THE

Law and Practice

OF

LETTERS PATENT FOR INVENTIONS:

STATUTES; PRACTICAL FORMS;

AND

DIGEST OF REPORTED CASES.

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By THOMAS WEBSTER, Esq.,

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TO

THE HONOURABLE

SIR WILLIAM HENRY MAULE, KNIGHT,

ONE OF HER MAJESTY'S JUDGES

OF

THE COURT OF COMMON PLEAS,

IN ADMIRATION

OF HIS

PROFOUND LEGAL KNOWLEDGE AND HIGH JUDICIAL CHARACTER,

THIS WORK

IS

INSCRIBED,

WITH SENTIMENTS OF THE GREATEST RESPECT,

BY

THE AUTHOR.

PREFACE.

THE exercise of the prerogative of the Crown in its grants of exclusive privileges, is the source to which the existing law and practice of letters patent for inventions must be traced. The legitimate exercise of that prerogative was well defined by the common law; and the statute of monopolies, which was declaratory of that law, confined the exercise of the prerogative to its proper objects, and among these to letters patent for inventions.

Various statutes exist having almost exclusive reference to grants of lands and offices; and the course of proceedings established in conformity with them, and with the principles of the common law, is the only source from which the practice as to letters patent for inventions is derived.

The application of the law and practice derived from these sources, to a subject-matter of the peculiar nature of new inventions, was attended with great difficulties, most of which were irremediable by common law, but which have been in a great measure obviated by the recent statute (5 & 6 W. 4, c. 83).

The design of the following pages is to exhibit the existing law and practice in a distinct and compendious form. The materials for this purpose consist of the Statutes, the Practical Forms, and the Reported Cases.

The Statutes more immediately connected with this subject, and the Practical Forms employed in soliciting or granting, or in the exercise of the rights under, letters patent, are given at full length; the decisions of the Courts, and recent rules of practice, and other explanatory matters, being embodied in notes to their respective clauses.

The words of the Statute (21 Jac. 1, c. 3) when taken in connexion with the corresponding words in the Practical Forms, seem to express every thing which can be required, and a careful examination of the authorities collected in the notes will show that, in recent cases at least, the rights and privileges intended to be conferred, have been fully secured to the patentee.

The new Rules of Pleading have directed the attention of the Profession to the words of the Statute and Letters Patent, and the consequence has been that, in several of the recent cases, the law has been expounded with a degree of distinctness and precision never before attained.

T. W.

2, *Pump Court, Temple,*
Nov. 24, 1840.

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LAW AND PRACTICE

OF

LETTERS PATENT FOR INVENTIONS.

Definition of Terms.

1. THE granting of exclusive privileges to particular individuals has from time immemorial been considered the undoubted prerogative of the sovereign power in these realms. The subject-matter of these grants has been various; as lands, honours, franchises, liberties, and monopolies. The legal instrument by which these grants are generally made is by "letters patent" (*a*), that is, letters open, and not sealed up; having the great seal pendant at the bottom, and directed or addressed by the sovereign to all the subjects at large, who may be interested in becoming acquainted with their contents.

Letters Patent.

Patent.

The term patent is frequently, in common parlance, employed for the preceding, and, in conformity with this usage, the person on whom the grant is conferred, or the grantee of the letters patent, is called the "patentee." These terms, "letters patent" and "patent," may be used indifferently in most cases.

But the term patent is also used in another and a more extended sense, so as to include the subject-matter of the grant, as well as the legal instrument by which the grant is made. No confusion, however, practically results from these different usages of the terms, since the circumstances under which each occurs immediately suggests in which of the two senses the term is there used. And a further application of the same term occurs in the phrase "patent rights," used generally to express all the privileges incident to, and enjoyed under, a grant of letters patent.

Origin of Letters Patent.

2. Letters patent for inventions derive their origin from the great system of monopolies, which included the mechanical arts, and nearly every branch of trade, down to the commencement of the seventeenth century; and which, however advan-

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(*a*) *Litteræ patentes*, in opposition to *litteræ clausæ*, which were sealed up and addressed to particular persons. The former are recorded in the patent-rolls, the latter in the close-rolls. 2 Bl. Com. 346.

tageous in the infancy of manufactures and commerce, soon became an intolerable grievance.

Monopoly.

The term monopoly (*b*) has received a somewhat different interpretation, according to the circumstances under which it is used. The natural meaning of the term is exclusive sale (*c*), and as this existed in general by virtue of the grant of some sovereign powers, the term became extended to include the privilege of exclusive sale, and thence other privileges, as of the sole making, working, and using, to which exclusive sale is incidental.

Origin of monopoly.

A monopoly may be created either by an act of the subject, as a contract between party and party, with the view of mutual aggrandizement, or by a grant from the Crown. To the former, the term ingrossing was generally applied (*d*). The character of the monopoly, and the consequent legality or illegality, depends on its tendency and effect with reference to the public; and an ultimate test by which the character may be ascertained is, whether the monopolist benefits himself without injuring others. For the whole aim of grants of this nature being to benefit the trade and manufactures of the country, and being dictated by motives of public policy, any thing in contravention of these objects would be clearly and entirely against their principle (*e*). Monopolies of both kinds, that is, by the act of the party, and by the grant of the Sovereign, have existed at all times and in all countries; and at their commencement have been almost invariably of the same character, namely, contrivances by the party, or agreements between the reigning power and the party, to deprive the people of their natural rights, and to furnish to each other the proceeds of their own avarice. The objects of these grants were confined, in the first instance, to the necessaries of life; but as society advanced in civilization, and the ingenuity of man was directed to increase the comforts and convenience of life by the extension of commerce and trade, more legitimate objects presented themselves.

(*b*) The reader will find the origin and progress of monopolies in states ancient and modern, and its history in England, fully treated of in the first two chapters of Collier's Essay on the Law of Patents.

(*c*) Monopolium: μόνος, sole, and πωλέω, sell. Quod est cum unus solus aliquod genus mercaturæ in universum emit ut solus vendat pretium ad suum libitum statuens 11 Co. Rep. 86. 3 Inst. 181.

(*d*) Monopoly differs from ingrossing only in this, that monopoly is by a patent from the king, and ingrossing by the act of the subject, between party and party. 2 Hawk. P. C. 293.

(*e*) A monopoly (says Sir E. Coke) is an institution or allowance by the King, by his grant or commission, or otherwise, to any person or persons, bodies politic or corporate, of or for the sole buying, selling, making, working, or using, of any thing whereby any person or persons, bodies politic or corporate, are sought to be restrained of any freedom or liberty that they had before, or hindered in their lawful trade. 3 Inst. 181.

Thus the subject-matter of a monopoly is twofold—namely, a trade already in existence, and a new invention. By a monopoly of the former kind, all others but the monopolist are excluded from that which the public were already in the possession and practice of, which is a clear violation of public right and policy; but by a monopoly of the latter kind, nothing is taken from the public which it before possessed, and such monopolies, under proper restrictions, may be greatly conducive both to public and private good.

Policy of Patents.

3. From the foregoing and following considerations some insight may be obtained into the policy of patent rights. That the person who brings into the public stock some new trade, whence arise the sources of national wealth, should receive some reward for his ingenuity, and some remuneration for the trouble and expense which he has incurred, is only reasonable. Hence the conferring of patent rights may be considered as having the following objects: To reward the inventor for his ingenuity, and for the benefit which he has conferred on the public: to secure to the inventor suitable remuneration for his outlay of capital: and to encourage and stimulate invention and improvements. Hence the granting of letters patent is not a mere matter of favour, but an equitable claim upon the Sovereign (*f*). Such being the policy and principles of patent rights, it would appear that a temporary or limited monopoly is a most appropriate, equitable, and convenient reward. For a reward of this nature proceeds directly from the invention; it depends in amount on the utility of the invention, and it is unfettered by legislative interference. The monopoly should only be temporary; for the inventor has no natural or inherent right in his invention; and it would be unjust and injurious to exclude the public, for any great length of time, from a participation in a branch of useful trade newly opened to them. This system of reward has consequently been adopted by most civilized nations, but not to the exclusion of other rewards, under special circumstances (*g*), and has been proved to give effectual encouragement to improvements in the practical arts. The advantageous operation of grants of letters patent on national

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(*f*) The patentee (says Lord Eldon) is a purchaser from the public, being bound to communicate his secret to the public at the expiration of the patent. *Williams* v. *Williams*. Consequently the disclosure of the secret, and the securing to the public the benefit of the invention, are essential conditions to be fulfilled by the patentee.

(*g*) Parliament has frequently given sums of money as recompense and for rewards to ingenious inventors. By 5 G. 2, c. 8, 14,000*l.* was given as a recompense to Lombe, for discovering and introducing the arts of making and working three Italian engines, and for preserving the invention for the benefit of the nation. See similar grants by 12 G. 2, c. 23, 2 G. 3, c. 14.

industry and wealth is widely extended; it generally exhibits itself in some one of the three following objects, viz., the making, using, or vending, to the comparative exclusion of the other two. In inventions like the steam-engine, the using is the great source of value to the public; in others, of an inferior nature, either the making or the vending will predominate, and be the great source of value, from the stimulus given to new branches of trade.

Common Law of Letters Patent.

4. The legitimate subjects for grants of letters patent becoming more distinctly recognised, the powers of the law were resorted to for the repeal of illegal grants, and the punishment of those who had solicited and obtained them (*h*). And many grants to corporations, as well as individuals, for privileges of exclusive trade, whereby others were debarred from and hindered in the enjoyment of their natural rights, were declared void, both by common law (*i*), and the statutes made for the freedom of trade (*k*).

The prerogative of the Crown, as to granting letters patent, is stated in the following manner in a very early and celebrated case (*l*):—

"Where any man by his own charge or industry, or by his own wit and invention, brings any new trade into the realm, or any engine tending to the furtherance of a trade that never was used before, and that for the good of the realm; in such cases the King may grant to him a monopoly patent for some reasonable time, until the subjects may learn the same, in consideration of the good that he doth bring, by his invention, to the commonwealth, otherwise not" (*m*). One part of the consideration

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(*h*) Towards the end of the reign of Edward the Third, John Peechie, of London, was severely punished for procuring a license under the great seal for the exclusive sale of sweet wines in London. Rot. Parl. 50 Ed. 3, n. 33. 3 Inst. 85. One of the articles charged William de la Poole, Duke of Suffolk, with obtaining divers liberties in derogation of the common law, and hinderance of justice, which was a penal offence. 3 Inst. The grant of sole ingrossing wills, and sole making pleas, was held void. 2 Hawk. P. C. 294.

(*i*) Sir Edward Coke declares all monopolies "to be against the ancient and fundamental laws of the realm." 3 Inst. 181. But he uses the term monopoly in the sense of his definition. See *ante*, n. *c*.

(*k*) See Magna Charta, 5 R. 2, st. 2, c. 1; 12 Ed. 3, c. 9. Also 9 Ed. 3, c. 1; 25 Ed. 3, st. 4, c. 2; 27 Ed. 3, st. 2, c. 2.

(*l*) 44 El. *Darcy* v. *Allein*. Noy, 182, 183. The case of Monopolies, 11 Co. Rep.

(*m*) Arts and manufactures were at this time (A.D. 1602) at an exceedingly low ebb in this country, and nearly all improvements were introduced from abroad. The law, as here stated, has been adhered to in spirit from the earliest cases to the present day.

In 9 El. letters patent were granted to Hastinges, in consideration that he brought in the skill of making frisadoes from abroad, not being used in England, for the sole trade of making and selling thereof for divers years. On this case being brought before the Exchequer Chamber, on an infringement, it appeared that certain clothiers had made baies very like the frisadoes, before the date of the letters patent, whereupon the clothiers were neither punished, nor restrained from making their baies like to his frisadoes. Noy, 183.

In 10 El. it was held, that a privilege to be consonant to law, must be for what is substantially and essentially newly in-

of the grant is the instruction of others in the art; the monopoly is to be for a reasonable time, until others may learn the art. What was then thought a reasonable time is not stated, but Sir E. Coke (*n*) objects to fourteen years as too long, on the grounds that those who have been apprenticed to learn the trade must continue apprenticed until the end of the term, and that consequently a sufficient number of persons would not devote themselves to the manufacture, to supply the wants of the public at the end of the term. This objection shows that the publication of a particular description of the invention, and in what manner it was to be performed, did not then form part of the principles of legislation, but that the invention became as it were a legalized secret during the term of the letters patent.

Origin of Specification.

5. It does not appear at what time the principle so strongly insisted on in the present day, viz., that the public should be instructed by the inventor himself, and that the full and public disclosure of the whole secret by the patentee, should be a condition of validity of the grant, and the price which he pays for the limited monopoly, began to be distinctly recognised as a fundamental principle of the grant of letters patent. But such a principle is most equitable; for the law granting a monopoly and securing privileges, for the violation of which a party may be punished, it is but just that the invention should be described so accurately that a person who takes proper pains may ascertain what the invention really is, from the exercise of which he is for a time excluded.

Since the latter part of the reign of Queen Anne, this principle has been fully recognised, and all letters patent since that time have contained a proviso, by which they will be void, unless the grantee within a given time, by an instrument under his hand and seal, and enrolled in the High Court of Chancery, particularly describe and ascertain the nature of his invention, and

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vented. *Birch's* case, 3 Inst. 85. Letters patent were granted to one Matthey, for the sole making of knives with bone hafts and plates of lattin, on the suggestion that he brought the first use thereof from beyond the seas. The wardens of the Company of Cutlers appeared to have made knives before, though not with such hafts; and it was held, that such a light difference or invention should be no cause to restrain them. Noy, 183.

Letters patent were granted to one Humphery, for the sole and only use of a sieve or instrument for melting lead, supposing it to have been his own invention, but the same appearing to have been used before, the Exchequer Chamber held, that he should not have the sole use thereof. *Ibid.* 184.

In 44 El. was the case of Monopolies, in which letters patent for the importation and manufacture of playing cards was declared a monopoly, and void by both common and statute law. 11 Co. Rep.

And in the more modern case of Arkwright's patent, *Buller*, J. said, "If there be any thing material and new, which is an improvement of the trade, that will be sufficient to support a patent." *R.* v. *Arkwright*, Printed Case, p. 182.

As to the necessity of novelty and utility co-existing in some degree in every patent, see *post* 9 & 11, and notes.

(*n*) 3 Inst. 184.

in what manner the same is to be performed (*o*). This instrument is called the specification: and so strongly was the House of Lords impressed with the justice of this condition, that a clause dispensing with the proviso in a bill for prolonging the term of letters patent, was unanimously rejected (*p*). But the publication of the invention in this manner being matter of public policy, special circumstances have occurred under which the legislature has thought it advisable to keep the specification sealed up (*q*).

Statute Law of Letters Patent.

6. Notwithstanding many letters patent being declared void, and patentees punished, the authority of the law was insufficient to cope with the prerogative of the Crown stimulated by penury to the exercise of such illegal means for raising money and rewarding its dependents and followers. During the reign of Elizabeth, the grievance grew to an intolerable height; great complaints were made in Parliament, and several attempts to check the evil. Mr. Lawrence Hyde introduced a bill, entitled "An Act for the explanation of the common law in certain cases of Letters Patent." After two unsuccessful attempts the bill was withdrawn, on the Speaker informing the House that the Queen had annulled many of the obnoxious patents (*r*). The opinions thus expressed

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(*o*) It does not appear on what authority this clause was introduced, but probably at the suggestion of the Attorney or Solicitor-General of the time. The first specification bears date 11 Anne. It was not a parliamentary measure. For the form of the specification, see *post*, Pr. Forms, No. XIV.

(*p*) See *post* 16, n. *s*.

(*q*) See *post* 16, n. *s*.

(*r*) The state of things at this period is thus described by the historian Hume:—"The active reign of Elizabeth had enabled many persons to distinguish themselves in civil and military employments; and the Queen, who was unable from her revenue to give them any rewards proportioned to their services, had made use of an expedient which had been employed by her predecessors, but which had never been carried to such an extreme as under her administration. She granted her servants and courtiers patents for monopolies; and these patents they sold to others, who were thereby enabled to raise commodities to what price they pleased, and who put invincible restraints upon all commerce, industry, and emulation in the arts. It is astonishing to consider the number and importance of those commodities thus assigned over to patentees. Currants, salt, iron, powder, cards, calf-skins, fells, poul-davies, ox-shinbones, train-oil, lists of cloth, potashes, anniseeds, vinegar, sea-coals, steel, aquavitæ, brushes, pots, bottles, saltpetre, lead, accidences, oil, calamine stone, oil of blubber, glasses, paper, starch, tin, sulphur, new drapery, dried pilchards, transportation of iron ordnance, of beer, of horn, of leather, importation of Spanish wool, of Irish yarn; these are but a part of the commodities which had been appropriated to monopolists. When this list was read in the House, a member cried, 'Is not bread in the number?' 'Bread!' said every one with astonishment. 'Yes, I assure you,' replied he, 'if affairs go on at this rate, we shall have bread reduced to a monopoly before the next parliament.' These monopolists were so exorbitant in their demands, that in some places they raised the price of salt from sixteen pence a basket to fourteen or fifteen shillings. Such high profits naturally begat intruders on their commerce; and in order to secure themselves against encroachments, the patentees were armed with high and arbitrary powers from the councils, by which they were enabled to oppress the people at pleasure, and to exact money from such as they thought proper to accuse of interfering with their patent. The patentees of saltpetre, having the power of entering into every house and committing what havoc they pleased in stables, cellars, or wherever they suspected saltpetre might be gathered, commonly extorted money from those who desired to free themselves from this damage

checked the evil partially, but great grievances still continued, and James almost immediately after his accession, of his own accord, repealed all the numerous patents of monopolies which had been granted by his predecessor, and which fettered every species of domestic industry.

In the twenty-first year of his reign, advantage was taken of great unanimity and good feeling between the King and his parliament, and the bill against monopolies was passed, which had formerly been encouraged by the King, but which had failed owing to a rupture between him and the last parliament (*s*). The particular provisions of this statute will be considered hereafter (*t*). In effect it declared all grants of monopolies to be contrary to the laws of the realm, and consequently void, saving and excepting letters patent, for a limited period, of the sole working and making of any manner of new manufactures within the realm, to the true and first inventor of such manufactures, which others at the time of making such letters patent should not use; with certain other conditions of validity. Statute of Monopolies.

Since this statute, a new invention is the only subject-matter

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or trouble. And while all domestic intercourse was thus restrained, lest any scope should remain for industry, almost every species of foreign commerce was confined to exclusive companies, who bought and sold at any price that they themselves thought proper to offer or exact.

"These grievances, the most intolerable for the present, and the most pernicious in their consequences, that ever were known in any age or under any government, had been mentioned in the last parliament, and a petition had been presented to the Queen complaining of the patents; but she still persisted in defending her monopolists against her people. A bill was now introduced into the Lower House, abolishing all these monopolies, and as the former application had been unsuccessful, a law was insisted on as the only certain expedient for correcting these abuses. The courtiers, on the other hand, maintained that this matter regarded the prerogative, and that the Commons could never hope for success, if they did not make application in the most humble and respectful manner, to the Queen's goodness and beneficence. The topics which were advanced in the House, and which came equally from the courtiers and the country gentlemen, and were admitted by both, will appear the most extraordinary to such as are prepossessed with an idea of the privileges enjoyed by the people during that age, and of the liberty possessed under the administration of Elizabeth. It was asserted, that the Queen inherited both an enlarging and a restraining power; by her prerogative she might set at liberty what was restrained by a statute or otherwise, and by her prerogative she might restrain what was otherwise at liberty; that the royal prerogative was not to be canvassed, nor disputed, nor examined, and did not even admit of any limitation; that absolute princes, such as the sovereigns of England, were a species of divinity: that it was in vain to attempt tying the Queen's hands by laws or statutes; since, by means of her dispensing power, she could loosen herself at pleasure; and that even if a clause should be annexed to a statute, excluding her dispensing power, she could first dispense with that clause, and then with the statute. After all this discourse, more worthy of a Turkish divan than of an English House of Commons, according to our present idea of this assembly, the Queen, who perceived how odious monopolies had become, sent for the Speaker, and desired him to acquaint the House, that she would immediately cancel the most grievous and oppressive of these patents." 5 Hume, 386, and L. L. *Ibid.* note.

(*s*) See 6 Hume, 126, and note *o*. In 1610, James published in print to the whole realm, that all grants of monopolies were contrary to law. See Preamble 21 Jac. 1, c. 3. Statutes, *post* 40.

(*t*) See notes to the Statute, *post* 40.

of a monopoly, and for any new species of monopoly recourse must be had to parliament (*u*).

Express conditions of validity.

7. The conditions of validity under this statute are express and implied. They relate to the term, the subject-matter, the grantee, the general legality and convenience; and the letters patent themselves contain clauses to the same effect.

The term.

The term is for fourteen years or under; hence letters patent for a longer or postponed term would be void *ab initio*, as not coming within the protecting clause of the statute. The term has frequently been extended by act of parliament, under special circumstances; and now, by a recent statute, new letters patent may be granted for a term not exceeding seven years, on a recommendation of the Privy Council (*w*).

The subject-matter.

The subject-matter is to be "the sole working or making of any manner of new manufactures within this realm;" and that will be new, or the condition of novelty will be satisfied by that "which others, at the time of making such letters patent and grants, shall not use." These clauses of the statute are of comprehensive import, and point out distinctly the class of inventions which it is the intention and policy of the legislature to protect. The various attempts made to suggest other terms (*x*), and to classify (*y*) all the subject-matters of letters patent, show

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(*u*) See Ray. 489; Cha. Ca. 165; Vernon, 166; 3 Mod. 126; 3 Bac. 627; Hawk. 4.

(*w*) See Statute 5 and 6 W. 4, c. 83; and Pr. Forms, No. XVII. *post*.

(*x*) The patent laws of other nations employ various phrases. By the Act of Congress of 1793 the words are "Any new and useful art, machine, manufacture, or composition of matter," which, in effect and construction, expresses no more than our own statute. Willard Phillips on Patents, p. 76.

The words of the French law are, "every invention or discovery in any kind of industry," which would comprehend many things not embraced by our law; as, for instance, a system of finance. But the construction of their law is very similar to that of our own; and M. Renouard's statement of the subject-matters of patents will serve for an exposition of our own law. "It is not every kind of invention and discovery that is the subject of a patent right. It is necessary that the invention or discovery should be of a nature to afford products that may be fabricated by the hands of man, or by the labour which he directs, or which may be the subjects of commerce by sale or purchase. If, for instance, a philosopher discovers and makes known a property of heat before unknown, and yet draws from his discovery no special and positive application to specific fabrications, his discovery is merely scientific, and not patentable. But if, on the contrary, he avails himself of the scientific principles for the production or combination of a new substance, for the formation of an instrument or machine—if he employs it to obtain a result that is new and of a vendible description, whatever it may be—he may take out a valid patent." Renouard Traité des brevets d'Invention, c. 5, s. 1, p. 165.

(*y*) The classification of the subject-matters of letters patent suggested by the following exposition of the statute, seems unobjectionable:

Abbott, C. J.: "Now the word 'manufactures' has been generally understood to denote either a thing made which is useful for its own sake, and vendible as such, as a medicine, a stove, a telescope, and many others, or to mean an engine or instrument, or some part of an engine or instrument, to be employed either in the making of some previously-known article, or in some useful purpose, as a stocking-frame, or a steam-engine for raising water. Or it may perhaps 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 expe-

the inadequacy of language to express all the minute distinctions which present themselves, and afford some colour of truth for the sentiment of M. Renouard, "that this branch of jurisprudence may be aptly denominated the metaphysics of the law." The difficulty which undoubtedly exists arises in a great measure from the fact of the arts and manufactures of a country being in a continual state of progression, whereby objects of skill never before contemplated suddenly present themselves, and changes most minute constitute the whole difference between a useful and a useless invention (*z*).

Novelty and Non-user.

The subject-matter must possess the incidents of novelty and non-user within these realms. The words in the statute are, "new, and which others at the time of making such letters patent and grant shall not use." The words in the letters patent are, "new as to public use and exercise." (*a*)

These conditions of novelty and of non-user will be satisfied, by that which is discovered then for the first time—by that which is introduced to these realms then for the first time—or by that which is communicated to the public then for the first time. That which was not known at all before, possesses the incidents of novelty and non-user absolutely; that which was not known at all before within these realms, possesses these incidents also absolutely, so far as these realms are concerned;

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ditious manner, or of a better or more useful kind. But no merely philosophical or abstract principle can answer to the word "manufactures." Something of a corporeal and substantial nature—something that can be made by man from the matters subject to his art and skill, or at least some new mode of employing practically his art and skill—is requisite to satisfy this word. *R.* v. *Wheeler.*

There may be a valid patent for a new combination of materials previously in use for the same purpose, or for a new method of applying such materials; but the specification must clearly express that it is in respect of such new combination or application. Per Lord *Eldon*, L. C., *Hill* v. *Thompson*, 3 Mer. 629.

1. The result or effect produced, as a stocking, a new fabric, or a piece of machinery.

2. The mode of production, as where known things acting in known manners produce known effects in a more economical or beneficial manner.

As Watt's, for the application of wood casing as a jacketing for steam-engines, to exclude cold or keep in heat; of condensation in a separate vessel; of oil, fat, &c., to keep the pistons tight. *Post* 46, n. *e.*

As Forsyth's, for giving fire to artillery by the application of detonating powder as a priming. *Ibid.*

As Hall's, for the application of the flame of gas to singe off the superfluous fibres of lace. *Post* 47, n. *e.*

As Lewis's, for shearing from list to list by a rotary cutter. *Ibid.*

As Russell's, for the omission of a maundril in making gas tubes. *Ibid.*

As Minter's, for the application of a self-adjusting leverage, so that the pressure on the seat and back of the chair might balance each other. *Ibid.*

As Derosne's, for the application of charcoal as a filter to the syrup of sugar. *Ibid.*

As Macintosh's, for the application of India rubber in a state of solution as a cement betwixt two fabrics, to produce a water-proof cloth. *Macintosh* v. *Everington.*

(*z*) Within the last two years, electricity has presented applications to practical purposes, and opened an immense field, in which many patents have already been granted; and in proportion as the laws of physics are more generally understood among practical men, will fresh fields be opened. The manufactures of a country are to be improved by additions to human power, by economy of time and materials, and by the adaptation of the laws of nature, and the application of materials to new purposes and in new manners.

(*a*) *Post* 45, n. *e*, and 80, n. *k.*

and that which is new as to public use and exercise, that is known and practised only in secret, possesses these incidents relatively, and within the meaning of the saving clause of the statute. Further, an invention known and in public use and exercise in two of the three kingdoms of these realms, may possess these incidents as to the third, and so be the subject-matter of letters patent therein (*b*).

The grantee.

The grantee is to be the true and first inventor within these realms, and this character may be acquired in three ways. He may be the original discoverer, and the first person who ever thought of, or exercised or put in practice, the invention. Under such circumstances he is absolutely the true and first inventor. He may be the introducer or importer of an invention known abroad, and in this case he is the true and first inventor absolutely within these realms. Or he may, though not absolutely the true and first inventor, by reason of some one else having made the same invention and kept it secret, be the true and first inventor relatively to the public, and within the meaning of the saving clause of the statute, as the first publisher thereof under the protection of letters patent (*c*).

Absolute inventor.

Importer.

Publisher.

General legality or convenience.

An invention illegal in itself, or having an illegal or injurious tendency, is clearly in contravention of the general policy of the patent laws, and void therefore at common law, as well as by the express condition of the statute.

But this clause gives rise to an implied condition, which is practically the most important and most indispensable incident, viz. utility. It must be considered as the legal inference from these words, that an invention absolutely useless is mischievous to the state, and generally inconvenient; and that letters patent for such an invention are void both by common and statute law (*d*).

Implied condition of validity. Utility.

8. Utility, as has been seen, is not an express condition, either of the statute or of the letters patent. It is referred to in the latter by way of recital, as that the patentee had represented or suggested to the crown that the invention would be useful to the public, and letters patent founded on such suggestion, if false, would be void at common law (*e*).

Whether then utility be viewed as an implied condition at common law, or as a legal inference from the latter portion of the saving clause of the statute, it has been recognised from the earliest times as an essential incident, and the absence of it as a valid objection to a patent. The question of utility is a question for the jury, and they have frequently found to the effect that all which was new was immaterial or useless; thus esta-

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(*b*) *Post* 49, n. *f*, and 67, n. *e*.
(*c*) *Post* 49, n. *g*.
(*d*) *Post* 50, n. *i*. and 117, n. *y*.
(*e*) *Post* 70, n. *w*.

blishing the identity of the two inventions, and consequent infringement (*f*).

Novelty and Utility.

It is consistent with the preceding, and with the general policy of the law, that a patent will be good and valid if the amount of invention and of utility taken as a sum be considerable—that is to say, if the invention be considerable, the utility may be inconsiderable; but if the invention be considerable, the utility must be considerable. This consideration of the two co-existing in some degree in every case, will be found consistent with the tenour of the reported cases (*g*). Novelty may frequently exist without utility, but great utility cannot be conceived to exist without novelty. Hence great utility of itself for all practical purposes constitutes novelty; and the latter may be assumed wherever the former is proved to exist in a very great degree; and it will frequently be found impossible to distinguish betwixt the two, so as to say where the sufficiency of each begins or ends.

Utility *per se* Novelty.

Statute 5 & 6 W. 4, c. 83.

9. The statute of monopolies, which enacted no new law, but was only both in form and substance declaratory of the existing law, and the rigorous spirit in which patent rights were legislated on by the courts, protected the public from unjust mono-

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(*f*) See *R.* v. *Arkwright*. Printed case.

(*g*) *Parke*, B., in delivering the judgment of the Court of Exchequer, in a recent case, says, "on a review of the cases it may be doubted whether the question of utility is any thing more than a compendious mode introduced in comparatively modern times of deciding the question whether the patent be void under the statute of monopolies." *Morgan* v. *Seaward*.

The following analysis of some of the leading cases may place this most important proposition in a clear light.

In Huddart's patent, the novelty of invention was small, but the utility of the result great, since much better cables and cordage were made than before. *Huddart* v. *Grimshaw*.

In Daniell's patent the invention consisted simply in dipping cloth in hot water, after it had been made and dressed in the common way; the result was highly useful, and the invention, if new, would have supported the patent. *R.* v. *Fussell*.

In Brunton's patent, the improvements on Captain Brown's cables consisted in substituting a cast-iron stay, with a broad end, for a wrought-iron stay, through the links; the cables so made came into general use. The jury found Brunton's cable new and useful; and on a motion for a new trial, *Abbott*, C. J., concurred as to the sufficient novelty of the invention, though the patent was invalid on other grounds. *Brunton* v. *Hawkes*.

In Hall's patent for improvements in the manufacture of lace, the novelty consisted in the substitution of the flame of gas for the flame of oil, or other substances; *Hall* v. *Gervas & Boot*. *Post* 47, n. *e*.

In Derosne's, in the use of a known substance, in a known manner, for a new purpose. *Derosne* v. *Fairie*. *Ibid*.

In Elliott's, for buttons, in the use of a particular silk in a known manner. *Post* 48, n. *e*.

In Russell's case, in omitting an instrument used in a former patent; *Russell* v. *Cowley*. *Ibid*.

In all these, the novelty or amount of invention was small, but the utility very great; and the patents so far good.

In Kneller's patent for improvements in evaporating sugar, it was contended that a former patent included it; but it was proved that the earlier patent had not come into use, and the defendant could not prove its utility. Held, that the difference between the two patents, however slight, was a difference which sufficed to make Kneller's patent come into use. The patent was supported. *Hullett* v. *Hague*. See 7 Lon. J. 2d series, 199.

Absence of utility or total failure of the invention, however great the novelty, will void the letters patent. *Manton* v. *Parker*.

polies at the expense of the patentee. The letters patent and specification were unalterable, clerical errors only excepted (*z*), and any defect or flaw which either of these instruments contained was irremediable, and interpreted most rigorously against the patentee. The common law declared letters patent wholly void for any defect in part, and the patentee was deprived of the whole of his invention from the failure of some condition, as want of novelty in a very small part. The hardship of the common law in this respect was so impressed on the legislature by the body of evidence contained in the Report of the Select Committee of the House of Commons on the law relative to Patents for Inventions, that an act was passed to amend the law in this respect, and to protect the patentee in his rights (*a*). By this act it is enacted, that a patentee may, with the consent of the proper law officers of the crown, amend his title and specification. A patentee may also obtain a confirmation of his letters patent in certain cases, where, from want of novelty, they would previously have been absolutely void, and a prolongation of the term by new letters patent under special circumstances, and on the recommendation of the privy council. Patent rights also are more effectually secured by giving a patentee treble costs on obtaining a second verdict, by compelling a defendant in an action to deliver notice of objections, and by a penalty for the unauthorized use of his name. The provisions of this statute had proved in the highest degree beneficial to the patentee, and many valuable patents have been amended and made secure (*b*).

2 & 3 Vict. c. 67.

By a proviso of the preceding statute, no extension of the term of letters patent was to be granted, unless the application for such extension was made and prosecuted with effect before the expiration of the term originally granted by the letters patent. A case occurred in which, owing to adjournments, the term originally granted expired in the vacation, and before any thing had been done effectively. The privy council felt this to be a case of great hardship, but irremediable. The 2 and 3 Vict. c. 67, repealed this proviso (*c*).

The preceding, with the exception of some statutes regulating the practice as to letters patent, are the only legislative enactments on the subject.

(*z*) The Master of the Rolls will order a clerical error to be amended. As where the copying clerk transposed the numbers of reference. In re *Redmund*. Or where the word was written "wire" instead of "fire." In re *Whitehouse's* patent.

(*a*) The report of the Committee of the House of Commons was ordered to be printed 12 June, 1829. The act in question, introduced by Lord Brougham, received the royal assent 10 Sept. 1835. See the act 5 & 6 W. 4, c. 83, Statutes, *post* 53.

(*b*) The decisions and practice under this statute will be found in the notes to the Statute, and to the Pr. Forms, *post*.

(*c*) See Statute 2 & 3 Vict. c. 67, *post* 67. & 58, n. s.

Practice as to Letters Patent.

10. Letters patent are distinct for the three kingdoms of England, Ireland, and Scotland, and the practice is in some respects different for each. The first step, however, is the same for all.

England.

The applicant for letters patent prepares a petition (*d*) to the Crown, stating his invention, and praying a grant of letters patent. The petition is accompanied by a declaration (*e*) made before a Master in Chancery, or a Master Extraordinary in Chancery, that he has made such an invention—that he is the true and first inventor thereof—or that it is new in this kingdom, according to the special circumstances of the case.

The petition and declaration are then taken and lodged at the office of the Secretary of State for the Home Department.

This petition may be had again in a few days, with a reference (*f*) upon it to her Majesty's Attorney or Solicitor-General. It is then taken to the chambers either of the Attorney or Solicitor-General, at the option of the applicant, for the report of that officer.

The Report.

At this stage some opposition may occur from a caveat (*g*) having been entered against the grant of letters patent, for the subject for which they are being solicited, without notice to the particular parties entering it. The clerk of the Attorney or Solicitor-General on receiving the petition referred for the report, looks over the books, and if any caveat is found, the applicant is delayed a week from the time that notice (*h*) is given to those who have entered caveats, to decide whether they will oppose. If the person having received the notice returns answer within the week that he shall oppose, sending at the same time the costs of the opposition, a summons is taken out for a hearing. A week's notice is given of the hearing, and on the parties appearing at the appointed time, the Attorney or Solicitor-General hears in private first the applicant, and then the opponents, in order. If at the appointed time for the hearing the opponents do not appear, or if, being heard, the Attorney or Solicitor-General thinks that the inventions are dissimilar, or do not interfere, he generally reports as of course in favour of the application. But if on the hearing he has reason to think there is an interference, he stops the application, or in his discretion recommends the parties to join in the patent, and on their acceding thereto, reports in favour of joint letters patent being granted.

The report (*i*) of the Attorney or Solicitor-General recites

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(*d*) Pr. Forms, I., *post* 65.

(*e*) Pr. Forms, II., *post* 67.

(*f*) Pr. Forms, III., *post* 68.

(*g*) Pr. Forms, IV. I have not noticed here the preliminary step sometimes adopted by the applicant, of entering a caveat. The policy of this will be found fully noticed and treated of in the note to the Practical Form, *post* 69.

(*h*) See notice and note, Pr. Forms, VI., *post* 69.

(*i*) See Report and notes. Pr. Forms, VII., *post* 70.

the reference, the petition, the declaration; that the novelty and utility of the invention are at the risk of the applicant; that it is reasonable for her Majesty to encourage inventions which may be for the public good; and recommends that in his opinion letters patent should be granted, provided a particular description of the nature of the invention be enrolled within a given time in the Court of Chancery (*k*).

Queen's Warrant.

This report is taken back to the Secretary of State's office for the Queen's warrant. The warrant, after briefly reciting the allegations and prayer of the petition, the Queen's readiness to encourage arts which may be for the public good, directs the bill to be prepared for her royal signature, with a proviso as to the enrolment of the specification, and for the insertion of all the usual clauses (*l*).

The warrant is taken to the Patent Office (*m*) for the bill.

Queen's Bill.

At this stage, opposition may again occur. An opposing party, unsuccessful in his former attempt, before the Attorney or Solicitor-General, may have entered a caveat (*n*) at the Patent Office, or another party may have entered one. The clerk of inventions in the Patent Office sends a notice; the party returning answer within a week that he shall oppose, and depositing 30*l.* as security for the costs (*o*), a hearing is appointed, and the Attorney or Solicitor-General exercises his discretion as to stopping the patent, or permitting it to proceed. If there be no opposition, or it be overruled, the bill is prepared, as of course. The body of the bill is precisely the same as the letters patent; it is attested or signed by the Attorney or Solicitor-General, and has a memorandum at the bottom recapitulating the contents of the bill briefly, also signed by the Attorney or Solicitor-General. The bill then goes to the Secretary of State's office for the Queen's sign manual, and having received this and been countersigned by the Secretary of State, it is called the Queen's Bill (*p*).

Signet Bill.

The Queen's Bill is then taken to the Signet Office, and one of the clerks of the signet makes in the Queen's name letters of warrant under the hand of such clerk, and sealed with the Queen's signet, to the Lord Keeper of the Privy Seal (*q*). This warrant, which is a copy of the bill, so signed and sealed, is called the Signet Bill (*r*).

Privy Seal Bill.

The Signet Bill goes to the Lord Keeper of the Privy Seal,

(*k*) As to the clause for the enrolment of the specification, see *ante* 5, and *post* 16, n. s.

(*l*) See Pr. Forms, VII., and notes.

(*m*) An office of the Attorney-General.

(*n*) See Pr. Forms, VIII.

(*o*) This sum of money is applied to the costs of the hearing of both parties. If the letters patent are stopped, to the fees which the petitioner has paid, and which would have been saved to him had the opposition taken place at the report, instead of at the bill. The remainder is returned to the opponent. *Post* 73, n. *l*.

(*p*) See Pr. Forms, IX.

(*q*) This course is enacted by 27 H. 8, c. 11, s. 1. See Statutes, *post* 33.

(*r*) See Pr. Forms, X. *post*.

where a warrant is made to the Great Seal, under the hand of the clerk of the Privy Seal, and sealed with the Privy Seal and directed to the Lord Chancellor (*s*). This is called the Privy Seal Bill (*t*).

The Privy Seal Bill goes to the Lord Chancellor's Office. Formerly it went to the Hanaper Office, but this is now dispensed with, except as regards the fees, which are received and paid over by the Lord Chancellor's officer, the clerk of the patents at the Great Seal.

Letters Patent.

At this stage the patent may be for the last time opposed by a party having entered a caveat (*u*). The Lord Chancellor is very averse to an opposition at this late stage, after so much expense has been incurred, and will order the costs to be paid by a party opposing on insufficient grounds, or not appearing to support his opposition, having given notice that he should oppose by entering a caveat (*w*).

If there be no caveat, or the caveat be removed by petition, the letters patent are made out and sealed, as of course (*x*).

For the Channel Isles and Colonies.

If the applicant desires that his letters patent should include the Channel Islands and the Colonies, the petition contains the words "in the islands of Guernsey, Jersey, Alderney, Sark, and Man, and in all your Majesty's colonies and plantations abroad." These are inserted in all the subsequent documents; there is no extra trouble or any additional document: there is an additional expense of about seven pounds (*y*). The time of obtaining a patent is from one month to six weeks, and the expense about 110*l.*

Letters Patent for Ireland.

The routine of practice for letters patent for Ireland, differs occasionally from the preceding. The first step is a similar petition and declaration, which is referred to the Lord Lieutenant of Ireland; on his report the Queen's letter is granted, which is the corresponding document to the Queen's warrant. The Queen's letter goes back to Ireland, and the letters patent for Ireland are granted under the Great Seal of Ireland.

The time of obtaining an Irish patent is five or six weeks, and the expense 130*l.*

(*s*) This is enacted by 27 H. 8, c. 11, s. 2.

(*t*) Pr. Forms, XI.

(*u*) Pr. Forms, XII.

(*w*) As to opposition at the Great Seal, see Pr. Forms, XII., and notes.

(*x*) Pr. Forms, XIII.

(*y*) The Channel Islands are "within these realms," and have been included in several recent patents. They were introduced on the solicitation of Mr. Carpmael, by Sir J. Campbell, Attorney-General, and Sir R. M. Rolfe, Solicitor-General, into letters patent granted November 1838.

An act of the colonial legislature is necessary to enable questions arising under the letters patent to be tried in a colonial court of justice, otherwise full proceedings must be in our courts here. The instances of applications for an act of the colonial legislature are very rare. It was done in the case of Hague's patent for expelling molasses from sugar.

The exclusive privileges cannot be preserved to an inventor in those territories abroad which are not colonies or plantations, as in the East Indies, without an express act of the Supreme Government.

For Scotland. To obtain letters patent for Scotland, a similar petition is prepared, and declaration before a justice of the peace in Scotland. This is referred to the Lord Advocate, upon which the Queen's warrant is granted, which is a substitution for the Queen's bill, and the letters patent are passed at Edinburgh under the Seal appointed by the treaty of Union to be used in place of the Great Seal of Scotland.

The time requisite for a Scotch patent is about six weeks, and the expense 80*l.*

The whole expense of letters patent for the three countries is about 350*l.*, exclusive of the cost of the specification and its stamps. The specification requires a stamp of 5*l.*; and if it contains 2160 words or upwards, an additional 1*l.* stamp for every entire quantity of 1080 words, over and above the first 1080. The stamp on the specification for Ireland is 1*l.*

Enrolment of Specification. The letters patent being sealed for the respective countries, any publication of the invention may be made without prejudice to the rights intended to be secured. The patentee must prepare his specification, which must be enrolled according to the terms of his patent, at the latest on the day on which the number of his months expire, exclusive of the day of the date of the letters patent. A certificate of enrolment is indorsed on the specification, the original copy of which is returned to the party as soon as enrolled (*z*).

(*z*) As to computation of time, see *post*, Pr. F. XIII., n. *h.* and for practice, Pr. F. XIV.

The enrolment cannot be dispensed with, except by act of parliament. Letters patent had been granted, A.D. 1812, to James Lee, for certain new methods of preparing hemp and flax, with a proviso for the enrolment of the specifications within fifteen months. An act of parliament was obtained for dispensing with this proviso, and substituting others, on the grounds that, if the specifications should be enrolled in the usual manner, foreign agents might obtain copies of them, and send them abroad. The specifications were to be deposited, sealed up, with the Lord Chancellor, the Lord Chancellor of Ireland, and the Lord Chief Baron of the Exchequer in Scotland, who were to appoint persons to examine and take charge of them. 53 G. 3, c. 179. (*L.* and *P.*)

The Lord Chancellor, *Eldon*, observed, that this case was a very peculiar one, being intended to secure to the state, in time of war, the benefit of a most important discovery. That in his opinion, the legislature would pause a long time, before they passed such an act in future. In re *Lacy*, 29 Rep. Arts, N. S. 250.

Applications to this effect have frequently been made to the Lord Chancellor, and refused.

A petition that the enrolment might be dispensed with, or some provision made for preventing the specification being made public, on the grounds that foreigners would obtain the invention, was dismissed. Ex parte *Koops*, 6 Ves. 595.

Lord *Eldon*, L. C.: "How can I do this? Either upon this or some other case, in the last session, a clause for this purpose was inserted in an act of parliament; and upon the motion of Lord *Thurlow*, upon reasons applying not only to that, but to all cases, and seconded by Lord *Rosslyn*, the clause was universally rejected, and rejected as it appeared to me upon very substantial grounds, in which I readily concur. As to the worth of the apprehension suggested, a man has nothing more to do than to pirate your invention in a single instance; and he will then force you to bring an action, and then the specification must be produced.

"But with regard to the King's subjects, a very strong objection occurs, which makes it necessary that the specification should be capable of being produced. They have a right to apply to

Amendment under 5 & 6 W. 4, c. 83.

11. It will not unfrequently happen that the patentee may discover some defect in the title of his invention, or in the specification, or some inconsistency betwixt the brief description of the invention in the letters patent, and the full and particular description in the specification. Time is given for preparing the specification, on the principle that the inventor has not, when the letters patent are applied for, brought his invention to that degree of perfection that he is supposed capable of doing; he may then only have conceived the idea of effecting something beneficial to the public, and the means by which he would then propose to carry it out into practice may be greatly inferior to those which, when experiments can safely be made, as in the interval allowed for specifying, will readily suggest themselves; and the patentee is bound to give the most improved state of his invention at the time of enrolling the specification (*a*). If his title is insufficient to include all the improvements afterwards specified, or if it be more extensive than the claims of his specification, the letters patent are invalid, until amended by disclaimer or memorandum of alteration. Other defects also, as want of novelty in some part, insufficient description, ambiguous terms, uselessness of parts, inadequacy of means, indefinite claims, surplusage, no proper distinction between new and old, or some objections to the specification as a true, full, clear and faithful account of the invention, may have crept in, and it may be necessary or advisable to resort at once to the provisions of amendment afforded under the statute.

If such defects should exist as would invalidate the letters patent, the patentee has no remedy for any infringement on his invention, until the letters patent and the specification have been amended; for he has no privileges which can be violated, so long as these instruments are void in law, by reason of the failure of some of the conditions of their validity. The practice as to entering disclaimers or memorandums of alteration is regulated by the statute, and by the rules laid down by the Attorney and Solicitor-General. The statute requires, that the party wishing to enter such disclaimer or memorandum of alteration, should first obtain the leave of the Attorney or Solicitor-General in the case of an English patent, of the Lord

Practice under 5 & 6 W. 4, c. 83, s. 1.

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the patent office to see the specification, that they may not throw away their time and labour, perhaps at a great expense, upon an invention, upon which the patentee might afterwards come with his specification alleging an infringement of his patent; when, if those persons had seen the specification they never would have engaged in their project. The enrolment is, therefore, for the benefit of the public." *Ibid.*

The specification may be enrolled at the Enrolment, Rolls Chapel, or Petty Bag Office.

(a) See per Lord *Tenterden*, C. J. *Bailey*, J. and *Littledale*, J., in *Crossley* v. *Beverley*: *Tindal*, C. J., in *Jones* v. *Heaton*; and *post* Pr. F. XIV. n. *a*.

Advocate or Solicitor-General of Scotland in the case of a Scotch patent, and of the Attorney or Solicitor-General for Ireland in case of an Irish patent. The Attorney or Solicitor-General requires the party to present a petition, setting forth the proposed disclaimer or memorandum of alteration. A time will be appointed for the hearing, and the Attorney or Solicitor-General will in their discretion accede to or refuse the prayer of the petition, or direct the party to advertise the application, and then at a subsequent hearing finally dispose of it (*b*).

Confirmation of letters patent under 5 & 6 W. 4, c. 83, s. 2.

12. Should the defect be such as cannot be cured by disclaimer, or memorandum of alteration, recourse must be had to the powers given to the Crown by the second section of the statute, of confirming the letters patent, or of granting new letters patent. These powers may be exercised on the Judicial Committee of the Privy Council reporting in favour of their exercise, in cases in which a jury shall have found, or the patentee or his assigns shall have discovered, that the patentee was not the first inventor, by reason of some other person having invented or used the invention, or some part thereof.

It has been seen, that the subject-matter must possess the incidents of novelty and non-user, and that the grantee must be the true and first inventor. The failure of any of these conditions, either in respect of the subject-matter, or of the grantee, for any part of the invention, will vitiate the grant. If this defect relates only to some part of the invention, it may in general be removed by disclaimer, or memorandum of alteration; but if it relates to the substantial and material part of the invention, it can only be cured by petition to the Crown to confirm the letters patent, or to grant new letters patent. It is altogether in the discretion of the privy council to make any recommendation at all in accordance with the prayer of the petition, and the adoption of one in preference to the other will depend on the peculiar circumstances of the case.

But before such a recommendation will be made, the Judicial Committee of the Privy Council must be satisfied that the patentee believed himself to be the first and original inventor, and that the invention was not publicly and generally used before the date of the first letters patent (*c*). The power thus given to the Judicial Committee of the Privy Council, extends to cases far beyond any decisions at law. The courts have only extended the doctrine of non-user, or want of publication, to the case of

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(*b*) See Statutes, *post* 53, n. *g*, and for practice as to amendment and form of disclaimers, &c., Pr. F. XV., and notes.

(*c*) See Statutes, *post* 55, n. *n*., and for proceedings, Pr. F. XVI., and notes.

inventions being used or known in secret, and which could not be said to be in public use or exercise. The privy council will not exercise their power under this section, so far as to recommend a confirmation of letters patent to the prejudice of any prior inventor, if such inventor has published his invention to the world, under the protection of letters patent(*d*); but they will exercise their power in cases of some minute portions only having been used, and where the petitioner swears that he did not know of such user(*e*); and they will also recommend a confirmation in a case of publication, where a description of the invention is only contained in a book little known, as a French work, deposited in the British Museum(*f*).

Many of the patents which have been repealed on very slight evidence, for want of novelty, or on the ground of the grantee not being the true and first inventor, would now be confirmed or secured to the patentee, under the powers given to the Crown by the recent statute(*g*).

Practice as to confirmation.

The party applying under this section, must advertise his intention prior to presenting the petition to her Majesty. This petition is referred to the Judicial Committee of the Privy Council. After due notice, the petitioners and any opposing parties will be heard, and the privy council will exercise their discretion as to the whole matter of the petition(*h*).

Extension of term.

13. The term of letters patent has frequently been extended by act of parliament, under special circumstances, as where part of the term originally granted had been spent by the patentee in experiments to bring his invention to perfection; or where the patentee has received no remuneration for his labour, or return for his capital, or adequate reward for his invention; or where he is threatened with impending ruin from the great debts incurred by reason of his invention; or where he has met with extraordinary opposition in introducing his invention, and

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(*d*) In re *Westrupp* and *Gibbins'* patent. 5 Rep. Arts, N. S. 227, where a petition under this section of the statute was dismissed with costs. See Statutes, *post* 56, n. *n*.

(*e*) Per Lord *Wynford*. *Ibid*.

(*f*) In re Baron *Heurteloupe's* patent. *Ibid*.

(*g*) The peculiar evils which this and the preceding section are calculated to remedy, are thus described by Mr. Rotch: "It often happens that a person invents a machine (for spinning cotton suppose), which, for want of just exactly the right thing, does not act; he tries it; it is a complete failure; some eight or ten years afterwards every body is trying who can save an hour in the spinning of cotton; it is likely a second person may invent the same thing, or may catch at the same principle. He adopts a different mode of carrying it into effect, and, being a little more clever than the other, he hits on the point the other wanted, and makes his a most valuable invention. He takes out his patent for it, and the other man comes and says, I made such and such wheels, and put them together for the same purpose ten years ago. I did this much of it, and the patent is upset." Parl. Rep. 114.

(*h*) See Rules of Practice, *post* 63; and Pr. F. XVI., and notes.

incurred very heavy law expenses in protecting his rights; or where time would be required to bring an invention into use, and the patentee having died after completing the machine, it could not be worked without a fresh grant (*i*).

But now, under the fourth section of the statute (5 and 6 W. 4, c. 83), this power, exercised only by the legislature, has been delegated to the Crown on the recommendation of the privy council, and her Majesty, on such recommendation, may grant new letters patent for a term not exceeding seven years. The privy council, in the exercise of their discretion, as to recommending an extension of the term of letters patent, have adopted the same principles for their guidance, as to the special circumstances, as the legislature followed. In the cases which have hitherto occurred, the privy council have required a strong case of hardship, and also a strong case as to the utility of the invention, to be established to their satisfaction (*k*).

Practice as to extension of term.

The practice for obtaining a prolongation of the term is regulated by the statute, and by rules issued by the Judicial Committee of the Privy Council. Notice is first to be given, by advertisement, of the intended application; a petition is to be presented to her Majesty, which will be referred to the Judicial Committee of the Privy Council. At the time appointed for hearing, all parties who have complied with the rules of practice, as to service of copies of petitions, and delivery of notice of objections, will be heard. The privy council will exercise their discretion as to costs of the opposition (*l*).

Amended practice, 2 & 3 Vict. c. 67.

The statute (5 and 6 W. 4, c. 83, s. 4) required the application, by petition, to be made and prosecuted with effect before the expiration of the term originally granted in the letters patent. But the latter part of this condition is repealed, and now it is only required that the petition be presented six calendar months before the expiration of the term, except under special circumstances, and then a petition, presented before the expiration of the term, is sufficient (*z*).

Property in an invention.

14. The law recognises the principle of an inventor having some interest in his invention, before it is protected by letters patent. The amount of this interest cannot be distinctly defined, but it is in law such an interest as will enable the

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(*i*) See 16 G. 2, c. 25; 23 G. 2, c. 33; 15 G. 3, c. 52; 15 G. 3, c. 51; 17 G. 3, c. 6; 47 G. 3, c. 131.

(*k*) See *post* 58, n. r, and Pr. F. XVII.

From a return made to parliament, 2 March, 1840, it appears that seventeen applications had then been made to the privy council, and the terms of twelve extended for different periods, and on special conditions. In one case, Downton's, the new letters patent were granted to the widow, the special circumstances being, no adequate remuneration during the life-time of the patentee, owing to the want of capital.

(*l*) See Pr. F. XVII., and notes.

(*z*) Statutes, *post* 61.

inventor to make some agreements respecting the invention, for breach of which he may recover damages. This principle cannot be deduced from any notion of equity as to the inherent rights of the first inventor, such rights being the result of positive enactments (*a*), but must be referred to the general principle of the common law, that there is no injury without its corresponding remedy. If an inventor, about to take out a patent, inform another of his secret under an agreement or bond conditioned in a penal sum not to disclose the secret, or to take any undue advantage of the communication, and that person publish the secret, or obtain letters patent for the invention in his own name, the inventor will have sustained a substantial injury, and may maintain an action for a breach of the agreement (*b*).

Property in letters patent.

But the interest or property in an invention protected by letters patent is that derived under and by virtue of the letters patent themselves. This interest or property is personal; a patent right being a personal chattel (*c*).

Assignment.

The letters patent are granted to the patentee, his executors, administrators and assigns, for the term of fourteen years; hence a temporary property is vested in the patentee or his personal representatives. The assignments which may be made are of two kinds, either by the act of the party, or by the operation of law; and a complete assignment confers as absolute a title as the patentee himself possesses, and the assignee may sue for any infringement in his own name.

Assignment of share.

Also, any share of the letters patent may be assigned, but the subdivision of interests, by way of assignment or the multiplication of shares, is subject to an express proviso for avoiding the letters patent, "if at any time hereafter these our letters patent, or the liberty and privileges hereby by us granted, shall become vested in or in trust for more than the number of twelve persons, or their representatives, at any one time, as partners, dividing or entitled to divide the benefit or profit obtained by reason of these our letters patent, reckoning executors or administrators, as and for the single person whom they represent, as to such interest as they are or shall be entitled to in the right of their testator or intestate."(*d*) The effect of this clause is to preclude a partnership of more than twelve persons, but it extends only to alienations or assignments by

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(*a*) It has been held on demurrer to a bill in equity, that no exclusive right can exist in a subject-matter not protected by letters patent. Per Sir *J. Plumer*, V. C. *Canham* v. *Jones*. See also *Williams* v. *Williams*.

(*b*) See *Smith* v. *Dickenson*.

(*c*) See 2 Bl. Com. 386 & 407.

Letters patent are devisable by will, and assets in the hands of an executor or administrator. *Williams's Executors*, 583.

(*d*) *Post* 82, notes *n* and *o*.

act of the party, and not to an assignment by operation of law, as to assignees under a commission of bankruptcy (*e*).

The privilege under letters patent being in the nature of an incorporeal hereditament, any assignment, either of the whole or of part, must be by deed (*f*).

Bankruptcy.

On the bankruptcy of the patentee, or of the assignee of the whole or of a share in a patent, the letters patent, or the particular share, become vested in the assignees as the representatives or trustees of the bankrupt. The assignees are the representatives of the bankrupt, and not of the creditors, as regards the share or interest in the letters patent. The creditors cannot in any sense be considered as partners, being only entitled to claim the amount of their debts, which may be settled from some other source; they can never have that participation in the profit or loss which is essential to a partnership.

Also, if a person having letters patent mortgage or assign them, but continue in the notorious use of the invention until his bankruptcy, this patent right would pass to the assignees (*g*).

If the bankrupt be uncertificated, and obtain other letters patent before obtaining his certificate, the property in these letters patent will vest in the assignees by relation to the assignment (*h*).

Insolvency.

The interest of an insolvent in letters patent will pass under the conveyance and assignment executed by him to the provisional assignee. Also, the interest of the insolvent in any future letters patent which he may obtain, will be the property of such provisional assignee, and liable to be seized under the execution which may, by permission of the court, be taken out upon the judgment entered up in one of the superior courts against any such person in the name of his assignee upon the warrant of attorney (which before any adjudication in the matter of his petition he is required to execute), to confess judgment for the amount of the debts stated in his schedule, or so much thereof

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(*e*) See *post* 82, n. ; also *Bloxam* v. *Elsee*, and *Cartwright* v. *Amatt*.

(*f*) For deed of assignment, &c. Pr. F. XVIII., and notes.

(*g*) Per Lord *Eldon*, L. C., who directed the case to be argued in the King's Bench, which was never argued. *Holroyd on Patents*, 141.

It has been held, that if the printer and publisher of a newspaper assign his interest therein to a creditor as a security, but continue to print and publish as before, and no affidavit of the change of interest be delivered to the commissioners of stamps, and the printer become bankrupt, the right to the paper will pass to his assignees under the assignment of the commissioners. *Longman* v. *Tripp*. 2 N. R. 71.

(*h*) The assignees of an uncertificated bankrupt, in their own names, execute a deed with other creditors, whereby they and all the creditors who might sign the said deed releases the bankrupt from all actions, suits, claims and demands against him or his estate, and such deed was not signed by all the creditors of the bankrupt—held, that the assignees were not barred from claiming as assignees the benefit of a patent right previously obtained by the bankrupt. *Hesse* v. *Stevenson*.

as shall appear at the time of executing the warrant of attorney to be due and unsatisfied (*i*).

Execution under *fi. fa.*

A patent right may be seized and sold in execution by the sheriff under a *fieri facias*, being in the nature of a personal chattel.

Trust.

Letters patent, in the same manner as other personal property, may be held in trust for the benefit of others, subject only to the condition previously mentioned of its not being in trust for more than twelve persons as partners. The doubt which is often quoted as expressed by Lord Thurlow on this subject was called forth under very peculiar circumstances, and does not appear to have been alluded to in any other cases in which trusts have been declared (*k*).

It has been doubted, in a recent case, whether letters patent, taken out on a secret trust to be held for the benefit of a real inventor who was an alien enemy, were void or not (*l*). To hold that such a trust could not exist, would appear contrary to the spirit and policy of the patent law, in recognising communications from foreigners as good subject-matters for letters patent; but no action could be maintained by such alien, or by the trustee on his behalf on any contract (*m*).

Mortgage or lien.

Letters patent may also be the subject of a mortgage or lien, and a mortgage is not within the proviso against subdivision, for neither the interest of mortgagees, as creditors of the patentee, nor their character as trustees until repaid, will cause a forfeiture, for they are not entitled to any share of the patent right as partners, but only to the amount of their debts.

Licenses.

15. Another and far more general mode of conferring an interest under the letters patent, is by licenses from the patentee to use the invention.

The granting of licenses is a privilege derived directly from the express words of the letters patent, which are granted to the patentee, his executors, administrators and assigns, who with such others as they shall agree with, and no others, have license and authority to exercise the said invention. From this express clause of the letters patent results the power of licensing. A license may be sole or exclusive, that is, may be granted to particular persons and their assigns, to use the invention within a particular district, or it may in ordinary terms give the power of using the invention without any restriction as to the patentee granting other licenses, or it may be strictly personal.

(*i*) 7 G. 4, c. 57, s. 11 & 57, and 1 & 2 Vict. c. 110.

(*k*) In *Cartwright* v. *Amatt* no objection was raised on these grounds. *Post* 99, n. *e*.

(*l*) The court gave no opinion on this objection in *Bloxam* v. *Elsee*.

(*m*) On the ground that the resulting moneys might be employed against the country. 6 T. R. 23; 2 Ves. & B. 323.

Nature of the interest.

The nature of the interest which a licensee can acquire is the privilege of user; he has no share in the letters patent, and is in no respect a partner entitled to divide profits and loss; hence any number of licenses may be granted, since each creates no direct interest in the patent.

Exclusive license.

The patentee may grant a sole or exclusive license of his invention in terms as general as the letters patent themselves, that is, he may license one person solely to use the invention, or part of the invention, in Great Britain, &c., or within particular districts only of the geographical extent of his own privileges. An opinion was very generally entertained that a license of this exclusive nature might invalidate a patent, should the number of parties interested exceed twelve; but in a very recent case, the Court of Exchequer gave a unanimous judgment to the effect, that an exclusive license was no more than a common license, and that the grant of an exclusive license to use a patent does not invalidate the patent itself, although the patent may be vested in twelve persons; and that it is wholly immaterial to its validity in what number of persons such a license is vested, whether exclusive or not, and that such a license would not be invalid if the districts or district covered by the license included the whole extent of country for which the patent was granted. The principle of this decision was, that a license is no part of a patent (*n*).

Rights and remedies of licensee.

The only right which the licensee can acquire under letters patent being a right of user, he cannot sue for any infringement, and consequently a patentee should covenant in the license deed, to sue all infringers. But a licensee would be able to recover for any special damages which he may have sustained (*o*).

A licensee will not, in general, be released from the covenants of his license deed by reason of the invalidity of the letters patent in law, and he will not be permitted, in answer to an action for the recovery of payments reserved under the license deed to deny what he had previously admitted under his hand and seal, as to the validity of letters patent under which he has had enjoyment (*p*). Under such circumstances, always supposing no fraud to have been practised upon him, the licensee should repeal the letters patent by *scire facias*, and then apply to a court of equity to be relieved from his contract.

(*n*) The following are the leading features of this very important case:

Letters patent were vested in twelve, as partners; an exclusive license granted by them for a district became assigned to a company of more than twelve, and twelve other such licenses were granted. See *post* 83, n. *p*.

(*o*) Per Lord *Eldon*, L. C.: "If the patents should be determined good, damages might be recovered, not only by the patentees, but by the persons who have obtained licenses from them." *George* v. *Beaumont & others.*

(*p*) See Pr. F. XIX. n. *b*.

Infringement.

16. The letters patent grant that the patentee and his representatives, their servants, and such others as they shall agree with, may exercise certain privileges, and prohibit all others from exercising the same privileges without their consent. The words used in the granting part are, make, use, exercise, and vend; the words in the prohibitory part are more explicit, and that clause commands all other persons that, during the term of fourteen years thereby granted, they neither directly nor indirectly make, use, or put in practice the said invention, or any part of the same, nor in any wise counterfeit, imitate, or resemble the same, nor make or cause to be made any addition thereunto, or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, deviser or devisers thereof (*z*). A breach of any part of the foregoing clause is an infringement of the letters patent, for which damages may be recovered. The words of the prohibitory part are quite sufficient to include all acts necessarily injurious to the patentee, but cases may arise, as for instance an exposure to sale (*a*); or a sale under certain circumstances, as for instance where a patent article is sold as part of the effects of a person (*b*), or where a sale takes place by operation and authority of law, as in the case of bankruptcy or insolvency, which are not included in this clause, and which, from the restraint on public convenience, without any correspondent advantage to the patentee, are not within its spirit (*c*).

The question of infringement frequently involves distinctions of great nicety and difficulty.

When the subject-matter of the patent is a new machine or a thing produced, little difficulty will occur, as competent witnesses can speak positively as to the former, and the inability or refusal of the alleged infringer to point out another mode of producing, will be evidence as to the latter, from which a jury may infer infringement. But where the substantial part of the invention consists in the application of some well-known principle of physics or mechanics, contradictory evidence may be given, and questions of great difficulty both of law and fact be involved (*d*).

The carrying out into practice the same principle by means very similar, will be a colourable evasion, and consequently an infringement; and also any slight departure from the specification; but not if the departure be material. Identity of pro-

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(*z*) *Post* 78.
(*a*) See *post* 77, n. *e*.
(*b*) Per Lord *Eldon*, 6 Ves. Jun. 708.
(*c*) See *post* 78, n. *g*.
(*d*) See *post* 79, n. *g*, where the principal cases on this point are collected.

ducts, coupled with the conduct of the defendant, as refusal to permit inspection of his manufactory, are grounds for presuming that the machines are the same(*e*).

The unauthorized use of the name of the patentee is an infringement, and a penal offence by the recent statute(*z*).

Remedies.

17. An infringement of letters patent is prohibited by the clause contained in the letters patent, upon such pains and penalties as may be justly inflicted on offenders for contempt of the royal command. Prior to the statute of monopolies all questions of this nature were tried in the star chamber, as contempts(*a*) of royal authority; but by the second section of that statute, all monopolies are to be tried by the common laws of the realm.

Hence the remedies which now exist are by bill in equity, and by action at law on the statute.

Bill in equity.

A bill in equity is very frequently first resorted to by a patentee for the protection of his rights. This course is advisable where the patent is really good, since the injunction will prevent further infringement; and if the validity of the patent be questionable, the defendant being restrained until the validity is tried at law, the patentee will be in a better situation than if he had to depend on a jury for damages. Also the trial taking place under the direction of a court of equity, the plaintiff may be in a better situation as to evidence than he would otherwise be(*b*).

A court of equity protects patentees who have had enjoyment and possession under their patent, by restraining the defendant; and the principle upon which the court interferes is, that property in the patent may be inferred from the possession, and that the patentee has been fraudulently treated by the defendant(*c*).

The bill states the invention, the grant, the enrolment of the specification; the novelty and utility; and the infringement by the defendant. It prays an account of the profits, and an injunction that the defendant may be restrained in the infringement. It is also generally part of the prayer of the bill, that the right, if disputed, may be tried and determined at law under the direction of a court of equity; the final object of the bill being a perpetual injunction to restrain the infringement of the right claimed by the plaintiff. But it is not necessary that the

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(*e*) See Lord *Tenterden*, C. J.; *Huddart* v. *Grimshaw*, Dav. P. Ca. 288.

(*z*) 5 & 6 W. 4, c. 83, *post* 60, n. *w*, and Pr. F. XXII.

(*a*) 3 Inst. 183, *post*, and stat. 42, n. *y*.

(*b*) In a recent case, a bill was retained for three years, with liberty for the plaintiff to bring an action, and the defendant was directed to admit that the plaintiff was the assignee of the patent, and that he had assigned it; and the plaintiff was ordered to produce certain deeds, and admit their execution. *Few* v. *Guppy*.

(*c*) Mitf. Eq. Pl. 138, 4th edit. See Bill, Pr. F. XX.

right be established by an action at law before filing the bill, a right under the letters patent being matter of record(*d*).

The bill must state a sufficient case to justify the injunction, and the plaintiff must not depend on the admissions contained in the defendant's answer, for granting or continuing the injunction (*e*).

Injunction moved for

On filing the bill, an injunction is usually moved for and obtained until answer or further order. It is generally granted on the *ex parte* affidavits, and the defendant is commanded either to refrain in future from the alleged infringement, or to keep an account of the proceeds until it can be determined whether the patent is valid, and whether it has been infringed by the defendant. Formerly the court would not interfere, unless the party had a clear legal right, and if an injunction were moved for on filing the bill, the right must have appeared clearly by affidavit, and if moved for on answer, it must have been clearly admitted by the answer, at least not denied. But the severity of this rule is relaxed, and it is now held sufficient if the party can show possession under colour of title; and in claims of right under letters patent, the court has gone further, and granted and continued injunctions until hearing upon possession alone, although the title to the patent may be very doubtful, and a long and exclusive enjoyment will entitle a party to an injunction, until an action can be tried at law(*f*).

Principle of interference.

Affidavits.

The affidavits, in support of the bill for an injunction, must state with particularity the alleged infringement; that the party, at the time of the application, believed himself to be the first and true inventor, for the belief of this, at the time of the application for the letters patent, will not be sufficient (*g*).

Answer.

An injunction having been granted, the defendant in his answer must show, either that the letters patent are void, or that he has not infringed them. If the answer deny the novelty and

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(*d*) A demurrer that the patent has not been established at law, will be overruled. *Hicks* v. *Raincock; Kay* v. *Marshall.*

(*e*) The bill must set forth a sufficient *prima facie* case. *Curtis* v. *Cutts.*

(*f*) In case of patent rights, if a party gets his patent, and puts his invention in execution, and has proceeded to a sale, that may be called possession under it, however doubtful it may be whether the patent can be sustained. This court has lately said possession under a colour of title is ground enough to enjoin and to continue the injunction till it is proved at law that it is only colour and not real title. There have been several instances of late. Can it be said that patent in the case of Boulton and Watt *v.* Bull was not doubtful? The Court of Common Pleas were divided on the validity of it. Upon the first argument in the Court of King's Bench, they were inclined to hold it bad; but they altered their opinion, and decided in favour of it. This court enjoined them all the time during the pendency of the proceedings at law, upon the ground that they had had possession of the invention under colour of the title which a patent, questionable in that degree, gave. Per Lord *Eldon*, 6 Ves. 705. See also *Hill* v. *Thompson; Sturts* v. *De la Rue; Bickford* v. *Skewes.*

(*g*) If this be omitted and the injunction be dissolved, costs will be given. *Sturts* v. *De la Rue.*

utility of the invention, and state (such being the fact) that the specification is imperfectly set forth in the bill, the court will dissolve an injunction previously obtained, giving the plaintiff liberty to bring an action, although the defendant admit by his answer that he has made machines upon the principle of the patent(*h*).

The hearing.

The answer being read, the injunction granted on the filing of the bill may be moved to be made perpetual or to be dissolved, or if refused when the bill was filed it may now be moved for. The court, in the exercise of its discretion, will continue or dissolve or grant the injunction, or will continue it and direct an issue at law to try the validity of the patent, or in dissolving it will leave the party to bring an action at law for the infringement, directing, in either of these latter cases, that an account be kept pending the litigation, or, if the affidavits are very contradictory, dismiss the suit altogether(*i*).

The court, in directing a trial at law, will put the parties upon such conditions as the equity of the case may require. It will order admissions of particular facts and documents; also, an inspection of the defendant's premises and machinery, when the invention is practised in secret(*k*).

After verdict.

After verdict the court will, on motion, revive and make perpetual the injunction, or dissolve the injunction, unless there is reason to believe that the verdict will be disturbed, or a new trial granted(*l*).

If the question be not decided at law, or if the judges be equally divided, the court will direct a new trial, but continue the injunction in the mean time(*m*).

Costs.

The successful party may move for the costs and expenses incurred by a suit, which could not be sustained. When a party is entitled to have an injunction made perpetual, the defendant will have to pay all costs subsequent to injunction, if he did not after the injunction granted tender the costs up to that time(*n*).

Action at law.

18. The course of an action at law, whether the first step by a patentee in the protection of his right under the letters patent, or under the order of a Court of Chancery, is the same.

The action is in form an action on the case for damages, and may be maintained by any person having a legal interest in the patent.

The parties to the action as plaintiffs must have a legal interest in the letters patent, either as patentee or assignee; a

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(*h*) See *Curtis* v. *Cutts*.

(*i*) See *Wood* v. *Cockerill*; *Westhead* v. *Keene*.

(*k*) *Huddart* v. *Grimshaw*; *Bovill* v. *Moore*; *Brown* v. *Moore*; and *Kynaston* v. *East India Company*; *Russell* v. *Cowley*.

(*l*) Per Lord *Eldon*, L. C. 3 Mer. 631.

(*m*) *Boulton & Watt* v. *Bull*, 3 Ves. 141.

(*n*) *Fradella* v. *Weller*.

mere licensee cannot maintain an action for an infringement, though he may recover damages from those exercising the invention without license, should the letters patent be good and valid at law (*a*).

The patentee and assignee may join, or the assignees may sue alone; and the patentee and assignee of part of the patent may join in an action of infringement, for, though the interest be several, the infringement is an entire joint damage to both, for which they may have their entire joint action. If parties not entitled to bring the action join, it is ground of nonsuit; for if they are to recover it must be in respect of a general joint damage, for the courts will not take notice of separate and distinct injuries in one and the same action (*b*).

Venue.

The venue may be laid in any county, but if laid in Middlesex it cannot be changed on the usual affidavit; for the patent being at Westminster, the defendant cannot swear that the cause of action arose wholly in another county, and not elsewhere (*c*).

Declaration.

The declaration states, by way of inducement, the grant of the letters patent, the granting and prohibitory clauses, and the conditions; it then avers performance of the conditions, the exercise of the invention, and assigns the breaches (*f*).

Demurrer and plea.

The defendant may demur, or plead, denying the infringement, and any special matter in bar of the plaintiff's right to recover; as want of novelty, insufficiency of specification; or any matter by way of justification or excuse, as a release, satisfaction, license, or any judgment recovered for the same cause of action, or statute of limitations (*g*). He must be guided as to this by the allegations and breaches in the declaration, and by the evidence which it will be in his power to adduce.

Evidence.

The nature of the evidence will, under the new rules of pleading, depend on the allegations in the declaration and on the pleas. The plaintiff will have to prove, unless admitted under an order of court or of a judge or on the record, the grant, by the production of the letters patent, or by the exemplification of them, that is, a certified copy under seal, the enrolment of the specification, and an examined or office copy of the specification, the original copy returned to the party after enrolment not being admissible in evidence (*h*).

(*a*) Per Lord *Eldon*, L.C.; *George* v. *Beaumont & others.*

(*b*) 2 Wm. Saund., 115 & 116*a*; 2 Wils. 245. The non-joinder of parties who ought to be joined, can only be taken advantage of by plea in abatement. *Addison* v. *Overend*, 6 T. R. 766.

(*c*) See *post*, Pr. F. XXI., n. *b*; *Cameron* v. *Gray*, *Brunton* v. *White*, and *R.* v. *Haine.*

(*f*) Pr. F. XXI.

(*g*) See pleas, Pr. F. XXI.

(*h*) *Ante.* If the specification on being read disclose an invention different from that set forth in the letters patent, the plaintiff will be nonsuited in an action for an infringement, or the Crown will have a verdict in proceedings of *scire facias.* See per *Abbott*, C. J.; *R.* v. *Wheeler.*

If the patent be for an improvement on a former patent, and the specification refers to the former patent, or be not sufficiently clear and intelligible of itself, both must be produced (*i*).

The plaintiff will also have to prove the sufficiency of the specification; that the invention can be practised as described, and must give some evidence of the novelty and utility of the invention, as that persons well conversant with the trade had never seen or heard of the invention before, and that the public give large orders for the article, or that licenses are taken under the letters patent.

The infringement must be proved, or that the defendant has made, used, or put in practice, the invention according to the specification, or made additions or subtractions for the purpose of counterfeiting the invention. The law does not require proof of precisely the same proportions and parts; it is sufficient to prove that the distinguishing characteristics are the same. The conduct of the defendant, also, as refusing to admit his manufactory to be inspected, with other facts, will afford strong presumption that defendant has infringed the plaintiff's invention (*m*).

Evidence for defendant.

The evidence which must be adduced at the trial by the defendant will depend entirely on the allegations in the declaration, and on the matters in issue by the pleas. The plaintiff having made out a *primâ facie* case of infringement, the defendant must show that he has not infringed the patent, that the thing produced or mode of production is materially different from that produced, by pursuing the specification; and if his pleas are sufficient to let in such evidence, may show the insufficiency of the specification, the want of novelty and utility, and any other matters rendering the letters patent void in law (*n*).

Notice of objections.

The defendant must deliver, with his pleas, notice of any objections on which he means to rely at the trial, and he will be precluded at the trial from all evidence which is not fairly included in such notice of objections. It is the object of the

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(*i*) Per Lord *Tenterden*, C.J.: "I cannot say what are improvements in a given thing without knowing what the thing was before. For all the things mentioned in the plaintiff's specification may have been in the former specification." *Lewis* v. *Davis*.

(*m*) Per Lord *Ellenborough*, C.J. "When one sees the rope of the defendant agree in all its qualities with a rope actually made upon the plaintiff's plan, it is *primâ facie* evidence, till the contrary is shown, that it was made on his method." *Huddart* v. *Grimshaw*. Per *Abbott*, C.J. in *Hall* v. *Gervas & Boot*.

(*n*) The law of evidence as to novelty is thus stated by Sir *Vicary Gibbs*, C.J.: "Fifty witnesses testifying that they never saw the invention before would be of no avail, if one were called who had seen it and practised it." *Manton* v. *Manton*.

This rule of law strictly interpreted has led to the greatest injustice towards patentees. Parl. Rep. 114.

But in recent cases juries have been directed to consider whether such evidence can satisfy them as to the want of novelty. See *Lewis* v. *Marling*, and *Cornish* v. *Keene*.

party delivering the notice that it should be comprehensive and general, and of the opposing party to compel as much particularity in every respect as possible, and the courts will require that the notice shall be sufficiently precise and definite to give some distinct information as to the real nature of the evidence that will be adduced, so that the patentee may not be misled, and fail at the trial from the production of evidence entirely unsuspected (*o*.)

Admissibility of evidence.

A licensee is a competent witness for the plaintiff in an action for the infringement of the patent under which he has a license. He has no direct pecuniary interest in supporting the patent, and it may be for his advantage that it should not be supported (*p*). A witness who made a machine may look at a drawing of the machine not made by himself, and be asked whether he has such a recollection of the machine as to say whether the drawing is a correct representation of the machine which he made. But, a model not made by the witness, cannot be produced (*q*).

Verdict.

If the plaintiff obtain a verdict, he will have judgment for damages, which are in the first action only nominal, and his costs (*r*), unless the defendant makes a successful application to the court above for a nonsuit, or for leave to enter the verdict for himself, or for a new trial (*s*).

New trial.

If a plaintiff obtains a second verdict for infringement of the same patent, he is entitled to treble costs, unless the judge certify to deprive him of them (*t*).

Costs.

But no costs are allowed on taxation for the expenses of experiments, nor for the time of witnesses employed in obtaining evidence on points in dispute, and new to scientific men (*u*).

Should the defendant obtain a verdict, the plaintiff may, notwithstanding his acquiescence therein, bring other actions for other infringements until the letters patent are repealed by *scire facias* (*w*). A patentee is protected against the unauthorised

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(*o*) For the cases on this point, see *post* 59; and notice of objections, *post*, Pr. F. XXI.

(*p*) Per Lord *Abinger*, C. B., *Derosne* v. *Fairie*.

(*q*) Per *Bailey*, J., *R.* v. *Hadden*, and *Tindal*, C. J., *Galloway* v. *Bleaden*.

(*r*) If the damages are under 40*s*. the plaintiff will be deprived of his costs unless the judge certify that the action was to try a right, 3 & 4 Vict. c. 24. s. 2.

(*s*) A large proportion of cases, in which the plaintiff has been successful, have been moved in the court above, on points reserved, and other grounds. The courts are extremely averse to granting new trials in cases of so expensive a nature as patent cases; and they will seldom do it, except under very peculiar circumstances and upon special terms. See *Derosne* v. *Fairie*.

If the grounds are such as vitiate the patent, the court will direct the defendant to have recourse to the proceedings by *scire facias* for its repeal. See per Lord *Tenterden*, C. J., *Lewis* v. *Marling*; and *Tindal*, C. J., *Haworth* v. *Hardcastle*.

(*t*) See *post* 57, n. *o*.

(*u*) See *Severn* v. *Olive*, 3 Br. & B. 72.

(*w*) The plaintiff had a verdict in *Arkwright* v. *Nightingale*, having failed in the first action *Arkwright* v. *Mordaunt*. The patent was subsequently repealed by *scire facias*. *R.* v. *Arkwright*.

Action on the statute.

use of his name by the provisions of the statute (5 & 6 W. 4, c. 83), by which the party so using it is liable to a penalty of £50 (*x*).

Scire facias.

19. The letters patent, so long as they exist, that is, until cancelled by the judgment in a *scire facias*, entitle the patentee to assert his right at law, notwithstanding his having been defeated in other actions. The writ of *scire facias* may be sued out by the Crown, or by any subject who is prejudiced by the grant, and if several letters patent be granted for one and the same subject-matter to several persons, the former patentee may have a *scire facias* to repeal the subsequent letters patent. The proceedings may be instituted on the grounds of fraud, false suggestion, non-compliance on the part of the patentee with the conditions of the letters patent, failure of any of the essential requisites of novelty and utility, or abuse of the privileges granted by the letters patent. A notice of the objections which it is intended to rely on must be delivered with the declaration, and if the verdict be against the defendant, judgment will be given that the letters patent be cancelled, and a *vacatur* will be entered on the enrolment (*y*).

Act of parliament.

20. Applications to the legislature can now be necessary in a very few cases, the statute (5 & 6 W. 4, c. 83) having provided other modes of proceeding for an extension of the term. Should a further extension than seven years be justified by the special circumstances of the case, or should it be wished to assign the patent to more than twelve as partners, or to dispense with any conditions of the letters patent, an act of parliament must be obtained (*z*).

(*x*) See *post* 60; and form of declaration, Pr. F. XXII.

(*y*) See Pr. F. XXIII.; and 4 Inst. 88, 2 Wm. Saund. 72*o*; and *Dyer*, 167*a* 196, 195*a*.

No costs are given. *R.* v. *Miles*, 7 T. R. 367.

(*z*) For the necessary proceedings, see Hand, Godson, 1st edition, or Holroyd on Patents, and the Standing Orders as to Private Bills; also 41 Geo. 3, c. 125 (L. and P).

STATUTES.

18 H. 6, c. 1.

For regulating Grants by the King.

"Whereas by suit made to the King by divers persons, it hath been desired by their petitions to have offices, farms, and other things of the gift and grant of the King by his gracious letters patent thereof to them to be made, desiring by the same petitions the same letters patent of the King, to bear date at a certain day limited in the same, the which day is often long before the King's grant to them made of their said petitions, whereby the King's letters patent to them thereupon made have borne the same date, by reason whereof divers of the King's liege people having such offices, farms, and other things of the gift or grant of the King by his gracious letters patent thereof to them long time before duly made, by such subtle imagination of such ante-dates desired by such petitions of such offices, farms, and other things often have been put out, removed, and expelled, against right, good conscience, and reason." Our said Lord the King, willing to put out such imaginations, by the advice and assent of the Lords spiritual and temporal aforesaid, and at the special request of the said Commons, hath ordained, by authority of the same parliament, that of every warrant hereafter sent by the same our Lord the King, or his heirs, to the Chancellor of England for the time being, the day of the delivery of the same to the Chancellor shall be entered of record in the Chancery. And that the Chancellor do cause letters patent to be made upon the same warrant, bearing date the day of the said delivery in the Chancery, and not before in anywise. And if any letters patent be from henceforth made to the contrary, they shall be void, frustrate, and holden for none (*a*).

18 H. 6, c. 1.

Date of Letters Patent.

(*a*) This is the earliest statute bearing any relation directly to letters patent for inventions; there are several earlier statutes relating chiefly to the regulation of trade, and the grants of lands and offices. See 9 H. 3; 9, 14, 25, 27 Ed. 3; 2, 5, 11 R. 2; 1, 2, 4, 6 H. 4.

The date of the letters patent is of great importance, both as regards the particular patent and other patents. For by a proviso of the letters patent, the specification is to be enrolled within a certain time. *Post*, Pr. F. XIII. n. *r*.

In practice, letters patent bear date the day of sealing, but in case of opposition, the Chancellor will order the prayer of a petition, that the letters patent may bear date the day on which the Queen's Warrant (the Privy Seal Bill) is left with the Chancellor. This is of importance to an opposed party; otherwise an opposing party having a patent for a similar object, may come to the Great Seal last, and if not opposed, obtain it first.

6 H. 8, c. 15.

6 H. 8, c. 15. *An act avoiding second letters patent granted by the King.*

"The King's highness, of his goodness, calling to his remembrance, that where his grace hath granted to divers of his servants (for their service to his grace done), lands, tenements, fees, offices, and other things, to have to them during his pleasure; and after other persons, by their sundry suits, have obtained of his highness other letters patent of the same, not advertising his grace of his former grants, whereby the said former patentees have been avoided, and put from the advantage of their said former grants and patents, contrary to the intent and grant of *our said sovereign lord.*"

What shall be expressed in the King's letters patent, in the case of duplicate grants of the same boon.

Wherefore be it ordained, established, and enacted by our said Sovereign Lord, the Lords spiritual and temporal, and the Commons in this present parliament assembled, and by authority of the same, that if any person or persons from henceforth do make suit to the King's highness for any lands, tenements, offices, or any other things so by his grace granted, or hereafter to be granted to any person or persons during his pleasure, the said first patentee then being in life; that he do express in his said bill of petition or patent, the tenor of the said former patent, and that the King then hath determined his pleasure against the first said patentee; or else the second letters patent of any of the premises to any person hereafter to be granted, to be void and of none effect (*b*).

II. This act to commence and take effect from the fourth day of April next coming, and not before.

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27 H. 8, c. 11.

27 H. 8, c. 11. *An act concerning Clerks of the Signet and Privy Seal*(*c*).

"Whereas the King's clerks of his grace's signet and privy seal, giving their daily attendance for the passing and writing of

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(*b*) Letters patent for inventions are not during the King's pleasure, but only for fourteen years; and a grant of second letters patent for the same subject-matter would be void under 21 Jac. c. 3, and at common law, as well as by this statute.

(*c*) These offices are regulated by 57 G. 3, c. 63, and to be abolished under 2 W. 4, c. 49.

This statute regulates the course of proceedings for passing letters patent. According to the preamble of the statute, it would appear to have been passed for the purpose of insuring fees to certain clerks; but Sir E. Coke speaks of it in the following terms:—"Such was the wisdom of prudent antiquity, that whatsoever should pass the Great Seal should come through so many hands, to the end that nothing should pass the Great Seal, that is so highly esteemed and accounted of in law, that was against

his Majesty's great and weighty affairs, and the causes of this his realm, having for their entertainment and their clerks no fees nor wages certain for those offices, other than such fees as cometh and groweth of the said signet and privy seal; to the intent that from henceforth they should not by any manner of means be defeated of any part or portion of the same their fees:" be it therefore ordained, established, and enacted, by the consent and assent of the Lords spiritual and temporal, and the Commons, in this present parliament assembled, and by authority of the same, that all and every gift, grant, and other writing, which shall be made or given in writing by the King's highness, or any of his most noble posterity, to any person or persons, signed with his grace's sign, or the sign or signs manual of any of them, to be passed under any his grace's great seals of *England*, *Ireland*, Duchy of *Lancaster*, or any of his highness's counties palatines, or principality of *Wales*, or by other process out of the Exchequer, after the fifteenth day of April, in the twenty-seventh year of his most noble reign, and that all and every gifts, grants, and other writings, of what name or names, quality or qualities soever the same be, or hereafter shall be named, deemed, or called, which the master of the King's wards, or general surveyors of the King's lands, for the time being, or any other officer or officers that now be, or hereafter shall be made, shall, by virtue of an act of parliament, or any the King's grants to them or any of them made, or hereafter to be made in that behalf, give, grant, or make, after the aforesaid fifteenth day of April, to any person or persons in the King's name, to be passed under any of his Majesty's seals, be in anywise first, and before the same grant, or any of them, be passed under any the King's said seals, or other process made of the same, brought and delivered to the King's principal secretary, or to one of the King's clerks of his grace's signet for the time being, to be at the said office of the signet passed accordingly (*d*).

27 H. 8, c. 11.

The King's grants shall be brought to the secretary or to a clerk of the signet.

II. And be it also ordained and enacted by the authority aforesaid, that one of the clerks of the signet, to whom any of the said writings, signed with the King's most gracious hand,

A warrant by the clerk of the signet to the lord keeper of the privy seal.

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law or inconvenient; or that any thing should pass from the King any ways which he intended not, by undue and surreptitious means." 2 Inst. 556. Its object has also been stated to ensure that the grants should be carefully inspected by the officers of the crown; but this is obviously futile as regards letters patent for inventions, the grant being at the peril of the grantee; and now, since the practice has been introduced of enrolling a specification, the patentee is judged on his own deed. *Post*, 70. Pr. F. VI.

(*d*) This section provides, that every grant in writing, after signature by the King, and before any seal has been affixed, which in the case of letters patent would be, the bill (*ante*, 14; *post*, Pr. F. IX.) should be brought to be passed at the Signet Office. The Queen's Bill on being passed at the Signet Office, is termed the Signet Bill. *Ibid.*

27 H. 8, c. 11.

or the hand of any other aforesaid, or any of them fortune to be delivered, may and shall by warrant of the same bills, and every of them, within the space of eight days next after he shall have received the same, unless he have knowledge by the said secretary, or otherwise, of the King's pleasure to the contrary, make or cause to be made in the King's name, letters of warrant, subscribed with the hand of the same clerk, and sealed with the King's signet, to the lord keeper of the King's privy seal, for the further process to be had in that behalf; and that one of the King's clerks of the said privy seal, upon due examination had by the said lord keeper of the said privy seal, of the said warrant to him addressed from the office of the said signet as afore, may and shall within the space of eight days next after he shall have received the same, unless the lord keeper of the privy seal do give them commandment to the contrary, make or cause to be made, by warrant of the aforesaid warrant to the said lord keeper of the privy seal,

A warrant from the privy seal to the great seal.

address from the office of the signet aforesaid, other letters of like warranty, subscribed with the name of the same clerk of the privy seal, to the lord chancellor of England, lord keeper of the great seal, chancellor of the duchy of Lancaster, chancellor of the King's land of Ireland, treasurer and chamberlains of the exchequer, and chamberlains of any of his counties palatines, or principality of Wales, or other officer, and to every of them, for the writing and enscaling with such seals, as remain in their custody, of letters patent or closed, or other process making, due and requisite to be had or made upon any the said grants, according to the tenor of the warrant to them or any of them directed from the officer of the privy seal, as is afore specified (*e*).

The penalty for altering of the course aforesaid.

III. And also be it enacted, by the authority aforesaid, that no manner of clerk or clerks, or other person or persons, do write or make any manner of writing, warrant or warrants, upon any manner of gift, or grant, made by the King's highness, or by any other his grace's officers as aforesaid, or procure the same or any of the same to be passed under the seals aforesaid, after any other sort, manner or fashion, or by any other warrant or warrants, than as before specified and delivered, upon pain to forfeit for every bill, warrant or writing, passed contrary to the

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(*e*) By the first clause of this section, the clerk is directed to prepare letters of warrant under his hand and the Signet Seal, to the keeper of the Privy Seal; and by the second clause, the clerk of the Privy Seal is directed to prepare other letters of warrant to the Lord Chancellor. The law takes notice of three seals; the Great Seal, the Privy, and the Signet. 2 Inst. 554.

The Great Seal is in the custody of the Chancellor; the Privy Seal in the custody of the clerk or Lord Keeper of the Privy Seal, and the Signet Seal in the custody of the principal secretary of the Signet. *Ante* 35, n. *c*.

order before limited and prescribed, the sum of 10*l.*; the one-half thereof to be to our Sovereign Lord the King, and the other half to him that shall first sue for the same by action of debt, writ, bill, plaint, or information in any of the King's courts; in which action or suit, no essoin, protection, privilege, nor wager of law, shall be admitted; any manner, act, statute, provision, proclamation, or other ordinance heretofore had or made, contrary to this present act, or any article of the same, in anywise notwithstanding. 27 H. 8, c. 11.

IV. And nevertheless be it also enacted, that every of the said clerks, or other person, which shall pass in writing, or procure to be passed in writing, any grant or grants by immediate warrant, wherefore fees be paid at the great seal, shall of the parties receive for the offices of the said signet and privy seal, as well as such fees as in this act is taxed for writing of any such grant or other writings, as also the fees for the seal of the same; which fees, and every part and portion thereof, the same clerk or clerks, by whom any grant shall pass in writing by immediate warrant, shall upon a bill of the hand of one of the said clerks of the said signet or privy seal, deliver unto one of the same clerks of the signet or privy seal, within the space of three months next and immediately ensuing after the passing and sealing of any of the said grant or grants by immediate warrant, upon pain of 10*l.* to be by every such of the said clerks or other person as shall offend, forfeited, to be levied in form aforesaid, as often as he or they shall offend contrary to the meaning of this act. Fees for writings which pass by immediate warrant.

V. Provided also, that this act, or any thing contained in the same, be not in anywise prejudicial to the lord treasurer of England for the time being, concerning such warrants or precepts as he by virtue of his office shall and may direct immediately to the Lord Chancellor of England, or to any other person or persons for making out of the King's grants or letters patent, to any person or persons, of any offices, farms, or lands, or tenements, or of any other thing belonging to his nomination or disposition; but that as well he may direct his said warrants or precepts for the causes abovesaid, as also his clerk, or clerks, or other person, may procure the same to be sealed under any of the seals aforesaid, without any warrant to be before or after sued or obtained under the King's signet or privy seal for the same, in as large and ample a manner, and after such sort or fashion as he or they might have done at any time before the making of this act; any thing in the same act mentioned to the contrary notwithstanding. This act shall not prejudice the lord treasurer for directing the warrants to the great seal.

VI. (This clause refers to leases of the duchy lands of Lancaster, which may pass under the seal of the same duchy, see 4 Inst. 210.)

27 H. 8, c. 11.

VII. (This relates to the grant of a small office in the duchy.)

VIII. (This section treats of certain trifling fees to the clerk of the signet for writing warrants for tales or reward, gift of offices, pensions, &c.)

The Lord Chancellor may pass instruments without fees.

IX. Provided also, that the Lord Chancellor of England for the time being, shall and may at all times use his discretion in passing and speeding any thing by the great seal, and delivering the same without paying any fees for the great seal, signet, and privy seal, as the case of necessity shall require, and as hath been accustomed; and that the clerks for writing or procuring such writings and patents by his commandment shall be discharged of all penalties expressed before in this act, for not receiving and paying fees to the signet and privy seal; any thing in this act contained to the contrary hereof notwithstanding.

X. XI. XII. (The first of these clauses refers to the officers and clerks of the court of augmentations. The second to the sealing of instruments in the King's private affairs, &c. The last respects grants or leases of farms under the yearly rent of 6*l.* 13*s.* 4*d.*)

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3 and 4 Ed. 6, c. 4.

3 & 4 Ed. 6, c. 4, explained by

An act concerning Grants and Gifts, made by patentees out of letters patent (*f*).

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13 El. c. 6.

13 El. c. 6.

An act that the exemplification or constat of letters patent, shall be as good and available as the letters patent themselves (*g*).

A supply of the statute of 3 & 4 Ed. 6, c. 4.

"For the avoiding of all such doubts, questions and ambiguities, as heretofore have risen and been moved, and of such as hereafter might rise and be moved, in and upon the statute made in the parliament begun and holden at Westminster, the fourth day of November, in the third year of the reign of our

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(*f*) Some doubt being entertained whether this statute applied to patentees themselves, as well as to those claiming under them, it was explained and amended by 13 Eliz. c. 6.

(*g*) These words, exemplification and constat, are used indifferently in the statute; and they differ only in the formal parts of their commencements and conclusions. An exemplification is the same with the *inspeximus*, so called because immediately after the King's style that word follows. It is called exemplification *a re ipsâ*, because the record is thereby exemplified, as appears by the end of it, *duximus exemplificand per præsentes*. The *constat* is so called, because of that word immediately after the King's style. Nothing is exemplified by either of them but the tenor of the record. Also a constat requires an affidavit, but an exemplification none. 5 Co. Rep. 54.

late sovereign lord King Edward the Sixth, intituled, "An act concerning grants and gifts, made by patentees out of letters patent, and for a due and full supply of all such wants as may be thought to be therein." 13 El. c. 6.

An exemplification of letters patent shall be of the same force as the letters patent themselves.

II. Be it enacted and declared, by the authority of this present parliament, that all and every patentee or patentees, their heirs, successors, executors, and assigns, and all and every other person and persons having by or from them, or any of them, or under their title, any estate or interest of, in, or to any lands, tenements, or hereditaments, or any other thing whatsoever, to such patentee or patentees, heretofore granted by any letters patents, either of the most famous princes, King Henry the Eighth, King Edward the Sixth, Queen Mary, King Philip and Queen Mary, or by any of them, or by the Queen's most excellent majesty that now is, at any time sithence the fourth day of February, in the twenty-seventh year of the reign of the said late King Henry the Eighth, or else by the Queen's majesty that now is, her heirs or successors, at any time hereafter to be granted, shall and may, at all times hereafter, in any of the Queen's highness's courts, her heirs and successors, or elsewhere, by the authority of this present act, make and convey, or be allowed and suffered to make and convey, to and for him, them, and every of themselves, such claim or title, by way of declaration, plaint, avowry, bar, replication, or other pleading whatsoever, as well against the Queen's highness, her heirs and successors, and every of them, as against all and every other person and persons whatsoever, for or concerning the lands, tenements, hereditaments, or other things whatsoever, specified or contained in any such letters patent, or of, for, or concerning any part or parcel thereof, by showing forth an exemplification or constat, under the great seal of England, of the enrolment of the same letters patent, or of so much thereof as shall and may serve to or for such title, claim or matter, the same letters patent then being and remaining in force, not lawfully surrendered nor cancelled, for or concerning so much and such part and parcel of such lands, tenements, hereditaments, or other thing, whereunto such title or claim shall be made, as if the same letters patent self were pleaded and showed forth; any law, usage, or other thing to the contrary notwithstanding (*h*).

(*h*) At common law no grant of the King is available or pleadable, unless under the Great Seal. 2 Co. Rep. 166.

Hence the letters patent themselves, with the Great Seal, must have been produced. But by 3 and 4 Ed. 6, c. 4, explained by this statute, patentees and persons claiming under them, may make title in pleading, by showing forth an exemplification of the enrolment of the letters patent, as if the letters patent themselves were pleaded and shown forth. And now they are to be given in evidence in the same manner as if they were pleaded. *Olive* v. *Gwyn*, Hardr. 119.

By these statutes, an exemplification of

43 El. c. 11.

43 El. c. 11. *An act for the confirmation of grants made to the Queen's Majesty, and of letters patent made by her Highness to others.*

I. and II. (Assurances, to or for the Queen, of lands, &c., and letters patent made by the Queen confirmed, and general saving.)

III. (Letters patent to be expounded, construed, deemed, and adjudged most beneficially for the patentee and grantee of the same, and their heirs, assigns, executors and administrators, according unto the word and purport of any the said letters patent (*i*).

IV—VIII. (Relate to letters patent of offices and land.)

IX. (Provides, that nothing in this act shall extend or be taken to make good any letters patent declared void by any writ of law or act of parliament, or any grant of privileges commonly called monopolies.)

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21 Jac. 1, c. 3.

21 Jac. 1, c. 3. *An act concerning Monopolies and Dispensations with Penal Laws, and the Forfeitures thereof* (*k*).

All monopolies, &c., shall be void.

"Forasmuch as your most excellent Majesty, in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did, in the year of our Lord God one thousand six hundred and ten, publish in print (*l*) to the whole realm, and to all posterity, that all grants of (*m*) monopolies (*n*), and of

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the part only which is material, is necessary. But such an extract as would be a surprise upon the party, or deprive him of any benefit he might derive if the whole were produced, is not sufficient. *Attorney-Gen.* v. *Taylor*. Prac. in Chan. 59.

(*i*) The words usually employed in letters patent for inventions would imply at common law what is here expressly enacted. Moreover, the letters patent contain a clause to the same effect. See *post* 76, n. *e*.

(*k*) For the circumstances which led to this passing of the statute, see *ante* 6, n. *r*.

(*l*) This publication was entitled, "A declaration of his Majesty's pleasure, &c." It was published A. D. 1610, out of the King's zeal to law and justice, and states, that monopolies are things against the laws of this realm, and therefore expressly commands that no suitor presume to move the King to grant any of them. 11 Rep. 886. The judgment in the case of monopolies (Darcy's case, *ante* 4, n. *l* and *m*.) was the principal motive for publishing this book, and that book was a great motive of obtaining the royal assent to this statute. 3 Inst. 182. For the definition of monopoly, *ante* 2, n. *e*.

(*m*) In all the reprints of this statute, with the exception of that in Mr. Holroyd's Treatise on the Law of Patents, the word *and* is substituted for *of*. See "Statutes of Realm printed in pursuance of an address of the House of Commons."

(*n*) These terms must be understood according to Sir E. Coke's definition of a monopoly. *Ante* 2, n. *e*. So that a grant of monopoly, according as the term is here used, is a grant for the sole buying, selling, making, working, or using of any thing whereby some persons are restrained of any freedom or liberty that they had before, or hindered in their lawful trade. It is material to attend to the latter part of this definition, since upon it rest the following incidents of a monopoly: 1. That it raises the price of a commodity. 2. That it diminishes its quality. 3. That it impoverishes artificers. 11 Rep. 86 b.

the benefit of any penal laws (*o*), or of power to dispense with the law (*p*), or to compound for the forfeiture (*q*), are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant and agreeable to the ancient and fundamental laws of this realm (*r*): And whereas your Majesty was further graciously pleased expressly to command that no suitor should presume to move your Majesty for matters of that nature; yet nevertheless upon misinformations and untrue pretences of public good, many such grants have been unduly obtained, and unlawfully put in execution, to the great grievance and inconvenience of your Majesty's subjects, contrary to the laws of this your realm, and contrary to your Majesty's most royal and blessed intention so published as aforesaid." For avoiding whereof, and preventing the like in time to come, may it please your excellent Majesty, at the humble suit of the Lords spiritual and temporal, and the Commons, in this present parliament assembled, that it may be declared (*s*) and enacted, and be it declared and enacted, by authority of this present parliament, that all monopolies and all commissions, grants, licenses, charters, and letters patent heretofore made or granted, or hereafter to be made or granted to any person or persons, bodies politic or corporate whatsoever, of or for the sole (*t*) buying, selling, making, working, or using of any thing within this realm or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty to dispense with any others, or to give license or toleration to do, use, or exercise any thing against the tenor or purport of any law or statute, or to give or make any warrant for any such dispensation, license, or toleration to be had or made; or to agree or compound with any others for any

21 Jac. 1, c. 3.

(*o*) It had been the practice to grant to particular persons, all the penalties which the crown should become entitled to, under penal statutes.

(*p*) The dispensing power of the crown was much alluded to in the debate in parliament on monopolies, and is much discussed in our old law books. See *ante* 6, n. *r*; also 7 Rep. 36 *b*.

This is now matter of mere legal curiosity, since the whole doctrine was exploded at the revolution. By the Bill of Rights it was declared "that from and after this present parliament no dispensation by *non obstante* of or to any statute or any part thereof be allowed, but that the same shall be held void and of none effect, except a dispensation be allowed in such a statute."

(*q*) The compounding for forfeitures was a relic of the same practice as the exercise of the dispensing power, and abolished with it.

(*r*) The decisions of the judges in 50 Ed. 3, in Peachie's case, 3 Inst. 85; in 15 Eliz. in Bircot's case, *Ibid.*; and in 44 Eliz. Darcie's case, 11 Co. Rep., and numerous others, had sufficiently established the common law of the realm in respect of grants of monopolies. See *ante* 4, n. *m*.

(*s*) This act is in form declaratory of the common law. The grants hereinafter mentioned were contrary to law, and are by this section declared so to be.

(*t*) The word sole, according to the observation of Sir E. Coke, is here applied to five several things, whereof four are special, and the fifth, sole using, is so general, that no monopoly can be raised but will be within the reach of this statute, and yet for more caution the words "or of any other monopolies" are added, and by reason of these words "sole using," divers provisions are made by this act. The words also "of any thing" are of so large an extent, as to cause some exceptions in the subsequent clauses. 3 Inst. 187.

21 Jac. 1, c. 3. penalty or forfeitures limited by any statute (*u*); or of any grant or promise (*w*) 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 (*x*), and so are and shall be utterly void and of none effect, and in nowise to be put in ure or execution.

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

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

All persons disabled to use monopolies, &c.

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

The party grieved by pre-

IV. And be it further enacted by the authority aforesaid, that

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(*u*) The great inconvenience of the practice here abrogated, appeared in the proceedings of *Empson & Dudley*, in the reign of Henry the Seventh, who had the office of masters of the forfeiture, and by colour of their commission and office did most intolerably and unlawfully oppress the subjects. 3 Inst. 187.

(*w*) Not only is the grant declared void, as contrary to the common law of the realm, but the promise also; for such promise maketh the more violent and undue proceeding against the subject, to the scandal of justice and offence of many. 7 Rep. 36 *b*.

(*x*) This statute does not enact any new law, but merely declares what is the common law.

(*y*) This act having in the preceding section declared all monopolies, &c., to be void by the common law, has provided by this that they shall be examined, heard, tried, and determined, in the courts of common law, according to the common law, and not at the council table, star chamber, chancery exchequer chamber, or any other court of like nature, but only according to the common laws of the realm, and not otherwise. For (according to Sir E. Coke) such boldness the monopolists took, that often at the council table, star chamber, chancery and exchequer chamber, petitions, informations, and bills, were preferred, pretending a contempt for not obeying the commandments and clauses of the said grant of monopolies and of the proclamations concerning the same. 3 Inst. 182, 183.

The court of the star chamber considered all infringements of patents and grants of the crown as contempt of royal authority, and on that principle supported any patent the crown thought fit to grant.

(*z*) Sir E. Coke observes, that this section for further extirpation of all monopolies, disableth all men to have, &c., that is, to take any monopoly, or to use, exercise, or put in use, any monopoly; whereby the wish and desire of the poet, "*Funditer extirpa*" is fully realized. 3 Inst. 183.

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

text of a monopoly, &c., shall recover treble damages and double costs.

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

(*a*) The remedy under this section by action on the statute, to parties grieved by pretext of monopoly, is practically superseded. Many of the terms and pro-

Letters patent heretofore granted for twenty-one years for new manufactures, saved.

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

Letters patent hereafter to be granted for fourteen years, for new manufactures, saved.

VI. Provided also, and be it declared and enacted, that any declaration before-mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under (*c*), hereafter to be made, of the sole working or

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ceedings, as aid-prayer, order of restraint, wager of law, are either unknown in modern practice or abolished by statute. See 3 Inst. 183.

The imparlance, which meant extension of time to plead till next term, is abolished by 2 W. 4, c. 39, s. 11.

The concluding clause of this section, Sir E. Coke observes, extends to the judges of the courts, and is more general than the one immediately preceding, which extended to the courts generally, but, as was resolved by a committee of the House of Commons, did not extend to the judges. 3 Inst. 183.

(*b*) Letters patent for inventions depend on the exceptions in this and the following section. The words of the two sections are the same, excepting that one relates to grants in existence at the time of passing the statute, the other to grants to be made afterwards. The whole act is declaratory; and as Lord Coke observes, "if any of the seven qualities stated in this section fail, the grant is void; and yet this act, if they have all these properties, sets them in no better case than they were before." 2 Inst. 184.

As to these seven qualities, see the notes to the following section.

Sir E. Coke makes the following observations respecting the excepted grants. "The cause wherefore the privileges of new manufactures, either before this act granted, or which after this act should be granted, having these seven properties, were not declared to be good, was for that the reason wherefore such a privilege is good in law, is because the inventor bringeth to and for the commonwealth a new manufacture by his invention, cost, and charges, and therefore it is reason that he should have a privilege for his reward, and encouragement of others in the like for a convenient time; but it was thought that the time limited by this act was too long for the private before the commonwealth should be partaker thereof, and such as served such privileged persons by the space of seven years in making or working of the new manufacture (which is the time limited by law of apprenticehood) must be apprentices or servants still during the residue of the privilege; by reason whereof such numbers of men would not apply themselves thereunto as should be requisite for the commonwealth after the privilege ended. And this was the true cause wherefore, both for the time passed, and for the time to come, they were left of such force as they were before the making of this act." 3 Inst. 184.

(*c*) The longest term for which letters patent can be granted, since this statute, is fourteen years; prior to 5 and 6 W. 4, c. 83, the term could be extended only by act of parliament, but under the 4th section of that statute, the crown, on a recommendation of the privy council

making (*d*) of any manner of new manufactures (*e*) within this realm (*f*) to the true and first inventor and inventors of such manufactures (*g*), which others at the time of making such letters patent and grant shall not use (*h*), 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 (*i*). The said fourteen years to be accomplished from the date of the first letters patent or grants of such privilege hereafter to be made, but that the same shall be of such force as they should be if this act had never been made, and of none other (*k*). 21 Jac. 1, c. 3.

VII. Provided also, and it is hereby further intended, declared, and enacted by authority aforesaid, that this act, or any thing This act not to extend to grants sanctioned by parliament.

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that the term should be extended, may grant new letters patent, for a term not exceeding seven years. See statute *post* 57, and Pr. F. XVII.

(*d*) The words of the letters patent are, "make, use, exercise, and vend" (*post* 77); these must be looked to in the interpretation of the words "working and making" of the statute. The former of these words has a more extensive signification than the latter, and includes what the latter, without the context, might not, as a peculiar mode or method of operating with known materials. See n. *e*.

(*e*) The words of the statute are sufficiently general to include every improvement in the arts and manufactures, as the following cases, since the statute, will show. For the cases prior to the statute, see 4, n. *m*.

I. As to what is a proper subject-matter.

Ramsaye's patent (A.D. 1630) for new inventions; among others, "To raise water from low pits by fire:" "To raise water from low places, and mynes, and coal-pits, by a new waie never yet in use." See Parl. Rep. 168.

Savery's patent (A.D. 1698), for his invention, "of great use and advantage for draining mines, serving towns with water, and for the working all sorts of mills, where they have not the benefit of water nor constant winds." This patent was extended by 10 and 11 W. 3. c. 31 (P).

Taite's patent (A.D. 1734), for an "engine for making stone pipes;" declared valid, and vested in Elwick, with an additional term of fourteen years, by 16 G. 2, c. 26 (P).

Cornwall's (A.D. 1712), for "a dredging-machine," secured to his children after the term expired, by 22 G. 2, c. 33 (P).

Dollond's patent (A.D. 1758), for "a new method of making the object-glasses of refracting telescopes." This patent was sustained, but some subsequent judges doubted its validity, on the ground of its title being for a method. But *Buller*, J. "Dollond's telescopes are certainly a manufacture within the statute; they consist of principles reduced into form and practice, and the patent is for glasses completely formed, not for mere principles. The specification describes the manner in which the invention is to be carried into effect, with all the perspicuity of which the thing is capable;" and also *Heath*, J., "I consider Dollond's patent to be substantially for an improved machine—a patent for an improvement of a refracting telescope, and a patent for an improved refracting telescope, are in substance the same." 2 H. Bl. 463.

It will frequently be observed hereafter, that the title furnishes but little information as to the real subject-matter of the patent, and recourse must almost invariably be had to the specification, and to the peculiar nature of the claim made therein.

Morris's patent (A.D. 1764), for "a machine with a set of working needles, to be applied to a stocking-frame, for making oilet holes or net-work in silk, thread, or cotton."

The patentee had a verdict in this case (A.D. 1776, *cor.* Lord *Mansfield*), and a patent for an addition was held to be valid. *Morris* v. *Branson*, Bull, N. P. 77.

Hartley's patent (A.D. 1773), for "a method of securing buildings from fire." The invention consisted in a mode of disposing iron plates. Cited as a good subject-matter, by *Eyre*, C. J. 2 H. Bl. 463.

Liardet's patent (A.D. 1770), for "a composition on stucco." Held bad for insufficiency of specification. *Liardet* v. *Johnson*, B. N. P. 76.

Turner's patent (A.D. 1780), for "a method of producing a yellow colour for painting in oil or water, making white lead, and separating mineral alkali from common salt, all to be performed by one single process." The specification of this patent was bad. *Turner* v. *Winter*.

21 Jac. 1, c. 3.

therein contained, shall not in any wise extend or be prejudicial to any grant, or privilege, power, or authority whatsoever, heretofore made, granted, allowed and confirmed by any act of parliament now in force, so long as the same shall continue in force.

Warrants granted to justices, saved.

VIII. Provided also, that this act shall not extend to any warrant or privy seal, made or directed or to be made or directed by his Majesty, his heirs or successors, to the justices of the courts of the King's Bench or Common Pleas, and barons of the Exchequer, justices of 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

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Watt's patent (A.D. 1769), for "his method of lessening the consumption of steam and fuel in fire-engines." The invention or subject-matter of the letters patent, as described in the specification, was as follows.

1. "The steam cylinder must be kept as hot as the steam that enters it, either by a case of wood, or by surrounding it with steam, &c." This was a claim for the exclusion of cold, by the application of an external case or jacket; *i. e.* for a practice of casing or enveloping.

2. "The steam is to be condensed in vessels distinct from the steam cylinder, and which are kept cold by the application of water." This amounts to a claim of the application of some known vessel to a new purpose; in fact, of the principle of the still to the steam-engine.

3. "Whatever elastic vapour is not condensed by that cold, is to be drawn out of the condenser." This was, in fact, a claim to a new mode of working by known means.

4. "To employ the expansive force of steam to press on the pistons, and work engines discharging that steam into the open air, after it has done its office." This was a claim for the application of a known law of nature, viz. the elasticity of steam to produce a new result by known apparatus.

5. "To produce motions round an axis, by applying steam within hollow steam-wheels, so as to turn them round, &c." This is a claim for another application of steam.

6. "To apply a degree of cold, not capable of condensing steam, but only of contracting it so as to work engines by the alternate expansion and contraction of steam." This was also a claim similar to the 4th.

7. "To use oil, wax, resin, fat, or quicksilver, to render the pistons tight." This is a claim to an application of known substances to a new purpose.

The term of this patent was extended to thirty years, by 16 G. 3, c. 61, and the patent, after seven years' continuous litigation, was established 25 Jan. 1799, by a unanimous judgment in the King's Bench, on writ of error from the Common Pleas. *Hornblower & Maberley* v. *Boulton & Watt*, 8 T. R. 95.

This case is always referred to as the first and leading case on the subject-matter of letters patent; indeed prior to this the question hardly appears to have been fully before the courts. The law of this case, in respect of the subject-matter, furnishes the most extended interpretation hitherto put upon the words of the statute. For the subject-matter of this patent may be briefly described as a series of claims of new applications of known principles and properties, and of instruments and things already in existence, to produce known effects, in a more beneficial manner. Many recent cases have confirmed the law in this respect.

Huddart's patent (A.D. 1793), for "a new mode of making great cables, and other cordage, so as to attain a greater degree of strength therein, by a more equal distribution of the strain upon the yarns." The invention consisted in the substitution of a tube through which all the yarns were brought, after passing through a register-plate, which was in use before. *Huddart* v. *Grimshaw*, Dav. P. C. 265.

Bainbridge's patent (A.D. 1807), for "improvements on the flageolet, or English flute." Bad for incorrect specification. *Bainbridge* v. *Wigley*.

Forsyth's patent (A.D. 1807), for "a method of giving fire to artillery, and all kinds of fire-arms." The invention consisted in the application of detonating or fulminating mixtures, as a priming, and was, by the claim, confined to the use and application of such substances to the purposes of artillery and fire-arms. *Forsyth* v. *Riviere*.

Hill's patent (A.D. 1814), for "improvements in the smelting and working of iron." The invention consisted in combination and proportion of old sub-

done against any penal statute depending in suit and question before them, or any of them respectively, after plea pleaded by the party defendant. 21 Jac. 1, c. 3.

IX. Provided also, and it is hereby further intended, declared, and enacted, that this act, or any thing 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 patent, to them or any of them; or unto any corporations, companies, or fellowships of any art, trade, occupation, or mystery, or to any companies or societies of merchants within this realm, erected for the maintenance, enlargement, or ordering of any trade of mer- Charters granted to corporations, saved.

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stanecs, so as to produce a new effect. It was bad for incorrect specification. *Hill* v. *Thompson & Forman.*

Brunton's patent (A.D. 1813), for "improvements in the constructing of ships, anchors, and windlasses, and chain cables or moorings." The invention in the cable consisted in the combination of a link of a known form, with a stay across the centre with broad ends, so as to clasp the link in a new manner. The patent was bad, for claiming too much, and imperfect specification. *Brunton* v. *Hawkes.*

Hall's patent (A.D. 1817), for "a method of improving every kind of lace or net." The invention consisted in applying the flame of gas to singe off the superfluous fibres of the lace, the flame being urged by the draught of a chimney, so as to burn up through the interstices of the lace, and singe the inside of the meshes. An oil lamp had been used long before; as also the flame of charcoal and paper. *Hall* v. *Gervas & Boot.*

Lister's patent (A.D. 1823), for "improvements in the method and machinery for preparing and spinning wool, silk, and other animal fibres." The invention consisted in applying heat to the fibres of wool, during the operation of spinning, by steam within hollow rollers. Repealed as an infringement on a previous patent of Hadden's (A.D. 1818), for the same object, heated irons being inserted into the rollers. *R.* v. *Lister.*

Daniell's patent (A.D. 1819), for "improvements in dressing woollen cloth." The invention consisted in immersing a roll of cloth manufactured in the usual manner in hot water. *R.* v. *Daniell.* The subjecting the cloth to a steam bath with the same object in view, was held an infringement. *R.* v. *Fussell.*

Crompton's patent for "an improved method of drying and finishing paper." The invention consisted in conducting paper against a heated cylinder. Bad for specification, calculated to mislead. *Crompton* v. *Ibbotson.*

Christie's patent for "certain improvements in copper and other plate printing." The invention consisted principally in the preparation of the paper. *Sturtz* v. *De la Rue.* *Per* Lord *Lyndhurst*, Chancellor, "an improvement in one of the several processes, as damping the paper, is an improvement in copper-plate printing." *Ibid.* The specification was bad.

Lewis's patent (A.D. 1818), for "improvements of a machine for shearing and cropping woollen cloths, the same being improvements in a machine for which Lewis had obtained a patent A. D. 1815." The invention of the earlier patent consisted in shearing cloth from end to end by a rotatory cutter, of the later in shearing cloth from list to list by rotatory cutters. Cloth had been sheared from list to list by other means before. *Held*, that the combination of the rotatory cutters and the shearing from list to list was a good subject-matter, *Lewis* v. *D.* And that defendant had infringed the patent by the fact of shearing from list to list by a rotatory cutter without reference to the machinery by which such shearing was produced. *Per* Lord *Tenterden*, C. J. *Ibid.*

Minter's patent "for an improvement in chairs." The claim was as follows: "My invention is the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counterbalance to the pressure against the back of such chair, as above described." Held good, *Minter* v. *Wells.* *Per* Lord *Lyndhurst*, C. B.

Derosne's patent for "certain improvements in extracting sugar and syrups from the cane juice and other substances containing sugar, and in refining sugar and syrups." The invention consisted in filtering the syrup of sugar through a filter to act with animal charcoal and charcoal from bituminous schistus. Charcoal had been used for the filtration of almost every other liquid, but not for sugar. Patent supported. *Derosne* v. *Fairie.*

Whitehouse's patent (A.D. 1825), as-

21 Jac. 1, c. 3. chandise; but that the same charters, customs, corporations, companies, fellowships and societies, and their liberties, privileges, powers, and immunities, shall be and continue of such force and effect as they were before the making of this act, and of none other; any thing before in this act contained to the contrary in any wise notwithstanding.

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

X. Provided also, and be it enacted, that this act, or any declaration, provision, disablement, penalty, forfeiture, or other thing before-mentioned, shall not extend to any letters patent of grants of privilege 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,

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signed to Russell, "for improvements in manufacturing tubes for gas and other purposes." Tubes had been manufactured under a preceding patent by a process in which a maundril was used. Under this patent the invention consisted in omitting the maundril. Held good, *Russell* v. *Cowley*.

Sievier's patent (A.D. 1833), for "improvements in the manufacture of elastic goods." The invention consisted, among other things, in making an elastic web by placing in the warp covered threads of India rubber with strands or threads of cotton or other inelastic material. Before this patent, uncovered threads of India rubber had been employed in the warp with threads or strands of an inelastic material; also the whole warp had been formed of covered strands of India rubber, and strands of India rubber such as were used by Sievier were covered under a previous patent; but the particular combination was new. Held a good subject-matter, *Cornish* v. *Keane*, 3 Bing. N. C. 570. *Tindal*, C. J.: "Now the first objection made to the patent so described is, that the invention is not the subject-matter of a patent; that it is neither a new manufacture nor an improvement of any old manufacture, but is merely the application of a known material in a known manner, to a purpose known before. The question, therefore, as to this point is, does it come under the description of 'any manner of new manufacture,' which are the terms employed in the statute of James. That it is a manufacture can admit of no doubt; it is a vendible article produced by the art and hand of man; and of all the instances that would occur to the mind when inquiring into the meaning of the terms employed in the statute, perhaps the very readiest would be that of some fabric or texture of cloth. Whether it is new or not, or whether it is an improvement of an old manufacture, was one of the questions of the jury upon the evidence before them; but that it came within the description of a manufacture, and so far as 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 Indian rubber previously covered by filaments bound round them was known before; the use of yarns of cotton, or other non-elastic materials, was also known before; but the placing them alternately side by side together as a warp, and combining them by the 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. It is a web combining the two qualities of great elasticity and a limit thereto." *Ibid.*

Galloway's patent for "improvements in paddle-wheels." The invention consisted in a particular arrangement, according to an assigned law, of float-boards previously in use. *Galloway* v. *Bleaden*.

Elliot's patent (A.D. 1837), for "improvements in the manufacture of covered buttons." The whole claim consisted in the application of a particular twist of silk, viz., organzene, when woven into a pattern for the covering of buttons, performed in the usual manner by dies and pressure, another twist of silk having been used before. The same fabric had been used before in covering buttons by hand with a needle. *Elliott* v. *Aston*.

But a claim simply for fixing certain known apparatus, as drawing rollers, at a given distance (two inches) apart, various distances being used before, is not a good subject-matter. *Kay* v. *Marshall*.

II. The subject-matter must be new. That which is worked or made then for

or shot for ordnance, nor to any grant or letters patent here- 21 Jac. 1, c. 3.
tofore made, or hereafter to be made, of any office or offices heretofore erected, made, or ordained now in being, and put in execution, other than such offices as have been decried by any his Majesty's proclamation or proclamations: but that all and every the same grants, commissions, and letters patent, and all other matters and things tending to the maintaining, strengthening, and furtherance of the same, or any of them, shall be and remain of the like force and effect, and no other, and as free from the declarations, provisions, penalties, and forfeitures contained in this act, as if this act had never been had nor made, and not otherwise.

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the first time, possesses the incident of novelty in the highest degree. That which is published in a book printed in England, is not new. *R.* v. *Arkwright.* Nor that which is contained in the specification of any prior patent. *Huddart* v. *Grimshaw.*

The construction of a machine, under injunction of secresy, is no publication. *Morgan* v. *Seaward.* And the disclosure of the invention to a third person, about to be interested in a subsequent patent, as by lending money upon it, is private and confidential, and no publication. *Ibid.*

But a sale to the public, prior to letters patent, by the inventor himself, will vitiate. *Wood* v. *Zimmer.* Also the sale of one article of an invention the same in principle as the subject of a subsequent patent, although the manufacturer was ignorant at the time of the novelty of the invention. *Minter* v. *Mower.*

Prior discovery, user in private, and abandonment, will not vitiate letters patent of a subsequent inventor who has not seen or heard of the previous invention. *Jones* v. *Pearce.* Per *Patteson*, J.

Nor the fact of a model brought to this country, shown to several persons, and copied, but machine never completed, or brought into use, if subsequent patentee never saw or heard of the model. *Lewis* v. *Marling.*

(*f*) If an invention be new in England a patent may be granted for it, though it was practised beyond the sea before; for the statute speaks of new manufactures within this realm, and if they be new here, it is within the statute, which was intended to encourage new devices useful to the kingdom, and whether learned by travel or by study it is the same thing. *Edgeberry* v. *Stephens*, 2 Salk. 446. This case establishes that the first introducer of an invention practised beyond the sea shall be deemed the true and first inventor. Per *Eyre*, C. J. 2 H. Bl. 463.

England, Ireland, and Scotland, are distinct countries for all the purposes of letters patent. 6 Ves. 708. And evidence as to want of novelty and user in one country, is not admissible for a defendant in an action for infringement of letters patent for the other countries.

(*g*) The grantee of letters patent must be the true and first inventor of the subject-matter within this realm. The cases in illustration of this clause may be conveniently referred to three classes: 1. The original discoverer. 2. An original discoverer and the first publisher. 3. The introducer of a foreign invention. *Ante* 10.

1. He is not the true and first inventor who has a material part of the invention suggested to him by another, unless by a foreigner residing abroad.

In Tennant's patent for a bleaching liquid, a chemist had suggested to the patentee, two years before the date of the patent, to keep the lime-water in a state of agitation. This being an essential part of the invention, the plaintiff was nonsuited. *Tennant* v. ———, Cor. Lord *Ellenborough*, cited 2 H. Bl. 487.

Nor if the person making the suggestion be the patentee's servant or workman.

In Barker & Harris's patent for hats, the improvements had been made by the witness when in the employ of the plaintiffs. Plaintiffs nonsuited. *Barker & H.* v. *Shaw*, Cor. *Holroyd*, J., cited 2 C. and P. 568. But if the witness had been employed for the express purpose of suggesting improvements, it might be different. Per *Bayley*, J. *Ibid.*

If a servant execute what his master has planned or projected, the result belongs to his master. *Bloxam & another* v. *Elsee.*

And a skilful person may be employed for the express purpose of perfecting the details of an invention. *Ibid.*

The preceding case will illustrate the law respecting the assistance which a true and first inventor may receive from other persons. The plaintiffs were assignees of Fourdrinier, to whom had been assigned Gamble's patents for making paper. The invention consisted in mak-

This act shall not extend to commissions for alum-mines.

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

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ing paper in continuous sheets, by machinery, of which the general principle was the receiving the pulp on an endless wire web, passing round cylinders, all moving with the same velocity. The original idea being conceived, the practical details were infinite; and Mr. Donkin, a most celebrated mechanical engineer, was employed professionally to advise as to the means of carrying this into effect, and many of the mechanical arrangements were invented by him. Such details were but subsidiary and incidental to the main idea. *Ibid.*

A calico printer, having discharged his head colourman, is entitled to the book in which that servant has entered the processes for mixing colours during his service, though many of the processes were the invention of the head colourman. *Mackpeace* v. *Jackson*, 4 Taun. 770. *Chambre*, J.: "The master has a right to something beside the mere manual labour of his servant in the mixing of colours; and though the servant invented them, yet they are to be used for the master's benefit, and he cannot carry on his trade without his book." *Heath*, J.: "Though there might be inventions of the servant in it, yet they were the property of the master." *Ibid.*

Nor if it may have been learnt from a book printed and published, and generally circulated within England. In Arkwright's case, part of the invention claimed (the beater) was published many years before, in Emerson's Mechanics, a book well known. *R.* v. *Arkwright.*

But not if it be only contained in a book in a foreign language, deposited in the British Museum. In re *Heurteloupe's* patent. *Post*, 56, n. *n.*

An experiment, or course of experiments, known to various persons tending to a certain result, but resting in experiment only, supposed by the parties to be fruitless, and abandoned because it is not brought to a complete result, will not prevent a more successful competitor who may avail himself as far as his predecessors have gone of their discoveries, and add the last link of improvements in bringing it to perfection. *Galloway* v. *Bleaden.* Per *Tindal*, C. J.

Hence, if letters patent be taken out in the name of two or more persons, when all and each of them will not satisfy the above condition of a true and first inventor, the letters patent would be void; and a joint letters patent cannot be sustained on a sole invention, nor a sole letters patent on a joint invention.

II. In Dollond's case, it was proved that Dr. Hall had practised the same invention long before, but had never published it to the world. Held, that Dollond, being a true inventor, and having published it to the world under the protection of letters patent, was the true and first inventor, within the meaning of the statute. Cited per *Buller*, J. 2 H. Bl. 487.

Of simultaneous inventors, he who first publishes under letters patent. *Forsyth* v. *Riviere.* *Ante*, 33, n. *a.*

III. See *ante*, 49, n. *f.*

A large number of the inventions for which letters patent are taken out, consist of communications from foreigners residing abroad.

The principle of this is consistent with the original policy of letters patent, namely, the encouragement of trade, arts, and manufactures, within this realm.

(*h*) The corresponding words in the letters patent are, "new as to public use and exercise," which afford an explicit exposition of the statute, and one easily applicable. For the cases, *post*, Pr. Fr. XIII. n. *k.*

The making a machine will not vitiate letters patent; nor the making in this country and user abroad. *Morgan* v. *Seaward.*

Nor will private use and subsequent abandonment vitiate the letters patent of a subsequent inventor; for the words of the statute limit the inquiry to the time of the grant. *Ibid.*

(*i*) Letters patent for an *improvement* in the use of drugs (except sugar) for brewing beer, would probably be held void, or the use might only be stopped by 42 G. 3, c. 38, & 51 G. 3, c. 87.

Utility, by this clause of the statute, is an essential condition of the validity of letters patent. For a monopoly in an invention altogether useless would be mischievous to the state, and to the hurt of trade, and generally inconvenient, by precluding all improvements thereon, until the expiration of the patent. See per *Parke*, B. *Morgan* v. *Seaward.*

A plea to put in issue the utility, must pursue the words of the statute. *Ibid.* See *post*, Pr. Fr. XXI.

It is not sufficient that an invention be merely not injurious, some evidence of utility must be given. *Manton* v. *Parker.*

The result proposed not being obtained, or the utility of the invention and pur-

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 the act had never been had nor made, and not otherwise. 21 Jac. 1, c. 3.

XII. Provided also, and be it enacted, that this act, or any declaration, provision, penalty, forfeiture, or other thing beforementioned, shall not extend or be prejudicial to any use, custom, prescription, franchise, freedom, jurisdiction, immunity, liberty, or privilege, heretofore claimed, used, or enjoyed by the governors and stewards and brethren of the fellowship of the hoast-men of the town of Newcastle-upon-Tyne, or by the ancient fellowship, gild, or fraternity, commonly called hoast-men, for or concerning the selling, carrying, lading, disposing, shipping, venting, or trading of or for any sea coals, stone coals, or pit coals, forth or out of the haven or river of Tyne, or to any grant made by the said governor and stewards and brethren of the fellowship of the said hoast-men to the late Queen Elizabeth, of any duty or sum of money to be paid for, or in respect of, any such coals as aforesaid; nor to any grants, letters patent, or commission, heretofore granted, or hereafter to be granted, of, for, or concerning the licensing of the keeping of any tavern or taverns; or selling, uttering, or retailing of wines to be drunk or spent in the mansion-house, or houses, or other place in the tenure or occupation of the party or parties so selling or uttering the same; or for or concerning the making of any compositions for such licenses, so as the benefit of such compositions be reserved and applied to and for the use of his Majesty, his heirs or successors, and not to the private use of any person or persons. Nor to the liberties of Newcastle-upon-Tyne, nor to licenses of keeping taverns.

XIII. Provided also, and be it enacted, that this act, or any declaration, provision, penalty, forfeiture, or other thing beforementioned, shall not extend or be prejudicial to a grant or privilege, for or concerning the making of glass, by his Majesty's letters patent under the great seal of England, bearing date the two-and-twentieth day of May, in the one-and-twentieth year of Nor to letters patent for glass making.

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pose of the patent wholly failing, the plaintiff was nonsuited. Per *Thomson*, C. B. *Ibid.*

But the uselessness of parts, a beneficial result on the whole being produced, will not vitiate.

In Clegg's patent for an improved gas apparatus, which consisted of a series of apparatus, of which two only were useful. Held, that the inutility of the others which answered the purpose proposed, and were clearly described, did not vitiate. *Crossley* v. *Beverley.*

It is not essential that all the parts should be useful, but only that all should be new. *Lewis & anr.* v. *Marling.*

But if the specification described the useless part as essential, its inutility would vitiate. *Ibid.*

If a machine be new and useful in the generality of cases, the fact of inutility in some cases will not vitiate. *Haworth* v. *Hardcastle.*

The court does not mean to intimate any doubt as to the validity of a patent for an entire machine or subject which is taken altogether useful, though a part or parts may be useless. Per *Parke*, B. *Morgan* v. *Seward.*

(*k*) This expresses what has been stated more fully above (n. *b*), that no new law was introduced by the statute.

21 Jac. 1, c. 3.

his Majesty's reign of England, made and granted to Sir Robert Mansel, Knight, Vice-Admiral of England: nor to a grant or letters patent, bearing date the twelfth of June, in the thirteenth year of his Majesty's reign of England, made to James

Or exportation of calves' skins.

Maxewell, Esquire, concerning the transportation of calves' skins: but that the said several letters patent, last mentioned, shall be and remain of the like force and effect, and as free from the declarations, provisions, penalties, and forfeitures before-mentioned, as if this act had never been had nor made, and not otherwise.

Nor to grants for making smalt.

XIV. Provided also, and be it declared and enacted, that this act, or any declaration, provision, penalty, forfeiture, or other thing before-mentioned, shall not extend or be prejudicial to a grant or privilege for or concerning the making of smalt, by his Majesty's letters patent, under the great seal of England, bearing date the sixteenth day of February, in the sixteenth year of his Majesty's reign, of England, made or granted to Abraham

Or melting iron ore.

Baker; nor to a grant or privilege for or concerning the melting of iron ewer, and of making the same into cast-works or bars with sea coals or pit coals, by his Majesty's letters patent, under the great seal of England, bearing date the twentieth day of February, in the nineteenth year of his Majesty's reign of England, made or granted to Edward, Lord Dudley; but that the same several letters patent and grants shall be and remain of the like force and effect, and as free from the declarations, provisions, penalties, and forfeitures before-mentioned, as if this act had never been had nor made, and not otherwise (*l*).

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5 and 6 W. 4, c. 62.

An Act, &c., for the abolition of unnecessary Oaths.

5 & 6 W. 4, c. 62.

Declaration substituted for oaths and affidavits heretofore required on taking out a patent.

XI. And be it enacted, that whenever any person or persons shall seek to obtain any patent under the great seal for any discovery or invention, such person or persons shall, in lieu of any oath, affirmation, or affidavit, which heretofore has or might be required to be taken or made upon or before obtaining any such patent, make and subscribe, in the presence of the person before whom he might, but for the passing of this act, be required to take or make such oath, affirmation, or affidavit, a declaration to the same effect as such oath, affirmation, or affidavit; and such declaration, when duly made and subscribed, shall be, to all intents and purposes, as valid and effectual, as the oath, affirmation, or affidavit, in lieu whereof it shall have been so made and subscribed (*a*).

(*l*) These last nine sections contain the exceptions rendered necessary by reason of the generality of the words of the statute. See *ante*, 41, n. *t*.

(*a*) This is the only section having any reference to letters patent for inventions, excepting those declaring the making a false declaration to be a misdemeanour. See Pr. F. II.

5 and 6 W. 4, c. 83.

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

5 and 6 W. 4, c. 83.

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 (*b*): be it enacted by the King's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present parliament assembled, and by the authority of the same, that any person who, as grantee, assignee, or otherwise (*c*), hath obtained, or who shall hereafter obtain, letters patent, for the sole making, exercising, vending, or using of any invention (*d*), may, if he think fit, enter with the clerk of the patents of England, Scotland, or Ireland, respectively, as the case may be, having first obtained the leave of his Majesty's Attorney-General or Solicitor-General, in case of an English patent, of the Lord Advocate or Solicitor-General of Scotland in the case of a Scotch patent, or of his Majesty's Attorney-General or Solicitor-General for Ireland in the case of an Irish patent, certified by his fiat and signature (*e*), 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 (*f*), not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent (*g*); and such disclaimer or memorandum of

Any person having obtained letters patent for any invention, may enter a disclaimer of any part of his specification, or a memorandum of any alteration therein, which, when filed, to be deemed part of such specification.

(*b*) As to the circumstance which led to the passing of this act, see p. 12, n. *a*.

By the preamble it appears, that the act contemplates alterations both in the letters patent and in the specification; the rights of the patentee being secured by and under the letters patent themselves, the benefit of the public being derived from the specification.

(*c*) Letters patent have been granted to the executor of the inventor.

(*d*) The statute pursues the terms of the letters patent, which differ from those used in the proviso of the statute. *Post*, Pr. F. XIII. n. *k*.

(*e*) See rules of practice of the Attorney and Solicitor-General, 63 *post*, and Pr. F. XV.

(*f*) For the forms under which these disclaimers and memorandums of alteration may be most conveniently made, see Pr. F. XV.

(*g*) A disclaimer or memorandum in breach of this condition would be simply void, and of none effect. It would simply have failed to cure the original defects of the title, or of the specification, and if these were such as to vitiate the grant, the letters patent would be voidable. See 54, n. *i*.

The defects which may exist in disclaimers or memorandums of alterations, present themselves under two classes. Firstly: When such disclaimer or memorandum is absolutely void, as where the Attorney or Solicitor-General has authorized the enrolment of one which he could not do by law. Secondly: Where the disclaimer or memorandum of alteration fails in its object entirely or partially. The letters patent and specification may really remain subject to all their legal defects, or only to some of them, or be

5 and 6 W. 4, c. 83.

alteration, being filed by the said clerk of the patents, and enrolled with the specification (*h*), shall be deemed and taken to be part of such letters patent, or such specification (*i*), 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 (*k*): 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 (*l*): 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

Caveat may be entered as heretofore.

Disclaimer not to affect actions pending at the time.

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

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made perfectly secure according to the sufficiency of the instrument enrolled under this section.

No cases precisely in point have come before the courts, but the principles for their decision will at once suggest themselves from the consideration of the grant, and the reason for the specification. See Pr. F. I. n. *b*.

If the crown have been deceived by any suggestion, or if the specification is in any respect false, or likely to mislead, so that the public cannot enjoy the benefit in the most ample manner, these defects at all events must be completely cured.

(*h*) An enrolment with the specification is sufficient, since that instrument recites the title. See Pr. F. XIV.

(*i*) This clause is to be understood as if it had been as follows:—"shall be deemed and taken to be part of such letters patent, or such specification from thenceforth, in all courts whatever." Per *Parke* B. *Perry* v. *Skinner*. In this case the patent would have been void, but for the disclaimer under this act, and it was held "that where a patent is originally void, but amended by filing a disclaimer of a part of the invention, the act has not a retrospective operation so as to make a party liable for an infringement of the patent, prior to the time of entering such disclaimer."

It was admitted on the pleadings in this case, that the infringement was in respect of parts of the invention, to which the disclaimer did not refer. The principle of the above decision was, that by a contrary decision, a party might be made a wrongdoer by relation. The legislature never could have intended that a party, having gone to a great expense on the faith of letters patent being void, should, though an innocent person, be made a wrongdoer. He would have been acting consistently with the law at a certain time, and for a long period, and then, though after the act done, be made a wrongdoer from that act.

(*k*) See Rules 63, IV. and Pr. F. XV.

(*l*) This proviso has created some ambiguity as to the meaning of the previous clauses. In *Perry* v. *Skinner*, it was contended that this proviso showed it to be the intention of the legislature, that the disclaimer and memorandum of alteration should be deemed and taken to be part of letters patent and specification as originally granted and enrolled. The court, however, of Exchequer, ruled that such could not be the construction of the statute. See *supra*, n. *i*.

The reason of the exception of proceedings by *scire facias* is obvious, as by these the letters patent are set aside, and the patentee deprived of all advantages or privileges accruing under them. This is an action at the suit of the crown against the patentee, and not by the patentee against a particular infringer; if the patentee fails in the former his letters patent may be immediately cancelled, whereas in the latter he only fails to recover for the infringement. It would therefore be unjust not to allow the patentee every opportunity of setting himself right with the crown.

same to advertise his disclaimer or alteration in such manner as to such Attorney-General, or Solicitor-General, or Lord Advocate, shall seem right, and shall, if he so require such advertisement, certify in his fiat that the same has been duly made (*m*). 5 and 6 W. 4, c. 83.

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

II. And be it enacted, that if in any suit or action it shall be proved, or specially found by the verdict of a jury, that any person who shall have obtained letters patent for any invention, or supposed invention, was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same, or some part thereof, before the date of such letters patent, or if such patentee or his assigns shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof, before the date of such letters patent, it shall and may be lawful for such patentee, or his assigns, to petition his Majesty in council to confirm the said letters patent, or to grant new letters patent, the matter of which petition shall be heard before the judicial committee of the privy council; and such committee, upon examining the said matter, and being satisfied that such patentee believed himself to be the first and original inventor, and being satisfied that such invention, or part thereof, had not been publicly and generally used before the date of such first letters patent, may report to his Majesty their opinion that the prayer of such petition ought to be complied with, whereupon his Majesty may, if he think fit, grant such prayer; and the said letters patent shall be available in law and equity to give 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 (*n*).

(*m*) Permission to enter such disclaimer or memorandum of alteration, is in the discretion of the law officer of the crown, who will judge of its effect and consequent legality, and the propriety of advertising, to warn other persons of the intentions of the patentee. This is a check on the enrolment of specifications with illegal claims, in the hopes of being able at any time to disclaim the same, should it be necessary. Whenever the law officers of the crown have reason to presume want of fairness on the part of the patentee in this respect, they have the power of refusing the prayer of the petition altogether, or ordering suitable advertisements, that the public may be fully apprised of the nature of the intentions on the part of the patentee. *Post*, Pr. F. XV.

A memorandum of alteration having been filed, the Master of the Rolls held that he had no power to take it off the roll, though wholly void. Parties entering cavents had an opportunity of opposing its being filed, and he had no power to interfere with what the Attorney or Solicitor-General had sanctioned. In re *Sharp's* patent, 3 Rep. Arts, 2d. ser. 232.

(*n*) The scope and effect of this clause

If in any action or suit a verdict or decree shall pass for the patentee, 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 receive treble costs.

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

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are not very apparent. It may, however, be considered as explanatory in some measure of the clause of non-user, in 21 Jac. 1, c. 3, s. 6, and as giving effect thereto by enabling the crown to confirm letters patent open to objections of previous invention and user, in cases in which, owing to a verdict of the jury, the patentee has failed in the protection to which, on the authority of the cases of this nature, both before and since the statute, he is entitled. The power of the judicial committee of the privy council is restricted to the cases in which the patentee believed himself to be the first and original inventor, and in which the invention had not been publicly or generally used before the date of the letters patent.

An application under this section was made to the privy council to confirm a patent under the following circumstances. Part of the invention claimed in the specification was printed and published many years before the date of the patent, and such part also was described in the specifications of two patents of prior date to the patent in question. There was, however, no evidence of the invention having been publicly or generally used before the date of the patent in question. The petition was dismissed with costs. In re *Westrupp & Gibbin's* patent. 5 Rep. Arts, 2d ser. 227.

Lord *Lyndhurst*: "The act could never be intended to apply to a case where a person having taken out a patent for an invention, not knowing of a former patent, the subsequent patentee comes to the court and applies to have the exclusive benefit of the invention, adversely to the rights and interests of the former patentee; but the rights of the real inventor must be preserved."

Lord *Wynford*: "I apprehend the object of the clause is, that if there are any minute portions which have been used, and the petitioner swears that he did not know it—a very trifling thing amounting to nothing—in that case the court may confirm it." *Ibid.*

In the preceding case, a distinction was taken between the terms 'publicly and generally used,' which are the words of the statute, and 'publicly and generally known,' as where an invention was published in a book or in the specification of a previous patent. The court did not, however, express any opinion on this distinction, but decided against the petition, on the general principle that the right of a real inventor, who had published his invention to the world under the protection of letters patent, was to be preserved.

It would appear on the authority of the preceding case, that the section of the act cannot be applied so as to give an exclusive privilege to a subsequent inventor and patentee, to the prejudice of a prior inventor and patentee, who has put the invention into use, though it may be applied to the prejudice of a prior inventor who has practised his invention only to an extent which may be a user in law.

It must be remarked that the prohibitory clause in the letters patent refers to any thing "heretofore found out, or invented and publicly used, or exercised," in the conjunctive. See Pr. F. XIII. n. *m*.

An application was made under this section to confirm letters patent granted to Baron Heurteloupe, for improvements in certain parts of certain fire-arms. The specification claimed among other things a mode of igniting a charge of gunpowder, by placing detonating powder in copper tubes. Subsequently to the patent, the baron discovered that in the year 1832, the date of his patent, a French work had been deposited in the British Museum, containing the description of a patent granted in France to a native for improvements in fire-arms, in which was a similar mode for exploding the charge, the only difference being that the French patent specified straw as a tube instead of metal. The baron being advised that this was a publication such as might endanger his patent, applied for its confirmation under this section. The privy council having received evidence to satisfy them that such an invention had never been used in England, or published previous to the date of the patent in any other manner than by this French book, directed a notice to be served on the Frenchman whose invention was described in this book, informing him of the baron's application, and of the day when the case would come on, should he wish to offer an opposition. This being done, and no person opposing on that day, the privy council, on proof of such notice, confirmed the patent. In re Baron *Heurteloupe's* patent, 14 Lond. Jour. Conj. ser. 58

fore 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 (*o*). 5 and 6 W. 4, c. 83.

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

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

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(*o*) The costs in an action for the infringement of letters patent are subject to the general statutes respecting costs—this statute making no change in this respect, but subjecting the party to a penalty of treble the amount in certain cases, with the view of checking vexatious opposition to the right of patentees. It not unfrequently happened that a patentee, though successful, was ruined by the expenses of continuous litigation against infringers; which this clause will have a tendency to check.

The patentee on a second or subsequent verdict passing for him is to receive costs to be taxed at "three times the taxed costs." These words prevent the application of the ordinary rule as to double and treble costs, viz. that "double or treble costs are not to be understood to mean, according to their literal import, twice or thrice the amount of single costs." But when a statute gives double costs, the mode of estimating them is to allow the single costs, including the expense of witnesses, counsel fees, &c., and then one-half of the amount of the single costs, without any deduction on account of these expenses. If treble costs are given, they are calculated as the common costs, then half of these, then half of the latter. So that treble costs, without any special words, would amount to the common costs and three-fourths of the common costs, or one-fourth less than twice the common costs. See Tidd's Practice, 9th edit. 987.

(*p*) The practice as to advertisements has been defined by rule issued by the privy council. *Post* p. 64 VII., and Pr. F. XVII.

(*q*) Form of petition and caveat, *post* Pr. F. XVII.

5 & 6 W. 4, c. 83.

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 any wise notwithstanding (*r*): 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 (*s*).

Repealed by 2 and 3 Vic. c. 67.

In case of action, &c. notice of objections to be given.

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

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(*r*) The recommendation is entirely in the discretion of the privy council, who, upon hearing and inquiring of the whole matter, may report to the crown that an extension should, in their opinion, be granted.

Erard's patent, of 1822, for improvements in piano fortes, was extended seven years, on account of the hardship of the case, and the merit of the invention; and Lord *Lyndhurst*, in delivering judgment in this, the first application under the act, said, that "the judicial committee of the privy council would, in all cases, require a strong case of hardship to be made out, as well as a strong case of the utility of the invention."

The term of Downton's patent, of 1825, was extended, on the application of his widow, for five years, on the ground of no adequate remuneration having been received by the patentee in his life-time, owing to want of capital; and the payment of the petitioner's costs was ordered, the opposition being unnecessary; because the Attorney-General appeared for the crown, and the opposing party showed no good cause for refusing the prayer of the petition. 13 Rep. Arts, N. S.

The term of Whitehouse's patent, assigned to Russell, was extended for five years, on the ground of the great utility of the invention, and no adequate remuneration, owing, in a great measure, to the expense of the continuous litigation in which the assignee had been involved, in the protection of his rights. It was made a condition of the recommendation in this case, that the inventor, Whitehouse, should receive an annuity.

A petition being abandoned, the opposing party obtained their costs. In re *Mackintosh's* patent.

(*s*) This clause is repealed by 2 and 3 Vict. c. 67.

The import of the phrase "prosecuted with effect" came before the committee of the privy council in the case of Bodmer's patent, under the following circumstances:—An application was made, in May, 1838, for an extension of the term of Bodmer's patent for cotton-spinning machinery. Caveats were entered in July. The case came on before the privy council the 17th of August, when, according to the rule (*post* 64, VII.) the opposing party was entitled to four weeks' notice of the hearing, for the purpose of preparing evidence. Before the expiration of this month, the privy council would have closed its sittings. The case was opened, and adjourned to the 29th of November. In the mean time the opposition was withdrawn, but the patent had also expired. It was held, that the words "prosecuted with effect" meant that something must have been effected, some conclusion arrived at by the council before the expiration of the patent; and no conclusion having been arrived at, nothing effected, the law did not empower the council to proceed with the matter farther, or the crown to grant new letters patent for an invention open to the public. In re *Bodmer's* patent, 15, London Journ. Arts.

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 (*t*).

5 & 6 W. 4, c. 83.

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

As to costs in actions for infringing letters patent.

(*t*) In an action for the infringement of a patent, the court will not compel the plaintiff to produce to the defendant any specimen of the patent articles, to assist the defendant to make out his plea of want of novelty. The specification gives the necessary information. *Crofts* v. *Peach & another*, 2 Hodg. 110.

The notice of objections delivered by the defendants under this section, is not conclusive at his peril, but the court, or a judge at chambers, under their general jurisdiction, as well as under this statute, may order a fuller and better notice. *Bulnois* v. *Mackenzie*, 6 Dow. P. C. 215.

If the notice of objections states the patent to have been worked by J. M. and others, and is therefore old, the defendant will not be compelled to give the name, description, and place of abode, of those others. *Ibid.*

Tindal, C. J.: "I think, on looking at the statute, that this case is clearly and closely brought to the same position as a case under the statute of set-off, and as there has been an invariable course of applications for particulars in such cases, I cannot see any objection to the court looking into the construction of particulars delivered, and in saying whether they are sufficient. At the same time, however, there is so much generality in the terms of the fifth section, that some doubt is left in my mind as to how we can compel a party to name the particular persons whom he intends to allege have used the invention. There is some doubt as to how far, under the words 'notice of objection,' we can compel a party to particularity, in the names of persons whom he intends to call as witnesses." *Ibid.*

The particular of objections delivered by the defendant must be precise and definite, and it is not sufficient to say that the improvements, or some of them, had been used before. The defendant should point out which. *Fisher* v. *Dewick & another*.

Tindal, C. J.: "The question is, whether the particulars of the defendant's objections are so uncertain and indefinite as to mislead the plaintiff. It was not the intention of the legislature to limit the defence, but merely to limit the expense of the trial, and to prevent the patentee from being upset at Nisi Prius by sudden and unexpected evidence. The notice contemplated by the fifth section must mean an honest and *bonâ fide* notice, and I see no reason to be afraid of incurring prolixity by deciding that it is necessary to point out all the specific objections to the patent, which I think the defendant is bound to do really and substantially." *Ibid.*

In a recent case, *Coltman*, J., at chambers, ordered names, addresses, and descriptions, to be given, and the words "divers other persons" to be struck out. Chitt. Arch. 1031.

If a defendant neglect to deliver with his pleas the notice of objections required by the fifth section, it seems doubtful whether the court have power to allow him to deliver them afterwards, *nunc pro tunc*. But if satisfied on the merits, they will grant him leave to plead *de novo*, and then he may deliver the notice of objections with the first pleas. *Losh* v. *Hague*, 2 Jur. 157. For the particulars of some of the notices of objections in these cases, see *post*, Pr. F. XX!

(*u*) The judge is, for the purpose of costs, to certify what part of each case has been proved at the trial. This section is not intended to interfere, in any manner, with the general statutes respecting costs, but has special reference to the notices of objections to be delivered ac-

Penalty for using, unauthorized, the name of a patentee, &c.

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

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cording to the preceding section. The court of Exchequer have held, that the certificate of the judge, under this section, should be as to the objections, and not as to the issues. *Losh* v. *Hague*, 7 Dowl. 495.

Parke, B.: "The effect of the statute is to make each of the objections raise a separate issue, and the judge's certificate should be as to the objections." *Ibid.*

In the preceding case there were seven objections, of which six were found for the plaintiff. The defendant had a verdict on one issue, which covered the entire cause of action, and it was held, that the plaintiff was entitled to six-sevenths of the costs of copying and transcribing those objections and the costs of the issues found for him, but that the defendant was entitled to the costs of the issue found for him, and the general costs of the cause. *Ibid.*

(*w*) An action on this penal statute must be brought within two years next after the offence committed, if at the suit of the crown, and within one year, if at the suit of any other person. 31 Eliz. c. 5, s. 5.

For the declaration in the *qui tam* action on this section, see Pr. F. XXII.

Prior to this statute, all grievances of the nature for which a penalty is, in the case of patent inventions, given by this section, could only be remedied either by injunction, or by action at law for damages; and cases of this kind have frequently been before the courts.

A manufacturer using the letters and figures which another manufacturer, a patentee, was in the habit of using, will be stayed by injunction, on application of patentee. *Ransom* v. *Bentall*, Law, J. H. T. 1815; 1 Chit. Gen. Pr. 721, n. *Knott* v. *Morgan*, 2 Keen, 213.

The appropriation of another tradesman's mark, for goods manufactured under a patent, with the fraudulent intention of drawing away customers, or of putting off bad goods, is actionable. *Blanchard* v. *Hill*, 2 Atkyns, 484.

If a manufacturer uses the mark of another manufacturer, and thereby de-

2 and 3 Vict. c. 67 (*x*).

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."

"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 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

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frauds the public, by giving an appearance to his articles that they were made by B, an action may be maintained by B, although A's articles are not inferior, and it is not shown that B has sustained any damage. *Blofield* v. *Payne*, 4 B. & Ad. 410.

Also, when a manufacturer had adopted a particular mark for his goods, in order to denote their manufacture by him, an action on the case may be maintained against another person adopting the same mark, for the purpose of denoting that his goods were manufactured by the plaintiff, and who sold the goods so marked as and for the goods manufactured by the plaintiff. *Sykes* v. *Sykes*, 3 B. & Cr. 541.

(*x*) This act was passed to remedy the hardship to which a patentee might be subject, under circumstances similar to those of Bodmer's patent. *Ante* 58, n. *s*.

Bodmer's patent has been extended under this statute.

2&3 Vict. c. 67. committee of the privy council; and it is expedient therefore that the said judicial committee should have power, when under the circumstances of the case they shall see fit, to entertain such application, and to report thereon, according to the provisions of the said recited act, notwithstanding that before the hearing of the case before them the terms of the letters patent sought to be renewed or extended may have expired:" Be it therefore enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present parliament assembled, and by the authority of the same, that so much of the said recited act as provides that no extension of the term of letters patent shall be granted as therein mentioned if the application by petition for such extension be not prosecuted with effect before the expiration of the term originally granted in such letters patent, shall be and the same is hereby repealed.

Repealing provision requiring the application by petition to be prosecuted with effect before the expiration of the term of the patent.

Term of patent right may be extended in certain cases, though the application for such extension not prosecuted with effect before the expiration thereof.

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

Act may be amended this session.

III. And be it further enacted, that this act may be altered, amended, or repealed by any act to be passed in the present session.

RULES OF PRACTICE (*y*).

Of the Attorney and Solicitor-General under s. 1.

I. The person applying must present a petition to the Attorney-General or Solicitor-General, stating what the proposed disclaimer or alteration is, when a time will be appointed for hearing the applicant. The petition is in general to be accompanied by a copy of the original specification, and of the proposed disclaimer or alteration.

Hearing.

II. If on the hearing the Attorney or Solicitor-General should think fit to disallow the proposed alteration or disclaimer, no further proceeding is necessary. If he should think fit to allow it without any advertisement, then on being applied to for the purpose, he will put his signature to the fiat, authorizing the clerk of the patent to make the required enrolment.

Advertisement.

III. If it appears to the Attorney or Solicitor-General that any advertisement or advertisements ought to be inserted, then he will give such directions as he may think fit relative thereto, and will fix any time not sooner than ten days from the first publication of any such advertisement for resuming the consideration of the matter.

Caveat.

IV. Caveats may be lodged at any time before the actual issuing of the fiat, and any party lodging a caveat is to have seven days' notice of the next meeting.

Fiat.

V. The fiat must be written or engrossed on the same parchment, with the disclaimer or alteration at the foot thereof.

Of the Privy Council under s. 3 & 4.

VI. A party intending to apply by petition under section 2 of the said act, shall give public notice by advertising in the *London Gazette* three times and in three London papers, and three times in some country paper published in the town where or near to which he carries on any manufacture of any thing made according to his specification, or near to or in which he resides, in case he carries on no such manufacture, or published in the county where he carries on no such manufacture, or published in the county where he carries on such manufacture, or where he lives in case there shall not be any paper published in such town, that he intends to petition her Majesty under the said section, and shall in such advertisement state the object of such petition, and give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day notice must be given of any opposition intended to be made to the

Advertisement.

Notice of opposition.

(*y*) These rules have been issued by the Attorney and Solicitor-General, and the Judicial Committee of the Privy Council, as the rules of practice under 5 & 6 W. 4, c. 83. For the forms of the documents, see *post*, Pr. F. XV.—XVII.

petition, and any person intending to oppose the said application shall lodge notice to that effect at the council office, on or before such day so named in the said advertisements, and, having lodged such notice, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

Under s. 4.

VII. A party intending to apply by petition under section 4 of the said act, shall, in the advertisements directed to be published by the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements, to be inserted in the *London Gazette*), and that on or before such day caveats must be entered; and any person intending to enter a caveat, shall enter the same at the council office on or before such day so named in the said advertisements; and, having entered such caveat, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

Advertisements.

Petitions.

VIII. Petitions under sections 2 and 4 of the said act must be presented within one week from the insertion of the last of the advertisements required to be published in the *London Gazette*.

Affidavits.

IX. All petitions must be accompanied with affidavits of advertisements having been inserted, according to the provisions of section 4 of the said act, and the 1st and 2d of the rules and the matters in such affidavits may be disputed by the parties opposing, upon the hearing of the petitions.

Copies to be served.

X. All persons entering caveats under section 4 of the said act, and all parties to any former suit or action touching letters patent, in respect of which petitions shall have been presented under section 2 of the said act, and all persons lodging notices of opposition under the first of these rules, shall respectively be entitled to be served with copies of petitions presented under the said sections, and no application to fix a time for hearing shall be made without affidavit of such service.

Notice of objections.

XI. All parties served with petitions shall lodge at the council office, within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions.

Copies.

XII. Parties may have copies of all papers lodged in respect of any application under the said act at their own expense.

Costs.

XIII. The master of the High Court of Chancery, or other officer, to whom it may be referred, to tax the costs incurred in the matter of any petition presented under the said act, shall allow or disallow, in his discretion, all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

PRACTICAL FORMS.

I.

PETITION (*a*).

To the Queen's most excellent Majesty, the humble petition of of, &c.

Sheweth,

That your petitioner, after much trouble and expense, has invented [*or* in consequence of a communication from abroad is in possession of an invention for]

(The title of the invention) (*b*).

(*a*) As to the practice connected with the petition, see *ante*, p. 13.

(*b*) In settling the title of the invention, important considerations, both of a legal and of a practical nature, present themselves. The title must express, correctly and concisely, the subject-matter of the invention. If this be not expressed correctly, as if the title be too narrow to include the whole invention, the patentee will fail in securing the exclusive privilege to the full extent to which he is entitled, and moreover the letters patent themselves may be void, unless amended under the statute (5 & 6 W. 4, c. 83); and if the title be too wide or extensive, that is, including more than the patentee has invented, the letters patent will be void, unless amended. Also the title must not be too particular, minute, and descriptive, or the petitioner will expose himself to opposition from those who are engaged in similar pursuits. The great object of the petitioner is to have a title sufficient in law, but conveying as little information as possible of the nature of his invention.

The grant being made on the consideration of the petitioner having invented that which his title expresses, will be void for false suggestion, and on the ground of the Crown being deceived if he has not really invented that which by his petition he represents himself to have invented.

Bailey, J.: "If a patent be taken out for several things, the entire discovery of all these things is the consideration upon which the King is induced to make the grant. That consideration is entire, and if it fails in any part, it fails *in toto*. It may be considered by the persons who are to advise the Crown as to the propriety of the grant, that the discovery of the three things together may form the proper subject of a patent, though each *per se* would not induce them to recommend the grant." *Brunton* v. *Hawkes*. See *Campion* v. *Benyon*, and *post* 77, n. *d*.

The invention, as described briefly in the title, is to be reduced to certainty by the specification, and the specification will be looked at for this purpose, but the title controls the specification, and the patentee cannot cover any thing by the specification which is not covered by the title, or draw from the specification any *construction whereby to comprehend in* the title any thing which would not be comprehended without recurrence to the specification.

Letters patent for a whole watch, the specification disclosing the invention of a particular movement only, were held void, on the ground of the title being more extensive than the invention. *Jessop's* case.

Letters patent for "an improved method of lighting cities, towns, and villages," and the specification disclosing an improvement of the old street-lamp, of parts known before, by a new combination, the plaintiff was nonsuited. Per *Le Blanc*, J. *Cochrane* v. *Smethurst*.

Letters patent for "a tapered head or hair-brush," the specification describing the improvements as consisting in making the brush with the centre bristles of each

which invention he believes will be of great public

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cluster projecting out beyond the others around the same cluster, were repealed by *scire facias*. *R.* v. *Metcalf*.

Letters patent for "a new and improved method of drying and preparing malt," the specification describing an invention which consisted in submitting malt, prepared by the ordinary process, to a high degree of temperature, and thus producing a colouring material for beer, and not the substance from which beer was to be made, were repealed by *scire facias*. *R.* v. *Wheeler*.

Letters patent being for "a machine for sharpening knives, scissors, and razors," and the specification disclosing a method applicable to knives only, the plaintiff was nonsuited. *Felton* v. *Greaves*.

Letters patent were granted for "certain improvements in steam-engines and in machinery for propelling vessels," and one of the inventions as described in the specification not being an improvement, the grant was held bad for falsity of suggestion. *Morgan* v. *Seaward*.

Parke, B.: "This brings me to the question whether this patent, which suggests that certain inventions are improvements, is avoided, if there be one which is not so. And upon the authorities we feel obliged to hold that the patent is void, upon the ground of fraud on the Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent, where such utility is not suggested in the patent itself as the ground of the grant. That a false suggestion of the grantee avoids an ordinary grant of lands or tenements from the Crown, is a maxim of the common law, and such a grant is void, not against the Crown merely, but in a suit against a third person. (*Travell* v. *Carteret*, 3 Lev. 135. *Alcock* v. *Cooke*, 5 Bing. 340.) It is on the same principle that a patent for two or more inventions, when one is not new, is void altogether, as was held in *Hill* v. *Thompson*, and *Brunton* v. *Hawkes*; for although the statute invalidates a patent for want of novelty, and consequently by force of the statute the patent would be void, so far as related to that which was old; yet the principle on which the patent has been held to be void altogether is, that the consideration for the grant is the novelty of all, and the consideration failing, or in other words the Crown being deceived in its grant, the patent is void, and no action maintainable upon it. We cannot help seeing, on the face of this patent, as set out in the record, that an improvement in steam-engines is suggested by the patentee, and is part of the consideration for the grant, and we must reluctantly hold, that it is void for the falsity of that suggestion. In the case of *Lewis* v. *Marling*, this view of the case, that the patent was void for a false suggestion, does not appear by the report to have been pressed on the attention of the court, or been considered by it. The decision went upon the ground that the brush was not an essential part of the machine, and that want of utility did not vitiate the patent, and besides, the improvement by the introduction of the brush is not recited in the patent itself as one of the subjects of it which may make a difference. We are therefore of opinion, that the defendant is entitled to our judgment on the third issue. It is a satisfaction to know that this objection will not, necessarily, in the present state of the law, destroy the patent, as the objection is one which will probably be removed by the Attorney-General, under the 5 & 6 W. 4, c. 83." *Ibid.*

But generality in the title, if not inconsistent with the invention as described in the specification, will not vitiate the letters patent.

Clegg's patent was "for an improved gas apparatus," and the specification described several distinct inventions applicable to the making and measuring of gas. An objection founded on the discrepancy was overruled at Nisi Prius by Lord Tenterden, and not moved afterwards. *Crossley* v. *Beverley*.

So where the letters patent were "for certain improvements in copper and other plate printing," and the specification described improvements in preparing the surface of the cards used for this purpose, whereby the lines became more clear and distinct, Lord Lyndhurst said, "The description in the patent (i. e. the title) must unquestionably form some idea, and, so far as it goes, a true idea of the alleged invention, though the specification may be brought in aid to explain it. The title in this case is for certain improvements in copper and other plate printing. Copper-plate printing consists of processes involving a great variety of circumstances. The paper must be of a particular description; before it is used it must be damped; it must remain damp a certain time, and must be placed in a certain temperature; the plate must be duly prepared and duly applied; and various processes must be gone through before the impression is drawn off, and brought to a finished state. An improvement in any one of these circumstances, in the preparation of the paper for instance, or in the damping of it, &c., may be truly called an improvement in copper-plate printing. In this case the principal part of the improvement relates to the preparation of the paper. It is material to the perfection of copper-plate printing, that the lines

utility (*c*); that he is the true and first inventor thereof [that the same is new within England, &c. (*d*)], and that the same is not in use [therein] 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 under the great seal of Great Britain (*e*), for the sole use, benefit, and advantage, of his said invention, within that part of your Majesty's United Kingdom of Great Britain and Ireland called England, your dominion of Wales, and town of Berwick-upon-Tweed, and also in the islands of Guernsey, Jersey, Alderney, Sark and Man, and in all your Majesty's Colonies and plantations abroad (*f*), for the term of fourteen years, pursuant to the statutes in that case made and provided. Prayer of the petition.

And your petitioner will ever pray, &c.

II.

DECLARATION.

I of in the county of do solemnly and sincerely declare that, after much trouble and expense, I have invented

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should be as distinct as pos-ible; and if by adding any thing to the surface of the paper more clearness is given to the lines, that is an improvement in copper-plate printing." *Stuart* v. *De la Rue*.

So a title "for improvements in extracting sugar or syrup from cane juice, and in refining sugar and syrups," is supported, if the invention as described be applicable to syrup after having undergone a certain degree of heat, though it fail when applied to the first drawings of the syrup. *Derosne* v. *Fairie*. See *post*, Pr. F. XIV. n. *a*.

It would appear from these cases that a title for improvements in an ultimate result, would be supported by an improvement in any part of the processes producing that result.

The terms "any other substance," will be limited according to the state of knowledge at the time of granting the letters patent.

In Clegg's patent for "an improved gas apparatus," the specification described an apparatus for extracting inflammable gas by heat from pit-coal, tar, or any other substance, from which gas and gases capable of being employed for illumination can be extracted by heat." The invention, as described in the specification, failed in making gas from oil, the use of which, for this purpose, was not at the time of the patent generally known. An objection being taken to the validity of the patent on these grounds, Lord *Tenterden*, C. J. ruled, that the words "other substances" must mean substances of *ejusdem generis*, and such as were known and used at the time of the patent. *Crossley* v. *Beverley*.

(*c*) This allegation seems material, as being part of the consideration in grants of this nature. See *post* 70, n. *w*.

(*d*) The parts within brackets are only to be used in the case of imported patents, and this clause should coincide with the prayer; the petition must also be in all respects consistent with the declaration, or the law officer will order one to be amended, and should pursue the words of the statute.

(*e*) The great seals of the three kingdoms are distinct for the purposes of letters patent. 6 Ves. 708.

In the petition for a patent for Ireland the words are, "under the great seal of Ireland," and for Scotland, "under the seal appointed by the treaty of Union, to be kept and used in Scotland instead of the great seal thereof."

(*f*) See *ante*, p. 15, n. *y*.

[*or* in consequence of a communication from abroad 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 [within, &c. (*g*)], and that the same is not in use by any other person or persons [therein] to the best of my knowledge and belief. (And I further declare that it is my intention to solicit letters patent for Ireland and Scotland (*h*).) And I make this declaration conscientiously believing the same to be true, and by virtue of the provisions of an act made and passed in the session of parliament held the fifth and sixth years of the reign of his late Majesty King William the Fourth, intituled (*i*) "An act to repeal an act of the present session of parliament, intituled, An act for the more effectual abolition of oaths and affirmations taken and made in various departments of the state, and to substitute declarations in lieu thereof, and for the more entire suppression of voluntary and extra-judicial oaths and affidavits, and to make other provisions for the abolition of unnecessary oaths."

A. B. { Declared at this day of A. D. Before me,

A Master in Chancery (*k*).

III.

REFERENCE (*l*).

Her Majesty is pleased to refer this petition to Mr. Attorney or Mr. Solicitor-General (*m*), to consider thereof, and to report his opinion what may be properly done therein; whereupon Her Majesty will declare her further pleasure.

——— (*n*).

(*g*) As in the prayer of the petition. See n. *d*.

(*h*) The effect of the insertion of this clause is, that six months, instead of two, are allowed in England from the date of the letters patent for the purpose of specifying. The usual term for an English patent is two months. For a Scotch patent four months, and for an Irish patent six months are allowed. The patentee is not compelled to proceed with the letters patent for the other countries, should he afterwards see fit to change his intention. *Post* 71, n. *z*.

This clause is omitted in the declaration for letters patent for Ireland or Scotland.

(*i*) 5 and 6 W. 4, c. 62, s. 11. Statutes, *ante*, 52.

(*k*) Or a master extraordinary in Chancery, or a justice of the peace for letters patent for Scotland.

(*l*) The petition and declaration having been lodged at the office of the Secretary of State for the Home Department, may be had in a few days with a reference to the proper officer written upon it, and is to be taken to the chambers of the Attorney or Solicitor-General, at the option of the petitioner.

(*m*) Or the Lord Lieutenant for an Irish, and the Lord Advocate for a Scotch patent.

(*n*) Signed by the Secretary of State for the Home Department.

IV.

CAVEAT (*o*).

Caveat against Her Majesty's letters patent for

[*Object of Invention.*] (*p*)

being granted to any person or persons without notice to A. B.
of
Dated this day of A. D. (*q*).

A. B.

V.

NOTICE OF CAVEAT (*r*).

Sir,

I beg to inform you, that of
in the county of is applying for letters patent for

[*The title.*]

should you consider that the above will interfere with your

(*o*) The caveat is left at the chambers of the Attorney or Solicitor-General, or Lord Advocate, and on a fee of 5*s.* being paid the clerk will enter it in a book, and give notice to the party, according to the terms of the caveat.

The policy of entering a caveat is frequently very questionable. This is not unfrequently the first step taken when an application for letters patent is contemplated. And when a person has communicated his intentions to any parties, or in taking the preliminary steps must necessarily employ workmen, and apprehends that the confidence thus reposed may be taken advantage of, he may by entering a caveat prevent such parties obtaining letters patent for the same invention, but he cannot thereby prevent his own letters patent being rendered void, should the party guilty of such breach of confidence immediately publish it to the world. The caveat affords no security to the real inventor, but another party may thereby be prevented from obtaining letters patent for a stolen invention. On a clear case of obtaining an invention wrongfully, the Attorney-General will grant the patent to the true inventor, and sometimes call on the wrongdoer to undertake not to publish the invention.

Caveats are frequently entered and renewed from year to year, by parties who have patents, or are interested in particular branches of the manufactures in which patents are frequently solicited, with the view of becoming opposing parties to patents in these branches, and of obtaining the earliest information of any improvements which may be contemplated. Such caveats are known by the name of "floating caveats."

(*p*) The description of the invention of which the party wishes to be apprised must be sufficiently distinct, or some inventions may be passed without the party receiving notice.

(*q*) A caveat is valid for one year from the date of its being entered, and may be renewed from year to year.

(*r*) The clerk of the Attorney or Solicitor-General or Lord Advocate on any petition being brought for the report of that officer, compares the title of the invention contained in the petition with the general descriptions in all the caveats which have been entered; and if in his judgment the titles in any of the caveats and in the petition relate to the same subject-matter, he informs the parties having entered such caveats of the application for letters patent. This occasions the delay of at least a week. See *ante*, p. 13, and next Form.

caveat, an answer is requested within seven days (*s*) from the date hereof, otherwise the patent will proceed.

——————————— (*t*).

VI.

REPORT (*u*).

To the Queen's most excellent Majesty.

May it please your Majesty—

In humble obedience to your Majesty's command, signified to me by the Right Honourable one of your Majesty's principal secretaries of state, referring to me the petition of of to consider thereof, and report my opinion what may be properly done therein, which petition sets forth that the petitioner

[*Allegations of the petition.*]

The petitioner therefore most humbly prays

[*Prayer of the petition.*]

And I humbly beg leave to certify unto your Majesty, 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.*]

Upon consideration of all which, 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 your Majesty to encourage all arts and inventions which may be for the public good (*w*), I am humbly of opinion that your Majesty may, by your royal letters patent under the great seal

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(*s*) Seven whole days are allowed exclusive of the day of notice.

(*t*) Signed by the clerk of the Attorney or Solicitor-General or Lord Advocate.

(*u*) This report is to be taken to the Secretary of State's office for the Queen's warrant.

(*w*) Novelty and utility are thus by implication made essential conditions of the grant, and the encouragement of the arts is suggested as the motive of the grant. Consequently, if these conditions and objects do not exist, or cannot be fulfilled, the crown will have been deceived by false suggestion, and the letters patent void.

of Great Britain (*x*), grant unto the petitioner, his executors, administrators and assigns, the sole use, benefit, and advantage of his said invention, within that part of your Majesty's United Kingdom of Great Britain and Ireland called England, your dominion of Wales, and the town of Berwick-upon-Tweed (*y*), for the term of fourteen years, according to the statute in that case made and provided, if your Majesty shall be graciously pleased so to do, with the usual proviso requiring the petitioner within the space of (*z*) calendar months, to be computed from the date of the said letters patent (*a*), to cause a particular description of the nature of his said invention, and in what manner the same is to be performed, under his hand and seal, to be enrolled in your Majesty's High Court of Chancery, otherwise the said letters patent to be void (*b*).

All which is humbly submitted to your royal wisdom.

---------- (*c*).

(*x*) In the case of an Irish or Scotch patent, see terms, *ante* 67, n. *e*.

(*y*) Or according to the prayer of the petition. *Ante* 67, n. *d*.

(*z*) The time usually recommended is six months, if the petitioner has declared his intention of proceeding to obtain letters patent for Ireland and Scotland; also *ante* 68, n. *h*. The letters patent for these countries are longer time in progress to completion than for England; and were this longer time not given, so that the specification was enrolled in this country before the letters patent for the other countries were sealed, the inventions might be carried and published, and put into public use in those countries, before the letters patent for those countries had obtained their respective seals, and the inventor would thereby lose the benefit of his invention in those countries. See *per* Lord *Eldon*, L. C. 6 Ves. 708.

The Attorney or Solicitor-General will, under very special circumstances, grant a longer time. In the case of the printing machine, twelve months was allowed for preparing the specification, on the ground of the great thought, labour, and mathematical calculation, required to perfect the details. Parl. Rep. 6.

Eighteen months were allowed on letters patent being granted to the executor of the real inventor. *Ibid.* 26.

Fifteen months were allowed in the case of Lee's patent. *Ante* 16, n. *z*. But Lord Eldon, in a subsequent case, refused to act on this as a precedent, and would not, on the grounds then adopted by the legislature, affix the great seal to letters patent to Lacy for a lace machine, fifteen months having been allowed for enrolling the specification. Ex parte *Heathcoat*, in re *Lacy*. 29 Rep. Arts, 2d ser. 250.

But if the application be not made at the Report, the time cannot be extended afterwards, except by act of parliament. Ex parte *Koops*, 6 Ves. 509. *Beck*, ex parte, 1 Bro. Ch. Ca. 378. Lord *Eldon*: "I cannot take the great seal from a patent, and repeal it in a most essential point; it is a legal grant, with a proviso for the benefit of all the King's subjects. The patent is void if the proviso be not complied with; you should have applied to the Attorney-General, before the patent passed for a longer time under the special circumstances." *Ibid.*

The time allowed for specifying may be intended for the patentee to mature the mechanical or working parts of his invention. *Crossley* v. *Beverley*.

(*a*) As to the computation of time, see *post*, Pr. F. XIII. n. *r*.

(*b*) This condition cannot be dispensed with, except by act of parliament. See p. 16, n. *z*.

(*c*) Signed by the Attorney or Solicitor-General.

The Report for letters patent for Ireland is signed by the Attorney or Solicitor General for Ireland, and for Scotland by the Lord Advocate.

VII.

Warrant.

THE QUEEN'S WARRANT (*d*).

Victoria R.

Whereas A. B. of in the county of has by his petition humbly represented to us that

[*Allegations of the petition.*]

the petitioner therefore most humbly prays that we will be graciously pleased to

[*Prayer of the petition.*]

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. Our will and pleasure therefore is, that you prepare a bill for our royal signature, to pass our great seal of Great Britain, containing our grant unto him the said A. B., his executors, administrators and assigns, of the sole use, benefit, and advantage, of his said invention, within that part of our United Kingdom of Great Britain and Ireland, &c., for the term of fourteen years, according to the statute in that case made and provided. Provided that the petitioner does, within the space of calendar months (*e*), to be computed from the date of our intended grant, cause a particular description of the nature of his said invention, and in what manner the same is to be performed, by writing under his hand and seal, to be enrolled in our High Court of Chancery, otherwise our said intended letters patent to be void (*f*); and you are to insert in the said bill all such clauses, prohibitions, and provisos, as are usual and necessary in grants of the like nature, and as you shall judge requisite (*g*); and for so doing this shall be your warrant.

(*d*) The warrant is to be taken to the Patent Office for the Bill.

In the case of letters patent for Ireland, the corresponding instrument is called the Queen's Letter, which goes to the Lord Lieutenant of Ireland, and the bill is prepared and all subsequent proceedings conducted at the castle of Dublin.

In the case of letters patent for Scotland, the corresponding instrument is called the Warrant, which goes to the Lord Keeper, and the subsequent proceedings take place at Edinburgh.

(*e*) As to the time, see 71, n. *z*.

(*f*) As to the clause, see p. 16, n. *z*.

(*g*) The clauses usually inserted are as follow: The recital of the petition; the granting and prohibitory part; provisos for avoiding the grant, if not new and beneficial; against authority under this grant interfering with similar grants to others; for avoiding the grant in case it should be invested in more than twelve, as partners, or specification should not be enrolled; lastly, that the letters patent shall be expounded most beneficially for the patentee. A clause also is sometimes inserted in letters patent, which relates to things which especially concern the Crown or the army and navy, for the supply of such things on reasonable terms. See Pr. Forms, XIII.

Given at our court at St. James's, the day of A. D., and in the year of our reign.

By her Majesty's command,

——— ——— (*h*).

To our Attorney or Solicitor-General.

VIII.

CAVEAT AT PATENT OFFICE (*i*).

Caveat at Patent Office.

Caveat against her Majesty's letters patent being granted to A. B. (*k*), of &c., for without notice to C. D. of &c. (*l*)

IX.

BILL FOR THE LETTERS PATENT (*m*).

Bill.

Victoria, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith, to all to whom these presents shall come, greeting.

Whereas A. B. of, &c.

[*The body of the letters patent*] (*n*)

Notwithstanding the not full and certain describing the nature

(*h*) Signed by the Secretary of State for the Home Department. If the Queen's sign manual be to a grant or warrant, it ought to be countersigned by a principal Secretary of State; if it be a direction for another act, as for letters patent to be made, it is sufficient that it be countersigned. Eq. cases, 54, 209.

(*i*) This is entered at the Patent Office. Should the opposing party have been unsuccessful in his first application to the Attorney or Solicitor-General, or should he not have entered a caveat, or opposed the application at the first stage, or on the report, he may oppose it at this stage, or on the bill, and, if successful, the patent is stopped.

(*k*) The caveat at this stage is called a specific caveat, because the name of the petitioner is inserted, whereas the former caveat was general. See Pr. F. IV.

(*l*) A notice being given in the same form as Pr. F. V., the party opposing at this stage has to deposit 30*l.* as a guarantee for the expenses of the opposition. This is applied to the expenses of the hearing; and should the opposition succeed to the expenses of the hearing and the additional expenses which the petitioner has incurred, owing to the opposition not being made at the report. The surplus is returned to the opposing party. Costs are charged on the successful opponent on the principle that he ought to have come sooner, and not allowed the petitioner to go on incurring additional expense, by proceeding to another stage, when he might have stopped it at an earlier stage. And consequently, a caveat entered after the report will not be allowed to stop the signing of a bill, unless the party entering pay the petitioner the expenses of the report, warrant, bill, and hearing, if the invention prove similar—and the expenses of the hearing only, if dissimilar. *Per* Sir Samuel *Romilly*, Solicitor-General.

(*m*) If no caveat be entered at the Patent Office, the bill is drawn out as of course, on the receipt of the warrant.

(*n*) See *post*, Pr. F. XIII.

or quality of the said invention, or of the materials thereto conducing and belonging (*o*). In witness, &c. Witness, &c.

Examined, ——————— (*p*).

Recapitulation of the grant and of the invention.

May it please your most Excellent Majesty—

This contains your Majesty's grant unto A. B. of &c., in the county of &c., of the sole use, benefit, and advantage of his invention of

[*The title of the invention.*]

to hold to him, his executors, administrators and assigns, within England, Wales, and the town of Berwick-upon-Tweed, and also in the islands of Guernsey, Jersey, Alderney and Sark, and in all your Majesty's colonies and plantations abroad, for the term of fourteen years, pursuant to the statute in that case made and provided. Provided that he does within calendar months from the date of the grant hereby intended, cause a particular description of the nature of his said invention, and in what manner the same is to be performed, by writing under his hand and seal, to be enrolled in your High Court of Chancery, otherwise your Majesty's said grant to be void. All such clauses, prohibitions, and provisos, are therein inserted as are usual and necessary in grants of the like nature. And this bill is prepared,

By warrant under your Majesty's sign manual (*q*).

Countersigned by ——————— (*r*).

——————— (*s*).

X.

Signet Bill.

THE SIGNET BILL (*t*)

(*Is a copy of the Bill under the Queen's Signet, and signed by one of the clerks of the Signet*).

(*o*) This latter clause refers more especially to letters patent for grants of lands, than for inventions. It is founded on several statutes, particularly 34 and 35 H. 8, c. 21, and 1 Ed. 6, c. 8, providing for the validity of letters patent, notwithstanding the misnaming of places, and uncertainty as to quantity, and quality, and value.

(*p*) Signed by the Attorney or Solicitor-General.

(*q*) The signature of her Majesty is affixed to the bill.

(*r*) Countersigned by the Secretary of State for the Home Department. *Ante*, p. 73, n. *h*.

(*s*) Signed by the Attorney or Solicitor-General, and dated.

(*t*) This and the following are provided by **27 H. 8. c. 11.** See Statutes, p. 33. The offices of the clerks of the signet and privy seal are now regulated by 57 G. 3, c. 63, and provisions made by 2 W. 4, c. 49, for their abolishment.

XI.

THE PRIVY SEAL BILL (*a*).

Victoria, by the grace of God, &c., to our right trusty and well-beloved cousin and councillor, Charles Christopher, Baron Cottenham, of &c., our Chancellor of that part of our said United Kingdom, called Great Britain, greeting. We will and command that under our great seal of our said United Kingdom remaining in your custody (*w*), you cause these our letters to be made forth patent in form following. Privy Seal Bill.

Victoria, &c.

[*The letters patent set forth.*]

Given under our privy seal at our palace at Westminster, the day of A. D. in the year of our reign.

Examined, ——————— Deputy (*x*).

On the Label.

To our right trusty and well-beloved cousin and councillor, Charles Christopher, Baron Cottenham, our Chancellor of that part of our United Kingdom of Great Britain and Ireland, called Great Britain.

XII.

CAVEAT AT GREAT SEAL (*y*).

Caveat against affixing the great seal of the United King-

(*a*) This warrant is to be taken to the Lord Chancellor's Patent Office, when the letters patent will be prepared and delivered out, if there be no caveat. The expenses at this office amount to 48*l.* 17*s.* 2*d.* Every additional name pays to the Hanaper 2*l.* 13*s.* 6*d.*

(*w*) The Lord Chancellor is the keeper of the great seal. See 74, n. *t*.

(*x*) Signed by one of the deputy clerks to the privy seal.

(*y*) The Lord Chancellor, on application to withhold the great seal, will only consider whether it is legal and right, and not whether the crown ought or ought not to make the grant. Ex parte *Daly*, *Vern. & Scriv.* 499.

The Lord Chancellor refused the great seal to a patent giving fifteen months for enrolment of the specification, on the ground that he would not grant more than the ordinary time. Ex parte *Heathcoat* in re *Lacy*, 29 Rep. Art. N. S. 250.

All that is required from parties opposing a patent, is to show that they have an interest. Ex parte *O'Reily*, 1 Ves. Jun. 112.

If a party, unsuccessful in opposing a patent at an earlier stage, thinks himself injured, and enter a *caveat* at the Chancery Patent Office, when the grant comes for the great seal, the Chancellor will privately examine all parties concerned, and do justice between them.

Letters patent were opposed at the great seal on the ground that the subject-matter was borrowed from an existing grant, and could not be used without it. The Chancellor, on an affidavit that the inventions were dissimilar, sealed the patent. Ex parte *Fox*, 1 Ves. and Bea. 67.

The Chancellor, though averse to *caveats* at the last stage, will not give costs unless the opposition is unreasonable. *Ibid.*

In general, however, the opposing party will have to pay all costs. *Ibid.*

dom to letters patent to A. B. of &c. for &c.
without notice to C. D. of &c.
Dated this day of

C. D.

XIII.

LETTERS PATENT.

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 (*a*).

Recitals. Whereas A. B. of in the county of hath by his petition humbly represented unto us that

[*Allegations of the petition.*]

the petitioner therefore most humbly prayed we would be graciously pleased to grant

[*Prayer of the petition.*]

and we being willing to give encouragement to all arts and inventions which may be for the public good (*b*), are graciously pleased to condescend to the petitioner's request. Know ye,

Give and grant. therefore, that we (*c*), of our especial grace, certain knowledge, and mere motion (*d*), have given and granted, and by these pre-

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A party on affidavit that he has had *good reasons for believing an invention*, for which letters patent are solicited, to have been obtained from him by breach of confidence, has a right to be heard in opposition at the great seal; but it is a right which must be exercised sparingly, and in the discretion of the Court. Per Lord *Brougham*, L. C. *Henson* v. *Alcock*.

(*a*) The direction of letters patent, prior to the time of Richard the Second, was "Omnibus Archiepiscopis ducibus Marchionibus Comitibus Episcopis," &c. This form is now only employed in letters patent for dignities; the words used in other cases are those in the text. 2 Inst. 1.

(*b*) As to this, see 70, n. *w*.

(*c*) In the reign of John, the king was named in the singular number in his letters patent, but since that period the plural has been adopted. 2 Inst. 2.

(*d*) The words *ex speciali gratiâ certâ scientiâ et mero motu*, used in the earlier letters patent, have peculiar legal efficacy, and their import and effect are much discussed in the early cases, most of which relate to grants of lands. It was held, that many defects and irregularities which would have vitiated the grant had all or some of these words been wanting, were cured by them; since they occasioned the grant to be taken in the most liberal and beneficial sense to the grantee, according to the king's intent and meaning expressed in his grant; and although the general words of the grant may be qualified by the recital, yet if the king's intent is plainly expressed in the body of the grant, the intent shall prevail.

The phrase *ex gratiâ speciali* implies bounty, *ex certâ scientiâ* imports science and knowledge, *ex mero motu* manifests that the grant is not made upon the suggestion or suit of the party; but all these are not of any effect or operation if the king be deceived, or if the intent or purpose of his grant cannot by law take effect. Case of the *Alton Woods*, 1 Co. Rep. 27.

The general rule of law, that grants shall be construed most strongly against the grantor, and in favour of the grantee, is said to be reversed when the king is the grantor, unless the grant contains some special words indicative of the

sents, for us, our heirs and successors, do give* and grant unto the said A. B., his executors, administrators and assigns, our especial license, full power, sole privilege and authority, that he the said A. B., his executors, administrators, and assigns, and every of them, by himself and themselves, or by his and their deputy and deputies, servants or agents, or such others as he the said A. B., his executors, administrators and assigns, shall at any time agree with and no others from time to time and at all times hereafter, during the term of years herein expressed, shall and lawfully may make, use, exercise and vend (*e*) his said invention, within that part of our United Kingdom of Great Britain and Ireland, called, &c. (*f*), in such manner as to him the said A. B., his executors, administrators and assigns, or any of them, shall in his or their discretions 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 advan-

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king's bounty. *Ibid.* *Priddle and Napper's* case, 11 Co. Rep. 110.

But no words can cure a false suggestion on the part of the grantee.

In *Arthur Legat's* case the suggestion was, that the patentee had found lands concealed, whereof the crown had no profit. The king granted these lands to him on this suggestion, which being false, the grant was held void. 10 Co. Rep. 109. This case contains a great deal of information as to the import and history of the introduction of these words. See also *Barwick's* case, 5 Co. Rep. 94. *Cholmley's* case, 2 Co. Rep. 54. *Auditor Curle's* case, 11 Co. Rep. 4.

In the *Earl of Devonshire's* case, a grant under the privy seal of broken and unserviceable ordnance and munition, such as was usually taken, held void for false suggestion. 11 Co. Rep. 89.

The doctrine of these cases has been fully recognised in many cases of letters patent for inventions, and particularly in a very recent case, in which it was held, that if it be suggested that certain inventions are improvements, and one of them be not so, the letters patent are void, unless amended under 5 and 6 W. 4, c. 83. *Morgan* v. *Seaward*.

Parke, B.: "The question is, whether this patent, which suggests that certain inventions are improvements, is avoided, if there be one which is not so. And upon the authorities we feel obliged to hold that the patent is void, upon the ground of fraud on the Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent, where such utility is not suggested in the patent itself as the ground of the grant. That a false suggestion of the grantee avoids an ordinary grant of lands or tenements from the Crown, is a maxim of the common law, and such a grant is void, not against the Crown merely, but in a suit against a third person." (*Travell* v. *Carteret*, 3 Lev. 135; and *Alcock* v. *Cooke*, 5 Bing. 340.) It is on the same principle that a patent for two or more inventions, when one is not new, is void altogether, as was held in *Hill* v. *Thompson*, and *Brunton* v. *Hawkes*. See p. 66, n. *b*, for the remainder of the judgment on this point.

(*e*) The words of the statute for working or making is explained by the letters patent, to consist in making, using, exercising, and vending. The import of the word vend, was fully considered by the Court of Queen's Bench on demurrer to a count of a declaration, alleging a breach of the letters patent, by "exposing to sale." The court held, that these words could not necessarily import the vending, so as to be injurious to the patentee, and to constitute an offence against the form of the letters patent, and gave judgment for the defendant. *Minter* v. *Williams*.

Coleridge, J.: "Do these words necessarily import the vending spoken of in the granting part of the patent? I certainly think not; because even assuming that to vend may mean both a selling and exposing to sale (though I rather think that it means the habit of selling and offering for sale), still those two meanings are not co-extensive; the former may include the latter, but a mere exposure to sale, *i. e.* with intent to sell, or for the purpose of selling, is not only not equivalent to a sale, but, as regards the patentee, may be attended with wholly different consequences." *Ibid.*

(*f*) As to this, see p. 15, n. *y*.

tage 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 licenses, powers, privileges and advantages hereinbefore granted or mentioned to be granted unto the said A. B., his executors, administrators and assigns, for and during and unto the full end and term of fourteen years from the date of these presents next and immediately ensuing, and fully to be complete and ended according to the statute in such case made and provided.* And to the end that he the said A. B., his executors, administrators and assigns, and every of them, may have and enjoy the full benefit and the sole use and exercise of the said invention, according to our gracious intention hereinbefore declared, we do, by these presents for us, our heirs and successors, require and strictly command all and every person and persons, bodies politic and corporate, and all other our subjects whatsoever, of what estate, quality, degree, name or condition soever they be, within that said part of our United Kingdom of Great Britain and Ireland, called, &c. aforesaid, that neither they, nor any of them, at any time during the continuance of the said term of fourteen years hereby granted, either directly or indirectly, do make, use, or put in practice the said invention, or any part of the same, so attained by the said A. B. as aforesaid, nor in any wise counterfeit, imitate or resemble the same, nor shall make or cause to be made any addition thereunto or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, deviser or devisers thereof (*g*), without the consent, license, or agreement of the said A. B., his executors, administrators or assigns, in writing,

Prohibitory part.

(*g*) A breach of any of these clauses constitutes necessarily an infringement of the letters patent, and for which the patentee or his representative has a remedy.

The granting and prohibitory parts differ in the terms employed, those of the former being "make, use, exercise, and vend," those of the latter "make, use and put in practice," the only difference in effect being the omission of the word vend. The exact import of the word may be defined to be the habit of selling or offering to sale (*per* Coleridge, J. *supra* n. *d*), and consequently it is, in all cases really injurious to the rights of the patentee, in effect included in the words of the prohibitory clause.

Coleridge, J.: "If we read the word vend as expressly inserted in the prohibitory part of the letters patent, we ought only to give it then the meaning which would effectuate the purpose of the patent, the prevention of acts injurious to the patentee, with as little restraint on the public as possible." *Minter* v. *Williams*.

An article made in one country cannot be brought for the purposes of trading into another, where the article is protected by letters patent.

Quære. Whether such article might not be sold as part of the private effects of such person. See per Lord *Eldon*. 6 Ves. 708.

The various terms and clauses of the prohibitory part will be found to have a particular reference and applicability to the various subject-matters. When the subject-matter is the thing produced, the infringement will generally consist in the making, not however to the exclusion of the using; thus in the case of a stove, a telescope, or paint, or a medicine, the making with a view to use will be the most common infringement; but in a steam engine, or stocking frame, or lace machine, the infringement of making will

under his or their hands and seals, first had and obtained in that behalf upon such pains and penalties as can or may be justly inflicted on such offenders for their contempt of this our royal command; and further be answerable to the said A. B., his executors, administrators and assigns, according to law for his

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generally be of rare occurrence, and subsidiary to the infringement, which is to be referred to the using or putting in practice the invention. When the subject-matter is an application of some known substance, the infringement will generally consist in the putting in practice the invention.

The making of a wheel on the principle of suspension in the manner described in the specification of plaintiff's patent, is an infringement of the letters patent without any evidence of user. *Per* Patteson, J. *Jones* v. *Pearse*. See *Hullett* v. *Hague*.

The using of the thing made, as of the wheel in the preceding case, by any other person, would also be an infringement. See *Haworth* v. *Hardcastle*.

An invention is the same in substance, if the principle be the same in effect, though the form of the machine be different. Per *Gibbs*, C. J. *Bovill* v. *Moore*.

Gibbs, C. J.: "I remember that was the expedient used by a man in Cornwall, who endeavoured to pirate the steam engine. He produced an engine which, on the first view of it, had not the least resemblance to *Boulton* and *Watt's*; where you looked for the head, you found the feet, and where you looked for the feet, you found the head; but it turned out that he had taken the principle of *Boulton* and *Watt's*. It acted as well one way as the other, but if you set it upright it was exactly *Boulton* and *Watt's* engine. So here I make the observation, because I observe it is stated, that one acts upwards and the other downwards; one commences from the bottom and produces the lace by an upward operation; the other acts from above, and produces it by an operation downwards; but that, if the principle be the same, must be considered the same in point of invention."

The infringement on Brunton's patent for anchors, cables, &c. consisted in making the links of the cable with a stay across, having a broad head at each end. *Brunton* v. *Hawkes*.

A small and immaterial variation of the invention will not entitle a person to break in upon a patent. *Gibbs* v. *Cole*.

A slight departure from the specification is an infringement. *Hill* v. *Thompson*.

In a patent for combinations and proportions producing an effect altogether new by a mode and process or series of processes not known before, the use of any of the ingredients singly, or their use in partial combination, omitting some or making use of all, or some others of them in proportions essentially different, and producing a result equally or more beneficial than the patent invention, may constitute an infringement. *Ibid.*

In the majority of cases in which patent rights have been litigated, the substantial defence has been on the ground of want of novelty, or defect in the specification. Great difficulty is frequently experienced in proving the infringement, and the evidence on this point in support of the allegations in the declaration, will be considered hereafter. *Post*, Pr. F. XXI.

The following cases will show what the courts have considered as an infringement or a breach of the letters patent. In Huddart's patent, the infringement was the use of a part of the invention, namely, of a tube to keep the strand together before passing the register plate. *Huddart* v. *Grimshaw*. See *post*.

In Forsyth's patent for "a method of giving fire to artillery," the specification claimed the application of detonating or fulminating powders as a priming, and described several descriptions of locks for discharging the detonating mixtures by a single blow. Held, that the use of detonating powder discharged by locks of a different description, was an infringement. *Forsyth* v. *Riviere*.

In Cochrane and Galloway's patent for "the working or making a manufacture, being a machine or machines for removing the inconvenience of smoke and gas generated in stoves," the leading features of the invention were the retention of a volume of atmospheric air in a condensed state within a close furnace, in order to effect perfect combustion, and was effected by enclosing the furnace in a close chamber, and supplying the air for the support of combustion by injection from a blowing apparatus, the extremity of the flue being partially closed by a loaded valve, or by other means, so as to prevent the rapid escape of the smoke and vapours. The infringement was the placing a furnace in a chamber, and supplying the air by a pump, and the flue terminating in a narrow tube, which produced the same compression as a loaded valve. *Cochrane & G.* v. *Braithwaite & E.*

Sir Thomas *Denman*, C. J.: "At a former trial Lord Tenterden had nonsuited the plaintiffs, from an idea that the valve at the extremity of the flue was too

and their damages thereby occasioned(*h*)*. 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, they or any of them do not, nor shall at any time hereafter, during the said term hereby granted, in any wise molest, trouble or hinder the said A. B., his executors, administrators or assigns, or any of them, or his or their deputies, servants or agents in or about the due and lawful use or exercise of the said invention, or any thing relating thereto.

All justices,&c. forbidden to molest patentee in the exercise of his rights.

Provided always, and these our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted it shall be made to appear to us, our heirs or successors, or any six or more of our or their privy council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general(*i*), or that the said invention is not a new invention as to the public use and exercise thereof(*k*), in

Provisos contrary to law, or not a new invention as to public use, or not invented by patentee.

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essential feature of the plaintiff's invention, and that as the defendants did not use a valve, it could not be said that the two machines were similar; but for his part he did not consider such a valve an indispensable condition of the plaintiff's invention.

"The plaintiff in his specification says, it is a valve or plate by which the smoke, gas, and heated air, are compressed according to the pressure placed on such plate or valve, either by any weight or fluid, or by any other known means of producing required resistance. All that seemed indispensable was, that the required resistance, the necessary degree of compression, should be produced, and if that could be obtained by narrowing the outlet, as well as by a weighted valve, such a mode of effecting the object must be held as being covered by the words, 'any other known means of producing required resistance.'" *Ibid.*

In Lister's patent, the invention consisted in applying heat to the fibres of wool, by making it pass between rollers heated by steam. Held an infringement on Hadden's prior patent, in which the rollers were heated by iron heaters, both patents having claimed the heating of the rollers, and heating rollers for such purposes not being new. *R.* v. *Lister.*

In Fussell's patent, the invention consisted in immersing the roll of cloth in steam. Held an infringement of Daniell's prior patent, in which the roll was immersed in hot water. Both patents were repealed for want of novelty. *R.* v. *Fussell.*

The infringement in Clegg's patent for an improved gas apparatus, was of the gas meter only. *Crossley* v. *Beverley.*

The specification of Minter's patent for an improvement in the constructing, making, or manufacturing chairs, claimed as the invention "the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counterbalance to the pressure against the back of such chair as above described." Held, that any application of this principle to the back and seat of a chair, and producing this effect, was an infringement. Per Lord *Lyndhurst*, C. B. *Minter* v. *Wells.*

(*h*) The only pains and penalties now known to the law are, restraint from infringement under an injunction from the Court of Chancery, damages for the injury sustained by an action at law, and the penalty by statute (5 & 6 Wm. 4, c. 83, s. 7) for using unauthorized the name of the patentee. *Ante* 60, n. *w.* Formerly, before the Statute of Monopolies (21 Jac. 1, c. 3), questions on patent rights were determined in the star chamber, all infringements of patents being considered as contempt of royal authority. 3 Inst. 182, 183.

(*i*) As to these clauses, *ante* 50, n. *i.*

(*k*) These words express more distinctly than the words in the statute the conditions of novelty and non-user. See *ante* 50, n. *h.* They in effect make the public use and exercise, or the utility of an invention, the test of novelty. See *ante* 11, n. *b.* The re-invention and introduction into public use and exercise of that which had been previously invented and abandoned as a failure, is within the words of the letters patent, and has been held a good subject-matter in several recent cases.

that said part of our United Kingdom of Great Britain and Ireland, &c. aforesaid, or not invented and found out (*l*) by the said A. B. as aforesaid; then upon signification or declaration thereof to be made by us, our heirs or successors, under our or their signet or privy seal, or by the lords and others of our or their privy council, or any six or more of them under their hands, these our letters patent shall forthwith cease, determine and be utterly void, to all intents and purposes, any thing hereinbefore contained to the contrary thereof in any wise notwithstanding.

Not to interfere with any letters patent previously granted.

Provided also, that these our letters patent or any thing 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 invented or found out by any other of our subjects whatsoever, and publicly used or exercised in that said part of our United Kingdom of Great Britain and Ireland, &c. aforesaid, unto whom our like

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In the case of Jones's patent for carriage-wheels of iron, on the principle of suspension, similar wheels were made by a Mr. Strutt seventeen years before, and abandoned as useless after two years' trial. Verdict for patentee, *Jones* v. *Pearse*.

The circumstance of ceasing to use would not make an invention new. The question is, whether there was really an invention by Mr. S. in use known to others. If the jury should think his an abortive attempt and a failure, or a mere experiment which did not answer, then it would not invalidate the patent. Per *Pattison*, J. *Ibid.*

Tindal, C. J.: "Another point is, whether the invention was a new invention, and not used publicly in England. That there had been many experiments made upon the same line, and almost tending, if not entirely, to the same result, and that they were known to many persons, is clear; but if they rested in 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, as far as his predecessors have gone, of their discoveries, and add the last link of improvements in bringing it to perfection." *Galloway* v. *Bleaden*. "Experiment in private and public use are the limits between which these cases range." *Cornish* v. *Keene*.

Machinery (paddle-wheels) manufactured in this country under injunctions of secresy, and when finished taken to pieces, packed up, sent abroad, and used up, is not a public use and exercise of the invention in this country, so as to vitiate a subsequent patent. *Morgan* v. *Seaward*.

The words of the statute are, that grants are to be good for the sole working or making of any manner of new manufactures within the realm which others, at the time of making such grants, shall not use, and the proviso in the patent in question founded on the statute is, that if the invention be not a new invention as to the public use and exercise thereof in England, the patent should be void. 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 be 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 secresy, 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 hand, in his own private workshops. Per *Parke*, B. *Ibid.*

(*l*) As to this, see *ante* 49, n. *g*.

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 (*m*).

Provided likewise nevertheless, and these our letters patent are upon the express condition, that if at any time hereafter these our letters patent, or the liberties and privileges hereby by us granted, shall become vested in or in trust for more than the number of twelve persons, or their representatives (*n*), at any

Not to be assigned to more than twelve as partners.

(*m*) See 80, n. *f*, *R.* v. *Lister* and *R.* v. *Fussell*; also 79, n. *f*, *Cochrane & G.* v. *Braithwaite & E.*, in which patents were repealed for want of novelty, and damages recovered for the infringements on a prior patent.

Letters patent are frequently granted for improvements on an existing patent; but the user of such without license, or before the expiration of the term, would be an infringement on the first patent. See *Harmer* v. *Playne*; *Lewis* v. *Davis*; and ex parte *For*.

The Judicial Committee of the Privy Council decided that the rights of a subsequent could not be confirmed adversely to the rights of a prior patentee. In re *Westrupp & Gibbin's* patent. See *ante* 56, n. *n*.

(*n*) The assignees of a bankrupt are the representatives of a bankrupt, and not of the creditors. They hold it in trust for the benefit of the creditors, whose claim or interest is limited to the amount of their debts. Hence if a patent were assigned to twelve persons as partners, one of whom becomes bankrupt, his property in the patent becomes vested in the assignees, whatever their number, as his representatives; and the restrictive clause does not apply, being confined to transfers by the act of the party, and not to those by operation of law. *Bloxam* v. *Elsee*.

This clause is somewhat different from that formerly inserted, and upon which the judgments delivered in the preceding case were delivered. Both, however, were introduced with the same view, namely, in conformity with the statute 6 Geo. 1, c. 18, against the unlimited raising of transferable shares, and to prevent the evil to the public of a too-extended partnership in the monopoly. The following was the clause:—

"Provided likewise nevertheless, and these our letters patent are upon this express condition, that if the said A. B., his executors or administrators, or any person or persons who shall or may at any time or times hereafter, during the continuance of this our grant, have or claim any right, title, or interest, in law or equity, of, in, or to the power, privilege, and authority of the sole use and benefit of the said invention hereby granted, shall make any transfer or assignment, or any pretended transfer or assignment of the said liberty and privilege, or any share or shares of the benefit or profit thereof, or shall declare any trust thereof to or for any number of persons exceeding the number of five, or shall open, or cause to be opened, any book or books for public subscriptions to be made by any number of persons, exceeding the number of five, in order to the raising any sum or sums of money, under pretence of carrying on the said liberty or privilege hereby granted; or shall by him or themselves, or his or their agents or servants, receive any sum or sums of money whatsoever of any number of persons, exceeding in the whole the number of five, for such or the like intents or purposes, or shall presume to act as a corporate body; or shall divide the benefit of these our letters patent, or the liberty and privileges hereby by us granted, into any number of shares exceeding the number of five; or in case the said power, privilege, or authority shall at any times hereafter become vested in, or in trust for more than the number of five persons, or their representatives, at any one time (reckoning executors or administrators as and for the single person whom they represent as to such interest as they are or shall be entitled to in right of such their testator or intestate), 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 be-

one time, as partners (*o*), dividing or entitled to divide the benefits or profits obtained by reason of these our letters patent (reckoning executors and administrators as and for the single person whom they represent as to such interest as they shall be entitled to in right of such their testator or intestate), that then these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine and become void, any thing hereinbefore contained to the contrary thereof in any wise notwithstanding: Provided that nothing herein contained shall prevent the granting of licenses in such manner and for such consideration as they may by law be granted (*p*).

And also * if the said A. B. shall not particularly describe and ascertain the nature of his said invention, and in what manner

Specification to be enrolled.

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come void; any thing hereinbefore contained to the contrary thereof in any wise notwithstanding."

Abbott, C. J.: "Construing the whole clause with reference to that which appears to my mind to be plainly and manifestly its object, it is my opinion that the whole clause is confined to assignments by acts of the party, and does not apply to any assignment or transfer by operation of law, and consequently that it will not apply to an assignment under a commission of bankrupt. Under the Ship Register Acts there are peculiar clauses, requiring any assignment to be notified in a particular manner, as clear and minute as words can be, without any exception of bankruptcy, or any thing of that kind; and yet it has been held that the assignees of a bankrupt take the interest in a ship, though there is no registration of the conveyance." *Ibid.*

The schemes of an uncertificated bankrupt do not pass under the assignment, *provided he does not carry them into* effect until he has obtained his certificate. *Hesse* v. *Stevenson.*

(*o*) It is essential to a partnership that there be a participation in profit and loss. The share of the interest which each partner possesses is immaterial; but all must have a share. Hence the interest of a partner is totally distinct from that of a licensee. The latter has no direct interest in the patent, and it may be for his benefit that the patent should be void.

A bond in violation of the old clause as to five, being conditioned for the payment of a sum of money on the formation of a company of 9,000 shares, to become assignees of letters patent, held illegal, and that no action could be maintained upon it. *Duvergier* v. *Fellowes.*

(*p*) The interest of a licensee under letters patent is totally of a distinct nature from the interest of an assignee of a part; the latter being a partner dividing or entitled to divide the profits with the other assignees; whereas the former has acquired only a right of user for some assigned or assignable consideration. A common license to use an invention, and a sole or exclusive license, are the same in their nature as regards the interest which they convey in the letters patent, neither giving any direct interest therein. *Protheroe* v. *May.*

The following were circumstances of the preceding case, in which the interest under licenses was fully before the Court of Exchequer.

Letters patent were granted to Arthur Dunn for certain improvements in the manufacture of soap, and became vested in twelve several persons as partners dividing or entitled in their own rights respectively, and not by representation, to divide the benefits and profits obtained by reason of the said letters patent. These partners agreed with Guppy and Protheroe to grant to them an exclusive license for the use and exercise of their invention within the city of Bristol, and a circuit of thirty-five miles therefrom. This license became assigned to and vested in a company or copartnership of more than twelve persons. The partners granted twelve other similar exclusive licenses for twelve other districts, eleven being granted severally to eleven individuals, and the twelfth to a co-partnership of thirteen persons. It was held—

1. That the grant of the first-mentioned exclusive license did not invalidate the letters patent.

2. That the assignment to and vesting of that license in the partnership of more than twelve did not invalidate the letters patent.

3. That the grant of the twelve last-mentioned exclusive licenses, nor of any of them, did not invalidate the letters patent.

4. That if the grantees of all the licenses were to coalesce and become jointly interested in such licenses, the letters patent would not be thereby invalidated.

5. That the letters patent would not be invalidated if the districts covered by

the same is to be performed, by an instrument in writing under his hand and seal (*q*), and cause the same to be enrolled in our High Court of Chancery, within calendar months next and immediately after the date of these our letters patent (*r*). *

Articles required for the service of the Crown to be supplied.

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, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the master-general of our ordnance, or the principal officers of the ordnance for the time being, that then and in any of the said cases these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly

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the licenses had included the whole of England, Wales, and Berwick-upon-Tweed, and the Colonies. *Ibid.*

Parke, J.: "Do you mean to contend that a license is to be considered as part of the patent? If not, how can it invalidate it?" *Ibid.*

The court in the preceding case expressed a decided opinion that an exclusive license was no more than a common license, and that it was wholly immaterial to the validity of the patent in what number of persons a license was vested, whether such license was an exclusive license or not. *Ibid.*

Hence any number of licenses, either common or exclusive, may be granted.

(*q*) As to the origin and introduction of this clause, *ante* 6, n. *o*. The instrument to which it gives rise, is called the specification; *post*, Pr. F. XIV.

A valid specification, according to the import of these words, must be a particular and accurate description of the nature and extent of the invention, so that a person acquainted with that department of the arts and manufactures to which the invention relates, may be able to ascertain by reasonable care what is the subject of the temporary monopoly, and what he must avoid as an infringement.

Further, it must be a particular and accurate description of the manner in which the invention is to be performed, so that the public, that is, any person of moderate skill and conversant with the department of the arts and manufactures to which it relates, may at the expiration of the term practise and enjoy the invention in as ample and beneficial a manner as the patentee himself.

The failure of any of these conditions will be a breach of the above clause, and the letters patent may be infringed with impunity, and repealed by *scire facias*, unless amended under 5 & 6 W. 4, c. 83.

These conditions being in law conditions precedent to the enjoyment of the right, the compliance with them or the specification is said to be the price which the patentee pays for his limited monopoly, and the whole may be viewed as a contract and bargain between the patentee and the public, to be construed like other bargains, as principles of perfect good faith. Per Lord *Eldon*, L. C.

For the particular rules for the construction of this instrument, and the defects which have been held to vitiate, see Pr. F. XIV. and notes.

(*r*) The months are to be reckoned exclusive of the day of the date of the letters patent, but inclusive of the day of enrolment of the specification.

Letters patent dated 10th May, contained a proviso for the enrolment of the specification within one calendar month next and immediately after the date thereof. The specification was enrolled on the 10th of June following. Held to be in time, as the month did not begin to run till the day after the date of the letters patent. *Watson* v. *Pears*, 2 Camp. 294. But when the computation of time is to be made from an act done, the day on which the act is done is to be included in the reckoning. *Castle* v. *Curditt*, 2 Camp. 296 n, and *Glassington* v. *Rawlings*, *ibid.*

The specification will be in time if lodged at the enrolment office by 12 o'clock at night of the day on which the time expires.

The reason of allowing this length of time is, that the patentee may perfect his invention, including in the specification all such details as may be necessary for properly carrying out the idea which he had conceived at the time of obtaining the letters patent. See per Lord *Tenterden*, C. J. *Crossley* v. *Beverley*.

The enrolment of the specification, that is the performance of this condition, cannot be dispensed with except by act of parliament. *Ante* 16, n. *z*.

cease, determine, and become void, any thing hereinbefore contained to the contrary thereof in any wise notwithstanding (*s*).

And lastly, we do by these presents, for us, our heirs, and successors, grant unto the said A. B., his executors, administrators and assigns, that these our letters patent, or the enrolment (*t*) or exemplification thereof (*u*), 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 (*v*), as well in all our courts of record as elsewhere, and by all and singular the officers and ministers whatsoever of us, our heirs, and successors, in that part of our said United Kingdom of Great Britain and Ireland, &c. aforesaid, and amongst all and every the subjects of us, our heirs, and successors, whatsoever and wheresoever, notwithstanding the not full and certain describing the nature or quality of the said invention, or of the materials thereunto conducing and belonging (*w*). In witness whereof we have caused these our letters to be made patent. Witness ourselves at Westminster this day of in the year of our reign.

Letters patent to be construed in the sense most beneficial to the patentee.

By writ of Privy Seal,

EDMUNDS. (*x*)

(*s*) Letters patent granted to Pering for improvements in anchors, contained a clause, that the patentee should supply for his Majesty's service all such articles of the invention as should be required, on such reasonable terms as should be settled by the Lords of the Admiralty. The latter used the invention, but did not buy the articles of the patentee, and the Court of Queen's Bench refused a mandamus to compel them to settle the terms according to the patent. Ex parte *Pering*.

(*t*) The clerk of the great seal enrols the privy seal bill, from which the letters patent are copied, and the privy seal bill so enrolled is the record in the High Court of Chancery.

(*u*) The exemplification is the copy under the great seal of the privy seal bill so continuing of record in the Court of Chancery. As to its admissibility in evidence, *ante* 39, n. *h*.

(*v*) This proviso, that the grant shall be taken and construed in the manner most favourable for the patentee, expresses what the common law would have inferred from the terms of the grant. See *ante* 76, n. *d*.

(*w*) This clause has reference to the description of the invention contained in the letters patent, that is, to the title, and not to the specification, since the particularly describing and ascertaining the nature of the invention, and in what manner the same is to be performed by means of that instrument, is one of the conditions of the grant, and as such must be construed and performed strictly. *Supra*, n. *q*.

This clause expresses rather more than the common law would have inferred from the terms of the grant, since in *Doddington's* case a grant of lands was held void because the words of the letters patent did not comprehend extent, number, nature, quality, and certain name of the land, nor any convenient certainty thereof. 4 Co. Rep. 32.

(*x*) The clerk of the letters patent. He is appointed by royal warrant under the sign-manual. 3 & 4 W. 4, c. 84.

XIV.

SPECIFICATION (*a*).

To all to whom these presents shall come, greeting; I, the said A. B., of in the county of send greeting; Whereas her most excellent Majesty Queen Victoria, by her letters patent under the great seal of Great Britain, bearing date at Westminster the day of A. D. in the year of her reign, did give and grant unto me, the said A. B., my executors, admi-

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(*a*) The clause in the letters patent giving rise to this instrument points out the two following characteristics or conditions of its validity:

1. It must particularly describe and ascertain the nature of the invention.

Every patent being a monopoly, and the specification being designed to give the public warning of the precise extent of the privilege conferred, such warning must be clear, and accurately describe the invention. *Campion* v. *Benyon*.

2. It must particularly describe and ascertain in what manner the invention is to be performed. The meaning of the specification is, that others may be taught to do the thing for which the patent is granted. It must, therefore, contain the fullest description of all particulars necessary for the public to exercise the invention. Per *Ashurst*, J.

The grant of letters patent is in the nature of a purchase for the public, who are entitled to a free participation in the benefit of the invention at the end of the time limited. The specification may be said to be the consideration for the bargain between the public and the patentee, and must be judged on the principle of good faith. See per *Lord Eldon*, 11 East 105, and 3 Meriv. 161. All the rules which are laid down with respect to the construction of specifications have reference to a breach of one of these conditions.

Hence, if the specification discloses an invention different from that on the suggestion of which the letters patent were granted, that is, if the title and specification are not co-extensive and do not support each other, the invention for which the letters patent were granted is not described in the specification, and the letters patent will be voidable on this account, as well as for the failure of the consideration or the falsity of the suggestion. *Ante* 65, n. *b*.

The spirit of the preceding characteristics and of the decided cases may be expressed as follows:

The specification must be true, full, clear and exact; must give names, quantities, and proportions, with accuracy and definiteness; must distinguish new from old; must direct how to use, exercise, and put in practice the invention in the most advantageous and economical manner known to the patentee.

A specification made with the utmost good faith, free from any material breach of the above conditions, and such as will enable those reasonably conversant with the particular branch of the arts to which the invention relates, to use, exercise, and practise the invention, will be sufficient in law.

The latters patent and the specification, which are to be taken together, and considered as one instrument, will therefore be construed according to their sense and meaning as collected from the terms used in them; which terms are to be understood in their plain, ordinary, and popular sense, unless they have generally, in respect to the subject-matter, as by the known usage of trade, or the like, acquired a peculiar sense distinct from the popular sense of the same words, or unless the context evidently points out that they must, in the particular instance, be understood in some special or peculiar sense. *Robertson* v. *French*, 4 East, 135.

The specification is addressed to artists, or persons of competent skill in the branch of the manufactures and processes to which the invention relates. Hence known machinery need not be described, and technical terms will receive their usual construction. It was held no objection to a specification that it contained French terms. Per *Abbott*, C.J., *Bloxam* v. *Elsee*.

Eyre, C. J.: "Suppose a newly invented chemical process, and the specification should direct that some particular substance should be poured upon gold in a state of fusion, it would be necessary, in order to this operation, that the gold should be put into a crucible, and should be melted in that crucible; but it would be hardly necessary to state in the specification the manner in which, or the utensils with which, the operation of putting gold into a state of fusion was to be performed. They are mere incidents,

nistrators and assigns, her especial license, full power, sole privilege and authority, that I, the said A. B., my executors, administrators and assigns, and such others as I, the said A.B., my executors, administrators and assigns, should at any time agree with and no others, from time to time, and at all times thereafter during the term of years therein mentioned, should and lawfully might make, use, exercise and vend within that part of the United Kingdom of Great Britain and Ireland, &c. my invention, &c.

[*Title of invention.*]

In which said letters patent there is contained a proviso that I

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with which every man acquainted with the subject is familiar." 2 *H. Bl.*, 497.

Thus the phrase "discolouring syrups" in a specification, the discolouring being a depriving or discharging of colour in the sense of the French *decolore*; the meaning, however, was apparent, from the context; also other purely technical terms, as "baking" and "extract," were held not to vitiate. *Derosne* v. *Fairie.*

The following are some of the principal cases in which the specification has been held bad:

For insufficiency and unnecessary ambiguity. Arkwright's patent was bad on this, among other grounds. *R.* v. *Arkwright.*

Buller, J.: "A patentee must disclose his secret in the specification, so that others may be taught by it to do the thing for which the patent is granted. It must teach what the art is, and put the public in possession of the secret, in as ample and beneficial a way as the patentee himself uses it. There is strong evidence of several sensible men, that know something of this particular business and mechanics in general, that they cannot do it; then it is not sufficiently described to support the patent. In the case that Mr. A. printed for the House of Commons, he admits that he has not properly described how the machines were made. Some articles in the specification are proved to be of no use. Why was it there? That could answer no purpose but to perplex. The specification does not distinguish between what is intended for preparing cotton and what for flax or wool, though they require very different preparation." *Ibid.*

In Turner's patent for a yellow colour and white lead, the process described did not produce what it professed. The degree of heat requisite upon which the colours depend was not stated. Some articles were enumerated which would not answer, and the white substance produced was not that commonly known as white lead. *Turner* v. *Winter.*

Ashurst, J.: "If there is any unnecessary ambiguity introduced, or any thing which tends to mislead the public, the patent is void. The patent is for making white lead and two other things. If the process directed does not produce that which it professes to do, the patent is void." *Ibid.*

In Crompton's patent for "an improved mode of drying and finishing paper," the invention was described as consisting in conducting paper by means of cloth or cloths against a heated cylinder, which cloths might be made of any suitable material; but the patentee preferred them to be made of linen warp and woollen weft; whereas he knew, from repeated trials, that no other substance would do. *Crompton* v. *Ibbotson.*

Lord *Tenterden*, C. J.: "Other persons, misled by the terms of this specification, may be induced to make experiments which the patentee knows must fail; and the public, therefore, has not the full and certain benefit of the invention—the only ground on which the patent is obtained." *Ibid.*

In Zinck's patent for a new method of making verdigris, the specification made no mention of aqua-fortis, which Zinck was accustomed to put secretly into the boiler in order to hasten the solution. *Wood & others* v. *Zimmer & others.*

Gibbs, C. J.: "A patentee must disclose the most beneficial manner he possesses of carrying on the invention with as little labour and expense as it costs himself. The price he pays for his patent is, that he will enable the public to practise in the same way, and with the same advantages. If any thing which gives an advantageous operation is concealed, the grant is void. Though this specification should enable a person to make verdigris substantially as good without aqua-fortis as with it, still as it would be with more labour, the omission is a prejudicial concealment, and a breach of the terms the patentee made with the public." *Ibid.*

In Macfarlane's patent for umbrellas, the specification did not describe and ascertain the improvements with sufficient particularity. *Macfarlane* v. *Price.*

Lord *Ellenborough*, C. J.: "The speci-

the said A.B. shall particularly describe and ascertain the nature of my said invention, and in what manner the same is to be performed, by an instrument in writing under my hand and seal, to be enrolled in her said Majesty's High Court of Chancery within calendar months next and immediately after the date of the said in part recited letters patent, as reference being thereunto had will more fully and at large appear.

Now know ye, that in compliance with the said proviso, I, the said A. B., do hereby declare the nature of my invention, and the manner in which the same is to performed is particularly described and ascertained in and by the following instrument in writing (reference being to the letters and figures therein contained, and to the drawings thereunto annexed, or to the drawings in the margin (*b*). My invention consists or has reference to, &c.

[*The introduction, description, and claim.*] *(c)*

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fication ought to state what is new and what is old, so that a person by reading it ought to be warned against the use of the particular invention. This specification does not say what is new and what was old, but it comprises that which is old, as well as that which is new, and it cannot be collected from the whole in what the improvement consists." *Ibid.*

In Savory's patent, the specification gave three distinct recipes for preparing the ingredients, but did not give any names to them, which were well known substances. *Savory* v. *Price.*

Abbott, C.J.: "It is the duty of a patentee to specify the plainest and most easy way of producing that for which the patent is granted, and to make the public acquainted with the mode which he himself adopts. By reading this specification, we are led to suppose a laborious process necessary to the production of the ingredients, when in fact we might go to any chemist's shop and buy the same things ready made. The public are misled by this specification, which tends to make people believe that an elaborate process is essential to the invention." *Ibid.*

In Christ's patent for improvements in copper-plate printing, the specification described a substance as the finest and purest chemical white lead, and it was proved that no such substance was known to the trade, and that the material employed could be obtained only at one shop and under another name. *Sturtz* v. *De la Rue.*

Lord *Lyndhurst*, L.C.: "It is said that the description in the specification will be sufficient, if the substance is known in the trade by the name of the purest and finest white lead, or the purest and finest chemical white lead; but it does not appear that there is any such substance generally known in the trade by that denomination." *Ibid.*

(*b*) Drawings are part of the specification when referred to in it, and may render a specification good, which is otherwise defective.

Abbott, C. J.: "If a drawing or figure will enable a workman of competent skill to construct the improvement, it is as good as any written description." *Brunton* v. *Hawkes.*

Lord *Ellenborough*, C.J.: "The inventor should say, my improvement consists in this, describing it in words if he can, if not, by reference to figures." *Macfarlane* v. *Price.*

It was objected to a specification, that it contained some obscurity because of French words referring to a scale on the drawings.

Abbott, C. J.: "The inventor of a machine is not tied down to make such a specification as, by words only, would enable a skilful mechanic to make the machine, but he is to be allowed to call in aid the drawings which he annexes to the specification; and if by a comparison of the words with the drawings, the one will explain the other sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient." *Bloxam* v. *Elsee.*

(*c*) It is extremely convenient in practice to adopt some mode of dividing the subject-matter of the specification. By an introductory or historical part, the patentee can bring fully and fairly before the world what was the state of invention in the particular branch of the arts to which his invention relates prior to his

In witness whereof, I, the said A. B., have hereunto set my hand and seal this day of A.D.

A. B. (seal)

Taken and acknowledged by
A. B., party hereto, the
day of 1840, at

Before me, ————————
A Master in Chancery.

CERTIFICATE OF ENROLMENT (*d*).

Enrolled in her Majesty's High Court of Chancery the day of , in the year of our Lord one thousand eight hundred and forty, being first duly stamped according to the tenor of the statute made for that purpose.

Signed ———————— (*e*)
By the Clerk of the Enrolments.

XV.

PROCEEDINGS.

Under 5 and 6 Will. 4, c. 83, s. 1.

PETITION (*f*).

Petition for leave to enter disclaimer or memorandum of alteration.

The petition of A. B., of in the county of manufacturer, sheweth,

That your petitioner obtained (*g*) her Majesty's letters patent

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patent. Many patentees have failed on trials at law, from its not being distinctly understood in what respect the subsequent invention differed from preceding ones, so as to be an improvement on the state of knowledge at the time of the grant.

The nature of the descriptive part will depend on the particular invention which is the subject of the letters patent.

The claim made in the specification is the most important part, as the whole validity of the letters patent may depend on the manner in which this is made.

In Cutler's patent, the specification having described the stove, claimed as the invention the introduction of the fuel at the lower part of the grate, in a perpendicular or oblique direction. It was held that the patentee had confined himself to a principle which was not new, although the application as described might be new. Per Lord *Ellenborough*, C. J. *R.* v. *Cutler*.

In Sanders' patent for buttons, the specification described two things, neither of which was sufficient to support a patent, and did not claim a third thing, which, in combination with the other two, might have been sufficient. *Sanders* v. *Aston*.

Littledale, J.: "Neither the button nor the flexible shank is new, and they do not, by merely putting them together, constitute such an invention as can support a patent. It is contended that the operation of the collet under the present patent is new; but that is not so stated in the specification, and it is in fact only one mode of carrying it into effect." *Ibid*.

(*d*) Indorsed on the original copy of the specification, which is returned to the party after being copied on the rolls.

(*e*) One of the clerks in the Petty Bag Office, or the Enrolment Office, or the Rolls Chapel Office. *Ante* 17, n *z*.

(*f*) See Rules of Practice, *ante* 63, 1. The petition is to be accompanied with a copy of the original specification and proposed disclaimer or memorandum of alteration.

(*g*) If the petitioner be assignee or executor of the patentee, this must be stated.

under the great seal of Great Britain, bearing date at Westminster the day of A. D. for

[*Title of the invention.*]

And whereas your petitioner, in pursuance of a proviso in the said letters patent contained, did particularly describe and ascertain the nature of his said invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and did cause the same to be enrolled in her Majesty's High Court of Chancery at Westminster, on the day of A. D. ; and whereas since the said letters patent were so granted, and the said instrument or specification was so enrolled as aforesaid, your petitioner has discovered that part of the said invention, as described in the said specification, is not new as to its public use and exercise within that part of the United Kingdom of Great Britain and Ireland, called England, the dominion of Wales, and town of Berwick-upon-Tweed, *or* cannot be made, used, and exercised in the manner therein described (*h*).

Wherefore your petitioner is desirous, in pursuance of the statute in such case made and provided, to enter a disclaimer of part of the title of the said invention and of the said specification; and a memorandum of alteration in the said title and specification (*as the case may be*) not being such disclaimer or memorandum of alteration as will extend the exclusive right granted by the said letters patent; that is to say, in the title I am desirous of disclaiming the words, &c., and in the specification the words, &c.

Your petitioner, therefore, prays leave of her Majesty's Attorney (*or* Solicitor) General, certified by his fiat and signature as by the statute in such case made and provided, to enter with the clerk of the letters patent of England the said disclaimer and memorandum of alteration, a copy of which, signed by your petitioner, is left herewith in the form in which your petitioner is desirous the same should be entered as aforesaid.

Disclaimer and Memorandum of Alteration (*i*).

Disclaimer and memorandum of alteration.

To all to whom these presents shall come, I, A. B., of , send greeting; Whereas her most excellent

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(*h*) The special circumstances must be set forth here. As to these, see 92, n. *l*.

(*i*) A copy of the proposed disclaimer or memorandum of alteration is to be left with the petition.

Majesty Queen Victoria, by her letters patent under the great seal of Great Britain, bearing date at Westminster the day of , in the year of her reign, did for herself, her heirs and successors, give and grant unto me, the said A. B. my (or unto one C. D. (*k*), his) executors, administrators and assigns, her especial license, full power, sole privilege and authority, that I, the said A. B., my executors, administrators or assigns, and such others as I, the said A. B., should at any time agree with, and no others, from time to time, and at all times thereafter during the term of years therein expressed, should and lawfully might make, use, exercise and vend within that part of the United Kingdom of Great Britain and Ireland, &c., my said invention of

[*Title of the invention.*]

And whereas I, the said A. B., in pursuance of a proviso in the said in part recited letters patent contained, did cause a particular description of the nature of my said invention, and in what manner the same is to be performed, by an instrument in writing, under my hand and seal, to be enrolled in her said Majesty's High Court of Chancery, on the day of A. D.

[And whereas, by a certain indenture of assignment, bearing date on or about the day of A. D., made between the said C. D., of the one part, and A. B. of the other part, the said letters patent were for the considerations in the said indenture mentioned, assigned, transferred, and set over unto the said A. B., his executors, administrators, and assigns.]

And whereas I, the said A. B., am desirous, for good and sufficient reasons hereinafter mentioned, to enter a disclaimer of that part of the title of my said invention hereinafter next mentioned (*or*) of the specification (*or*) memorandum of alteration in title in the specification (*as the case may be*), and have obtained leave of her Majesty's Attorney (*or* Solicitor) General, certified by his fiat and signature, according to the form of the statute in such case made and provided. Know ye, therefore, that I, the said A. B., do hereby disclaim the following part of the title of my said invention; that is to say, I disclaim the words

[*The words disclaimed.*]

And also, that I hereby disclaim the following part (or parts) of the said specification; that is to say, I disclaim the words

[*The words disclaimed.*]

(*k*) If by any other party than the patentee, this must appear, and the subsequent clauses adapted accordingly.

And further on, in the claiming part of the said specification, I disclaim the words, &c.

And also, that I, the said A. B., do hereby enter the following memorandum of alteration; that is to say, in the title of the said invention; that is to say, I alter, &c.

[*The alterations.*]

and also in the specification, I alter, &c.; and further on, in the claiming part of the specification, I alter, &c.

And I, the said A. B., do also hereby declare that my reasons for making and entering the above disclaimer and memorandum of alteration are as follows; that is to say,

[*The reasons*] (*l*).

And I, the said A. B., do hereby further declare that the above disclaimer and memorandum of alteration is not such disclaimer or such alteration as will extend the exclusive right granted by the said letters patent.

In witness whereof I have hereunto set my hand this day of A. D.

A. B.

To the Clerk of the Patents of England (*m*).

I have this day granted my fiat, giving leave to the above-mentioned A. B., to file with you the above written disclaimer and memorandum of alteration.

(Signed) ————————, (*n*)

(*l*) The particular reasons will, of course, depend on the special circumstances of each case. Want of novelty or utility in a part failure of a particular arrangement or combination; indistinctness in a claim, whereby the patentee may be thought to claim what he does not; and generally ambiguity, whereby the Crown may have been deceived and the public may be misled. See disclaimers, &c., 5, 6, 12, 13, Rep. Arts, N.S.

Falsity of suggestion, as that an invention is an improvement, when it is not. Per *Parke*, B. *Morgan* v. *Seaward*, *ante* 66, n. *b*. This patent was amended, after verdict and judgment against the patentee on the above grounds.

The practice, as regards the memorandum of alterations, presents considerable difficulties, since it will often be a very nice question whether or not such memorandum extends the right granted by the letters patent. A title or specification may be so drawn, that a simple disclaimer would have this effect; but questions of this nature will arise far more frequently on a memorandum of alteration. The alterations will, in general, be confined to remedying the immediate effects of the disclaimer, as by rendering the various parts consistent with each other and with the context.

(*m*) See Rules of Practice, *ante* 63, V.

(*n*) By the Attorney or Solicitor-General, or Lord Advocate.

Advertisement (*o*).

Advertisement ordered by Attorney or Solicitor-General.

In the matter of letters patent granted to A. B., of, &c., for &c., bearing date, &c.

Notice is hereby given, that under and by virtue and in pursuance of an act of parliament made and passed in the session of parliament held in the 5th and 6th years of his late Majesty's reign, intituled "An act to amend the law touching letters patent for inventions," a petition has been presented to her Majesty's Attorney (*or* Solicitor) General (*or* Lord Advocate), for leave to enter a disclaimer or memorandum of alteration, as to so much, &c. (*set forth the proposed disclaimer or alteration as in the petition*) of the title or of the specification of the invention, for the sole making, using, exercising, and vending of which letters patent were granted to A. B., of, &c.

A. B. or Agent.

Caveat (*p*).

Caveat against disclaimer or memorandum of alteration.

Caveat against a disclaimer or memorandum of alteration in the matter of letters patent granted to A. B., of, &c., for his invention of

[*Title of invention.*]

and bearing date at Westminster, &c., without notice to C. D., of, &c.

Dated this day of A. D.

C. D.

XVI.

CONFIRMATION, &c.

Under 5 and 6 Will. 4, c. 83, s. 2.

Advertisement (*a*).

In the matter of letters patent granted to A. B., of, &c., for, &c., bearing date at Westminster, &c.

(*o*) The law-officer of the Crown will use his discretion as to ordering advertisements of the proposed disclaimer.

If an advertisement is ordered, the consideration of the matter will not be resumed within ten days from the first publication of the advertisement. *Rules*, 63, III.

(*p*) The statute provides that any person may enter a caveat in like manner as caveats are now entered, *ante* 54. By the rules of practice, a caveat may be entered at any time before the actual issuing of the fiat; and any party lodging a caveat is to have seven days' notice of the next meeting respecting such disclaimer, *ante* 63, IV.

(*a*) This is to be inserted three times in the *London Gazette*, and in three London papers, and in some provincial papers. *Ante* 63, VI.

Notice is hereby given, that under and by virtue of the second section of an act of parliament made and passed in the session of parliament held in the 5th and 6th years of his late Majesty's reign, intituled "An act to amend the law touching letters patent for inventions," the patentee (*or* the assignee) of letters patent granted to A. B., of, &c., for, &c., bearing date, &c., intends to petition her most gracious Majesty in council to confirm the said letters patent, or to grant new letters patent (*b*).

And notice is hereby further given, that an application will be made on the day of to the Judicial Committee of the Privy Council, for a time to be fixed for hearing the matter of the said petition (*c*).

The day A. D.

A. B., or Agent of Petitioner.

Notice of Opposition (*d*).

Notice is hereby given, that I intend to oppose the petition in the matter of letters patent granted to A. B. of, &c., for, &c., bearing date, &c., for a confirmation of the said letters patent, (*or*) for a grant of new letters patent.

C. D.

Petition for Confirmation (*e*).

To the Queen's most excellent Majesty in council, the humble petition of A. B., of, &c.,

Sheweth,

That your petitioner (one C. D., of, &c.), after much trouble and expense, invented, &c., which invention is of great public utility. That your Majesty was graciously pleased in consideration thereof, by your royal letters patent under the great seal of Great Britain, bearing date at Westminster, &c., to grant to your said petitioner, his executors, administrators and assigns, the sole use and exercise of the said invention, within that part of the United Kingdom of Great Britain and Ireland called England, the dominion of Wales, and town of Berwick-upon-Tweed, for the term of fourteen years from the date of the said letters patent.

(*b*) The object of the petition is to be stated in the advertisement. *Ante* 63, VI.

(*c*) This clause is essential, and the time must be not less than four weeks from the date of the publication of the last of the advertisements in the *London Gazette*. *Ibid.*

(*d*) This notice must be lodged at the Council Office, Whitehall, on or before the day named in the advertisement; and the opposing party is entitled to four weeks' notice. *Ibid.*

(*e*) This petition must be presented within one week of the last of the advertisements in the *London Gazette*. *Ante* 64, VIII.

If there has been any suit or action touching the letters patent sought to be confirmed, the parties to such suit or action must have notice of the petition before it is presented. See *Statutes*, *ante* 55 & 64, X.

That your petitioner, in pursuance of a proviso in the said letters patent, did particularly describe and ascertain the nature of his said invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and did cause the same to be enrolled in your Majesty's High Court of Chancery at Westminster on the day of

A. D.

[That by a certain indenture of assignment, bearing date on or about the day of , between the said A. B. of the one part, and your petitioner of the other part, the said letters patent were for the considerations in the said indenture expressed, assigned, transferred and set over unto your petitioner, his executors, administrators and assigns.]*

That it hath, since the date of the said letters patent, been proved, *or* specially found by the verdict of the jury, in a certain action (*state the parties and the action fully*), that your petitioner was not the first inventor of the said invention, *or* of some part of the said invention, by reason of one E. F. having invented the same before the date of the said letters patent.

That your petitioner has, since the date of the said letters patent, discovered that a certain other person, to wit, one C. D., of, &c., had, unknown to the said patentee, invented or used the said invention, or some part thereof, before the date of the said letters patent.

That your petitioner at the time of the said letters patent believed himself to be the first and original inventor of the said invention (*f*).

That the said invention, or any part thereof, had not been publicly and generally used before the date of the said letters patent.

That your petitioner has advertised, &c. (*state the particulars* (*h*).

Your petitioner therefore humbly prays that your Majesty will be graciously pleased to confirm the said letters patent, or to grant new letters patent, according to the form of the statute in such case made and provided.

And your petitioner, &c.

(*f*) This and the next allegation must be supported by affidavits.
(*h*) This must be verified by affidavits.

XVII.

PROLONGATION OF TERM.

Under 5 & 6 W. 4, c. 83, s. 4.

Advertisement (*a*).

In the matter of letters patent granted to A. B. of &c., for &c., bearing date, &c.

Notice is hereby given, that under and by virtue and in pursuance of an act made and passed in the session of parliament held in the fifth and sixth years of his late Majesty's reign, intituled "An act to amend the law touching letters patent for inventions," the patentee intends to petition her Majesty in council, praying her Majesty to grant him a prolongation of his term of sole using and vending his invention, under letters patent granted to A. B. of &c., for &c., bearing date, &c. And notice is hereby further given, that an application will be made on the day of, &c.(*b*) to the Right Honourable the Lords of the Judicial Committee of the Privy Council, to fix an early day for the hearing of the matters contained in the said petition, and all persons desirous of being heard in opposition to the prayer of the said petition, are requested on or before the day aforesaid to enter a caveat at the Privy Council Office (*c*).

A. B. Patentee *or* Agent.

Petition.

To the Queen's most excellent Majesty in Council, the humble petition of, &c.

Sheweth—

That your petitioner, &c. (*as in preceding form to the asterisk.*)

[*The special circumstances*] (*d*).

(*a*) This advertisement is directed by the statute to be inserted three times in the *London Gazette*, and three times in three London papers, and three times in some provincial paper published near where the manufacture under the letters patent is carried on, or near the residence of the petitioner. *Statutes*, 57.

(*b*) This is essential. *Rules*, 64, VII.

(*c*) *Rules*, 64, VIII.

(*d*) In some cases, as, for instance, where the application is by an assignee, it may be advisable or necessary to detail all the circumstances attendant on the assignment. A brief outline of the petition in Russell's case will serve to explain this fully. The petition set forth, as special circumstances, a history of the progress of the invention, of the difficulties from opposition, prejudice, and combination of workmen, with which he had to contend; that having taken out one patent, very great improvements were suggested by a workman in his employ, for which patents were taken out in the name of the workman at the expense of the petitioner, and the patents were purchased of this workman and assigned to the petitioner. The great improvement thus introduced so increased the demand, that £10,000 were spent in experiments and erecting works; and as soon as the inventions were brought to maturity, infringements became numerous, and led to continuous litigation for seven years, and numerous proceedings, both at law and

That your petitioner has advertised in the *London Gazette* three times, and three times in the, &c., being three London papers; and three times in the being a country paper published in the where your said petitioner resides, and carries on the manufacture of his said invention; that it is his intention, &c. (*according to advertisement.*)

Your petitioner therefore humbly prays your Majesty will be graciously pleased to take your petitioner's case into your royal consideration, and to refer the same to the Judicial Committee of your Majesty's most honourable Privy Council, and that your petitioner may be heard before such committee by his counsel and witnesses. And that your Majesty will be pleased to grant to your petitioner new letters patent for his said invention, for a term of seven years, or for such other term not exceeding seven years, as from and after the expiration of the said term of fourteen years, granted by the said letters patent, as to your Majesty may seem fit, according to the form of the statute in such case made and provided.

And your petitioner shall ever pray, &c.

Caveat.

Caveat against the prolongation of the term of letters patent granted to A. B. &c., without notice to C. D., of

C. D.

Dated this day of A. D.

XVIII.

ASSIGNMENT *or* MORTGAGE (*a*).

This indenture (*b*), &c. between A. B. &c., and C. D. &c. Parties.

Whereas the said A. B. *was the true and first inventor, &c., Recitals. and whereas the said invention was new as to its public use, &c., and whereas in consideration thereof her most excellent Majesty Queen Victoria, by her letters patent, under &c., did give, &c.

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equity, in all which the petitioner was ultimately successful. The expenses of this litigation, the capital laid out, and the loss occasioned by the surreptitious manufacture, have been such that the petitioner has failed to obtain those advantages to which, from the importance and great utility of the invention, he might be reasonably entitled.

(*a*) This general precedent will serve for all the cases which usually occur in practice, as where the purchase-money is to be paid at once or by instalments. It contains precedents for all the clauses and covenants which can usually be required in deeds of this nature. Others, of less frequent occurrence, will be found in the notes. The parts applicable only to a mortgage are in brackets.

(*b*) All assignments must be by deed; *ante*, p. 22. An *ad valorem* stamp will be requisite, whether the consideration be gross or annual; this alienation being included in the term "conveyance" in the Stamp Act, the term "lease" being confined to hereditaments. 55 G. 3, c. 184.

(*as in letters patent from* * p. 77 *to* * p. 78), subject nevertheless to the provisos and conditions in the said letters patent contained, as by the said letters patent reference being thereunto had will fully and at large appear.

Of enrolment of specification.

And whereas the said A. B., in pursuance of a proviso in the said letters patent contained, did particularly describe and ascertain the nature of his invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and did cause the same on the, &c., to be duly enrolled in her Majesty's High Court of Chancery.

Of disclaimer or memorandum of alteration. (c)

[And whereas a certain disclaimer, &c. under the hand and seal of the said A. B., bearing date on or about the day of A. D. was duly enrolled with the specification of the said letters patent, under by virtue and in pursuance of the provisions of a certain act of parliament, made and passed in the session of parliament held in the fifth and sixth years of the reign of his late Majesty, and intituled "An act to amend the law touching letters patent for inventions," *] as by the records remaining in the said court, reference being thereunto had, will fully and at large appear (*d*).

Of purchase (*or*) of agreement for loan.

And whereas the said C. D. hath contracted and agreed with the said A. B. for the purchase of the said letters patent at or for the price of £ to be paid, &c., *or* [hath agreed to advance and lend to the said A. B. the sum of £ at interest on the security hereinafter expressed].

Testatum.

Now this indenture witnesseth, that in pursuance of the said agreement, and also in consideration of the sum of £ of lawful British money to the said A. B. paid, &c., *or* [advanced and lent, &c.] at or immediately before the sealing and delivery of these presents, the receipt of which said sum the said A. B. doth hereby acknowledge, and from the same doth discharge the said C. D., his executors, administrators and assigns by these presents; he the said A. B. hath granted, assigned, transferred and set over, and by these presents doth, &c. unto the said C. D., his executors, administrators and assigns, all those the hereinbefore in part recited letters patent, and the exclusive exercise, right and enjoyment of the invention therein mentioned, and thereby granted to the said A. B., his executors, administrators and assigns as aforesaid, for the said term of fourteen years, and all and singular the liberties, privileges, profits, emoluments and advantages whatsoever appertaining or belonging thereunto, or

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(*c*) If there had been any disclaimer, this recital should be inserted.

(*d*) The proper insertion of these recitals is essential to the protection of the interest both of the patentee and of the assignee, since all parties (privies) to the deed will be thereby estopped from denying what is here recited. *Bowman* v. *Taylor*. See 103, n. *b*.

A patentee, in an action by his assignee, is estopped from denying his title to the letters patent. *Oldham* v. *Langmead*.

in any wise to be had or made therefrom; and all the right, title, interest, term of years unexpired, property, claim and demand whatsoever at law and in equity, of him the said A. B., of, in, to, out of and upon the letters patent and premises hereby assigned, or intended so to be (*e*); to have, hold, exercise and enjoy the said letters patent, and premises, privileges and authorities thereto belonging; and also all and singular other the premises hereinbefore expressed to be hereby assigned unto the said C. D., his executors, administrators and assigns, henceforth during all the residue now unexpired of the term of fourteen years, in and by the said letters patent granted, and for all other the term and interest (if any) of the said A. B. therein (in as full and beneficial a manner, to all intents and purposes, as he the said A. B. might or could have held or enjoyed the same if these presents had not been made), [but subject nevertheless to the proviso or agreement for the redemption hereinafter contained, that is to say, Provided always, and it is hereby agreed and declared, that if the said A. B., his heirs, executors or administrators, shall pay or cause to be paid unto the said C. D., his executors, administrators or assigns, at, &c., the full sum of £ of lawful British money, with interest thereon, after the rate of £5. for every £100. by the year, on the, &c., and without any deduction or abatement whatsoever; then and in such case he the said C. D., his executors, administrators and assigns, will, at the request and at the costs and charges of the said A. B., his executors or administrators, assign and assure the said letters well and effectually grant, assign, and make over, upon the trusts the said hereinbefore excepted grants or letters patent touching or relating to the said inventions, and every and any other matters in contest for which the same were reserved out of these presents, and the specifications thereof, and all his legal and other estate and interest therein; and that in the mean time, and until such last-mentioned assignment thereof shall be made and executed, he the said assignor shall and will stand legally possessed of and interested in the same reserved grants or letters patent for the behoof of them, the (*assignees*), their executors, &c., subject to the same trusts," the legal interest will vest in the assignees immediately on the determination of the suit that was depending at the time when the indenture was executed. *Carteright* v. *Amatt*.

All the right, &c.

Habendum.

Proviso for redemption.

The preceding case is of importance, as one in which a trust was declared of a patent, and no objection taken, contrary to the doubt casually expressed by Lord Thurlow, as to whether a patent was the subject of a trust. Ex parte *O'Reilly*, 1 Ves. Jun., 112.

(*e*) The assignment can be either of the whole, or of any share of the patent, subject only to the restriction of the letters patent that not more than twelve shares are to be created. *Ante* 82, n. *n*.

If a party is assigning several patents by the same deed, and from any cause, as a suit pending touching some of them, it may be the intention of the parties that the assignor should continue the legal owner of the patents in trust for the assignee—the preceding clause may be qualified by words to the following effect: "Save and except nevertheless, and out of these presents reserving unto the said (*assignor*), until the final determination or conclusion of the suit or action now depending between, &c., all such of the said hereinbefore-mentioned as are or shall be necessary to be given in evidence for the support of the said suit or action, and the legal right or interest of the said (*assignor*) in and to the same upon the trusts," &c. And if this clause should be followed by a covenant to the following effect, "That when and so soon as the said suit, &c., shall be determined, the said (*assignor*) shall forthwith thereafter

patent, and all other the premises hereby assigned, or intended so to be, unto the said A. B., his executors, administrators or assigns, or as he or they shall direct, free from all incumbrances made or executed by the said C. D., his executors, administrators or assigns, or any person or persons claiming through or under him or them]; and the said A. B. doth for himself, his executors and administrators, by these presents irrevocably

Letter of attorney.

nominate and appoint the said C. D., his executors, administrators and assigns, to be the lawful attorney or attorneys of him the said A. B., his executors and administrators, with full power and authority in his or their name, or in the name of the said A. B., his executors or administrators, to ask, demand, recover and receive all and every sum and sums of money, profits and proceeds payable or to accrue by virtue or in respect of the said letters patent, and to give, sign and execute proper receipts, acquittances and discharges for the same; and he, the said A. B. for himself, his executors and administrators, doth hereby agree to ratify and confirm whatever acts and things the said attorney or attorneys shall lawfully do or cause to be done in or about the premises by virtue hereof; and the said C. D. doth

Covenant for payment.

hereby for himself, his executors, administrators and assigns, covenant, promise and agree with and to the said A. B., his executors, administrators and assigns, in manner following, that is to say, that he the said C. D. &c., shall and will pay or cause to

For good title.

be paid, &c. (*f*); and also that for and notwithstanding any act, deed, matter or thing whatsoever by him the said A. B. made, done, omitted, committed, executed, or knowingly or wilfully permitted or suffered to the contrary, the said letters patent are, at the time of the execution of these presents, good, valid and subsisting in law, and not forfeited and become void or voidable, and that for and notwithstanding any such act, deed, matter or thing as aforesaid, he the said A. B. hath in himself, at the time of the execution of these presents, good right, full power, and absolute and lawful authority, to assign and transfer the said letters patent and premises hereby assigned, or intended so to be, unto the said C. D., his executors, administrators and assigns, for and during all the residue now unexpired of the said term of fourteen years in manner aforesaid, and according to the true intent and meaning of these presents (*g*); and that the said letters patent

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(*f*) According to the arrangement, &c., as to the times and mode of payments, if annual or by instalments.

(*g*) A deed of assignment contained a covenant by the assignor of certain shares in a patent-right, "that he had good right, full power, and lawful authority, to assign and convey the said shares, and that he had not by any means, directly or indirectly, forfeited any right or authority he ever had or might have had over the same." It was held, that the generality of the former words of the covenant was not restrained by the latter. *Hesse* v. *Stevenson*.

Letters patent obtained by an uncertificated bankrupt are affected by the previous assignment and vest in the assignees. *Ibid.*

and premises shall, for and during the said residue of the said term of fourteen years, be held and enjoyed by the said C. D., his executors, administrators and assigns, without the let, suit, trouble, denial, interruption, claim or demand whatsoever, of or by him the said A. B., his executors or administrators, or of or by any person or persons lawfully or equitably claiming or to claim by, for, under or in trust for him, them or any of them, or by or with his, their or any of their respective title, acts, means, default, privity or procurement.

For quiet enjoyment (after default).

[And also that immediately after default shall be made in payment of all or any part of the said sum of £ and interest, contrary to the true intent and meaning of the proviso or agreement for redemption hereinbefore contained, it shall be lawful for the said C. D., his executors, administrators or assigns, thenceforth during the residue of the said term of fourteen years, to use, exercise and enjoy the said new invention or discovery, in such manner as he or they shall think fit, and receive and take for his and their own use all profits and advantages arising from the letters patent and premises hereby assigned, or intended so to be, without interruption or disturbance of or by the said A. B., his executors or administrators, or any other person or persons.]

And for further assurance.

And, moreover, that he the said A. B., his executors and administrators, and every other person lawfully claiming by, from or under him, them, or any of them, shall and will, at the request of the said C. D., his executors, administrators or assigns, but at the costs and charges of the said A. B., his executors or administrators, make, do and execute, or cause to be made, done and executed, all such further and other lawful acts, deeds and assurances in the law whatsoever, for the more effectually assigning and assuring the letters patent and premises hereby assigned, or intended so to be, and the right, title and interest of the said A. B., his executors and administrators therein, unto the said C. D., his executors, administrators and assigns, in manner aforesaid, according to the true intent and meaning of these presents, as by the said C. D., his executors, administrators or assigns, or his or their counsel in the law, shall be reasonably required.

Lord *Alvanley*, C. J.: "It is true that the schemes which a man may have in his own head before he obtains his certificate, or the fruits which he may make of such schemes, do not pass; nor could the assignees require him to assign them, provided he does not carry them into effect until after he has obtained his certificate. But, if he avail himself of his knowledge and skill, and thereby acquire a beneficial interest, which may be the subject of assignment, I cannot frame to myself an argument why that interest should not pass as any other property acquired by his personal industry. We are, therefore, clearly of opinion, that the interest in the letters patent was an interest of such a nature as to be the subject of assignment by the commissioners." *Ibid.*

Further testatum.

Covenant to assign any further patent for improvements in the invention.

[And this indenture further witnesseth, that for the consideration aforesaid the said A. B. doth hereby for himself, his heirs, executors and administrators, covenant with the said C. D., his executors, administrators and assigns, that in case at any time or times hereafter during the continuance of this security, the said invention or any alteration or improvement therein should be secured to the said A. B., his executors or administrators, by other letters patent for some further term or terms, then and in every such case the said A. B., his executors or administrators, shall and will, at the request of the said C. D., his executors, administrators or assigns, but at the costs and charges of the said A. B., his executors or administrators, assign and assure unto the said C. D., his executors, administrators and assigns, all such letters patent so to be granted as aforesaid, and the exclusive right and enjoyment of the said invention, and the alteration or improvement thereby to be secured, and all the right, title and interest of him the said A. B., his executors or administrators therein, for and during all such term and terms, time and times, as in and by such letters patent respectively shall be granted and limited; subject nevertheless to such and the same proviso or agreement for redemption as is hereinbefore contained of and concerning the letters patent and premises hereby assigned, or intended so to be, as by the said C. D., his executors, administrators or assigns, or his or their counsel in the law, shall be reasonably required.

For quiet enjoyment by mortgager until default.

And it is hereby declared and agreed, that in the mean time, until default shall be made in payment of all or some part of the said sum of £ and interest, contrary to the proviso or agreement for redemption hereinbefore contained, it shall be lawful for the said A. B., his executors or administrators, to use, exercise and enjoy the said new invention or discovery, and any such improvements therein as aforesaid, in such manner as he or they shall think fit, and to receive and take for his and their own use all profits and advantages arising from the letters patent and premises hereby assigned, or intended so to be, and covenanted to be assigned as aforesaid, without any interruption whatsoever, of, from or by the said C. D., his executors, administrators or assigns, or any person or persons rightfully claiming by, from, under or in trust for him or them, any thing hereinbefore contained to the contrary notwithstanding] (*h*).

In witness, &c.

(*h*) If a share is assigned, a covenant against subdivision, so as to avoid the patent, will be necessary; also, in some cases, a covenant to assist in any applications under 5 & 6 W. 4, c. 83. Also a covenant as to the granting of licenses.

XIX.

LICENSE (*a*).

This indenture made, &c., between A. B. &c., and C. D. &c. Parties.

Whereas the said A. B. (*or* one E. F. (*b*) &c., *as in preceding form from* * p. 97, *to* * p. 98 (*b*). Recitals (*b*).

[And whereas by an indenture of assignment, &c. (*c*)] Assignment.

And whereas the said A. B. hath agreed with the said C. D. to grant to him, his executors, administrators, and assigns, his license and authority to make, use, exercise, and vend the said invention according to the specification so enrolled as aforesaid, and upon the terms and conditions, and in the manner hereinafter mentioned (*d*). Agreement for license.

Now this indenture witnesseth, that in pursuance of the said

(*a*) This precedent contains the usual clauses for a common, or exclusive, or personal license. Other special provisions and covenants, which may be requisite, are stated in the notes.

Before the recent case of *Protheroe* v. *May*, doubts were entertained whether a license was not an interest in a patent such that, on assignment to more than twelve, it might become void; hence clauses were inserted restricting the licensee from assigning. But the Court of Exchequer having held in the above case that a license is no part of a patent, a patentee may grant whatever licenses he pleases, and need insert for his own safety no clauses of that nature. For the particulars of this very important case, see *ante* 83, n. *p*. But for other reasons it may be advisable for the patentee to have a covenant against assignment, except on certain conditions, or that the license should be strictly personal.

(*b*) The proper insertion of these recitals is most material to the protection of the interests of the patentee in an action against his licensee for non-payment of his rent under a license.

By a recital in a license that the plaintiff has invented certain machines, and enrolled a specification, the defendant is estopped from afterwards denying it. And a plea that the plaintiff was not the true and first inventor, or that the invention was not new, is bad on demurrer. *Bowman* v. *Taylor*.

But *aliter*, if there be no such recital, as in the case of *Hayne & another* v. *Maltby*, where the only recital was, that the plaintiffs were assignees. *Ibid*.

In action for breach of an agreement to work a patent machine according to the specification, the defendant is not estopped from pleading that no specification was enrolled, or the machine not new. *Hayne & another* v. *Maltby*.

But see preceding case.

A licensee having had enjoyment under letters patent, cannot recover back any of the moneys he has paid, on it being discovered that the letters patent are void. *Taylor* v. *Hare*.

But *aliter*, if there have been any fraud on the part of the patentee. *Ibid*.

In an action for non-payment of an annuity, according to an agreement, for the exclusive use, manufacture and sale of certain patent inventions, the defendants pleaded that the invention was not a new invention, and that the plaintiff was not the true and first inventor. Held on special demurrer, that as it did not appear by the declaration that the defendant had ever enjoyed any part of the patent, the plea impeaching the consideration was a bar to the action. *Chanter* v. *Lease*.

An agreement for the purchase of part of the profits of a patent, which turned out a mere bubble, one of the parties having used fraud and misrepresentation, was set aside, and so much of the money as had been paid under the agreement ordered to be repaid. *Lovell* v. *Hicks*.

(*c*) If the license be granted by any other than the patentee, as by the assignee of the patent, or of some share of it, a recital to that effect must be inserted, setting out the parties, and the granting part of the deed, &c.

(*d*) In an exclusive license, there may be required recitals of assignment of all rights except within a certain district, and of agreement to grant a license therein: "And whereas the said patentee has assigned the said several patents, and all benefits arising from the said inventions, to , excepting and reserving all rights and interests therein, so far as concerns the town of, &c. and miles around the same. And whereas the said A. B. has agreed with the said C. D. to

agreement, and in consideration of the reservations, covenants,
Testatum. provisos, and agreements hereinafter contained, on the part of the said C. D., he, the said A. B., hath given and granted, and by these presents doth give and grant, unto the said C. D., his executors, administrators, and assigns, full and free liberty [sole and exclusive], license, power, privilege, and authority to use, exercise, and put in practice (*e*) the said invention [at, &c.] (*f*), and to vend, use, sell, and dispose of the so produced, when, where, and as the said C. D., his executors, administrators, or assigns, shall think fit (*g*), to have and to hold the said license,
Habendum. power, privilege, and authority hereby given and granted, or intended to be, with all benefit and advantage thereof, unto the said C. D., his executors and administrators, henceforth for and during the remainder now to come and unexpired of the said term of fourteen years so granted by the aforesaid letters patent, subject nevertheless to the covenants, restrictions, conditions, and agreements hereinafter contained on the part of the said C. D., his executors, administrators, and assigns, to be observed and performed in respect of the said license, privilege, and premises hereby granted, yielding and paying therefore unto the
Redendum. said A. B., his executors, administrators, or assigns, the sum of £ *(Special covenants as to price, quantity, modes of payment, accounts, &c.)* (*g*).

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grant him, his executors, administrators, and assigns, an exclusive license to make, use, exercise, and vend the said invention within the town of, &c., and at such other place and places within miles therefrom, as they shall think proper.

Some agreement may also be made in respect of any future improvement, in which case a recital to the following effect may also be introduced: "And whereas the said A. B. has agreed with the said C. D. to grant to him, his executors, administrators, and assigns, his license and authority to make, use, exercise, and vend all other improvements which shall be made or invented by the said C. D. at any time within the space of years hence next ensuing, so far as such improvements can be applied to the process of, &c., for the term of years from the date thereof."

(*e*) These are the words of the prohibitory part of the letters patent.

(*f*) The invention may be of such a nature that the licenses will have reference to some particular place; as, for instance, in licenses for the manufacture of iron at a particular furnace. In the case of a sole or exclusive license, it will generally be to exercise within a certain district. In a recent case, it was to use, exercise, and put in practice, the invention within the city of Bristol, and at such other place or places within thirty-four miles thereof. *Protheroe* v. *May*.

(*g*) The following are covenants of common occurrence. To pay a certain annual rent for a certain number of machines, or according to the dimensions, or according to quantity manufactured, or so much *per cent.* on the invoice prices; to manufacture so much per week, and to render exact quarterly accounts, with liberty of inspection of works and books, and power of distress. Against granting licenses to other parties on more advantageous terms, or more than a certain number of licenses.

To mark the manufactures with the name of the patentee and a number; to send out no imperfect articles into the market so marked, and to keep a sufficient supply for the public, also a depôt for inspection. For the reference of any disputes to arbitration.

Many special clauses, both in the recitals and other parts of the deed, may be advisable for the interests of both parties; for instance, that the accounts rendered should be verified by affidavit on solemn declaration under 5 & 6 W. 4, c. 62; that the licensee will work under no other patentee; and for the revoking the license, and for the discontinuance of payments, should the patentee fail in any actions for infringement.

Further testatum.

And this indenture further witnesseth, that for the considerations aforesaid, he the said A. B. doth hereby for himself, his heirs, executors and administrators, covenant with the said C. D., his executors, administrators and assigns, that he the said A. B., his executors or administrators, shall and will from time to time, and at all times during the continuance of the said term, use his and their utmost endeavours to discover and detect any infringement that shall hereafter be made, or attempted to be made, by any person or persons whomsoever, of any of the rights or privileges granted by or incident to the letters patent hereby assigned, or expressed and intended so to be, and shall and will forthwith communicate the same when discovered to the said C. D., his executors, administrators or assigns; and also that the said A. B., his exccutors or administrators, shall and will render his or their utmost assistance to the said C. D., his executors, administrators or assigns, for the purpose of enabling him or them to protect or defend the said rights or privileges granted by or incident to the said letters patent, or to prosecute any action or proceeding against any person or persons infringing the same as aforesaid.

Covenant by patentee to assist in detecting and prosecuting infringers.

Covenant by patentee not to license others.

[And the said A. B. doth, for himself, his heirs, executors and assigns, hereby covenant, promise, and agree with the said C. D., his executors, administrators, and assigns, that he, the said A.B., his executors, administrators, or assigns, shall not, nor will at any time hereafter, permit or suffer any person or persons whomsoever, other than the said C. D., his executors, administrators, and assigns, to use, exercise, or put in practice, the said invention within, &c.]

To give the licensee the benefit of further improvements.

And also, that if, at any time or times hereafter, within the term of years now next ensuing, he, the said A. B. shall invent, discover, or make any other improvement or improvements which can or may be applied to the said invention, then and in every such case he, the said A. B., shall and will communicate such improvement or improvements to him, the said C. D., his executors, administrators, or assigns, when and as soon as it shall appear that the same can or may be applied as aforesaid; and if he or they shall approve of the same, then he, the said A. B., shall and will grant to him or them license and authority to use and practise for the residue which shall be then unexpired of the terms hereby granted, or either of them, and that whether the said A. B. shall have obtained her Majesty's letters patent therefore or not. In witness, &c.

XX.

PROCEEDINGS IN EQUITY.

Bill (*a*).

To the Right Hon. Charles Christopher Baron Cottenham, of Cottenham, in the county of Cambridge, Lord High Chancellor of Great Britain.

The letters patent.

Humbly complaining, showeth unto your lordship, your orator, A. B., of, &c., that by letters patent under the great seal of Great Britain, bearing date, at Westminster, the day of, &c., after reciting, among other things, that the said A. B. (or one C. D.) having by his petition represented to her Majesty that he had invented, &c., her said Majesty did give, &c. (*b*), and in the said letters patent were contained the usual clauses and provisos in such cases used and accustomed, and, amongst others, a proviso that if, &c. (*c*) that then the said letters patent, and all liberties and advantages whatsoever thereby granted, should utterly cease, determine, and become void, any thing thereinbefore to the contrary thereof in any wise notwithstanding, as by the said letters patent reference being thereunto had will more fully and at large appear.

Enrolment of the specification.

That the said A. B. (or C. D.), in pursuance of the said proviso in the said letters patent, did afterwards, to wit on, &c., by an instrument in writing under his hand and seal, particularly describe and ascertain the nature of his said invention, and in what manner the same was and is to be performed, and did cause the same to be duly enrolled in her Majesty's High Court of Chancery, to wit on the day and year last aforesaid, and within six calendar months next and immediately after the date of the said letters patent, in which said instrument in writing so enrolled as aforesaid the said invention, and the manner in which the same is to be performed, are described in words (with letters and figures referring to a plan or drawing annexed, and that the said words, letters, and figures are) as follows, that is to say, &c. (*d*)

(*a*) Separate bills must be filed against parties on distinct grounds of infringement. *Dilly* v. *Doig*.

Clear title at law is not necessary to sustain an injunction; but possession under colour of title, as where a party has a patent, puts it in execution, and proceeds to a sale, is sufficient. *Harmer* v. *Playne*; *Hill* v. *Thompson*; *Kay* v. *Marshall*.

Long and undisturbed possession will entitle a party to an injunction until after an action at law; but if the patent be recent, and doubts be entertained as to its validity, the right must be first established at law. *Ibid*; *Bickford* v. *Skewes*; *Curtis* v. *Cutts*.

A sufficient *prima facie* case to justify the injunction must appear on the face of the bill, and a party must not depend on the admissions contained in the answer for granting or continuing an injunction. *Curtis* v. *Cutts*.

(*b*) Set out granting and prohibitory parts (from * p. 78 to * p. 80).

(*c*) Set out clause for specification, (from * p. 83 to * p. 84).

(*d*) Set forth the specification, or so much of it as may be necessary to explain the alleged infringement. It is not ne-

[*Disclaimer, &c., and indenture of assignment.*]

And your orator further showeth, that being under and by virtue of the said letters patent (*or*, indenture of assignment) sole owner and proprietor of the said invention, according to the said specification he made, used, exercised and vended, &c., and still continues to make, use, exercise, and vend, the said invention, and has laid out and expended large sums of money in and about establishing manufactories, &c., and hath made large profits, &c.

That he has had sole possession of the said invention, except so far as he has been disturbed therein by, &c. (*e*)

That being the sole owner and proprietor of the said invention, he had as he is advised a just right, and is well entitled to and ought to have and receive all benefits, profits, and emoluments, which may arise from the aforesaid letters patent, or from the manufacture and sale of the said invention, without any invasion or infringement whatsoever of the right.

That E. F., of, &c., has lately, without the permission of, &c. made, and is now, without the permission of, &c. making, &c. That thereby your orator hath sustained, and is likely to sustain, great injury; that your orator hath frequently requested them to desist from, &c., and to account with your orator for the profits already received by them arising from the sale thereof. But the said E. F. refuses so to do, pretending that the said invention was not new as to public use and exercise, &c., and that the said, &c., so made, &c., by the said E. F. as aforesaid, are wholly different from those, &c. (*f*) Whereas your orator charges the contrary of all such pretences to be true, &c.

And your orator further showeth, that the defendant ought to discover and set forth a full, true, and particular account, &c., of all, &c., made, &c.

That the said defendant has sold large quantities at a great under-value, &c., and that defendant so did for the purpose of injuring and defrauding your orator, of depressing and diminishing the trade and profit, &c.

To the end therefore that the defendant may answer the premises, and may make a full discovery and disclosure of all the

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cessary to set out the whole; a reference thereto, with an allegation that the plaintiff had done all which was required of him, will be sufficient on demurrer. *Westhead* v. *Keene.*

The specification being of record in the court, will be noticed by it. *Browne* v. *Moore*, and *Kay* v. *Marshall.*

If any disclaimer or memorandum of alteration has been entered, this must be stated. Also the indenture of assignment.

(*e*) If proceedings have been instituted against other infringers, who have submitted, this should be stated.

(*f*) The statements in this part of the bill will depend on the subject-matter of the letters patent, and the nature of the infringement complained of.

matters aforesaid, and that an account may be taken by and under the direction and decree of this honourable court of all, &c., and that defendant may be compelled to pay to your orator what may be found due to your orator on taking said account, and may be charged with full, real, and utmost value of all, &c., and that the defendant and his workmen, servants, and agents, may be restrained as well by the interim as by the perpetual order and injunction of this honourable court, from, &c., made according to the said invention, or any part thereof, or otherwise, in infringement of the said patent during your orator's term therein. And for further relief (*g*).

[*The affidavits.*] (*h*)

XXI.

PROCEEDINGS AT LAW.

DECLARATION.

In the

Parties (*b*).

The day of A. D.

(*a*) to wit A. B. (the plaintiff in this suit), by , his attorney, complains of C. D. (the defendant in this suit), who has been summoned to answer the said plaintiff in an action on the case (*b*). *For that whereas heretofore, and before and at the

Recital of grant of letters patent.

(*g*) This was the prayer of the bill in the important recent case of *Russell* v. *Cowley*, in which the following order was made:—"That the plaintiff should be at liberty to bring such action at law against the defendant as he should be advised; and provided he delivered a declaration within a month from that time. That the defendants should keep an account of all moneys received by them on account or in respect of all iron pipes or tubes for gas and other purposes, made according to, or in infringement of, the said letters patent; that said party should prove it, and suffer the solicitor and two approved inspectors to visit the manufactories, to ascertain the process pursued, and afford every facility for that purpose, it being the object and intention of the court to enable the defendant to give such evidence as will enable them to negative the infringement complained of. All proceedings in this suit to stand over until the trial of the action, and the consideration of the question of costs to be reserved."

(*h*) On application *ex parte* for an injunction, the party must swear at the time of making it, that he believes himself the original inventor. It will not be sufficient to swear as to his belief at the time of applying for the letters patent. *Hill* v. *Thompson*.

If this be omitted, and the injunction be dissolved, costs will be given. *Sturt* v. *De la Rue*.

It must also be shown, that the party complained of worked according to the precise proportions mentioned in the specification, if the proportions form the essence of the invention. *Hill* v. *Thompson*.

(*a*) The venue in actions for infringement of a patent is transitory; but if laid in Middlesex, it cannot be changed on the application of the defendant on the ordinary affidavit of the cause of action having arisen in the county to which it is proposed to change the venue, and not elsewhere; since this affidavit cannot with propriety be made, the letters patent, which are the substratum of the action, being at Westminster. *Cameron* v. *Gray*, and *Brunton* v. *White*.

As to the requisites of the affidavit, see *Allen* v. *Griffiths*, 3 T. R. 495; and *Walker* v. *Wright*, 4 East, 495. But the venue may be changed on special grounds, or by consent.

(*b*) If the action be by the assignee of a share of the patent, the patentee should be joined with him. But this objection can only be taken by plea in abatement. 2 Saun. 115 & 116 a.

If the parties sue or are sued in any official character, this must appear on the

time of the making the letters patent, and of the committing of the grievances by the defendant as hereinafter mentioned, the plaintiff (*or*, one E. F. (*c*) was the true and first inventor of, &c., and thereupon her Majesty Queen Victoria heretofore, to wit, on the day of , in the year of her reign, by her letters patent duly sealed in that behalf, to wit, with the great seal of Great Britain, and which the plaintiff now brings here into court (*d*), after reciting that the said plaintiff had by his petition humbly represented that he had, &c. her said Majesty did for herself, her heirs, and successors, give, &c. (*e*)

Grant and prohibitory part.

And in the said letters patent was and is contained, amongst other things, a proviso that, &c. (*f*), the said letters patent and all liberties and advantages whatsoever thereby granted should utterly cease, determine, and become void, any thing hereinbefore contained to the contrary thereof in any wise notwithstanding, as by the said letters patent reference being thereunto had will, amongst other things, more fully and at large appear. And the plaintiff further says, that he, the said plaintiff, did afterwards, and within six calendar months, to wit, on the, &c., in pursuance of the said proviso in that behalf in the said letters patent contained, and of the said letters patent, by an instrument in writing under his hand and seal, particularly describe and ascertain the nature of his said invention, and in what manner the same was to be and might be performed, and did afterwards, and within six calendar months next and immediately after the date of the said letters patent, to wit, on the day and year last aforesaid, cause the said instrument in writing to be duly enrolled in her Majesty's High Court of Chancery at Westminster, as by the record of the said instrument in writing now remaining of record in the said court fully appears.

Proviso for specification.

[Which said instrument in writing was and is as follows: "To all," &c. (*g*)]

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record, and an objection on this ground will be good after verdict, and in arrest of judgment.

In a recent case, the defendant on the record was styled as C. D., Secretary to the Commercial Steam Packet Company, and the declaration charged an infringement by the company. There was no allegation that the defendant was the registered officer of the company, pursuant to the act of parliament in that case made and provided; or in pursuance of letters patent granted in that behalf. On motion to arrest judgment, on the ground of insufficiency of declaration, no right of action whatever being shown thereby against the defendant, the Court of Common Pleas granted a rule. Before cause was shown, the plaintiff obtained a rule to show cause why the *nisi prius* record should not be amended by inserting the proper allegation; and on cause being shown on this latter rule, the amendment was allowed on the terms of the plaintiff paying the costs of both rules and foregoing the costs of the action. *Galloway* v. *Bleaden.*

The Crown is empowered to grant letters patent to companies to confer the right of suing and being sued by one of their officers, on certain conditions as to registration. 1 Vict. c. 73.

(*c*) If the action be by the assignee, this title must be distinctly set forth.

(*d*) It is usual to make profert, but oyer is not demandable of letters patent.

(*e*) Set out the recitals briefly and the granting and prohibitory part of letters patent in past tense, from * p. 77 to * p. 80.

(*f*) As in letters patent from * p. 83, to * p. 84.

(*g*) If any disclaimer or memorandum

Entry of disclaimer.

[And the plaintiff further says, that afterwards, and before the committing by the defendant of the grievances hereinafter mentioned (*h*), and after the passing of a certain act of parliament made and passed in the session of parliament held in the fifth and sixth years of his late Majesty King William the Fourth, intituled "An Act to amend the law touching Letters Patent for Inventions," and before the commencement of this suit, to wit, &c., he, the said plaintiff, under, by virtue, and in pursuance of, the provisions of the said statute, did enter with the clerk of the patents of England, by and with the leave of Sir Knight, being her Majesty's Attorney *or* Solicitor-General, first had and obtained for that purpose, and duly by his the said fiat and signature in that behalf, the following disclaimer, &c., in the title, &c., of the said letters patent, not being such disclaimer or such alteration as extended the exclusive right granted by the said letters patent, by which said disclaimer, &c., being under the hand and seal of the plaintiff, the said plaintiff did disclaim, &c., as follows: "I," &c. (*i*) which said disclaimer, &c., was afterwards, to wit on, &c., filed by the said clerk of the patents of England, and duly enrolled with the said specification, pursuant to the statute in that case made and provided, as by the record of the said specification and disclaimer, &c., remaining of record in the said High Court of Chancery fully appears.] [And the plaintiff further saith, that afterwards, &c. (*k*), by a certain indenture of assignment, &c. (*l*)]

And the plaintiff further says that he has always from the time of granting the said letters patent [until the making of the said indentures, made, used, exercised, and vended the said invention, and that he, the said plaintiff, hath always, from the making of the said indenture and entering such disclaimer as aforesaid,] hitherto by himself, his deputies, servants, and agents in that behalf, made, used, exercised, and vended the aforesaid [undisclaimed] invention, to wit, the said which he was so entitled to make, use, exercise, and vend as aforesaid, to his great advantage and profit*. Yet the defendant, well knowing the premises, but contriving and wrongfully and injuriously intending to injure

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of alteration have been enrolled, it will be necessary to set out the specification *verbatim*; and if there were any drawings annexed, there should be an allegation to the following effect: "And the plaintiff further saith, that there was and still is annexed to the said instrument in writing or specification, a certain drawing, with certain figures and letters marked thereon, as in the said instrument in writing or specification mentioned."

(*h*) This is material, inasmuch as a party cannot be made a wrongdoer by relation, and the act has no retrospective operation, so as to make a party liable for an infringement prior to the time of entering the disclaimer; although the infringement was in respect of part of the invention not disclaimed. *Perry* v. *Skinner*. See *ante* 54, n. *i*.

(*i*) Set forth so much of the disclaimer as is necessary.

(*k*) If the indenture of assignment was posterior in order of time to the disclaimer, &c., this clause will come in here; but if anterior, it must precede the last, which must be altered accordingly.

(*l*) Set out the parties, and as much as may be necessary to show the plaintiff's title. See *ante*, 98 and 99.

the said plaintiff, and to deprive him of the profits, benefit, and advantages which he might and otherwise would have derived and acquired from the making, using, exercising, and vending the said invention, after the making of the said letters patent [and of the said indenture, and of the said disclaimer, &c., so entered, &c.], and within the said term of fourteen years in the said letters patent mentioned, to wit, on the, &c., and on divers other days and times between that day and the commencement of this suit, and within that part of the United Kingdom, &c., to wit, &c., unlawfully and unjustly, without the leave, license, consent, or agreement of the plaintiff in writing under his hand and seal, or otherwise howsoever, for that purpose had and obtained, and against the will of the plaintiff, did make divers, to wit, &c., on the said improved plan, &c., of the said [undisclaimed] invention of the plaintiff, in breach of the said letters patent, and against the privileges so granted to the plaintiff as aforesaid (*m*).

Second count.

And the plaintiff * further says, that he the said plaintiff so being such inventor, and the said letters patent having been so made as aforesaid, and the said instrument in writing having been so made and enrolled as aforesaid, and the said invention having been so made, used, exercised, and vended, by the plaintiff as aforesaid, the defendant well knowing the premises, but further contriving and intending as aforesaid, after the making of the said letters patent, and within the said term of fourteen years therein mentioned, to wit, on the day and year last aforesaid, and on divers other days and times between that day and the commencement of this suit in England aforesaid, wrongfully and unjustly, without the license, consent, or agreement of the plaintiff, under his hand and seal or otherwise howsoever, for that purpose had and obtained, and against the will of the plaintiff, * did make divers, to wit, &c., being parts of the said invention [so not disclaimed], in breach of the said letters patent, and against the privileges so granted to the plaintiff as aforesaid.

Third count.

And the plaintiff, &c. (*as in 2d count between asterisks*) did use and put in practice the said invention in this, to wit, that he did vend divers, to wit, &c., knowing the same to have been

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(*m*) The counts in this precedent are those which naturally arise from the prohibitory part of the letters patent. The particular words of the breaches to be assigned will depend on the subject-matter of the patent, and the nature of the infringement. In Watt's case there are twelve counts. 2 H. Bl. 464.

Should a plaintiff under the new rules be compelled to rely on a single count, *semble* that the word use, which occurs both in the granting and in the prohibitory part, should be selected as the most potential.

In the action on Galloway's patents for improvements in paddle-wheels, the breaches were,—1. Made divers, &c., paddle-wheels for propelling vessels on the said improved plan or principle, and in imitation of the said, &c., and sold and vended divers others.

2. Used and put in practice divers, &c.,

made without the license, and consent of the said plaintiff, in breach, &c.

Fourth count. And the plaintiff, &c., did counterfeit, imitate, and resemble the said invention, that is to say, did make and cause and procure to be made, divers, to wit which were intended to counterfeit, imitate, and resemble, and did counterfeit, imitate, and resemble, the said [undisclaimed] invention of the plaintiff, in breach, &c.

Fifth count. And the plaintiff, &c. did make, and cause to be made, divers additions to, and divers subtractions from, the said [undisclaimed] invention, that is to say, &c. whereby to pretend

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paddle-wheels for propelling vessels, in imitation, &c.

3. Did counterfeit, imitate, and resemble the said invention of the said E. G. in part, and did make divers colourable additions thereto, and subtractions from the same, whereby to pretend the said defendants the inventors thereof, and did then sell and put in practice divers, &c., paddle-wheels, for propelling vessels then made to counterfeit, imitate, and resemble in part, the said invention of the said, &c., with such colourable additions thereto, and subtractions therefrom, as aforesaid, &c.

4. Did make divers, &c., for propelling vessels, with other improvements in the construction thereof, respectively, which were then intended to imitate and resemble, and did imitate and resemble, the said improved paddle-wheels, so invented, &c.

The pleas were—1. The general issue. 2. That said E. G. was not the true and first inventor. 3. That the nature of the said invention, and the manner in which, &c. were not particularly described. Conclusion to the country. 4. That said invention was not a new invention or manufacture within this realm; but, on the contrary thereof, had been and was publicly practised and used by others, to wit, within that part, &c., before and at the time of the grant of the said letters patent; wherefore, &c. Conclusion, with a verification.

The following were the objections:—

1. That said E. G. was not the first and true inventor of said improvements, for which the patent in the declaration mentioned is alleged to be in force, but that all said improvements before the date and grant of the said letters patent had been and were invented, used, and in practice, by Messrs. M. and F., or one of them. And that the use of divided floats, applied according to the principle or mode described in the writing or specification in the declaration mentioned, was discovered, invented, and in practice, by the said Messrs. M. and F., or some or one of them, before the date and grant of said letters patent.

2. And that said alleged invention, for which said patent was granted, is not an invention of any new manufacture within this realm, but is merely an invention of a principle; that is to say, the principle of arranging the floats of paddle-wheels in divided portions, and in a form calculated to displace the least possible quantity of water in their immersion, and not for any specific means of applying that principle to practical purposes; and that said patent is calculated to prevent the said principle from being investigated and usefully applied by others.

3. And that the specification of said patent does not sufficiently describe and ascertain the nature of the invention, and in what manner the same was or is to be performed; and is ambiguous, obscure, and insufficient, in that the specification does not give or suggest any specific means of determining the supposed point, called *b* (in the drawings accompanying said specification, No. 1), at which it is necessary to place the floats at a less angle to the radius of the wheel than the angle *bde*; nor does said specification state or show at what angle it is that said patentee places the bars or floats in such positions, that they will be nearer to each other than said position, therein called *d* to *b*; nor does said specification state or show at what angle, or in what line, whether curved or straight, said bars or floats are to be placed, when the space between any two of them would be too great if arranged in the cycloidal form.

And that the principle of said patent, and the application of that principle, had, previously to the date and grant of said letters patent, been discovered and known and used by Messrs. M. and F., or one of them; and also that said specification is too large and extensive, and claims too much, inasmuch as it includes a certain invention of a similar kind, made, used, and put in practice previously to the date and grant of the said letters patent, by the said Messrs. M. and F., or one of them, and would, if valid, prevent the exercise of the said invention.

himself to be the inventor and deviser of the said invention, and did pretend himself to be the inventor and deviser of the said invention of the plaintiff in breach, &c. By means of the committing of which said several grievances by the defendant as aforesaid, the plaintiff has been and is greatly injured, and has lost and been deprived of divers great gains and profits which he might and otherwise would have derived from the said invention and letters patent, and in respect whereof he was and is entitled to such privileges as aforesaid, and was otherwise damaged. To the plantiff's damage, &c.

In the action on Crane's patent, "for an improvement in the manufacture of iron," the following were the breaches:—

1. Did smelt, manufacture, and make divers, &c. tons of iron, on the said improved plan or principle, and in imitation of the said invention, &c.

2. Used and put in practice the said invention, by smelting, manufacturing, and making divers, &c.

3. Did counterfeit, imitate, and resemble said invention, and did make divers colourable additions thereto, and subtractions therefrom, whereby to pretend themselves, &c.

4. Smelted and manufactured, and made divers, &c., with certain other improvements in the process of such smelting, manufacturing, and making aforesaid, which were then and there intended to imitate and resemble, and did imitate and resemble, the said improvement so invented by said plaintiff, and thereby counterfeited the same in breach, &c.

The following were the pleas:—

1. Not guilty.

2. That plaintiff was not the true and first inventor of the said alleged improvements. Conclusion to the country.

3. Set forth specification, and alleged that said, &c., was not before and at the time of the said letters patent a new manufacture, invented by said plaintiff, within the statute, as to the public use and exercise thereof, &c. With a verification.

4. That nature of said invention, and manner, &c., were not nor are particularly described or ascertained, according to the true intent and meaning of the said letters patent, in or by the said instrument, &c. conclusion to the country.

5. Set forth specification, by reference to 3d plea, and the proviso in the letters patent (*ante* 81), against prejudicing any previous patent. It then averred the granting of letters patent to one J. B. N., and stated the invention to have been in public use, with the license of J. B. N. It then alleged that this previous patent of J. B. N. was in full force; and that in consequence thereof, that plaintiff could not use this said former invention without the license of J. B. N.; and that having this license the plaintiff used J. B. N.'s invention.

The replication to the 3rd plea traversed it, and to the 5th plea, set out the usual proviso in J. B. N.'s patent for enrolling the specification, and the specification itself; and averred that the invention thereby described was not and is not the same as described in plaintiff's specification; and that the using by the plaintiff of his invention is not a using or imitating of the invention of the said J. B. N. contrary to the said proviso.

The rejoinder traversed the averment in the replication to the 5th plea.

The following were the objections:—

1. That the alleged invention, &c. is not a new manufacture within 21 Jac. 1, c. 3, s. 6, for which a patent can be granted, but only the using at the same time a well-known article, viz., anthracite, or stone coal or culm, and of the hot-air blast (the latter admitted by the plaintiff's specification to be then well known), each separately in use for smelting and manufacturing iron before the date of the said letters patent.

2. That anthracite, &c., had been publicly used as the only fuel in the smelting and manufacturing of iron by T. H., at &c., of &c., and had been so used, mixed with other fuel, by &c., at &c., before the date of the letters patent, and the alleged invention of the plaintiff is only the use of anthracite ore, &c. with the hot-air blast.

3. That the using of hot-air blast in the smelting or manufacture of iron was not the invention of the plaintiff, but was well known, and in use at various places (specifying them).

4. That the alleged invention of the plaintiff necessarily involves the use of another invention, which was patented before the date of the plaintiff's patent, namely, to J. B. N.; and that the application thereof to anthracite, which was a well-known fuel, was an application all persons were and are at liberty to make who had permission to use the invention of J. B. N.

Pleas (*o*).

In the

The day of A.D.

Not guilty. 1. The defendant by his attorney, says, that he is not guilty of the premises above laid to his charge, or any or either of them, or any part thereof in manner and form, as the plaintiff has above thereof complained against him; and of this the defendant puts himself upon the country, &c. (*p*)

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5. That the exclusive use of the hot-air blast having been previously granted to J. B. N., the subsequent patent for the same invention is void.

6. That anthracite being well known and in use as a fuel, the application of such fuel to the smelting or manufacture of iron by well-known methods is not a new manufacture within the meaning of the statute.

7. That the use of the hot-air blast, described in the specification, produces substantially only the same effect when the anthracite is used as a fuel, as when any other kind of coal or coke is used for the same purposes.

8. That the specification is defective, inasmuch as it does not describe the kind of furnace to which the alleged invention is applicable, and it is not applicable to all kinds of furnaces.

9. That the specification does not clearly state whether or not it is intended to apply to the use of anthracite as the only fuel, or whether it is intended to include the use of anthracite together with other fuel.

(*o*) The pleas here given are those which usually occur in practice; but others of a more special nature will sometimes be requisite.

The subsequent pleadings depend so entirely on those at this stage, that it would be useless to pursue them here.

Any defence by way of justification or excuse, as a release, satisfaction, license, &c. must be specially pleaded.

The new rules of pleading render it of the greatest importance to a defendant to take care that sufficient and proper pleas are put upon the record, or he may be excluded from availing himself of a substantial defence. Before these rules a defendant might, under the general issue, rely on any objection to the validity of the patent. But in recent cases defendants have been held excluded from defences which were not let in by their pleas.

Thus an objection that the specification is not so large as the title, is not raised by a plea that the plaintiff did not by an instrument in writing describe his invention, &c. *Derosne* v. *Fairie & others*. See *post* 116, n. *t*.

Also the questions, whether there be not a good patent as specified, or whether the patent is for a principle or not, will not be in issue under a similar plea. *Jupe* v. *Pratt*.

The state of the law in respect of the pleas and the notice of objections to be delivered with them, is remarkable; since it is a question how far the statute 5 & 6 W. 4, c. 83, s. 5, regulates or modifies Reg. Gen. H. T. 4, W. 4.

From the intimations of the judges in the cases just cited, and in *Morgan* v. *Seaward*, it is conceived that the courts will uphold the principles of the above rules, and that consequently hereafter it will be a question much discussed, as to whether the pleas are sufficient to admit the notices of objections delivered under the statute. The statute was passed subsequently to the new rules; and, in respect of the notice of objections, in the same spirit as the rules, but without any reference to them.

A similar difficulty arose in respect of the costs, on which the Court of Exchequer has given a decision. See *Losh* v. *Hague*, and *ante* 59, n. *u*.

(*p*) This plea puts in issue merely the fact of the infringement in manner and form as alleged in the declaration. The rule to this effect is that of H. T. 4 Wm. 4, 7: "That in actions on the case, the plea of not guilty shall operate as a denial only of the breach of duty or wrongful act, alleged to have been committed by defendant, and not of the facts stated in the inducement, and no other fact than such denial shall be admissible under that plea; all other pleas in denial shall take issue on some particular matter of fact alleged in the declaration." In the preceding declaration the inducement, that is the introductory matter prefatory to the charge, or statement of facts out of which the charge arises, states the grant of the letters patent, the performance of the conditions precedent as to the specification, the assignment, disclaimer. If it is intended to deny all or any of these they must be specially traversed, as in some of the following forms.

Hence this plea, if pleaded alone, merely puts in issue the infringement as alleged, and the evidence to be prepared

Not the true and first inventor.

2. And for a further plea in this behalf the defendant says, that the said plaintiff (*or* E. F.) was not the true and first inventor of the said improvement in the declaration mentioned [and not disclaimed by the plaintiff, as in the declaration mentioned], in manner and form as the plaintiff hath above in his said declaration in that behalf alleged, and of this the defendant puts himself upon the country (*q*).

That invention was not now.

3. And for a further plea in this behalf the defendant says, that the said invention in the declaration mentioned [and not disclaimed, &c., as in the declaration mentioned], and for in respect of which the said letters patent were so made, and the said instrument in writing was so enrolled, as aforesaid, was not at the time of the making of the said letters patent a new invention as to the public use and exercise thereof, in that part of the United Kingdom of Great Britain and Ireland, &c., and this the defendant is ready to verify (*r*).

That the specification is not sufficient.

4. And for a further plea in this behalf, the defendant says, that the plaintiff did not by any instrument in writing, under his hand and seal, particularly describe and ascertain the nature of his said invention, and in what manner the same was to be and might be performed, in manner and form as the plaintiff hath above in his said declaration in that behalf alleged; and of this the defendant puts himself upon the country, &c. (*s*)

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must be directed to the particular breaches laid in the declaration. *See ante*, n. *m*.

The evidence on the part of the defendant in support of this plea will depend on the breaches assigned in the declaration. If the infringement complained of is in respect of any thing made or mode of making, the proof of any substantial difference in the article, or in the process pursued, will be a valid answer.

(*q*) The legal import of the terms "true and first inventor," is satisfied in three ways—the discoverer, the discoverer and publisher, the importer. *Ante* 49, n. *g*.

This plea admits the invention to be new, but denies the plaintiff to be the inventor, and will be supported by evidence of any other person having made the same invention and published it to the world.

(*r*) This plea concludes with a verification, this conclusion being proper whenever the plea introduces matter which is not alleged in the declaration. A direct allegation in words to the effect of this plea would not properly be made in the declaration as being matter not within the plaintiff's knowledge. This plea is the converse of the former, in that it admits the plaintiff to be an inventor, but denies the invention to be new.

(*s*) This plea puts the plaintiff to the proof of the sufficiency of his specification.

Buller, J.: "I hold that a plaintiff must give some evidence to show what his invention was, unless the other side admits that it has been tried and succeeds. Whenever the patentee brings an action on his patent, if the novelty or effect of the invention be disputed, he must show in what his invention consists, and that he produced the effect proposed by the patent in the manner specified. Slight evidence of this on his part is sufficient, and it is then incumbent on the defendant to falsify the specification." *Turner* v. *Winter*.

Hence, when it was a question whether a particular substance answered the proposed effect (the substance, bituminous schistus, which had been used having been supplied by the patentee himself), it was held that the plaintiff must show either some known process of preparing it, or that there was some bituminous schistus known in this country with the iron not entirely extracted, that might be used with effect. *Derosne* v. *Fairie*.

"It seems to me to be clearly the duty of the plaintiff to have done one of two things; either to prove that bituminous schistus, with the admixture of the sulphuret of iron, as it is known in Eng-

That specification was not duly enrolled.

5. And for a further plea in this behalf, the defendant says, that the plaintiff did not within calendar months, next and immediately after the date of the said letters patent, cause the said instrument in writing, under his hand and seal, to be enrolled in her Majesty's High Court of Chancery, at Westminster, in manner and form as the plaintiff hath above in his said declaration in that behalf alleged; and of this the defendant puts himself upon the country (*t*).

That the invention was not an improvement.

6. And for a further plea in this behalf, the defendant says, that the said invention in the declaration mentioned [and not disclaimed, &c.] was not an improvement in, &c., in manner and form as the plaintiff hath above in his declaration in that behalf alleged; and this the defendant is ready to verify (*u*).

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land, would, on the whole, answer the purpose beneficially; or that it could be removed by any practical man acquainted with the subject, that there is no secret connected with it." Per *Parke*, B. *Ibid.*

But this plea will not let in an objection to a specification, on the ground that it does not disclose the double process which would be expected from the title: "The plea states the specification to be insufficient, whereas it is said it is sufficient, supposing we think it adequate to describe the invention that he really had made, even if it be not sufficient to describe the second branch of the invention set forth in the patent; and it is said that the true objection is, that he has taken out his patent too large for his invention, and that of that objection the defendant may avail himself by putting his plea in a different form to that on the record." Per Lord *Abinger*, C. B. *Derosne* v. *Fairie*.

Nor an objection that the patent as specified is not good, or that the patent is for a mere abstract principle. *Jupe* v. *Pratt*.

(*t*) This plea puts the plaintiff to the production of an office copy of the specification, the enrolment of which would be admitted on the record if not traversed. In *Derosne* v. *Fairie* and in *Cornish* v. *Keene*, the plea was, "did not, &c. cause any instrument in writing, particularly describing and ascertaining the nature of his said invention, and in what manner the same was to be performed, to be enrolled," &c. And the question was, whether under this plea the defendant could go into any objection as to the sufficiency of the specification.

The real issue under this plea would appear to be, whether the invention was described by an instrument in writing, and not whether the instrument is sufficient to support the patent, or whether it sufficiently describes the mode of manufacture, or is in any way defective. The decision in *Fisher* v. *Pimbley*, 11 East, 188, appears to have overruled some of the earlier decisions applicable to this point.

(*u*) This defence may frequently be pleaded in another form, as by traversing an allegation in the declaration, as in *Cornish* v. *Keene*.

But when the patent is for several inventions claimed as improvements, great care will be requisite in pleas of this nature.

In an action for the infringement of letters patent, granted for "certain improvements in steam engines and in machinery, for propelling vessels," &c., the defendant pleaded, among other pleas, "that the alleged improvement was not an improvement in steam engines." This issue being found for the defendant, the question was whether the plaintiff was not entitled to judgment *non obstante veredicto*, or to a repleader.

Parke, B. "The suggestion in the letters patent is, that Galloway had invented certain improvements in steam engines, and in machinery for propelling vessels, which improvements were applicable to other purposes, and the patent is granted for the invention of those improvements. But unless the specification be referred to, to explain the title of the patent, it is doubtful whether the invention claimed is of improvements in steam engines, as connected with the other machinery only, or of improvements in steam engines to whatever purpose they may be employed. Upon reference to the specification, there is no doubt that the claim is of the latter description; but that instrument is not stated in the record; and, upon what appears in the record, it is by no means clear that the patentee does claim an improvement in steam engines unconnected with

Setting out specification, and denying its sufficiency.

And for a further plea in this behalf the defendant says, that the said instrument in writing so enrolled in her said Majesty's High Court of Chancery as aforesaid, was and is as follows :—To all to whom, &c. [*setting out the specification*], as by the said instrument in writing, now remaining enrolled in her said Majesty's High Court of Chancery, will more fully appear. And the defendant further says, that the said specification or instrument in writing so enrolled as aforesaid, does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, according to the true intent and meaning of the said letters patent and proviso in manner and form as in the said declaration alleged. And this the defendant is ready to verify (*w*).

That invention is prejudicial.

7. And for a further plea in this behalf the defendant says, that the said letters patent in the declaration mentioned were and are contrary to law and mischievous to the state, by raising prices of commodities at home, and to the hurt of trade, and generally inconvenient in this to wit, that the said invention, &c. (*x*); and this the defendant is ready to verify (*y*).

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the machinery; and if he does not, the plea would probably have been bad on demurrer, as it is uncertain whether it does not deny the invention to be an improvement in steam engines unconnected with machinery. But after verdict this objection is removed; for it is a rule, that if an issue could have been material, the court after verdict ought to intend it to be so (*Kemp* v. *Crews*. Lord Raymond, 162); and as the plaintiff did not demur, it must be taken that he admits that the plea is to be understood as denying the invention to be an improvement in steam engines, in that sense in which it is used in the patent itself, and the jury must be intended so to have found." *Morgan* v. *Seaward*.

(*w*) If the specification be set out in the declaration, this plea must be modified accordingly. If the specification is not set out in the declaration, it will frequently be advisable for the defendant to put it upon the record, by setting it out in his plea, that the court may be able to judge of its sufficiency.

This form of plea, with the allegations of the plaintiff not being the true and first inventor, *or want of novelty*, may be adopted, instead of the second and third pleas, in some cases.

(*x*) The special facts, from which the general inconvenience and prejudice to the public result, should be distinctly stated. Per *Buller*, J., *R.* v. *Arkwright*. Printed case, 30.

(*y*) This plea is suggested in consequence of the observations of the learned judges in some recent cases, and the difficulty which presents itself as to the manner in which the defence of want of utility should be put upon the record.

The Court of Exchequer intimated that a plea, "that the alleged invention was and is of no use, benefit, or advantage to the public whatsoever," would be bad on special demurrer, and that a plea to this effect ought to pursue the words of the statute.

Parke, B., in delivering the judgment of the court, says, "A grant of a monopoly for an invention which is altogether useless, may well be considered as mischievous to the state, to the hurt of trade, and generally inconvenient within the meaning of the statute, which requires as a condition of the grant, that it should not be so; for *no addition or improvement* to such an invention could be made by any one during the continuance of the *monopoly, without obliging the person* making use of it to purchase the useless invention; and on a review of the cases, it may be doubted whether the question of utility is any thing more than a compendious mode introduced in comparatively modern times, of deciding the question whether the patent be void under the statute of monopolies; and the court does not mean to intimate any doubt as to the validity of a patent for an entire machine or subject which is, taken altogether, useful, though a part or parts may be useless, always supposing that such patent contains no false suggestion." *Morgan* v. *Seaward*.

That the infringement was before the disclaimer.

8. And for a further plea as to so many of the supposed grievances in the said declaration mentioned, as were committed before a certain day, to wit, &c., the defendant says, that the said disclaimer and memorandum of alteration in the declaration mentioned were not entered or enrolled until the said day of A.D. aforesaid, and until after the committing of the said several supposed grievances in the introductory part of this plea mentioned, and that the said invention for and in respect of which the said letters patent were so granted as in the declaration mentioned, was not at the time of making and granting the said letters patent a new invention as to its public use and exercise, within, &c., but on the contrary thereof had been and was, to a material part thereof, before and at the time of the making and of the grant of the said letters patent, in public use and exercise, within that part of the United Kingdom of Great Britain and Ireland, &c., by reason whereof the rights, &c., were at the time of making and granting the said letters patent, and of enrolling the said specification, and at the said several times when, &c., before the said day, and from thence respectively until the entry and enrolment of the said disclaimer and memorandum of alteration, and until and after the committing of the said supposed grievances in the introductory part of this plea mentioned, continued to be wholly void and of no effect, wherefore the defendant at the said several times when, &c., in the said declaration mentioned, before the said day, &c., and whilst the said privileges, benefits, monopolies, advantages and prohibitions, were so void and of no effect, as

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It has been held, that the inutility of an original invention cannot be given in evidence, in defence in an action for infringement on the improvement; for, though the original invention was not useful, the improvement might be so, as remedying the defect of the original invention. Per *Tenterden*, C. J., *Lewis* v. *Davis*.

See *Hullett* v. *Hague*. *Ante* 11, n. *g*.

If a machine be new and useful in the whole, the fact of its not being useful in some cases is not sufficient to vitiate the patent. It is sufficient if it be useful in the generality of cases. *Haworth* v. *Hardcastle*.

If the utility of the invention, and the purpose of the patent as described, and the specification, wholly fail, this is of itself an answer to the action. Per *Thompson*, C. B., *Manton* v. *Parker*.

Hence some evidence of utility, though slight will suffice, must be given. See *ante*, n. *s*.

But the uselessness of parts of an invention, if a beneficial result on the whole be obtained, will not vitiate.

In a patent for an improved gas apparatus, consisting of a series of apparatus, most of which were laid aside; they did, however, answer the purpose proposed. Held, that the uselessness of these parts did not vitiate the grant. *Crossley* v. *Beverley*.

In Lewis's patent for shearing woollen cloth, it was held not essential that all the parts should be useful, but only that they be new. *Lewis & another* v. *Marling*.

But *contra*, if the specification described such useless part as essential. *Ibid*.

The new rules make it necessary to consider very accurately what pleas you should make, now you are confined to the pleadings. Per Lord *Abinger*. *Jupe* v. *Pratt*.

"It is probable that something may arise out of that provision, that states that an invention, if prejudicial, is not to be the subject of a patent. I agree that if a patent is not useful it may not be prejudicial, therefore you ought not to plead that it is not useful." Per *Alderson*, B. *Ibid*.

aforesaid, committed the said several supposed grievances in the introductory part of this plea mentioned, as he lawfully might for the cause aforesaid; and this the defendant is ready to verify (*z*).

Notice of Objections (*a*).

In the, &c.

Between, &c.

Take notice, that the defendant will rely on the following objections to the letters patent in the declaration in this cause mentioned.

That, &c. (*b*)

Dated this, &c.

A. B.
Defendant's Attorney.

To C. D., Plaintiff's Attorney.

(*z*) The allegations of this plea will depend on those of the disclaimer and memorandum of alteration, and special circumstance of the case. This form of plea was pleaded in *Perry* v. *Skinner*.

The replication alleged that the grievances were respectively committed only with relation to and in respect of those parts of the invention to which the disclaimer and memorandum of alteration did not apply. On demurrer to this replication, the court held the plea an answer to the action. See *ante* 54, n. *i.* and *k*.

(*a*) These objections are to be delivered with the pleas; and if the defendant omit to deliver this notice with his pleas, as required by the statute, the court, if satisfied on the merits, will grant him leave to plead *de novo*, and then he may deliver his notice of objections with the first pleas. *Ante* 59, n. *t*.

(*b*) What is a sufficient notice of objections under the statute has been much discussed. See *ante* 59, n. *t*. The objections in several recent cases have been already noticed. *Ante* 112, n. *m*. &c.

In *Fisher* v. *Dewick* twenty particulars of objections were delivered, but the court was of opinion that they were so vague, that they could scarcely have been furnished with any other object than to mislead; that the specific objections must be pointed out. See 4 *Bing*. N. C. 707.

The amended particulars in this case state with extreme minuteness of detail the particular parts, as described in the specification, which were old or useless; the names and addresses of those who were said to have used them; the kind of machines to which the alleged improvements were inapplicable. This case had been considered as overruling the previous case of *Bulwer* v. *Mackenzie*, but this has been doubted, and judges at chambers have declined to act upon it, and ordered the parties to apply to the court.

In a recent case the following objections, among others, were delivered:

"That the plaintiffs are not the true and first inventors of the patented invention, for that locks similar to the patented invention were made by the defendant's mother, and by himself, many years before the date of the said patent, and sold to divers persons, and among others to one S. T. of W."

An application was made for the names and addresses of these divers persons, on the ground of the objection being vague and indefinite; but *Coltman*, J., refused an order, and directed an application to the court.

XXII.

ACTION ON THE STATUTE.

5 & 6 W. 4, c. 83, s. 7.

DECLARATION.

In the, &c.

The day of A.D.

—to wit, A. B., who sues as well for our sovereign lady the Queen as for himself in this behalf (the plaintiff in this suit), by, &c., complains of C. D. (the defendant in this suit), who has been summoned to answer the said plaintiff in an action of debt, and the plaintiff demands of the defendant the sum of 50*l.*, which he owes to and unjustly detains from him, and our said sovereign lady the Queen; for that whereas, &c. (*a*)

And the plaintiff further says, that the said defendant, before and at the time of the committing of the grievances hereinafter mentioned, or any or either of them, had not obtained letters patent for the sole making and selling of the said invention, yet the said defendant, well knowing the premises, but contriving and wrongfully intending to injure the (*patentee*), and against the form of the statute in such case made and provided, afterwards and during the said term of fourteen years by the said letters patent so granted as aforesaid, to wit, on the day of A.D. unlawfully and without leave in writing of such patentee or his assigns, did make *or* use, &c. (*b*), a certain, &c., and did write, &c., upon the said, &c., for the sole making or selling of which he had not obtained letters patent as aforesaid, contrary to the form of the statute in such case made and provided, whereby and by force of the said statute the said defendant has forfeited the sum of 50*l.* of lawful money of Great Britain, and thereby and by force of the statute in such case made and provided an action hath accrued to the said plaintiff, who so sues as aforesaid, to demand and have for our said lady the Queen, and for himself in this behalf, of and from the said defendant the said sum of 50*l.* so forfeited as aforesaid, being the said sum above demanded; yet the said defendant has not paid the said sum of 50*l.* to the said plaintiff, who sues as aforesaid, or to our said lady the Queen, or either

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(*a*) As in the declaration in the action at law, from * p. 108 to * p. 110. Any person may sue in this action, and the plaintiff may consequently be neither patentee nor assignee, nor in any way connected with the patent.

(*b*) Those words of the statute must be selected which are peculiarly applicable to the circumstances of the case.

of them, but to pay the same, or any part thereof, to them or either of them, the said defendant has hitherto wholly refused, and still doth refuse, and therefore, as well for our said lady the Queen as for himself, the said plaintiff brings his suit, &c.

Plea (*z*).

And the defendant by, &c., says that he does not owe to our sovereign lady the Queen, and to the plaintiff who sues as aforesaid, or to either of them, the said sum above demanded, or any part thereof, in manner and form as the said plaintiff, who sues as aforesaid, hath above thereof alleged, and of this the defendant puts himself upon the country, &c.

XXIII.

SCIRE FACIAS (*a*).

Victoria, by, &c., to the sheriff of Middlesex, greeting; Whereas we lately, by our letters patent under the great seal of Great Britain, bearing date, &c., reciting that whereas C. D., of, &c. (*b*), as by the said letters patent, enrolled in our said High Court of Chancery, more fully and at large appears.

And whereas we are given to understand that the said C. D. was not the true and first inventor thereof, &c.; that the said invention, at the time of the granting of the said letters patent, was not a new invention as to its public use and exercise, &c. (*c*); and we are also given to understand, that although the said C. D. did cause a certain instrument, &c., pretending thereby particularly to describe, &c., which was and is in the words

Allegations.

(*c*) This plea is good in penal actions notwithstanding the new rules, it being enacted by 21 Jac. 1, c. 4, that in any penal action the defendant may plead that he is not guilty, or that he owes nothing, and give the special matter in evidence.

(*a*) The *scire facias* is a judicial writ founded on some matter of record; though a judicial writ, or writ of execution, it is so far in the nature of an original that the defendant may plead to it, and in that respect it is considered as an action, and a release of all actions includes proceedings by *scire facias*. It is also in the nature of a declaration, and may be formed according to the subject-matter. Co. Litt. 291 *a*.

It may be sued out either in the Petty Bag Office in Chancery, or in the Queen's Bench. See 2 Williams Saun. 72, *p*, and 6 Bac. Ab. Sci. Fa. C. 3. 4 Inst. 72.

If the *sci. fa.* be returnable in the Queen's Bench, that court alone has jurisdiction in the writ. *Brewster* v. *Weld*.

(*b*) Set out the letters patent *verbatim*.

(*c*) The usual allegations will be those here inserted, but others of a special nature may be introduced.

In Arkwright's case there was an allegation that the grant was prejudicial and inconvenient; and *Buller*, J., held that this being traversed raised only a consequential issue, and refused to receive any evidence upon it; and that the special facts, or in what respect it was so, should be tated. *R.* v. *Arkwright*. See *ante* 117, *n. x.*

following, that is to say, "To all," &c. (*d*); yet that the said C.D. has not in and by the said instrument in writing so by him enrolled in our High Court of Chancery, or by any other instrument in writing under his hand and seal enrolled in our High Court of Chancery, within calendar months next and immediately after the date of the said letters patent, particularly described and ascertained the nature of his said invention, and in what manner the same is to be performed; but hath wholly neglected so to do, contrary to the proviso of the said letters patent in that behalf. By means of which several premises the said letters patent so as aforesaid granted to the said C. D. are and ought to be void, and of no force and effect in law.

And, we being willing that what is just should be done in the premises, command you, that by good and lawful men of your bailiwick, you make known (*e*) to the said C. D. that he be before us in our Chancery in fifteen days (*f*) now next ensuing, wheresoever we shall then be in England, to show if he hath or knoweth any thing to say for himself why the said letters patent so granted to him, and the enrolment of the same for the reasons aforesaid, ought not to be cancelled, vacated, and disallowed, and those letters patent restored into our said Chancery, there to be cancelled, and further to do and receive those things which our said Chancery shall consider in this behalf, and have you there the names of those by whom you shall give him notice and this writ (*g*).

Witness, &c.

Notice of Objections (*h*).

Pleas (*i*).

(*d*) Set out the specification *verbatim*. If there be drawings, there should be an averment to that effect. *Ante* 110, n. *g*.

(*e*) This in the old writ being *scire facias*, the proceedings thence derive their name. Co. Litt. 291 *a*.

(*f*) If there be fifteen days inclusive, between the teste of the writ of the first *sci. fa.* and the return of the second, it is sufficient. 2 Salk. 599.

(*g*) The judgment is, that the said letters patent of our said lady the Queen be revoked, cancelled, vacated, annulled, void and invalid, and be altogether had and held for nothing, and that the enrolment thereof be cancelled, quashed, and annulled. 4 Just. 88.

Hence the Chancellor derives his name, it being the highest point of his jurisdiction to cancel the letters patent of the Crown. *Ibid.*

The letters patent are to be recalled into the same place whence they issued, and cancelled by having the great seal taken off. 1 Str. 151.

(*h*) The plaintiff in *scire facias* must deliver a notice of the objections on which he means to rely. *Ante*, 58. As to these, see *ante* 119, n. *b*.

(*i*) The defendant, if he does not demur (3 Lev. 220), will simply have to traverse the allegations in the writ.

TABLE OF FEES.

PATENT FOR ENGLAND.

	£.	s.	d.			£.	s.	d.	£.	s.	d.
Stamps	6	0	0	Secretary of State's	Reference .	2	2	6			
					Warrant .	7	13	6			
					Bill . . .	7	13	6			
									17	9	6
				Mr. Attorney-Gen.	Report . .	4	4	0			
					Bill . . .	15	16	0			
									20	0	0
				Signet Office,*	Fees . . .	3	1	0			
					Gratuity . .	1	1	0			
					Office-keeper	0	5	0			
									4	7	0
				Privy Seal*,	Fees	2	16	0			
					Gratuity . .	1	1	0			
					Office-keeper	0	5	0			
									4	2	0
	30	2	0	Great Seal† Office	Fees						
					Stamps . .	30	2	0			
					Bonds . .	0	3	6			
					Gratuity .	2	2	0			
					Hanaper . .	7	13	6			
					Deputy . .	0	10	6			
					Recipi . .	1	11	6			
					Sealers . .	0	10	6			
					Office-keeper	0	5	0			
									49	2	2
				Passing the Patent					10	10	0
				Letters, &c.					1	1	0
	5	0	0	Specification according to its length.							
Stamps,	£41	2	0					£	106	11	8

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SIGNET OFFICE:

Fees and Stamps	7	13	0
Gratuity	2	2	0
Receiver and Assistant Clerk . .	0	10	6
	£10	5	6

PRIVY SEAL OFFICE:

Fees and Stamps	7	8	0
Gratuity	2	2	0
Record Keeper	0	10	6
	£10	0	6

† Every additional name pays £2 13*s.* 4*d.* at the Great Seal. If the letters patent include the Colonies or the Channel Islands, either or both, there will be an additional expense of £7 7*s.* 6*d.*, viz.: £1 7*s.* 6*d.* both on the Warrant and Bill; £2 5*s.* both at the Signet and Privy Seal; and 2*s.* 6*d.* on the Attorney-General's Bill.

SCOTCH PATENT.

	£.	s.	d.			£.	s.	d.	£.	s.	d.
				Secretary of State's	Reference .	2	2	6			
	£.	s.	d.		Warrant . .	15	7	0			
Stamps	1	10	0		Stamp . .	1	10	0			
									18	19	6
				Lord Advocate's	Report . .	.	.	.	4	4	0
					Director . .	15	0	0			
					Clerk . . .	7	10	0			
					Translator .	1	1	0			
					Director . .	1	1	0			
					Servant . .	0	2	6			
					Livery . .	0	3	7½			
					Extra . . .	0	2	6			
									25	0	7½
				Great Seal, Lord Keeper .		6	13	4			
					Deputy . .	2	10	0			
					Usher . .	2	4	5½			
					Appendee .	2	2	0			
					Deputy . .	1	1	0			
					Wax . . .	0	7	6			
					Extra . . .	0	2	6			
					Agent . .	4	4	0			
									19	4	9½
				Passing Patent					10	10	0
				Letters					1	11	6
	5	0	0	Specification according to length.							
Stamps,	£6	10	0					£	79	10	5

IRISH PATENT.

	£.	s.	d.			£.	s.	d.	£.	s.	d.
				Secretary of State's	Reference . .	2	2	6			
	£.	s.	d.		Warrant . .	7	13	6			
Stamp	1	10	0		Stamp . . .	1	10	0	11	6	0
				Mr. Attorney-General and Solicitor-General's Report					31	10	0
				Paid entering at Signet Office . . .					3	3	0
				Paid entering at Seal Office					2	14	6
				Lord Lieutenant for Fiat					5	5	0
				Mr. Attorney-General and Clerk for Fiat					11	0	3
				Clerk of the Hanaper					8	9	2
	23	13	4	Stamp to the Grant					21	13	4
				Enrolling					1	1	8
Stamp to Specification	1	0	0	Further Fees paid in Ireland					21	2	6
				Passing the Patent					10	10	0
				Letters					0	10	6
	£26	3	4					£	128	5	11

DIGEST

OF

THE REPORTED CASES.

1. Letters patent for the sole trade of making frisadoes, held bad, on the grounds that certain clothiers in this country had made baize very like the frisadoes prior to the date of the letters patent. *Hastings'* case, *A.D. 1568.*

2. A privilege, to be consonant to law, must be of a subject-matter essentially and newly invented. *Bircot's* case.

3. A slight difference, as a different kind of haft to knives, is not sufficient to support an invention. *Matthey's* case.

4. Letters patent for the sole and only use of an instrument, as newly invented by the grantee, held void, if the same has been used before. *Humphrey's* case.

5. Letters patent for the sole importation and manufacture of playing cards void both at common law and by statute. *Darcy* v. *Allein.* The case of monopolies.

6. 21 Jac. 1, c. 3.—*The statute of Monopolies.* All grants of monopolies void, except letters patent for fourteen years, of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patent 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.

7. The crown will grant a warrant to amend and reseal letters patent of a grant of lands, in the case of a clerical error in the name of a county. In re *Digby.*

7*. A *scire facias* may be sued by any person who is prejudiced by a patent, as well as by the King.

If a writ issue out of Chancery, and be returnable into another court, the court into which it is returnable and not the Chancery has jurisdiction, nor can the Chancery supersede such writ. *Brewster* v. *Weld.*

8. Affidavits allowed to be read for the patentee of a new invention, on a motion to dissolve an injunction, on the coming in of the answer. Where there is a grant of a new invention by patent, a small variation of the invention will not entitle another to break in upon the patent. So in the case of a grant of the sole printing of a book to the author who takes whole paragraphs from another book, this, not material for it, may be necessary to introduce what is new. *Gibbs* v. *Cole.*

9. The plaintiff moved for an injunction to restrain the defendant from using the Mogul stamp on his cards, suggesting the sole right to be in the plaintiff, having appropriated the stamp to himself, conformable to the charter granted to the Cardmakers' Company by Charles I. Lord Hardwicke denied the injunction, and said he knew no instance of restraining one order from making use of the same mark as another.

A cloth-worker may maintain an action against another of the same trade for using his mark, where it is done with a fraudulent design to put off bad cloths, or to draw away customers.

This court will never establish a right claimed under a charter, unless there has been an action to try the right at law.

The objection of the defendant taking away the plaintiff's customers by using the same mark, is of no more weight than to one innkeeper setting up the same sign with another. *Blanchard* v. *Hill.*

10. If an invention be new in England a patent may be granted for it, though it was practised beyond the seas before; for the statute speaks of new manufactures within this realm; and if they be new here it is within the statute, which was intended to encourage new devices useful to the kingdom, and whether learned by travel or by study it is the same thing. *Edgebury* v. *Stephens.* Cited by *Buller*, J., in *Boulton & Watt* v. *Bull*, as almost the only case under the saving clause of the statute of 21 Jac. 1, c. 3.

11. Every false recital in a thing not material will not vitiate the grant, if the King's intention is manifest and apparent.

If the King is not deceived in his grant by the false suggestion of the party, but from his own mistake upon the surmise and information of the party, it shall not vitiate or avoid the grant.

Although the King is mistaken in point of law or matter of fact, if that is not part of the consideration of the grant, it will not avoid it.

Where the King grants *ex certâ scientiâ et mero motu*, those words occasion the grant to be taken in the most liberal and beneficial sense, according to the king's intent and meaning expressed in his grant.

Although in some cases the general words of a grant may be qualified by the recital, yet if the King's intent is plainly expressed in the body of the grant, the intent shall prevail and take place. Per *Lee*, C. J., *R.* v. *Massary.*

12. A patent for an addition or an improvement must be confined to that addition or improvement; and if the invention be of a particular movement of a watch, the patent must be for that, and not for the whole watch. *Jessop's* case.

13. The first publisher of an invention, if also an inventor, is the true and first inventor within the statute. *Dollond's* case.

14. An addition to an existing machine, as of a set of working needles for oilet holes to a stocking frame, is a good subject-matter. Per Lord *Mansfield*, C. J. *Morris* v. *Branson*.

15. The meaning of the specification is, that others may be taught to do the thing for which the patent is granted; hence, if it be false, or give not the fullest and most sufficient description of all the particulars on which the effect depends, to the very best of the knowledge of the patentee, the patent is void. Per Lord *Mansfield*, C. J., *Liardet* v. *Johnson*.

The omission in the specification of the proportions or quantities of the ingredients, would have been fatal to Dr. James's patent for fever powders. *Ibid.*

Also the omission of any material process. *Ibid.*

16. A specification, describing the machine altogether, without distinguishing old from new, or claiming it as the application of a new invention upon an old thing, is bad. *Williams* v. *Brodie*.

17. A demurrer to a bill for injunction to stay the infringement of a patent right, on the ground that the plaiutiff had not established his right at law, will be overruled. *Hicks* v. *Raincock*.

18. Letters patent bore date the 12th August, but a caveat was not discharged till the 27th; the patentee, supposing they bore date the latter day, did not enrol his specification till the 18th December, when the four months had expired. Held, that the date of the patent could be altered. *Beck*, ex parte.

19. Any thing material and new which is an improvement of trade, will be sufficient to support a patent, but it must be for that addition only.

The allegation that a patent is prejudicial to the King's subjects in general is a consequential issue; the record should state in what the general inconvenience consists, and the jury having found such facts, it was a question of law as to the inconvenience.

The specification must disclose the secret so that others may be taught by it; and must teach what the art is, and put the public in possession of the secret in as simple and beneficial a way as the patentee uses it; and if it be proved by men knowing something of the particular business, mechanics in general, that they cannot do it, the invention is not sufficiently described to support the patent.

The specification must distinguish between things for different purposes what is intended for each.

The insertion of that which is not new, or which has nothing to do with the machine, and for which no motive can be assigned but to perplex, will vitiate the patent. Per *Buller*, J., *R.* v. *Arkwright*.

The verdict was for the Crown, and a motion for a new trial on the grounds of surprise was refused, and judgment was given to cancel the patent. (November, 1785.)

This patent had been the subject of litigation previously. In *Arkwright* v. *Mordaunt* there was a verdict for the defendant, on the ground of obscure and imperfect specification (A. D. 1781), and in *Arkwright* v. *Nightingale* for the plaintiff (Feb. 1785).

20. A claim for making lace of silk and cotton thread mixed, without confining it to the particular mode of mixing them upon the frame, which constitutes the merit of the invention, will vitiate a specification. Per *Buller*, J., *R.* v. *Else*.

21. A patent is void if the specification is ambiguous, or gives directions which tend to mislead the public. *Turner* v. *Winter*.

As if it states that by one process three things may be produced, and the process fail as to any one, or if the specification directs the same thing to be produced several ways, or by several different ingredients, and any one of them fail. *Ibid.*

22. Upon application to the Chancellor to withhold the great seal from a patent, he will only consider whether it is legal or not; and not whether the Crown ought to grant it or not. Ex parte *Daly*.

23. That which is granted by the patent must be entirely new, and it is not sufficient that one part should be very ingenious and perfectly new, unless it be claimed by the specification. Per Lord *Kenyon*, C. J., *Bramah* v. *Hardcastle*.

24. A patentee who has conveyed away his interest is estopped from denying his right to convey. Per Lord *Kenyon*, C. J., *Oldham* v. *Longmead*.

25. The court refused to seal a patent for representing Italian operas, because the provisions for carrying it on were by agreement with the Lord Chamberlain, his executors and administrators, and the right to the patent was not sufficiently connected with the property in the house.

It is not sufficient for the party applying merely to answer objections, but he must lay a proper case. Upon such application the court will take care that the King is not deceived, nor his object disappointed, and will represent the whole to the King, but will not decide upon the merits of the various claimants.

The court will not seal a patent which does not put the parties under some control, though there is no caveat.

A patent in fee could not stand if abused.

Qy? Whether a patent can be the subject of a trust. Per Lord *Thurlow*, L. C. Ex parte *O'Reilly*.

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

26*. A method of disposing plates of iron so as to produce a useful effect, viz., to secure buildings from fire, is a good subject-matter. Per *Eyre*, C. J. *Hartley's* case.

27. In order to prevent a patent invention being made known abroad before it could be used by the King's subjects, an act of parliament was passed permitting the specification to be delivered to the Lord Chancellor within eight months under certain restrictions, sealed, instead of being enrolled, 32 G. 3, c. 73, *Booth's* patent.

28. The venue cannot be changed from Middlesex to another county, since the letters patent, the substratum of the action, are at Westminster, and the usual affidavit that the cause of action arose wholly in the other county, and not elsewhere, cannot properly be made. *Cameron* v. *Gray*.

29. There must be separate bills upon distinct invasions of a patent, otherwise of a right of fishery or the custom of a mill. *Dilly* v. *Doig*.

30. A patent was granted to A. B. for a newly invented method of using an old engine in a more beneficial manner than was before known.

The specification stated that the method consisted of certain principles, and described the mode of applying those principles to the purposes of the invention, and an act of parliament, reciting the patent to have been for the making and vending certain engines by him invented, extended to A.B. for a longer term than 14 years the privilege of making, constructing and selling the said engines.

Qy? Whether under these circumstances the patent right was valid. *Boulton & Watt* v. *Bull*.

The court was equally divided in opinion, and no judgment was given. *Post* (32).

31. Injunction, that the validity of a patent might be tried at law; verdict for the patentee, subject to the court upon a case, the court equally divided; the patentee must bring another action; but the court will not impose any terms upon him, nor dissolve the injunction. Per Lord *Loughborough*, L. C. *Boulton & Watt* v. *Bull*.

32. A patent was granted by the Crown for fourteen years to A. "for his method of lessening the consumption of steam and fuel in fire-engines." The specification stated that the method consisted of the following principles (describing the mode in which those principles were applied to the purposes of the invention); afterwards an act of parliament passed to extend the patentee's term, the title of which was, "an Act for vesting the sole property, &c. of certain steam-engines called fire-engines of his invention," &c. and after reciting that the patent was for making and vending certain engines by him invented for lessening the consumption of steam and fuel in fire-engines, &c. it granted him the sole right of making and selling the said engines.

Held, that the invention was the subject of a patent, and (the patentee having in his specification described the invention) that the patentee's right under the patent and act of parliament was valid. *Hornblower & Maberly* v. *Boulton & Watt*.

33. A., by indenture (reciting that a suit was depending between him and B. respecting certain patents, and that the same could not be assigned without hazard of defeating the suit) granted absolutely the said patents, together with some others, to C., excepting, however, until the determination of the above-mentioned suit, such patents as should be necessary to support A.'s legal title. Then followed a covenant that A., upon the determination of the suit, should assign the excepted patents to C., and that, until such assignment, A. should stand legally possessed of the same. Held, that the legal interest in the excepted patents vested in C., upon the determination of the suit, without assignment. *Cartwright* v. *Amatt*.

34. If the specification is not sufficiently clear to enable an ordinary tradesman to practise the invention, the plaintiff will be nonsuited. Per Lord *Eldon*, C. B., *Rountree* v. ——.

35. The enrolment of a patent cannot be dispensed with for the purpose of preventing the specification being made public. After a patent has passed, the time for specifying cannot be enlarged without an act of parliament. Per Lord *Eldon*, L. C. Ex parte *Koops*.

36. If any material part of the invention be suggested by another person, the patentee will be nonsuited. Per Lord *Ellenborough*, C. J., *Tennant's* case.

37. Upon the answer to a bill by the universities of Oxford and Cambridge, the King's printer not joining, but being made a defendant, an injunction, restraining the sale in England of Bibles, Prayer Books, &c., printed by the King's printer in Scotland, was continued to the hearing. *Universities* v. *Richardson*.

38. The imitation of any part of an invention included in a prior patent, is an infringement. Per Lord *Ellenborough*, *R.* v. *Murray*.

39. A patent was taken out by Hare for an apparatus in brewing beer, whereby the essential oil of hops obtained from the steam of the worts was preserved, and used for heating the water for brewing. By a previous invention, the water had been boiled by a similar method, which, however, preserved the oil, though not intended to do so. *Hare* v. *Harford & Taylor*.

The jury returned a verdict for the defendant, without waiting for the judge summing up.

40. A. having obtained a patent for an invention of which he supposed himself the inventor, agreed to let B. use it, upon payment of a certain annual sum secured by bond. This sum was paid for several years, when B., discovering that A. was not the first inventor, but that it was in public use *before* A. obtained *his* patent, brought an action for money had and received to recover back the amount of the annuity paid. Held, that he could not recover. *Taylor* v. *Hare*.

41. Covenant by the assignor of certain shares in a patent right, that he has good right, full power, and lawful authority, to assign and convey the said shares, and that he has not by any means, directly or indirectly, forfeited any right or authority he ever had, or might have had, over the same.

Held, that the generality of the former words of the covenant is not restrained by the latter.

If the assignees of an uncertificated bankrupt in their own name execute a deed with other creditors, whereby they and all the creditors who may sign the said deed release the bankrupt from all actions, suits, claims and demands against him or his estate, and such deed be not signed by all the creditors of the bankrupt, the assignees are not barred from claiming, as assignees, the benefit of a patent right afterwards obtained by the bankrupt.

A patent right for the exclusive exercise of an invention obtained from the Crown by an uncertificated bankrupt, is affected by the previous assignment of the commissioners, and vests in the assignees.

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

42. A resultant or product found to agree in all its qualities with that actually made under a patent, is *primâ facie* evidence, till the contrary is shown that it was made on the patentee's method.

The specification must convey to the public a corresponding advantage with that of the patentee, so that any person who is skilled in the subject may, looking to the specification, be able to accomplish the end.

In inventions of mechanism, there are some materials which are common, and cannot be appropriated by any patent. They are common elements; but it is the adoption of those to the execution of a particular purpose that constitutes the invention; and if the application of them be new—if the combination in its nature be essentially new—if it be productive of a new end, and beneficial to the public, it is that species of invention which may be protected by patent; but if, prior to the date of the patent, any part of that which is of the substance of the invention has been communicated to the public in the specification of any other patent, or in part of the service of the country, so as to be a known thing, the patent cannot be maintained. Per Lord *Ellenborough*, C. J., *Huddart* v. *Grimshaw*.

43. The plaintiff declared in assumpsit, on an agreement by the defendant, not to avail himself or take any undue advantage of a communication made to him by the plaintiff, of an invention for which the plaintiff intended to take out a patent, and assigned as a breach that the defendant fraudulently obtained a patent in his own name. Evidence that the defendant fraudulently obtained a patent in his own name, which the plaintiff afterwards agreed should remain in the defendant's name upon certain terms, which terms the defendant, before the commencement of the action, had renounced, insisting upon the invention as his own, was held to maintain this breach.

If a party agree not to do some specified act, under a "penalty" of £1,000, such sum cannot be counted in the nature of liquidated damages. *Smith* v. *Dickenson*.

44. The court will not dissolve an injunction granted on the ground that the public has permitted a reasonably-long and undisputed possession of an exclusive right, under colour of a patent; for there is less inconvenience in granting the injunction until the legal question can be tried, than in dissolving it at the hazard that the patent may in the result prove valid; and unless the injunction were granted, any person might violate the patent, and the patentee would be ruined by litigation. The patentee having had possession against all the world, it would be against principle and practice to dissolve the injunction before the validity of the patent is tried, unless under very strong doubts whether the specification is not bad in law. Per Lord *Eldon*, L.C. *Harmer* v. *Playne*.

45. A. having obtained a patent for a certain manufacturing machine, of which he duly enrolled a specification, afterwards obtained another patent for certain improvements in the said machine, in which the grant of the former patent is recited; and the latter patent contained the usual condition that it should be void, if the patentee did not, within one month, enrol a specification, particularly describing and ascertaining the nature of the said invention, and in what manner the same was to be performed. Held, that a specification containing a full description of the whole machine so improved, but not distinguishing the new improved parts from the old parts, or referring to the former specification, otherwise than as the second patent recited the first, was a performance of that condition. *Harmer* v. *Playne*.

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

Held, that the month did not begin to run till the day after the date of the patent, and that the specification was in time.

But where the computation of time is to be made from an *act done*, the day on which the act is done is to be included in the reckoning. *Watson* v. *Pears*.

47. If the specification state improvements on the flageolet, by giving it the power of producing new notes, when in fact only one new note is produced, the patent is bad for failure of consideration. Per Lord *Ellenborough*, C.J., *Bainbridge* v. *Wigley*.

48. In concurrent applications for letters patent for the same object, he who obtained the great seal first by getting quickest through the various stages, will have the sole right at law. Per Lord *Eldon*, L.C. Ex parte *Dyer*.

49. The Lord Chancellor will not withhold the great seal on the representation of a patentee that the invention is borrowed from his patent.

A party having invented improvements upon a patent cannot use that patent as a substratum before the patent has expired.

Costs will not be ordered, unless the caveat be unreasonable. Per Lord *Eldon*, L.C., *Fox* ex parte.

50. No exclusive right in a subject not protected by patent so as to prevent sale by another person under the same title, not assuming the same name and character as the plaintiff. Such a right would be a much better right than that of a patentee. Per Sir J. *Plumer*, V.C. *Canham* v. *Jones*.

51. If the utility of the invention, that is, the purpose of the patent, wholly fail, that of itself is an answer to the action, and the plaintiff will be nonsuited. Per *Thompson*, C.B., *Manton* v. *Parker*.

52. A patent is void—1st, if the specification omit any ingredient which, though not necessary to the composition of the thing for which the patent is claimed, is a more expeditious and beneficial mode of producing the manufacture; and, 2dly, if, previous to the date of the patent, the article has been publicly vended, though only four months before, and by the patentee himself. Per *Gibbs*, C.J., *Wood & others* v. *Zimmer*.

53. The patentee must show that the invention is new, unknown to the trade and to the world before, that it is useful to the public, and that the specification is sufficient. Some men of experience never having seen an invention before the patent, is *primâ facie* evidence; but fifty witnesses proving that they never saw it before, would be of no avail against one who had seen and practised it. Per *Gibbs*, C.J., *Manton* v. *Parker*.

54. An injunction obtained on the grounds that the party, under pretence of treating with the patentees for license, had watched the progress, and then practised it without a license, will be

dissolved if the validity of the patent be doubted, and an account will be ordered to be kept of the extent to which the invention has been practised, until the validity of the patents can be tried at law. Patents must be protected until found to be bad. If the patent be good, damages may be recovered against the infringers, not only by the patentees, but by all who have obtained licenses from them. Per Lord *Eldon*, L. C., *George* v. *Beaumont*, W. & M.

55. On an application to dissolve an injunction obtained for infringing the plaintiff's patent for lace-making, an objection that the bill does not contain the specification will be over-ruled by the Chancellor, the same being in record of court, and therefore unnecessary to set it out in *hæc verba*. It was also objected that the patentee had taken out his patent for machinery in general, and not for a particular machine. But the Lord Chancellor ordered the injunction to be continued, and an action at law to be tried. *Brown* v. *Moore*.

56. The specification of a patent for an improved instrument must point out precisely what is new and what is old; and it is not sufficient to give a general description of the construction of the instrument without making such distinction. If a plate be annexed, it should contain a detached and separate representation of the parts in which the improvement consists. Plaintiff non-suited. Per Lord *Ellenborough*, C. J., *Macfarlane* v. *Price*.

57. An article appearing to be an infringement, the court will direct an action at law, an account of the profits until the final determination of the suit, to be paid to the successful party, and the costs at law and equity to abide the event. *Cochrane* v. *Smethurst*.

57*. Letters patent for an improved mode of lighting cities, towns, and villages, are not supported by a specification describing an improved lamp; the title being too large and general. *Per Le Blanc*, J., *Cochrane* v. *Smethurst*.

58. The specification of letters patent for a machine consisting of an entirely new combination of parts, though all the parts may have been used separately in former machines, is correct in setting out the whole as the invention of the patentee; but if a combination of a certain number of those parts have previously existed up to a certain point in former machines, the patentee merely adding other combinations, the specification should only state such improvements, though the effect produced be different throughout. *Bovill* v. *Moore*.

59. An injunction will be refused if doubts be entertained as to the validity of the patent in respect of its subject-matter. An action should be brought at law, and then an injunction may be moved for. Per Lord *Eldon*, L. C., *Forsyth* v. *Manton*.

60. If several persons simultaneously discover the same thing, the publisher or party first communicating it to the public under the protection of a patent becomes the legal inventor, and is entitled to the benefit to be derived from the exclusive use of the invention. *Forsyth* v. *Riviere*.

61. The great seal will not be affixed to letters patent in which fifteen months are allowed for the enrolment of the specification, being contrary to the general policy of the law. Per Lord *Eldon*, L.C., ex parte *Heathcoat* in re *Lacy*.

This application was made on the precedent of Lee's case, in which an act had been passed allowing fifteen months for the enrolment of the specifications, which were even then to continue sealed up, and remain in the custody of the Chancellor, under certain restrictions, and not to be open to the public. 53 Geo. 3, c. 179 (L. & P.)

62. If a patentee in the specification sums up the principle in which his invention consists, and this principle be not new, the patent cannot be supported, although it appear that the application of the principle as described in the specification is new. Per Lord *Ellenborough*, C. J., *R.* v. *Cutler*.

63. An injunction once made must be observed until dissolved, although the patent on examination be found invalid; and the party disobeying the injunction will be guilty of contempt of court. Per Lord *Eldon*, L. C., *Walker* v. *Congreve*.

64. The court will not interfere by injunction to prevent the violation of an agreement of which, from the nature of the subject, there could be no decree for a specific performance, as, for instance, to restrain the defendant from imparting the secret of an invention which had been the subject of a patent long since expired.

To support a patent, the specification should be such as to enable all the world to use the invention from the moment of the expiration of the patent. Per Lord *Eldon*, L. C., *Newberry* v. *James*.

65. In order to obtain an injunction against the violation of a patent, the party must, at the time of applying, swear as to his belief that he is the original inventor.

Where there has been a length of exclusive enjoyment under a patent, the court will grant an injunction in the first instance without previously putting the party to establish his right by an action at law; but otherwise, where the patent is recent, to establish its validity, the invention must be new and useful, and the specification must accurately describe it.

Also, if the specification seeks to cover more than is actually new and useful, it vitiates the patent, rendering it ineffectual even to the extent to which it might otherwise have been supported.

The injunction having been dissolved, with liberty to the plaintiff to bring an action to establish his patent right, and the defendant to keep an account in the meanwhile, a verdict having been obtained for the plaintiff in the trial of the action, on application being made to revive the injunction, it was objected that the defendants intended to move for a new trial; and the matter was ordered to stand over till the result of that application should be known, the parties continuing to keep an account in the interim. Per Lord *Eldon*, L. C., *Hill* v. *Thompson & Forman*. *Post* 68.

66. *Quære*, Whether a court of equity, in the exercise of its jurisdiction to decree the specific performance of an agreement, can interfere by injunction to restrain a party from divulging a secret in medicine which is unprotected by patent.

In this case, an injunction which had been granted for that and other purposes was dissolved, upon the affidavit of the defendant (an infant) denying the facts of the case as represented by the plaintiff's affidavit in support of the injunction, and upon the ground that there was no secret in the alleged invention. Per Lord *Eldon*, L. C., *Williams* v. *Williams & uxor*.

67. A brush, differing from a common one in no other respect than in the circumstance that the hairs or bristles are purposely made of unequal lengths, is improperly described in a patent for a new invention as a tapering brush.

The difficulty arising from the grammatical construction cannot be removed, unless the term has by usage of trade acquired a perverted sense. Per Lord *Ellenborough*, C.J., *R.* v. *Metcalfe.*

68. Letters patent for an improvement or discovery (*i. e.* the title) should state in substance what is set out in detail in the specification, and if taken out for more than is strictly the inventor's own addition or improvement, or for discovery, when it is merely addition or improvement, they are bad; and such invention must be both new and useful, and the discovery not confined to the knowledge of the party making it, and must be accurately described in the specification, which, if it seeks to cover more than is actually new and useful, vitiates the patent. Therefore, where letters patent were for "the invention of certain improvements in the smelting and working of iron," and the specification described the improvements to consist in certain processes thereinafter set forth, by which the iron contained in slags or cinders, produced from the several furnaces, was by smelting brought into the state of bar iron (whether all the sorts of the said slags, or any of them, were mixed together and used; or whether all the sorts of the said slags, or any one or more of them, were compounded with iron stones or iron ores, or with both of them; whether all the said several compounds were used together, or whether only one or more of them were used); and, further, in the use and application of lime to iron, subsequently to the operation of the blast furnace, whereby the quality in iron, called "cold short," was prevented. The specification then described, that in the smelting a mixture of lime and mine rubbish was used, and stated their proportions, and also the various processes, compounds, and proportions used in the different furnaces, in the smelting and working; and further declared, that the patentee had discovered that the addition of lime, or lime-stone, or other substances, consisting chiefly of lime, and free or nearly free from any ingredient known to be hurtful to the quality of iron, would sufficiently prevent or remedy that quality in iron called "cold short," and would render such iron more tough when cold.

On the trial of an action for the infringement of this patent, it appeared that iron had before been extracted from slags, that it had been previously discovered, and even published, that the application of lime would prevent the quality called "cold short;" that such application had been used for that purpose in an extensive iron work for a series of years, previous to the date of the patent; and that the defendants had not worked according to the processes, compounds, and proportions described in the specification, for that they frequently varied the proportions, and, in one instance, omitted one of the ingredients altogether, with an equally successful result. Held, that there had been no infringement, and that the patent was void, the invention claimed not being new. *Hill* v. *Thompson & Forman.*

69. An injunction to restrain the use of spinning machines will not be granted, if the evidence as to the piracy be very contradictory, but the parties will be left to their remedy at law. *Wood* v. *Cockerill.*

70. Letters patent were "for a new or improved method of drying and preparing malt." The specification stated the invention to consist "in the heating of malt to 400° Fahrenheit, according to a process therein described; and in so heating it that the greater part of the saccharine and amylaceous principles of the grain became changed into a substance resembling gum, and extractive matter of a deep-brown colour, readily soluble in hot or cold water." Held, that the letters patent were void, being for a different invention than that disclosed by the specification; the title being for preparing malt, which must mean making it from barley, the specification describing a mode of operating on the known substance, so as to produce a new substance, viz., a colouring matter.

The subject-matter of letters patent may be a thing made, useful for its own sake, or to be applied to a useful purpose, or perhaps 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; but not a merely philosophical or abstract principle. Something of a corporeal and substantial nature, something that can be made by man from the matters submitted to his art and skill, or at the least some new mode of employing practically his art and skill, is requisite to satisfy the words of the statute. The specification of a patent for a process must be definite and precise as to the process, stating, for instance, time and degrees of heat, and state of dryness or moisture; and will be bad if it cast on the public the labour of experiment and trial. *R.* v. *Wheeler.*

71. An injunction will be granted to restrain a defendant from communicating certain recipes for medicines, and vending them, on the ground that he has obtained a knowledge of the mode of preparing them by a breach of trust. *Yovat* v. *Wynyard.*

72. Letters patent were for an improved method of making sail cloth without any starch whatever.

The improvement or discovery, if any, consisted in a new mode of texture, and not in the exclusion of starch, the advantage of excluding which had been discovered and made public before.

Held, that the patent was void, as claiming, in addition to what the patentee had discovered, the discovery of something already made public. *Campion* v. *Benyon.*

73. Letters patent, for improvements in the construction of ship's anchors, windlasses, and chain cables, cannot be supported, unless there is novelty in each invention; and it appearing that there was no novelty in the construction of the anchors—held, that the patent was wholly void. *Brunton* v. *Hawkes.*

74. In an action for infringement of plaintiff's patent for improving lace, by singeing off the superfluous fibres by the flame of gas, it was proved that the defendant had altered the arrangement of the gas pipes without any assignable cause, and carried them into a part of the shop kept quite closed, and that the consumption of gas was excessive for the size of the shop. This, in connection with the defendant's having commenced the business of bleaching and clear-starching lace, was held sufficient evidence of the infringement. Per *Abbott*, C.J., *Hall* v. *Gervas & Boot.*

75. Letters patent were for a mode of making a neutral salt or powder, viz., Seidlitz powder.

The specification set out three distinct recipes, and described the modes in which the substances were to be mixed, but did not call the substances

by their known names. Held bad, as tending to mislead, those methods not being essential to the combination, nor part of the invention. Per *Abbott*, C. J., *Savory* v. *Price*.

76. An improvement made by a workman will not support letters patent granted to the master. Per *Holroyd*, J., *Barker* v. *Shaw*. Plaintiff nonsuited. Cited in *Bloxam* v. *Elsee*.

77. Where plaintiff marked his goods "Sykes' patent," to show they were his own manufacture. The defendant copied the mark on his goods, to show that they were the plaintiff's manufacture, and sold the goods so marked as and for the plaintiff's manufacture. Held, that case would lie for the injury, though the plaintiff and defendant were both named "Sykes," and neither of them, in fact, had a valid patent. The declaration alleged that defendant sold the goods as and for goods manufactured by plaintiff. The evidence was, that the persons to whom defendant sold them knew that they were not manufactured by plaintiff, but that defendant copied plaintiff's mark, and sold the goods so marked, in order that the purchasers might resell them as and for goods manufactured by plaintiff, and which they did. Held, not a fatal variance. *Sykes* v. *Sykes*.

78. The addition of a bolt sliding or moving in a groove, held sufficient to support letters patent, for an improvement on the percussion gun-lock.

The effecting the same object by a spring held an infringement, on the evidence of mechanics, that a spring in a bolt was the same thing as a bolt sliding in a groove. Per Lord *Tenterden*, C. J., *Webster* v. *Uther*.

78*. An action was raised by the pursuer in the Court of Session in Scotland, to have it found that the defendants had infringed his patent for a slip, and that they should be liable in damages. The defenders appeared, and denied that they had committed any infringement, their machine being different to that of the pursuer. No question was remitted to the Jury Court, and the defenders having failed to appear, held that the infringement was admitted; and the pursuer would be entitled to nominal damages on putting in the letters patent, and giving some evidence of the novelty and utility of the invention. *Morton* v. *Barclay & others*.

This case came on in the Jury Court, Edinburgh, 15 March, 1824, before the Lord Chief Commissioner, Lord Gillies, and Lord Pitwilly, and was the first since the Union—*Mr. Jeffrey*, the pursuer's advocate, submitting, that since the Union the same practice in regard to patents had been followed in Scotland as in England; and that consequently the law appeared to be as well understood as if provided for by statute. The court seems to have adopted this view.

79. If by a private act of parliament, a privilege of the sole making of a newly invented machine is vested in certain persons, with a proviso that it shall be forfeited in case it shall become vested in, or in trust for, more than five persons, or their representatives, otherwise than by devise or succession (reckoning executors and administrators only as the single persons they represent)—held, that if one of the persons becomes bankrupt, the right passes to his assignees; and that though there are more than five creditors, yet the assignees do not hold it in trust for more than five persons, otherwise than by devise, or succession, within the meaning of the act.

It being objected that a specification, enrolled pursuant to a patent for an invention, contained French terms—held, that an inventor is not tied down to make such a specification, as by words only would enable a skilful mechanic to make the machine; but he is allowed to call in aid the drawings that he may annex to the specification; and if, by a comparison of the words and drawings, the one will explain the other, sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient.

A witness cannot be asked what the opposite party has said as to the contents of deeds executed by him; unless such party has had notice to produce such deeds.

If a servant, while in the employ of his master, makes an invention, that invention belongs to the servant, and not to the master; but *semble*, that if the master employs a skilful person for the express purpose of inventing, that the inventions made by him will so much belong to the master as to enable him to take out a patent for them.

Quære. If a patent be taken out by a British subject on a secret trust, to hold it for the benefit of the real inventor, the patent stating that the patentee has obtained the invention from a certain foreigner; whether if such inventor, for whom it is held, be an alien enemy at the time, that will annul the patent, without its being necessary to sue out a *scire facias* for its repeal. Per *Abbot*, C. J., *Bloxam* v. *Elsee*.

80. The application of steam to heat iron rollers is an infringement of a patent in which hot irons were inserted into hollow rollers, the final process in both being the same, viz., the applying heat to the fibres of wool during the operation of spinning it, by making the slivers pass betwixt the rollers so heated. *R.* v. *Lister*.

These proceedings were at the suit of Hadden to repeal Lister's patent of 1823, for improvements in the method and machinery for preparing and spinning wool, silk, and other animal fibres. See next case.

81. On a *scire facias* to repeal a patent for a machine, on the ground that it is not new, a drawing made by another person may be put into the hand of a witness who had constructed a machine for the same purposes; and he may be asked whether he has such a recollection of the machine he made, as to be able to say that that is a correct drawing of it. *R.* v. *Hadden*.

These proceedings were at the suit of Lister, and the cause was tried the same day as the preceding cause, and the patent repealed for want of novelty of invention.

82. The venue cannot be changed in an action for the infringement of a patent. *Brunton* v. *White*.

83. By an act of parliament for enlarging the term granted to a patentee for the enjoyment of his patent, it was enacted, that in case the power, privilege, or authority granted by the letters patent, should at any time become vested in or in trust for more than the number of five persons or their representatives at any one time, otherwise than by devise or succession (reckoning executors and administrators as and for the single persons they represented as to such interest as they are or shall be entitled to, in right of such their testators or testator); then, and in every of the said cases, all liberties, privileges, and advantages

vested in the patentees, their executors, administrators and assigns, should cease, determine, and become void. The patentees having become bankrupt, and creditors exceeding five in number having proved under the commission, it was held that this clause applied only to an assignment by act of the party, and not to an assignment by operation of law, and consequently that the interest of the assignees of the bankrupt had not ceased.

The patent was for a machine for making paper in single sheets, without seam or joining, from one to twelve feet wide, and from one to forty-five feet and upwards in length: held, that this imported that paper varying in width between those extremes should be made by the same machine, and that the patentee at the time of taking out the patent not having any machine capable of producing paper of different widths, the patent was void. *Bloxam* v. *Elsee.*

84. If an instrument alleged by plaintiff's witness to be an infringement, in the opinion of the judge is not the same as that described in the specification, but substantially the same as has been long in use, the plaintiff will be nonsuited. Per Lord *Wynford*, C. J., *Barton* v. *Hall.*

85. The immersing cloth, made and dressed in the usual way, in a close and compact roll, in a steam bath, for a sufficient length of time for the fibres to become softened, whereby they acquire a tendency to retain the same direction, and the effect of dressing is rendered permanent, is an infringement on a patent for immersing cloth in the same manner and for the same purpose in hot water. Per Lord *Tenterden*, C. J., *R.* v. *Fussell.*

86. The proceedings in the preceding case were at the suit of Daniell, and his patent was repealed on the same day, by *scire facias*, at the suit of Fussell, for want of novelty. *R.* v. *Daniell.*

87. The specification of a patent contained these words: "Which cloth may be made of any suitable material; but I prefer it to be made of linen warp and woollen weft," the patentee knowing from experiment that no other material but this would answer.

Held bad, as not being sufficiently accurate, and misleading the public, by inducing them to make experiments which the patentee knew must fail. *Crompton* v. *Ibbotson.*

88. Leave will be given on petition to amend a clerical error in a specification to a patent. In re *Redmund.*

89. To an action of debt on bond, conditioned for paying plaintiff £10,000 upon his forming a company, and procuring purchasers for 9000 shares thereu; which company was to carry on a distillery according to a process for which a patent had been granted: the defendant pleaded that the patent contained a proviso, rendering it void if transferred to more than five; that it was intended at the time of making the bond that the company should consist of more than five, and be formed for the purpose of enjoying the benefit of the letters patent, and of acting as a corporate body, and of dividing the benefit of the patent into 10,000 shares, transferable and assignable, without any charter, from the King; and that it was corruptly and illegally agreed between the parties, that the plaintiff should form the company for such purposes, and should sell the 9000 shares, in order to raise a larger sum of money, under the pretence of carrying on the privilege granted by the patent. Held a bar to the action. *Duvergier* v. *Fellowes.* See *post* (96) and (98).

90. An invention for giving paper, by the application of a certain composition, such a surface as renders the lines of copper and other plate printing more clear and distinct, may properly be described in a patent as an improvement in copper and other plate printing.

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

On an application for injunction to restrain the infringement of a patent, the party must swear that at the time of making the application he believes that at the date of the patent the invention was new, or had not been previously known or used in this kingdom. Per Lord *Lyndhurst*, L.C., *Sturtz* v. *de la Rue.*

91. If the shearing of cloth from list to list by shears be known, and the shearing it from end to end by means of rotary cutters be also known, and a person construct a machine to shear from list to list by means of rotary cutters, this is a new invention, and will entitle the inventor to maintain a patent for it.

If A., in 1818, take out a patent for improvements in a machine, for which J. L. took a patent in 1815, it is necessary for A., on the trial of an action for infringement of his patent, to put in J. L.'s patent and specification; but it is not material whether a machine made according to the specification of J. L. would be useful or not, if it be shown a machine constructed according to A.'s specification would be so. Per Lord *Tenterden*, C. J., *Lewis & another* v. *Davis.*

92. If a specification state certain improvements in the mechanical part of the apparatus, which appear to have been invented after the sealing of the letters patent: this will not invalidate the patent, as the public ought to have the advantage of all improvements down to the time of the specification.

A specification of an invention for which a patent had been granted, stated the invention to be an improved apparatus to extract gas from pit coal, tar, or any other substance from which gas, capable of being used for illuminations, could be extracted by heat. Held, that the words "other substance," must mean substance *ejusdem generis*, and that oil was not meant to be included in it, it being shown that at the time in question oil was considered much too expensive to be used for the making of gas for the lighting of streets and buildings, though it was known to afford an inflammable gas.

If in the specification of an improved gas apparatus, no direction is given respecting a condenser, which is a necessary part of every gas apparatus; this will not invalidate the patent, if it appear that every one capable of constructing a gas apparatus must know that a condenser must form a part of it. *Crossley* v. *Beverley.*

93. Letters patent were granted for a machine

to sharpen knives and scissors; and in the specification this was directed to be done by passing their edges backwards and forwards, in an angle formed by the intersections of two circular files; and in the specification it was also stated that other materials might be used according to the delicacy of the edge. It was proved that for scissors there ought to be one circular file and a smooth surface; but that two Turkey stones might also succeed.

Held that the specification was bad, as it neither directed the machines for scissors to be made with Turkey stones, nor to be made with one circular file and a smooth surface. Per Lord *Tenterden*, C. J., *Felton* v. *Greaves*.

94. The specification of a patent for an improved machine, claimed as an invention a part which turned out to be useless. Held, that this did not vitiate the patent; the specification not describing it as essential to the machine. It appearing in evidence that the patentee himself *invented and brought into use the machine for* which the patent was granted; but before that time, several other persons had seen a model and specification of such a machine, which were brought over from America.

Held, that the patentee was nevertheless to be considered the inventor, within the meaning of the statute, 21 Jac. 1, c. 3, s. 6, no machine having been manufactured and brought into use from the model and specification, and there being no evidence that the patentee had ever seen them. *Lewis & others* v. *Marling*.

95. A plaintiff who complains of a piracy of his work has no remedy in equity, unless he establish a title to an injunction, and then the account will follow.

The court will not grant an injunction, but leave the plaintiff to seek his remedy at law, where the matter, which is the subject of the alleged piracy, forms but a very inconsiderable part of the plaintiff's work, and contains merely calculations, and when the work complained of has been published some years. *Baily* v. *Taylor*.

96. Where a bond was given for the payment of £11,000, with a condition that the money should be paid on the obligee's procuring subscriptions for 9000 shares in a company, to be formed of many persons, for the purpose of becoming assignees of a patent, and carrying on the patent process; and the patent contained a proviso that it should be void if assigned to more than five persons.

Held, that the obligee must be presumed to know of that proviso; and that as the bond was subject to a condition for the performance of an illegal act, it was void. *Duvergier* v. *Fellowes*. In error from the C. P., *ante* (89), *post* (98).

97. Letters patent were for "improvements in *evaporating* sugar," &c. The specification was as follows: "My invention consists in a method, or apparatus, as hereinafter described, by which I am enabled to evaporate liquids and solutions at a low temperature, &c.; and my said invention and improvement consists in forcing, by means of bellows, or any other blowing apparatus, atmospheric or any other air, either in a hot or cold state, through the liquid or solution subjected to evaporation; and this I do by means of pipes, whose extremities reach nearly (or within such distance as may be found most suitable under peculiar *circumstances*) to the upper or interior area of the bottom of the pan or boiler containing such liquid or solution; the other extremities of such pipes being connected with larger pipes, which communicate with the bellows or other blowing apparatus, which forces the air into them." The lesser pipes were to be equally distributed, and their lower ends on a level with each other. It was further declared, that the form of the apparatus might be varied, provided the essential properties were maintained.

Held that, taking the whole of the specification together, it appeared that the invention consisted of the particular method or process of forcing, by means of bellows, &c., air through the liquid, subjected to evaporation, viz., by pipes connected with larger pipes, and placed as mentioned in the specification; and, therefore, that it was not void because another patent had been before granted to other persons for effecting the same object, by a coil of pipes, lying at the bottom of a vessel, perforated with small holes, or by a shallow cullender placed at the bottom of the vessel. *Hullett* v. *Hague*.

98. In the condition of a bond, executed by D. for £10,000, an agreement was recited to the following effect: That S., one of the obligors, had obtained letters patent for the distillation of potatoes; and that S., together with B. and F., the two other obligors, were engaged in partnership in a distillery, according to the system for which the patents were procured; and that they were desirous of selling and transferring their interest in the concern to a company; and that they had agreed with D., who was a man of large acquaintance and influence, that he should procure persons to take 9000 shares, of £50 each, into which the concern was to be divided, and to form a joint stock company, under the title of the Patent Distillery Company; and to induce D. to exert his influence with such persons, and to indemnify him for his expenses, S., B., and F. had agreed to pay D. the sum of £10,000, by three instalments, at the times when the calls upon the shares should be paid.

An action of debt being brought by D. upon this bond, F., who was defendant in the action, pleaded that the letters patent were granted to S. upon the express condition that if S., his executors, administrators, or assigns, or any person who should have any right, title, or interest, &c., in the invention, should make any transfer or assignment of the liberty and privilege, or any share of the benefit or profit thereof, or should declare any trust thereof, to or for any number of persons exceeding five, or should open any books for public subscription, &c., or should act as a corporate body, or should divide the benefit of the letters patent, &c., into any number of shares exceeding five, or should do any act, &c., contrary to the intent, &c. of the statute, 6 Geo. 1, in case the power, privilege, &c., should at any time become vested in or in trust for more than five persons or their representatives, &c., that the letters, &c., should be void. And then it was averred in the plea, that the company mentioned in the condition of the bond was intended by the parties thereto, at the time of executing the bond, to consist of more than five persons, to wit, 10,000 persons, and to be formed for the purpose of using the privileges, &c., in the letters patent mentioned for the use of such persons, exceeding five in their number, &c., and that therefore the letters patent were void.

To these pleas there was a general demurrer.

Upon an argument of these demurrers in Court of Common Pleas judgment was given for the defendant, and this judgment upon error in the Court of King's Bench was affirmed, upon the ground of the statement in the plea, that it was intended by the parties to the bond that the company was to consist of more than five persons to receive the benefit of the letters patent, which being a violation of the condition upon which they were granted, no action could be maintained upon such a bond, whether the party knew or did not know the terms of the letters patent.

Semble. If two courts have been of the same opinion on any point, and their judgments are appealed from and affirmed, the House of Lords will give costs on the affirmance. *Duvergier* v. *Fellowes.*

99. Letters patent were "for improvements in making buttons." The specification stated the improvements to consist in the substitution of a flexible material for metal shanks, and it described the mode in which this material might be fixed to the intended button, and made to project from it in the necessary condition for use, by the help, among other things, of a metal callet or ring with teeth. Neither the construction of the button, nor the application of a flexible shank, was new —the use of the toothed ring, as described in the specification, was so—but this was not stated to be the subject-matter of the invention; and it appeared by the specification, that the effect produced by it might be brought about in other modes, which the plaintiff had also used.

Held, that the patent was not maintainable, since the invention consisted only in combining two things that were not new; and the use of the toothed ring in forming the flexible shank, though new, was not claimed as the object of the invention, but only a mode, among others already known, of carrying it into effect. *Sanders* v. *Aston.*

100. The claim to a new principle cannot be supported, but a claim for the invention of a method of making wheels on a principle, which method is described in the specification, is good. The question is, was there really an invention by S. in use and known to others? If the jury should think his an abortive attempt or failure, or mere experiment which did not answer, this would not invalidate the plaintiff's patent.

Evidence of making only is sufficient to support an action of infringement. Per *Patteson, J.*, *Jones* v. *Pearce.*

101. On affidavit that an invention for which letters patent are about to be sealed, is in fact the invention of the deponent, and has been obtained by a breach of confidence, the Lord Chancellor will hear opposition or caveat at great seal. The parties have, under the circumstances, a right to be heard, but the right must be exercised sparingly and with great discretion.

The opposing party, if unsuccessful, will be ordered to pay all costs. Per Lord *Brougham*, L. C., *Henson* v. *Alcock.*

The Chancellor sent the parties in the preceding case back to the Attorney-General "to see whether the inventions are the same, as an inquiry in aid of the conscience of the court, to see whether the sealing should go."

102. If the specification be not sufficiently clear to be understood by an ordinary workman (a witness for the plaintiffs) witnesses will not be allowed to be called to explain the intention of the patentees, and plaintiffs will be nonsuited. Per Lord *Lyndhurst*, C. B., *Brooks & Hargrave* v. *Ripley & Ogle.*

103. A manufacturer using the mark of another, for the purpose of giving to articles manufactured by the former the appearance of being the manufacture of the latter, an action may be maintained by the latter against the former, although the articles are not inferior in quality, and although it is not shown that actual damage has been sustained. *Blofield* v. *Payne.*

104. A manufacturer will be restrained from using certain letters and figures which a patentee was in the habit of using. *Ransome* v. *Burtall.*

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

106. The claim in a specification was as follows: "My invention is the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counterbalance to the pressure against the back of such chair, as before described."

Held, that this was not a claim to the principle of the lever; but to an application of that principle to a certain purpose by certain means, and that the patent was good. *Minter* v. *Wells.*

107. Where a license to use certain patent machines is granted by indenture, in which it is recited that the grantor has invented the machines, and has obtained letters patent for the sole use of the invention, and enrolled the specification, parties (and privies) to the deed are estopped from pleading, either that the invention is not a new invention, or that the grantor was not the first inventor, or that no specification was enrolled.

Declaration in covenant stated, that by indenture, after reciting that plaintiff had invented certain improvements in the construction of looms, and had obtained letters patent for such invention; and that he had agreed with defendants to let them use the said invention for a certain part of the term granted by the letters patent, in consideration of certain covenants, &c., plaintiff covenanted to permit defendants to use and have the benefit of such invention and patent; and defendants in consideration of the grant, &c. covenanted to perform the agreement on their part. Breach non-performance. Pleas, after setting out the patent, that the supposed invention therein, and in the declaration mentioned, was not nor is a new invention, and that plaintiff was not the first or true inventor of the improvements in the said indenture and letters patent mentioned.

Held on general demurrer, that if the pleas amounted to a denial of the plaintiff having invented the improvements in the sense in which the deed alleged him to have done so, the defendants were estopped by their recital in the deed from contradicting that fact. And that, if the

pleas did not amount to such denial, but were intended merely to allege that the plaintiff was not the sole inventor, or that the invention had taken place long before the patent was granted, such pleas were no answer to the action.

There may be an estoppel by matter of recital.

Quære. Whether in covenant by the patentee of an invention, brought to recover rent reserved in respect of a license to use the invention, a plea merely alleging that the invention was not new, or that the plaintiff was not the first inventor, without showing that the defendant had in consequence failed to have the exclusive enjoyment covenanted for, is a good plea, by analogy, to a plea of eviction. *Bowman* v. *Taylor.*

108. A court of equity will not grant a motion to restrain a defendant from proceeding in an action at law, or to admit evidence of the invalidity of a patent obtained by the defendant.

A patent right was sold by the defendant to the plaintiff for a sum paid immediately, and certain annual rents. The deed contained a covenant, that should the plaintiff furnish evidence of an infringement, the defendant would bring an action, or cause an injunction to be obtained, to protect the patent. Afterwards the validity of the patent was disputed by some third parties, and a parol agreement was entered into, by which the plaintiff agreed to pay the defendant a certain definite sum, and the defendant agreed to abandon all further claims upon the plaintiff. About eight years afterwards, the defendant brought an action against the plaintiff to recover the moneys under the original contract. The plaintiff pleaded that there was no valid patent, which was decided on demurrer to be no good defence, the plaintiff being estopped by his deed. Under these circumstances, the plaintiff filed a bill in equity to restrain future proceedings at law, or to prevent the deed being set up. Held, that the agreement was not of such a nature as to entitle the plaintiff to the interposition of the court; the bill did not seek the performance of the agreement, which was merely voluntary, and was not to be considered as an abandonment of the rights of the defendant. *Collinge* v. *Bowman.*

The case of *Bowman* v. *Collinge* is not reported, but the points were the same as in *Bowman* v. *Taylor*, 106; and see *post* (110).

108*. If the specification be silent as to part of an invention stated in the title, or as to any part of the invention which is essential, the plaintiff will be nonsuited. Per Lord *Denman*, C. J., *Jones* v. *Ripley.*

109. Delay in applying to the court is no valid objection against the party's right, if it can be explained. An injunction will be granted after the expiration of the term of letters patent, if the delay can be explained.

A decree, directing an account of what profit had been received, and what benefit derived, from the use of machines made and manufactured during the existence of letters patent, must be worked out, however great the practical difficulties, and the principle appearing correct, an appeal against the order will be dismissed with costs. *Crossley* v. *Derby Gas Company.*

In this case the bill prayed that the defendants might be restrained from manufacturing gas meters according to the plaintiff's patent; and an account to have the profits, which would have accrued to the patentee under his patent, had he made the meters which the defendants had manufactured.

110. The declaration stated the execution of a deed by plaintiff and defendant. The plea did not traverse the execution, but alleged new matter, upon which the replication took issue. The deed was put in at the trial, and its recital directly contradicted the new matter alleged in the plea. Held, nevertheless, that the defendant was not precluded from submitting such matter of defence to the jury, inasmuch as the plaintiff had not pleaded the recital of the deed by way of estoppel. And the judge at *nisi prius* having treated such deed as conclusive, and directed a verdict for the plaintiff, the court granted a new trial, without entering into the question whether the plea was or was not bad.

Evidence may be given in support of a plea upon which issue is taken, though such plea be bad, as being repugnant to the admission of parties on the record. *Bowman* v. *Rostron.*

110*. In an action for the infringement of a patent, a purchaser of a license to use the patent is a competent witness for the plaintiff. Per Lord *Abinger*, C. B., *Derosne* v. *Fairie.*

111. In the recital of a patent, it was stated that the patentee was the true and first inventor of certain improvements in extracting sugar and syrups from cane juice, and other substances containing sugar, and in refining sugar and syrups. The specification alleged that the invention consisted in a means of discolouring syrups of every description by charcoal, produced by the distillation of bituminous schistus alone, or mixed with animal charcoal, or even of animal charcoal alone.

It then alleged, that the discoloration was to be effected by means of a filter made of charcoal, and that there was nothing particular in the carbonization of the bituminous schistus; only that it was convenient, before the carbonization, to separate the sulphurets of iron which are mixed with it.

To an action for infringing this patent, the defendant pleaded that the patentee did not by any instrument particularly describe and ascertain the nature of his invention, and in what manner the same was to be and might be performed.

Held, that the specification sufficiently described the invention stated in the title of the patent, it being shown that it was applicable with advantage to the extracting of syrup from cane juice, before it is baked to such a consistency as to granulate and become sugar.

It was proved that the sulphuret of iron was combined with the bituminous schistus found in this country; and there was no evidence to show that the presence of iron in the charcoal produced by the schistus was not injurious to the matter going through the process of discoloration.

Held, that it was incumbent on the patentee to prove that the presence of iron in the bituminous schistus used in the process of filtering would not be injurious, or else that the method of extracting the iron from it was so simple and well known, that a person ordinarily acquainted with the subject could remove it with ease; or that the bituminous schistus, as known in England, could be used in the process with advantage.

Semble. An objection that the specification is not so large as the title, or does not describe the double process, which would be expected there-

from, is not let in by a plea of the insufficiency of the specification.

Semble. That the use of words in a purely technical sense, or in a new sense, if explained by the context, will not vitiate a specification. *Derosne* v. *Fairie.*

112. In a declaration for infringing a patent, which granted that the plaintiff, and no other, should "make, use, exercise, and vend" his invention, and forbade all persons "to make, use, or put in practice" the same, or to counterfeit or imitate it, without the plaintiff's license; the plaintiff alleged, that the defendant without his license exposed to sale articles intended to imitate, and which did imitate, his invention.

Held on general demurrer, that the count was bad, as not stating any thing which was necessarily an infringement of the patent. *Minter* v. *Williams.*

113. Whether a particular thing is an improvement or colourable alteration, is a question peculiarly for a jury; and, under such circumstances, an injunction will not be continued, since, if the jury should find that there had been no infringement, no compensation would be obtained by the defendants for the improper continuance of the injunction. But should the jury find for the plaintiff, complete justice will be done by taking an account. The injunction must, therefore, be dissolved, with liberty to the plaintiff to bring an action, the defendant undertaking to submit to the order of the court respecting the profits of the present or any future contract, reserving the consideration of costs. The plaintiff with scientific witnesses to be at liberty, as may be arranged, or as may be prescribed by the court, to inspect the defendant's works. Per Sir L. *Shadwell*, V. C., *Morgan & another* v. *Seaward & others.*

113*. The question as to infringement is whether the defendant's machine differs colourably, and in those things only which are mechanical equivalents, the one for the other. If it is the same in substance, it is an infringement; but if not the same in substance, it is not an infringement, though it may have a resemblance in its parts.

The specification is good if it gives a method of making the machine at any angle which may be required, so that an ordinary workman with competent skill and with the ordinary means of knowledge which artisans possess, might make the machine from that alone, without finding out a method of doing that which has not been specifically described in the specification. Per *Alderson*, B., *Morgan* v. *Seaward.*

114. A patent claimed the invention of manufacturing tubes by drawing them through rollers, using a mandril in the operation. A later patent claimed the invention of manufacturing tubes by drawing them through fixed dies or holes, but the specification was silent as to the use of the mandril.

Held, that the court, taking the whole of the specification together, would infer that the mandril was not to be used, and that the later patent was good.

The court will read the specification so as to support the patent if possible. *Russell* v. *Cowley.*

115. *Statute* 5 & 6 W. 4, c. 62.

A declaration to be substituted for oaths and affidavits heretofore required on taking out a patent. *Ibid.*

116. *Statute* 5 & 6 W. 4, c. 83.

A disclaimer or memorandum of alteration of part of the title or specification of a patent may be filed. The Crown on the recommendation of the Judicial Committee of the Privy Council may confirm, or grant an extension of, letters patent. The patentee on obtaining a second verdict shall be entitled to treble costs. Notice of objections to be delivered by defendant with his plea, and by plaintiff in *scire facias*, and costs to have reference to that part of case which is proved. A party using the name of a patentee unauthorised, liable to a penalty of £50. *Ibid.*

117. On application to Privy Council the petitioner must prove his compliance with the usual practice as to the specification, advertisements, &c.

The Privy Council will require a strong case of hardship and of the utility of the invention to be made out. In re *Erard's* patent.

118. The court will not, for the purpose of determining the validity of a plaintiff's title as the patentee of an invention, make an order upon demurrer, directing the bill to be retained with liberty to the plaintiff to bring an action.

Where the bill alleges that the plaintiff is the patentee of an invention, stating its nature generally, but referring for greater certainty to a specification in which it is set forth and described at large, and alleges also that the plaintiff has been for ten years in the exclusive enjoyment of such patent, and has established his legal title by repeated actions; a general demurrer on the ground of the invalidity of the patent, as stated in the bill, will be overruled. Per Lord *Cottenham*, L.C., *Kay* v. *Marshall.* See *post* (155).

119. A claim that the invention of an improved expanding table consists in constructing the same so that the sections of which the original or unexpanded table is composed may diverge from a common centre, and the table be enlarged or expanded by inserting leaves or pieces in the openings or spaces caused by such divergence, is a claim to a new manufacture, without reference to the mechanical means by which the divergence is effected. A plea that the patentee did not describe his invention, will not raise the issues whether the patent is good, as so specified, or whether the patent is for a principle or not. *Jupe* v. *Pratt.*

"You cannot take out a patent for a principle, but you may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle, but invented some mode of carrying it into effect; but then you must start with having invented some mode of carrying the principle into effect; if you have done that, then you are entitled to protect yourself from all other modes of carrying the same principle into effect, that being treated by the jury as a piracy." Per *Alderson*, B. *Ibid.*

120. On application to confirm a patent, part of which was old, a former patent having been taken out for a similar thing—

Held, that the subsequent patentee had no right to a confirmation adversely to the rights of the former patentee; that the subject was matter of disclaimer for the Attorney-General to deal with, and not for this court; and that the petition must be dismissed with costs. In re *Westrupp & Gibbins'* patent.

121. A claim for the application of India rubber in a state of solution as a cement between two fabrics to make a waterproof covering is good, notwithstanding the application of other substances, and of India rubber in other states, to the same purpose. Per *Tindal*, C. J. *Macintosh* v. *Everington*.

122. In an action for the infringement of a patent, the plaintiff will not be compelled to produce a specimen of the patent articles, to enable the defendant to prepare his defence to the action. The specification gives the requisite information. *Crofts* v. *Peach*.

123. Letters patent for the exclusive use of an improvement in the invention of anchors, contained a proviso for avoiding the patent, if the patentee should not supply for his Majesty's service all such articles of the invention as should be required on such reasonable terms as should be settled by the Lords of the Admiralty.

The latter used the invention, but did not take the article of the patentee.

The court refused to issue a mandamus to them to settle the terms according to the proviso of the letters patent. *Perring* ex parte.

124. Agreement for the purchase of part of the profits of a patent which turned out to be a mere bubble, set aside as having been obtained by fraud and misrepresentation, and so much of the purchase money as had been paid under the agreement ordered to be repaid.

Semble, that the joint owners of a patent are answerable for losses occasioned by their coadventurers only to the extent of their respective shares. Per *Alderson*, B., *Lovell* v. *Hicks* & *others*.

But see *post* 132, that joint owners are liable in *solido*.

125. A bill having been filed by an assignee of certain alleged patent inventions for an injunction to restrain the infringement of the patents, and for an account of the profits made by their use; the defendants by their answer insisted that the patents were originally invalid; and also that, if originally good, they had been made void by subsequent acts of the patentee. By the decree made at the hearing of the cause the bill was retained for three years, with liberty for the plaintiff to bring an action; and the defendants were directed to admit that plaintiff was the assignee of the patents, and that they (the defendants) had used the alleged inventions; and the plaintiff was ordered to produce certain deeds at the trial and to admit their execution. The defendants then filed a bill of discovery against the plaintiffs; but the discovery sought by that bill had reference only to the acts by which it was alleged that the patents had become void subsequently to their creation. The defendants afterwards finding the necessity of a discovery as to the original invalidity of the patents, applied to the court for permission to file another bill of discovery which should relate to such original invalidity, and the court granted the permission desired. *Quære*. Whether it was regular to file the first bill of discovery without leave of the court. *Few* v. *Guppy*.

126. The inventor of an improvement in the wheels of steam-engines, before he took out a patent, procured an engineer to make two pair of wheels at his factory, with an injunction as to secresy. The wheels were completed at the engineer's factory with the privity of the plaintiff, but not shown to those who might happen to come there; and after remaining a short time were taken to pieces, packed up in cases, and sent abroad for the use of a company of which the plaintiff was a director. The inventor afterwards took out a patent and assigned it to the plaintiff. Held, that there had been no use or publication of the invention, and that it was new at the time the patent was taken out.

Semble. That if an inventor before he takes out a patent constructs an article for public sale, though only fit for a foreign market, or to be used abroad, such a sale would be a use of the invention, so as to defeat a patent afterwards taken out.

In an action for infringing a patent, the declaration stated the plaintiff to be the inventor of "certain improvements in steam-engines, and in machinery for propelling vessels," which improvements were applicable to other purposes; the defendant pleaded that the invention was not an improvement in steam-engines. This issue was found for the defendant. Held, on motion for judgment, that the plea was good after verdict.

If a patent suggest that certain inventions are improvements, and one of them be not so, the patent is void unless amended under the 5 and 6 W. 4, c. 83.

Where the subject of a patent taken altogether is useful, the patent is valid, though part or parts of the machine be useless.

Semble. In order to take advantage of the defence of the want of utility in the subject of a patent, the defendant should plead the words of the statute of James I. and not that the invention was of no use. *Morgan* v. *Seward*.

127. An injunction will be dissolved as far as it applies to any thing which is not protected under a patent apparently valid, and a mutual inspection of machinery will be ordered.

A party will be restrained from selling an article in such a state that it may be applied by others so as to infringe a patent, though they may not be restrained from applying it themselves to a different purpose. Per Sir L. *Shadwell*, V. C., *Abbott* v. *Williams* & *others*.

128. It is not enough in opposition to a motion for an injunction for the defendant to confess infringement, but promise not to repeat it; the court will interfere to protect patent rights notwithstanding any such promise. Per Sir L. *Shadwell*, V. C., *Losh* v. *Hague*.

129. The patentee is bound to give in his specification the most improved state of his invention up to the time of enrolling his specification. Per *Tindal*, C. J., *Jones* v. *Heaton*.

130. It will be for the jury to say whether the invention was or was not in public use and operation at the time the patent was granted. There are certain limits to this question. A man may make experiments in his own closet if he never communicates these experiments to the world, and lays them by; and another person has made the same experiments, and being satisfied takes a patent: it would be no answer to say that another person had made the same experiments: there may be several rivals starting at the same time; the first who comes and takes a patent, it not being generally known to the public, that man has a right to clothe himself with the authority of the patent, and enjoys the benefit of it. If the evidence when properly considered classes itself under the de-

scription of experiment only, that would be no answer. On the other hand, the use of an article might be so general as to be almost universal; then you can hardly suppose any body would take a patent. Between these two limits most cases will range themselves, and it must be for the jury to say whether the evidence convinces their understanding that the subject of the patent was in public use and operation at the time when the patent was granted. Per *Tindal*, C.J., *Cornish* v. *Keene*.

131. In a patent for the improvements of the manufacture of elastic goods, one of the subjects proposed by the patentee in his specification was to produce cloth from cotton or other materials, in which should be interwoven elastic cords or strands of Indian rubber wound with filamentous materials; after describing the manner of effecting this object, it was stated that by this process a cloth was produced which should afford any degree of elastic pressure according to the proportion of the elastic and non-elastic material. It appeared that the use of elastic strands of Indian rubber covered with a filamentous material was known before, and also the use of cotton materials, but the placing them together side by side as a warp was new. It was proved that the new manufacture formed a cloth which combined the two qualities of great elasticity and a limit thereto, and that it was a cheaper, lighter, and more durable article than any which had before been produced.

In an action for infringing this patent, the jury found a verdict for the plaintiff; and a rule for nonsuit, on the ground that to apply a known material and in a known manner to effect a known object (the production of an elastic cloth) was not a good subject-matter, the court held that the above came within the meaning of the words "any manner of new manufactures" of the statute.

On the ground of the verdict being against evidence, held, that the question whether the various instances brought forward amounted to proof that before or at the time of taking out the patent the manufacture was in public use in England, or whether it fell short of that point, and proved only that experiments had been made in various quarters and had been afterwards abandoned, being a question from its nature of considerable delicacy, and in which a slight alteration in the effect of the evidence will establish either the one proposition or the other, the only proper way of deciding it is by leaving it to the jury. And if a jury hear the evidence patiently, and appear to apply it with intelligence, the verdict will not be disturbed.

Held also, that a suggestion in a specification of another patent after the plaintiff's patent was sealed and his invention known in the market, but before plaintiff's specification was enrolled, does not of itself alone afford any proof whatever of the want of novelty in the manufacture under the plaintiff's patent. *Cornish* v. *Keene*.

132. The general rule is, that no other evidence can be given at a rehearing than might have been given at a hearing. Therefore where a document is not included in the order of course to prove exhibits *viva voce* at the hearing, or when the plaintiff has obtained no such order, he cannot obtain an order to prove an exhibit *viva voce* at a rehearing, without a special application.

The joint owners of a patent for a particular process used in carrying on a trade are answerable *in solido* for the losses occasioned in relation to the patent by the frauds of their co-adventurers. Per *Alderson*, B., *Lovell* v. *Hicks*.

133. The specification of a patent improved chair stated the invention to consist "in the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counterbalance to the pressure on the back." Before this patent was taken out a chair had been made and sold by B., upon the same mechanical principle, although the operation of it was encumbered by some additional machinery. Held, that the patent could not be sustained, inasmuch as the specification claimed more than the patentee had invented, and would have precluded B. from making his own chair.

Semble. That had the specification been for an improvement only in the application of the principle, it would have been good. *Minter* v. *Mower*.

134. *The 5 & 6 W. 4, c. 83, s. 1, is not* retrospective in its operation, so as to enable a party entering a disclaimer under that act for such parts of his invention as are not new, to have a right of action against persons who have infringed the patent before such disclaimer; and this, even where the infringement has been in respect of portions of the patent not included in the disclaimer. *Perry* v. *Skinner*.

135. In an action for the infringement of a patent, the court will not compel a defendant to give the names and addresses of persons whom, in a notice of objections under 5 & 6 W. 4, c. 83, s. 5, he alleges to have used the invention before the patent was granted; but where a judge had made two orders, requiring the name and address of a person who had used the invention, and the defendant complied with the orders, the court refused to rescind them.

The court may order a further and better notice of objections under their general jurisdiction, as well as under the statute. *Bulnois* v. *Mackenzie*.

136. An *ex parte* injunction having been obtained, and suffered to go undisturbed for two years, and the specification appearing free from obscurity and the evidence of novelty sufficient, held that the court could not be doing wrong in upholding the injunction. Per Sir *L. Shadwell*, V. C., *Luckey* v. *Robson*.

137. The notice of objections delivered by the defendant in an action for infringing a patent right, must be precise, distinct, and definite. It is not sufficient to say that the improvements, or some of them, have been used before; the defendant should point out which. *Fisher* v. *Dewick*.

138. The declaration stated, that by a memorandum of agreement between the plaintiff of the one part, and the defendants of the other part (after reciting that by a certain other agreement between the plaintiff and the defendants, the plaintiff did agree with the defendants for the sale of W.'s patent furnace; and that plaintiff and one C. had obtained a patent for an improvement in generating steam; and the plaintiff and one J. had obtained a patent for a metallic wheel and revolving axle; and that the plaintiff was solely interested in a patent for a new mode of abstracting heat from steam vapour; and the plaintiff and one G. had obtained a patent for an improved furnace); it was agreed between the parties, that it should be lawful for the defendants exclusively

to use, manufacture, sell, and dispose of any or all of the aforesaid patent inventions, upon this among other considerations, that the defendants should pay to the plaintiff £400 a-year during the existence of the said agreement. *Breach*, non-payment. *Pleas* as to the patent for the said supposed improvement in furnaces, that it was not a new invention, and that the supposed improvement in furnaces was not invented or found out by the plaintiff.

Held, on a special demurrer, that as it did not appear by the declaration that the defendants ever enjoyed any part of the patents, which was the consideration for their agreeing to pay £400 a-year, or that that sum could in any way be apportioned among the different patents, that the plea impeaching the consideration was good to avoid the whole contract.

The memorandum of agreement was stated to be made between J. C., J. M., F. J. I., and S. G. Held, that there was a variance between the declaration and contract, in not setting out all the contracting parties.

Semble. That the contract being with all the parties, founded upon a consideration to part, of which each was a conducing party, the action ought to have been by all. *Chanter* v. *Lease & ors.*

139. The statute 5 & 6 W. 4, c. 83, s. 5, does not give a party the general costs of the cause, where he would not be entitled to them independently of that statute.

The certificate given by a judge on the trial should be as to the objections, of which notice had been given, and not as to the issues. And the costs of the objections will be regulated according to the result of them on the trial.

The legislature intended, by means of the objections, and the certificate of the judge at Nisi Prius, to raise in effect so many distinct issues, the costs of each of which were to follow their respective results; but it was not meant to interfere with the practice of taxation in other respects. *Losh* v. *Hague.*

140. It is not necessary for the plaintiff, by his bill, to set forth a full statement of the specification, enrolled in respect of letters patent granted to him. If the plaintiff refers to the specification, and alleges by the bill that he has done all that was required of him, the court, on demurrer, will give credit to the allegation. Where the bill states a contract to purchase a patent by one defendant from the plaintiff, and that that defendant claims to be interested in the patent, a demurrer by a co-defendant, who is alleged to have infringed the patent, for misjoinder of defendant, is bad.

If a party have a defence beyond the record, he may plead it; or he may put in a short answer, admitting the facts stated by the plaintiff, but denying the plaintiff's right. *Westhead* v. *Keene.*

141. Where a bill is filed to restrain the infringement by the defendant of letters patent, a sufficient case to justify the injunction must be stated by the plaintiff on the face of the bill, and he must not depend solely on the admissions contained in the defendant's answer for granting or continuing the injunction. If the answer deny the invention to be new, and also the enjoyment under the letters patent, and state (as was the fact) that the specification is imperfectly set forth in the bill, the court will dissolve an injunction previously obtained on affidavit, giving the plaintiff liberty to bring an action, although the defendant admits by his answer that he has made machines upon the principle comprised in the letters patent.

Long and exclusive enjoyment under letters patent will entitle a party to an injunction, until an action can be tried at law. *Curtis* v. *Cutts.*

142. If the defendant is guilty of delay in moving to dissolve an injunction granted against him, the court will not assist him by compelling the plaintiff to try an action to establish the plaintiff's right at a very early period, which would be inconvenient to the plaintiff.

The court gives credit to the title of a party who has been in undisturbed possession of a patent for a number of years; it will protect him till he has the opportunity of establishing his title at law.

The court does not withdraw its protection from a party in whose favour an injunction has been granted, after it has directed him to proceed to an action, to establish his right at law. *Bickford* v. *Skewes.*

143. The fact of a workman leaving plaintiff's employ, and entering into the employ of the defendant, subsequent to which a machine is erected by the defendant similar to that used by the plaintiff, and an article (a fuze) similar in all respects to that manufactured by plaintiff under his patent, are evidence whence an infringement may be inferred. *Bickford* v. *Skewes.*

144. A memorandum of alteration in the specification of a patent had been enrolled, under the statute, on the application to take it off the roll, on the ground that it was wholly void, the Master of the Rolls held that he had no jurisdiction; that if parties had desired to oppose it, they had the opportunity afforded them by caveat before the Attorney or Solicitor-General; and that as those officers had sanctioned the alteration, he could do nothing in it. In re *Sharp's* patent.

145. A motion for an injunction for infringement of a patent right, being opposed on the ground of the patent being bad, and the evidence being doubtful, and the plaintiff undertaking to bring an action, will be directed to stand over till after the action, with liberty to the defendant to apply. Per Lord *Langdale*. *Westhead* v. *Keene.*

146. On application for an extension of patent by the widow of the patentee who died in 1839 (patent granted in 1825), on the ground of no adequate remuneration having been received by him in his life-time, owing to want of capital, an extension was granted for five years, and the petitioner's costs were ordered to be paid, the opposing party having shown no good grounds for their opposition, the Attorney-General appearing for the Crown. In re *Daunton's* patent.

147. The Attorney-General for the Crown offering no opposition, and no caveat being entered, the Judicial Committee of the Privy Council granted an extension for seven years, on the ground of the ingenuity and merit of the invention, the difficulties opposed to the patentee in bringing it into effective operation, and no fair remuneration having consequently been derived from so important an invention. In re *Roberts'* patent.

148. Opposition by the Attorney-General on the part of the Crown, on the ground of the inven-

tion not having been carried into successful and effective operation, will not preclude an extension, if peculiar circumstances, as adverse partners and law proceedings, have prevented its general adoption.

Great economy of time and materials, with less injury to the goods than in other processes of washing, being proved, an extension for seven years was granted. In re *Wright's* patent.

149. The Privy Council will recommend the confirmation under 5 & 6 W. 4, c. 83, s. 2, of a patent, for an invention which is contained only in a French book deposited in the British Museum. In re Baron *Heurteloupe's* patent.

150. The 5 & 6 W. 4, c. 83, s. 2, cannot be applied to secure rights to a subsequent patentee, adversely to the rights of a prior patentee. In re *Westrupp & Gibbins'* patent.

151. On motion for an attachment for contempt, in violating an injunction against infringement, if parties appear to have acted under a mistake, the court will not commit them, but order them to pay the costs of the application. *Cornish & Sievier* v. *Keene.*

152. The terms "prosecuted with effect," in 5 & 6 W. 4, c. 63, s. 4, require something to have been done, some conclusion to have been arrived at, before the expiration of the letters patent, or the privy council have no power to recommend, or the Crown to grant, an extension. In re *Bodmer's* patent.

153. *Statute* 2 & 3 *Vict. c.* 67.

So much of 5 & 6 W. 4, c. 83, s. 4, as requires an application to be prosecuted with effect, before the expiration of the letters patent, is repealed; and it is provided that the time of a patent may be extended in certain cases; though the application for such extension be not prosecuted with effect before the expiration thereof. *Ibid.*

154. An application by petition for the extension of the term of a patent having been made before the expiration of the term, and the prosecution thereof with effect being prevented by circumstances not in the petitioner's control, the privy council granted an extension under 2 & 3 Vict. c. 67. In re *Bodmer's* patent.

155. A patent was granted for "new and improved machinery for preparing flax, hemp, and other fibrous substances by power," and the specification declared the nature of the invention to consist in "new machinery for macerating flax, and other similar fibrous substances, previous to drawing and spinning, and also in improved machinery for spinning the same, after having been so prepared;" held, that this was not a claim for an entire single object, viz. the macerating and spinning the macerated flax on a machine where the rollers are retained at a prescribed distance from each other; that though the first part of the invention described in the new machinery for macerating, may be a proper subject-matter as regards novelty and in all other respects, the latter part, which consists in placing the retaining and drawing rollers nearer to each other than they have ever before been placed, the placing them at variable distances being old, is not a good subject-matter. *Kay* v. *Marshall.*

156. Experiments made upon the same line, and tending to almost the same result, and known to many persons, but abandoned as fruitless, will not vitiate the patent of a more successful competitor, who, availing himself of the discoveries of his predecessors, adds the last links of improvements by bringing the invention to perfection. Per *Tindal*, C. J.; *Galloway* v. *Bleaden.*

157. On a motion for an injunction to restrain the infringement of a patent for three objects, it was ordered that an injunction issue restraining the defendants on one object, and that defendants pay 10*l.* as computed amount of profit on another object, and that the plaintiffs admit the defendants' right as to a part of the third object. *London Caoutchouc Company* v. *Bedells and others.*

158. There having been no *bonâ fide* dealing on the patent, and the specification and patent and infringement being doubtful, the court will direct the plaintiff to bring such action as he may be advised, and the motion to stand over with liberty for both parties to apply. *Parkin* v. *Harrison & others.*

159. A defendant pleaded that the patent had been assigned to more than twelve persons, and was consequently void, and gave in evidence a conveyance to seven persons as trustees for a company. A verdict was taken for the plaintiff, with leave to move on this plea. *Cur.* Lord *Denman*, C. J.; *Claridge* v. *Latrade.*

160. When the plaintiff is entitled to have the injunction made perpetual, the defendant will have to pay the costs of the suit however trivial the subject-matter of the suit may be, if he did not after the injunction was granted, tender the costs up to the time. *Fradella* v. *Weller.*

161. The essential part of an invention being that a necessary degree of compression should be produced in a quantity of air, held that if this could be effected by narrowing the outlet as well as by a weighted valve, both were covered by the words "any other known means of producing the required resistance." Per Sir T. *Denman*, C. J. *Cochrane & Galloway* v. *Braithwaite & Ericsson.*

162. An exclusive license is in respect of the letters patent the same as a common license, and it is wholly immaterial in what number of persons such a license becomes vested. *Protheroe* v. *May.*

163. The infringement of any part of that claimed as new, is an infringement of the patent.

The sending out a cab into the public streets for a short time, for the purpose of experiment, is not such a user or publication as can vitiate the patent. Per *Coltman*, J. *Gillett & another* v. *Wilby.*

164. In the case of a clerical error, the Master of the Rolls will order the prayer of a petition, that the proper officer may amend the original roll or entry of the said specification remaining of record in the Enrolment Office, by altering the letter "w" in the word "wire" to the letter "f," so that the same may be read "fire." In re *Whitehouse's* patent, *ex parte* Russell.

165. A new trial in *scire facias* will not be granted that more evidence may be produced, no surprise or new discovery being stated.

The court will not postpone argument on rule *nisi* for a new trial, till after proceedings by *scire facias.* *Haworth* v. *Hardcastle.*

166. The question, whether the application of a known mode of working, to produce effects also known before, is a manufacture, is a question of law. Per *Tindal*, C. J.; *Crane* v. *Price & others.*

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