year, 20 frs. (16s.); third year, 30 frs. (24s.); and so on till the twentieth year, when the tax will be 200 frs. (£8). Each annual tax is to be paid in advance.

No tax is payable on patents for improvement when delivered to the original patentee; such patents expire with the original patent.

Patents confer on their owners or assigns the exclusive right of working the invention for themselves, or having it worked by persons authorised by them.

Applicants for patents are required to lodge at the proper office, in duplicate, a full description of the invention, with drawings, models, or samples, when necessary. The first annual tax is paid when the documents are lodged.

Specifications of patents are published three months after the grant. If the annual tax is not paid within the month after it falls due, patentees shall, after previous notice being given to them, and under penalty of losing their patent rights, pay a sum of 10 francs, besides the annual tax.

Patents become void in case of nonpayment of the annual tax within the month it falls due.

The owner of a patent must work the invention in Belgium within one year from its having been worked abroad; otherwise it becomes void, and this will be the case if a suspension of the working of the invention for one year takes place, unless good reasons can be given.

Patents will become void if the invention is destitute of novelty, either by reason of having been previously worked in Belgium or of having been published in a printed work; also if the specification is not full and complete.

The cost of a Belgian patent varies from £10 to £15.

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## BRAZIL.

Natives or foreigners can obtain patents without distinction.

All inventions or improvements are patentable.

Patents of invention only are granted. The importer of a

foreign discovery is only entitled to a reward, the value of which depends on the importance of the invention. No certificates of addition or prolongations are granted.

The duration of a patent is fixed by the Government, and varies from five to twenty years.

There is no Government tax, but the granting of a patent necessitates the payment of certain official expenses, which amount to about £40.

The fees are payable in advance.

Patents are granted without any preliminary examination.

The period within which the invention must be worked is two years.

The application must be accompanied by a duplicate set of drawings and descriptions.

The applicant must declare that he is the true inventor.

The patent becomes void: if the patentee who has obtained a patent in Brazil afterwards patents the same invention abroad, if the invention be not worked within the specified time, or if the invention be proved to be old.

A patent for Brazil costs about £40.

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## DENMARK.

Inventors, whether natives or foreigners, as well as the first importer, may obtain patents.

All inventions or improvements are patentable.

The patent dates from the day of the reception of the demand.

Patents of invention and of importation are granted. Improvements can only be protected by new patents of invention.

The term of patents of invention is fixed by the Government, and cannot exceed twenty years; that of patents of importation is five years.

A uniform tax of 60 francs is required for each demand for patent. If the patent be in the name of several persons, the

tax is from 120 francs. Over and above these sums are various stamp duties and other charges, to be paid in advance.

Prolongations are not usually granted boyond the term fixed by Government for the duration of the patent.

A slight examination of the invention is made before granting the patent.

Patents are not published, and information cannot be obtained without the intervention of the College of Commerce, to which a demand, with the special motives for the same, must be presented.

The working of the invention should be proceeded with during the first year of the patent, and continued without interruption during the whole term.

The patent does not prevent the introduction of similar products into the country, provided they have been manufactured abroad.

Assignments of patents are not authorised; they may, however, be accomplished by the joint demand of the proprietor and of the assignee, for a new patent in the name of the latter.

The petition to the King should indicate the object of the invention. From the day on which the demand is received, the applicant has four weeks allowed him if he be a citizen of the country, and six weeks if he be a foreigner, to prepare and send to the Council of Commerce duplicate descriptions in Danish and drawings of the invention.

The agent or attorney must be furnished with a power legalised by the Danish Consul.

The patent becomes void, if the invention is not new, or if it has not been worked within the given time.

The cost of a patent for Denmark is about £21.

## FRANCE.

As the country nearest our own shores, and with which our intercourse is so close, it is desirable all inventors should be well informed on the subject of the French laws.

It is highly important inventors should bear in mind that French patents must be applied for prior to the filing the complete specification in England. (See *Lister's Patent*, Newton's London Journal, 1st August, 1859.)

Letters patent for inventions (*brevets d'invention*) are regulated in France by a law bearing date the 5th July, 1844, the material parts of which are as follow:—

Every new discovery or invention in any branch of industry, confers upon its author, under the conditions and for the time hereafter mentioned, the exclusive right of working the same for his own benefit. Such right is constituted by the documents issued by Government denominated *brevets d'invention.*

The following cannot be patented:—(1.) Pharmaceutical compounds, or medicines of any kind, these being governed by special laws and regulations, principally by a decree of the 18th August, 1810; (2.) schemes and projects of credit and finance.

The duration of patents is five, ten, or fifteen years; the payment in respect of a patent for five years, 500 francs (£20); for a patent for ten years, 1,000 francs; and a patent for fifteen years, 1,500 francs. These sums are to be paid by yearly instalments of 100 francs, and the patent will expire if default shall be made in payment of any one instalment. The duties may all be paid up in advance when desired.

Foreigners may obtain patents in France; and persons who have patented their inventions abroad may obtain patents for them in France. In such a case, the French patent will expire when the foreign patent expires.

Persons desirous of obtaining a patent apply by petition to the Minister of Agriculture and Commerce, and give a de-

scription of the discovery, invention, or application forming the subject of the proposed patent, accompanied, when needful, by specimens.

The petition must be in the French language, and restricted to a single principal object, with the necessary details and its proposed applications. It must mention the duration which the applicant desires for the patent. It must also give a title, comprehending a summary and precise designation of the subject of the invention.

No documents will be received except on production of a receipt proving payment of a sum of 100 francs (£4), on account of the tax on the patent.

The patents which have been applied for in due form, are delivered out without previous examination, at the risk and peril of the applicants, and without Government guarantee, either as to the reality, the novelty, or the merit of the invention, or as to the fidelity or accuracy of the description.

The patentee, or the person entitled to the patent, has the right, during the currency of the patent, to make alterations, additions, or improvements in the invention, and the proceedings are similar to those required to be taken in applying for an original patent. The petition is subjected to a tax of 20 francs only. The certificates of addition obtained by any one person entitled under the patent shall accrue to the benefit of all.

A patentee who, in respect of an alteration, addition, or improvement, desires to take out a principal patent for five, ten, or fifteen years, in place of a certificate of addition expiring with the original patent, must pay the tax levied on original patents.

Only the patentee, and those claiming under him, can, during a year, obtain a valid patent for an alteration, improvement, or addition to the invention forming the subject of the original patent; nevertheless, every person wishing to obtain a patent for an alteration, improvement, or addition to a discovery already patented, may, in the course of the said year,

make a formal application to the Minister of Agriculture and Commerce, which shall be transmitted to him, and shall remain deposited under seal. At the expiration of the year, the seal shall be broken and the patent issued; but the original patentee shall always have the preference in respect of alterations, improvements, and additions, for which he himself shall, during the year, have demanded a certificate of addition or a patent.

A patentee may assign the whole or a part of his property under a patent. The entire or partial assignment of a patent, whether as a gift or for valuable consideration, can only be made by a notarial act, and after payment of all the instalments of the tax. No assignment is valid with respect to third parties until after registration.

The descriptions, drawings, specimens, and models of patents issued, remain deposited, until the expiration of the patents, with the Minister of Agriculture and Commerce, where they may be inspected by anyone, free of charge.

Patents are null and of no effect in the following cases, viz., (1.) if the discovery, invention, or application is not new; (2.) if the discovery, invention, or application is not patentable; (3.) if they refer to principles, methods, systems, discoveries, and theoretical or purely scientific conceptions, the industrial applications of which are not shown; (4.) if the discovery, invention, or application is contrary to the order, *safety, morals, or laws of the kingdom*; (5.) if the title under which the patent has been applied for, fraudulently indicates something which is not the true subject-matter of the invention; (6.) if the description annexed to the patent is insufficient for carrying the invention into effect, or if it does not completely and fairly state the real methods adopted by the inventor.

No discovery is held new, which, previous to the date of the deposit of the petition, has received publicity in France, or in a foreign country, sufficient to enable anyone to execute it.

A patentee will be deprived of his rights under the following circumstances :—(1.) If he should fail to pay the annual payment before the commencement of each year of the term of the patent; (2.) if he shall not put his invention or discovery into execution within two years from the date of the signature of the patent, or if he shall cease for the space of two consecutive years to work the patent—unless, in either case, he can justify his inaction; (3.) if he introduces into France objects made in a foreign country similar to those protected by his own patent.

Whoever, in his trade inscriptions, advertisements, prospectuses, marks, or stamps, shall assume the title of patentee, without possessing a patent issued according to law, or after the expiration of a patent; or who, being a patentee, shall describe himself as patentee, or refer to his patent, without adding thereto the words—"*sans garantie du gouvernement*" (without the guarantee of the Government), is liable to a penalty of from 50 to 1,000 francs. In case of a repetition of the offence, the penalty may be doubled.

The cost of a French patent varies from £12 to £20, according to circumstances.

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## *HANOVER.*

The law relating to patents for inventions is dated 18th August, 1847. A few regulations were subsequently made, and the whole law is subject to the Convention of the Zollverein.

Any person making a new industrial invention may obtain a patent in respect of it, and any person importing an invention from foreign countries, unless such invention be already known to the public, may likewise obtain a patent.

A patent may also be obtained for an essential improvement to an invention already patented in the kingdom.

The petitioner for a patent must deliver a precise, correct,

and complete description of the object to be patented, setting forth the peculiar claims to novelty, together with the required drawings or models, and, if possible, a pattern of the product.

In case of the invention being already patented abroad, an official copy of the former letters patent must be produced.

Foreigners will not be allowed to obtain patents except for inventions intended to be carried out within the kingdom.

A patent shall not be granted for a longer term than ten years. In the case of a patent being granted originally for a shorter period, its duration may be extended to that term. Such a prolongation, however, must be published at least one year before the expiration of the term originally fixed.

Patents of importation shall not endure beyond the term of the foreign patent.

A patent may be transferred or made over to others by will.

A patent will be cancelled if it can be shown that the invention is not new, and particularly if, at the time of the granting of the patent, it had already been openly put into practice, or had gained such publicity as to allow of its imitation. If such an invention has been worked out secretly by private individuals, the patentee shall have no claim on them.

The patent may, moreover, be cancelled if it be shown that the invention has been wrongly or incompletely described.

Likewise, if it be proved by some other person that the invention was made or originally imported by him, and that the patentee had illegally appropriated the same.

Finally, if the invention shall not, without sufficient reason, be put into practice in the kingdom within six months from the granting of the patent, or whenever the working of the said invention has been interrupted during six months.

The cost of a patent in Hanover varies from £20 to £30

## HOLLAND.

Patents for inventions in Holland are governed by a law promulgated in January, 1817, and by certain regulations founded thereon. Patents may be obtained for five, ten, or fifteen years. The Government charges are, respectively, 317 francs, 635 francs, and 1,270 francs. A patent obtained for five or ten years may be prolonged, sufficient reason being shown, to the full term of fifteen years; but as such prolongations are not easily obtainable, it is better to apply for a duration of fifteen years at first.

A patent obtained for an imported invention will expire with the patent obtained in respect of the same invention in the foreign country, and the invention must be exercised in the kingdom.

It secures to the patentee the exclusive right of manufacturing and selling throughout the kingdom, or of licensing others to make and sell, objects to which the patent refers.

Whenever a patent is applied for, an exact detailed description must be deposited, under seal, of the object or secret for which a patent is sought, accompanied by the necessary plans and designs (in duplicate), samples or patterns. This description will not be published until after the expiration of the patent.

A petitioner, when he lodges his petition, is required to give an undertaking to accept the patent, if granted; to pay the dues within three months; and to submit, in the event of not fulfilling this undertaking, to have the patent annulled, and the invention made public.

A patent will be void, (1.) if it appears that the petitioner has wilfully omitted to describe any part of his secret, or has given a fraudulent explanation in his specification; (2.) if it appears that the subject of the patent has been described in some printed and published work; (3.) if the patentee shall not put his invention into practice within two years of the grant, unless there are special reasons, of which the Government

will judge; (4.) if the patentee should, after obtaining his patent, obtain a patent in any other country;* (5.) if it appears that the patented invention is dangerous in its nature or application to the security of the kingdom or its inhabitants. Should a patent be pronounced null on any of these grounds, so much of the tax as is proportionate to the time which it may have to run will be returned.

Where a patentee has invented an improvement, he may obtain a patent of addition for the term for which the original patent has to run, or he may apply for a new patent in the same manner as if he were applying for an independent invention.

Government makes no charge on patents of addition, where the improvement strictly relates to the patent previously taken; but all sums due in respect of the former patent must be paid before application is made for a patent of addition.

Before a patentee can assign his patent, either wholly or in part, he must obtain the royal licence, and the instrument of transfer must be registered. The tax on a transfer is about 18 francs. Persons succeeding by inheritance to the rights of a patentee must likewise register their title.

It has been the practice of late years for the patentee to pay only about ten per cent. of the tax in the first instance, and to give an undertaking to pay the remainder within two years.

The first cost of a patent in Holland varies from £15 to £20.

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## ITALY.

The law which governs the grant of patents for the new Kingdom of Italy is dated from 31st January, 1864.

The inventor only, whether a native or a foreigner, can obtain a patent of invention.

* This absurd regulation is got rid of in practice by the patentee taking the foreign patents in another name, and then having them transferred to him.

Inventions are considered patentable which have for their immediate object:—(1.) An industrial product or result; (2.) any instrument, machine, &c., or mechanical arrangement; (3.) any process or method of industrial production; (4.) a motor, or the industrial application of a force already known; (5.) lastly, the technical application of a scientific principle in such a condition that it will produce direct industrial results.

The invention must be novel.

A new invention or industrial discovery patented abroad and not yet imported into Italy, although already published by means of such foreign patent, confers the right to the inventor of obtaining a patent in Italy, provided the application be made before the expiration of the foreign patent.

A patent of invention takes effect from the date of the application, and is in force from the last day of that one of the months of March, June, September, or December which follows next after the date of the application.

*Certificates of addition* are granted annexed to the principal patent. Application for certificates of addition made during the first six months by the owner of a patent have precedence over applications made for the same invention by others.

*Certificates of reduction*, or disclaimers, may be demanded by a patentee within the first six months of his patent, for the purpose of reducing the patent to one or more parts of the invention forming the object of the description annexed to the original demand; it being necessary to point out clearly the parts to be struck out of the patent.

Patents are granted for various terms from one to fifteen years, at the desire of the petitioner. A patent granted for an invention already patented in another country expires with that patent for which the longest term has been granted, but in no case exceeds the maximum limit of fifteen years.

Certificates of addition expire with the original patent to which they are attached.

Every patent is liable to two taxes: the one consisting of as many times 10 francs as there are years in the term demanded;

the other (annual), consisting of 40 francs for each of the first three years of the patent; 65 francs for each of the three following years; 90 francs for the seventh, eighth, and ninth years; 115 francs for the tenth, eleventh, and twelfth years; 140 francs for each of the three last years.

A sum of 20 francs only is required for certificate of addition, to be paid in advance.

All certificates of prolongation necessitate over and above the taxes the payment of a sum of 40 francs.

Each certificate of reduction involves the payment of a tax of 40 francs.

The amount of the proportional tax for the term demanded and the first annuity is to be paid when making the application for the patent. This obligation to pay in advance the total of the proportional tax becomes burdensome if the patent should not be continued. On the other hand, each demand for prolongation necessitates the payment of a fixed tax; and the patents demanded for more than five years have accorded to them a period of two years within which they are to be put into operation. Hence the usual practice is to demand a patent for six years. The other annuities are paid in advance the first day of each year of the term of the patent, and are subject to triennial augmentation even in the case of prolongation of the patent. Three months' grace is allowed for the payment of the annuities, and if this period lapses the patent is forfeited.

Patents demanded for a less term than fifteen years can be prolonged to this term. Each demand for prolongation must be accompanied by a statement showing the ownership of the patent, and the receipt for the tax of 40 francs.

Demands for patents are subjected to no other examination than that in reference to the rules laid down by the authorities, with the exception, however, of patents for drinks and eatables, which are examined by the superior sanitary council.

The records containing the certificates of deposit, changes, additions, cancelling, or assignment of patents are published.

Persons requiring extracts from such records must make the application on stamped paper; the extracts are supplied at the expense of the applicant.

The drawings and descriptions are published three months after the grant of the patent; anyone can then obtain one or more copies at his own expense.

Every three months a list of the patents granted during the preceding three months is published in the official journal. Every six months the descriptions and drawings of the patents granted during the previous six months are published.

Patents granted for a term not exceeding five years must be put in operation within the first year of the term, and the working must be continued without interruption for more than one year.

Patents granted for more than five years have a period of two years allowed for working them; in both cases the owner of the patent should, in case of inaction, show the reason of neglect; but the want of funds is not recognised as a valid excuse.

The importation by a patentee of similar articles manufactured abroad is not protected by the patent.

Every deed of transfer or assignment of a patent is registered upon the grant of the original patent, and published in the official journal; such publication is not valid as regards a third party, excepting from the date of registration.

The application for a patent addressed to the Minister of Finance must contain:—(1.) The name and surname, place of birth and residence of the applicant, and of his attorney or agent; (2.) a short and precise description, in the form of a title, of the nature and object of the discovery; (3.) the length of the term for which the patent is desired.

To the application should be annexed:—(1.) Three copies of a description of the invention in French or Italian; (2.) explanatory drawings or models (also three copies); (3.) a receipt proving the payment of the tax; (4.) a list of the documents.

An Italian patent becomes void:—(1.) If it has reference to any of the inventions proscribed by the law; (2.) if the title fraudulently sets forth another object than the true object of the invention or discovery; (3.) if the description does not fully and faithfully point out the necessary means of carrying out the invention; (4.) if the invention is not new or useful; (5.) if the patent has formed the subject of a certificate granted to a third party for modification of an invention within the six months reserved to the author or his proxy; (6.) if the tax be not paid within the three months from the date at which it is due; (7.) if the patent has not been worked within the prescribed period; (8.) if the patent has been granted to any other than the inventor or his agent.

The cost of an Italian patent varies from £21 to £31 10*s*.

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## MEXICO.

The law which governs the grant of patents is dated the 7th May, 1832.

Natives or foreigners can obtain patents.

Patents for invention are granted for ten years, for improvements for six years.

If the invention or improvement is of such a nature as to admit of its being kept secret, and if a patent has been obtained for the same, the invention or improvement must be thrown open to the public at the expiration of the term.

Inventions or improvements cannot be worked as patent inventions before the patent which establishes the rights of the patentees is delivered.

Contests about the property of inventions or improvements are settled according to the common laws.

Whenever patents are proved to have been obtained fraudulently, by applicants representing mere importations as inven-

tions or improvements, the patentee forfeits his right to the same.

If inventions or improvements are desired to remain secret, the drawings, descriptions, &c., are not to be published before the expiration of the term.

The patent fees vary between 10 and 300 dollars (pesos).

Half the number of men, at least, employed by the patentee in mechanical works, must be subjects of Mexico, if such may be had.

The entire expense of a patent for Mexico is about £42.

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## POLAND.

The law is declared by an imperial decree, dated the 2nd (14th) of November, 1836.

Patents for inventions, discoveries, or improvements shall be granted for three, five, or ten years. Patents for importations can only be granted for the term obtained abroad. Patents of invention are delivered on a mere application without previous examination, and consequently neither the merit, priority, or quality of the invention is guaranteed.

The taxes on patents are 150 florins for three years, 250 florins for five years, and 500 florins for ten years. These taxes are paid in advance.

The application for a patent must be accompanied by a declaration as to whether the article about to be patented is an original invention or an importation, as well as by a complete specification of the principles, means, and processes that constitute the invention or improvement, as well as the required drawings and models.

In cases of importations of inventions patented abroad, applicants must at the same time prove the article to be really patented abroad, and the foreign patent not to have expired. Moreover, they must say whether they wish the description to be published in full, by extracts, or not at all. Whenever

specifications are published, no one, during the whole term of the patent, shall be entitled to imitate or manufacture the article described. If, on the contrary, descriptions are not published, and are only deposited at the Board of the Government Commission, all other parties making the same, or a similar invention, may at all times obtain a patent for working the same.

In case the Commission find the term for which the patent is demanded too long, they have power to shorten the same, and then the difference of the payment made shall immediately be returned to applicants.

Assignments of patents must be registered.

The Board of Home Affairs and Public Instruction may refuse to grant patents for inventions that might be injurious to society, that relate to the common wants of life, or for objects that have already been manufactured in the country.

Patents will be annulled (1.) if inventors have not delivered an exact description, and explained with clearness and precision the means of manufacturing the invention, discovery, or improvement; and if it is proved that it would be impossible to attain the object of the invention by following the published description and the information given by the inventor: (2.) if, during the term mentioned in the letters patent, inventors have not worked their invention, or if they cannot show good cause for such inaction: (3.) whenever it is proved that the invention does not properly belong to the patentee; and also whenever it is proved that the same invention, discovery, or improvement has been known and published before the patent was applied for.

A patent for the kingdom of Poland costs from £25 to £35, according to circumstances.

## PORTUGAL.

A royal decree, dated the 31st December, 1852, regulates the law of patents in Portugal. Its principal provisions are to the following effect:—

Authors of new inventions, whether national or foreign, are entitled to secure an exclusive right in them by patent; but the patent will be no guarantee of the reality, priority, or merit of the invention. An invention, though in use in foreign countries, is, if new, patentable in Portugal, but only for five years.

The duration of a patent privilege cannot exceed fifteen years; it is at the option of a patentee to obtain it for a less period. A specific time having been once demanded, no prolongation will be subsequently granted. To inventors who have already obtained a patent in a foreign country, no longer time will be granted than is sufficient to make up fifteen years from the date of the foreign patent. The importer of an invention (not being the inventor himself) can only obtain a patent for five years.

On applying for a patent, an inventor must deliver to the proper office an exact description under seal of the principles, means, and processes which constitute the invention, with the necessary plans, sections, drawings, and models.

A patent will not be allowed to comprise more than one subject-matter.

Patentees are required to expose to public observation their manufacture in full operation, at least twice a month, three days' previous notice having been given in the Government gazette.

An annual tax of 5,000 reis (about 28*s.*) is imposed on a patent, and default in payment of this tax renders the patent void.

Patent rights pass by assignment or by will.

A patent becomes void if the invention be not carried into

operation within half the term for which the patent is granted, or if the manufacture be adjudged a nuisance by a competent tribunal.

A patent for this kingdom costs from £25 to £40.

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## PRUSSIA.

The law of Prussia with respect to patents is regulated by royal ordinances, dated the 27th September, 1815, and 18th September, 1828. Reference must also be made to the overriding law of the Zollverein.

By the letter of the law only subjects of Prussia can obtain patents, but, in practice, foreigners are allowed to apply; and when it appears that the applicant would be entitled, if a subject, to the patent solicited, he may acquire the right of citizenship in the prescribed manner, or he may transfer his rights to a subject of Prussia, in whose name the patent can be taken out.

Patents are granted not only for original inventions and improvements made in Prussia, but also for imported inventions and improvements. In applying for the patent, an exact description of the invention, either in writing, or by models and designs, and if possible in all these ways, must be sent in. A patent will not be granted for less than six months, nor for a longer period than fifteen years; the usual terms, however, are for five, six, or eight years. It usually extends to the whole monarchy. The Government fees are of trifling amount.

The patent will be invalidated if the invention is not put into operation within six months of the grant. This article of the law is indulgently construed by the Government; but it is necessary to lay before it some proof that the invention was put into execution within the time limited, otherwise the patent is lost.

The patentee of a process of manufacture cannot prohibit the importation of any articles, whether made by the patented process or not. The patentee of a machine or mechanical contrivance may prohibit its use by other persons, whether it shall have been made within the country or abroad.

A patent cannot be obtained for the mere application of a contrivance or process of construction already known to purposes whereto it has not previously been applied, this not being deemed a new invention; nor can a patent be obtained for a contrivance or process known to have been already applied to similar purposes.

When an invention has been described in published works, either native or foreign, or when models of it have been publicly exhibited in Prussia, it ceases to be new, and cannot be patented. Even when the description was published and the model exhibited by the inventor himself, still he will be precluded from obtaining a patent subsequently.

Patents for imported inventions are only allowed when they have not become known in the country by means of published works or other means; if so known, it will be no ground for a patent that the applicant is the first importer and user of the invention in Prussia.

Patent rights may be transferred from one person to another.

The examination of the application for a patent belongs to the Board of Trade, and is limited to an inquiry into the novelty and originality of the invention without reference to its utility, except in the case where it professes to be an improvement on previous contrivances or processes. If the claim is allowed, the applicant will be informed in what the novelty and originality of the invention were conceived to consist, and whether it is patentable in respect of all its parts, or only in respect of some, or simply in respect of their combination, the parts separately not being new and original. The invention is then described in the official journals of Government.

If it should appear that the invention is destitute of novelty

and originality, the patent is vitiated, and this will be set forth in the grant itself.

The cost of a Prussian patent varies from £20 to £30. In consequence of the illiberal strictness with which the inventor's application is examined, the obtainment of a patent in this kingdom is attended with much difficulty, not one application in ten being successful.

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## THE ROMAN STATES.

A law of the Apostolic Chamber, dated 3rd September, 1833, contains the following regulations:—

Patents will be issued either to subjects of the Pope, or to foreigners, in respect of—1st, a newly-discovered natural production; 2nd, a new and important kind of agricultural cultivation; 3rd, a new and useful art not previously brought into practice; 4th, a new and useful improvement in the arts or agriculture—for a period varying from five to fifteen years, except as regards improvements and processes patented abroad. In such cases the Papal patent will expire with the original patent. With respect to novel processes and improvements already known by means of printed books, but not brought into use in the Papal States, the patent will be limited to a period of from three to six years.

The importance of the invention, the amount of capital required to carry it into effect, and the amount of gain likely to be derived from it, will be taken into account in determining the duration of the patent, and whether it ought to extend over the whole of the Papal States, or only over a part.

Proof of unexpected expenses and losses, and reasons of public utility, will afford ground for obtaining a prolongation of a patent, originally obtained for less than fifteen years or six years, not being in respect of an invention patented abroad.

The applicant for a patent must present a petition to the

proper authorities, getting forth the nature of the discovery, invention, process, or improvement, the probable utility to the State, and the possible injury to public health or private interests.

The petition must be accompanied in duplicate by a full description of the invention, sufficiently clear, complete, and exact to enable others to put it in practice, and by the needful plans, drawings, sections, models, or samples. This description will be kept secret until the determination of the patent.

A patentee can deal with his right as with any other species of property. He can transfer it to another; and he may share it with others as partners, or license others to use it.

No one will be allowed to contest the validity of the patent on the ground of want of priority or novelty in the invention after the expiration of six months from the date of the patent.

The patent will become of no effect in the following cases:—(1.) If the invention shall be injurious to the public health, safety, or interest; (2.) if it shall be decided by a competent tribunal that some other person had previously introduced or put in practice the patented invention; (3.) if the process or improvement had been made known through the public prints, such publication not having been declared in the applicant's petition; (4.) if, in describing the invention, the patentee had concealed or misstated the means of carrying it into effect; (5.) if the patentee fails to carry the invention into effect within a year from the date of the patent, or if he shall suspend the working of it for that space of time; (6.) if he shall not pay the tax within a month after the time fixed; (7.) if, on examination of samples, &c., it shall be discovered in any year that the manufacture or cultivation has deteriorated.

The tax on patents for original inventions is calculated at the rate of ten Roman scudi (i.e. ten crowns = about £2 2*s*. 8*d*.) per annum, and that on patents for imported inventions at the rate of fifteen Roman scudi per annum (about £3 4*s*.), on the whole time for which the patent is granted. The

sum is payable in two moieties—the first on the patentee receiving the patent, the second within a month after the expiration of the first half of the term for which the patent was granted.

The first cost of a Roman patent is from £20 to £30.

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## RUSSIA.

The law as to privileges for inventions in Russia was declared by an imperial decree of the 17th of June, 1812.

The privilege granted for inventions in arts and manufactures is founded upon a certificate (obtained on presenting a petition to Government, accompanied by a full description of the invention), which certificate states that the invention therein mentioned was presented in due time to the Government, as the property of the person named therein.

The Government does not guarantee that the invention belongs to the person who makes the application; it only certifies what are the peculiar properties of the invention.

The privilege granted by the Government does not prevent other persons from proving, in legal form, that the invention does not belong to the person who obtained the patent.

Until the ownership of the invention is contested, the person to whom the privilege was granted has a right—

1. To the absolute property in the invention for the specified time.
2. To use the invention himself, and to sell its results to the public, or to transfer the privilege to another person.
3. To prosecute persons infringing the privilege in the courts of law, and to recover an indemnity for the loss sustained by the infringement.
4. To treat as an infringement the making of articles

in a similar manner with small and unessential differences.

The person applying for a patent privilege must deliver to the Government an exact description of his invention, with all essential details, and the mode of carrying it into effect; and also the necessary plans and drawings, not keeping back anything requisite to be known.

Inventions made in foreign countries may be patented in Russia when no detailed description has been published, and when they have not been already introduced into the empire.

A patent for an imported invention has the same validity as one granted for an invention made in Russia, until it is shown that the invention had been brought into use before the grant, or that it had been described in published books or papers, in such a way that it could have been carried into effect without the patentee's description.

Patent privileges for original inventions are granted for three, five, or ten years (the extreme limit), at the option of the applicant; for imported inventions the longest period is six years. The Government charges amount, on patents for original inventions for three years, to 300 roubles (£15), for five years to 500 roubles (£25), and for ten years to 1,500 roubles (£75); whilst, in the case of imported inventions, the Government charges, in respect of a four years' patent, are 800 roubles; in respect of a five years' patent, 1,000 roubles; and in respect of a six years' patent, 1,200 roubles.

A patent will be void when it is shown to the proper tribunal that the invention has been already practised in Russia, or that, at the time of the presentation of a petition for a patent, it had been previously described in books or periodicals published in Russia or elsewhere, so that it might have been carried into effect without further description. It will also be void where it is impossible to arrive at the promised result by following the directions of the patentee.

In case of the absence of the inventor, the person applying

for the patent must be duly authorised by power of attorney, and this person will have to give a written engagement for payment of the money due to Government.

No prolongation of the term originally granted can be obtained. For improvements in a patented invention, a new patent must be applied for. A patent for an imported invention cannot endure beyond the expiration of the patent in the country from which the invention was brought. An invention for which a patent has been obtained must be carried into effect within one quarter of the space of time for which the patent was granted.

A patent for this empire costs from £90 to £105, including the Government tax.

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## SAXONY.

By a royal decree dated the 20th January, 1853, a few regulations were added to the law agreed upon by the Zollverein.

The Government reserves the right of naming the length of time for which a patent shall be granted; yet the applicant is expected to mention the period which he desires: a patent is usually granted for five years, which the Government may allow to be extended to ten years, if application is made at least four weeks before the expiration of the first term. The Government charges vary from five to fifty thalers (from 15*s.* to £7 10*s.*). In certain cases they may slightly exceed the last-mentioned sum. On a patent for five years they amount to £3 10*s.*, besides some small official fees and stamp duty.

The applicant's petition is addressed to the Minister of the Interior, and must be accompanied by a specification, and, if possible, by drawings and samples. Foreigners not being subjects of any other state of the Zollverein, are required to nominate a Saxon subject, in whose name the patent will be issued.

A patent for the kingdom of Saxony costs from £15 to £25.

## SPAIN.

A royal decree, signed the 27th March, 1826, established the following regulations :—

A patent can be obtained by any person whomsoever, who proposes to establish, or does establish, in Spain, a machine, apparatus, or a mechanical or chemical process, or operation, which is new, wholly or in part, or which has not hitherto been established in the same manner or form in the kingdom. The patent, however, will be no guarantee of the novelty or utility of the invention. Patents shall endure for five, ten, or fifteen years, at the option of applicants, in respect of original inventions, but for imported inventions they shall be limited to five years. A patent for five years, in respect of an original invention, may be afterwards prolonged for five more years; but patents originally obtained for ten or fifteen years cannot be prolonged.

To be entitled to a patent for an original invention, it is necessary that the invention shall not have been brought into use, either in Spain, or elsewhere out of the kingdom. When it has been practised abroad, but is new in Spain, a patent as for an imported invention only can be applied for.

The exclusive privilege granted by a patent for an imported invention applies only to a manufacture within the kingdom, and does not authorise the importation from abroad of things there manufactured.

The petition for a patent must not comprise more than one invention, and it must be accompanied by a plan or model, with a full description of the invention.

Before the patent is allowed to issue, the Government tax must have been paid. This tax varies according to the length of the privilege awarded, viz.:—Five years, 1,000 reals; ten years, 3,000 reals; fifteen years, 6,000 reals. On a patent for an imported invention, 3,000 reals are payable.

Patent rights are transferable, and may be bequeathed in the same manner as other personal property.

A patent becomes void in the following cases:—If the patentee does not carry his invention into effect within a year and a day after the date of the patent; if there should be a cessation for the same space of time in working the invention; if it should be proved that the invention had been in use within the kingdom previous to the date of the patent, or had been described in printed books, or in engravings, paintings, models, plans, or descriptions, to be found in the Royal Conservatory of Arts; if the invention was previously known abroad, and the patent has been taken out in respect of an original invention.

The cost of a patent for Spain, in addition to the Government tax mentioned above, is from £20 to £30.

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## SPANISH COLONY—CUBA.

Applications for letters patent may be made by the inventor, or by his agents, by means of petitions addressed to the Governor-General of Cuba.

Each application must not comprise more than one subject, and must be accompanied by a plan or model, with a description clearly explaining the nature of the invention, and the manner in which the same is to be carried out.

Models must be presented in a closed and sealed case, which the Governor shall deliver to the Royal Exchequer, there to be opened; previous to which delivery, applicants have to present a receipt for payment of the following fees:—For a patent for five years, 70 dollars; for ten years, 210 dollars; for fifteen years, 420 dollars; for importations, 210 dollars.

Patents are granted for five, ten, or fifteen years for objects of the grantee's own invention, but only for five years if for importations from other countries.

Patents of inventions granted for five years can be extended to ten years; those granted for ten or fifteen years cannot be extended.

Patents must be worked within the time stipulated, and kept working for one year and one day without interruption, or the patent becomes void.

The cost of a patent for Cuba is about £42.

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## SWEDEN AND NORWAY.

### (SWEDEN.)

By a royal ordinance, bearing date the 19th August, 1856, the following regulations concerning patents were made:—

Patents are granted—1st, For new inventions, whether they consist in machinery or in some art; 2nd, for improvements on old inventions. They are not granted for medicines, nor for bare principles.

Patents are not granted for a shorter term than three years, nor for a longer term than fifteen years, and the length of time will depend upon the value and importance of the invention. The inventor only can obtain a patent.

If any one has obtained a patent in a foreign country, he can obtain one in this kingdom; but the time must never extend beyond the duration of the patent in the foreign country.

A full description of the invention, accompanied when necessary by drawings and models, must be lodged along with the petition at the Chamber of Commerce.

The patentee is required to furnish, before the expiration of two years, to the Chamber of Commerce, proof that he is in full exercise of the patent—which period he can reduce to one year, or may, in consequence of a petition to that effect, extend to four years, this being regulated by the value and importance of the patent in question; and also to furnish annually, during the entire period in which the patent right remains in force, proofs that he continues to exercise the invention.

Patents may be assigned when certain formalities have been complied with.

If a patent has been granted for an invention of the same nature as one previously patented or exercised by some other person residing in the kingdom; or if the holder of a patent has given in an inexact description of the means employed for the working of such invention, so that the real nature of the invention cannot be properly understood; or if the holder has given himself out to be the inventor without being so; or if a patented invention contains anything injurious to the public safety or health, or anything having an immoral tendency, this patent will be declared void.

The cost of a patent in this country varies from £15 to £25.

(NORWAY.)

Patents for inventions are granted for a period not exceeding ten years, and on condition of the party concerned, before obtaining the patent, giving in a satisfactory account of when the invention was made and in what it consists. If the invention has been made simultaneously by more persons than one, and they all desire exclusive right, then they may expect to obtain a patent on conditions as above—in such a manner, however, that any one of them may renounce this exclusive right to the same effect as if renounced by all.

The receiver of a patent must, if he makes use of it in a market town, become a citizen and otherwise invest himself with the same rights and duties as masters in trades.

The description furnished by the inventor must be accompanied by drawings in duplicate where the nature of the invention requires them.

Patents become void unless the patentee puts his invention into practical use in this country within a period of two years.

A fee to the State treasury of ten specie dollars shall be paid for every patent.

The cost of a patent for Norway varies from £15 to £25.

## WURTEMBERG.

A royal ordinance, dated the 5th of August, 1836, modified by a decree of 29th June, 1842, regulates the law in Wurtemberg to this effect:—

The Government grants patents in respect of the invention of a new article, a new machine, or a new process of manufacture, as well as to the importer of a new invention from abroad, if such invention is protected by patent in the country from which it is imported. The applicant must give in a statement of his abode, or of the place where he desires to establish the trade or manufacture founded on his invention; and he must set forth a full description of his invention, accompanied by the drawings, models, or patterns requisite to the intelligibility of the same, especially describing the particulars wherein the invention differs from others already in use.

The application will be refused—(1.) If the invention be in any way discountenanced by the law; (2.) if a patent has already been granted for a similar invention; (3.) if the invention has already been brought into use in the country. The Government will not grant a patent for a longer term than ten years. A longer term can only he obtained by means of a special Act of the Legislature. When a patent has been obtained, in the first instance, for a shorter term than two years, it may be prolonged to the full term, provided the patentee makes application before the commencement of the last year of the original term, or, in the case of a patent for an imported invention, before the termination of the first half of the original term.

The description of the invention delivered along with the petition, can only be seen by a resident citizen of Wurtemberg, and only when he can show an interest sufficient to entitle him to the inspection, and on his giving security for the non-infringement of the patent during its existence. An inspection will only be permitted after the time allowed for applying for

a prolongation has elapsed. All applications for an inspection are advertised before they are granted, in order to give the patentee an opportunity of opposing them.

An annual tax is imposed on patents, varying from five to twenty florins (8*s.* 4*d.* to £1 13*s.* 4*d.*), the first instalment being paid on the delivery of the patent, and the others at the commencement of each year of the term.

Patents can be transferred by the patentee to others, or he can allow others to participate in the working and profits. In case of the patentee's death before the expiration of the term, his rights pass to his legal representatives.

A patent will not be granted, or, if granted, will be considered invalid, if, before the deposit of the description, another person has already applied for a patent for the same invention; or if the invention has been in public use, either in Wurtemberg or abroad, unprotected by patent, or has been described in some printed publication; or if the description contains any material concealment, or misrepresentation; or if another citizen proves that the invention was originally made by him, and has been improperly appropriated by the patentee or applicant. When the invention has been already made, but kept secret by another person, the patent will be good except as against that person.

A patent will become void if the invention has not been carried into effect in the country within two years of the grant, or if a suspension in carrying it into effect has taken place; unless, in either case, sufficient reason can be adduced for not proceeding under the patent. It will also be void when the exercise of the patented trade is removed to a foreign country, or there is anything contrary to law in the manufacture. A patent for an imported invention will become void, also, if the patent, or one of the patents, protecting the invention abroad, has become invalid at the time of the grant in Wurtemberg.

The cost of a patent for this kingdom varies from £20 to £30.

## THE GERMAN ZOLLVEREIN.

The German Confederation is composed of thirty-eight States, and of these twenty-five have formed a trade league, known as the Zollverein. The States of this League are the following:—

Kingdoms of Prussia, Bavaria, Saxony, Hanover, and Wurtemberg.

Grand Duchies of Baden, Hesse, and Saxe-Weimar-Eisenach.

Electorate of Hesse.

Duchies of Saxe-Coburg-Gotha, Saxe-Meiningen-Hildburghausen, Saxe-Altenburg, Nassau, Anhalt-Dessau, Anhalt-Bernburg, Anhalt-Coethen.

Principalities of Schwarzburg-Rudolstadt, Schwarzburg-Sondershausen, Hohenzollern-Hechingen, Hohenzollern-Sigmaringen, Waldech, and the two branches of the House of Reuss.

Landgraviate of Hesse-Homburg.

City of Frankfort-on-the-Maine.

These States have agreed upon a general system of law with regard to letters patent, and this was embodied in a Convention, dated 21st September, 1842, which was ratified the 29th June, 1843. The terms of this Convention override the particular laws of the States; but it is expressly reserved to each State to regulate the issuing of letters patent as it thinks fit, whether for original or for imported inventions, upon all points as to which the Convention is silent.

Article 1.—Patents shall only issue in respect of such inventions as are new and original. Inventions already in use, or known in any manner whatever, within the limits of the League, are not patentable; and especially those which have been so described in words, or by figures, in books published in Germany or abroad, that competent persons may carry them into effect.

Each State must decide for itself as to the novelty and originality of inventions sought to be patented.

A patent having been granted to a subject of any State of the League, no patent for the same invention can be taken out in any other State, except by the original inventor, or the person lawfully succeeding to his rights.

Art. 2.—Subject to the preceding regulations, patents may issue for improvements in inventions already patented or known, provided that the improvement is real and original; but no prejudice shall thereby be occasioned to the patentee, and the patentee of the improvement shall have no claim to share in the profits of the original patentee.

Art. 3.—A patent confers no right upon the patentee to forbid the importation of articles similar to those patented, or the sale of such imported articles. Neither shall the patentee have any right to forbid the use of imported articles, except only when they are machines or manufacturing or industrial instruments, and not general articles of trade used by the public.

Art. 4.—Every Government in the League has authority to grant, by patent, within the limits of its jurisdiction, the exclusive right of making and executing any particular article; and also the exclusive right of applying both a new process of manufacture, and new machines or instruments of manufacture, so that the patentee, as long as he possesses the patent, may prevent anyone else from using the patented article or process, except when it has been obtained from him.

Art. 5.—Each State of the Zollverein will treat the subjects of the other States as its own subjects, both as regards the granting of patents, and the protection of the rights thereby obtained; but the grant of a patent in one State shall not ground any right to a patent in any other State.

Whether an invention is or is not patentable in any one State, is a question to be determined solely by that State, which is not to be bound in this respect by the decisions of other States.

A patent granted by any given State, confers no right beyond the limits of that State.

Art. 6.—If, after the grant of a patent, it is made to appear

that the invention is destitute of novelty and originality, the patent shall be forthwith annulled. When the invention was previously known only to a few persons who kept it to themselves, the patent shall be valid as regards all other persons, if there are no other causes affecting its validity.

Art. 7.—Every grant of a patent shall be forthwith made known in the official journals, with a statement of its object, the name and residence of the patentee, and the duration of the patent. And in the same way the prolongation of a patent, or its determination before the expiration of the term originally granted, shall be published.

Art. 8.—At the end of every year, the several Governments of the States shall send to each other correct abstracts of patents granted in that year.

# PATENT LAWS OF THE BRITISH COLONIES.

PATENTS for the British Colonies are not frequently asked for, it being obvious that, unless in exceptional cases, it is more likely that inventions will be worked in the mother-country and the results exported, than that the necessary manufactories will be established in the separate colonies. There are exceptions to this rule; and as the colonies progress, and become more populous and more rich, the exceptions become more frequent. Canada at present has the bad preëminence of being the only colony of importance which does not follow the good example of the United Kingdom in granting patents to all alike, whether residents or aliens. The rules in some of the colonies are even in advance of those at home; in the East Indies, for instance, many regulations are adopted which might well be grafted on the imperial system.

It is not proposed to go into the details of the regulations of all the colonies, but to give those only of primary importance.

## BRITISH GUIANA.

The law relating to patents is governed by an ordinance dated July 12, 1861.

Every inventor desirous of obtaining a patent must petition the Governor for the grant. The form of the documents is very similar to those in use in Great Britain, and the proceedings under the petition are also very similar, there being

a reference to the Attorney-General, whose duties in respect to patents nearly resemble those of the same officer at home.

The conditions of the patents granted are nearly, if not precisely, similar to those of the British grants, and there is a duty of 100 dollars payable in the seventh year of the term.

The ordinance also contains provisions as to disclaimers similar to those in operation at home.

The cost of a patent for this colony is about £31 10s.

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## CANADA.

Three Acts of the Colonial Legislature, viz. 12 Vict. c. 24, 14 and 15 Vict. c. 79, and 22 Vict. c. 34, govern the law of patents in Canada.

Any person a subject of Her Majesty, and *resident in the province*, having discovered or invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement (the same not being known or used in the province by others before his discovery or invention thereof, and not at the time of the application in public use or on sale in the province, with his consent or allowance, as the inventor or discoverer thereof), and desiring to obtain an exclusive property therein, may make application by petition to the Governor of the province expressing such desire; and the Governor is bound to grant such patent, which shall be good and available to the grantee, his heirs, lawful representatives, or assigns, for the period of fourteen years. The applicant must make a solemn declaration that he believes himself to be the true inventor, and must deliver a clear and complete description of his invention, with drawings, &c.

The above provision extends to any subject of Her Majesty, *being an inhabitant of the province*, who shall in his travels in any foreign country have obtained a knowledge of, and be desirous of introducing into the province, any invention not

known or in use there. This clause, however, is not to extend to inventions discovered or used in the United States of America, or in any part of the Queen's dominions in Europe or America.

An original and true inventor is not deprived of the right to a patent for his invention by reason of his having previously taken out letters patent therefor in a foreign country, and of the same having been published at any time within six months next preceding the filing of his specification and drawing.

Patents are assignable in law either as to the whole interest or any part thereof. Assignments and licences shall be recorded in the proper office.

Patents may be issued to the assignee of the inventor, the assignment thereof being first recorded, and the application therefor being made, and specifications declared by the said inventor. The applicant for a patent must furnish duplicate drawings, whenever the case admits of drawings—one to be deposited in the proper office, and the other to be annexed to the patent.

If a patent should be invalid by reason of a defective or insufficient description or specification, if the error have or shall have arisen from inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, the patentee may surrender such patent and obtain a new patent. Patentees may disclaim any part of the invention.

The term of a patent may be extended to the term of twenty-one years, upon taking certain proceedings six months before the expiration of the original term.

Persons who have purchased, discovered, &c., machines, &c., prior to the application for a patent by another person claiming to be the inventor, are entitled to use such machines, &c., without liability to the patentee, and the patent will not be invalidated except in certain cases.

Any subject, inhabitant of this province, who may have invented or produced any new or original design, for a manufacture, whether of any metal or mixed metals, or other

material or materials, or any new and original design for the printing of woollen, silk, cotton, or other fabrics, or any new or original design for a bust, statue, or *bas-relief*, or composition in *alto* or *basso-relievo*, or any new or original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture, may obtain a patent for such design, &c., for seven years.

Patentees must stamp or engrave on each article vended or offered for sale the date of the patent thereof. Neglect of this provision renders a patentee liable to a penalty.

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## CAPE OF GOOD HOPE.

This Colonial Legislature has adopted a system very similar to that of the mother-country, governed by an Act passed in 1860.

The applicant for a patent must deposit at the office of the Colonial Secretary a specification of his invention, which is referred to the Attorney-General, who reports upon it, and the Attorney-General issues a warrant for the grant.

A writ of *scire facias* may be sued out for the repeal of the patent.

The letters patent are void unless a stamp duty of £10 is paid at the expiration of the third year, and of £20 at the expiration of the seventh year of the grant.

Letters patent for foreign inventions expire with the foreign grant.

The regulations as to disclaimers, prolongations, and confirmations, are similar to those of the home patents.

A register of patents and of proprietors is kept.

There is a penalty of £100 for the unauthorised use of the word "Patent."

Particulars of breaches and of objections are to be given in patent actions.

The cost of a patent for the Cape of Good Hope is about £25.

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## CEYLON.

The inventor of any new manufacture may petition the Governor for leave to file a specification thereof; such petition must be in writing, and signed by the petitioner or his agent, and shall state the name, condition, and place of residence of the petitioner, and the nature of the invention, upon which the Governor may order the petitioner to file a specification.

The specification must be filed within six months from the date of the order, upon which the Governor may grant to the inventor the sole and exclusive privilege of making, selling, and using the said invention in Ceylon for the term of fourteen years from the time of filing such specification; and for a further term not exceeding fourteen years, upon petition to be presented by such inventor, not more than one year and not less than six months before the expiration of the exclusive privilege thereby granted.

The specification must be in writing, and signed by the petitioner, and shall particularly describe and define the nature of the invention, and the manner in which the same is to be carried out.

No specification can be filed until the petitioner has paid all fees. The fee on filing a specification is £10.

The cost of a patent for Ceylon is about £25.

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## INDIA.

The Act relating to patents for inventions is dated 17th May, 1859.

Exclusive privileges may be obtained for protecting the

invention or improvement of any art, or process, or manner of producing, preparing, or making an article, and also the invention or improvement of any article prepared or produced by manufacture. It is required that the invention be useful, and that it be new; and an invention is to be considered new if it have not, at the time the exclusive privilege is applied for, been publicly used in India or in any part of the United Kingdom, or been made publicly known in any part of India or of the United Kingdom by means of any written or printed publication. If, however, the knowledge of an invention has been obtained surreptitiously, or has been communicated to the public in breach of confidence, the public use or knowledge is in that case to be no bar to the acquisition of the exclusive privilege, if the inventor have not acquiesced in it, and if he make his application within six months after the public use has commenced; nor is the use of an invention by an inventor, or his agent, or any person with his license, for a period not exceeding one year before the exclusive privilege is applied for, to be deemed a public use within the meaning of the Act. The provisions of the Act are available, not merely for actual inventors, but also for the personal representatives and the assignees of actual inventors; and they extend also to foreigners, whether resident abroad or not. The importer of a new invention into India is, however, expressly excluded from the benefits of the Act, unless he be also the actual inventor, or his personal representative or assignee.

The exclusive privilege is acquired by merely filing a specification of the invention, upon which, without any further process, the applicant becomes at once entitled to the exclusive right of using and selling the invention in India, and authorising others to do so, for the term of fourteen years from the date of filing the specification. Leave to file the specification must, however, be previously obtained; and for this purpose, a petition must be presented to the Governor-General in Council, who is empowered to refer it to any person or persons for inquiry, and, in the event of an order authorising the

specification to be filed being granted, to annex any conditions he deems proper to the order. The fees attending the inquiry are paid by the petitioner, and no specification is to be filed until all the fees have been paid. Every specification mus be filed within six months after obtaining the Governor-General's order.

The specification must be in writing, signed by the petitioner, and must particularly describe the invention, and how it is to be performed. The petition and specification are each accompanied by a declaration, signed by the petitioner, or by his agent, if he be absent from India, stating that he is in possession of the invention, which he believes will be of public utility, and that to the best of his belief it is not known or used in India, or in any part of the United Kingdom, and that it is truly described in the petition and specification. Persons making false statements in these declarations are to be considered guilty of perjury; and wilful misstatements in the petition or specification will render the exclusive privilege liable to be declared void. The specifications filed under this Act are registered in a book, kept in the office of the Secretary to the Government, and is to be open to the public on payment of a small fee.

Any part of an invention may be disclaimed, should it appear at a future time to the petitioner that he ought not to have included it in his petition or specification; and in case of any defect or insufficiency in the latter, leave may be obtained to file an amended specification, which, however, is not to extend the exclusive privilege before acquired. In both these cases, moreover, it must be shown that no fraud has been intended. The term of an exclusive privilege may be extended for a term not exceeding fourteen years from the expiration of the first fourteen years, upon taking certain proceedings not more than one year, nor less than six months, from the expiration of the original term. All rights which had been acquired under the repealed Act, previously to its repeal, are preserved.

Every exclusive privilege granted is to cease, if the Go-

vernor-General in Council shall declare the same, or the mode in which it is exercised, to be mischievous to the State, or prejudicial to the public. Further, if satisfactory proof be afforded to the courts of law that any condition, upon which leave to file a specification was granted, has been broken, power is given to the Governor-General in Council to declare that the exclusive privilege thereby obtained shall cease.

Any inventor who has obtained letters patent for the exclusive use of an invention in the United Kingdom may, by taking proper proceedings within six months from the date of filing his complete specification in England, obtain protection in India for his invention, which is to be deemed new there, if it was not publicly used or known in India before the date of the petition for letters patent; but no such exclusive privilege is to extend beyond the term of the letters patent, unless they are renewed, in which case the exclusive privilege may also be extended for a like term.

If any person, not being the actual inventor, or the representative or assignee of an actual inventor, has fraudulently obtained any exclusive privilege for protecting an invention, he may be compelled, upon proof of the fraud, to assign the exclusive privilege to the actual inventor, or his representative or assignee, and to account to him for the profits.

The Act contains provisions allowing any persons to apply to the courts of law for a declaration that any alleged exclusive privilege has not been acquired, in consequence of non-compliance with the requirements of the Act; and there are also regulations respecting the conduct of proceedings to restrain infringements, &c., but as these relate mainly to the practice of the Indian Courts, it is unnecessary further to refer to them here.

The cost of a patent for India is about £31 10*s*.

## JAMAICA.

The law of patents in this island is governed by an Act passed in the year 1857.

Every inventor desirous of obtaining a patent must petition the Governor; the petition, accompanied by a declaration as to the invention, and a specification fully describing the same, is then referred to the Attorney-General, who gives a certificate of his allowance, upon which the Governor issues letters patent.

The patent must be brought into operation within two years from its date.

The patentee is at liberty to assign all or any part of his rights, and patents may be issued to assignees of any persons who have obtained patents in other countries.

The Act also makes provision as to disclaimers, and provides that a patentee may add a specification or description of any improvement upon the original invention, and have the same annexed to the original specification.

The Act also contains provisions as to pleadings and costs in actions, as to the writ of *scire facias*, and as to the appointment of commissioners.

The letters patent bear a stamp duty of £5.

The cost of a patent for Jamaica is from £25 to £30.

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## NEWFOUNDLAND.

The law of patents for this colony is now based upon an Act passed 12th May, 1856.

Inventors desirous of obtaining patents in Newfoundland, must present a petition to the Governor for the grant, and must deliver into the office of the Colonial Secretary a specification of the invention, and in case of a machine, a model also. The patent is granted upon this petition, after a reference to the Attorney-General.

A patentee is at liberty to assign his patent.

Infringers are liable to pay damages to the patentee, amounting to three times the actual damage sustained.

No inventor is debarred from obtaining a patent in Newfoundland because he has already obtained a patent elsewhere, provided the invention has not been introduced into common use in the colony.

Letters patent may be issued to assignees of inventors who have obtained patents abroad, but not to assignees of persons abroad who have not obtained such foreign patents.

Letters patent are invalid, if the inventions protected are not introduced into operation within two years from grant.

The Act also contains clauses as to disclaimers, memoranda of alterations and additions or improvements, very similar to those of Jamaica.

The applicant for a patent has to pay £5 to the Colonial Secretary.

The cost of a patent for Newfoundland is about £25.

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## NEW SOUTH WALES.

The Act of the Colonial Legislature relating to patents is dated 14th September, 1852.

Every person who, upon claiming to be the author or designer, by his agent or assignee, of any invention, shall be desirous of obtaining a letter of registration, shall deposit with the Colonial Treasurer the sum of £20 sterling, and shall, after such deposit, present a petition to his Excellency the Governor, setting forth that he is the author or designer of such invention, and specifying the particulars of such invention, and that he has deposited with the Colonial Treasurer the sum of £20; whereupon the Governor may grant the letters of registration, and such letters of registration, within three days after the granting thereof, are to be registered in the proper office in the Supreme Court. Every grantee of such letter of

registration can assign the same to any person or persons by an instrument in writing under his hand and seal, to be registered in the Supreme Court in the same manner and within the same period after the execution thereof as the original letters of registration.

The letters of registration may be repealed by *scire facias*.

The cost of the letters of registration is about £42.

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## NEW ZEALAND.

The Act relating to patents in this colony was passed 27th October, 1860.

Any person being the originator or discoverer of any new invention for which no patent has been granted in New Zealand or any other country, and being desirous of obtaining letters patent, shall deposit with the Colonial Treasurer the sum of £10; and shall leave at the office a petition addressed to the Governor, stating clearly the object to be attained by his invention, and praying that letters patent may be granted to him for the exclusive use thereof in the colony.

The inventor shall deliver a written specification, accompanied with drawings in duplicate, of his invention, fully setting forth the nature of the same and the manner in which the same may be carried out. One set of drawings shall be deposited in the office of the Colonial Secretary, and the other shall be annexed to the patent and considered a part of the specification thereof.

The Governor is to refer the consideration of the petition to any competent person, and on his report the letters patent are granted for fourteen years.

The Act contains numerous other provisions as to actions at law, *scire facias*, disclaimers, &c., in most respects similar to the regulations in force in the mother-country.

A patent for New Zealand costs about £42.

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## QUEENSLAND.

No patent laws have been enacted in the colony of Queensland since its separation from New South Wales, but the Colonial Act (New South Wales), 16 Victoria, No. xxiv., 14th September, 1852, was continued in force in the colony by an Order in Council of the 6th November, 1859, and a patent can be obtained similar in terms to those granted in New South Wales, at a cost of about £42.

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## TASMANIA.

The law of patents in this colony was established by an Act passed 5th November, 1858.

The proceedings to obtain patents are very similar to those at home, and the provisions with respect to actions, disclaimers, &c., are also much the same.

The Government fees are about £7 10s. on application, and a stamp duty of £15 is to be paid at the expiration of the third year, and £10 at the expiration of the seventh year of the grant.

The expense of a patent for this colony is about £31 10s.

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## TRINIDAD.

No special law on the subject of patents has been passed in this colony, but patent rights are secured to inventors by separate ordinances of the Colonial Legislature.

The applicant must present a petition to the Legislative Council, giving the name and purport of his invention, and on this an ordinance is passed, granting to him the exclusive benefit of his invention for a limited time, on condition that he lodge a specification before a certain day with the Registrar-General of the island; and on condition, also, that if the in-

vention be not new, or be found to be prejudicial or inconvenient to Her Majesty's subjects, that the privileges granted to him shall cease.

No fees are exacted on the petition, but, by a recent order of the Legislative Council, a fee of 50 dollars must be paid on the introduction of the Bill. The total charges attending the passing of an ordinance for granting patent rights are now as follows:—

| | |
|---|---|
| Fee on presentation of Bill . . | $50 |
| Government printer's charge . . | 10 |
| | $60=£12 10s. |

The entire expense of a patent is from £40 to £50.

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## VICTORIA (AUSTRALIA).

An Act of the Colonial Legislature, entitled 'An Act concerning Letters Patent for Inventions,' was passed in March, 1857, being Act No. 3 of the session held in the twentieth year of Queen Victoria. The previous Patent Act of the 17th Vict., No. 15, was first repealed, and then power was given to the Governor of the colony to issue letters patent, the langunge of the Act being nearly the same as that of the British statute of James I.

All applications for letters patent for an invention are to be made as follows:—The applicant must deposit a specification, accompanied by drawings when necessary, at the office of the Chief Secretary. Provisional protection for six months is thereby obtained. The form of the specification, and the size of parchment, are set forth in the Act. The subsequent proceedings are pretty much the same as those had in obtaining British patents.

The patent will become void unless the sum of £15 is paid

before the expiration of the third year, and the sum of £20 before the expiration of the seventh year.

The colonial patent will expire at the same time as the foreign patent, in case any foreign patent should have been previously obtained.

A patentee or his assignee is authorised to file disclaimers or memoranda of alterations.

Patents may be prolonged by taking the proceedings prescribed in the Act; but the patentee or his assignee must make application for this purpose at least six months before the expiration of the original term.

The schedules of the Act contain forms of petitions, notices, letters patent, &c. The first cost of a patent for this colony varies from £25 to £40.

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