AN

ANALYSIS

OF THE

LAW OF PATENTS.

HARVARD
LAW SCHOOL

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PREFACE.

THE object of the author has been, to present as complete a view of the Law of Patents for inventions, whether settled or undetermined, in as small a compass as might be compatible with perspicuity and accuracy. In prosecuting it, he has been led into two peculiarities, which he freely confesses, and begs permission to vindicate.

The neglect of verbal quotation in his citations of cases will doubtless be noticed. This was partly matter of necessity, as the preservation of the language of his authorities would often have obliged him to give detailed narratives and observations, instead of con-

densed results; partly matter of choice, as the practice imposed on him the necessity of definitely understanding the propositions which he undertook to render into equivalent language, and, in short, obliged him to think instead of copy*ing*.

With regard to the abundance of positions laid down without authority, which cannot but be noticed as another characteristic of the work, the author can only say, that he has been anxious to fortify himself with adjudged cases, as far as they go; but law, as a science, is not confined to those specific points which statutes have enacted or courts decided; all legitimate corollaries are also law; all propositions which are supported by acknowledged general principles or appropriate analogies. Desirous to meet, and even to seek, rather than to shun difficulties, the author has

ventured into tracts where there were few, if any, land-marks to guide him [see Part II. ch. 4, 5, 6, 7, 8, Part III. ch. 1, 2, 3, &c. &c.]; and, to prevent misapprehension, he begs to declare that, generally speaking, he has found no direct authority wherever he has quoted none. In these cases it is hoped the reader will exercise the same liberty which the author has taken, —the liberty of examining and judging for himself. This explanation is perhaps necessary, as without it the tone in which some of the undecided positions are laid down may seem too positive. The author can declare, that he has advanced no position but what he conscientiously believes the courts will sanction, or ought to sanction, whenever the occasion arises; and he has anxiously endeavoured to express, by his manner of laying down each po-

sition, the degree of confidence or doubt which he really entertained.

The freedom of animadversion which he has sometimes used, appeared to him to be imperatively required by his obligation to express the sentiments which he felt, candidly and honestly.

The practice of obtaining patents [Part I.] is designedly a mere sketch. It would have been superfluous to enter into ordinary details and directions, for which Mr. Hands's useful work is quite sufficient.

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INTRODUCTION.

MONOPOLIES, though more injurious to the public than lucrative to the crown, were profusely granted and oppressively enforced during the tyrannical reign of Elizabeth. It is related, that on a long list of them being read in the House of Commons, a member sarcastically asked, whether bread was not among the number? At the commencement of the succeeding reign the existing grants were recalled; and the legislature, some years afterwards, provided against the revival of such public grievances. A statute(*a*) was passed, pro-

(*a*) 21 Jac. 1. c. 3. s. 1 & 6.

hibiting monopolies in general for the future, except for the sole working and making of any new manufacture, by the first and true inventor, for fourteen years or less;—with the restriction that it should not be contrary to law, or mischievous to the state, by raising prices of commodities at home, or to the hurt of trade, or generally inconvenient.

On this statute is founded the modern law of patents. Modern it may be justly called, for it could not be considered a system before the case of *Hornblower* v. *Boulton*, in 1799.

The points for consideration may be resolved into—

1. The practice as to the application, grant, and specification.

2. The conditions of validity.

3. The incidents of a valid or invalid patent, and the consequent remedies.

PART I.

PRACTICE

AS TO

APPLICATION, GRANT, & SPECIFICATION.

CHAP. I.—APPLICATION.

SECT. 1.—CAVEAT.

THE first step usually is to enter a caveat against the grant of a patent for the invention to any other person. The effect of this is merely to insure to the applicant notice of any counter-application, when he must prosecute his opposition before the attorney or solicitor-general, or it will be disregarded. This caveat lasts for a year only, unless renewed. It is not imperative to enter one, but advisable, though the applicant

should intend to obtain the grant immediately, for it provides against contemporary applications.

S. 2.—Petition and Affidavit.

When the applicant is prepared to take the grant, which he cannot be until his invention is sufficiently mature to determine the propriety of the title (*b*) at least, he petitions the crown, verifying his statements by an accompanying affidavit.

The common form of the petition and affidavit is, that the petitioner has, after great labour, trouble, and expense, invented, &c. [describing the invention by its proper title] which invention he believes will be of great public utility and benefit; and that the petitioner

(*b*) See part 2. ch. 2.

believes that he is the true and original inventor, and that the invention has never before been used.

The statement of great trouble and expense seems superfluous. The prospect of public benefit (*c*) is proper to be stated, and probably indispensable. The statement of original invention is, in ordinary cases, necessary; but is varied when the party claims in respect of an invention communicated to him by a foreigner. Patents for such inventions, as "to A. B. who, in consequence of a communication made to him by a certain person residing abroad, is in possession of an invention for," &c., are now frequent; though it seems (*d*) the patentees might legally and properly claim as original inventors.

(*c*) See part 2. ch. 1. s. 4.

(*d*) See part 2. ch. 1. s. 3.

SECT. 3.—REFERENCE TO ATTORNEY-GENERAL.

The petition is referred to the attorney or solicitor-general, who is attended by the applicant and all competitors separately. They explain their projects to him, and he decides on the propriety of granting or withholding the patent in question; and where two proposed inventions coincide, rejects both applications (*e*). This important discretion is not subject to any appeal (*f*), or to any responsibility, except the common reme-

(*e*) See page 115, note (*b*).

(*f*) On the part of rejected applicants; opposers having an opportunity of applying to the chancellor to prevent affixing the seal, as in *ex parte Fox*, 1 V. & B. 67. But it is generally preferable to let the patent pass, and treat it as void for want of novelty.

dies against public officers by impeachment, indictment, and action,—neither of which could succeed, unless a corrupt motive were shown. The power of the attorney-general only amounts to a veto, for his sanction confers no security. The objections to a patent are founded on conditions (*g*) expressed in the statute, or expressed or implied in the grant; and in any of these cases the attorney-general can have no dispensing power.

Sect. 4.—Power of Arbitrary Refusal.

The approbation of the attorney-general having been obtained, the grant is made out and sealed. It should be noticed, however, that though all these

(*g*) See part 2. passim.

proceedings are practically matters of course, a patent is legally considered as an act of voluntary favour on the part of the crown; and that, therefore, if one should be capriciously refused, the subject could have no remedy. A case of perfect caprice is evidently imaginary; but the crown might possibly refuse a patent for an invention of extraordinary importance, the use of which should be deemed necessary for naval, military, or other public purposes.

CHAP. II.—GRANT.

SECT. 1.—PURPORT.

A PATENT recites the petition (in which the invention is mentioned by a descriptive title, as before noticed), and grants to the applicant, his executors, &c., by themselves, or such persons as they shall agree with, the exclusive privilege of using, exercising, and vending the said invention, in England, Wales, and Berwick-upon-Tweed, for fourteen years; prohibits other persons from directly or indirectly interfering with such privilege; and contains several conditions for avoiding the patent.—Some (*a*), as want of novelty or invention, illegality, and public inconvenience, are

(*a*) See part 2. ch. 1. s. 2 & 3. and ch. 4.

superfluous, as existing independently by law, and that more completely than under the grant, which would only make them causes of nullity when certified to the crown by six privy-counsellors. The others (which avoid the patent at once) are:—if the patentee shall not enrol a specification, truly describing his invention (*b*), in a given time (generally six months, but frequently a shorter term); if he shall open subscriptions or act as a corporate body, for the purpose of using the privilege; or if, at any time, the patent shall become vested in or in trust for more than five persons. It declares that it shall be construed most favourably for the grantee.

(*b*) See part 2. ch. 6.

Sect. 2.—Scotland, &c.

Similar patents may be obtained for Scotland and Ireland. The expediency of obtaining them necessarily varies with each case. The colonies may be included in the English patent, if desired.

Sect. 3.—Duplicity.

More inventions than one may legally be comprised in one patent (*c*), as improvements in cables and anchors; but to include many unconnected (*d*) ones would be most imprudent, as multiplying the chances of nullity. It is not likely, however, that such a patent would be permitted to pass the offices, while fees and stamp duties exist.

(c) *Brunton* v. *Hawks*, 4 B. & A. 541.

(d) See part 2. ch. 8.

Sect. 4.—Duration, &c.

Under the terms of the statute, the duration of a patent must not exceed fourteen years, from the date of the grant; and one for a longer or a postponed term would be void ab initio, as not coming within the protecting clause. So, probably, would a postdated patent, as an evasion. Indeed, there is authority (*e*) for avoiding patents in all cases of false dates.

In some cases, private acts have been obtained to extend the term, but some special ground for the application must be made out, as extraordinary expenditure, ingenuity, or utility, and inadequate remuneration. In such an act there is a proviso, that it shall not add any validity to the patent, but that all objections shall retain their full force.

(*e*) Vin. Ab. XVII. p. 79.

CHAP. III.—SPECIFICATION.

SECT. 1.—FORM.

THE specification is, by the patent, required to be under the patentee's hand and seal, but (like a memorial) it need not be delivered. There is no settled form, but it usually commences as a deed poll, recites very shortly the grant of the patent, with the condition of specifying, and proceeds,—"Now know ye that I, the said A. B., in pursuance, &c., do hereby ascertain and declare, that the nature of my said invention and the manner of performing it consist of the particulars following, viz.—First, I construct, &c."—or to some such effect. It is usual, but unnecessary, to state that the patentee believes the description fully sufficient for

the direction of any common workman acquainted with the general subject to which the patent relates.

The description should be sufficiently general, for the introduction of any unnecessary particular (as prescribing copper where iron or other metals would answer the purpose) limits the privilege, at all events, to the invention so circumscribed, and sometimes endangers its validity (*a*), by representing that as essential which is not so. The opposite fault of vagueness, and the other defects incident to a specification, will be considered hereafter.

The execution of the specification is usually attested by two witnesses, but one is sufficient. It is then acknowledged before a master ordinary or extraordinary in Chancery, preparatory to its enrolment.

(*a*) See part 2. ch. 3.

SECT. 2.—NECESSITY.

The chancellor cannot dispense with the enrolment, or enlarge the limited time. He disclaimed any power to do either on one occasion (*b*), though the application was made on the ground that it was peculiarly expedient to conceal the invention from foreigners, who would be put in possession of it by the enrolment; and he said that the object could not be attained without an act of Parliament. But as the crown, and not the statute, imposes the condition, it seems, on principle, that the crown might grant a dispensing patent before the condition is broken, or a confirming one after.

(*b*) Ex parte *Koops*, 6 Ves. 599.

PART II.

CONDITIONS

OF

VALIDITY.

CHAP. I.—SUBJECT.

SECT. 1.—MANUFACTURE.

A. THE subject of a patent must be (under the statute) a manufacture, new, and invented by grantee, and (on general principles) useful.

The word manufacture signifies either a thing manufactured (i. e. made by hand), or a manufacturing process. One or the other, therefore, must be considered the essence of the invention, to which all questions respecting ori-

ginality, utility, description, infringement, &c., must be referred.

B. Machines, being things manufactured, come properly under the former division; but, when agents in a manufacturing process, they are sometimes classed under the latter also: this view will be considered hereafter (*a*).

Under the former division, all new combinations of old materials are fit subjects for patents (*b*).

So a new machine of which the parts were separately old (*c*).

So an improvement in chain cables, by making the link in one plain and introducing a central stay (*d*).

(*a*) Infra, F.

(*b*) *Huddart* v. *Grimshaw*, Davies's Patent Cases, 267, 278, 279.

(*c*) *Brunton* v. *Hawks*, 4 B. & A. 550. (per Cur.)

(*d*) Ibid. (semble).

So improvements to an old machine (*e*).

So (it is conceived) any new compound metal, medicine, cement, &c., however simple the process of producing it.

C. Under the latter division, any new method of producing an old compound or substance (*f*) will support a patent: as the production of sulphuric acid by combùstion of pyrites, with certain management (*g*).

So, probably, an improved mode of printing, as such, for a printed book is a manufactured article, whatever the MS. was.

(*e*) *Harmar* v. *Playne*, 11 E. 101.

(*f*) Per Eyre, C. J. *Boulton* v. *Bull*, 2 H. B. 494.

(*g*) *Hills* v. *Thompson*, C. P. Sittings after Hil. 1823.

So, probably, any processes incident or subservient to certain manufactures, though the processes be not, *per se*, manufactures in the strictest sense, as scouring, dying, bleaching, polishing, &c.

A bleaching patent was avoided for want of novelty, after conflicting evidence (*h*); 'but an objection under the present head would have been preliminary, and independent of evidence; yet it does not appear to have been raised.

So in another action (*i*) founded on a bleaching patent, no objection to the nature of the subject was taken.

D. But there can be no patent for an abstract principle (*k*).

(*h*) *Tennant's* case, cited in *Hill* v. *Thompson*, 8 T. 395.

(*i*) *Campbell* v. *Jones*, 6 T. R. 570.

(*k*) Per Cur. *Rex* v. *Wheeler*, 2 B. & A. 345.

The Court of K. B. doubted (*l*) whether a patent could be good for the process of making colouring malt, if it were the mere application of a certain heat to common malt, without any essential apparatus. But this seems going too far, for a new substance (i. e. a substance new in qualities and properties, as the report shows) was produced, which would seem to bring the case under the former of the two divisions.

A patent, claiming (substantially) the invention of boiling by applying confined steam under the boiling vessel, was considered by a learned sergeant too abstract. A particular apparatus would have been a fit subject. It was probably from extreme caution on this head, that the inventor of another method of boiling by steam was advised (though his invention consisted of an

(*l*) *Rex* v. *Wheeler*, 2 B. & A. 345.

apparatus,) to confine his privilege to the processes (manufactures) of brewing, distilling, and sugar-refining.

It is said(*m*) rather too metaphorically, that a patent is good for a philosophical principle embodied in a machine; this means, for a machine whose identity consists in a certain mechanical application of a certain philosophical principle.

So Dollond's patent for achromatic telescopes was (quoad hoc) rightly supported (*n*).

E. A patent is not good for the particular use, as such, of a known substance or material (*o*).

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

(*n*) *Dollond's* case, cited in *Boulton* v. *Bull*, 2 H. B. 487.

(*o*) Lord Eldon. *Hill* v. *Thompson*, 3 Mer. 629.

As the (new) use of a known medicine to cure any particular malady (*p*).

Or the use of a particular machine or apparatus for a new (but not manufacturing) purpose.

But separate patents will probably lie in respect of two purposes, for one new machine. Therefore, where a patent had been taken out for an improved method of producing steam for the use of the steam-engine, it was considered competent to the inventor to take out a fresh patent for producing steam for general purposes; but it was judged necessary to take it out before specifying under the first patent, as that would have made the invention public (*q*).

F. A particular use of a known ma-

(*p*) Per Buller, J. *Boulton* v. *Bull*, 2 H. B. 487.

(*q*) See next section.

chine in the course of a manufacturing process seems to be a subject for a patent, as part of a manufacture;—because processes, generally speaking, consist in the particular use of tools or utensils upon materials; and, for the purposes of the present question, a machine is a complex tool or utensil. The individual cases of this sort, however, lead the mind into questions of nicety, with reference to the novelty (*r*).

G. In the present investigation, a critical analysis of Watt's celebrated patent may afford useful illustrations, and in particular serve to show how remarkably the strictness of the courts has increased since the decision on that patent; for at the present day, instead of being completely sustained, as it was, it would probably be overthrown on any

(*r*) See next section.

one of its seven divisions. Yet the general rules laid down in the case are, upon the whole, still recognised as sound.

The patent (s) was for "a method of lessening the consumption of steam and fuel in fire-engines," which might *a priori* possibly consist in mechanical construction, i. e. manufacture. (t) The title, therefore, was good. It was stated to consist of the following "principles," a word on which an objection was raised, and rightly disallowed, for "there is no magic in words."

1. In keeping the cylinder constantly as hot as the steam entering it, by casing it with wood or some bad conductor of heat, or by surrounding it with steam, and by not suffering water or any cold substance to enter it.

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

(t) See post, ch. 2.

There is no ground for a patent in taking care to exclude cold substances. A wooden case, or an external steam-reservoir, of a given construction, would have been a manufacture, and a subject for a patent, but certainly not the practice of casing or enveloping anyhow.

2. In condensing in a separate vessel occasionally communicating with the cylinder, and keeping such vessel cold by application of water, &c.

This separate vessel being a material addition to the engine, would have been a fit subject; but the want of particular directions for constructing it would have been fatal under a subsequent head (*t*). The keeping it cold, and condensing steam in it, were merely directions for use, but could be no part of the subject of an invention.

(*t*) Post, ch. 3.

3. In drawing off the uncondensed steam by pumps worked by the engine or otherwise.

The objections to this are similar. If the invention consisted in pumping off, generally, it was no subject for a patent; if in the addition of a particular pump in a particular manner, the specification did not describe it.

4. In applying in many cases the expansive force of the steam in the same manner as the pressure of the atmosphere was usually applied, and discharging it into the air where cold water was scarce; but this was declared inapplicable where the water to be raised entered the cylinder.

This remarkable clause claims the invention of the high-pressure engine. The specification *per se* would have been fatally vague had the subject been sufficient; but, as any possible engine

on the principle of high pressure was sought to be monopolized, the patent was emphatically for a principle, and consequently bad.

5. In producing a rotatory motion by a certain hollow wheel, &c.

The description (which it is superfluous to extract) is so loose, that the specification must be condemned as defective. Besides, there seems a fatal want of congruity with the title (*u*).

6. In producing incomplete condensation, and working by alternate expansion and contraction of steam.

This was a mere principle, and the effect might even have been produced by a certain management of the old apparatus. No new mechanism is at all adverted to.

7. In lubricating the piston with

(*u*) Post, ch. 2.

unctuous substances, or fluid metal, instead of water.

A mere direction for management ; allowable as such, if inserted in a valid specification, but fatal when claimed as an independent invention, which is the manifest import of each of the several clauses under consideration.

Sect. 2.—Novelty.

A. The manufacture must be new. This head and the next are so naturally connected (*x*) that they are usually confounded ; but the subject of a patent may be new, and yet not have been invented by the patentee, and invention may exist without novelty, as in a case where a patent for "imperial verdigris" was set aside (*y*), because the

(*x*) See post, sect. 3.

(*y*) *Wood* v. *Zimmer*, F. L. Holt, 58.

inventor had publicly sold the article four months before the patent was obtained, though under a different name, and without disclosing the process.

B. The statute says (*z*), any new manufacture "which others at the time of such patent shall not use;" which limits the inquiry in every case to the novelty of the invention at the time of the grant. It follows, that a patent is not avoided by the invention being published before specification, even by a stranger who has in the interim independently re-invented it. The patent itself makes invention and novelty conditions of validity, but the particular words need not be noticed, as they seem substantially equivalent to those of the statute, except as before observed (*a*).

(*z*) 21 Jac. 1. c. 3. s. 6.

(*a*) Part 1. ch. 2. s. 1.

C. As to the fact of novelty, it is properly a question for the jury (*b*), and every case must stand on its own peculiar grounds; but, it is conceived, the principle of consistency may be attained by referring the inquiry to the strict subject or essence of the patent, the particular thing manufactured, or the particular process of manufacture, as the case may be.

A patent for improvements in the manufacture of iron, one of which was the curing of "cold short" by lime (*c*), was set aside, because lime had before been used for the purpose, though in different proportions; the proportions not being made the essence of the patent.

It is a frequent popular objection to

(*b*) See *Brunton* v. *Hawks*, 4 B. & A. 541.

(*c*) *Hill* v. *Thompson*, 8 T. 375.

a patent that "the principle of it is by no means new;" but under the preceding rule, this is visibly futile; for the essence of the invention for which the patent is granted is a manufacture, and not a principle. The varying expansibility of metals was known before Harrison constructed his chronometer; but it would be absurd to deny the novelty of his invention on such a ground.

It does not follow, however, that trifling or nonessential variations constitute diversity of invention. An intelligent jury will readily distinguish between what is characteristic and what is colourable.

A patent was obtained for constructing anchors by making the flukes in one piece (*d*), inserting the end of the shank through a bell-mouthed orifice in it, and

(*d*) *Brunton* v. *Hawks*, 4 B. & A. 541.

then heating and hammering. The former mode had been by welding the flukes on to the shank. The patent was adjudged void for want of novelty, the contrivance having been long practised in the construction of the pickaxe, the hammer, and the mushroom and adze anchors; which, though called anchors, are totally unlike the common anchor in form, as their names show, and are only used as mooring-posts. This case may be called rather severe.

D. It is laid down that a foreign manufacture, newly introduced, is new under the statute (*e*). This seems correct.

But it may be asked, can any one adopt a French patent? Certainly not; for he is not the introducer (*i. e.* in-

(*e*) *Edgberry* v. *Stephens*, 2 Salk. 447. *Jessop's* case, cited 2 H. B. 476.

ventor, *quoad hoc*), the manufacture being publicly recorded, and therefore open to the world. Montgolfier, by delaying till his French patent was known in this country, debarred himself, though the actual inventor, from obtaining an available English patent for an improvement to his beautiful invention of the hydraulic ram (*f*).

E. A manufacture is new, if only discovered before in the way of private experiment, and never brought into practice (*g*); therefore, Dollond's patent for achromatic telescopes was good against Dr. Hall, who had previously made, but concealed, a similar invention.

(*f*) Millington's Lectures on Natural Philosophy, 8vo. 1823.

(*g*) *Dollond's* case, cited in *Hill* v. *Thompson*, 8 T. 395.

It is uncertain whether mere communication of the invention by a previous theoretical inventor would avoid a theoretical patent (*h*): probably it would not.

But if the previous inventor have made substantial use of the invention, though concealing it from all but the persons employed in his business (*i*), the patent is defeated; and that though the extent of the use have been but slight (*k*).

F. It has been observed, that the particular use of a known machine in a particular manufacture may probably be patented (*l*); but the mere application of it to a new subject can hardly be deemed to constitute novelty of invention: there should be some new pecu-

(*h*) 8 T. 394.

(*i*) *Tennant's* case, cited ibid.

(*k*) *Rex* v. *Arkwright*, cited 8 T. 395.

(*l*) Ante, sect. 1. F.

liarity in the management of the machine introduced; for it would be absurd to suppose that a cabinet-maker could patent the circular saw for any newly-introduced wood, or that a soap-boiler could appropriate a sugar-mill for barilla, or a chemist for drugs, or a brewer adopt a dyer's copper. The admissible patents of this kind must therefore be few.

Sect. 3.—Invention.

The statute authorizes a patent to "the first and true inventor" only, but the inventor (*m*) who first puts into practice and announces his invention is considered the first, as to the public. So the introducer of a foreign article is considered the inventor, as to this country (*n*).

(*m*) Ante, sect. 2. E.

(*n*) *Edgberry* v. *Stephens*; and *Jessop's* case, ante, s. 2. D.

It is usual to grant patents for foreign inventions specially (*o*), but this seems unnecessary; for unless the patentee be by legal construction the inventor, the patent is void under the statute. If he be legally considered the inventor, he may surely claim as such.

The introducer of a domestic invention, previously made by another but concealed, has never been adjudged entitled to a patent, unless himself an independent inventor (*p*); and, it is submitted, cannot be, consistently with the letter or spirit of the statute (*q*).

It does not appear to be commonly left to the jury to *find* whether the patentee was the inventor, but simply whether the patent was new; but the latter fact is *prima facie* evidence of

(*o*) Part I. ch. 1. s. 2.

(*p*) See *Dollond's* case, cited in *Boulton* v. *Bull* 2 H. B. 470.

(*q*) Buller, J. cont[illegible]

the former, and ought to be conclusive, without the most positive proof of plagiarism.

Sect. 4.—Utility.

It is not sufficient that the invention should be merely innoxious(*r*), but some positive utility(*s*) is required, as the prospect of it enters into the consideration for the grant. The degree probably need not be great. If the invention be of a new article, it should be applicable to some purpose of necessity, comfort, or luxury; if of a manufacturing process or a machine, the object of it should be accomplished either in a cheaper or a better way than usual.

In reason, the probability of future

(*r*) See post, ch. 4.

(*s*) Per Lord Ellenborough, *Hnddart* v. *Grimshaw*, Davies, 278.

usefulness, if clear and definite in its nature, and considerable in its degree, would be sufficient utility to support a patent.

The disuse of an invention in consequence of greater improvements in the arts might be ground for a *sci. fa.* to recall a patent granted for it, but ought not to be considered sufficient to avoid the patent absolutely, for utility is not made a condition by any express words either in the statute or the grant.

A patentee, in supporting his patent, gives some evidence (which may be slight, if unopposed), of the utility of his invention, and the question is left to the jury (*t*). No particular points appear to have been decided, or at least reported.

(*t*) See *Brunton* v. *Hawks*, 4 B. & A. 541.

CHAP. II.—TITLE.

SEVERAL patents have been set aside for improprieties in the title, considered with reference to the specification; or, rather, to the subject of the invention, as disclosed by the specification.

The title need not positively express or imply a manufacture (*a*); if it be possible that the invention may, consistently with the title, be one, the patent is provisionally good, subject to the further disclosure of the specification.

So that "a method" of performing any thing is generally good, if the method turn out to be a mechanical apparatus (*b*).

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

(*b*) Ibid. And *Rex* v. *Wheeler*, 2 B. & A. 350.

The title, however, must be correct; wherefore a patent (*c*) for making colouring-malt (by heating common malt strongly) is vitiated by the title of "a method of drying and preparing malt;" as such title implies a new process of making common malt from grain.

So a patent for "tapering hair brushes" was set aside (*d*); it appearing that the peculiarity lay in using bristles of unequal lengths in each insertion.

It must be descriptive; for a patent (*e*) for a new lamp is void, if entitled "a new method of lighting cities, towns, and villages."

It must not include non-essentials as important. A patent (*f*) for "an im-

(c) *Rex* v. *Wheeler*, 2 B. & A. 345.

(*d*) *Rex* v. *Metcalf*, 2 Star. 249.

(e) *Lord Cochrane* v. *Smethurst*, 1 Star. 205.

(*f*) *Campion* v. *Benyon*, 3 B. & B. 5.

proved method of making sail-cloth without any starch whatever," was adjudged void; the omission of starch not entering into the essence of the invention, though incident to the invented process.

Should a title be such as to prove that the invention could not consistently with it be a manufacture, the patent must be void *ab initio*; for if the invention were a manufacture, the title would be fatally incorrect, if not, the subject would be defective. But whether there can be any such title is open to some doubt. Any one would have thought "a new method of computing mathematical and astronomical tables" as unpromising a title as could be conceived. Yet an eminent mathematician has lately invented a machine which will perform with correctness most intricate calculations, and is peculiarly adapted to the construction of tables. A patent for

such a machine would be unquestionably allowable, and it is submitted that the above title would be unexceptionable.

The title should be co-extensive with the specification (g), as will be noticed hereafter.

(g) See post, chap. 3. s. 6.

CHAP. III.—SPECIFICATION.

SECT. I.—DESCRIPTIVENESS.

IT has been already seen how a specification must be executed, and when it must be enrolled (*a*): it remains to be considered, what characteristics the condition in the grant has been construed to require; and one of the most important is Descriptiveness.

The invention must be so described, that a common workman may be able to perform it from the specification, without further directions (*b*): this means, any common workman conversant with the general subject (*c*). The

(*a*) Part I. ch. 3.

(*b*) Bull. N. P. 77. *Harmar* v. *Playne*, 11 E. 101.

(*c*) Bull. N. P. 77. *Arkwright* v. *Nightingale*, Davies, 36.

description of a new steam-engine should be sufficient for workmen accustomed to the manufacture of steam apparatus: a shoemaker, or even an ordinary blacksmith, could not be expected to understand it, however perspicuous. Therefore, when known methods of operating are prescribed, as boring, turning, welding, &c., the manner of performing them need not be set out, nor need any common incidents which the nature of the process obviously implies (*d*).

All essential particulars, however, must be furnished (*e*); as, where heat is required, the intensity must be stated. It is insufficient to say, that the degree will be learned by experience (*f*), for the

(*d*) Per Eyre, C. J. *Boulton* v. *Bull*, 2 H. B. 494.

(*e*) Per Dallas, C. J. *Hill* v. *Thompson*, 8 T. 393.

(*f*) *Rex* v. *Wheeler*, 2 B. & A. 345.

public should have the benefit of the patentee's experience.

But it is unnecessary to state the extent of benefit, as the quantity of fuel saved (g).

Drawings are frequently annexed and referred to, which of course makes them part of the specification, and subject to the rules affecting it. There may be cases where no verbal description could be intelligible without them; this would render them indispensable. It must be remembered, however, that though a drawing may define vague expressions, it never has been, and probably never will be, permitted to cure by contradiction positive errors in the text. The proportions of a drawing must be true, unless the text determine them. A scale of feet is proper, but not indis-

(g) Per Eyre, C. J. *Boulton* v. *Bull*, 2 H. B. 498.

pensable, unless the peculiar nature of the case absolutely require one.

The sufficiency of a specification in this and other respects being deducible principally from testimonial evidence, is generally a question for a jury, to whom a patentee must adduce at least *prima facie* evidence that the directions are intelligible, and that by following them the desired effect is produced.

SECT. 2.—FAIRNESS.

The description must be full and fair.

Any material concealment, or wilful inaccuracy, will destroy the patent (*h*); for the public, after the expiration of the term, are to enjoy the invention as beneficially as the patentee.

(*h*) *Rex* v. *Arkwright*, Bull. N. P. 77.

Therefore, a patent for trusses was set aside (*i*), because the specification omitted to direct rubbing the steel with tallow, which was advantageous, and known and practised as such by the patentee.

So, concealing the use of aquafortis in a new process for making verdigris, vitiated the patent, though it was only beneficial, and not essential (*k*).

Sect. 3.—Accuracy.

The statements must be accurate.

For if a patentee profess to produce a substance in three different ways, or three different substances by one process, and fail in any one respect, or if he represents an ingredient as indis-

(*i*) Bull. N. P. 76.

(*k*) *Wood* v. *Zimmer*, F. L. Holt, 58.

pensable, which is not so, the patent is void (*l*).

But it seems (*m*) that a patentee would not destroy his patent by stating that he believed a certain degree of heat most advantageous to his process, though, in fact, a much higher degree should prove to be better, unless either the misstatement were wilful, or the prescribed degree totally inadequate to produce the effect. Inaccuracy in theories or non-essentials would not probably be fatal. It is safest, however, to exclude every thing which is not in some measure descriptive or illustrative. Mere theory should be totally interdicted.

(*l*) *Turner* v. *Winter*, 1 T. R. 602.

(*m*) See Davies, 381.

Sect. 4.—Definition of Claim.

The extent of patentee's claim must be defined.

Where the specification of a patent for improvements in umbrellas (*n*) described the new umbrellas in their complete state, without distinguishing the parts in respect of which novelty was claimed, the patent was overthrown.

But where a patent was taken out for improvements to a machine, referring to a former patent for the machine itself (*o*), it was held sufficient to describe in the specification, without any reference, the machine in its improved state; for the reference in the patent made the two specifications parts of a whole.

(*n*) *M'Farlane* v. *Price*, 1 Star. 200.

(*o*) *Harmor* v. *Playne*, 11 E. 101.

When the essence of a patent is combination, it must be clearly so expressed (*p*).

Much judgment is necessary in defining the privilege with sufficient particularity to insure the patentee's safety, and sufficient generality to consult his interest. It is usual and prudent, and sometimes necessary, to use the language of disavowal, to prevent misconstruction; as, "But I do not claim the construction or adaptation of these valves as any part of my invention;" and to direct known articles to be made "by the known and usual methods."

(*p*) Per Cur. *Hill* v. *Thompson*, 8 T. 393.

SECT. 5.—CORRECTNESS OF DEFINITION.

The definition of the claim must be true.

Therefore, if a whole machine be claimed where an addition only has been invented, or if an improvement be stated as a general discovery, the patent is avoided (*q*).

If the invention be new, but be stated to consist in that which is not new, the mis-statement is fatal; as where a patentee declared that he had discovered that the application of lime would cure "cold short" in iron, and then proceeded to give particular directions; whereas the general use for the

(*q*) *Morris* v. *Brandon*, Bull. N. P. 77. Per Dallas, C. J., in *Hill* v. *Thompson*, 8 T. 394.

purpose was not new, though the particular directions and proportions might be (*r*).

So, where the inventor of a fire-grate recapitulated that his invention consisted in introducing the coals from below, which was not new, though his specified contrivance for it was, the patent was annulled (*s*).

If a patent be for a combination of parts, which combination has been carried up to a certain point by previous inventors, the specification must notice how far they have gone, and claim originality from that point only, and not assume the combination *ab initio* as the patentee's invention (*t*).

(*r*) *Hill* v. *Thompson*, 8 T. 375.

(*s*) *Rex* v. *Cutler*, 1 Star. 354.

(*t*) *Bovill* v. *Moore*, 2 Marsh, 211.

Sect. 6.—Relation to Title.

The specification must be co-extensive with the title.

For if the title be for two inventions, and the specification for one, the condition is not fulfilled.

If the specification, besides satisfying the condition, add another invention this would seem harmless surplusage, if manifest; but if likely to mislead as to the extent of the privilege, it would probably be fatal on the ground of fraud and unfairness.

CHAP. IV.—STATUTE RESTRICTIONS.

SECT. 1.—WORDS OF STATUTE.

The statute of monopolies, in protecting patents for inventions (*a*), imposes these restrictions,— "So as the same be not contrary to law, or mischievous to the state, by raising prices of commodities at home, or hurt of trade, or generally inconvenient;" words which seem to express no more than the common law would very probably have implied (*b*).

(*a*) 21 Jac. I. c. 3. s. 6.

(*b*) See 11 Rep. 86 b.

SECT. 2.—GENERAL ILLEGALITY.

The words "not contrary to law," in particular, only express what sound construction would have implied without them; viz. that the objection to patents, on the ground of monopoly, is the only one cured by the saving clause; all specific objections to the particular subject of the patent, either under a statute or at common law, remaining in full force.

Thus, a patent for brewing beer from drugs would be void under the 42 G. III. c. 38. and 51 G. III. c. 87.

Or (at common law) any imaginable manufacture which must necessarily, under any circumstances, be a nuisance.

However, patents for offensive manufactures are frequent, and, when they can be enjoyed consistently with the

rule "sic utere tuo, ut alienum non lædas," unobjectionable.

Sect. 3.—Raising Prices and injuring Trade.

The denunciation of patents "mischievous to the state, by raising prices of commodities at home, or hurt of trade," seems to be included in the more comprehensive expression "generally inconvenient." The legislature probably felt the same alarms as their predecessors, who persecuted forestallers, regraters, and ingrossers; but it is difficult to conceive a patent raising prices or injuring trade generally. It may, in a limited department, do both, and if its success be great, it probably will. The oil-gas patent may possibly raise the price of oil, and injure the coal trade; but the particular injury is

evidently inseparable from the public benefit in this case, and the act condemns those patents only, which so raise prices of commodities, or injure trade, as to be mischievous to the state.

Sect. 4.—General Inconvenience.

As to general inconvenience, it is apprehended that a very strong case must be made out to affect the validity of a patent; for good sense teaches, that a new invention is *prima facie* an important benefit, not only by its own immediate utility, but by the foundation which it lays for improvements and derivative inventions, and perhaps still more by the spirit of enterprising ingenuity which it at once develops and stimulates. The words, in their

natural import, mean generally inconvenient on the balance of advantages and disadvantages; and this, without doubt, is the shape in which the question would be left to a jury, if a patent marked by some positive utility and some positive disadvantage should be submitted to them.

Machines, now recognised as sources of national wealth and prosperity, were held in detestation by the wisdom of our ancestors; and Lord Coke seems to have thought that a saving of manual labour amounted to "general inconvenience;" for in his commentary on this clause(*c*), he adduces a statute of Edward the Fourth, prohibiting the use of a fulling-mill, on the ground of its doing the work of eighty persons (*d*). An

(*c*) 3 Inst. 184.

(*d*) 22 Ed. IV. c. 5. repealed by 1 Jac. I. c. 25. s. 38.

inexcusable blunder in Rees's Cycl. [Patent] represents this as a judicial decision under the statute of Monopolies; but it is gratifying to remark, that no decision on any part of this restrictive clause is reported.

S. 4.—Term and Date.

The statute limiting patents to fourteen years, the term or the date may occasion nullity, as has been seen (*e*).

(*e*) Part I. ch. 2. s. 4.

CHAP. V.—IMPLIED CONDITIONS.

SECT. 1.—FRAUD.

PERFECT bona fides in obtaining patents is necessary. Therefore, if a patent have been obtained through any misrepresentation, fraud, or artifice, particularly if the crown have been deceived as to the consideration, it will be a ground of forfeiture (*a*).

But a mistake on the mere surmise of the crown, without any deception, is not fatal (*b*).

Nor is mere mis-statement of consideration in the patent (*c*).

(*a*) *Legat's case*, 10 Rep. 109. So 10 Rep. 66, b. *Rex* v. *Kemp*, 12 Mod. 78.

(*b*) Dy. 352, a. 2 Cro. 34. 2 Brownl. 242. 11 Rep. 4, b. 12 Mod. 78.

(*c*) *Case of the Churchwardens of St. Saviour's*, 10 Rep. 66, b.

SECT. 2.—ABUSE.

Any abuse of the privilege granted by a patent will be a cause of forfeiture (*d*), (but the Chancellor, in the cited case, seemed to think a sci. fa. requisite).

SECT. 3.—NONUSER.

So nonuser; for it is an implied condition, that the public are to be supplied with the article. Should there be no demand for it, it is conceived that no objection would lie to the patent under the present head; but the disregard of the public might have some weight with a jury on the question of inutility (*e*), though it ought not to have much.

(*d*) Ex parte *O'Reily*, 1 Ves. Jr. 113. 118.

(*e*) Ante, ch. 1. s. 4.

Sect. 3.—Exorbitance.

The patentee, like every monopolist, is *bound to render* the article at a reasonable price, or an action will lie (*f*); but exorbitance was not considered a cause of forfeiture in the quoted case, which, being under an act of Parliament, was not quite similar to the present one. However, as it must be a question of quantum, exorbitance seems a more fit ground for damages than for forfeiture.

There appear to be no decisions on the subject of this chapter directly affecting patents for inventions, but the rules are deducible by analogy, and particularly from the law of franchises (*g*).

(*f*) *Allnutt* v. *Inglis*, 12 E. 527.

(*g*) See Cruise's Digest, 1st Ed. vol. 3. p. 302, 305.

It is probable that abuse or nonuser would not make the patent void, but merely voidable by sci. fa. (*h*) Fraud, however, would probably avoid it totally.

(*h*) Ex parte *O'Reily*, 1 Ves. Jr. 113.

CHAP. VI.—EXPRESS RESTRICTIONS IN PATENT.

SECT. I.—SUBSCRIPTIONS OR CORPORATE ACTS.

The grant is declared to be void if the patentee shall open books for public subscriptions, or act as a corporate body, for the purpose of exercising the privilege, or shall otherwise transgress the 6 Geo. I. c. 18. This mention of Sir John Barnard's act, however, seems superfluous, as the companies described in it would come under the more comprehensive prohibitions in the patent; indeed, the other parts of the cited clause seem almost equally unnecessary, for, in such a subscription or company as the condition contemplates,

the members or subscribers cannot but exceed five, and then the case falls under the following restrictions.

Sect. 2.—Subdivision.

The grant is conditioned to be void, if the patentee, his executors, or administrators, or any person interested in the privilege, shall make any transfer or pretended transfer of the privilege, or any share of the benefit or profits, or declare any trusts, to or for more than five persons, or shall receive moneys from more than five persons for the purpose of carrying on the privilege, or shall divide the privilege into more than five shares. But all these cases resolve themselves into the more comprehensive one next mentioned, with which the condition concludes.

If the patent shall otherwise than by devise or succession become vested "in, or in trust for," more than five persons at once, reckoning co-executors and administrators as one person in right of the deceased, the grant is annulled.

A contract for sale would, of course, fall under this prohibition.

Sect. 3.—Interest of Trustees.

It is questionable whether the cited words apply to mere trustees. They do not necessarily require such a construction, and its inconve. ience would immediately be decisive against it, but for the difficulty thrown in the way by the mention of executors and administrators, who in their character of representatives are mere trustees. It seems, however, best to consider the qualifica-

tion as inserted *ex majori cautelâ* only, and to construe the restriction as applying exclusively to beneficial owners, taking the words "in or in trust for" as denoting and distinguishing absolute and equitable owners. A contrary construction would lead to endless inconvenience.

Whether the subdivided ownership be possessory or reversionary seems immaterial, if it be vested in interest.

SECT. 4.—INTERESTS ARISING BY OPERATION OF LAW.

Assignees in bankruptcy and insolvency are not named, but the spirit of the clause is so evident, that there can be little doubt that in construing it they would be held to represent the bankrupt or insolvent. The restriction, construed as reason and liberality require, only

applies to the intentional act of a party, and not the mere operation of law. Now it is in the latter way that assignees become possessed of assets; for though the creditors nominate the persons, the law creates the office; and, accordingly, a condition against alienation in a lease is held not to be broken by bankruptcy. Besides, the reasoning concerning trustees includes assignees.

It seems clear, on the foregoing principle, that the equitable division among next of kin, by the operation of the Statute of Distribution, would not avoid a patent; but the exception of "succession" in the condition protects this division still more effectually.

In this last-mentioned case, and in the case of a bequest among many, an equitable division being protected, it seems that a representative would be permitted to give it a legal effect, by

executing assignments of the shares to the parties.

Subdivision arising from a condition broken, or a resulting trust, would seem to fall under the prohibition, being caused by voluntary acts, unless the number of the claimants had been multiplied in one of the protected ways.

Sect. 5.—Limited Interest of Creditors.

If a patent should become vested in assignees, the number of the creditors would be immaterial, under the principle adverted to in the last section, of the exception of interests arising by operation of law, and also under the principle next mentioned, if correct.

A trust in an assignment of a patent for satisfaction of scheduled creditors was thought immaterial by C. J.

Rooke (i), because the creditors were not entitled to any proportion of the benefit of the patent, as such. They could only claim the amount of their debts, which might be satisfied *aliunde*. The point was saved; but, on a motion to set aside a nonsuit, it was not urged, and the court (with the deed before them) took no notice of it (*k*). A new trial was in fact granted, and the patentee ultimately obtained a verdict.

If this doctrine be correct (and it seems accordant with the spirit of the condition), a mortgage of a patent to more than five would be valid; for neither their interest as creditors, nor their character as trustees, would cause forfeiture.

(i) *Cartwright* v. *Amatt*, C. P. 1799.

(*k*) S. C. 2 B. & P. 43.

SECT. 6.—CAUTIONARY PROVISION, &c.

The restriction against subdivision places a shareholder in a most hazardous situation, for the patent may at any time be totally lost by the act of a co-proprietor. It is, however, not improbable that the crown might confirm the patent to the innocent shareholder. It is highly important to patentees to arrange who shall be at liberty to subdivide until the number be complete, as otherwise neither proprietor could forbid the other; and it is also right to provide, as well as can be done, against forfeiture by subdivision. A provision that any deed, contract, &c. should be void, would be insufficient, as the condition reaches any pretended assignment, &c. The best way seems to be,

to insert in every assignment of a share a proviso making it void, if the grantee shall make, or agree or propose to make, any assignment, declaration of trust, contract, or assurance, vesting the benefit of the patent, or any share of it, in more than one person ; for the grantee would then, *ipso facto*, cease to be such, and therefore it might be said that no actual shareholder committed the supposed act of forfeiture. Yet as, even then, the assignee's interest would only cease by, and not before the act (except, perhaps, where it ceased by a proposal, which might avoid his title-deed without forfeiting the patent), it would rather seem that of two concurrent rights, the crown's would be preferred.

Should a shareholder avoid a patent by subdivision, his co-proprietors might recover damages, provided he knew

that the number was full, but hardly otherwise, without express stipulation.

F

CHAP. VII.—TIME FROM WHICH A PATENT MAY BE AVOIDED.

SECT 1.—VOID AB INITIO.

A PATENT will be void *ab initio* for such defects only as are demonstrable at the time of the grant; which appear to be the following.

A longer term than fourteen years, a deferred term, or a false date (*a*).

Necessary insufficiency in the subject, on the face of the grant; but this is improbable, and, except on the question of manufacture (*b*), seems impossible; for there is no reason why a patent for a really new and useful invention should be impeached for not asserting novelty, invention, or utility, or even for

(*a*) Part I. ch. 2. s. 4.

(*b*) See Ante, ch. 2.

negativing them, if such an absurdity can be supposed (*c*).

Fraud or deception in procuring the grant (*d*).

The last defect rests on general principle, the preceding ones on the statute.

Sect. 2.—Void by Relation.

When the specification is enrolled, and not before, it is known what the invention is, and consequently whether the subject, title, and specification, are sufficient; if either is defective, the patent is generally void, by relation to the time of its grant.

It seems, that where the defect rests on the statute, this relation must always obtain; for if the subject, novelty, or

(*c*) See ante, ch. 5.

(*d*) Ante, ch. 5.

invention fail, the patent is discovered not to be such a one as the statute authorizes.

Utility (*e*) is not required by the statute in express words, but established implication seems for the present purpose equivalent; therefore, if the specification disclose an useless invention, the patent is void by relation. But supervening inutility would not have a retrospective effect, in reason.

Public injury (*f*) stands on nearly the same ground as inutility, or rather, on stronger, being named in the statute and patent (*g*). It would therefore vacate the patent by relation, if original, but if subsequent, only from its actual occurrence.

(*e*) Ante, ch. 1. s. 4.

(*f*) See ante, ch. 4.

(*g*) See part I. ch. 2. s. 1.

All defects in the title and specification, and the omission to specify, rest on the express or constructive conditions in the grant; and the nature of the case seems to point out nullity by relation as the species of forfeiture ensuing. The other cases of forfeiture under the terms of the patent seem to fall into the next class.

SECT. 3.—VOID FROM ACT OF FORFEITURE.

Where a patent is void for supervening inutility or public injury, it probably is void from the occurrence of the evil only (*h*).

So, where it is void for abuse or non-user (*i*).

(*h*) Supra.

(*i*) Ante, ch. 5.

Or for transgression of the proviso against joint subscriptions, corporate acts, and subdivision (*k*).

This classification does not appear to have been the subject of any decision or discussion; reason and principle are therefore the only guides.

(*k*) Ante, ch. 6.

CHAP. VIII.—EXTENT IN WHICH A PATENT MAY BE AVOIDED.

SECT. 1.—PRINCIPLES OF PARTIAL AND TOTAL NULLITY.

WHERE any defect exists, it seems that the patent must be, at all events, absolutely void or voidable, for the particular subject to which the defect relates; for it will be seen, by a survey of all the preceding defects, that no case of modified or abridged validity has ever been recognised. The only manner, therefore, in which nullity can be partial, is in respect of different subjects.

It is laid down (*a*), that a patent may

(*a*) Vin. Ab. XVII. 80, cites *Sackville Coll.* case, 1 Ray. 177.

be partially repealed, but that it shall be only in independent clauses.

So that a grant of two manors, exceeding the disposing power over one, remains good for the other; and it seems to have been thought, and, if so, rationally, that a grant of a manor and monopoly of alum was void for the monopoly only, and good for the manor (*b*).

Applying this, it follows, that a patent for an invention is not destroyed by an included grant of an illegal privi. lege, as exclusive printing, &c., unless conditional on the exercise of the illegal privilege, or otherwise inseparably connected with it. So, if a patent grant a monopoly of one invention for fourteen years, and of another for fifteen, it will be void for the latter only.

(*b*) Vin. Ab. Ibid. Cites Jenk. 209. pl. 41. and 2 Free. 17. pl. 15.

Whether a patent is lost *quoad* a given invention, by breach of a condition in the grant relating to a different invention or subject, depends on the words of forfeiture, which in practice may be said to be always general.

The consideration of a patent is, unless otherwise expressed, entire; therefore, the deficiency of any part of it, or any deception regarding any part of it, annuls the whole grant (*c*).

Sect. 2.—Cases of Double Patents.

It will now be considered in what cases a double patent is wholly void, for a particular defect relating to only one of the included inventions.

(*c*) *Brunton* v. *Hawks*, 4 B. & A. 541.

One of the inventions may be no manufacture. If this defect were originally demonstrable from the title (*d*), the crown has not been deceived as to the consideration, but has simply exceeded its power as to this invention, and the patent remains good for the other (*e*); but if the crown could possibly have imagined the yet unspecified invention to be a manufacture, the consideration fails; for it is understood that the invention is to be consistent with the statute. This defect, therefore, will generally superinduce total nullity.

Novelty, being a requisite under the statute, forms part of the consideration; and therefore, where one of two inventions included in a patent proved

(*d*) See ante, ch. 2.

(*e*) Supra, sect. 1.

not to be new, the other fell with it (*f*).

Invention seems to fall under the same rule as novelty.

Utility is distinguishable. The hope or prospect of it is recited as entering into the consideration, and, in fact, does enter into it at the time of the grant; but the eventual realization of it being in its nature contingent, and the quantum indeterminate, it cannot found a positive deception as to the consideration, like the facts of novelty and invention (*g*); and as it is not an express condition, the case seems referrible to general principles of justice and policy, which would separate the useless invention from the useful one, and preserve to the patentee the monopoly of

(*f*) *Brunton* v. *Hawks*, 4 B. & A. 541.

(*g*) See ante, ch. 5.

the latter, in respect of which, at least, he has been meritorious.

There is an authority (*h*), maintaining, that if any part of an invention be new and useful, it will sustain the rest; but it seems to refer to a compound invention rather than to a double patent; otherwise it is clearly wrong as to the novelty, and therefore not to be relied on as to the utility.

The title is material from its relation to the invention, as disclosed by the specification, and objections to the title are therefore deducible from the patentee's obligation to specify such an invention as the title describes, which rests on a condition in the grant. Consequently, an objection to any part of the title involves the total destruction of a double patent.

(*h*) *Rex* v. *Else*, Bull. N.P. 76.

Any fault in the specification, though relating to one of the inventions only, is for the same reason subversive of the whole patent.

The inconveniences mentioned in the statute seem, for the present purpose, analogous to inutility. Their appearance cannot convict the patentee of any mis-statement of consideration, for he could not foresee them. Therefore, the patent would (under the statute) probably be void, *quoad* the obnoxious invention only, as for illegality in an independent clause. But under the words of the grant, inconvenience would be a ground for total recall, if the crown should think proper to exercise its right (*i*).

Fraud, abuse, or nonuser, relating to any privilege included in a patent,

(*i*) See Part I. ch. 2. s. 1.

must affect the whole grant, for it impairs the meritorious consideration, which is in its nature entire.

The restraints against subdivision, &c., endanger the whole patent, being express conditions in it.

Hence it may be laid down as a general rule, that the failure of a double patent, as to one invention, destroys it entirely. The exceptions are confined to the cases where the defect was originally manifest, as an excessive term and a demonstrably improper subject, and those where it was essentially contingent and involuntary, as inutility and inconvenience; and even these cases are doubtful.

PART III.

INCIDENTS AND REMEDIES.

CHAP. I.—ALIENATION.

SECT. 1.—POWER IN GENERAL,

THE patent is by express words made assignable; and a complete assignment confers as absolute a title as the patentee possessed, for the grantee may sue for infringement in his own name (*a*).

Consequently, any modified alienation will be valid; as for part of the term, or by way of lease.

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

So alienation of a share, subject to the restrictions before noticed (*b*).

Sect. 2.—Form.

The privilege being incorporeal, an absolute alienation of the whole, or any part of it, must be by deed (*c*), which of course must contain sufficient words to express and carry into effect the intention of parting with the whole interest, or it may be construed as a declaration of trust, particularly in the case of a derivative share; though the possibility of a legal title to a share is not questioned.

Alienations are, in general, for a valuable consideration, gross, annual, or contingent.

(*b*) Part II. ch. 6.

(*c*) Co. Litt. 49 a, b.

An ad valorem stamp is obviously necessary in the first case; the second looks like a lease, but is nevertheless, under the stamp act of 1815, subject to an ad valorem conveyance stamp, reckoning the sum total of the annual payments as a gross consideration (*d*); the reason is, that the title "Conveyance," in the act, comprises generally all alienations of real or personal property (*e*) not specially described, and the title "Lease" is confined to hereditaments. No ad valorem stamp is necessary, where the consideration is wholly contingent, as by a reservation of profits; which, indeed, would be reserving an equitable share of the patent (*f*).

(*d*) 55 Geo. 3. c. 184. And see *Attree* v. *Anscomb*, 2 M. & S. 88.

(*e*) But see *Warren* v. *Howe*, 2 B. & C. 281.

(*f*) Infra, s. 3.

The assignor should covenant for title, and, in a mortgage, absolutely. Whether by covenants for title a purchaser should be indemnified from latent defects or causes of forfeiture, is matter of stipulation. Without such stipulation, it is submitted that the vendor need only covenant to the extent of his knowledge or own acts for validity of patent, right to assign, quiet enjoyment, freedom from incumbrances, and further assurances. Should the vendor retain a share, there should be mutual covenants to account for profits, and a mutual proviso against subdivision (g).

(g) Part II. ch. 6. s. 5.

Sect. 3.—Trust.

It is clear on principle, and seems sanctioned by the words of the patent and by judicial authority, that a patent may be the subject of a trust (*h*). A judicial doubt has, however, been unaccountably expressed on the subject (*i*).

Without digressing at large into the rules of equity respecting created and resulting trusts, it is proper to remark, that the acquisition of any share of the profits, as such, amounts to an equitable alienation, whether it be by reservation in a grant, as noticed above, by express declaration, by implication arising from proportionate advances, by introduction of the patent into a partnership stock, or otherwise.

(*h*) Part II. ch. 6. s. 2. *Cartwright* v. *Amatt*, 2 B. & P. 43.

(*i*) Ex parte *O'Reily*, 1 Ves. Jr. 129.

Sect. 4.—Partnership.

To a certain extent, division of a patent must create a partnership. From the analogy of a ship, the owners must join and be joined in actions relating to their joint interest (*k*) ; and if they carry on the privileged manufacture themselves, which they must do, unless they adequately supply the public through some licensee (*l*), they are completely partners in respect of such manufacture; but as to the patent itself, their interest is, by the before-mentioned analogy, a tenancy in common (*m*).

(*k*) *Addison* v. *Overend*, 6 T. R. 766. *Baldney* v. *Ritchie*, 1 Star. 342. And see *Cartwright* v. *Amatt*, 2 B. & P. 43.

(*l*) See Part II. ch. 5.

(*m*) *Rex* v. *Liverpool Collector*, 2 M. & S. 223.

SECT. 5.—MORTGAGE.

There seems no objection to a mortgage of a patent; but, to render it available, it should be legal, to enable the mortgagee fully to use the privilege, and it should contain a power of granting licenses, and a power of sale.

A mortgage probably does not come within the proviso against subdivision(*n*); but if the form of one were adopted for the purpose of evading the clause, when the parties intended absolute alienation in reality, there can be no doubt that such a colourable transaction would amount to a forfeiture, if discovered.

It is conceived that a lien on a patent may subsist, but of course not beyond the depositor's title.

(*n*) See Part II. ch. 6.

Sect. 6.—Assignees, &c.

Patents, of course, may devolve upon assignees, executors, and administrators; their rights and liabilities do not seem to differ from those of other trustees.

A patent granted to an uncertificated bankrupt vests in the assignees by relation to the assignment, notwithstanding a release from the assignees and some other creditors; such release being only *suo jure* (*o*).

(*o*) *Hesse* v. *Stevenson*, 3 B. & P. 565.

CHAP. II.—LIABILITIES OF OWNERS.

FROM well-known analogies it may be laid down, that alienees of the whole or any share of a patent take it subject to any equities which affected their grantors in respect of it; except in the case of a legal assignment to a *bonâ fide* purchaser without notice.

The responsibilities attaching to an absolute or modified ownership in a patent, depend, of course, on the nature of the interest. As far as the crown is concerned, the conditions of the patent must be fulfilled, and it matters not how great or small the interest of the fulfilling or transgressing party may be.

Inter se, part-owners are bound to preserve the privilege, if valuable, as far

as in them lies; and, by consequence, to concur in supplying the public, and contribute for the purpose, and to commit no act of forfeiture.

As to third persons, co-proprietors or sole owners are responsible (*a*) for the due supply of the public, and liable to an actior for exorbitance; and debts contracted in the prosecution of the manufacture will bind all the parties concerned in it, whether apparent or actual. Cestuisque trust, however, would not be liable to third persons, unless ostensibly acting as owners.

Trustees of all kinds are responsible as owners, both to co-proprietors and third persons, unless the credit be actually given to the cestuique trust.

(*a*) Part II., ch. 5.

CHAP. III.—ENJOYMENT.

SECT. 1.—USING AND SELLING.

THE statute allows the privilege of "sole working and making," which words might seem to circumscribe the more comprehensive ones of the patent, "use, exercise, and vend;" but, as using and selling are ancillary to the privilege of making, which could not be adequately enjoyed without them, it rather seems that they also are included in the patentee's privilege. Indeed, it would not otherwise be a "monopoly," which the statute recognises it to be. Besides, in actions for infringement, it is usual to insert counts for using and selling, and there is no instance of a demurrer.

Sect. 2.—Licensing.

It is almost universal now for patentees to grant licenses to persons desirous of using the invention. The terms, of course, may be indefinitely varied. The partial interest thus given to the licensees looks, at first sight, like a subdivision, but it must be considered that the licensees acquire no aliquot share of the benefit or profits as such; and the sanction implied by those words in the patent which grant the exercise of the privilege to the patentee by himself, his agents, &c., "or such as shall agree with him for the same," and by those which prohibit the use of the invention without the patentee's consent, and the universal understanding and practice, seem fully to establish the security of licenses without limit.

All important licenses should contain

a warranty from the patentee(*a*), and a covenant by him to sue all infringers; and the manner of the licensee's enjoyment should be defined.

(*a*) See post, ch. 6, s. 2.

CHAP. IV.—INFRINGEMENT.

SECT. 1.—REMEDY BY ACTION.

PLAINTIFFS.

AN action on the case lies for infringing the monopoly, and the owner at the time of infringement is the proper plaintiff(*a*).

It seems that where there are several owners, all must join in this action(*b*), and that therefore a person having a limited interest, as a licensee(*c*), cannot bring it.

DEFENDANTS.

The action must generally be brought against the actual maker, user, or seller, of the invented article or process;

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

(*b*) Ante, ch. 1, s. 4.

(*c*) See ante, ch. 3, s. 2.

but where a second patent infringes on a first, it is possible, but uncertain, that the second patentee may be sued for having granted licenses, as having caused the prohibited invention to be made.

Invasion.

The patent prohibits all persons from counterfeiting or resembling, or adding to (*d*) or subtracting from the invention, or directly or indirectly disturbing the patentee's exercise of his privilege. This would all be rationally deducible from the simple grant of the monopoly.

The right of enjoyment, as considered in the preceding chapter, determines wherein infringement may consist. The fact, in particular cases, is completely a question for a jury;

(*d*) Acc. *Exparte Fox*, 1 V. & B. 67.

the same principles of identity and diversity which decide the novelty being applicable (*e*).

Evidence.

In an action for infringement, the plaintiff must prove the patent and specification, in the same way as matters of record in general, and give *primâ facie*, and, if necessary, the strongest evidence of the novelty and utility of the invention, and the intelligibility and sufficiency of the instructions in the specification (*f*); for which latter purpose a witness who has never been assisted by any extrinsic explanation is best. Should the plaintiff be an assignee of any kind, he must, of course, deduce his title.

(*e*) See Part II. ch. 1, s. 2.

(*f*) Part II. ch. 1, s. 2, 3; and Part II. ch. 3, s. 1.

All the defects mentioned in Part II. make the patent void, not voidable (except probably supervening inutility, and possibly abuse and nonuser); therefore, all will be evidence against the plaintiff on the general issue. A book, or an old patent, though void, will be evidence to disprove novelty.

But if the defendant be the original patentee, who has sold to the plaintiff, it has been held (*g*) that he has concluded himself as to the validity of the patent.

Damages.

It is not usual to claim substantial damages, as the patentee's evidence must then disclose his profits; but the Court of Chancery will direct the in-

(*g*) *Oldham* v. *Langmead*, cited in *Hayne* v. *Maltby*, 3 T. R. 438.

vader to account. Should the plaintiff have acquiesced long in the infringement, a jury would be naturally indisposed to give large damages.

Venue.

The venue in actions for infringement cannot be removed by the defendant, except into Middlesex, as the patent, which is part of the cause of action, is considered to be at Westminster (*h*).

Sect. 2.—Injunction.

The courts of equity will grant an injunction against the invader of a patent, and compel him to account for profits.

(*h*) *Cameron* v. *Gray*, 6 T. R. 363.

The facts of validity and infringement, if disputed, must be tried at law; but, in the mean time, an injunction may be obtained (*i*).

An exparte injunction has been granted on affidavit, even after answer (*k*).

Where the court of law was divided on a reserved case, an interim injunction was granted till another action was brought; but no terms were imposed (*l*).

The affidavit to ground the injunction must state applicant's belief of novelty and invention at the time of application, lest the contrary should have appeared since the grant (*m*).

(*i*) *Boulton* v. *Bull*, 3 V. Jr. 140. *Harmar* v. *Playne*, 14. V. Jr. 130.

(*k*) *Isaac* v. *Humpage*, 1 V. 430.

(*l*) *Boulton* v. *Bull*, supra.

(*m*) *Hill* v. *Thompson*, 3 Mer. 624.

An exparte injunction will only be granted on the plaintiff's possession, not where the invention is recent and disputed; but an account will be ordered (*n*).

Sect. 3.—Premunire.

The patent threatens infringers with a premunire. This is unimportant, except as matter for antiquarian curiosity.

(*n*) *Hill* v. *Thompson*, 3 Mer. 624.

CHAP. V.—DETERMINATION OF NULLITY.

SECT. 1.—INFRINGEMENT.

THE most obvious way of overthrowing an insecure patent is by infringing the supposed privilege, since any defect will nonsuit the patentee. But neither a nonsuit nor a verdict for the defendant is fully conclusive, as the question may be raised again by another action.

SECT. 2.—ISSUE.

An issue is sometimes directed by a court of equity to try the validity of a patent, but the decision is only conclusive in that court which directed the issue.

SECT. 3.—SCI. FA.

The most effectual way of destroying a patent is by a sci. fa., which may be brought, of right, by any subject (*a*); and the patentee must support his privilege against all objections stated in the writ.

This remedy is peculiarly suitable for a patentee who complains of infringement by a subsequent patent, for the second patent may be repealed on comparison of it with the first (*b*), without bringing the validity of the latter into question.

(*a*) A petition is first presented to the crown, and a warrant obtained thereon to the attorney-general, who grants his fiat; but that he is bound to grant it, for the suppression of a grievance (as an illegal monopoly), see *Sir Oliver Butler's* case, 2 Vent. 344, and *Regina* v. *Aires*, 10 Mod. 354.

(*b*) Ante, ch. 4, s. 1, (Evidence.)

It is no objection to a sci. fa. that the patent is void, and not merely voidable (*c*); else this remedy would seldom reach patents for inventions.

No costs are allowed in this proceeding, as the crown is plaintiff, and the statute giving costs on sci. fa. is confined to cases between subjects (*d*).—The legislature should remedy this.

(*c*) Vin. Ab. XVII. Prerogative, S. b. 14. U. b. 2, 4.

(*d*) *Rex* v. *Mills*, 7 T. R. 367.

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CHAP. VI.—Remedies consequent on Nullity.

Sect. 1.—Purchaser of Article.

It seems clear that the purchaser of a manufactured article from a supposed patentee cannot, on the subversion of the patent, recover back any part of the price, however it may have been enhanced by the imaginary monopoly.

Sect. 2.—Licensee.

A licensee can probably (independently of stipulation) recover damages where deception has been practised on him; or where the patentee is the culpable cause of nullity, as by neglecting to enrol a specification, or by transgressing

the implied or express conditions (*a*); and he can probably sue the individual who commits the act of forfeiture in case, though he may not have been the licenser.

It has been decided (*b*) that a licensee could not recover his consideration as money had and received, where the patentee was found not to be the inventor (and apparently innocently); but the licensee had, in fact, had the use of the invention, and the possibility of his recovering damages was not decided.

It is most probable, however, that want of novelty, and all other extrinsic defects of title, where unknown to both parties, would be considered as latent defects in chattels, which entitle a purchaser

(*a*) Part II. ch. 5, 6.

(*b*) *Taylor* v. *Hare*, 1 N. R. 260.

without warranty to no damages (*c*). And, *d fortiori*, a licensee could have no remedy for an intrinsic, and therefore discoverable, defect, as an insufficient title or specification, an improper subject, inconvenience, or inutility.

Where damages are recoverable by a licensee, his consideration money would be, in a great measure, the criterion, allowing for any actual or possible profit in the interim.

Sect. 3.—Purchaser.

A purchaser of a void patent is exactly in the situation of a purchaser of a bad title, whence, after transfer fully executed and money paid or secured, he has no remedy beyond his covenants for title; but if he discover the defect before completion, he may rescind the

(c) 2 B.C. 451. and see *Parkinson* v. *Lee*, 2 E. 314.

contract, and recover any advances as money had and received.

The damages recoverable under covenants for title would have reference to the purchase-money, as above.

Sect. 4.—Part-Owner.

Part-owners may recover damages against any shareholder who wilfully commits an act of forfeiture (*d*); for one tenant in common may sue another for destruction of the subject matter.

(*d*) See part II. ch. 6, ad fin.

CONCLUSION.

IN dismissing the subject, it may be noticed, that every step of the inquiry has exposed numerous and serious discouragements, which the law of patents presents to inventive ingenuity. Rigid it is in itself, and rigidly has it been expounded; for it is a melancholy truth that the books record scarcely any thing on patents, but unsparing destruction, attributable, generally, to that over-nice criticism, which will not be satisfied with less than unattainable accuracy. Whether this is still to prevail or not, a modified permission to amend a title or specification would be a reasonable and valuable relief, aided by an obligation on an opposing infringer or the prosecutor of a sci. fa. (*a*) to deliver a par-

(*a*) A *sci. fa.* sets out the objections, but in

ticular of his objections; leaving it still open to the jury to destroy the patent, by pronouncing the original defect in the title or specification to have been designed. Where the jury specially find the contrary, amendment might be permitted even after verdict.

An act of forfeiture committed by a shareholder should be made not to affect his innocent co-proprietors. Few cases of this sort have probably occurred, but if any have, they must have been cases of injustice and hardship.

Independent contemporary applicants should have several grants as against all others (*b*).

such general terms, that the patentee cannot always know distinctly and specifically the points relied on. All possible objections to the specification are comprehended under a general denial of the performances of the condition to specify.

(*b*) At present it is the practice to offer them a

The greatest liberality should be shown in attributing novelty of invention to confessed improvers, and patents should be allowed for all improvements in the mechanical arts, though not strictly manufactures.

It has been suggested that an improvement deserves a shorter privilege than an entire invention: but such an arbitrary classification would often set merit and reward at variance; while the profit of a monopoly is more likely (at least) to preserve a just proportion to the importance of the invention, by the natural operation of demand and supply.

It might increase the security of patentees against infringement, if an official inspector of concealed manufac-

joint grant; to which they sometimes object (and, perhaps, reasonably and prudently), though the rejection of both applications follows.

tures were appointed, under proper restrictions.

Patentees certainly have a just and reasonable claim to liberal protection and encouragement; for, independently of the risk to which every patentee is exposed of a contest insuring expense, and often threatening defeat, a fourteen years' privilege too often proves a poor recompense for a man who has benefitted his country and the world by his science and talent, the labour of his best years, and the devotion of his honest earnings: too often is such a man reduced, by the tardy justice of the public, to say at last—"*sic vos non vobis.*"

THE END.

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