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claimed as of the invention of the patentee a great number of distinct matters, many of which were of no practical utility, and one of which only had been actually used by the inventor. There were subsequent patents for improvements by the same patentee, and the original patent could not be worked without them. An extension of so much of the patent as related to the useful parts was recommended upon the petitioner undertaking to disclaim all other parts. In *Lee's Patent* (a) no disclaimer was required.

Validity of patent not adjudicated upon by the Judicial Committee.

It is not the duty of the Judicial Committee upon an application for extension to adjudicate upon the validity or invalidity of the patent itself; (b) for the extension decides nothing as to the validity of the patent; (c) nor will they enter into any questions as to the want of novelty and utility. The new letters patent are subject to any objections on these grounds which may exist to the original letters patent, and unless it is contended that the patent is altogether useless they will not be considered. (d) It must, however, be shown that there is such an amount of novelty and utility as will entitle the petitioner, if everything else is satisfactory, to extension. (e)

Bad patent not extended.

The meaning of the specification and the sufficiency of the subject matter must be ascertained, (f) and if the patent is manifestly bad it will not be extended.

(a) 10 Moo. P. C. C. 230.

(b) *McDougal's Patent*, L. R.

2 P. C. 1; *Betts' Patent*, 1 Moo.

P. C. C. (N. S.) 49; *Heath's*

Patent, 8 Moo. P. C. C. 217;

Pinkus' Patent, 12 Jur. 233.

(c) *Woodcroft's Patent*, 2

Webs. P. R. 81.

(d) *Galloway's Patent*, 1

Webs. P. R. 725.

(e) *Saxby's Patent*, L. R. 3

P. C. 292.

(f) *McDougal's Patent*, L. R.

2 P. C. 1.

In *Woodcroft's Patent* (a) Lord Brougham said: "Where there is a disputed right as to the validity of the patent, and where the validity of the patent itself must come in question, two things are to be considered. First, is the case to prove the invalidity of the patent, to prove the patent void, clear, past all ordinary and reasonable doubt? Or secondly, does the case hang so doubtful, that their lordships would retire from its consideration, and not because it is not necessary, decide the question here? In the former instance, namely, where it is a clear case, their lordships will not grant an extension; first, because they do not see merit, and secondly, because they will not put the parties against whom the patent right is granted and is sought to be extended, to the vexation, trouble, and expense either of bringing a *scire facias* to repeal the letters patent, or of sustaining an action for infringement. But where the matter hangs very doubtful, where there is conflicting evidence, where upon the construction of the specification on the patent, or in any other way, questions of law or questions of fact, as it may be, shall arise, their lordships have not been used to refuse to exercise their discretionary powers, vested in them by the legislature, of recommending an extension, merely because elsewhere the validity of the patent may reasonably be contested." (b)

Nor is it an objection that there is a suit pending respecting the validity of the patent, (c) and in such a case, if extension is granted, it will be for a longer period

Lis pendens.

(a) 2 Webs. P. R. 30.

(c) *Kay's Patent*, 3 Moo. P.(b) And see also *Betts' Patent*, 1 Moo. P. C. C. (N. S.) 49; *Hill's Patent*, *ib.* 258; *Erard's Patent*, 1 Webs. P. R. 557.C. C. 24; *Heath's Patent*, 8 Moo. P. C. C. 217.

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than usual, as some time must elapse before the petitioner can avail himself of the extension. (a)

Cognate patents.

Where two cognate patents of different dates are extended, the extension will be granted, so that the new terms shall expire on the same day. (b)

Persons to whom extension granted, and who may petition.

The persons to whom extension is granted are those in whom the legal estate in the letters patent is vested at the time of making the application. (c) In one case where the petition was presented by the patentee and his mortgagees, extension was granted to the patentee alone. (d)

Administrators and executors.

Trustees of company.

Extension has been granted to the administratrix of a patentee, (e) to the executrix, (f) to the trustees of a joint-stock company, (g) where the patentee joined in the petition. Extension has also been granted to trustees when the patentee had parted with all his interest. (h)

Assignees.

It was at one time considered doubtful whether extension could be granted to the assignee of a patent. It was therefore by 7 & 8 Vict. c. 69, s. 4, enacted that it should be lawful for Her Majesty on the report of the Judicial Committee to grant extension either to an assignee or assignees, or to the original patentee or patentees, or to an assignee or assignees and original patentee or patentees conjointly, and by s. 7 of the same Act new

(a) *Heath's Patent*, 8 Moo. P. R. 565; *Heath's Patent*, 8 P. C. C. 224.

(b) *Johnson and Atkinson's Patent*, L. R. 5 P. C. 87.

(c) *Southworth's Patent*, 1 Webs. P. R. 488; *Wright's Patent*, *ib.* 563.

(d) *Bovill's Patent*, 1 Moo. P. C. C. (N. S.) 348.

(e) *Downton's Patent*, 1 Webs.

(f) *Porter's Patent*, 2 Webs. P. R. 193.

(g) *Petitt Smith's Patent*, 7 Moo. P. C. C. 138.

(h) *Claridge's Patent*, 7 Moo. P. C. C. 138; *Napier's Patent*, 13 Moo. P. C. C. 543.

letters patent granted before the passing of the Act were declared to be valid. (a) CHAP. VIII.

The rule followed by the Judicial Committee in granting extension to assignees is laid down by Lord Brougham in *Morgan's Patent*: (b) "That their lordships by taking into their view and favourably listening to the application of the assignee are, though not directly, yet mediately and consequentially, as it were, giving a benefit to the inventor, because if the assignee is not remunerated at all, it might be said that the chance of the patentee of making an advantageous conveyance to the assignee would be materially diminished, and consequently his interest damnified. For this reason consideration has been given to the claims of the assignee who has an interest in the patent." (c) And in *Whitehouse's Patent*, (d) his lordship said that the merit of the assignee in patronizing the inventor, in expending money till he was enabled to complete his invention, and in liberally supplying the funds which were requisite for the purpose of carrying the invention into execution, had been taken into consideration. (e)

Reasons for granting extension to assignees, interest of patentee injured if not.

Merit of assignee in patronizing patentee.

Where the patented invention was well known abroad and neither the patentee nor his assignee had been at any great risk or expenditure in introducing it into this country, extension was refused. (f) So too, where the assignee had taken an assignment of four-fifths of the

Extension refused where assignee's risk small.

(a) See *Ledsam v. Russell*, 1 H. L. C. 687.

(b) 1 Webs. P. R. 738.

(c) See also *Pitman's Patent*, L. R. 4 P. C. 87, where this rule was cited and approved of.

(d) 1 Webs. P. R. 477. S. C. nom. *Russell's Patent*, 2 Moo. P. C. C. 496.

(e) See also *Norton's Patent*, 1 Moo. P. C. C. (N. S.) 339.

(f) *Claridge's Patent*, 7 Moo. P. C. C. 394.

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patent, for a small consideration, only a few months before its expiration. (a)

Executor of an assignee may petition.

The executor of an assignee may petition for extension, (b) and there does not seem to be any objection to a petition by an equitable assignee. (c)

Importer of an invention.

The importer of an invention is an inventor and is entitled to petition. In *Berry's Patent*, (d) Lord Brougham said: "The patent law is framed in a way to include two species of public benefactors; the one, those who benefit the public by their ingenuity, industry and science, and invention and personal capability; the other, those who benefit the public, without any ingenuity or invention of their own, by the importation of the results of foreign inventions. Now the latter is a benefit to the public incontestably, and therefore they render themselves entitled to be put upon somewhat if not entirely the same footing as inventors. In this case, certain parties have by their adventurous spirit and by the outlay of capital, benefited the public in the proportion of the value of the foreign invention in question, which but for that adventurous spirit and outlay of capital would not have been available to the people of this country. That therefore is to be considered as a solid claim to the exercise of the *quasi* legislative power which the statute vests in this committee. . . . Upon all principles and all analogy, their lordships are of opinion, that we cannot do otherwise than regard this as a solid ground for the application made on the part of the importers." In

(a) *Normand's Patent*, L. R. 3 P. C. 193.

(b) *Bodmer's Patent*, 6 Moo. P. C. C. 468; *Honiball's Patent*, 9 Moo. P. C. C. 378.

(c) *Noble's Patent*, 7 Moo. P. C. C. 191.

(d) 7 Moo. P. C. C. 189.

Newton's Patent (a) extension was granted to a petitioner who had obtained the letters patent as agent and trustee for the foreign patentee.

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Agent for
foreign
patentee.

But the merits of the invention, (b) and all the antecedent circumstances (c) will be enquired into.

An alien resident abroad who was interested in an English patent by a foreign inventor in respect of sales of and licences to use the patent was held to have such a *locus standi* as to entitle him to petition the Crown to revoke an order in council for granting an extended term of an English patent and to recall the warrant for sealing it. (d)

Petition to re-
voke.

By s. 25 of 15 and 16 Vict. c. 83, it is enacted that "where upon any application made after the passing of the Act, letters patent are granted in the United Kingdom for or in respect of any invention first invented in any foreign country or by the subject of any foreign power or state, and a patent or like privilege for the monopoly or exclusive use or exercise of such invention in any foreign country is there obtained before the grant of such letters patent in the United Kingdom, all rights and privileges under such letters patent shall (notwithstanding any term in such letters patent limited) cease and be void immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in such foreign country shall continue in force, or where more than one such patent or like privilege is obtained abroad immediately upon the expiration or determination of the term which shall first expire or be determined of such

Letters patent
obtained in
United King-
dom for
patented
foreign inven-
tions not to
continue in
force after the
expiration of
the foreign
patent.

(a) 14 Moo. P. C. C. 156.

(c) *Johnson's Patent*, L. R. 4(b) *Claridge's Patent*, 7 Moo. P. C. 80.

P. C. C. 394.

(d) *Re Schlumberger*, 9 Moo.

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several patents or like privileges: Provided always that no letters patent for or in respect of any invention for which any such patent or like privilege as aforesaid shall have been obtained in any foreign country, and which shall be granted in the said United Kingdom after the expiration of the term for which such patent or privilege was granted or was in force, shall be of any validity."

Effect of
"such" in
proviso.

The earlier part of this section only applies to cases where patents have been granted in foreign countries before the grant of the patent in the United Kingdom, and the words in the proviso "any such patent" refer to the entire description of the patents mentioned in the foregoing part of the section and to no others. This construction renders the section consistent throughout and applicable in every part of it to the same subject. Where a patent is taken out in a foreign country before a patent for the same invention in the United Kingdom the latter patent is to terminate at the same time as the foreign patent. Where the term in a foreign patent has expired, any grant of letters patent in the United Kingdom made after that period is to be of no value. (a) And in a late case it was said that the meaning of the proviso is that where a patent is taken out in a foreign country before the grant of letters patent in England and the foreign patent has expired, then that the patent in England shall cease to be in force, and that where one "such" patent or the old patent had been obtained abroad, then the English patent should be determined at the expiration of the earliest of the letters patent granted in a foreign country. (b)

(a) *Betts' Patent*, 1 Moo. P. C. C. (N. S.) 49.

(b) *Blake's Patent*, L. R. 4 P. C. 537.

If it were not the case that this clause only applies to a case where a patent has been previously obtained in a foreign country, an English patentee who takes out a patent for an invention, invented in this country could not venture to take out a patent in a foreign country if the foreign term were less than the English. (a)

Where the foreign patent is the first taken out and is determined by act of law abroad, the English patent also is determined. (b) But it appears that any part of the English patent which is not identical with the foreign patent would still remain in force. (c)

An English patentee, who after taking out a patent in this country takes out a patent abroad in addition, is in no sense to be prejudiced, either with respect to his original patent or with respect to any application which he may be advised to make for a renewal of it. (d)

The question as to the jurisdiction of the court has often been discussed, and it may now be taken to be clearly settled, that where the foreign patent was obtained before the English, the court has no power to entertain an application for extension after the foreign patent has expired; but that where the English patent was the first obtained, it has such power. (e)

The policy of the Act, it was said by Sir J. T. Coleridge, "is to prevent in the case of inventions made and patented in any foreign country, the continuance of a monopoly in

Foreign patent determined by law.

English patentee not prejudiced by subsequently taking out foreign patent.

Jurisdiction of the Court.

Policy of the Act.

(a) *Poole's Patent*, L. R. 1 P. C. C. (N. S.) 49; *Poole's Patent*, L. R. 1 P. C. 518.

(b) *Daw v. Eley*, L. R. 3 Eq. 510.

(c) *Ib.*

(d) *Johnson's Patent*, L. R. 4 P. C. 80; *Betts' Patent*, 7 Moo.

(e) See the judgment in *Winnan's Patent*, L. R. 4 F. C. 93, and *Blake's Patent*, *ib.* 535, in which all the antecedent cases are examined.

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this country by virtue of any patent subsequently granted here beyond the time when the discovery shall have become public property in the foreign country.”(a) And Sir W. P. Wood, V.C., said: “Now in looking at s. 25 one sees at once that the object was to prevent the subjects of this kingdom from being fettered in their right to compete with each other in the production and manufacture of different articles, when it was open to foreigners to enter into such competition without being fettered by any exclusive rights claimed by an inventor and patentee, or by the additional price which must be imposed upon the article in consequence of the patent right. The object, I say, is to prevent the English manufacturer from being fettered while the foreigner remains free.”(b)

Foreign patent
taken out
shortly after
English.

Where the foreign patent has been taken out very shortly after the date of the English patent and is allowed to expire, although the case is not strictly within the provisions of this section, yet it is within the spirit of it, and extension will not be granted.(c)

An English patent will not be extended on the mere chance of extension being granted abroad.(d)

Act not logic-
ally consistent.

Sir W. P. Wood, V. C., remarked, in *Daw v. Eley*,(e) that the provision of this section is not pursued to its proper logical consequences in the Act, which only deals with the case in which a foreign patent has been granted and determined; whereas, if no foreign patent has ever

(a) *Hill's Patent*, 1 Moo. P. C. C. (N. S.) 258.

P. C. C. 176; *Winan's Patent*, L. R. 4 P. C. 98; *Blake's Patent*, *ib.* 537.

(b) *Daw v. Eley*, L. R. 3 Eq. 510; *Normand's Patent*, L. R. 1 P. C. 193; *Johnson's Patent*, L. R. 4 P. C. 75; *Winan's Patent*, *ib.* 94; *Blake's Patent*, *ib.* 535.

(d) *Normand's Patent*, L. R. 3 P. C. 193; *Winan's Patent*, L. R. 4 P. C. 97.

(e) L. R. 3 Eq. 510.

(c) *Newton's Patent*, 15 Moo.

been granted, any number of foreigners may be manufacturing the article abroad, while English manufacturers may be exposed, by the existence of a patent in this country, to the very difficulty from which this section professes to relieve them, and that it undoubtedly does appear very hard to prevent the English manufacturer from having the benefit of manufacturing that which all the rest of the world can manufacture at their pleasure; and yet to say that if it is protected for a certain limited time abroad, then, and then only, when that protection has ceased, shall the English manufacturer become free. This argument was raised in *Blake's Patent*, (a) where it was contended that there is not much difference between allowing a foreign patent to expire, and not taking out a foreign patent at all. The difference was there pointed out to be that where a patentee takes out a patent for his invention abroad, he is taking active measures to make the invention known in the country in which he takes out such patent; and the Legislature has not said that no patent shall be granted in England for a foreign invention, unless the inventor shall have taken out a patent in some other country, and that if they had so provided, it would in effect be prohibiting altogether the grant of a patent for a foreign invention.

The grounds upon which extension of the term of letters patent are granted were said by Lord Romilly, in *Norton's Patent*, (b) to have reference to the inventor himself; and to be, in the first place, to reward him for the peculiar ability and industry he has exercised in making the discovery; in the second place, to reward him, because some great benefit of an unusual description has

Grounds of extension generally.

(a) L. R. 4 P. C. 538.

(b) 1 Moo. P. C. C. (N. S.) 343.

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by him been conferred upon the public through the invention itself; or lastly, because the inventor has not been sufficiently remunerated by the profits derived from his strenuous exertions to make the invention profitable, and that all these grounds proceed upon the supposition that the invention is new and useful. And Lord Langdale, in *Pinkus' Patent*, (a) said that what was usually taken into consideration was, first, the merit of the invention; secondly, the utility of the machinery which has been invented; and lastly, whether the patentee has received a sufficient remuneration for the merit which he has displayed. (b)

Interests of
public con-
sulted.

Where a patentee agreed with a company, who exclusively worked his patent, that he would not during the continuance of the term grant any other licence or licences than the licence already granted to the company, or otherwise permit or suffer any person or persons other than the said company to make or put in practice the said invention within a certain locality, and that at the determination of the letters patent he would use his interest to obtain a renewal of them, and, in case of obtaining a renewal, would observe and fulfil the covenants contained in the agreement; extension was refused, on the ground that such an agreement manifestly interfered with the public interest, and was at variance with the spirit of the law under which the application was made. (c) So, too, where it appeared that the real applicants were a company who had bought the patent with others founded on it, for the purposes of trade, and not for any purpose by which any benefit could be derived by the original inventor, who not only had long since parted with all interest in the

(a) 12 Jur. 234.

(c) *Cardwell's Patent*, 10 Moo.

(b) *McDougal's Patent*, L. R. P. C. C. 490.

2 P. C. 1.

patent, but was dead at the time the application was made, extension was refused. (a)

It is not necessary to show that there is case enough for an Act of Parliament, as there are many cases that “would never have prevailed upon the legislature to make a new personal law prolonging a monopoly, which nevertheless might seem meritorious enough in respect of the individual, beneficial enough in respect of the public, and deficient enough in remuneration to justify interference.” (b) In *Morgan’s Patent*, (c) Lord Brougham said: “Their Lordships do not consider that this invention is entirely without merit, but it seems of a very moderate degree, being a substitution of the chemical process of washing with sulphuric acid for the scaling process by fire, making a cheaper and somewhat better article. It is not without merit; at the same time, it cannot be said to be of very great merit—merit which would lead their Lordships to strain much in favour of the inventor.” (d)

Merit of inventor.
Amount of merit.

The grounds upon which the Court proceeds in estimating the merit of the inventor were thus laid down in *Hill’s Patent* (e) by Sir J. T. Coleridge: “It may be collected from what has been already said, that in determining whether to recommend the prolongation of a patent or not, even where the claim to a first discovery and the beneficial nature of that discovery are both con-

(a) *Norton’s Patent*, 1 Moo. P. C. C. (N. S.) 347; *Claridge’s Patent*, 7 Moo. P. C. C. 394.

(b) *Per* Lord Brougham in *Soames’ Patent*, 1 Webs. P. R. 734.

(c) 1 Webs. P. R. 739.

(d) And see *Woodcroft’s Patent*, 3 Moo. P. C. C. 171; 2

Webs. P. R. 19; *Whitehouse’s Patent*, 1 Webs. P. R. 477; *Downton’s Patent*, *ib.* 567; *Hardy’s Patent*, 6 Moo. P. C. C. 441; *Markwick’s Patent*, 13 Moo. P. C. C. 313.

(e) 1 Moo. P. C. C. (N. S.)

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ceded, it will be still proper to consider both the degree of merit as inventor, and the amount of benefit to the public flowing directly from the invention. A monopoly limited to a certain time is properly the reward which the law assigns to the patentee for the invention and disclosure to the public of his mode of proceeding. Whether that term shall be extended in effect, whether a second patent shall be granted for the same consideration, and the enjoyment by the public of its vested right be postponed, is to depend on the exercise of a discretion, judicial indeed, yet to be influenced by every such circumstance as would properly weigh on a sensible and considerate person in determining whether an extraordinary privilege, not of strict right, but rather of equitable reward, should be conferred. Now one may be strictly an inventor within the legal meaning of the term; no one before him may have made and disclosed the discovery in all its terms as described in his specification, but this may have been the successful result of long and patient labours, and of great and unaided ingenuity, without which, for all that appears, the public would never have had the benefit of the discovery; or it may have been but a happy accident, or a fortunate guess; or it may have been very closely led up to by earlier and, in a true sense, more meritorious, but still incomplete, experiments. Different degrees of merit must surely be attributed to an inventor under these different circumstances. The moral claim to an extension of time may in this way be indefinitely varied, according as the circumstances approach nearer to the one or the other of the above suppositions.” (a)

(a) And see *Johnson's Patent*, *ib.* 96; *Blake's Patent*, *ib.* L. R. 4 P. C. 85; *Winan's Patent*, *ib.* 536.

In *Betts' Patent* (a) a distinction was drawn between the merit of ingenuity and the merit of utility. The petitioner's patent was for making a new material by compressing lead and tin. Many years previously a patent for a similar manufacture had been taken out by one Dobbs, but had never been practically used. Lord Chelmsford, in recommending an extension of the term, said, "Dobbs' specification may have given the petitioner the idea of the possibility of uniting the two metals of tin and lead, and may thus have deprived him of the merit of originality. But in Dobbs' hands the discovery was barren; the petitioner, however, who followed out his suggestion, and after repeated trials gave it a practical application, is the real benefactor to the public, and is entitled to claim that description of merit which constitutes one of the grounds for extending the term of a patent."

Merit of ingenuity and merit of utility.

An invention may be of very considerable merit, though the amount of advance in improvement is small, and therefore the smallness of the step is not an objection. (b)

No objection because improvement small.

Simplicity, far from detracting from the merit of an invention, greatly increases its value. (c)

Nor because of simplicity.

It is no objection that the original invention has been improved upon, if the invention has merit and the patentee has not been remunerated; (d) but it is rather an argument in its favour. (e) Nor that the patent

Nor that original invention has been improved meanwhile.

Nor that improvements are on expired imported patent.

(a) 1 Moo. P. C. C. (N. S.) P. R. 119; *Newton's Patent*, 14 Moo. P. C. C. 159.

(b) *Soames' Patent*, 1 Webs. P. R. 735; *Derosne's Patent*, 4 Moo. P. C. C. 416; *Woodcroft's Patent*, 2 Webs. P. R. 32. (d) *Galloway's Patent*, 1 Webs. P. R. 727; *Bodmer's Patent*, 8 Moo. P. C. C. 284.

(c) *Muntz's Patent*, 2 Webs. P. R. 735. (e) *Soames' Patent*, 1 Webs. P. R. 735.

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sought to be extended consists of improvements upon an expired imported patent. (a)

Nor that mode of manufacture altered.

An alteration in the mode of manufacture will not prevent extension from being granted, if it does not materially detract from the merit of the original invention. (b)

Some invention required.

Some invention must be shown by the patentee. (c) In endeavouring to show want of invention, reference to a suggestion previously published, of the principle upon which the patent is based, is immaterial, unless it is shown that it is such a suggestion as any one could easily make use of. (d)

Merit of importer.

The merit of an importer is of course much less than that of an original inventor, and it is an argument against a patent that it was imported and not invented. The amount of merit is not actually taken away, but it is lessened. (e)

Circumstances considered where merit.

The labour, care and science bestowed on an invention, (f) the fact that the nature of the invention is such that it would not be likely to come into immediate use, (g) that the patentee has not been benefited either owing to the nature of the opposition to the patent, (h) or in consequence of his misfortunes and of those connected with

(a) *Bovill's Patent*, 1 Moo. P. C. C. (N. S.) 348.

(b) *Heath's Patent*, 8 Moo. P. C. C. 223.

(c) *Derosne's Patent*, 2 Webs. P. R. 4.

(d) *Woodcroft's Patent*, 2 Webs. P. R. 23.

(e) *Soames' Patent*, 1 Webs. P. R. 733; *Woodcroft's Patent*, *ib.* 740.

(f) *Swaine's Patent*, 1 Webs. P. R. 560; *Hill's Patent*, 1 Moo. P. C. C. (N. S.) 265.

(g) *Wright's Patent*, 1 Webs. P. R. 576; *Kollman's Patent*, *ib.* 565.

(h) *Roberts' Patent*, 1 Webs. P. R. 573; *Russell's Patent*, 2 Moo. P. C. C. 496; *S. C. nom. Whitehouse's Patent*, 1 Webs. P. R. 477.

him as agents or otherwise in the management of the patent, (a) will be considered where the merit of the patent is established.

As one of the grounds upon which a patent is granted to an inventor is, that he may be rewarded by the monopoly on account of the ultimate benefit to be reaped by the public from the utility of the invention; it is clear that if the invention turns out to be useless and the public are not benefited, the claim of the inventor to extension is gone. A strong case of hardship as well as a strong case upon the utility of the invention must be made out. (b)

It must be shown that the invention is of such a character that the public will be benefited by it after the original term has expired; (c) and the term will be extended in such a case even though there is little novelty in the invention. (d)

The extent of the benefit conferred must vary in each case with the circumstances. (e) Extension was granted where it appeared that the invention, which introduced a new material for the manufacture of paper, would, if adopted by the trade, be a great public benefit as a valuable addition to the number of raw materials in a trade in which raw materials are very scarce and dear. (f)

If the invention is of such a nature that it will be to

Utility of the invention.

Public benefit must be proved.

Extent of benefit.

If detriment to the public, no extension.

(a) *Southworth's Patent*, 1 Webs. P. R. 487; *Wright's Patent*, *ib.* 576.

(b) *Erard's Patent*, 1 Webs. P. R. 559.

(c) *Simister's Patent*, 4 Moo. P. C. C. 166; *Hardy's Patent*, 6 Moo. P. C. C. 443; *Petitt Smith's Patent*, 7 Moo. P. C. C. 138.

(d) *Derosne's Patent*, 2 Webs. P. R. 4.

(e) *Hill's Patent*, 1 Moo. P. C. C. (N. S.) 265; *Johnson's Patent*, L. R. 4 P. C. 79.

(f) *Houghton's Patent*, L. R. 3 P. C. 461.

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the detriment of the public that the monopoly should be continued, extension will be refused. Thus, where the invention was generally for deodorizing and disinfecting sewage and other offensive matters, by means of a compound of sulphurous acid and carbolic acid, both of which are well known disinfectants, and had been used for disinfecting purposes before the date of the patent, extension was refused on the ground that the restriction by patent from general use, of the combination of the articles referred to in the mode described in the specification would be a great public detriment. (a)

Nor if specification too general.

Where the specification described the invention to consist in the application of a metallic soap to the bottoms of ships to prevent their fouling, and it appeared that the soap was composed of well known substances in common use; extension was refused on the ground that as the individual substance for the application of which the patent was sought to be prolonged was not specifically defined, every kind of metallic soap being within the limits of the specification, many questions affecting the patent might be raised if any metallic soap was used by the public in ignorance of the extensive nature of the specification. (b)

Delay in using the invention is evidence of inutility.

The petitioner must have done all in his power to bring the invention into notice and use; (c) for the fact that an invention when known, has never been generally used, raises a strong presumption against its utility, (d)

(a) *McDougal's Patent*, L. R. 2 P. C. 1.

(b) *McInnes' Patent*, L. R. 2 P. C. 54.

(c) *Hill's Patent*, 1 Moo. P. C. C. (N. S.) 265; *Markwick's Patent*, 13 Moo. P. C. C. 313.

(d) *Wright's Patent*, 1 Webs. P. R. 576; *Simister's Patent*, *ib.*

723; *Pinkus' Patent*, 12 Jur. 233; *Herbert's Patent*, L. R. 1

P. C. 399; *Allan's Patent*, *ib.* 507.

though it is not conclusive. (a) Delay in using the invention may be explained in some circumstances from want of funds to prosecute it, as the pecuniary difficulties, in which the patentee has been involved in working out his invention, may have placed him in a situation which has made it extremely difficult for him to obtain the means for taking the necessary steps to put the patent into operation. But where the petitioner was a gentleman possessed of ample means to put his invention into operation, and he had taken no effectual steps for this purpose for ten years, extension was refused. (b) In this case the non-user was further explained by the disputes between the patentee and his partners. In another case, however, where partnership disputes were given as a reason for want of success, combined with want of capital, and the impossibility of getting other partners on account of the disputes, extension was refused on the ground that the partnership was the petitioner's own act. (c)

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May be explained by pecuniary difficulties of patentee.

By partnership disputes.

Non-user may also be explained by the circumstance that the nature of the invention is such that it would not be likely to come into immediate use. (d) In *Herbert's Patent*, (e) the patent was for improvements in constructing and mooring light vessels, buoys and other similar floating bodies. The merit and utility of

By nature of the invention.

(a) *Woodcroft's Patent*, 2 Webs. P. R. 29; *Bakewell's Patent*, 15 Moo. P. C. C. 386; *Herbert's Patent*, L. R. 1 P. C. 399.

(b) *Norton's Patent*, 1 Moo. P. C. C. (N. S.) 339; *Wright's Patent*, 1 Webs. P. R. 576.

(c) *Patterson's Patent*, 6 Moo. P. C. C. 469.

(d) *Southworth's Patent*, 1 Webs. P. R. 487; *Jones' Patent*, *ib.* 579; *Woodcroft's Patent*, 2 Webs. P. R. 32.

(e) L. R. 1 P. C. 399.

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the invention were not denied. It was shown that the market was very limited, and that there was great difficulty in getting the invention tried, and on these grounds extension was granted. (a) If the patent has not been used at all during the whole term, that of itself, unless rebutted by the strongest and most distinct evidence, will as a rule be sufficient ground for refusing extension, (b) even though the patent is of such a kind as to require a company to provide sufficient capital. (c)

The fact that the patented article is much more expensive than an article for a similar purpose in actual use, and yet that a number of the patented articles have been sold is strong evidence of utility. (d)

Sufficiency of remuneration principal question.

The principal question in considering whether extension shall be granted or not, always is, has the individual patentee under all the circumstances received what in equity and good conscience may be considered a sufficient remuneration? (e)

The merit and utility being proved.

It is of course necessary to consider the merit and utility of the invention, (f) for if the patent is wanting in these essentials, extension will be refused, even though there has been a loss. (g)

Reason for non-remuneration must be given.

It must be shown that the patentee has used all reasonable means to make the invention productive; but

(a) And see *Berrington's Patent*, cited in Coryton's Law of Patents, 225.

(b) *Bakewell's Patent*, 15 Moo. P. C. C. 386; *Allan's Patent*, L. R. 1 P. C. 507.

(c) *Ib.*

(d) *Downton's Patent*, 1 Webs. P. R. 566.

(e) *Hill's Patent*, 1 Moo. P.

C. C. (N. S.) 264; *Norton's Patent*, *ib.* 343; *Pinku's Patent*, 12 Jur. 234; *McDougal's Patent*, L. R. 2 P. C. 1; *Downton's Patent*, 1 Webs. P. R. 567.

(f) *Morgan's Patent*, 1 Webs. P. R. 738.

(g) *Simister's Patent*, 1 Webs. P. R. 724; *Betts' Patent*, 10 Jur. 363.

that nevertheless the remuneration obtained has either entirely failed or has been quite disproportionate to the merits and to the benefit conferred upon the public. (a)

Thus extension was granted where it appeared from the nature of the invention ; a patent for iron wheels for carriages ; that it was hardly possible that within the ordinary period of time remuneration could be expected, and that not only was there no remuneration, but a heavy loss had been sustained. (b) So where the loss in working a patent in Southern Australia was owing to want of labour caused by the discovery of the gold fields, (c) and where the invention was expensive, and there had been no remuneration till the end of the term. (d) But there must be a reasonable prospect of success during the extended term. (e)

Where the benefit derived from the patent by the public is proportionately greater than that derived by the inventor, the term will be extended, even though large profits have been made. (f)

Profits made by the patent abroad will be considered in estimating the amount of remuneration. (g) In *Poole's Patent*, (h) the foreign profits were not taken into account, but their Lordships in *Johnson's Patent* (i) desired

Benefit to public great, extension though profits.

Profits from foreign patent considered.

(a) *Honiball's Patent*, 9 Moo. P. C. C. 393 ; *Markwick's Patent*, 13 Moo. P. C. C. 393.

(b) *Jones' Patent*, 1 Webs. P. R. 579 ; *Southworth's Patent*, *ib.* 487 ; *Stafford's Patent*, *ib.* 563 ; *Kollman's Patent*, *ib.* 564.

(c) *Napier's Patent*, 13 Moo. P. C. C. 545.

(d) *Newton's Patent*, 14 Moo. P. C. C. 156.

(e) *Woodcroft's Patent*, 2 Webs. P. R. 33.

(f) *Derosne's Patent*, 2 Webs. P. R. 4 ; *Hardy's Patent*, 6 Moo. P. C. C. 443.

(g) *Johnson's Patent*, L. R. 4 P. C. 82.

(h) *Poole's Patent*, L. R. 1 P. C. 514.

(i) L. R. 4 P. C. 82.

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it to be understood that that case was not to be considered as laying down any general rule of law, and that they were of opinion that in taking into consideration the remuneration received, they must have regard to the remuneration which the invention has brought in to the patentee or the person who claims the right of the patentee whether it be in one country or another.

Position of assignees.

Assignees are not on the same footing as the patentee, and where it appeared that the patentee had been remunerated though the assignees had not, and the invention was imported and well known abroad, extension was refused. (a) So too where the petitioner had purchased the letters patent and stock-in-trade of the patentee at a fair value, and had not sustained any loss. (b)

Importers.

Where the patentees were importers of the invention and had incurred loss in their endeavours to introduce it into this country, extension was granted. (c)

Patent must be taken as a whole.

Where the patent consists of several branches, it must nevertheless be taken as a whole, and the Court will not allow it to be divided and subdivided to see whether there has been a gain under some branches, and a loss under others, (d) and *semble*, that if there has been considerable profit under one branch, that would be a ground for refusing extension, even though there has been loss under the others. (e)

Act of Parliament obliging use of patent not objection.

It is no objection to extension that by an Act of Parliament the public will be obliged to use the patentee's in-

(a) *Claridge's Patent*, 7 Moo. P. C. C. 394.

(b) *Quarrill's Patent*, 1 Webs. P. R. 740.

(c) *Berry's Patent*, 7 Moo. P. C. C. 187.

(d) *Perkins' Patent*, 2 Webs. P. R. 7.

(e) *Ib.*

vention, if it can be proved that at the time of making the application he has not received sufficient remuneration. (a)

The application must not be made until shortly before the expiration of the term of the original patent, as the profits made during the last portion of the term may materially affect the question of extension. (b)

The most unreserved and clear statement of the accounts of the profits made by the patent is necessary; (c) for the extension of the term of a patent being a matter of favour and not of right, it is essential to the favourable consideration of an application for extension that the patentee should distinctly prove how much the public have had to pay, that is to say, how much has been received by him on account of his patent; and if he has so acted as to be unable to give such proof when he applies for extension, his application must fail. (d)

In *Saxby's Patent* (e) Lord Cairns said that it is "the duty of every patentee who comes for the prolongation of his patent to take upon himself the *onus* of satisfying this committee in a manner which admits of no controversy, of what has been the amount of remuneration which, in every point of view, the invention has brought to him, in order that their lordships may be able to come to a conclusion whether that remuneration may fairly be considered a sufficient reward for his invention or not. It is not for this committee to send back the accounts for further particulars, nor to dissect the accounts for the

When application to be made.

The accounts must be clear.

(a) *Foade's Patent*, 9 Moo. P. C. C. 376.

(b) *Macintosh's Patent*, 1 Webs. P. R. 739.

(c) *Hill's Patent*, 1 Moo. P. C. C. (N. S.) 271.

(d) *Trotman's Patent*, L. R. 1 P. C. 124.

(e) L. R. 3 P. C. 294.

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purpose of surmising what might be the real outcome if they were differently cast; it is for the applicant to bring his accounts before the committee in a shape which will leave no doubt as to what the remuneration has been that he has received.” (a)

It was suggested in *Perkins' Patent* (b) that where the accounts were not clear, they should be handed to the Solicitor to the Treasury to examine.

What accounts must contain.

The actual expenses must be shown, it is not sufficient to state that there has been neither profit nor loss. (c) It is material to know in what ratio profits have increased if they have increased from year to year. (d) Profits arising from the sale of the patented article for exportation must be included. (e)

Deductions allowed to be made in calculating profits.

In calculating whether any profit has been obtained through or by means of a patent, it is correct to deduct in the first place, beyond the cost price, a fair manufacturer's profit on the articles sold, and the mere preference of the market obtained by the manufacturer is not to be deemed a profit derived from the patent. (f) Where the patentee deducted two-thirds as profits from the manufacture and sale, and only credited the patent with one-third, the deduction was held to be unreasonable. (g) Lord Brougham in *Muntz's Patent* (h) said: “ We cannot weigh in golden scales the proportions between manu-

Manufacturer's profit.

(a) And see *Clark's Patent*, L. R. 3 P. C. 425.

(b) 2 Webs. P. R. 14.

(c) *Quarrill's Patent*, 1 Webs. P. R. 740.

(d) *Perkins' Patent*, 2 Webs. P. R. 17.

(e) *Hardy's Patent*, 6 Moo. P. C. C. 441.

(f) *Galloway's Patent*, 7 Jur. 453; *Betts' Patent*, 1 Moo. P. C. C. (N. S.) 49.

(g) *Hill's Patent*, 1 Moo. P. C. C. (N. S.) 269.

(h) 2 Webs. P. R. 120.

facturers' profits and patentees', but we must take it in the gross; and applying our minds as men of the world, men of business, neither unfairly towards the inventor nor extravagantly and romantically towards him in his favour, neither against him pressing nor in his favour straining, we must ascertain whether he has in the eyes of men of ordinary but enlightened understandings, judging fairly between him and the public, had a sufficient remuneration."

Expenses caused by litigation in protecting the patent may be deducted. (a) But where the patentee compromised suits and gave up costs to which he had no apparent title, a deduction was not allowed. (b)

Loss by litigation.

The patentee may in his accounts charge for loss of time in endeavouring to bring the patent into notice. (c)

Loss of time.

Deductions will also be allowed on account of the costs of experiments. (d)

Experiments.

In *Perkins' Patent* (e) the following accounts were allowed:—

	£
Amount of yearly sales of patent apparatus	64,920
	<hr style="width: 100%;"/>
Materials, labour, tools, and expenses belonging to the sales	47,282
Bad debts	2,296

(a) *Betts' Patent*, 1 Moo. P. C. C. (N. S.) 49; *Roberts' Patent*, 1 Webs. P. R. 573; *Kay's Patent*, 1 Webs. P. R. 572.

(b) *Hill's Patent*, 1 Moo. P. C. C. (N. S.) 268.

(c) *Newton's Patent*, 14 Moo. P. C. C. 156; *Mallet's Patent*, L. R. 1 P. C. 311; *Perkins' Patent*, 2 Webs. P. R. 17; *McInnes' Patent*, L. R. 2 P. C. 54; *Clark's Patent*, L. R. 4 P. C. 542. In the three last of the above cases the sum of £400 a year was allowed to be charged.

(d) *Kay's Patent*, 1 Webs. P. R. 572; *Perkins' Patent*, 2 Webs. P. R. 17.

(e) 2 Webs. P. R. 17.

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		15,176
	Leaving	15,176
	as the amount of profit, subject to the following deductions:	
	Cost of materials, labour in experiments, and patents	500
	Interest at £5 per cent. on the average amount of capital for twelve years at £225 a-year	2,700
	Personal attendance of patentee for thirteen and a-half years at £400 a year	5,400
		£8,600
	Total	£8,600

Leaving £6,576 as net profit from the patent business, subject to be reduced should any unpaid debt prove bad.

Royalties paid to agent.

Where a patentee employs an agent to bring the patent forward and pays him by the royalties, the amount so paid may be deducted. (a)

Patentee also a manufacturer must keep separate patent accounts.

Where the patentee is also a manufacturer he ought to keep a patent account distinct and separate from any other business in which he may happen to be engaged, so as to be able to give the clearest evidence of everything which has been paid on account of the patent. (b) In *Saxby's Patent* (c) Lord Cairns said: "Where a patentee is also the manufacturer, the profits which he makes as manufacturer, although they may not be in a strict point of view profits of the patent, must undoubtedly be taken

(a) *Poole's Patent*, L. R. 1 (N. S.) 61; *McInnes' Patent*, P. C. 514; *Perkins' Patent*, 2 L. R. 2 P. C. 54.

Webbs. P. R. 16.

(c) L. R. 3 P. C. 295.

(b) *Betts' Patent*, 1 Moo. P. C.

into consideration upon a question of this kind. It is obvious that in different manufactures there will be different degrees of connection between the business of the applicant as a manufacturer and his business or his position as the owner of a patent. There may be patents of some kind which have little or no connection with the business of the manufacture, and there may be patents of a different kind where there is an intimate connection with the business of the manufacturer; that the possession of the patent virtually secures to the patentee his power of commanding orders as a manufacturer.” (a)

The distinction between the profits made as a patentee and as a manufacturer was thus commented upon by Lord Brougham in *Muntz's Patent*: (b) “There are two cases in which a patentee may come before us, and one is where, as in the case of the late Mr. Howard for the sugar refinery, the party is a mere chemist, and has made an invention of the most useful and meritorious process to be used by sugar bakers; there no confusion can ever arise between gains of patentee *quasi* inventor and his gains *quasi* manufacturer. The other case is the case of Mr. Watt, who came before Parliament for the extension of his patent, and obtained an Act, he having been out of pocket by the invention, and having been all his life in law and equity in consequence of the disputes with others—with pirates of his great and immortal discovery. He there combined in his own person the inventor and manufacturer, Mr. Watt never denying that he was to set down to the account of his patent, of the benefit that he had reaped from his patent, the preference that was given him in the market as a manufacturer. He would not

Distinction between profits of patentee and profits of manufacturer.

(a) And see *Johnson's Patent*, L. R. 4 P. C. 82. (b) 2 Webs. P. R. 121.

have been able to have carried on his trade to anything like that extent had it not been for that patent. It is impossible to sever the two heads of profit one from the other. Mr. Muntz has gained *quasi* patentee, and even though he obtained and reaped the fruit and, as it were, arrived at the fruits of his ingenuity as an inventor, through his labour and the use of his capital and industry as a manufacturer, it is no answer to say that of these things the one can be deducted from the other. You may make out a very lucrative patent to be of no gain at all to the patentee although agreeing that the patent was lucrative and had been a gain. It is really a monopoly preference which he has; because as patentee he is enabled to sell and to trade in a manner which, but for his invention and but for his patent, he could not."

Royalties from licensees.

The rules laid down above as to perfect openness in stating the accounts, apply as well to a case where the applicant has not manufactured his patented article, but has received his remuneration by royalties received from licensees, as to where he is his own manufacturer, and in such a case he must prove the amount of the profits made by the licensees in respect of the patented article. (a)

Course of procedure where accounts *prima facie* satisfactory.

If the statement of accounts is *prima facie* satisfactory, the petitioner may prove the merits of the invention before entering upon the question of the accounts. (b) But if it is unsatisfactory the petition will be dealt with without reference to the merits. (c) These cases, however, only go to this extent; that where there are special statements which show upon the face of the accounts that

(a) *Trotman's Patent*, L. R. 1 P. C. 118.

(b) *Houghton's Patent*, L. R. 3 P. C. 461.

(c) *Saxby's Patent*, L. R. 3 P. C. 292; *Clark's Patent*, *ibid.*

the petitioner has in fact made very large profits by his invention, such circumstance is sufficient for the Court at once to determine the application without going into the merits of the invention. (a)

The accounts must be strictly proved. (b) Where, however, the accounts were unsatisfactory, owing to the loss of the account books, during the petitioner's bankruptcy, extension was granted on a proper account of the profits and losses of the patent verified by affidavit being sent to the Attorney General, with a satisfactory explanation, accounting for the non-production of the books. (c) In another case the accounts were taken on the petitioner's own evidence. (d) And where it appeared that the estate of a deceased patentee was of little value, and that no accounts had ever been kept, the petitioner, the administratrix of the patentee, on an allegation in the petition that not only had there been no profits but considerable loss, was examined to prove that fact. (e)

Evidence to prove accounts.

The Judicial Committee has power to impose terms on the patentee or his assignees before granting extension. This will be done where it is for the benefit of the public that the government should use the invention. Thus extension was granted in *Petitt Smith's Patent* (f), subject to a proviso that the Admiralty should be at liberty to manufacture and fit the invention without any license from the patentee.

Terms imposed in certain cases.

(a) *Houghton's Patent*, L. R. 3 P. C. 461; *Wield's Patent*, L. R. 4 P. C. 90.

(b) *Perkins' Patent*, 2 Webs. P. R. 15.

(c) *Markwick's Patent*, 13 Moo. P. C. C. 310.

(d) *Hutchison's Patent*, 14 Moo. P. C. C. 364.

(e) *Heath's Patent*, 8 Moo. P. C. C. 217.

(f) 7 Moo. P. C. C. 139.

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Such a proviso will not, however, be required if the patentee has not received sufficient remuneration. (a) An application for the extension of a patent for an improved method of printing in colours was opposed by the apprentices of the patentee, on the ground that they had expected to be able to exercise the trade themselves on the expiration of the patent, and that they would not be able to get employment. It appeared however that they had been so instructed as to be able to get employment in another branch of the trade, and no condition was imposed. (b)

Partners.

If there has been a partnership between the patentee and other parties the Court will on extension require the patentee to give the partners the same rights and privileges as they were entitled to under the deed affecting the original letters patent, no further powers will be given than those contained in the deed of partnership, especially if the partners refuse to concur in the application. (c)

Licensees.

Where a patentee did not manufacture the article for which he had taken out a patent but had granted a license to a particular firm to manufacture it, and it appeared that there was an agreement that the license should be exclusive, extension was granted on condition that licenses should be granted to any persons who should be desirous of having them upon the same terms as the original license. (d)

Assignees.

In the case of a petition by an assignee, the condition

(a) *Lancaster's Patent*, 2 Moo. P. C. C. (N. S.) 189; *Carpenter's Patent*, *ib.* 191.

(b) *Baxter's Patent*, 13 Jur. 593.

(c) *Normandy's Patent*, 9 Moo. P. C. C. 452.

(d) *Mallett's Patent*, L. R. 1

P. C. 308.

usually is that he shall secure some remuneration to the patentee. This is generally in the form of an annuity during the extended term. (a)

Where a moiety of a patent had been assigned and a petition for extension was presented by the patentee together with the assignees, but before the hearing the patentee died having by his will appointed his widow executrix and residuary legatee, extension was granted to the assignees on condition that they held the moiety of the patent in trust for the widow. (b)

Terms, however, will not be imposed upon the assignees when they have lost heavily by the patent. (c)

The interests of the public will be considered in granting extension to assignees. Thus in *Hardy's Patent*, (d) besides requiring the assignees to pay an annuity to the patentee, a further condition was imposed that neither the assignees nor their assigns should charge for articles made according to the invention, any sum or sums of money, greater than after the rate of the sums thereafter mentioned, over and above the price of bar iron per ton as fixed by the Staffordshire ironmasters at the quarterly meeting next preceding the date of any contract of sale.

The applicant for prolongation must advertise in the "London Gazette" three times, and in three London papers, and three times in some country paper published in the town where, or near to which, he carries on any manufacture of anything made according to his specifica-

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

(a) *Whitehouse's Patent*, 1 Webs. P. R. 477; S. C. nom. *Russell's Patent*, 2 Moo. P. C. C. 496; *Markwick's Patent*, 13 Moo. P. C. C. 312; *Hardy's Patent*, 6 Moo. P. C. C. 445.

(b) *Herbert's Patent*, L. R. 1 P. C. 399.

(c) *Bodmer's Patent*, 6 Moo. P. C. C. 468.

(d) 6 Moo. P. C. C. 445.

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tion, or near to or in which he resides, in case he carries on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to apply to Her Majesty in Council for a prolongation of his term of sole using and vending his invention, and must petition Her Majesty in Council to that effect. (a)

Advertisements.

The petitioner must in the advertisements give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition, which day must not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the "London Gazette." (b) These notices will be included in one advertisement. (c)

Petitions must be presented within one week from the insertion of the last of the advertisements, and must be accompanied with affidavits of advertisements having been duly inserted, and the matters in such advertisements may be disputed by the parties opposing upon the hearing of the petition. (d)

Where the patentee resides abroad, and the manufacture of the patented article is carried on under licenses, the advertisements should be inserted in papers circulating where the manufacture is actually carried on. (e)

Where the advertisements were inserted in London papers only, a witness was allowed to be called to prove

(a) 5 & 6 Will. IV. c. 83, s. 4. *Patent, ib. 564; Wright's Patent,*

(b) Rules of the Privy Council, cls. 2—4. *ib. 576.*

(c) *Erard's Patent, 1 Webs. P. R. 559, n.; Southworth's Patent, ib. 486, n.; Stafford's* (d) Rules of the Privy Council, 2—4.

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

that the patent apparatus was manufactured in London, and not elsewhere. (a)

To entitle an equitable assignee to appear with the legal assignee of a patent, his name must appear in the advertisements; and if it does not his counsel will not be heard. (b)

The advertisements must be proved before the case is heard. (c)

The applicant must lodge at the Privy Council office six printed copies of the specification and also four copies of the balance sheet of expenditure and receipts, relating to the patent, which accounts are to be proved at the hearing. If the specification has not been printed, and if the expense of making six copies of any drawing would be considerable, the lodging of two copies only of such specification and drawing will be deemed sufficient. All copies must be lodged not less than one week before the day fixed for hearing the application. (d)

Documents to be lodged at Privy Council office.

The Court will refuse to enter upon accounts if they have not been filed as required. (e)

Delay in filing

Where owing to the mistake of the petitioner's agent the petition was not filed within the prescribed time, the petition was allowed to be filed on a special application being made. (f)

Everything relating to the title of the petitioner must be fully and fairly stated in the petition. (g) Where the

The petition.

(a) *Perkins' Patent*, 2 Webs. P. R. 8, n.

(e) *Johnson and Atkinson's Patent*, L. R. 5 P. C. 87.

(b) *Noble's Patent*, 7 Moo. P. C. C. 191.

(f) *Hutchison's Patent*, 14 Moo. P. C. C. 364.

(c) *Perkins' Patent*, 2 Webs. P. R. 8.

(g) *Hutchison's Patent*, 14 Moo. P. C. C. 364; *Johnson's Patent*, L. R. 4 P. C. 83.

(d) Rules of the Privy Council, cl. 9.

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petitioner omitted to state that the patent was in fact a communication from a foreigner living abroad, who had previously taken out a patent for the same invention in America, and that the American patent had expired but had been renewed, the application was refused. (a)

Assignees must state their title strictly. (b)

Amendment.

Where material facts relating to the petitioner's title were omitted, the hearing of the petition was adjourned with leave to amend. (c)

Caveats.

Any person may enter a *caveat* at the council office, and is entitled to be heard in opposition to the petition. (d) The *caveat* must be entered before the day on which the petitioner has advertised his intention of applying for a day to be fixed for the hearing. Any person entering a *caveat* is entitled to four weeks' notice of the time appointed for the hearing, to be served with a copy of the petition, and no application to fix a time for hearing may be made without affidavit of such service. All parties served with petitions must lodge at the council office within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions. (e)

No person can be heard in opposition to an application for extension unless he has entered a *caveat*. Where a patent agent had entered a *caveat* in his own name, but in reality as the agent of several other persons as well as

(a) *Pitman's Patent*, L. R. 4
P. C. 84.

(b) *Wright's Patent*, 1 Webs.
P. R. 561; *Galloway's Patent*,
ib. 725.

(c) *Hutchison's Patent*, 14 Moo.
P. C. C. 365.

(d) 5 & 6 Will. IV. c. 83, s. 4;
Lowe's Patent, 8 Moo. P. C. C. 1.

(e) Rules of the Privy Council,
cls. 2, 5, 6.

on his own behalf, it was held that his counsel could only be heard for him, and could only ask such questions as respected his interest. (a)

Any person who has rights under the patent which the patentee refuses to recognise on extension, may petition that no extension may be granted unless the patentee admits his rights. (b)

Any person entering a *caveat* is entitled to notice of any objection which would prevent the patent from being received. (c)

The Attorney-General appears on behalf of the public generally, and is entitled to oppose, although no *caveat* has been entered. (d) In *Petitt Smith's Patent*, (e) an application by the Lords of the Admiralty to enter a *caveat* and be heard against the petition, such *caveat* not having been filed within the time required by the rules was refused, on the ground that the Attorney-General represented the interests of the Crown as well as those of the public.

Opposition by
Attorney-
General.

Unless parties opposing have distinct and separate interests, not more than two counsel will be heard to oppose. (f)

Two counsel
only heard.

The Court will not on an application under 14 & 15 Vict. c. 99, s. 6, which gives the Courts of Common Law power to compel inspection of documents on application by either party, and to investigate all documents in the custody or control of the other, and to take and examine

Inspection of
accounts not
compelled.

(a) *Lowe's Patent*, 8 Moo. P. C. C. 1.

(b) *Normandy's Patent*, 9 Moo. P. C. C. 452.

(c) *Hutchison's Patent*, 14 Moo. P. C. C. 365.

(d) *Petitt Smith's Patent*, 7 Moo. P. C. C. 133; *Erard's Patent*, 1 Webs. P. R. 557 n.

(e) 7 Moo. P. C. C. 133.

(f) *Woodcroft's Patent*, 3 Moo. P. C. C. 172.

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copies of the same, compel a petitioner to allow the opponents to inspect his accounts. (a)

Evidence.

As the proceedings before the Judicial Committee are in substitution for a Bill in Parliament, the Court follows a similar course to that which would be followed by Parliament, and adopts rules of evidence as nearly as possible resembling the rules of evidence in courts of law. (b)

Costs.

Costs will not be given to the opposers where there is no ground for opposition. (c) Where there was some conflict of opinion on the part of scientific witnesses as to the merits of the invention, costs were refused although extension was granted. (d)

Costs will be given to all opposers, if the petition is abandoned upon the hearing, (e) and it is not necessary that the opposers should serve the petitioners with notice of their intended application to the Court for costs. (f)

Where the petition has been heard and is dismissed, the opposers are generally given their costs, for if costs were not given persons would be discouraged from coming to protect the interests of the public. (g) But costs will not be given where the opposition has not been properly conducted, as where the opposers caused expense by relying on irrelevant evidence, and produced

(a) *Bridson's Patent*, 7 Moo. P. C. C. 499; *Patent*, 7 Moo. P. C. C. 500.

(b) 1 Webs. P. R. 557.

(c) *Downton's Patent*, 1 Webs. P. R. 567.

(d) *Galloway's Patent*, 1 Webs. P. R. 129.

(e) *Mackintosh's Patent*, 1 Webs. P. R. 739; *Bridson's*

Patent, 7 Moo. P. C. C. 499; *Hornby's Patent*, *ib.* 503; *Milner's Patent*, 9 Moo. P. C. C. 39.

(f) *Bridson's Patent*, 7 Moo. P. C. C. 499.

(g) *Westrupp and Gibbins' Patent*, 1 Webs. P. R. 556;

Wield's Patent, L. R. 4 P. C. C. 92.

witnesses who were not credible. (a) Where there are several opposers who really represent the same kind of opposition, a gross sum will be allowed for costs to be apportioned between them, unless the petitioner prefers within a certain time to tax the costs of all parties. (b)

Where patentees neglected to obtain new letters patent in pursuance of an order in council and a petition was presented to revoke the order and to recall the warrant to seal, and it did not appear that the petitioner or the public had suffered any loss by the laches of the patentee; the Judicial Committee, though they did not consider the delay sufficient to deprive the patentee of all benefit of the renewed patent, made it a condition before dismissing the petition, that the patentees should pay the petitioner £200 for costs, and give an undertaking not to prosecute for any infringement which might have occurred from the date of the order in council to the date of the dismissal of the petition. (c)

(a) *Honiball's Patent*, 9 Moo. C. (N. S.) 271; *Johnson's Patent*, L. R. 4 P. C. 79; *Wield's Patent*, *ib.* 93.

(b) *Milner's Patent*, 9 Moo. P. C. C. 39; *Jones' Patent*, *ib.* (c) *Re Schlumberger*, 9 Moo. P. C. C. 1.

CHAPTER IX.

OF CONFIRMATION OF THE TERM OF LETTERS PATENT.

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Publication
unknown to
patentee.

5 & 6 Will. IV.
c. 83, s. 2.
Mode of pro-
ceeding where
the patentee is
not the real
inventor,
though he be-
lieved himself
to be so.

IT occasionally happens that there has been a previous publication of an invention for which letters patent have been taken out, and that such publication is unknown to the patentee. The patent is nevertheless void, as has already been seen, for want of novelty. In many cases formerly the patentee suffered great hardship by the operation of this rule. The majority of patents are for improvements on some existing machine, and it often happened that persons having the improvement of the same machine in view carried it out by the same means. In order to provide a remedy for this state of things, it was provided by the 5th & 6th Will. IV. c. 83, s. 2, that "if in any suit or action it shall be proved or specially found by the verdict of the jury that any person who shall have obtained letters patent for any invention or supposed invention was not the first inventor thereof, or some part thereof, by reason of some other person or persons having invented or used the same or some part thereof before the date of such letters patent, or if such patentee or his assignees shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof before the date of such letters patent, it shall and may

be lawful for such patentee or his assigns to petition his Majesty in Council to confirm the said letters patent or to grant new letters patent, the matter of which petition shall be heard before the Judicial Committee of the privy council; and such committee upon examining the said matter and being satisfied that such patentee believed himself to be the first and original inventor, and being satisfied that such invention, or part thereof, had not been publicly and generally used before the date of such first letters patent, may report to his Majesty their opinion that the prayer of such petition ought to be complied with, whereupon his Majesty may, if he think fit, grant such prayer; and the said letters patent shall be available in law and equity to give such petitioner the sole right of using, making and vending such invention as against all persons whatsoever, any law, usage or custom to the contrary notwithstanding: Provided that any person opposing such petition shall be entitled to be heard before the said Judicial Committee: Provided also, that any person, party to any former suit or action touching such first letters patent shall be entitled to have notice of such petition before presenting the same."

The intention of the statute is that the patentee may, if circumstances render it fitting in the judgment of the Judicial Committee, be protected against any prior invention not publicly or generally used, where he has no reason to believe that such prior invention existed, and it confers the power of giving to the patentee that which he did not possess before the passing of the statute, or in other words, of curing that which before the statute would have constituted an invalidity. If the patent were valid by law as it existed before the passing of the statute, it could hardly be necessary to confirm it. The

Intention of
statute.

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case to be remedied is not that of a patentee discovering a prior invention, so known that the patent might be invalidated on that ground, though not publicly and generally used. The statute was framed to protect against circumstances which constituted an invalidity, though the patentee had so far as his knowledge went every reason to believe himself to be the original inventor. (a)

When application to be made.

An application for confirmation should be made as soon as possible after the patentee becomes aware that there has been a previous publication.

Powers of the Judicial Committee.

The power of the Judicial Committee to confirm letters patent is discretionary, (b) and will be very cautiously exercised, (c) as the effect of it is to supersede the ordinary rules of law at the expense of the public in favour of an individual, to give force and validity by a *quasi* legislative authority to a grant of monopoly actually void; and to exclude from the use of the invention not only the public generally, but the first and original inventor, who has actually brought it into public though not into general use before the first patent was taken out. (d)

What patentee must prove.

The patentee must prove to the satisfaction of the Judicial Committee that he believed himself to be the first and original inventor at the time that he took out his patent, (e) and also that at that time the patent was not publicly and generally used. (f)

(a) *Stead's Patent*, 2 Webs. P. R. 146.

(b) *Westrupp and Gibbins' Patent*, 1 Webs. P. R. 555; *Stead's Patent*, 2 Webs. P. R. 146.

(c) *Card's Patent*, 6 Moo. P. C. C. 213.

(d) *Honiball's Patent*, 9 Moo. P. C. C. 378.

(e) *Card's Patent*, 6 Moo. P. C. C. 213; *Honiball's Patent*, 9 Moo. P. C. C. 378; *Stead's Patent*, 2 Webs. P. R. 146.

(f) *Honiball's Patent*, 9 Moo.

In *Heurteloupe's Patent* (a) it was discovered that a patent had been granted in France to one L. de Valdahon, for an invention, part of which was similar to the petitioner's invention, but it had never been known in England, otherwise than by a description in a book published in France, a copy of which was in the British Museum. Notice of the day of hearing was directed to be given to L. de Valdahon, and on an affidavit that such notice had been sent through the Post Office, directed to Paris, confirmation was recommended.

A person who desires to have his patent confirmed ought not, before his petition is heard, to bring an action for infringement, as the two proceedings are contradictory: the one admits the invalidity of the patent, the other seeks relief because a valid patent is infringed. (b)

An action for infringement not sustainable before petition heard.

When it was proved that the invention for which the patent had been granted had been known before the date of the letters patent, and was being used at the time when the application for confirmation was made, Lord Campbell said, that the case which the legislature had in view when this enactment was passed was, that where there had been an invention which had been actually practised but which had not continued to be practised, the patent should not be rendered invalid by those abortive attempts, but that where the invention was carried on before the patent was granted, was considered beneficial by those who carried it on, was proved to be beneficial by them had never been abandoned and was carried on by them down to the time when the application was made, the Act

Invention must have been abandoned.

P. C. C. 378; *Lamenaude's Patent*, 2 Webs. P. R. 171; *Stead's Patent*, 2 Webs. P. R. 146.

(a) 1 Webs. P. R. 553.

(b) *Stead's Patent*, 2 Webs. P. R. 147.

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was never intended to apply; and the application was refused. (a)

Confirmation not granted adversely to rights of former patentee.

Where an application was made by an assignee to confirm letters patent for "improvements in an apparatus for converting sea water or otherwise impure water into fresh and pure water" and it was stated in the petition that it had been discovered since the date of the assignment that one of the modes of condensing steam from sea water was known but not publicly or generally known or used, and the affidavit in support of the petition stated that the patentees believed that they were the true and first inventors, the application was opposed on the ground that part of the invention had been published many years before the patent in a well-known book and had also been the subject of a patent. Two specifications were produced in support of this allegation. It was also contended that the petitioner ought to have disclaimed that part of the invention which was old. Lord Lyndhurst said that he did not think that the Act was ever intended to apply to the case where the patentees chose to shut their eyes when they might have gone to the office and seen the specifications. That the Act could never be meant to apply to a case where two patents had been taken out for the same thing, the subsequent patentee should have a right to come to the court to apply to have the exclusive benefit of the invention adversely to the rights and interests of the former patentee; and the petition was dismissed with costs. (b)

Extended term may be confirmed.

As the grant of an extended term is a new grant by

(a) *Card's Patent*, 6 Moo. P. C. C. 206; *Lamenaude's Patent*, 2 Webs. P. R. 171; *Honiball's Patent*, 9 Moo. P. C. C. 378. (b) *Westrupp and Gibbins' Patent*, 1 Webs. P. R. 554.

new letters patent, subject to the same conditions and open to the same objections as the original letters patent, it is entitled, in ordinary cases at least, to the same advantages as the original letters patent and may therefore be confirmed. (a)

The user in England of an invention prior to the date of a Scotch patent will invalidate the patent, and such a patent cannot be confirmed. (b)

The mode of procedure on a petition for confirmation of letters patent is similar to that on a petition for extension. (c) The petition must be directed to Her Majesty in Council, and must state the patent, the specification, and if the applicant is an assignee, the assignment under which he derives his title. (d) If the name of the first inventor is known it should be stated in the petition and he should be served with notice in order that he may appear to oppose if he thinks fit. (e) The petition must state all the facts on which the plaintiff relies, and must be verified by affidavit.

In *Stead's Patent* (f) two petitions had been presented, the second being supplementary to and stating what had taken place subsequent to the presentation of the first. The affidavits made by the petitioner in support of the first petition gave a general history of his invention of the communication from abroad on which it was founded, and of his attempts to introduce it into use in this country; and those in support of the second petition stated pro-

(a) *Honiball's Patent*, 9 Moo. P. C. C. 387.

(b) *Robinson's Patent*, 5 Moo. P. C. C. 65; S. C. nom. *Pow's Patent*, 2 Webs. P. R. 5.

(c) See *ante*, p. 213.

(d) *Westrupp and Gibbins' Patent*, 1 Webs. P. R. 544.

(e) *Lamenaude's Patent*, 2 Webs. P. R. 164.

(f) 2 Webs. P. R. 143.

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ceedings at law which had taken place since the presentation of the first petition, the publications adduced at the trial as impeaching the novelty of the invention and the petitioner's title. It was objected that the affidavits could not be received as proof of the matters contained in them, the intention being that they should be received in addition to other evidence, because the applicant having made a good case might be the only person who knew the real case; but it was held that the affidavits were admissible and that the opposers might prove their case by other evidence.

CHAPTER X.

OF ASSIGNMENTS AND LICENCES.

LETTERS patent are granted to the patentee, his executors, administrators and assigns; there is therefore an implied power of assignment. The letters patent usually contain a clause restricting all persons from making, or using, or vending the patented invention, without the consent, licence, or agreement in writing of the inventor, his executors, administrators or assigns, under his or their hands and seals, first had and obtained in that behalf.

By 15 & 16 Vict. c. 83, s. 35, it is provided that the grantee or grantees of letters patent may assign the letters patent for England, Scotland, or Ireland respectively, as effectually as if the letters patent had been originally granted to extend to England or Scotland or Ireland only, and that the assignee or assignees shall have the same rights of action and remedies, and shall be subject to the like actions and suits, as he or they should and would have had, and been subject to, upon the assignment of letters patent granted to England, Scotland or Ireland, before the passing of the Act.

More than twelve persons may have a legal and beneficial interest in letters patent. (a)

The mere fact that a patent has been taken out by Partnership.

(a) 15 & 16 Vict. c. 83, s. 36.

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Power to
assign and
grant licences
given by the
letters patent.

several persons jointly will not of itself constitute a partnership. Any one of the grantees may use the invention without the consent of the others, and cannot be compelled to become jointly concerned in the working of the patent, and the profit or loss arising therefrom, nor to concur with his co-proprietors in granting licences to others to use it. But if the co-proprietors agree to work the patent together jointly, the relation of partners may be created.

An agreement to advance a sum of money for the purposes of the invention will not constitute a partnership. In *Elgie v. Webster*,^(a) the plaintiff by an agreement in writing agreed to lend the defendant (an inventor), a sum of money, in order to enable him to perfect his invention, and it was also agreed that if the invention was accomplished, and became of public or private use, the defendant should be entitled to one-third part or share of the same, and of all benefit and advantage, and emoluments to arise or be made therefrom, both for public or private use. The agreement contained an express promise on behalf of the defendant to repay the sum of money advanced by the plaintiff. It was objected on behalf of the defendant that the effect of the agreement was to constitute a partnership between the contracting parties, and to prevent their suing each other in respect of the matters contained in the agreement, but it was held in an action brought to recover the money thus advanced, that this agreement did not constitute a partnership between the parties.

There may be a partnership for working a particular patent,^(b) or for working it in a particular place.^(c)

^(a) 5 M. & W. 518.

^(c) *Ridgway v. Phillip*, 1 C.

^(b) *Lovell v. Hicks*, 2 Y. & C. M. & R. 415.

An admission by any person that he is a partner is evidence against him, but is not conclusive, and he may show that he has only a limited interest. Thus where A, a patentee, informed B, who had entered into a contract with him, that C was his partner, which C admitted; on an action by B against A and C for breach of the contract, C was allowed to prove his limited interest. Parke, B., said: "It frequently happens in cases where the liability of persons as partners comes in question, that juries are induced to give too much effect to slight evidence of admissions. An admission does not estop the party who makes it; he is still at liberty, so far as regards his own interest, to contradict it by evidence. (a) It appears that joint owners of a patent are answerable for losses occasioned by their co-adventurers only to the extent of their respective shares. (b)

A declaration stated that a petition had been presented by the plaintiffs at the request of the defendants, and at their own expense, for the granting to the defendant of a patent; and that the plaintiffs then duly filed at their own expense the provisional specification, and obtained provisional protection, upon condition that the defendant should complete the specification within six months. And that by an agreement in writing made between the plaintiffs and defendants, it was mutually agreed that the defendant should sell to the plaintiffs his patent rights for the sum of £5, such sum to be paid by the plaintiffs to the defendant on their having completed the patent at their own expense; that thereupon it became necessary in order to enable the plaintiffs to complete the patent

Agreement for
assignment.

(a) *Ridgway v. Phillip*, 1 C. M. & R. 415.

(b) *Lovell v. Hicks*, 2 Y. & C. 46.

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in pursuance of the agreement, that the defendant should sign and seal a complete specification; and that the plaintiffs tendered him the necessary specification for his signature. Breach that he would not sign it. It was held that the defendant was bound under this agreement to sign the specification. (a)

Statute of
Frauds.

A written proposal containing the terms of a proposed contract signed by the defendant and assented to by the plaintiff by word of mouth, is a sufficient agreement within the 4th section of the Statute of Frauds. (b)

An agreement, whereby all that is to be done by the plaintiff constituting one entire concession for the defendant's promise, can be performed within a year, and no part is intended to be postponed until after the expiration of the year, is not within the section, although the performance on the part of the defendant is or may be extended beyond that period. (c)

Assignment
should be by
deed.

An assignment ought to be by deed under hand and seal. The patentee should covenant that he is the true and first inventor, and that the patent is valid. He should also covenant that he will assist the assignee in the case of an application for confirmation.

A grant of a patent, reserving the patentee's legal title until the determination of a suit then pending, with a covenant that the grantor would upon the determination of the suit assign the patent, was held to vest the legal estate in the patentee without assignment as soon as the suit was determined. (d)

Must be ac-
cording to
conditions of
patent.

Any agreement to assign a patent which is contrary to

(a) *Lewin v. Brown*, 14 W. R.
640.

(c) *Ib.*

(b) *Smith v. Neale*, 2 C. B. & P. 43.
(N. S.) 67.

(d) *Cartwright v. Amatt*, 2 B.

the policy of the conditions upon which the patent is granted, is void. Thus where a bond was given for payment of £10,000 with a condition that the money should be paid on the obligee's procuring subscriptions for 9,000 shares in a company for the purpose of becoming assignees of a patent and carrying on the patent process; and the patent contained a proviso that it should be void if assigned to more than five persons, it was held that as the bond was subject to a condition for the performance of an illegal act, it was void. Lord Tenterden, C. J., said: "Now it is said that the plaintiff might be ignorant that such a consequence would follow: but on this record we cannot find grounds for supposing he was ignorant. If he was not cognisant of the terms of these particular patents, he must be supposed to know the general law of the land. By that all monopolies are illegal, but there is an exception in favour of patent rights, and if he knew that the monopoly proposed to be created could only be justified by the patents, he was bound to know their contents. We cannot presume that he was ignorant of that which it was his duty to know, and presuming that he knew the terms of the patent, the bond is void." (a)

The interest of a bankrupt in a patent passes to his assignees. (b) Where by a private act of parliament, the sole making of a newly-invented machine was vested in certain persons, with a proviso that it should be forfeited in case it should "become vested in trust for more than five persons or their representatives, otherwise than by devise or succession," and two of the patentees became bankrupt, it was held that the assignment of their in-

Bankruptcy of
patentee.

(a) *Duvergier v. Fellows*, 10
B. & C. 829.

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

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terest to their assignees, though the number exceeded twenty, was not within the proviso. (a)

Tenants in common or joint tenants.

It seems doubtful whether when a patent is vested in trustees upon trust for several tenants in common, or joint tenants, any one of them is at liberty to work it on his own account. (b) But where two or more persons jointly obtain letters patent, any one of them may use the invention without the consent of the others. (c)

Licence may be by verbal agreement.

A verbal agreement that a patentee shall supply machines constructed according to his patent to any person constitutes a licence. (d)

Need not be under seal.

A licence will not apparently be void if it is not under seal, so long as it is such a licence as the licensee has bargained for, and he has kept it, (e) and *semble* that a licence does not require a stamp if there is no pecuniary consideration. (f)

Includes all the privileges of a vendee.

A licence to manufacture and sell necessarily includes all the privileges that a vendee can have, including that of selling again without the consent of the patentee. (g) It does not convey an interest in the patent, it is an excuse for an infringement. (h)

In *Lister v. Leather* (i) it was argued that if a subsequent patent for a combination includes a part of an invention already protected by patent, it infringes on the

(a) *Bloxam v. Elsee*, 6 B. & C. 169; *M'Alpine v. Mangnall*, 3 C. B. 491.

(b) *Hancock v. Bewley*, Johns. 601.

(c) *Mathers v. Green*, L. R. 1 Ch. 29. See too *Re Russell*, 2 De G. & J. 130.

(d) *Crossley v. Dixon*, 10 H. L. C. 293.

(e) *Chanter v. Dewhurst*, 12 M. & W. 823.

(f) *Chanter v. Johnson*, 14 M. & W. 408.

(g) *Thomas v. Hunt*, 17 C. B. (N. S.) 183.

(h) *Bower v. Hodges*, 13 C. B. 774.

(i) 8 El. & Bl. 1017.

property of another, and so is a violation of his right, and ought to be held illegal on account of his interest. Lord Campbell said that the answer was, "that the patent for an improvement on an invention already the subject of a patent, if confined to the improvement, is not an infringement of the former patent. The use of the improvement with the former invention, during the existence of the former patent, would be an infringement, but with licence that would be lawful." (a)

The grant of an exclusive licence does not invalidate the patent itself, although the patent may be vested in twelve persons; and it is wholly immaterial to its validity in what number of persons such a licence is vested, whether exclusive or not, and such a licence would not be invalid, if the districts or district covered by the licence included the whole extent of the patent. (b)

Where the patentee has a manufactory abroad as well as one in England, and disposes of the patented article abroad, he necessarily transfers with the goods the licence to use them wherever the purchaser pleases, unless there is some clear agreement to the contrary. But if he has assigned his patent in either country, he cannot sell the articles so as to defeat the rights of the assignees. (c)

There is no implied warranty upon an agreement for the sale of or licence to use a patent, that the patent is valid, and it is no answer to an action that the invention is not new, and that the plaintiff is not the true and first inventor.

In *Hall v. Conder* (d) the declaration stated, that by an agreement, made between the plaintiff and the defendants,

(a) See p. 53.

(b) *Protheroe v. May*, 5 M. & W. 675.

(c) *Betts v. Willmott*, L. R. 6

Ch. 239.

(d) 2 C. B. (N. S.) 22.

Exclusive licence.

Manufactory abroad.

No implied warranty on sale or licence.

after reciting that the plaintiff had invented a method for the prevention of boiler explosions, and had obtained a patent for the use of the same within the United Kingdom, and was desirous of taking out patents in France, Belgium, and such other places as might be found expedient; and that he had already parted with or assigned away an interest in one-half of the said English patent, and was desirous of disposing of the remaining half, to which he declared he had full right and title; and that he had applied to the defendants to assist him in taking out the foreign patents, and also to purchase his interest in the English patent; it was agreed that the defendants should take out the foreign patent, and should pay to the plaintiff the sum of £2,500 in such manner as should be mutually agreed upon, and a further sum equal to one tenth part of the net proceeds of one-half of the English patent, from and after the time that the net profits should amount to the sum of £20,000. And in consideration of the engagement on the part of the defendants, the plaintiff agreed to transfer to them one-half of the foreign patents when the same should be obtained, and also one-half of the English patent.

It was contended, among other things, that the invention was wholly worthless and of no public utility and was not new as to the public use and exercise thereof in England, and that the plaintiff was not the true and first inventor. Williams, J., said: "With regard to the sale of ascertained chattels, it has been held that there is not any implied warranty of either title or quality unless there are some circumstances beyond the mere fact of a sale from which it may be implied. . . . In this case the thing sold was ascertained, viz. a moiety of a patent granted by

Her Majesty; there was no express warranty, and whether it be said that the question raised on this plea impeaches the plaintiff's title to the thing sold, or its quality, no warranty can be implied. But did the plaintiff profess to sell and the defendant to buy a good and indefeasible patent right? or was the contract merely to place the defendant in the same situation as the plaintiff was in with reference to the alleged patent? . . . The plaintiff professed to have invented a method for the prevention of boiler explosions. It is not alleged that he was guilty of any fraud. He must therefore have been an inventor; for, if he was not he must have known it, and would have been guilty of fraud in pretending to have invented. Whether he was the true and first inventor within the meaning of the statute of James is another question. The first material allegation in the plea is that the alleged invention was wholly worthless and of no utility to the public. Now, that was a matter as much within the knowledge of the defendants as of the plaintiff. The next allegation, viz. that it was not new as to the public use thereof in England, and that the plaintiff was not the true and first inventor, was also a matter as much within the knowledge of the defendants as of the plaintiff. They had the same means of inquiring into the fact and of learning whether it had been in use or the invention had been previously made known in England. Why, therefore, should we assume that the plaintiff meant to assert that the patent was indefeasible and that the defendants purchased on that understanding rather than that, each knowing what the invention was, and having equal means of ascertaining its value, they contracted for the patent, such as it was, each acting on his own judgment?

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We think that the latter was the true nature of the contract and that there was no warranty, express or implied." (a)

Failure of consideration.

The payment of a sum of money for a continuation of a licence to use a patent about to expire, on prolongation of the term being obtained, gives the licensee a right to require an application for prolongation of the patent to be made, not merely to have the benefit of the prolongation if it is granted, and the licensee, if no application is made, will be entitled to maintain an action for the recovery of the money so paid, on the ground that the consideration has wholly failed. (b)

Money paid for use of void patent cannot be recovered.

A licensee cannot, if he discovers that the patent is void, recover back money paid for its use. Thus, where a licence was granted in consideration of an annuity secured by bond, which was paid for several years, and it was then discovered that the invention had been in public use before the patent, unknown to the patentee when he granted the licence, it was held that the licensee could not recover back the money he had paid on account of the annuity. Sir J. Mansfield, C. J., said: "Two persons equally innocent make a bargain about the use of a patent, the defendant supposing himself to be in possession of a valuable patent right and the plaintiff supposing the same thing. Under these circumstances the latter agrees to pay the former for the use of the invention, and he has the use of it; *non constat*, what advantage he made of it; for anything that appears he may have made considerable profit. These persons may be considered

(a) See also *Smith v. Neale*, 2 C. B. (N. S.) 67; *Smith v. Trotman v. Wood*, 16 C. B. (N. S.) 479; *Scott*, 6 C. B. (N. S.) 771; (b) *Knowles v. Borill*, 22 L. *Noton v. Brooks*, 7 H. & N. 499; T. (N. S.) 70.

in some measure as partners in the benefit of this invention;" and Heath, J., said: "We cannot take an account here of the profits. It might as well be said, that if a man lease land and the lessee pay rent, and afterwards be evicted, that he shall recover back the rent, though he has taken the fruits of the land." (a) But if money is paid for the use or purchase of a patent which has been obtained by fraud it can be recovered." (b)

Unless there is fraud.

A patentee, after he has parted with his interest in the patent is estopped from contesting its validity and cannot contend that he had no title to convey. (c) Nor can a licensee by deed refuse to pay royalties or contend that the patent is invalid on the ground of want of novelty or utility in the invention; for the principle of estoppel is that where a man has entered into a solemn engagement by deed, under his hand and seal, as to certain facts, he shall not be permitted to deny any matter which he has so asserted, (d) even if the patent has been found invalid at law upon proceedings between the patentee and third parties, (e) and the principle applies even if no formal licence has been executed, but royalties have been paid. (f) But he may refuse to continue the use of the patent and

Estoppel.

(a) *Taylor v. Hare*, 1 Bos. & C. & F. 726; *Hills v. Laming*, 2 P. (N. R.) 260. Exch. 256; *Noton v. Brooks*,

(b) *Lovell v. Hicks*, 2 Y. & 7 H. & N. 499; *Smith v. Coll. 46. Scott*, 6 C. B. (N. S.) 771;

(c) *Oldham v. Langmead*, 3 T. R. 441; *Hall v. Conder*, 2 C. B. (N. S.) 22; *Walton v. Lawes v. Purser*, 6 E. & B. 930; *Besseman v. Wright*, 6 W. R. 719.

(d) *Lavater*, 8 C. B. (N. S.) 162; *Chambers v. Crichley*, 33 Beav. 374. (e) *Grover and Baker Sewing Machine Co. v. Millard*, 8 Jur. (N. S.) 713.

(f) *Bowman v. Taylor*, 2 A. & E. 291; *Baird v. Neilson*, 8 L. C. 293. (f) *Crossley v. Dixon*, 10 H.

to make any future payments ; (a) and after the licence has determined he may contest the validity of the patent. (b) A purchaser or licensee may set up the defence that the patent is bad on the ground that it was obtained by fraud. (c)

If the claim in the specification is susceptible of two constructions, one of which would make the specification bad, and the other would make it good, a licensee may insist that the latter is the true construction. (d) If he use the patented invention in other machines obtained from another quarter, he cannot contest the validity of the patent, but only that the other machines did not embody its principle. (e)

Where in an action for infringement against the members of a partnership firm, the defendants submitted to judgment before any pleadings filed and immediately took a licence from the plaintiff to use his invention for a term of five years ; in a suit in equity to restrain the original defendants and two new partners from infringing the patent ; it was held that they were not estopped from contesting the validity of the patent. (f) An agreement to purchase a licence to use a patent will not in equity preclude the purchaser from disputing its validity. (g)

(a) *Hayne v. Maltby*, 3 T. R. 438 ; *Neilson v. Fothergill*, 1 Webs. P. R. 287 ; *Pidding v. Franks*, 1 Mac. & G. 56.

(b) *Dangerfield v. Jones*, 13 L. T. (N. S.) 144.

(c) *Hayne v. Maltby*, 3 T. R. 441 ; *Hall v. Conder*, 2 C. B. (N. S.) 22 ; *Lawes v. Purser*, 6 E. & B. 930 ; *Pidding v. Franks*, 1 Mac. & G. 56.

(d) *Trotman v. Wood*, 16 C. B. (N. S.) 479.

(e) *Crossley v. Dixon*, 10 H. L. C. 293.

(f) *Goucher v. Clayton*, 11 Jur. (N. S.) 107.

(g) *Baxter v. Combe*, 1 Ir. Ch. 284 ; *Pidding v. Franks*, 1 Mac. & G. 56.

If a licensor waives any right to forfeit the licence by reason of breaches in the terms, he will not be entitled to an injunction to restrain the licensee from using the patent. (a) A covenant by the licensee of a patent for the residue of the term, that he will not make or use any of a certain class of machines without the patented invention applied to them is not void as a covenant in restraint of trade, for the restraint is not greater than the privilege. (b)

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 Waiver by licensor.
 Covenant to use patented invention only.

The sale of a moiety of a patent right conveys an interest *pro tanto* in the patent. (c)

Sale of moiety.

(a) *Warwick v. Hooper*, 3 Mac. & G. 60.

(c) *Walton v. Lavater*, 8 C. B. (N. S.) 162.

(b) *Jones v. Lees*, 1 H. & N. 189.

CHAPTER XI.

OF REGISTRATION.

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Register of
proprietors
kept at office.

A REGISTER of proprietors of patents is kept at the office, in which is entered assignments of letters patent, licences and other matters affecting their proprietorship, certified copies of entries are received in evidence, and are *primâ facie* proofs of assignment. But until such entry as is directed by the Act is made, the grantee is deemed to be the exclusive proprietor of the letters patent, and of all licences and privileges connected with them. (*a*)

Registration
relates back to
day of assign-
ment.

The registration relates back to the day of assignment so as to enable an assignee to maintain an action for an infringement committed between the date of the assignment and of the registration, (*b*) and an assignee who has not registered his deed of assignment cannot maintain an action, (*c*) but where there has been a *bonâ fide* assignment and the assignee has neglected to register, a subsequent assignee cannot, by prior registration, defeat the rights of the first assignee. (*d*)

Fraudulent
entry in re-
gister.

Any person who wilfully causes a false entry to be made in the register, or who wilfully forges or causes to

(*a*) 15 & 16 Viet. c. 83, s. 35.

(*b*) *Hassall v. Wright*, 10 Eq.
509.

(*c*) *Chollett v. Hoffman*, 7 El.
& Bl. 686.

(*d*) *Green's Patent*, 24 Beav.
145.

be forged any copy of any entry, or produces or tenders any such copy in evidence knowing it to be forged, is guilty of a misdemeanour. (a)

Any person aggrieved by any entry in the register of proprietors may apply by motion to the Master of the Rolls or to any of the Courts of Common Law for an order to expunge, vacate, or vary such entry. (b)

Expunging
entries.

The Court has power to expunge any entry fraudulently made, while the right in the patent is in another person, and can direct any facts relating to the proprietorship to be placed on the register, it will not decide questions of rights and titles; those must be deduced from the facts that appear on the register by any person dealing with the patent. Thus when A assigned one-half of his patent to B on the 13th of January, 1851, but B did not register the assignment till the 5th of August, 1857, and in the mean time A assigned the whole of his patent to C by a deed registered the 21st of June, 1853, which by recital excepted a licence to work and use granted to B, it was held that C had constructive notice of B's rights, and an entry was ordered to be made in the register that the licence referred to in C's assignment was the deed of assignment to B subsequently registered. (c)

Where letters patent are granted to two persons jointly neither of them is entitled to cause any entry to be made in the register which purports to affect or prejudice the rights of the other. Thus where one of two joint grantees assigned his share in the patent by deed and purported to release the assignee from all claims by either of the patentees in respect of the patent, and this

Joint
grantees may
not prejudice
each others'
rights by
entries.

(a) 15 & 16 Viet. c. 83, s. 37.

(b) *Ib.*

(c) *Morey's Patent*, 25 Beav. 581. And see *Green's Patent*, 24 Beav. 145.

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deed was entered on the register *verbatim*; it was held that the non-assigning patentee was entitled to have the whole entry expunged. (a)

No appeal
from Master
of the Rolls.

There is no right of appeal from an order made by the Master of the Rolls under this section. (b)

Copies of
entries.

Certified copies of all entries made in the register of proprietors are sent to Edinburgh and Dublin. (c)

(a) *Horsley and Knighton's
Patent*, L. R. 8 Eq. 475.

(b) *Horsley and Knighton's
Patent*, L. R. 4 Ch. 784.

(c) 15 & 16 Vict. c. 83, s. 35.

CHAPTER XII.

OF INFRINGEMENT.

ANY person who directly or indirectly uses a patentee's invention for the purposes of profit without his licence is guilty of an act of infringement. An infringement, said Sir N. C. Tindal, C.J., is a copy made after and agreeing with the principle laid down in the specification. (a)

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Use of invention for profit is infringement.

A slight departure from the patentee's specification for the purpose of evasion only is of course a fraud upon the patent, and the question, therefore, that always arises, is, whether the mode of working by the person who is alleged to have committed the act of infringement has or has not been essentially or substantially different, (b) that is to say whether, in the case of a machine, the two inventions are the same or substantially the same mode of carrying the principle into effect, or accomplishing the object desired. In *Bovill v. Pimm* (c) the plaintiff's invention consisted in the application of ventilating vanes or screws at the centre of the stones for supplying the air between the grinding surfaces; a portable ventilating machine, blowing by a screw vane, which caused a current

Colourable difference only will be infringement.

(a) *Galloway v. Bleaden*, 1 R. 242; *Stead v. Anderson*, 1 Webs. P. R. 523. Webs. P. R. 155.

(b) *Hill v. Thompson*, 8 Taunt. 491; 2 B. Moo. 433; 1 Webs. P. (c) 11 Exch. 739.

of air parallel to the axis of the vane was attached externally to the eye of the upper millstone, and thus the screw vane being set in rapid motion, the air was compelled to pass through the eye into the centre of the stones and so find its way out again; the defendant distributed the air from the eye of the mill-stones, by means of an air box placed below them into which air was forced by the rapid rotation of a fan or blower which caused a current of air perpendicular to the axis of the fan; and the air was conducted by a pipe through the eye of the lower stone to the centre of the two stones and there distributed between them. It was held that the invention was no infringement of the plaintiff's; but that each was a new method of obtaining a well-known object by the common principle of obtaining a current of air by a rotating vane.

In *Walton v. Bateman*, (a) Cresswell, J., said that the "defendants are not to resemble a counterfeit; they are not to make any addition to or any subtraction from the patent, availing themselves of what is in truth the subject-matter of it, so as by such alteration to pretend that they are the true inventors of that article."

Substance of
invention to be
considered.

The substance and not the mere form of the invention is to be considered. (b)

In *Walton v. Potter* (c) Sir N. C. Tindal, C.J., said: "Where a party has obtained a patent for a new invention or a discovery he has made by his own ingenuity, it is not in the power of any other person simply by varying in form or in immaterial circumstances the nature or subject-matter of that discovery to obtain either a patent for it his self or to use it without the leave of the patentee,

(a) 1 Webs. P. R. 616.

(c) 1 Webs. P. R. 586.

(b) *Morgan v. Seaward*, 1
Webs. P. R. 171.

because that would be in effect and in substance an invasion of the right, and therefore what you have to look at upon the present occasion, is not simply whether in form or in circumstances that may be more or less immaterial, that which has been done by the defendants varies from the specification of the plaintiff's patent, but to see whether in reality, in substance, and in effect, the defendants have availed themselves of the plaintiff's invention in order to make that article which they have sold in the way of their trade; whether in order to make that they have availed themselves of the invention of the plaintiff." (a)

Where the patent is for an invention which consists in the use of certain proportions, the patentee is not bound to limit his claim to the precise proportions, and even if he does do so, a stranger will not be allowed to evade the patent by slightly varying the amounts used. (b)

It is no answer to an action for the infringement of a patent that the defendants have greatly improved upon the machinery or apparatus constructed according to the plaintiff's specification. Thus where the plaintiff's patent was for the "improved application of air to produce heat in fires, forges and furnaces," and the invention consisted in heating the air between the time of its leaving the blowing apparatus and its introduction into the furnace in any way in any close vessel exposed to the action of heat, and it was proved that the defendants' apparatus was much superior to that of the plaintiff's but that the principle in both was the same, Parke, B., said: "If the specification is to be understood in the sense

Improvements
by defendant
no answer.

(a) See also *Bateman v. Gray*,
Macr. 102.

(b) *The Patent Type Founding
Co. v. Richard*, Johns. 385.

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claimed by the plaintiff, the invention of heating the air between its leaving the blowing apparatus and its introduction into the furnace, in any way, in any close vessel, which is exposed to the action of heat, there is no doubt that the defendants' machinery is an infringement of that patent, because it is the use of air which is heated much more beneficially, and a great improvement upon what would probably be the machine constructed by looking at the specification alone; but still it is the application of heated air, heated in one or more vessels between the blowing apparatus and the furnace, and therefore if it should turn out that the patent is good, and the specification is good, though unquestionably what the defendants have done is a great improvement upon what would be the machinery or apparatus constructed under this patent, it appears to me that it would be an infringement of it." (a)

In *The Electric Telegraph Co. v. Brett* (b) the patentee's invention was described as an invention of "improvements in giving signals and sounding alarms in distant places, by means of electric currents transmitted through metallic circuits." The defendant used the earth as a return circuit by plunging the two ends of the wire into it, and it was held that such a circuit, if used in connection with the machinery for signals, would be an infringement, as the use of the earth was merely an equivalent for the return wire.

The substitution of a mechanical equivalent to attain the same result is an infringement.

Any person who in order to arrive at the same result aimed at by the plaintiff's patent substitutes for any portion of the patented invention which is new and

(a) *Neilson v. Harford*, 1 Webs. P. R. 310. (b) 10 C. B. 838.

useful, some mechanical equivalent, so that his machine is only colourably different from that of the patentee, is guilty of an act of infringement. (a)

In *Webster v. Uther* (b) the invention consisted in an improvement on the patent percussion gunlock, by the addition of a bolt sliding or moving in a groove by which the roller magazine was then fixed, that had formerly been fastened by a screw and washer; the defendant's lock had a spring in the bolt, and the jury, upon the evidence of mechanics that a spring in a bolt was the same thing as a bolt sliding in a groove, found that there had been an infringement.

In *Bovill v. Moore*, (c) Gibbs, C. J., said, referring to the use of mechanical equivalents: "I remember that was the expedient used by a man in Cornwall, who endeavoured to pirate the steam engine. He produced an engine, which, on the first view of it, had not the least resemblance to Boulton and Watt's. Where you looked for the head you found the feet, and where you looked for the feet you found the head. But it turned out that he had taken the principle of Boulton and Watt—it acted as well one way as the other; but if you set it upright, it was exactly Boulton and Watt's engine."

"If," said Sir F. Pollock in *Sellers v. Dickinson*, (d) "a portion of a patent for a new arrangement of machinery is in itself new and useful, and another person, for the purpose of producing the same effect, uses that portion of the arrangement, and substitutes for the other matters combined with it another mechanical equivalent, that would be an infringement of the patent." (e) But the

(a) *Morgan v. Seaward*, 1
Webs. P. R. 171.

(b) *Gods*. 232.

(c) *Dav. P. C.* 405.

(d) 5 *Exch.* 326.

(e) And see *Harwood v. The*

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principle which protects a patentee against the use by others of mechanical equivalents is inapplicable to a case where the whole invention depends entirely on the particular machinery, by means of which a well known object is attained. (a)

Or chemical equivalent.

The substitution of a chemical equivalent in a process is an infringement. It is very difficult, however, to apply the doctrine of equivalents to a chemical process. In the case of mechanical equivalents, the result can be generally predicted with certainty; whereas, in the case of chemical equivalents, that is not so, and there may be such an amount of experiment required as to constitute a new discovery.

Although exactly the same materials may not be used in a similar process; yet if the same result is arrived at by the introduction of some step into the process, which is not absolutely necessary, and which is merely introduced for the purpose of evasion, this will be an infringement. Thus, where the plaintiff's invention consisted in making metal plates for sheathing the bottoms of ships, of an alloy of zinc and copper in certain proportions, and the specification stated that the invention was to be performed by melting "best selected copper" and "foreign zinc" together in certain proportions, and it was proved that the metal made at the defendant's works was, in fact, made of the same materials and in the same proportions as pointed out in the plaintiff's specification, Lord Lyndhurst said, that if the materials were originally combined in the same proportions, the infringement was clear; and that if other materials were purified in the

Great Northern Railway Co., (a) *Curtis v. Platt*, 35 L. J. L. R. 11 H. L. C. 654; *Bateman v. Gray*, Macr. 102. (Ch.) 852.

course of manufacture, there would be a colourable imitation. (a)

An action was directed to be tried at law, to decide the title to the patent, when Sir N. C. Tindal, C. J., said: "Further, the plaintiff says (and that evidence is before you), that in the month of April, and when the mode of making it and the materials of which it was made were somewhat altered, that is, when, according to the testimony of defendant's witnesses, they used nothing but cake copper, and not the purest copper obtained from the regule of the copper, as the witnesses have stated, yet still it would be for you to say whether, if the very same effect and result is produced, it could have been produced in any other way than by some mode of altering the properties of the common cake copper; because there has been evidence brought before you that the cake copper would not produce the result, and be attended with those properties which the plaintiff has taken out his patent for; and, therefore, upon that second branch you will have to ask yourselves whether, seeing that which has been used, and the analysis of it, and the result of such analysis, and the mode in which the witnesses on the part of the defendants explained that it was carried on, stating certainly that nothing was used but the cake copper for that purpose; whether in the mode of using that cake copper, which before did not produce the result of the plaintiff's discovery, something or other must not have been managed or contrived on the part of the defendants to give it that purity which, if you are satisfied upon the evidence, it did not possess, it must have had through their instrumentality. If it

(a) *Murtz v. Foster*, 2 Webs. P. R. 93.

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were so, that would be a contrivance, and an evasion of the direct letter and description of the patent. Although the patent describes the copper must be of the purest quality (and that seems to me to be the sense of the specification), yet, if persons could take an inferior kind of copper, and by dressing it up, and by some particular way of melting and refining it give it exactly the same effect as the best kind of copper would have done, it must be for you to say whether in that case they intended to imitate (as one branch of the declaration states they did) and to evade the patent which the other party had granted to him.” (a)

In *Stevens v. Keating*, (b) the plaintiff claimed the manufacture of cement, or a composition equivalent to cement, by the union of gypsum, acid and alkali. The defendant claimed the manufacture of cement by combining gypsum, sulphate of lime, or other calcareous substances, with borax. On an application for an injunction Lord Cottenham said: “*Primâ facie* that may appear to be a very different thing, because till you come to examine what borax is, it may appear that borax is some substance totally different, and not within what the plaintiff discovered; that borax is a substance of itself which is capable by combination with gypsum of producing very hard cement; and that the patentee has no right to say, I am entitled to the exclusive privilege, because I claim the invention of uniting gypsum with acid and alkali. But then when we find that borax itself is composed of an acid and an alkali, where is the difference? If borax is an article used in the trade found

(a) *Muntz v. Foster*, 2 Webs. P. R. 101.

(b) 2 Webs. P. R. 176.

in a natural state, but used as an artificial composition, composed and compounded of an alkali and acid, is it not exactly the same thing as if the plaintiff had said, I claim as my invention to be the uniting with gypsum the acid and alkali found in borax? It is hardly a different mode of describing the same thing. He has adopted different language, but if the language conveys the same meaning, it is the same thing." An injunction was granted, the plaintiff being ordered to bring an action, which was tried before Sir F. Pollock, C. B., (*a*) who in summing up said: "The only point I have to leave to you is whether you think the defendant has infringed the first patent of the plaintiff by using boracic acid and soda, that is, in the shape of borax, instead of the pearlash, which is potash and sulphuric acid, the only alkali and only acid mentioned in the specification. . . . It has been said that this borax which the defendant uses is a chemical equivalent. I may say that I do not quite go along with the doctrine of equivalents in chemistry, applied in the same way as in mechanics, and those matters to which you can apply the principles of the exact sciences. If a man discovers a machine that can be successfully used to produce any effect, whether to print a newspaper, to make a stucco, to light an apartment, or to do any process whatever, it is well known that if he uses a crank there are two or three substitutes for a crank; if he use one mode of changing the direction of motion, there are three or four perfectly well known means of doing that; and if he puts in a specification describing his machine, and somebody comes and instead of a crank substitutes something else, or if instead

(*a*) 2 Webs. P. R. 182.

of a pulley to change the motion, he substitutes a wheel or some adaptation of wheels to change the motion, everybody will at once see that to be an evasion of the patent, and for this plain reason, that all these equivalents are perfectly well known; they are just as well known as that 10 added to 6 makes 16, and that 8 added to 8 makes also 16. In the mechanical sciences, or wherever you can apply the exact sciences, you can frequently predict the results without the slightest difficulty, and with the same certainty as that with which a skilful arithmetician can tell you what will be the amount of certain numbers added together, and that a certain other set of numbers apparently differing from them altogether will when added together produce the same result, with precisely the same certainty a skilful mechanic will tell you that such and such a combination will produce a result, and that such and such another combination to the ordinary eye apparently totally different will produce precisely the same result, but looked at with the experienced eye of a mechanic he would say, Yes, here appears to be a great difference; here is a lever instead of an inclined plane, a pulley instead of two wheels to change the motion and so on; but a skilful mechanic will say, the general expression in all these might be put down as exactly the same; so that however different they may appear to the eye, they are to the mind precisely the same.

“ I do not think that doctrine applies altogether to the case of chemistry, because although you can predict with confidence in mechanics in some instances, and in some cases where mathematics can be applied, in chemistry you almost entirely fail. You cannot—because sulphuric acid will succeed—tell at all that nitric acid will succeed, or that any other acid will succeed, until you have tried.

They do not exist in any relation to each other as numbers do, or as mechanical science presents to you the different mechanical powers. You cannot anticipate the result, it is a mere question of result upon experiment. Still, there may be a probable anticipation of a result which may be treated and properly treated by a jury as merely a servile imitation or else a colourable evasion of the patent. That may occur in chemistry; and where one of the witnesses in reference to this case stated that he thought borax was a salt that would most probably suggest itself to anybody as likely to answer where sulphate of potash has succeeded, I must own in the first instance, with the highest respect for the gentleman who was giving that evidence, I heard it with very great surprise; but when explained it was perfectly true, perfectly intelligible. . . . The question was asked, 'If you wish to make a cement similar to the plaintiff's without using sulphuric acid and potash, what would you suggest?' And the answer was, 'I should give the preference to borax.' I could not conceive why sulphuric acid, being a very strong acid, boracic acid a very weak one, and potash and soda being very analogous as the two fixed alkalis, I could not understand why anyone's attention as a chemist would be directed to borax more than any other salt. Then it is explained. He says this, 'Sulphate of potash acts as a flux; borax is a salt that also acts as a flux. This opinion I obtained, for I examined the substance with a microscope, and I observed that particles of the plaintiff's cement presented to the microscope the appearance of having melted. I therefore thought that any salt that would operate as a flux would probably answer better than any other salt, therefore I should have used borax.' But if borax is used merely as a flux, and not

used because it is a mixture of an alkali and an acid, I should say that really has nothing to do with the infringement of the patent, any more than if they had used some totally foreign material that might be suggested, for instance, some of the fifty odd metals that exist; if any one of those should be used as a flux, being neither an acid nor an alkali, he might have used that flux metal and that could not be an infringement of the patent. The use of borax merely as a flux and not as an alkali and acid would probably be considered as no evasion of the patent. . . . Then if sulphate of potash so used (*i. e.* used instead of its ingredients) would be an infringement, would borax, which is the boreate of soda, be an infringement? Why, soda is an alkali, and boracic acid is an acid, and an acid that exists in a separate form; it might be used, it has been used; and the question is, is that within the scope and compass in point of fact of the plaintiff's specification? assuming that the plaintiff claims acids and alkalis beyond those that are specifically named. The true construction in point of law of the specification is in my judgment that he does claim acids and alkalis beyond those he mentions. You will have to say whether in your judgment what the defendant has done has been within the scope of the plaintiff's invention, or whether it is in imitation of it."

The great difficulty that there is in deciding whether a subsequent chemical process does or does not consist in the substitution of a chemical equivalent is well illustrated by the case of *Heath v. Unwin*. (a)

The patent was for "certain improvements in the manufacture of iron and steel." The patentee declared

(a) 22 Webs. P. R. 216; on appeal, 5 H. L. C. 505, *nom. Unwin v. Heath*.

the nature of his invention to be among other things, the use of a certain portion of oxide of manganese in the process of converting cast iron into malleable iron by the process of puddling; and the use of carburet of manganese in any process whereby iron is converted into cast steel. The specification after describing the use of oxide of manganese in the description of another part of the invention, proceeded to describe the part of the process alleged to have been infringed, in these terms: "Lastly, I propose to make an improved quality of cast steel by introducing into a crucible bars of common blistered steel, broken as usual into fragments, or a mixture of cast and malleable iron, or malleable iron and carbonaceous matters, along with from one to three per cent. of their weight of carburet of manganese, and exposing the crucible to the proper heat for melting the materials, but I do not claim the mixture of any such mixture of cast and malleable iron or malleable iron and carbonaceous matter, as any part of my invention, but only the use of carburet of manganese in any process for the conversion of iron into cast steel." Carburet of manganese is formed by the fusion of black oxide of manganese with carbonaceous matter. The defendant never used carburet of manganese by putting any of it into the crucible, but he placed the black oxide and carbonaceous matter together in the crucible, and scientific witnesses gave their opinion, that those two substances would form during the process of conversion, and before actual union with the melted steel, carburet of manganese in a state of fusion. The jury found that supposition to be true, but also found that the quantity of carburet so formed would be less than one per cent. of the weight of steel in the crucible. Upon

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these facts the Court of Exchequer held that there had been no infringement. Parke, B., said, in delivering the judgment of the Court: "In order to decide this (the question of infringement), we must first determine for what invention the patent as explained by the specification is taken out. It is not for the use of oxide of manganese in the melting of cast-steel, for carburet of manganese is expressly mentioned and distinguished from oxide of manganese; nor could the patent for the use of the oxide have been supported, as that substance had been used long before in steel making; nor is it for the use of oxide of manganese in any mode of combination with carbon generally. If it had, it would have been liable to a similar objection, as oxide of manganese had been used in crucibles containing in their construction a quantity of carbonaceous matter, with a portion of which it would necessarily combine during the process; nor is it for the use of the oxide with such a quantity of carbon as would deoxidize it and leave the manganese alone to operate upon the steel, so that neither the quantity of the steel be altered nor the crucible destroyed by the oxide of manganese abstracting, as it otherwise would do, some quantity of carbon from them. The patent is obtained for the use of one particular combination of carbon and manganese, the metallic substance called carburet of manganese, and for the use of it in that state. The specification is expressly for the employment of carburet of manganese, and the mode of using it, is by putting a certain quantity by weight of that substance in an unmelted state into the crucible. This being, in our opinion, the true construction of the specification, it is clear that the defendant has not directly infringed the plaintiff's patent, for he has never used that substance in the mode described in the

specification. Then comes the question whether he has indirectly infringed the patent by imitating and using the same patent substantially, but making a colourable variation; now there is no doubt, we think, if a defendant substitutes for a part of a plaintiff's invention some well-known equivalent, whether chemical or mechanical, he would probably be considered as only making a colourable variation. But here he has not done so. It is quite clear upon the evidence that the defendant never meant to use the carburet of manganese at all; he certainly never knew—and there is no reason to suppose that prior to this investigation any one else knew—that the substance would be formed in a state of fusion; and it is a mere matter of speculative opinion (though after the verdict we must assume it to be a correct opinion among men of science) that it would, but it was clearly not ascertained and still less was it a well-known fact. There was, therefore, no intention to imitate the patented invention, and we do not think the defendant can be considered to be guilty of any indirect infringement if he did not intend to imitate at all.”

Two years after this case the case of *Stevens v. Keating* (a) was decided, and as the doctrine of intention was there dissented from, (b) another action was brought by Mr. Heath in the Court of Common Pleas. (c) Sir C. Cresswell considered that he was bound by the decision of the Court of Exchequer and directed a verdict for the defendant on the issue of not guilty, saying: “My ruling is simply this, that the use of the ingredients of the oxide of manganese and the carbonaceous matter was not an

(a) 2 Webs. P. R. 175.

(c) 2 Webs. P. R. 228.

(b) See *post*, p. 277.

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infringement of the patent, although those ingredients form a carburet of manganese before it entered into combination with the steel.”

The case then went before the Court of Exchequer Chamber, (a) where three of the judges held that there had been an infringement of the patent. Platt, B., said: “Whether the carburet or its constituent parts separately are put into the melting-pot could not make any difference if those parts afterwards combined, and in their combined state acted in the same manner on the subject of the manufacture. The defendant’s may be a different manner of manufacturing carburet of manganese, but however manufactured, if used in the conversion of iron into cast steel, it would be an infringement of the patent.” Erle, J., said: “The question is, was there evidence that the defendant by heating the elements of carburet of manganese with iron formed first the carburet and then cast steel? If so, there would be a direct infringement.” And Wightman, J., said: “The mode adopted by the defendant is not by using chemical equivalents; the material combinations are the same, in both the carburet is formed. The patent is not for the mode of preparing the carburet, but for its use in any process whereby iron is converted into cast steel; the process by which the defendant makes his carburet may be an improvement on that mentioned in the specification, but when made he uses it for the same purpose and the same effect as the defendant.” The remaining judges, Coleridge, J., and Alderson, B., while admitting the doctrine of chemical equivalents, held nevertheless that there was not an infringement in this case, as although an equivalent had

(a) 2 Webs. P. R. 236.

been used, it was not known at the date of the plaintiff's patent, and they thought therefore that it constituted a new discovery wholly independent of the specification which omitted it.

In the House of Lords the following question was put by their lordships to the judges:—"Whether, looking at the record as set forth in the joint appendix to the printed cases, there was evidence for the jury that the plaintiff in error was guilty of an infringement of the patent stated in the declaration, by using oxide of manganese and carbonaceous matter in the manufacture of cast steel, in the manner in which, according to his admission at the trial, he did use them." To this question seven of the judges answered in the affirmative and four in the negative. The House of Lords, nevertheless, reversed the decision of the Exchequer Chamber, and decided that there had been no infringement. Lord Cranworth, L. C., said: "The invention for which the patent was granted was, according to the language of the specification, a mode of 'making an improved quality of steel by introducing into a crucible bars of common blistered steel, along with from one to three per cent. of their weight of carburet of manganese.' It is certain that this process was not adopted by Unwin. He never used such a substance as carburet of manganese at all. And if, therefore, what he did amounted to a violation of the patent, it must be because he used a substance or a combination of substances which in the process of fusion generated carburet of manganese, so that he indirectly, though not directly, used the substance on the use of which the plaintiff's invention was founded. It must, I think, be assumed that in the course of the process adopted by the defendant carburet of manganese in a liquid state was

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generated. There was evidence from which the jury might reasonably infer such to be the case, and if the use of substances thus producing carburet of manganese in a state of fusion was a violation of the plaintiff's patent, the learned judge at the trial ought not to have told the jury, as he did, that there was no evidence on which they could find a verdict for the plaintiff.

“But I think that the use of substances thus producing carburet of manganese in a state of fusion, was no violation of the patent. The substance for the use of which (*inter alia*) the patent was granted was a solid metallic substance, capable of being broken into fragments and weighed, so that certain definite quantities might be put into the crucible with the steel. There is no evidence whatever tending to prove that at the date of the patent it was known to persons acquainted with the subject of manufacturing cast steel, that coal tar and oxide of manganese would be chemical equivalents for the carburet of manganese claimed by the plaintiff. Indeed, it is obvious that the discovery of such equivalents was made after the use of the carburet, as a distinct metallic substance, had been some short time in operation. It was itself a most valuable discovery, and would have legitimately formed the subject of a new patent. The costly nature of the substance claimed in the patent might and probably would have prevented its use altogether; and if at the date of the specification it was known to the plaintiff that, by the use of two common substances, well known in commerce, more than one hundred-fold cheaper than carburet of manganese, the same results precisely would be obtained, as by the use of that material the specification would have been bad as not truly disclosing the invention.

“On the short ground, therefore, that the invention claimed is for the use of a particular metallic substance, namely, carburet of manganese, in certain definite proportions, according to the weight of steel under fusion, and that no such substance nor any equivalent for it, known to be such at the date of the specification, was used by the defendant, I think there was no evidence of infringement, so that the ruling of the learned judge at the trial was correct.”

In *Hills v. The Liverpool Gaslight Co.*, (a) the plaintiff claimed as his invention “the purifying coal gas from sulphuretted hydrogen, cyanogen, and more or less perfectly from ammonia, by passing it through the precipitated or hydrated oxides of iron from whatever source obtained,” and also “repeatedly renovating or re-oxidizing the said purifying materials, by the action of air, whenever they from time to time cease to absorb sulphuretted hydrogen, so that they may be used over and over again to purify the gas. The defendants used for the purification of their gas a natural product or substance, found in Ireland, and known as “bog-ochre.” It was held by Lord Westbury, that the user by the defendants of the bog-ochre employed by them in the purification of gas, so long as the same was used in its native state or condition, was not an infringement of the plaintiff’s patent, but that the user of the same material in the purification of gas, after it had been re-oxidized or renovated by the means described in the plaintiff’s patent, or any other means, was an infringement.

Where a patent has been taken out for a combination of parts, some of which are new and some old, the use of

The use of any portion of a patent for a

(a) 9 Jur. (N. S.) 140.

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combination
which is new
is an infringe-
ment.

any part of the combination which is new and material will be an infringement of the patent, though any part which is old may be used, and it is not necessary to show that the whole combination has been imitated. (a)

In the case of the *Electric Telegraph Co. v. Brett*, (b) the breaches in the declaration stated that the defendants had used and counterfeited the invention of the patentees. The invention consisted of nine specified improvements, and it was held that the finding of the proof of an infringement, in respect of one of the improvements, was a sufficient finding of the infringement alleged in the declaration.

In *Sellers v. Dickinson*, (c) the patent was for improvements in looms for weaving. The specification was for an improved process for stopping power looms, when the shuttle stopped in the shed, by the combination of mechanism described in the specification. The process comprised two main operations, viz. the shifting of the driving strap from the foot to the loose pulley, and the bringing of the break to the fly wheel. The arrangement for shifting the driving strap, by a clutch box and other means, could be distinguished from the arrangement for moving the break to the fly-wheel; but the whole combination was specified without any claim or disclaimer as to any part. The clutch box for shifting the strap was old; the defendant had made a combination for the same purpose, containing two arrangements: that for shifting the driving strap was by a frog instead of a clutch box, and was not the same as the plaintiff's; but that for applying the break to the fly-wheel was the

(a) *Gillett v. Wilby*, 9 Car. & P. 334; 1 Webs. P. R. 270.

(b) 10 C. B. 882.

(c) 5 Exch. 312.

same. The defendant contended that if the plaintiff's patent was for the whole there was no infringement, and if it was for each part the clutch box was old, and so the patent was void; but it was held that the patent was valid if the whole combination was new and useful, and that the defendant had infringed if he had taken a new and material part, that is, the arrangement for bringing up the break.

This case was founded on *Newton v. Grand Junction Railway Co.*(a) where the patent was for improvements in the construction of boxes for axles, and the specification claimed a combination by which boxes cast with fillets were lined, first with a coating of tin, and then of alloy, for the purpose of preventing the abrasion arising in ordinary boxes. The defendant lined boxes with tin without using fillets or alloy; but the lining of tin was intended for and effected the purpose to which the plaintiff's patent related; the judge ruled that the jury must take the whole of that for which the patent was granted, fillets lined with tin and then with alloy, and say whether that was new; that, if a patent was granted for a new combination of several things known before, this did not prevent any one from using what was old; and that it was for the jury to say whether the part used by the defendant was substantially the same thing as the plaintiff's invention. This direction was held to be right. Sir F. Pollock, C.B., in giving judgment, observed: "It was argued that the same criterion was to be applied to the question of infringement as to that of novelty, but that is not so. In order to ascertain the novelty you take the entire invention, and if in all its

(a) 5 Exch. 331.

parts combined together, it answers the purpose by the introduction of any new matter, by any new combination, or by any new application, it is a novelty entitled to a patent. But in considering the question of infringement, all that is to be looked at is, whether the defendant has pirated a part of that to which the patent applies; and if he has used that part for the purpose for which the patentee adapted his invention, and that for which he has taken out his patent, and the jury are of opinion that the difference is merely colourable, it is an infringement;" and Alderson, B., said: "Where the invention consists partly of what is old and partly of what is new, the combination is the subject of the patent. Therefore a person cannot infringe that part of the patent which is old, because the public cannot be prevented from using that which they had before used in that state. If the invention consists of something new, and a combination of that with what is old, then if an individual takes for his own and uses that which is the new part of the patent that is an infringement."

In *Smith v. The London and North-Western Railway Co.* (a) Lord Campbell, C. J., said: "Where a patent is for a combination of two or three or more old inventions, a user of any of them would not be an infringement of the patent, but where there is an invention consisting of several parts, the imitation or pirating of any part of the invention is an infringement of the patent. Suppose that a man invents a machine consisting of three parts, one of which is a very useful invention, and the two others are found to be of less practical use, surely it could not be said that it was free to any person to use

(a) 2 El. & Bl. 76.

the useful part so long as he took care to substitute some other mode of carrying out the less useful parts of the invention." In this case the plaintiff's invention consisted in the manufacture of an improved wheel, "by welding wrought iron bars together into the form of a wheel, whereof the nave, spokes and rim when finished will consist of one solid piece of malleable iron." The evidence showed a clear imitation and infringement of the manner of forming the boxes or nave into one piece of malleable iron with the rest of the wheel, but the mode of forming and welding the rim was different, and it was held that as it appeared that the mode of forming the nave was a new and useful part of the invention, the use of it by the defendant was an infringement, although the patentee stated that the new invention consisted in the circumstance of the centre boxes or nave, arms and rim of the said wheel being wholly composed of wrought or malleable iron, "welded into one solid mass in manner hereinbefore described."

These cases were cited and commented upon in the case of *Lister v. Leather*, (a) and it was there unanimously decided by the Court of Queen's Bench and in the Exchequer Chamber that the use of a subordinate part of a combination might be an infringement of the patent, if the part so used was new, that is to say, new in itself, or in its effect, not merely in its application and material. (b)

If the defendants have used a material part of the plaintiff's patent, it is not necessary to determine whether

Infringed part need not have been claimed expressly.

(a) 8 El. & Bl. 1004.

White v. Fenn, 15 W. R. 348;

(b) See also *Bovill v. Keyworth*, 7 El. & Bl. 725; *Thomas v. Foxwell*, 5 Jur. (N. S.) 37;

McCormick v. Gray, 7 H. & N. 35.

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their claim extends to the rest of the patent, for as the manufacture, which is the result of the process invented and patented, is the ultimate object in view, the purpose of the patent laws is to protect all that is new in the process, if it is described, though not expressly claimed. Thus, where the specification of a patent for "improvements in the manufacture of envelopes" described a machine in which a piece of paper was held upon a platform whilst the flaps of the envelope were folded, and concluded by claiming "the so arranging machinery that the flaps of envelopes may be folded thereby as herein described," it was held that a machine in which the flaps of an envelope were folded might be an infringement of the patent although the envelope was not held down during the operation of folding. In the same case the specification of another of the plaintiff's patents for an invention with a similar title described and claimed "the application of gum or cement to the flaps of envelopes by apparatus acting in the manner of surface printing," and it was held that an apparatus for applying the gum might be an infringement although it acted only in part in the manner of surface printing according to the description contained in the specification. (a)

But if the patentee's invention consist merely in the use of an old machine or well known tool to work new materials, or to produce a new effect, that is not the subject matter of a patent, and the use of it by another person is not an infringement. (b)

Not only in order to constitute an infringement, must

Part used must
be for the same
purpose.

- (a) *De la Rue v. Dickinson*, 7 El. & Bl. 738. *Co. v. Seymour*, 5 C. B. (N. S.) 164; *Finlay v. Allen*, 2 Dec. of Ct. of Sess. 2 series, 1087.
- (b) *Patent Bottle Envelope*

the part used be new and material, but it must also be used for the same purpose. (a)

In *Newton v. Vaucher* (b) the plaintiff's patent was for the application of soft metal to the bearings of machinery for the purpose of diminishing friction, and the defendant's patent was for the application of soft metal for the purpose of packing hydraulic and other machines, so as to render them air and fluid tight; and it was held that the principle of the two inventions was totally different, and that there had been no infringement.

In *Lister v. Eastwood*, (c) Erle, C. J., told the jury that in order to constitute an infringement the defendant must have not only taken a new and material part of the combination, but must also have applied it to a purpose similar or analogous to that which the plaintiff's combination was intended to effect. It was contended that this was a misdirection, but Williams, J., in delivering the judgment of the Court, said, "We are of opinion that it was not, but that it was a correct exposition of the law. It is true that in the judgment of the Court in *Lister v. Leather* (d) this qualification of the doctrine was not superadded in express terms, but it appears to us to flow inevitably from the principles on which that doctrine was founded."

Where a patent is taken out for a combination of machinery for a particular purpose it will be an infringement to adopt it to another purpose. In *Cannington v. Nuttall* (e) Lord Westbury said: "If you are obliged to adopt a combination of machinery which originally is directed to one purpose, before you can make it minister

The adaptation of a machine to another and additional purpose is an infringement.

(a) *Thomas v. Foxwell*, 5 Jur. (N. S.) 37.

(b) 6 Exch. 859.

(c) 9 L. T. (N. S.) 766.

(d) 8 El. & Bl. 1004.

(e) L. R. 5 H. L. 220.

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to another and additional purpose, the user of it for this additional purpose is an infringement of the patent which first introduced that combination.”

New combina-
tion of old
materials for
same purpose
not infringe-
ment.

But it is not an infringement of a patent for a combination to effect a new combination of the same parts for the same purpose, if it is not a mere colourable imitation or evasion. In *Curtis v. Platt*,^(a) the plaintiff's patent, which was granted in 1854, specified a combination of mechanism applicable to spinning mules; and the first claim was for “the novel construction, combination and application of mechanism hereinbefore described, whereby one half of the clutch or catch box hereinbefore described, or any mechanical equivalent therefor, is connected with or acts upon cams or other similar parts of mechanism direct.” There were other claims, but in respect of these breaches were not alleged in the plaintiff's particulars of breaches. The defendant's patent, granted in 1860, specified a combination of mechanism which embodied the leading idea of the plaintiff's patent, and by which one half of a clutch box was made to act upon cones direct, and he adopted some of the elements combined by the plaintiff, but he disposed them in a different manner. These were important parts of the prior combination, and, although old mechanical contrivances, were new in respect of the particular mode in which the plaintiff applied them, and the immediate object of their combination by him was new, viz. to make a clutch box act on cams direct. The effect brought about by the direct action of the clutch box on the cams had long previously been produced, but less advantageously, by other contrivances of various kinds. The defendant's mode of combination

(a) 35 L. J. Ch. 852; L. R. 1 H. L. 337.

effected the common object of each patent in a more beneficial manner than it was or could be effected by the mode of combination specified in the plaintiff's patent, and it displayed an equal amount of inventive ingenuity. It was held that the plaintiff's claim was limited to the entire combination claimed as before described in his specification; that the defendant's combination was not a mere colourable evasion, and that there was no infringement.

In *Hill v. Thompson* (a) the patent was for a combination of processes, and it was held that any use made of any of the ingredients singly, or any use made of such ingredients in partial combination, some of them being omitted, or any use of all or some of such ingredients in proportion, essentially different from those specified and yet producing a result equally beneficial with the result obtained by the proportions specified, would not constitute an infringement.

It is not an infringement of a patent which describes a particular machine, to perform the process by the application of different machinery.

Different machinery to perform same process not infringement.

Where the particular manner described in the specification of using the invention was by means of a "weight," and the defendants employed a machine similar in many respects, but though using weight or pressure occasioned by weight as a force they did not use a "weight," it was held that this did not amount to an infringement; (b) and where the specification of a patent for improvements in the process of finishing hosiery and other goods manufactured from lambs' wool, Angola and worsted yarns, described the pro-

(a) 8 Taunt. 391; 2 B. Moo. 448; 1 Webs. P. R. 242.

(b) *Seed v. Higgins*, 8 H. L. C. 551.

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cess as consisting in submitting hosiery and similar goods made of elastic stocking fabric to the finishing process of a press heated by steam, hot water, or other fluid in the manner thereafter described, and a drawing of the machine was given, representing an iron steam box supported upon iron columns, beneath which was another box upon which the goods to be pressed were placed, and which was capable of being pressed against the upper one by means of an hydraulic press, it was held that a method of finishing hosiery goods by passing them through heated rollers was not included in this patent, and therefore was no infringement of it. (a)

Patent for application of a principle not infringed, if different application of principle.

Where a patent has been taken out for the application of a principle, the making of an article on the same principle as the patented article will not of itself alone be an infringement, because the principle may be applied in different ways; but if it is applied in the same way as in the patent, then the want of two or three circumstances, which are contained in the plaintiff's specification, will not prevent the plaintiff from recovering. (b) Where the patent was for the application of a self-adjusting leverage to the back and seat of a chair, Alderson, B., told the jury that it was material to consider whether the species of self-adjusting leverage had ever been applied to the back and seat of a chair before. For if there had been a self-adjusting leverage applied before, and the patent had been taken out for the particular mode of accomplishing it in the patent chair—any one else might have applied the same principle in any other way, and that would have been no infringement; but if the patent was

(a) *Barber v. Grace*, 1 Exch. 339. And see *Newall v. Elliott*, 10 Jur. (N. S.) 956.

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

for the adjustment of a self-acting leverage to the back and seat of a chair, it would become a very different question when the question of infringement was considered. (a)

But if the patentee has not only discovered a mode of carrying a principle into effect, but is also the discoverer of the principle, he is entitled to protect himself from all other modes of carrying the same principle into effect.

Patentee who has discovered principle as well as mode of carrying principle into effect entitled to all modes.

In *Crossley v. Beverley*, (b) the patent was for an improved gas-meter, and the infringement complained of was a close imitation of this improved machine; the patentee obtained a verdict, the principle being the same in both cases. In *Jupe v. Pratt*, (c) Alderson, B., referring to this case, said: "There never were two things to the eye more different than the plaintiff's invention and what the defendant had done in contravention of his patent right. The plaintiff's invention was different in form, different in construction, it agreed with it only in one thing, and that was by moving in the water a certain point was made to open either before or after, so as to shut up another, and the gas was made to pass through this opening; passing through it, it was made to revolve it; the scientific men, all of them, said the moment a practical scientific man has got that principle in his head he can multiply without end the forms in which that principle can be made to operate. The difficulty which will press on you, and to which your attention will be called in the present case, is this: You cannot take out a patent for a principle; you may take out a patent for a principle coupled with the mode of carrying the principle

(a) *Minter v. Wells*, 1 Webs. P. R. 130.

(b) 1 Webs. P. R. 106.

(c) 1 Webs. P. R. 146.

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into effect, provided you have not only discovered the principle, but invented some mode of carrying it into effect. But then you must start with having invented some mode of carrying the principle into effect; if you have done that, then you are entitled to protect yourself from all other modes of carrying the same principle into effect." (a)

In *Russell v. Cowley*, (b) the plaintiff's patent consisted in the manufacture of tubes, by turning up a piece of plate of iron so that the edges abutted on each other, heating the iron so prepared, and drawing it, when at welding heat, through dies having a conical hole. By this process, the use of a mandril was avoided. The defendants passed tubes through grooved rollers, and afterwards through a scorpion, which was in effect the plaintiff's die. Evidence was given, which proved that the two inventions were similar in principle, and it was held that there had been an infringement of the plaintiff's patent.

Acts done on the high seas not infringement.

A patent granted for the United Kingdom, Channel Islands, and Isle of Man is not infringed by acts done on the high seas. In *Newall v. Elliott*, (c) it was held that a patent for an improved method of laying telegraph cables was not infringed by acts done between Malta and Alexandria.

Contemporaneous inventor.

Where an inventor filed a provisional specification, and obtained within six months letters patent, which were dated as of the date of the provisional specification, and another person had previously made a similar invention, but had not used it for his trade till after the date of the specification being filed, although his invention was completed and might have been used, it was held, that as the

(a) And see *Forsyth v. Rivière*,
1 Webs. P. R. 97, n.

(b) 1 Webs. P. R. 462.

(c) 10 Jur. (N. S.) 956.

date of the patent is that of filing the provisional specification, there was not such prior user as to invalidate the patentee's right, and therefore that there had been an infringement of his patent. (a)

If a person actually makes an article according to the patented process for the purposes of sale, his making it will be a sufficient infringement of the patent. (b)

The making for sale of a patented article is an infringement.

In *Gibson v. Brand*, (c) Sir N. C. Tindal, C. J., said: "If the defendants have themselves sold an article of exactly the same fabric, made in the same manner as that for which the patent was taken out, such sale may be considered as a using of the invention within the terms of the declaration." (d)

In *Minter v. Williams*, (e) it was held that the merely "exhibiting to sale" imitations of an invention was not any infringement of the patent.

Exhibiting to sale not.

If the article is made for the purpose of amusement only, or as a model, (f) or for private use, and not for profit, there is no infringement.

Nor making for amusement and not for profit.

In *Higgs v. Goodwin*, (g) the invention consisted in the precipitation of all animal and vegetable matter contained in sewage water by the use of hydrate of lime. The defendant applied this process for the purpose of deodorizing sewage water, and did not use the product as an article of value, but *bonâ fide* rejected it as being accidentally

(a) *Smith v. Davidson*, 19 Dec. of Ct. of Sess. 2nd series, 691.

(b) *Jones v. Pearce*, 1 Webs. P. R. 122; *Muntz v. Foster*, 2 Webs. P. R. 101.

(c) 4 M. & G. 179; 4 Scott (N. R.) 844; 1 Webs. P. R. 630.

(d) And see *Holmes v. The London and North Western Railway Co.*, Macr. 22.

(e) 4 A. & E. 251; 1 Webs. P. R. 137.

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

(g) El. Bl. & Bl. 529.

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Sale in this country of article manufactured abroad is infringement.

produced and useless, and it was held that there was no evidence of infringement.

A sale in this country, of an article manufactured abroad, according to the specification of an English patent is an infringement. In *Walton v. Lavater*, (a) Sir W. Erle, C. J., said: "The words in the statute of James are 'working or making.' In the granting part of the letters patent the words are, 'make, use, exercise and vend,' and in the prohibitory part, 'make, use, or put in practice.' . . . It appears to me to be clearly the intention of the Crown in granting letters patent for a new invention to prohibit and prevent third persons from using the patent article for the purpose of profit by selling. The object is to give to the inventor the profit of his invention; and the most effectual way of defeating that object would be the permitting others to derive from the sale of the patent article the profit which it was intended to secure to the patentee. It seems to me, therefore, that proof, that a party has sold the patent article without proof of his having made it or procured it to be made, would be good evidence to warrant a jury in finding that he has been guilty of an infringement. As to the circumstance of the goods having been imported from abroad, I should say, that if this were simply the case of an importation without any proof of knowledge on the part of the importer, that the article imported was a patented article, the mere sale would be sufficient to charge him." And in *Elmslie v. Boursier*, (b) Sir W. M. James, V.C., said: "I am of opinion both upon principle and upon the authorities that the doing what is admitted to have been done by these defendants is a

(a) 8 C. B. (N. S.) 162.

(b) L. R. 9 Eq. 222.

violation of the rights granted to the plaintiff by the letters patent.

“ The plaintiff has by a lawful grant from the Crown under the statute obtained the right to ‘ make, use, exercise and vend ’ his invention within the United Kingdom, in such manner as he thinks fit ; and the right to have and enjoy ‘ the whole profit, benefit, commodity and advantage ’ accruing and arising by reason of the said invention.

“ Now one of the most useful inventions is that of a process by which a common article may be made more economically than it was made before.

“ It is said that tin-foil can be made by the plaintiff’s process at less cost than by the old method ; and it is conceded that nobody in England can use the plaintiff’s process of making cast tin-foil as distinguished from rolled tin-foil without a licence from the plaintiff. If that cannot be done in England it would be a very strange thing if a person in England could send an order to some one in France, get the same thing manufactured there in exactly the same way, and bring it here so as to compete with the person to whom the Crown has granted ‘ the whole profit, benefit, commodity and advantage ’ arising from the patent. It would be a short mode of destroying every ‘ profit, benefit, commodity and advantage, ’ which a patentee could have from such a thing if all that a man had to do was to get the thing made abroad, import it into this country, and then sell it here in competition with the English patentee.” (a)

Where the patented article is made abroad and is

The sending to
England of
patented arti-
cles made

(a) And see *Wright v. Hitchcock*, L. R. 5 Exch. 37.

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abroad is infringement, though no sale.

there applied to the purposes for which it is made, and is then sent to this country not for sale here, but for exportation to another country, there is nevertheless such a user of the patent here as to constitute an infringement. Thus, where the patent was for capsules which were made abroad according to an English patent and the bottles they were used to cover were sent through England for exportation, it was held that there was an infringement of the patent. (a)

Manufacture for exportation is infringement.

If the parts of a patented machine are old, it is not an infringement to manufacture them separately and export them. But the manufacture and exportation of the complete machine will be an infringement. (b)

Improvement on existing patent not infringement.

A patent for an improvement on an invention already the subject of a patent if confined to the improvement is not an infringement of the former patent, but the use of the improvement with the former invention during the existence of the former patent without licence is an infringement. (c)

Delay in using invention no excuse.

It appears that if an invention, for which a patent is granted, would if put into practice, be useful, an action for infringement may be brought, although the plaintiff's invention has never been put into actual use, except by the defendant when he infringed the patent. (d)

Experiments with known articles not infringement.

When it is known that a mixture of certain articles will produce a beneficial result, and a patent is taken out for mixing them in certain proportions, it is not an infringement for another person to make experiments for

(a) *Betts v. Neilson*, L. R. 3 Ch. 429; S. C. on app. *Neilson v. Betts*, L. R. 1 H. L. 1.

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

(b) *Goucher v. Clayton*, 11 Jur. (N. S.) 462.

(d) *Macnamara v. Hulse*, Car. & M. 471.

ascertaining what the proportions or properties of the different articles would come to. (a)

It is no answer to an action for infringement or a suit to restrain the infringement of a patent, to say that any infringement which may have taken place was contrary to the orders of the defendant, and that the acts were done by workmen employed by him in the course of their duties, but against his orders. (b)

Ignorance of the existence of a previous patent is no answer to a charge of infringement. If the defendant's patent is capable of being accurately represented as an imitation of the plaintiff's, it will be an infringement, although at the time of making his invention the defendant was innocent of any knowledge of the plaintiff's patent. (c)

It has been seen that the Court of Exchequer, in *Heath v. Unwin*, (d) considered that if the defendant did not intend to imitate the plaintiff's invention, there was no infringement. This doctrine was dissented from in *Stevens v. Keating*; (e) and when *Heath v. Unwin* came before Sir L. Shadwell, V. C., his Honour said: "The party complaining of the act is none the less prejudiced by it, because it was committed unintentionally; and my opinion is that if a party has done an act that is injurious to the rights of another (though without any intention of doing him an injury), he is answerable for the consequences." (f) The action is maintainable

Acts done by workmen may be infringements.

Ignorance of existing patent no excuse.

Intention immaterial.

(a) *Muntz v. Foster*, 2 Webs. P. R. 101.

(b) *Betts v. De Vitre*, L. R. 3 Ch. 441.

(c) *Curtis v. Platt*, 11 L. T. (N. S.) 245; *Nunn v. D'Albergue*, 34 Beav. 595; *Wright*

v. Hitchcock, L. R. 5 Exch. 37.

(d) 2 Webs. P. R. 227.

(e) 2 Webs. P. R. 175.

(f) *Heath v. Unwin*, 15 Sim. 552; *Unwin v. Heath*, 5 H. L. C. 535.

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in respect of what the defendant does, not what he intends. (a)

Patentee entitled to damages though no loss sustained where infringement.

A patentee is entitled to a verdict with nominal damages, even though he has sustained no real injury, if his rights have been invaded. Thus, where an action was brought against a person for selling hones wrapped in envelopes similar to those of the plaintiff's, and the jury found that the defendant's hones were not inferior to those of the plaintiff, and it was not proved that the plaintiff had suffered any specific damages, it was held that as his right had been invaded, he was entitled to recover nominal damages. (b)

Proof of patent documents.

The Patent Law Amendment Act, (c) after directing a seal to be made for the purposes of the Act, provides "that all Courts, judges and other persons whomsoever shall take notice of such seal, and receive impressions thereof in evidence, in like manner as impressions of the great seal are received in evidence; and shall also take notice of, and receive in evidence, without further proof or production of the originals, all copies or extracts certified under the seal of the said office of or from documents deposited in such office." A later Act (d) provides "that printed or manuscript copies or extracts, certified and sealed with the seal of the commissioners, of letters patent, specifications, disclaimers, memoranda of alterations, and all other documents recorded and filed in the Commissioners' office, or in the office of the Court of Chancery, appointed for the filing of specifications, shall be received in evidence in all proceedings relating to letters

(a) *Stead v. Anderson*, 4 C. B. 833; 2 Webs. P. R. 156.

(b) *Blofield v. Payne*, 4 B. & Ad. 410.

(c) 15 & 16 Vict. c. 83, s. 2.

(d) 16 & 17 Vict. c. 115, s. 4.

patent for inventions in all courts whatsoever within the United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, and Her Majesty's colonies and plantations abroad, without further proof or production of the original." (a)

The specification of the plaintiff's and defendant's patents must be compared, in order to see whether there is that variation in substance that will give the denomination of a new discovery to what the defendant has done, or whether he is not following out the invention of the plaintiff, with some variation in the description which may not allow it the name of a new discovery. (b)

It is not proof of an infringement that identical terms are used in different specifications, the things described may be different; it must be proved that they are themselves identical, and are used for the same purpose. (c)

The question as to whether or not there has been an infringement of the plaintiff's patent is a mere question of fact, and peculiarly for the consideration of the jury; and it is for them to say whether, under the circumstances, that which has been done by the defendants amounts to such an infringement or not, (d) even though there is no question with respect to whether the defendant has or has not used the particular machine or process which is alleged to be an infringement. (e) Where, in an action for infringing a patent for blocks for pavement,

Two specifications must be compared.

The question of infringement is for the jury.

(a) As to proof of transcripts in Scotland and Ireland, see 16 & 17 Vict. c. 115, s. 5, and *ante*, ch. vii.

(b) *Walton v. Potter*, 1 Webs. P. R. 587.

(c) *Cutler's Patent*, 1 Webs.

P. R. 427. And see *ante*, p. 114.

(d) *Walton v. Potter*, 1 Webs. P. R. 586.

(e) *De la Rue v. Dickinson*, 7 El. & Bl. 738; *Lister v.*

Leather, 8 El. & Bl. 1004.

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the plaintiff claimed as his invention that his block was bevelled both inwards and outwards on the same side of the block, and it was alleged that the defendant's blocks were an imitation of the plaintiff's, as two of the defendant's blocks were equivalent to one of the plaintiff's, it was held that it was for the jury to say whether the defendant's blocks were in effect the same as the plaintiff's, although no single block of the defendant's was bevelled both inwards and outwards on the same side. (a)

The Court will not in deciding whether there has been an infringement, express an opinion as to whether the jury were justified in their verdict unless it is contended that the verdict was given against evidence. (b)

Evidence in support of patent.

The plaintiff in an action for infringement must give some evidence to show what his invention is, unless the other side admit that it has been tried and succeeds. (c) It is a sufficient test of the sufficiency of the specification that witnesses state that they have been able to make the patented article from the description given in the specification; and that no person has been called who has stated that he could not understand it, has been misled by it or incurred expense in endeavouring to work according to it. (d)

Patent is *prima facie* evidence of novelty of invention.

The patent is *prima facie* evidence that the invention in respect of which it is taken out is new. "The plaintiff," said Alderson, B., "in order to establish his right must show that the invention is new, and that it is useful, and that the specification is such that an ordinary

(a) *Macnamara v. Hulse*, Car. 607; 1 Webs. P. R. 81. And & M. 471; 2 Webs. P. R. 128. see *Bateman v. Gray*, 1 C. L. R.

(b) *Sellers v. Dickinson*, 5 512. Exch. 323.

(d) *Cornish v. Keene*, 1 Webs.

(c) *Turner v. Winter*, 1 T. R. P. R. 502.

workman could make the machine which would answer the purpose which the patent was intended to accomplish. The patent is *primâ facie* evidence on the part of the person who claims the right that he is so entitled, and it is for the person who seeks to infringe that patent to show some circumstances whereby that right, which otherwise would be presumed to exist, is defeated, to show that the Crown's grant has been improperly obtained by the present plaintiff." (a)

Where the alleged piracy has taken place abroad, it is the duty of the defendant to give evidence of a negative character to prove (in answer to the *primâ facie* case made by the plaintiff), that the process used is different from that which has been patented. (b)

Where defence is set up that the patent is void on account of publication in a previous specification, evidence of all that has been done in the trade to which the patent relates, between the date of the two patents, is admissible. (c)

The plaintiff's witnesses can only give negative evidence, and it is for the defendant to show affirmatively that the invention is not new. (d)

Plaintiff's witnesses can only give negative evidence.

In *Manton v. Manton* (e) Gibbs, C. J., said: "The first witness, a man of considerable experience, had never seen any locks with the lips so perforated: *primâ facie* that is good evidence, but when the question is whether this had existence previous to the patent, fifty witnesses

(a) *Minter v. Wells*, 1 Webs. P. R. 129. And see *Russell v. Crichton*, *ib.* 677 n.; 15 Dec. of Ct. of Sess. 1271.

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

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

(d) *Galloway v. Bleaden*, 1 Webs. P. R. 526.

(e) *Dav. P. C.* 350.

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proving that they never saw it before would be of no avail if one was called who had seen it and practised it.” (a)

Validity of patent assumed.

The Court will assume for the purpose of inquiry, whether the defendant has infringed the patent or not, that it is valid, and that no objection arises either to the nature of the grant or the specification. (b)

Sale of similar article evidence of infringement.

It is *prima facie* evidence of infringement that an article has been made according to the patentee's process, when it is seen to agree in all respects with that manufactured and sold by the patentee.

In *Huddart v. Grimshaw*, (c) the plaintiff's patent was for “a new mode of making great cables and other cordage, so as to attain a greater degree of strength therein, by a more equal distribution of the strain upon the yarns.” Pieces of cordage made by the defendant were put into the hands of the plaintiff's witnesses, and from the fact that the same effect was produced in them, and from the similarity of structure, they gave the opinion that they were made by the same process as the plaintiff's. Lord Ellenborough said that it had happened to him in the same morning to give, as far as he was concerned, his consent to the granting of three different patents for the same thing; but the modes of attaining it were all different. But it did not follow that the plaintiff's method of attaining the object was open to the public; and therefore the question for the jury was, whether the defendant had used the plaintiff's method or some other. (d)

(a) And see *Hill v. Thompson*, 8 Taunt. 375; 2 B. Moo. 448; 1 Webs. P. R. 244.

(b) *Muntz v. Foster*, 2 Webs. P. R. 97.

(c) 1 Webs. P. R. 91.

(d) See also *Galloway v. Bleaden*, *ib.* 523; *Davenport v. Richard*, 3 L. T. (N. S.) 503.

Where it was proved that the defendant sold an article in the state to which it would have been brought by the plaintiff's process, and that he had the means of practising the plaintiff's process at hand, it was held that that was sufficient evidence of infringement. (a)

Where the patent is for the mode of manufacturing a certain article and not for the article itself, evidence must be brought to prove that the defendant uses the same process as the plaintiff, and the production of an article made by the defendant which is similar to that made by the plaintiff is not evidence of infringement. Thus where the patent was for a mode of manufacturing candles by the application of peculiarly formed wicks, and the mode of manufacturing candles by the application of two or more plaited wicks as described in the specification, it was held that the production of candle with a plaited wick, without showing in what way it was made, was not evidence of infringement. (b) But where the alleged infringements took place abroad and the defendant did not bring negative evidence to prove that his process was different from the plaintiff's, and positive evidence was given on the part of the plaintiff by one workman, that he had been employed at the foreign manufactory, and there saw articles manufactured by a process not distinguishable from the patented process; it was held that these circumstances warranted the conclusion of identity of material and process, and were sufficient warrant for the grant of an injunction. (c)

Unless patent
for mode of
manufacture.

Where in a patent for "improvements in apparatus

Use of similar
article.

(a) *Hall v. Boot*, 1 Webs.
P. R. 101.

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

(b) *Palmer v. Wagstaff*, 9
Exch. 494.

employed for laying down submarine electric telegraph wires," the invention consisted in coiling the wire or cable round a cone, and in the supports placed cylindrically outside the coil round the cone; it was held, that the substitution by the defendants of a cylinder having a domed or hemispherical top, for a cone with a conoidal apex in the plaintiff's apparatus—both the plaintiff's and the defendant's apparatus being used for the same purpose and in nearly the same manner, was evidence and strong evidence of infringement. (a)

Evidence of motives for prior user inadmissible.

Where evidence of prior user by some third party is attempted to be shown, the declaration of such party as to his motives for such user are inadmissible as mere hearsay. (b)

Patentee who has assigned may be witness.

A patentee who has assigned the whole of his interest in a patent may be examined as a witness in an action by the assignees for infringement. (c)

The Court looks with distrust on experiments conducted with a view to litigation. (d)

(a) *Re Newall and Elliott*, 4 C. B. (N. S.) 293.

(b) *Hyde v. Palmer*, 3 B. & S. 657.

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

(d) *Young v. Fernie*, 4 Giff. 577.

CHAPTER XIII.

OF AN ACTION FOR INFRINGEMENT.

THE injury which a patentee sustains by the infringement of his patent entitles him to maintain an action at law against the wrongdoer, to recover compensation for the damage he has sustained. (a)

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In an action to recover damages for the infringement of a patent, the proper person to be plaintiff is the party in whom the legal estate in the patent was vested at the time of the infringement, and the person who has directly or indirectly committed or authorized the alleged wrongful act must be the defendant. (b)

Parties.

The assignee of a patent may maintain an action for infringement, (c) and if a patentee has assigned part of his patent he may join with his assignee in bringing an action. (d)

Assignee may sue.

The assignee of a separate and distinct part of a patent may sue for an infringement of that part without joining

(a) Bull, N. P. 76. As the rules of pleading are so soon to be altered under the Judicature Act, it has not been thought advisable to increase the size of this work by any notes on the subject of pleading. The reader is referred to Bullen and Leake "On Pleading," Chitty's "Prece-

dents in Pleading," and to Fisher's "Common Law Digest," for a collection of the cases.

(b) Hindm. 251.

(c) *The Electric Telegraph Co. v. Brett*, 10 C. B. (N. S.) 838.

(d) *Boulton v. Bull*, 2 H. Bl. 464.

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any person who has an interest in another part, and the damages will accrue to him alone. In *Dunnicliff v. Mallett*,^(a) Sir W. Erle, C. J., said: "The question is whether an assignment of part of a patent is valid. I am inclined to think that it is. It is every day's practice, for the sake of economy, to include in one patent several things which are in their nature perfectly distinct and severable. It is also every day's practice by disclaimer to get rid of part of a patent which turns out to be old. Being therefore inclined to think that a patent severable in its nature may be severed by the assignment of a part, I see no reason for holding that the assignee of a separate part which is the subject of infringement may not maintain an action. Then are the assignees bringing an action for an injury done solely to them by an infringement of that, part of which is thus vested in them alone, liable to be defeated because they have not joined the assignees of other parts of the patent who have no manner of interest in the damages sought to be recovered in such action? I see no reason why the action should be defeated on any such ground; I see no reason why the plaintiffs should be put to the trouble and expense of applying for leave to use the names of the other parties, or for compelling them by means of a judge's order to permit their names to be used upon an indemnity where no practical advantage whatever is to be gained by it, the injury being to the assignees of part only, and the damages to be recovered being theirs only."

Even where
defendant is
original
grantee.

When a person becomes the assignee of two several moities of a patent he is entitled to sue for an infringement of the patent although the defendant is the original

(a) 7 C. B. (N. S.) 209.

grantee. In *Walton v. Lavater* (a) it was argued that the effect of an assignment was only to give the assignee a licence to use the patent and a right to an account, and that the original patent right remained in the grantee; but it was held, following *Dunnicliff v. Mallett*, (b) that an assignee, whether of the entirety of a patent or of a part or share in it, takes the legal interest, and is not to be considered merely as a licensee. (c)

Where two persons are assignees of a patent as tenants in common, if one of them dies, actions for infringements commenced in his lifetime descend to the survivor, who is entitled at law to recover the whole of the damages. (d)

Tenants in common, right descends to survivor.

The assignees of a bankrupt patentee may maintain an action for infringement of the patent. (e)

Assignee of bankrupt.

A mere licensee cannot sue for the infringement of the patent, (f) but an exclusive licensee has a right to sue in the name of the patentee. (g)

Licensee cannot sue unless exclusive.

An action may be maintained although there has been no infringement since the defendant has received notice that the entire interest in the patent has become vested in the assignee. (h)

By 5 & 6 Will. IV. c. 83, s. 5, it was provided that in actions for infringement and in any *sci. fa.* that notice of objections should be given. This enactment was repealed by s. 41 of the Patent Law Amendment Act, (i) which

Notice of objections at law.

(a) 8 C. B. (N. S.) 162.

(f) *Derosne v. Fairie*, 1 Webs.

(b) 7 C. B. (N. S.) 209.

P. R. 154.

(c) And see *Wallington v. Dale*, 7 Exch. 888.

(g) *Renard v. Levinstein*, 2 H. & M. 628.

(d) *Smith v. London and North Western Railway Co.*, 2 El. & Bl. 69.

(h) *Walton v. Lavater*, 8 C. B. (N. S.) 162.

(e) *Bloxam v. Elsee*, 6 B. & C. 169.

(i) 15 & 16 Vict. c. 83.

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

provides that "in any action in any of her Majesty's superior Courts of record at Westminster or in Dublin, for the infringement of letters patent, the plaintiff shall deliver with his declaration particulars of the breaches complained of in the said action, and the defendant on pleading thereto shall deliver with his pleas particulars of any objections on which he means to rely at the trial in support of the pleas in the said action; and at the trial of such action no evidence shall be allowed to be given in support of any alleged infringement or of any objection impeaching the validity of such letters patent which shall not be contained in the particulars delivered as aforesaid; provided always that the place or places at or in which and in what manner the invention is alleged to have been used or published prior to the date of the letters patent shall be stated in such particulars. Provided also, that it shall and may be lawful for any judge at chambers to allow such plaintiff or defendant to amend the particulars delivered as aforesaid upon such terms as to such judge shall seem fit.

Particulars of breaches.

The plaintiff's particulars of breaches cannot be called in aid of the defective particulars of objections. (a)

Where in an action for the infringement of a patent for "improvements in obtaining pictures or representations of objects" the plaintiff delivered the following particulars of breaches—"that the defendant on the 1st of August, 1853, and on divers days between that day and the commencement of this suit, at No. 65, Oxford Street, in the county of Middlesex, infringed the plaintiff's patent by making, using and selling pictures and portraits made and executed according to the plaintiff's invention in the said

(a) *Palmer v. Cooper*, 9 Exch. 231.

patent, otherwise than in relation to the parts disclaimed, and also infringed the said patent by making, using and selling pictures and portraits whereby the plaintiff's said invention was counterfeited, imitated and resembled," the Court refused to compel him to specify particularly the persons and occasions, and the particular parts of the specification alleged to have been infringed. (a)

The requirements of the statute as to the notices by the defendant are clearly confined to notices affecting the validity of the patent only, and a defendant therefore may object to the validity of an assignment although the objection has not been specified in the notice of objections delivered by him. (b)

The statute does not make the notice of objections stand in the place of pleas, and the defendant cannot by his notice of objection go beyond his pleas. (c)

The object of the statute in requiring the defendant to deliver particulars of objections was to enable the plaintiff to know what objections he had to meet; and the particulars must be precise and definite. It is not sufficient to say that if any part of the invention is new the same is useless, but the defendant must point out what part; or to say that the improvements, or some of them, have been used before: the defendant must point out which. (d)

Where the defendant pleaded that the nature of the invention and the manner in which the same was to be performed were not particularly ascertained and described in the specification, and that the invention was not new,

(a) *Talbot v. La Roche*, 15 C. B. 310.

(b) *Chollet v. Hoffman*, 7 El. & Bl. 686.

(c) *Macnamara v. Hulse*, Car. & M. 471.

(d) *Fisher v. Dewick*, 4 Bing. (N. C.) 706; 6 Scott, 587; 1 Webs. P. R. 264.

Particulars of objections, Effect of.

May not go beyond pleas.

Object of statute.

and the particulars of objections stated that the specification did not describe the nature of the invention and the manner in which it was to be performed and that the invention was not new and was either wholly or in part used and made public before the obtaining of the letters patent, it was held that the first of the objections was sufficient, but that the second was bad and ought to have pointed out what portions of the alleged invention were previously in use. (a)

An objection that the defendant did not state the best mode with which he was acquainted is sufficient. (b) Books intended to be relied on must be distinctly described. (c)

Notice of objections is to give plaintiff more information than plea.

The notice of objections is intended to give the plaintiff more information than the plea, (d) and it is no answer to a motion for better notice that the notice is as specific as the plea. (e) Where a defendant pleaded that the patentee was not the true and first inventor and that the invention was not, when the letters patent were granted, a new invention, it was held that he was not bound to state who was the first inventor nor under what circumstances the invention had been previously used. (f)

In *Leaf v. Topham* (g) the defendant delivered a notice of objections, one of which stated that the patentee did

(a) *Heath v. Unwin*, 10 M. & W. 684.

(b) *Jones v. Berger*, 5 M. & Gr. 208; 1 Webs. P. R. 544.

(c) *Ib.*

(d) *Neilson v. Harford*, 8 M. & W. 806; 1 Webs. P. R. 370; *Jones v. Berger*, 5 M. & Gr. 208; 1 Webs. P. R. 544; *Bul-*

nois v. Mackenzie, 4 Bing. (N. C.) 127; 1 Webs. P. R. 260.

(e) *Betts v. Walker*, 14 Q. B. 363.

(f) *Russell v. Ledsam*, 11 M. & W. 647; *Heath v. Unwin*, 10 *ib.* 684; *Bulnois v. Mackenzie*, 4 Bing. (N. C.) 127; 1 Webs. P. R. 260.

(g) 14 M. & W. 146.

not by his specification sufficiently describe the nature of the supposed invention; and the other stated that he had not caused any specification sufficiently describing the nature of the supposed invention to be enrolled. It was held that the last objection was not sufficiently precise; and an amendment was ordered by inserting the word "other" before "specification."

A notice of objections stated that the invention was known to certain persons (naming them) and others before the date of the patent. The Court refused to strike out the words "and others." (a)

The notices of objection delivered by the defendant are not conclusive at his peril, but the Court has power to order a further and fuller notice. (b) Where the defendant pleaded that the grant of letters patent was obtained by fraud and misrepresentation, it was held that he ought to state in his notice of objections what the fraud and misrepresentation was. (c)

Not conclusive.

Where the defendant relies on a general user of the invention, it is sufficient to state in the particulars of objection that the invention was used by manufacturers generally at a particular place without naming any person or specifying any manufactory. If he relies on a specified user by certain persons named, proof of user by any one of the persons named will support his objection. (d) If the place or places are not named, the defendant will not be allowed to give evidence of the user. (e)

(a) *Bentley v. Keighley*, 7 M. & Gr. 652.

(c) *Russell v. Ledsam*, 11 M. & W. 647.

(b) *Bulnois v. Mackenzie*, 4 Bing. (N. C.) 127; 1 Webs. P. R. 260; *Perry v. Mitchell*, 1 Webs. P. R. 269; *Electric Telegraph Co. v. Nott*, 4 C. B. 462.

(d) *Palmer v. Wagstaff*, 8 Exch. 840.

(e) *Palmer v. Cooper*, 9 Exch. 213.

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Further notice.

If the plaintiff thinks that the notice of objection does not sufficiently raise the point on which the defendant intends to rely, his course is to apply to a judge at chambers for an order for the delivery of a more specific notice, and if he omits to do so he cannot object to the generality of the notice at the trial; the only question then is whether the notice is sufficiently large to include the objections relied on by the defendant. (a)

If the evidence is within the literal meaning of the words of the particulars, however general the statement, it will be received at the trial. Thus where the particulars stated that the invention had been generally known and publicly used in corn mills for many years previously, evidence that the invention had been in use before the date of the patent in mills in Cheshire was admitted. (b)

17 & 18 Vict.
c. 125, s. 51.
Interrogatories.

It is no ground for refusing to answer interrogatories under s. 51 of the Common Law Procedure Act, 1854, when the defendant admits the infringement; that the defendant's customers may be liable to actions for infringement. (c) Where the cause of action arose more than six years before the action was commenced, the Court refused to allow the plaintiff to administer interrogatories before declaration. (d)

Discovery.

In an action by a patentee against a licensee, the declaration stated that the plaintiff obtained a patent for an improved roving machine, and had covenanted to

(a) *Neilson v. Harford*, 8 M. & W. 806; 1 Webs. P. R. 331; *Hull v. Bollard*, 1 H. & N. 134.

(b) *Hull v. Bollard*, 1 H. & N. 134.

(c) *Telfey v. Easton*, 18 C. B.

643. As to the form and extent of interrogatories which may be exhibited to a defendant before plea, see *Thomas v. Tillie*, 17 Ir. C. L. R. 783.

(d) *Jones v. Pratt*, 6 H. & N. 697.

grant a licence on certain terms to the defendant, he paying so much for each machine made with the plaintiff's invention, and covenanting to keep a true account of and pay for all the machines he made with the plaintiff's invention applied; and that he would not during the continuance of the licence, make or vend machines, without the invention of the plaintiff. Breaches first that the defendant did not pay the sums due for licences, and secondly, that he made and sold machines without the plaintiff's invention being applied. The defendant, in answer to the interrogatories, stated that he had made and sold 1,200 machines, to which the plaintiff's invention had not been applied, but declared that he could not give any information as to the persons to whom he had sold them; and that he could not give any further information about them. The defendant, however, gave the addresses of the persons to whom he had sold the machines with the invention, but alleged that he could give no further information about them without disclosing his own evidence; and the plaintiff claiming in respect of all the machines the defendant had made under one or other of the covenants, and asserting that he had seen some of them, which had his invention applied; it was held that the defendant was entitled to such particulars as should describe those portions of the machines to which the plaintiff contended that his invention had been applied, so as to enable the defendant to understand as far as possible the nature of the machine as to which he was to be charged under either of the covenants, and that it was no answer to the application for such particulars that the defendant's answer to the interrogatories was insufficient to enable the plaintiff to furnish the particulars; for if the answers were insuffi-

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cient, they should have been objected to. But the plaintiff was allowed to inspect the machines on the premises of the defendant, and also to examine him *vivâ voce*. (a)

Inspection.

By 15 & 16 Vict. c. 83, s. 42, it is provided that in any action, in any of the superior Courts of record at Westminster for the infringement of letters patent, it shall be lawful for the Court in which such action is pending, if the Court is then sitting, or if it is not then sitting, for a judge of such Court, on the application of the plaintiff or defendant respectively, to make such order for an inspection, and to give such direction respecting such action and inspection, and the proceedings therein, as to such Court or judge may seem fit.

Affidavit
must be clear
and precise.

The affidavit in support of an application for an order under this section must be clear and precise. Where in an action for the infringement of a patent for numbering and paging books, it was sworn in the affidavit "that the machine used by the defendants for paging and numbering their books is the same for which the plaintiff has obtained a patent," it was held that the affidavit was too vague and defective, and that it ought to have stated at least that there was such a machine, and that the plaintiff had reason to believe it was an infringement. (b)

When appli-
cation may be
made.

There is no limitation in the Act as to the time when the application is to be made, the enactment is general and applicable whenever an action is pending; an application therefore made before the delivery of the declaration is not premature. But an order for inspection will not be granted as of course, and the applicant must show that it is material and really wanted for the purposes of

Inspection
not matter of
course.

(a) *Jones v. Lee*, 25 L. J. Exch.) 241.

(b) *Shaw v. The Bank of England*, 22 L. J. Exch. 26.

the cause. (a) The inspection mentioned in the statute is an inspection of the instruments or machinery manufactured by the parties with a view to evidence of infringement, and does not refer to an inspection of books, which is provided for by another Act of Parliament. (b) The Court will not compel the defendant to grant an inspection of his books, under 14 and 15 Vict. c. 99, s. 6, unless a *prima facie* legal right is established by the plaintiff, and it is not enough for the plaintiff to show that he has been injured, and that there is a possibility of his discovering the amount of injury that he has suffered, if he is allowed to examine the books. (c)

An order will not be made, if the defendant positively swears that he does not use the plaintiff's invention, and the plaintiff does not swear that the invention is used. Thus in an action for the infringement of a patent for a mode of making veneers or mouldings, an order was refused, as it was doubtful on the plaintiff's affidavit whether the patent was for the kind of veneering, or for the process by which it was done; and the defendant positively swore that he used no machinery in his process. (d)

In *The Patent Type Founding Co. v. Walter*, (e) an application to the Court of Exchequer for leave to inspect, and if necessary to take specimens of type, alleged to be made according to the plaintiff's patent, for the purpose of analysis, was refused. The plaintiffs

(a) *Amies v. Kelsey*, 22 L. J. Q. B. 84.

(b) *Vidi v. Smith*, 3 El. & Bl. 974. And see *Smith v. The Great Western Railway Co.*, 3 W. R. 69.

(c) *Smith v. The Great Western Railway Co.*, 3 W. R. 69.

(d) *Meadows v. Kirkman*, 29 L. J. Exch. 205.

(e) 5 H. & N. 192.

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thereupon filed a bill against the defendant, and an order was made for him to deliver a sample of type to the plaintiffs for analysis. (a) Where the defendants refused to produce their books before the Master for the purpose of taking an account, on the ground that they were about to appeal, an order was nevertheless made for production and inspection of the books. (b)

Injunction.

By 15 & 16 Vict. c. 83, s. 42, it is provided that in any action in any of the superior Courts of record at Westminster for the infringement of letters patent, it shall be lawful for the Court in which such action is pending, if the Court be then sitting, or if the Court be not sitting, then for a judge of such Court, on the application of the plaintiff or defendant respectively, to make such order for an injunction, and to give such direction, respecting such injunction and the proceedings therein respectively, as to such Court or judge may seem fit.

Rule for injunction is rule to show cause only in first instance.

Costs.

A rule for a writ of injunction to restrain a defendant from infringing a patent is a rule to show cause only in the first instance. (c)

It is provided, by 5 & 6 Will. IV. c. 83, s. 6, that in any action for infringing the right granted by letters patent, in taxing the costs thereof, regard shall be had to the part of such case which has been proved at the trial, which shall be certified by the judge before whom the same shall be had, and the costs of each part of the case shall be given according as each party has succeeded or failed therein, regard being had to the notice of objections as well as the counts in the declaration, and without

(a) S. C. Johns. 727.

(b) *Saxby v. Easterbrook*, L. R. 7 Exch. 207.

(c) *Gittins v. Symes*, 15 C. B.

362, a case which was decided under 17 & 18 Vict. c. 125, s. 82.

regard to the general result of the trial. And by the Patent Law Amendment Act, (a) it is provided that, in taxing the costs of any action in any of the superior Courts at Westminster, for infringing letters patent, regard shall be had to the particulars delivered in such action; and the plaintiff and defendant respectively shall not be allowed any costs in respect of any particular, unless certified by the judge before whom the trial was had to have been proved by such plaintiff or defendant respectively, without regard to the general costs of the cause, and that it shall be lawful for the judge before whom any such action shall be tried to certify that the validity of the letters patent in the declaration mentioned came in question; and the record with such certificate being given in evidence in any suit or action for infringing the said letters patent, or in any proceeding by *scire facias* to repeal the letters patent, shall entitle the plaintiff in any such suit or action, or the defendant in such proceeding by *scire facias* on obtaining a decree, decretal order, or final judgment, to his full costs, charges, and expenses, taxed as between attorney and client, unless the judge making such decree or order, or the judge trying such action or proceeding, shall certify that the plaintiff or defendant respectively ought not to have such full costs. This section virtually repeals section 3 of 5 & 6 Will. IV. c. 83.

Where the defendant obtained a verdict on a plea which went to the whole action, it was held that he was entitled to the general costs of the cause, deducting the costs of the objections on which the plaintiff succeeded and of the issues found for him. (b)

(a) 15 & 16 Vict. c. 83, s. 43. (b) *Losh v. Hague*, 5 M. & W. 387.

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 Judge's certificate.

The defendant will not be entitled to the costs of his particulars of objections, even in the case of a non-suit, if the judge has not certified that they have been proved. "These particulars," said Parke, B., "and the costs with respect to them, are wholly the creatures of this Act of Parliament; and the Act makes the judge's certificate a condition precedent to the recovery of such costs from the opposing party." (a)

The certificate should be as to the determination of each objection, of which notice has been given, and not as to the issues. (b)

Where the defendant pleaded that the invention was not new and a verdict was given for the plaintiff, it was held that the validity of the patent might be considered to have come in question under the plea, so as to entitle the plaintiff to a certificate to that effect under 5 and 6 Will. IV. c. 83, s. 3. (c)

The judge has no power to grant a certificate after taxation. (d)

If the defendant at the trial consents to a verdict for the plaintiff, without any evidence being given to prove the validity of the patent, the judge will not certify that the validity of the patent came in question before him, as the certificate would affect third parties; and it would be possible for two parties by collusion to consent to a verdict in favour of a patent, and to use the certificate afterwards to the injury of another party who was really contesting the validity of the patent. (e)

(a) *Honiball v. Bloomer*, 10 Exch. 538.

(b) *Losh v. Hague*, 5 M. & W. 387.

(c) *Gillett v. Wilby*, 9 C. & P. 334.

(d) *Gillett v. Green*, 7 M. & W. 347.

(e) *Stocker v. Rodgers*, 1 C. & K. 99.

Where an action was brought to recover damages for an alleged infringement, and a compromise was made upon terms embodied in an order of *nisi prius*, and a verdict was by agreement entered into for 40s. and costs, "with all usual certificates," and the judge indorsed and signed on the record a certificate that the record in another case in which the validity of the letters patent had come in question, and the certificate had been given in evidence before him, it was held that the certificate was improperly granted, the record and certificate in the former action not having been given in evidence, and it not being, under the circumstances, a "usual certificate" within the contemplation of the parties. (a)

If a plaintiff gives notice of trial, which is afterwards abandoned, the defendant is entitled to the costs of preparing the particulars of objection and the evidence in support of them, as the statute applies only to cases where there has been a trial; where there has been no trial, the law stands as it did before. (b)

Trial abandoned, costs of particulars.

Where the defendant applied for time to plead, which was granted upon the terms that he should take short notice of trial, and that the cause might be set down for trial before issue joined, in order that the case might be tried at the next sittings, and the pleas were afterwards delivered, and on the application of the plaintiff a special jury was nominated but not struck, and the action was abandoned without joinder of issue or notice of trial, it was held that the master was right in disallowing the defendant's costs of preparing for the trial. (c)

(a) *Bovill v. Hadley*, 17 C. B. (N. S.) 435. *ties Railway Co.*, 1 El. & El. 961.

(b) *Greaves v. Eastern Counties Railway Co.*, 10 Jur. (N. S.) 823.

(c) *Curtis v. Platt*, 10 Jur. (N. S.) 823.

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If a cause has not been tried, the defendant is not entitled, under 6 Geo. IV. c. 50, s. 34, to the costs of a special jury, for which he has applied. (a)

Account.

The Court may, upon the application of the plaintiff or defendant respectively, make such order for an account, and give such directions respecting such account and the proceedings therein as the Court may think fit. (b)

Power of court.

The meaning of the legislature was to vest in the Courts of Common Law in which actions for the infringement of patent rights might be brought the power to order an injunction, inspection and account previously exclusively exercised by Courts of Equity; so that suitors might be saved the vexation, delay, and expense to which they had before been exposed. The Court may grant either an interlocutory order, an account of all articles sold during the action, or after verdict for the plaintiff and as part of the final judgment, an account of all profits made by the defendant since the commencement of the action, and after notice that an account would be required. But the Court has no power where damages nominal or substantial have been recovered to order an account of profits made by the defendant prior to the commencement of the action, the damages assessed by the jury being considered as the compensation for the loss of such profits. (c)

Retrospective account.

No retrospective account can be granted before final judgment, but the Court has authority to order the defendant pending the action to keep an account of all the articles that he sells made upon the principle alleged to

(a) *Greaves v. Eastern Counties Railway Co.*, 1 El. & El. 951.

(b) 15 & 16 Vict. c. 83, s. 42.

(c) *Holland v. Fox*, 3 El. & Bl. 983.

be an infringement of the plaintiff's patent, and of the profits arising therefrom until further order of the Court; on condition of the plaintiff agreeing to waive all claim to recover more than nominal damages at the trial of the action, and on condition that in case the verdict and judgment in the action shall be in favour of the defendant he will pay to him the expense of keeping such account. (a)

Reasonable evidence of the validity of the patent and of its having been infringed must be given. (b)

As there can be no order for an account of profits until final judgment, any prior account ordered to be kept of sales pending the action can only be ancillary to this account of profits; the interim account of sales becoming nugatory if there should be a verdict and judgment for the defendant. (c)

An account will be granted as soon as the verdict is given, and the defendant cannot refuse to allow his books to be inspected for the purpose of taking an account on the ground that he is about to appeal. (d)

Where the patentee has obtained a verdict, an account will be ordered of all pirated goods made and sold by the defendant, and of the number he has in stock, and he will be ordered to pay over the price received for the articles sold and the value of those remaining in stock. (e)

If a person adopts a part only of a patentee's invention he will be liable to account. (f)

(a) *Vidi v. Smith*, 3 El. & Bl. 969.

(b) *Ib.*

(c) *Holland v. Fox*, 3 El. & Bl. 985.

(d) *Sarby v. Easterbrook*, L. R. 7 Exch. 207.

(e) *Holland v. Fox*, 23 L. J.

Q. B. 211.

(f) *Trotman v. Wood*, 16 C. B. (N. S.) 479.

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The account will be for all profits that the defendant has made by selling the patented article, not of all profits of which the plaintiff has been deprived by the infringement. (a)

(a) *Elwood v. Christy*, 18 C. B. (N. S.) 494. For form of rule or order, see *Holland v. Fox*, 3 E. & B. 977; *Walton v. Lavater*, 8 C. B. (N. S.) 191.

CHAPTER XIV.

OF A SUIT IN EQUITY.

THE jurisdiction of the Court of Chancery in respect of patents is founded upon the assumption of the legal rights of the patentee to the exclusive use of the invention comprised in his letters patent ; and the Court exercises great latitude and discretion in dealing with any application made to it. (a)

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Jurisdiction of
the Court of
Chancery.

If the patentee is unable to support his patent on a trial to ascertain its validity, a bill to restrain the infringement of the patent cannot be supported. (b)

It must be remembered that the Court now has the power of determining questions of law or fact. (c)

It was said at one time that if the title was not clear at law the Court would not grant an injunction, till the title was ascertained, but in the case of *The Universities of Oxford and Cambridge v. Richardson*, (d) Lord Eldon refused to accede to that proposition, and said : “ There are many instances within my own memory in which this Court has granted or continued an injunction to the hearing under such circumstances. In the case of patent rights if the party gets his patent and puts his invention

Injunction
may be granted
though title not
ascertained by
trial.

(a) *Bacon v. Jones*, 4 M. & Cr. 436.

(b) *Calcraft v. West*, 2 J. & Lat. 123.

(c) See *post*, Trial of questions of law or fact.

(d) 6 Ves. 707.

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Possession
under colour
of title.

Course of pro-
cedure on
application for
injunction.

into execution and has proceeded to a sale that may be called possession under it, however doubtful it may be whether the patent can be sustained; this Court has lately said possession under colour of title is enough to enjoin and continue the injunction until it shall be proved at law that it is only colour of title and not real title.”

On an application for an injunction the Court has the power to grant the injunction without more; this course however will not be taken when the defendant questions the validity of the patent, but the Court will either grant an injunction and direct the plaintiff to establish his legal title, or will require him to establish his legal title and suspend the grant of the injunction until that investigation is completed, the defendant in the meantime keeping an account. (a) In *Bridson v. M'Alpine*, (b) Lord Langdale, M.R., said: “When an injunction is asked to restrain the infringement of a patent, the Court has occasion to consider, first the validity of the patent, and secondly the fact of the infringement. Where these two facts are established, it is within the power as it is the duty of the Court to grant the injunction. It depends on the degree of doubt which exists on these questions whether the Court will grant the interim injunction. In such cases it will cautiously consider the degree of convenience or inconvenience to the parties by granting or not granting the injunction. These things are to be carefully considered; the right between the parties is a legal right, and being a legal right, the Court in cases where the matter is doubtful, is naturally anxious to obtain the decision of the Court of Law where the

(a) *Bacon v. Jones*, 4 M. & Cr. 436; *Hill v. Thompson*, 3 Mer. 626.

(b) 8 Beav. 231.

matter is properly cognizable, before it interferes to prevent a party exercising his *primâ facie* right. According to the doubt which may exist in the mind of the Court upon the facts and according to the degree of inconvenience to the parties, the Court not thinking fit to grant the injunction at the time, may take one of several courses; it may either refuse to grant the injunction simply, or it may refuse it on the terms of the party undertaking to keep an account, or it may direct the motion to stand over, on the terms of the plaintiff proceeding to a trial at law. Where it has been determined that the plaintiff must first establish his right at law, the Court does not generally interfere with the mode of trying the legal question, though in some instances it may require the parties to make the necessary admissions of facts to facilitate the trial. It is to be remembered that the proceeding is not like the trial of an issue, but an action in the ordinary form, with which generally the Court will not interfere until the legal right has been determined at law. I must, however, qualify this by saying that in cases of overwhelming mischief, the Court has authority to interfere at any time.”

In certain cases an injunction if improperly granted might cause infinitely more mischief to the defendant than the delay in granting it would cause to the plaintiff, as where the defendant's works are very extensive, and in such a case the legal right must be proved beyond all possibility of doubt before an injunction will be granted. (a)

Injunction not granted before title ascertained if injury to defendant great.

The Court will not as a general rule grant an injunc-

(a) *Neilson v. Forman*, 2 *Neilson v. Thompson*, 1 *Webs. Coop. C. C.* 61, n. *S. C. nom.* P. R. 278.

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Injunction
granted where
uninterrupted
enjoyment.

tion unless satisfied, the legal right being disputed, that in the result, such legal right would be established, or the legal right not being disputed that the acts complained of are an infringement. (a)

Where the plaintiff has had uninterrupted enjoyment of his patent, the court will not look into the title, but will give credit to it, and will continue an injunction to restrain infringement until it has been shown that the title is bad. (b)

In *Hicks v. Raincock*, (c) a demurrer to a bill, on the ground that the plaintiff had not established his title at law, was overruled.

In *Hill v. Thompson*, (d) Lord Eldon said: "Where a patent has been granted, and an exclusive possession of some duration under it, the Court will interpose its injunction without putting the party previously to establish the validity of his patent by an action at law. But where the patent is but of yesterday, and upon an application being made for an injunction, it is endeavoured to be shown in opposition to it that there is no good specification, or otherwise that the patent ought not to have been granted, the Court will not from its own notions respecting the matter in dispute act upon the presumed validity or invalidity of the patent without the right having been ascertained by a previous trial, but will send the patentee to law and oblige him to establish the

(a) *The Electric Telegraph Co. v. Nott*; 2 Coop. C. C. 48; *Wood v. Cockrell*, *ib.* 58, n.; *Jones v. Pearce*, *ib.* 1 Webs. P. R. 122; *Renard v. Levinstein*, 2 H. & M. 628.

(b) *Boulton v. Bull*, 3 Ves.

140; *Harmer v. Plane*, 14 Ves. 130; *Bickford v. Skewes*, 4 M. & Cr. 500.

(c) 2 Dick. 647.

(d) 3 Mer. 622; 1 Webs. P. R. 236.

validity of his patent in a court of law before it will grant him the benefit of an injunction."

In *Caldwell v. Vanvlissingen*, (a) Sir G. Turner, V.C., said: "It is part of the duty of this Court to protect property pending litigation; but when it is called upon to exercise that duty, the Court requires some proof of title in the person who calls for interference. In the case of a new patent, this proof is wanting: the public whose interests are affected by the patent have had no opportunity of contesting the validity of the patentee's title, and the Court therefore refuses to interfere until his right has been established at law. But in a case where there has been long enjoyment under the patent (the enjoyment of course including use) the public have had the opportunity of contesting the patent; and the fact of their not having done so successfully affords at least *primâ facie* evidence that the title of the patentee is good; and the Court therefore interferes before the right is established at law." (b)

The Court will not on any suggested defect in the specification allow the patentee's privilege to be disturbed until the title has been decided. (c)

Where a legal right exists the Court cannot refuse to interfere for its protection upon grounds which depend exclusively upon considerations of national policy. (d)

A patentee does not lose his title by exclusive enjoyment because he has omitted to proceed by *scire*

(a) 9 Hare, 424.

Curtis v. Cutts, 2 Coop. C. C. 60, n.

(b) See also *Stevens v. Keating*, 2 Ph. 335; *Newall v. Wilson*, 2 D. M. G. 291; *Bovill v. Goodier*, L. R. 2 Eq. 200;

(c) *Muntz v. Foster*, 2 Webs. P. R. 95.

(d) *Caldwell v. Vanvlissingen*, 9 Hare, 215.

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facias to set aside a subsequent patent extending to part of his invention, unless such subsequent patent is put in practice. (a) If the patentee has not only proved enjoyment under the patent, but has also successfully maintained actions at law against infringers, the Court will at once grant an injunction, unless there are sufficient grounds for withholding its interference. (b)

An allegation which is not denied that the defendant's circumstances are such as to render it improbable that he would be able to meet the pecuniary demands to which he would be liable if unsuccessful in establishing his alleged legal right, is an additional reason for granting an injunction under such circumstances. (c) If however it appears from the nature of the invention, or from the conflicting evidence as to its novelty, that the validity of the patent is doubtful, or if the evidence of exclusive possession is not satisfactory, an injunction will not be granted although the patent is of long standing. (d)

Injunction
after verdict.

Where the plaintiff has been directed to ascertain the validity of the patent and has obtained a verdict, an injunction will be granted almost as a matter of course, (e) and where a motion that the verdict should be set aside and a nonsuit entered had failed, Lord Lyndhurst said that it was a matter of course that the injunction should issue till the hearing. (f)

(a) *Newall v. Wilson*, 2 D. M. G. 290.

(b) *Caldwell v. Vanvlissingen*, 9 Hare, 425; *Davenport v. Goldberg*, 2 H. & M. 282; *Bovill v. Goodier*, L. R. 2 Eq. 200.

(c) *Newall v. Wilson*, 19 L. T. (N. S.) 161.

(d) *Collard v. Allison*, 4 M. & Cr. 487.

(e) *Neilson v. Harford*, 1 Webs. P. R. 373.

(f) *Russell v. Cowley*, 2 Coop. C. C. 59, n.

If a trial has been directed the result of which is not conclusive as to the right of the patentee, he must proceed again to prove his right, but no terms will be imposed on him, and the Court may grant an injunction at once, as more evil may be done to the plaintiffs by delaying the injunction than to the defendants by granting it, even if the patent afterwards turns out to be bad. (a)

If after an injunction has been granted upon the terms of the plaintiff's ascertaining his legal right, he does not proceed to trial, the injunction will be dissolved. (b)

Where the plaintiff is assignee of the patent the Court may on directing a trial instead of granting an injunction, order the defendant to admit the plaintiff's title to the patent, (c) but where the plaintiff is merely equitable assignee no admissions will be required. (d)

Before an injunction will be granted a fair *primâ facie* case of infringement must be proved, even though the validity of the patent is not denied; and where the evidence on the question of infringement is conflicting, an injunction will not be granted until it has been ascertained by a trial that the acts complained of amount to an infringement of the patent. (e)

Where the alleged acts of piracy have taken place

(a) *Boulton v. Bull*, 3 Ves. 140; *Neilson v. Harford*, 1 Webs. P. R. 373; *Bridson v. Benecke*, 12 Beav. 7; *Lister v. Leather*, 3 Jur. (N. S.) 433; *Baxter v. Combe*, 3 Ir. Ch. 245.

(b) *Bickford v. Skewes*, 4 M. & Cr. 501.

(c) *Morgan v. Seaward*, 1 Webs. P. R. 169.

(d) *Pidding v. Franks*, 1 Mac. & G. 56.

(e) *Hill v. Thompson*, 3 Mer. 626; 1 Webs. P. R. 236; *Bridson v. McAlpine*, 8 Beav. 230; *The Electric Telegraph Co. v. Nott*, 2 Coop. C. C. 41; *Caldwell v. Vanvlissingen*, 9 Hare, 424.

Terms.

Assignee.

Infringement
must be shown.

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abroad it becomes the duty of the defendant to give evidence of a negative character to prove (in answer to the *primâ facie* case made by the patentee) that his process is different from that which has been patented, and where such negative evidence was not given by the defendant, but positive evidence on behalf of the patentee was given by a workman employed in the foreign manufactory that the processes were identical, it was held that there was sufficient evidence to warrant the grant of an injunction. (a)

The length of time for which the patentee has had exclusive enjoyment will influence the Court in granting an injunction where there is a *primâ facie* case of infringement. (b)

If the patented article is made abroad, and is sent to this country for shipment to foreign customers, there will be such a user of the invention as to entitle the patentee to an injunction. (c)

It is no answer to a motion for an injunction that the defendant has volunteered to keep an account; (d) nor that he has promised not to repeat the infringement. (e)

Where the Court is of opinion that the plaintiff is entitled to a decree at once, the final order will not be delayed pending an appeal. (f)

Two patents.

Where two parties have obtained patents for the same invention the Court will not interfere to prevent either of

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

(b) *Davenport v. Richard*, 3 L. T. (N. S.) 503.

(c) *Betts v. Neilson*, L. R. 3 Ch. 429; *Neilson v. Betts*, L. R. 5 H. L. 1.

(d) *Renard v. Levinstein*, 2 H. & M. 628.

(e) *Losh v. Hague*, 1 Webs. P. R. 200; *Geary v. Norton*, 1 De G. & S. 9.

(f) *Penn v. Bibby*, L. R. 3 Eq. 308.

them from doing what he has a right to do by the act of the Crown, but will leave them to try their legal right by *scire facias*. (a)

The conduct or admissions of the defendant may be such as to show that he has admitted the validity of the patent. Thus where the plaintiff and defendant had worked the patent as partners under circumstances which afforded a presumption that, during the continuance of the partnership the defendant had not disputed that the patent was valid, the Court, upon an interlocutory application for an injunction, assumed that the patent was valid; (b) and where the defendant had not contested the validity of the patent when the plaintiff had raised the question in a previous suit of which the defendant had knowledge, it was held that the conduct of the defendant entitled the plaintiff to an injunction until the validity of the patent could be ascertained. (c)

Admissions of
defendant.

In *Dudgeon v. Thompson* (d) the plaintiff in the year 1872 commenced proceedings against the defendant in Scotland, and the Lord Ordinary granted an interdict which was afforded by the Court of Session in 1873. On an application for an injunction, Sir G. Jessel, M. R., said: "The Court can grant an injunction before the hearing where the patent is an old one and the patentee has been in long and undisturbed enjoyment of it, or where its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to

(a) *Copeland v. Webb*, 11 W. R. 134. See also *Basket v. Cunningham*, 2 Eden, 137.

(b) *Muntz v. Grenfell*, 2 Coop. C. C. 61, n.

(c) *Betts v. Menzies*, 3 Jur. (N. S.) 357.

(d) 30 L. T. (N. S.) 244.

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enable the Court to say, that, as against the defendant himself, there is no reason to doubt the validity of the patent."

Injunction
may be granted
though patent
recent.

If the patent is new, and if it has not acquired the sanction of enjoyment, the Court will as a rule, however plain the case may be, exercise its own judgment upon the subject until the plaintiff has established his legal title. (a)

But the Court has power to grant an injunction to restrain the infringement of a recent patent without requiring the patentee to establish his right, if it appears that such a course will do justice between the parties. (b)

Where an action has been brought to establish the validity of a patent, and it has been referred to arbitration, the award of the arbitrator will be considered as equivalent to a verdict establishing the validity of the patent against which there has been no motion for a new trial. (c)

Where the award is that the patent is not illegal the defendant in a subsequent suit between the same parties is not estopped from disputing the validity of the patent. (d)

Injunction not
granted where
trial ordered.

An injunction will not be granted after the patentee has been directed to ascertain his right by a trial until the title is fully decided. Thus; after the patentee had obtained a verdict in an action; an application to revive

(a) *Hill v. Thompson*, 3 Mer. 626; 1 Webs. P. R. 236; *Caldwell v. Vanvlissingen*, 9 Hare, 424.

(b) *Bacon v. Jones*, 4 M. & Cr. 436; *The Electric Telegraph Co. v. Nott*, 2 Coop. C. C. 49; *Gardner v. Broad-*

bent, 2 Jur. (N. S.) 1041; *Clark v. Ferguson*, 1 Giff. 184; *Renard v. Levinstein*, 10 L. T. (N. S.) 176.

(c) *Lister v. Eastwood*, 26 L. T. 4.

(d) *Newall v. Elliott*, 9 Jur. (N. S.) 359.

an injunction was ordered to stand over until the result of a motion for a new trial, which the defendant intended to make, should be known. (a)

The plaintiff is not precluded from asking for an injunction at the hearing, by the fact of his not having applied for it on an interlocutory motion; he must show his title clearly, and if he fails in that and has not previously obtained an injunction, he will not be allowed to use the facts proved in the cause as evidence of a *prima facie* case. (b) ‘ ‘ Generally speaking, ’ ’ said Lord Cottenham, ‘ ‘ a plaintiff who brings his cause to a hearing is expected to bring it on in such a state as will enable the Court to adjudicate upon it, and not in a state in which the only course open is to suspend any adjudication until the party has had an opportunity of establishing his title by proceedings before another tribunal. ’ ’ (c)

Injunction at the hearing.

An injunction will not be made perpetual until the validity of the patent has been conclusively established. (d)

A patentee who discovers that his patent is being infringed must proceed to assert his rights at once, and where there has been delay, an injunction will not be granted until the plaintiff has proved his title, even though the Court is in his favour, on the question of the validity of the patent.

Delay and acquiescence.

But he will have some time allowed him for the purpose of making inquiries. Thus where the plaintiff received

(a) *Hill v. Thompson*, 3 Mer. 631; 1 Webs. P. R. 238; *Col-lard v. Allison*, 4 M. & Cr. 487; *Bridson v. M'Alpine*, 8 Beav. 229.

(c) *Bacon v. Jones*, 4 M. & Cr. 437. And see *Patent Type Founding Co. v. Walter*, Johns. 731.

(b) *Bacon v. Spottiswoode*, 1 Beav. 382.

(d) *Hill v. Evans*, 4 De G. F. & J. 288; 8 Jur. (N. S.) 525.

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notice that his patent was being infringed on the 23rd of March, and inquiries were made and some correspondence took place between the parties, and the bill was not filed till the 7th of July, it was held that there had not been such delay as to deprive the plaintiff of his right to an injunction. (a) But where the plaintiff knew of the alleged infringement in August, 1835, and did not apply for an injunction till the year 1839, the Court refused either to grant the injunction or to retain the bill; Lord Cottenham, L. C., said: "It is no trifling grievance to a defendant to have a chancery suit hanging over him for four years, in which, if the Court shall so determine at the hearing he will have to account for all the profits he has been making during the intermediate period. Is a defendant to be subject to this annoyance without any absolute necessity or even any proportionate advantage of his adversary, and without that adversary being able to show any reason why he did not apply at an earlier time? It appears to me that it would be very injurious to sanction such a practice, more especially when I can find no case in which the Court has thought it right to retain a bill simply for the purpose of enabling a plaintiff to do that which this plaintiff might have done at any time within the last four years." (b) And where the plaintiffs delayed making their application for a year, the injunction was refused, Lord Langdale saying: "I think that a party coming for the assistance of this Court to protect a legal right not absolutely established, against the party who is alleged to have infringed it, ought to come at an early period, I do not say at the earliest possible

(a) *Losh v. Hague*, 1 Webs. P. R. 201.

(b) *Bacon v. Jones*, 4 M. & Cr. 436.

period, because that would be putting an application for an injunction on notice, where all parties have an opportunity of being heard in the same condition, as an injunction *ex parte*, which it would not be expedient to do. The rule of this Court is very strict that you must apply in proper time." (a)

In *Bovill v. Crate* (b) an injunction was refused although the delay was caused by the difficulty the plaintiff had found in selecting a person to proceed against from a number who had infringed the patent.

If a patentee is aware that any person is about to use what he alleges to be his invention and he allows him to go on and expend money in erecting machinery and to use it, he will not be entitled to an injunction. (c)

Where the patent has expired the defendant may upon a motion to commit for breach of the injunction show that by the expiration there is no longer any order of the Court existing which he has infringed. (d) But an injunction may be granted to restrain the sale, both before and after the expiration of the term limited by the patent, of machines piratically manufactured while the patent is in force with a view of throwing them upon the market when the patent has expired. (e)

Patent expired.

The invalidity of a patent on the ground of the expiration of a foreign patent cannot be raised at

(a) *Bridson v. Benecke*, 12 Beav. 1. And see *Baxter v. Combe*, 1 Ir. Ch. 284; *Hancock v. Bewley*, Johns. 601; *Smith v. London and South Western Railway Co.*, Kay, 417.

(b) L. R. 1 Eq. 388.

(c) *Neilson v. Thompson*, 1 Webs. P. R. 275.

(d) *Daw v. Eley*, L. R. 3 Eq. 496.

(e) *Crossley v. Beverley*, 1 R. & M. 166, n.; 1 Webs. P. R. 119; *Price's Patent Candle Co. v. Bauwen's Patent Candle Co.*, 4 K. & J. 731.

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the hearing if the point has not been raised by the answer. (a)

Misrepresentation of machine.

A manufacturer will not be restrained from selling, as the plaintiff's machines, "with the latest improvements," old machines manufactured and sold by the plaintiff without such improvements. (b)

Trial of questions of law or fact.

Formerly when a question of law or fact arose during the trial of a suit in equity, it was necessary to state a case for the opinion of a Court of Law on the legal question, or to direct an issue as to the question of fact, or to direct an action to be tried at law if a mixed question of law or fact was raised, the bill being retained until the points in dispute were settled. By 15 and 16 Vict. c. 36, ss. 61 and 62, power was given to the Court of Chancery to determine any question of law which in the judgment of the Court should be necessary to be decided previous to the decision of the equitable question at issue between the parties, and also to determine the legal title or right of any party seeking equitable relief. By 21 and 22 Vict., c. 27, power was given to the Court to try questions of fact before itself either with or without a jury. These powers were enlarged by 25 and 26 Vict. c. 42 which enacted that the Court, should determine every question of law and fact incident to the relief sought, at the same time giving it power to direct issues to be tried at assizes when more convenient.

Where the validity of the patent had already been established in an action, an issue was directed to try whether the plaintiff was the true and first inventor. (c)

(a) *Bovill v. Goodier*, L. R. 2 Eq. 195. *Machine Co. v. Wood*, 20 L. T. (N. S.) 10.

(b) *Wilcox & Gibbs Sewing* (c) *Bovill v. Goodier*, L. R. 2 Eq. 195.

The effect of the Act is simply to say that the Court shall not send away any case to be tried elsewhere, its powers are not limited. The plaintiff will be entitled to an injunction if he can show long and quiet enjoyment of the patent, or if he has successfully supported it in an action, and the Court will now enter into the question of validity on a motion for an injunction. (a)

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Effect of the
act.

Issues will not be directed to be tried at assizes unless the balance of convenience is greatly in favour of such a course. In *Young v. Fernie* (b) Lord Westbury said: "I construe the statute as laying down the rule for the future that these things shall be heard and determined in this Court. The proviso operates by way of exception only to the rule; and in order to bring a case within the proviso, the Court must be satisfied that the administration of justice in the particular suit may be more conveniently exercised and promoted by directing issues to be tried by a jury at the assizes or at any sittings in London or Middlesex for the trial of issues in the Common Law Courts, than by completing the hearing and enquiry before itself. In a patent case particularly, and in this case, having regard to the nature of the questions raised, I do not think that anything more inconvenient can be suggested than that where there are mixed questions of law and fact, the one bound up with the other and scarcely capable of being separated, an attempt should be made to cut the cause in halves and to send one half of it to be tried by a jury in a Court of Common Law, reserving the other half for the determination of this Court." (c)

The usual issues may be granted before the hearing of

Grant of issues.

(a) *Davenport v. Jepson*, 1 N. R. 173.

(b) 1 De G. J. & S. 354.

(c) And see *Fernie v. Young*, L. R. 1 H. L. 63; *Copeland v. Webb*, 1 N. R. 119.

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the cause, although the defendant denies the validity of the patent. (a) Issues will not be granted at the request of the defendant when the motion is opposed by the plaintiff. (b)

Separate issues.

The Court may direct separate issues to be tried before itself; the practice is not to be considered as peremptory, but is to be regarded as nothing more than a convenient mode of arranging the questions to be decided by the Court. (c)

Addition of new issue.

A defendant will not be allowed to add a totally new issue of fact not in any way suggested by his answer, to the issues which have been already directed for trial, and it appears that to raise such new issue the defendant must file a supplemental answer. (d)

Forms of issues.

The forms of issues usually adopted are those ordered to be tried in *Davenport v. Jepson*, (e) as follows:—

1st. Whether the invention in the pleadings mentioned was the working or making of any manner of new manufacture which others at the time of making the letters patent of the ——— day of ——— 18—— in the pleadings mentioned did not use?

2nd. Whether the grantee of the said letters patent was the true and first inventor of the said new manufacture?

3rd. Whether the specification particularly described and ascertained the nature of the invention for which the said letters patent were granted, and the manner in which the same is to be performed?

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

(c) *Curtis v. Platt*, 11 L. T. (N. S.) 250.

(b) *Henderson v. Runcorn Soap and Alkali Co.*, 19 L. T. (N. S.) 277.

(d) *Morgan v. Fuller*, L. R. 2 Eq. 296.

(e) 1 N. R. 307.

4th. Whether the said defendant A. B. has infringed the said letters patent?

In *Renard v. Levinstein*, (a) another issue was added, viz. was the invention one of public utility? (b)

An issue may be granted to determine whether the invention described in the specification is that for which the patent is granted, and the form is as follows: Whether Her Majesty the Queen did grant the letters patent, dated the —— day of —— 18—— for the alleged invention as described and claimed by —— in the specification of the letters patent granted to him for ——.(c)

The plaintiff upon trial of issues is entitled to adduce evidence in reply for the purpose of rebutting the case set up by the defendant, as it is impossible for him to know the nature of the evidence which will be produced, but after his evidence in reply has been given, and the evidence for the defence has been summed up, the defendant will not be allowed to bring further evidence to contradict that given by the plaintiff's witnesses in reply. (d) Evidence.

If the case is clear, the Court will determine the question of fact without reference to a jury. Where the issues raised have already been determined, the defendant has no right to have them referred to a jury *ex debito justitiæ*. But where there is really a doubtful case, the Court will not refuse to have the question decided by a jury if either party wishes it. (e) Right to a jury. "If," said Lord

(a) 11 L. T. (N. S.) 766.

(d) *Penn v. Jack*, L. R. 2 Eq.

(b) See also *Spencer v. Jack*, 11 L. T. (N. S.) 242; *Penn v. Jack*, 14 L. T. (N. S.) 496.

314.

(e) *Davenport v. Goldberg*, 2 H. & M. 282.

(c) *Needham v. Oxley*, 2 N. R. 232.

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Cairns, "the Court thinks it best that a question should be tried before a jury, a jury can be had, but if in the opinion of the Court a trial without a jury is preferable, neither party can claim a jury as a matter of right. It is a fallacy to say that under the old practice the Court required a legal question to be tried by jury. What it required was the judgment of a Court of Common Law. In most cases it was a necessary incident to proceedings at law that there should be the verdict of a jury before judgment, but these cases were sent to law not that they might be tried by a jury, but because this Court had not jurisdiction to decide upon a legal right. (a)

When the plaintiff's counsel made charges which were not raised by the pleadings, and the defendant's counsel thereupon asked for a jury, the application was acceded to, and the cause ordered to stand over. (b)

When the Court is sitting without a jury, it will not require the same strictness in matters of pleading as would be necessary in a trial before a jury, but will follow that course of procedure which it deems best to diminish expense, and to hasten the determination of the suit. Thus where the defendant gave no notice of objections to the patent on the ground of prior publication up to the time of proving the cause, and only gave notice of such objection after the plaintiff's case was closed and his own had been opened, a motion by him to amend his particulars of objections by an allegation of prior publication in a given document was allowed. (c)

(a) *Bovill v. Hitchcock*, L. R. 3 Ch. 417. And see *Patent Marine Inventions Co. v. Chudburn*, 21 W. R. 745.

(b) *Tangye v. Stott*, 14 W. R. 128.

(c) *Renard v. Levinstein*, 11 L. T. (N. S.) 505.

It appears that it is not necessary to certify for a special jury, when questions of fact are tried before the Court itself. (a)

After the jury have delivered their verdict on a given issue, the Court of Appeal will not, except on a motion for a new trial, or a motion for a judgment *non obstante veredicto* enter into the question and set aside the verdict of the jury, and the same rule holds good upon a trial before a judge alone. (b)

There is the same right of appeal from any order of the Court on an application for a new trial as from any other order, (c) and the proviso applies equally whether the trial was with or without a jury. (d)

The verdict of a judge is of the same effect as the verdict of a jury, and any person may apply for a new trial, either to the judge before whom the trial was had, or to the Court of Appeal in Chancery. (e)

An appellant may move for a new trial within the time allowed for that purpose, although the decree has been enrolled. (f)

Where the issues raise mixed questions of law and fact, if the decision of one of the questions discussed is sufficient to dispose of the case, final judgment may be given without ordering a new trial. (g)

(a) *Needham v. Oxley*, 2 N. R. 388.

(b) *Fernie v. Young*, L. R. 1 H. L. 63; *Simpson v. Holliday*, *ib.* 315.

(c) 21 & 22 Vict. c. 27, s. 3. See also *Simpson v. Holliday*, L. R. 1 H. L. 315; *Curtis v. Platt*, *ib.* 337.

(d) *Curtis v. Platt*, L. R. 1 H. L. 337.

(e) 21 & 22 Vict. c. 27, s. 5. See also *Fernie v. Young*, L. R. 1 H. L. 63; *Curtis v. Platt*, *ib.* 337.

(f) *Fernie v. Young*, L. R. 1 H. L. 63.

(g) *Simpson v. Holliday*, L. R. 1 H. L. 315.

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 Rejection of
 evidence.

Where a new trial is moved for on the ground that evidence has been improperly rejected; the evidence ought to have been formally tendered to the judge of the Court below and rejected by him. (a)

The trial of questions of fact and the hearing of the cause should not be fixed for the same day except by consent. (b)

Particulars of
 breaches and
 objections.

The plaintiff must before the trial deliver particulars of the breaches complained of by him, and the defendant must deliver particulars of any objections on which he means to rely at the trial. (c)

If the particulars and the pleadings give the defendant fair notice of the case intended to be made against him by the plaintiff, they will be sufficient. (d) Where the particulars merely mentioned certain machines made by the defendants, they were held to be sufficient. (e) The defendant must in his particulars of objections, put the plaintiff in possession of all he himself knows, so far as to enable him to identify the instances alleged, the principle of the court being to prevent the plaintiff from being taken by surprise. (f)

Where the defendant had been ordered upon the application of the plaintiff to file amended particulars of objections stating "the names and addresses of the persons by whom, and the places where, and the dates at, and the manner in which" there had been alleged user prior to the date of a patent for improvements in carriages, the alleged invention being that the apparatus for open-

(a) *Penn v. Bibby*, L. R. 2
 Ch. 127.

(b) *Fernie v. Young*, L. R. 1
 H. L. 63.

(c) 15 & 16 Vict. c. 83, s. 41.
 And see *ante*, p. 287, as to prac-
 tice at law.

(d) *Renard v. Levinstein*, 11
 L. T. (N. S.) 505.

(e) *Needham v. Oxley*, 1 H. &
 M. 248.

(f) *Curtis v. Platt*, 8 L. T.
 (N. S.) 38.

ing and closing the heads of carriages could be worked by a coachman or person sitting on the driving seat, or by a person sitting behind the carriage; objections that similar head-joints had been commonly used and applied for the same purposes by carriage builders generally throughout Great Britain, long before the date of the plaintiff's patent, and that head-joints similar in form and action to those described in the plaintiff's specification had been actuated in their motions by lever handles and connecting rods before the date of the patent, in carriages fitted up or constructed by various carriage builders in or near London, Liverpool, Manchester, Southampton, and various other of the principal towns of Great Britain, where the carriage building trade had been carried on; were held to be insufficient. (a)

It appears, however, that where the objection points to the public use of a particular preparation, the words "by various makers in or near London" might be sufficient, and that if the defendant cannot give the names of the makers in or near London, etc., he will be required to specify the class or classes of invention with respect to which the alleged prior user has taken place. (b)

The defendant will not be required to deliver particulars of objections where replication has been filed and the Court has refused to direct issues. (c)

Where the novelty of the invention is denied by the answer, the plaintiff has no right to a discovery of the particulars on which the defendant relies as showing prior user. (d)

(a) *Morgan v. Fuller*, L. R. 2
Eq. 297.

(b) *Ib.*

(c) *Bovill v. Goodier*, L. R. 1
Eq. 35.

(d) *Daw v. Eley*, 2 H. & M.

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Form of order.

The following is the form of order for the delivery of particulars :—“ Ordered that the plaintiff do on or before the day of inst. deliver to the solicitor of the said A. B. particulars in writing, of the breaches complained of, and that the said defendant A. B. do on or before the day of inst. deliver to the plaintiff’s solicitor, particulars in writing of any objections on which he means to rely at the trial hereby directed.” (a)

Evidence.

No evidence can be given in support of any alleged infringement or of any objection impeaching the validity of the patent which is not contained in the particulars. (b)

Amendment.

The defendant will not be allowed to produce evidence of prior user not disclosed by the objections, even though it has only come to his knowledge since they were delivered; but leave will be given on short notice of motion, to amend the particulars, so as to introduce such newly discovered evidence, the defendant paying the costs of the application. (c)

Pleading.

It is not necessary for the plaintiff to set out the specification of his patent in the pleadings. Where the bill stated that the plaintiff had obtained a patent for new and improved machinery for preparing and spinning hemp, flax, and other fibrous substances, and that in his specification he had set forth, described and ascertained the nature of his invention and the several parts thereof, and by what means the same was to be performed, and referred for greater certainty to the specification and also alleged

725; *Bovill v. Smith*, L. R. 2 Eq. 459.

(a) *Davenport v. Jepson*, 1 N. R. 307.

(b) 15 & 16 Vict. c. 83, s. 41.

(c) *Daw v. Eley*, L. R. 1 Eq. 38; *Renard v. Levinstein*, 13 W. R. 229; *Penn v. Bibby*, L. R. 1 Eq. 548.

that the plaintiff had been for ten years in the exclusive enjoyment of the patent and had established his legal title by repeated actions, a general demurrer for want of equity was overruled. (a)

Nor is it necessary that there should be an express averment of the novelty of the invention, as the allegation of the grant and production of the letters patent throw upon the defendant the *onus* of disputing the novelty. (b)

Where a bill was filed to restrain the infringement of a patent, and for an account, and the defendants were desirous of disputing the validity of the patent, on the grounds that so far as the invention was new, it was useless, and that so far as it was useful it was not new, the defendant was allowed to plead first that the invention was not useful; secondly, that it was not new. (c)

Before a double plea can be put in, the defendant must obtain an order for leave to do so, and if the plea is filed without an order, it is irregular and liable to be overruled. (d)

The assignee of a patent may maintain a suit to restrain infringement against the assignor and subsequent licensees from him, who have notice of the assignment, although, when the suit was instituted, the assignment had not been registered. (e)

The directors and managers of a company are proper parties. (f)

(a) *Kay v. Marshall*, 1 M. & Cr. 373; *Westhead v. Keene*, 1 Beav. 287.

(b) *Amory v. Brown*, L. R. 8 Eq. 663.

(c) *Kay v. Marshall*, 1 Keen, 190.

(d) *Ib.*

(e) *Hassall v. Wright*, L. R. 10 Eq. 509.

(f) *Betts v. De Vitre*, 34 L. J. Ch. 289.

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Where a company had been formed for the purchase of the plaintiff's patent, and no written contract had been signed, and no assignment had been executed by the plaintiff, but the company claimed some equitable interest in the patent; a demurrer to a bill, to which the company had been made defendants, on the ground of misjoinder of parties, was overruled. (a)

Consolidation
of suits.

If the patent has been infringed by several persons who have no connection with each other, there must be a separate bill against each person who has infringed; (b) the Court will in such a case direct the suits to be consolidated, if possible. Thus, where a patentee had filed 134 bills; upon a motion by 19 of the defendants, that the plaintiff should proceed in such one only of the suits as he should select for the purpose, until such suit should have been determined, or until the validity of the patent should have been decided, and that the proceedings in the other suits should in the meantime be stayed, the defendants undertaking to abide by the result of the suit to be selected, so far as the validity of the patent was concerned, in like manner as if the same result had been arrived at in the several suits; a trial of the validity of the patent as against the plaintiff and the several defendants before the Court, to be conducted by three of the defendants representing different classes of infringers, on behalf of the remainder, all objections to be delivered within a fortnight; was ordered, with liberty for defendants in any of the other suits to apply to be made parties. (c)

In a similar case, Sir W. P. Wood, V. C., suggested that the plaintiff, instead of filing many bills, might, after

(a) *Westhead v. Keene*, 1 Beav. 287.

(b) *Dilly v. Doig*, 2 Ves. J. 478.

(c) *Foxwell v. Webster*, 10 Jur. (N. S.) 136; 2 Dr. & Sm.

250.

getting information of case after case of infringement, select that which he thought the best to try the question fairly, and proceed in that case to obtain his interlocutory injunction, at the same time writing to the others who were *in simili casu*, saying: "Are you willing to take this as a notice to you that the present case is to determine yours? Otherwise I shall proceed against you by way of interlocutory injunction; and if you do not object on the ground of delay, I do not mean to file bills against all of you at once. Am I to understand that you make no objection of that kind? If you do not object, I shall file a bill against only one of you." (a)

The plaintiff, in applying for an injunction *ex parte*, must swear as to his belief that he is the original inventor; for although when he obtained his patent, he might very honestly have sworn as to his belief of such being the fact, yet circumstances may have intervened, or information been communicated, sufficient to convince him that the patent was not his own original invention, and that he was under a mistake when he made his previous declaration to that effect. (b) The reason that such an affidavit is required, is that the injunction asks that a legal title may be protected, which legal title ought to be sworn to, and the facts supported before the Court. (c) The motion may be ordered to stand over, to allow such an affidavit to be made. (d)

(a) *Bovill v. Crate*, L. R. 1 Eq. 391.

(b) Per Lord Eldon in *Hill v. Thompson*, 3 Mer. 624; 1 Webs. P. R. 236; *Sturtz v. De la Rue*, 5 Russ. 329; *Mayer v. Spence*, 1 J. & H. 87.

(c) *Gardner v. Broadbent*, 2 Jur. (N. S.) 1041.

(d) *Mayer v. Spence*, 1 J. & H. 87; *Whitton v. Jennings*, 1 Dr. & Sm. 211.

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The affidavit must state particularly in what the alleged infringement consists. (a)

The plaintiff must prove, first, that the thing made is his own patented article, and, secondly, that it has been unlawfully sold; and he must be prepared to swear distinctly that it is not manufactured by him or his agents. (b)

If there is any material variation between the allegations in the bill or the aid sought by it and the affidavits in support of the plaintiff's case, the injunction will be dissolved, with costs. (c)

Where the patentee is dead, the affidavits must state the title of the plaintiff. (d)

Interrogatories
and discovery.

A defendant who submits to answer must answer fully; he cannot by denial of the plaintiff's title escape answering. (e) In a suit to restrain the infringement of a patent for improvements in preparing colouring matter for dyeing and printing, the process, as described in the specification, consisted in boiling a mixture of red aniline dye and aniline with hydrochloric acid and water. The defendant denied that his process was an infringement, and alleged that it was a secret, and that his trade depended on his keeping it secret. It was held that he was bound to answer whether he used the materials mentioned in the specification, and whether he used any additional materials, but that he was not bound to disclose

(a) *Hill v. Thompson*, 3 Mer. 626; 1 Webs. P. R. 236; *Mayer v. Spence*, 1 J. & H. 87.

(b) *Betts v. Willmott*, L. R. 6 Ch. 239.

(c) *Stocking v. Llewellyn*, 3 L. T. 33.

(d) *Bickford v. Skewes*, 1 Webs. P. R. 211.

(e) *Swinborn v. Nelson*, 16 Beav. 416; *Hoffman v. Postill*, L. R. 4 Ch. 673.

the proportions in which he used the specified materials, nor what the additional materials were. (a)

Where the defendant, by his answer, sets up the defence that the invention is not new, the plaintiff is not entitled to a discovery of the particulars on which the defendant relies, as showing a user of the thing patented prior to the date of the patent; (b) but the defendant may ask any question tending to destroy the plaintiff's claim. (c)

A question in an interrogatory is not less one of fact, because, in maintaining the subject matter of the question, the interrogatory refers to the specification, or to some written document. (d)

The defendant must state the names and addresses of all persons from whom he has received sums of money for the use of articles alleged to have been manufactured in infringement of the plaintiff's right, even though such persons reside abroad; (e) he must also state the number of machines sold by him, the profit, and the names of the purchasers, and cannot refuse to answer, on the ground that he would thereby disclose the names of his customers and the secrets of his trade. (f)

A defendant cannot be excused from answering fully and at once, on the ground that the validity of the patent would require to be established by an issue; (g) but if the discovery sought is wholly immaterial to the plain-

(a) *Renard v. Levinstein*, 3 N. R. 665; 10 L. T. (N. S.) 94.

(b) *Daw v. Eley*, 2 H. & M. 725; *Bocill v. Smith*, L. R. 2 Eq. 459.

(c) *Hoffman v. Postill*, L. R. 4 Ch. 673.

(d) *Ib.*

(e) *Crossley v. Stewart*, 1 N. R. 426.

(f) *Howe v. M'Kernan*, 30 Beav. 547.

(g) *Forwell v. Webster*, 3 N. R. 403.

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tiff's title, which the defendant denies, he will not be obliged to answer, and is not obliged to put in a plea denying infringement. (a)

Where separate bills have been filed against numerous defendants, the plaintiff has a right to have a separate answer from each defendant. (b)

Taking bill
pro confesso.

When a defendant, who was out of the jurisdiction of the Court, had been duly served with the bill and interrogatories, and did not appear or put in an answer, the Court ordered that notice should be given to him, that unless he put in an answer within fourteen days from the service of the notice, an appearance would be entered for him, and proceedings taken to have the bill taken *pro confesso*. (c)

Account.

If the plaintiff is able to establish his title to an injunction, an account will also be granted in order that his remedy may be complete. (d) And if no case is made for an injunction the account will not be decreed; (e) although it may appear at the hearing that since the interim injunction was moved for, the defendants have sold articles, which, had the facts and law been then sufficiently ascertained, the Court would have restrained them from selling. (f)

If a patent has been infringed the patentee is entitled to an injunction and an account, even though the defen-

(a) *De la Rue v. Dickinson*,
3 K. & J. 388.

(b) *Foxwell v. Webster*, 3
N. R. 103.

(c) *Grover & Baker Sewing
Machine Co. v. Millard*, 8 Jur.
(N. S.) 713.

(d) *Baily v. Taylor*, 1 R. &
M. 73.

(e) *Smith v. The London and
South Western Railway Co.*,
Kay, 408; *Kernot v. Potter*, 3
De G. F. & J. 447.

(f) *Price's Patent Candle Co.
v. Bauwen's Patent Candle Co.*,
4 K. & J. 727.

dant has submitted and has offered before suit, to pay the amount of profits made. (a)

Where letters patent are granted to two or more jointly any one of the grantees may use the invention without the consent of the others, and is not liable to account to them for the profits he has made. (b) Where a patentee agreed with the defendant that he should make and sell the patented machines, paying not more than a certain sum as royalty to the patentee for each machine sold, and retaining a certain sum on his own account, so that the total amount charged for each machine should not exceed a fixed sum, it was held that the patentee could not maintain a suit in Equity for an account against the defendant as agent, although in one case he had received a sum of money for the patentee. (c)

If the account is only a part of an agreement which the Court cannot wholly enforce, the account alone will not be decreed, but the parties will be left to their remedy at law. (d)

The account extends over the six years immediately previous to the filing of the bill, and is of all profits and benefits derived from the use of articles made according to the patent for that time. There must be no delay in applying for an account. (e)

(a) *Nunn v. D'Albuquerque*, 34 Beav. 595.

(b) *Mathers v. Green*, L. R. 1 Ch. 29.

(c) *Moxon v. Bright*, L. R. 4 Ch. 292. See also as to account between principal and agent, *Edwards v. Normandy*, 3 N. R. 562.

(d) *Kernot v. Potter*, 3 De G. F. & J. 447.

(e) *Crossley v. Derby Gaslight Co.* 1 Webs. P. R. 119.

As to the form of order for an injunction and account, see *Betts v. De Vitre*, 34 L. J. Ch. 289.

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 Damages.

The Court has power in all cases in which it has jurisdiction to entertain an application for an injunction against a breach of any covenant, contract or agreement, or against the commission or continuance of any wrongful act, or for the specific performance of any covenant, contract or agreement; to award damages to the party injured, either in addition to, or in substitution for such injunction or specific performance, to be assessed either by a jury or by the Court itself. (a)

Not given
 where account.

The Court will not direct both an inquiry as to damages and also an account of profits, as the two things are hardly reconcilable; if an account of profits is taken, the infringement is condoned. (b)

Form of in-
 quiry.

Where an inquiry as to damages is directed the form will be "What damages the plaintiff has sustained," not "what damages, if any," as in the case of a trade mark; the difference between the case of a trade mark and that of a patent being that in the former case the article sold is open to the whole world to manufacture, and the only right the plaintiff seeks is that of being able to say, "Don't manufacture under my mark." He may find his customers fall off in consequence of the defendant's manufactures, but it does not necessarily follow that he can claim damages for every article manufactured by the defendant, even though it be under that mark, whereas on the other hand every sale without licence of a patented article must be a damage to the patentee. (c)

Remedy
 against both
 manufacturer
 and user of
 patented
 article.

Where bills to restrain the infringement of a patent have been filed against both the person who manu-

(a) 21 & 22 Vict. c. 27.

(b) *Neilson v. Betts*, L. R. 5
 H. L. 22; *De Vitre v. Betts*, L.
 R. 6 H. L. 319.

(c) Per Sir W. P. Wood,
 V. C., in *Davenport v. Rylands*,
 L. R. 1 Eq. 302; *Betts v. De
 Vitre*, 34 L. J. Ch. 289.

factures and the person who uses the article, and issues of fact have been found for the plaintiff, he is entitled not only to an account against the manufacturer of the patented article, but also to damages against the person who uses it, wherever it be found. (a) But a plaintiff who has obtained a decree against wrongful users, not being manufacturers of his invention, and who has been paid the ordinary royalty charged by him, by such users, cannot recover any further royalties from the manufacturer who supplied the machines. (b)

Damages may be awarded at the hearing although the patent has expired, if there was jurisdiction when the bill was filed.

Damages may be awarded though patent expired since bill filed.

In *Davenport v. Rylands* (c) Sir W. P. Wood, V. C., said: "*Primâ facie*, I was somewhat impressed with the notion that in order to award damages at the hearing, the Court must have jurisdiction to grant an injunction. But I think that would be a narrow construction to put upon this beneficial Act. If it were adopted in this case and I were to dismiss the bill without costs, an action would be open to the plaintiff, and thus the very mischief contemplated by the legislature would ensue. A person coming here would be turned round and told, 'Although it be true that the jurisdiction existed at the time of the filing of the bill, something has occurred since which prevents the jurisdiction attaching at the hearing, and therefore, now, you must be left to go to law and the whole matter shall be tried over again there. Although this Court has (assuming the construction of the statute I am adopting) full power to grant damages

(a) *Penn v. Bibby*, L. R. 3 Eq. 308.

(b) *Penn v. Jack*, L. R. 5 Eq. 81.

(c) L. R. 1 Eq. 302.

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instead of the injunction and settle the whole dispute between the parties; yet the Court will not do that, in consequence of something that has happened since the filing of the bill, and during litigation.' I think the sound view of the whole case is that I ought to exercise the jurisdiction granted to me by the Act, that I ought to consider myself as having had jurisdiction at the time the bill was filed, for the purpose of ultimately giving relief pursuant to the Act, and therefore I shall direct an inquiry as to what damages the plaintiff has sustained, and I shall give the plaintiff the costs up to the hearing."

There must be no doubt as to the validity of the patent. (a)

Where, however, the bill was filed so immediately before the expiration of the patent as to render it impossible to obtain an interlocutory injunction the bill was dismissed with costs, it being held that it was a mere device to transfer the jurisdiction to award damages from the Court to which that jurisdiction properly belongs, to the Court of Chancery. (b)

A patentee who is not in the habit of manufacturing the patented article but is accustomed to grant particular licences to other manufacturers, on the payment of a royalty, can only on a decree for damages "by reason of user or vending" of the invention, claim damages to the amount of the royalty. He therefore cannot also claim a manufacturing profit, and *à fortiori*, not such a manufacturing profit as he would have made if every unlicensed machine had been sent to him to be fitted with the in-

(a) *Fox v. Dellestable*, 15 W. R. 194.

(b) *Betts v. Gallais*, L. R. 10 Eq. 392.

vention. It appears, however, that it would be otherwise if he had been in the habit of charging infringers with a higher royalty than ordinary licensees. (a)

Where there will be extreme difficulty in the Court seeing its way to assess the damages, it appears that leave will be given to the plaintiff to proceed at law for the purpose of recovering damages. (b)

The plaintiff on making out a *prima facie* case of infringement is entitled to an order to permit him and his witnesses to inspect the defendant's machinery at work on giving reasonable notice, (c) and the defendant and his witnesses will also be entitled to inspect the plaintiff's machinery at work, as it is the object of the Court to enable the parties to produce sufficient evidence at the trial. (d) But an order for inspection cannot be granted when the alleged piracy has taken place abroad. (e) Inspection is not a matter of right; but the Court will require it to be satisfactorily proved, first that there is really a case to be tried at the hearing of the cause; and secondly that the inspection asked for is of material importance to the applicant's case as made out by his evidence. (f)

Inspection.

In *Tolson's Patent* (g) an application for an inspection of a provisional specification, on the ground that the subject matter was the same as that for which the application had obtained a patent, was refused.

Inspection of provisional specification.

(a) *Penn v. Jack*, L. R. 5 Eq. 81. P. R. 458; *Davenport v. Jepson*,

(b) *Betts v. De Vitre*, 11 Jur. 1 N. R. 308.

(N. S.) 9, and see *Hills v. Evans*, 8 Jur. (N. S.) 525.

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

(d) *Morgan v. Seaward*, 1 Webs. P. R. 169; *Bovill v. Moore*, 2 Coop. C. C. 56 n.

(f) *Piggott v. The Anglo-American Telegraph Co.* 19 L. T. (N. S.) 46.

(g) *Russell v. Cowley*, 1 Webs.

(g) 6 D. M. G. 422.

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 Form of order.

The form of the order is as follows: "Ordered that the plaintiff and the defendant A. B. by their solicitors and scientific witnesses be at liberty from time to time upon giving three days' notice of their intention so to do, mutually to inspect the machines heretofore used by the plaintiff and the said defendant in the manufacture of — and that the same machines be put to work upon such inspection, and that the plaintiff and the said defendant, by their said witnesses and solicitors, be at liberty to take samples of the — made or to be made upon the said machines." (a)

The defendant will not be compelled to allow the plaintiff to inspect all the machines in his stock; but he will be directed to verify on affidavit the several kinds of machines that he has sold or exposed for sale, and to produce one machine of each class for inspection, (b) and the plaintiff will be entitled to put the machines to work and take samples of the produce. (c)

Samples for
 analysis.

The Court has power to order the defendant to deliver samples to the plaintiff for the purpose of analysis. Thus where the plaintiffs were the proprietors of a patent for improvements in the manufacture of type, and the defendant was a printer who used types alleged to be a colourable imitation of the type manufactured by the plaintiffs, he was ordered to deliver up a sample for analysis. (d) *Laches* sufficient to defeat the plaintiffs' right to an interlocutory injunction is no bar to an order on the same motion for inspection and analysis. (e)

(a) *Davenport v. Jepson*, 1 N. R. 308.

(b) *Singer Manufacturing Co. v. Wilson*, 5 N. R. 505.

(c) *Davenport v. Jepson*, 1 N. R. 308.

(d) *Patent Type Founding Co. v. Walter*, Johns. 727.

(e) *Ib.*

All articles in the possession of the defendant manufactured in violation of the plaintiff's patent may be ordered to be delivered up and destroyed. (a) But where a patent for a combination of machinery only has been infringed, the Court will not order the defendant's machines to be broken up, but will order them to be marked. (b)

The Court will if asked give such a certificate that the validity of the patent has come in question in the suit and has been determined in favour of the plaintiff as described in the Patent Law Amendment Act (15 and 16 Vict. c. 83, s. 43). (c)

The usual rules as to the costs of a motion are those laid down by Sir J. Leach in 1 Sim. & S. 357, 1: That the party making a successful motion is entitled to his costs as costs in the cause; but the party opposing it is not entitled to his costs as costs in the cause. 2. That the party making a motion which fails is not entitled to his costs as costs in the cause; but the party opposing it is entitled to his costs as costs in the cause. 3. That where a motion is made by one party and not opposed by the other, the costs of both parties are costs in the cause. Costs of motion.

Where the plaintiff obtained an injunction on motion, the defendant appearing and opposing, and at the hearing the bill was dismissed with costs, it was held that the defendant was entitled to the costs of the motion which he had unsuccessfully opposed; (d) and where the motion for an injunction stood over pending the trial of

(a) *Betts v. De Vitre*, 34 L. T. Ch. 289; *Tangye v. Stott*, 14 W. R. 386. (c) *Needham v. Oxley*, 11 W. R. 852.

(b) *Needham v. Oxley*, 11 W. R. 852, 2 N. R. 388. (d) *Stevens v. Keating*, 1 Mac. & G. 659.

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an action, and nothing was said about costs; and the bill was ultimately dismissed with costs, it was held that the defendant's costs of the motion were costs in the cause. (a)

The plaintiff is entitled to the costs of an injunction, although the defendant promises to commit no further act of infringement. (b)

Costs of suit.

But if the defendant submits and offers to pay all costs and to give the plaintiff all the relief he requires and the plaintiff nevertheless brings the suit to a hearing, he will not be allowed the subsequent costs of the suit. (c)

Where the directors of a company are made parties to the suit, and it is proved that they have been active in causing the patent to be infringed by the company; they may be ordered personally to pay the costs of suit. (d)

Costs as between solicitor and client.

By the Patent Law Amendment Act, 15 & 16 Vict. c.83, s. 43, the judge before whom any action for infringing letters patent shall be tried may certify on the record that the validity of the patent came in question; and the record with such certificate being given in evidence in any suit for infringing the said patent, shall entitle the plaintiff in any such suit or action to his full costs, charges and expenses, taxed as between solicitor and client, unless the judge making such decree or order, or the judge trying such action shall certify that the plaintiff ought not to have such costs.

The certificate required under the above provisions may be given by a judge of the Court of Chancery before whom the validity of the patent has been tried. (c)

(a) *Betts v. Clifford*, 1 J. & H. 75.

(b) *Geary v. Norton*, 1 De G. & S. 9.

(c) *Numm v. d'Albuquerque*, 34 Beav. 595; *Geary v. Norton*, 1 De G. & S. 9.

(d) *Betts v. De Vitre*, 11 Jur. (N. S.) 9.

(e) *Nedham v. Oxley*, 11 W. R. 852. And see *Hills v. Evans*, 4 De G. F. & J. 288; 8 Jur. (N. S.) 526.

In order that the costs may be taxed as between solicitor and client, the decree or order must, notwithstanding the words of the Act, contain, as in other cases, an express direction to that effect. (a)

As the statute means that the certificate should be produced in evidence on a second trial for the infringement, and the extra costs are given in order to afford a complete indemnity, the costs of a first trial will not be given as between solicitor and client. (b)

(a) *Lister v. Leather*, 4 K. & J. 425; *Hills v. Evans*, 4 De G. F. & J. 238; 8 Jur. (N. S.) 526.

(b) *Penn v. Bibby*, L. R. 3 Eq. 308. And see *Betts v. De Vitre*, 11 Jur. (N. S.) 9; *Davenport v. Rylands*, L. R. 1 Eq. 302.

CHAPTER XV.

OF PROCEEDINGS TO REPEAL LETTERS PATENT.

CHAP. XV.

A PATENT remains in force until it has been declared void in a court of law, by proceedings taken for that express purpose. The remedy provided by the law against a bad patent is by the writ of *scire facias*, which is prosecuted in the name of the sovereign. If therefore a patent is void for any of the reasons already considered it will be cancelled. (a)

The Patent Law Amendment Act (b) provides that the writ of *scire facias* shall lie for the repeal of any letters patent issued under that Act, in the like cases as the same would lie for the repeal of letters patent formerly issued under the great seal, and by 12 & 13 Vict. c. 109, s. 29, the writ of *scire facias* may be directed to the sheriff of any county.

Parties.

One of two joint patentees cannot plead in abatement that he had assigned all his interest in the patent to his co-patentee before the writ was issued, and that he has not since had any interest in it. (c)

Particulars of objections to be delivered.

The prosecutor in any proceedings by *scire facias* to repeal letters patent must deliver with his declaration

(a) For the practice upon writs of *scire facias*, see Hindmarch on Patents, 376; Norman's Law of Patents, 194.

(b) 15 & 16 Vict. c. 83, s. 15.

(c) *Reg. v. Belts*, 15 Q. B. 540.

particulars of any objections on which he means to rely at the trial in support of the suggestion of the declaration, and at the trial no evidence will be allowed to be given which is not contained in the particulars. The place or places at or in which and in what manner the invention is alleged to have been used or published prior to the date of the letters patent must be stated in the particulars, and any judge at chambers may allow the prosecutor to amend the particulars upon such terms as to the judge may seem fit. (*a*)

Where the prosecutor, while the record was in Chancery, filed notice of objection that other persons than the patentee had used the invention in England before the grant of the patent, the Court refused on motion after the proceedings were in the Queen's Bench to order the delivery of the particulars, stating the names and addresses of such persons. (*b*)

The pleadings are to be delivered, not filed. (*c*)

Pleadings.

Where the declaration contained suggestions of want of novelty and utility in a certain part of the invention, and the objections pointed out one particular claim as being bad for want of novelty and utility, and the pleas traversed all the suggestions, and after issue joined, disclaimed this particular claim, it was held that the objections were not part of the record so as to form part of the issues to be tried. (*d*)

Applications as to reforming recitals and suggestions in a writ of *scire facias* ought to be referred to one of the superior courts of Common Law and not to the Court of

(*a*) 15 & 16 Vict. c. 83, s. 41.
This enactment is similar to, but more comprehensive than, 5 & 6 Will. IV. c. 83, s. 5.

(*b*) *Reg. v. Walton*, 2 Q. B. 969.

(*c*) 12 & 13 Vict. c. 109, s. 31.

(*d*) *Reg. v. Mill*, 10 C. B. 379.

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Chancery, as they can dispose more satisfactorily of questions of pleading. (a)

Evidence.

The defendant is entitled to begin and to give evidence in support of his patent, and if evidence is adduced on the part of the prosecutor impeaching the validity of the patent, the defendant will be entitled to reply. (b) The onus of proof is on the prosecutor, and he must show that the patent is void on some of the grounds contained in the suggestions. (c)

As to refreshing the memory of a witness by drawings, see *R. v. Haddan*. (d)

Suit pending stayed on terms.

In *Smith v. Upton*, (e) the Court of Common Pleas stayed proceedings in an action for infringement for a definite period, (f) at the result of a motion pending in the Queen's Bench on a *scire facias*, upon the terms that the plaintiff should pay the defendant any costs which he might have been put to in preparing for trial and the costs of the motion. (f)

Where, pending proceedings in *scire facias*, the patentee disclaimed a part of his patent, and the prosecutor still proceeded and ultimately failed, he was ordered to pay the costs subsequent to the disclaimer. (g)

The Court has no power to stay proceedings on a *scire facias* or to order a *nolle prosequi* to be entered, as the proceedings are conducted by the Attorney-General

(a) *Reg. v. Hancock*, 5 D. M. G. 332. nom. *Muntz v. Foster*, 9 D. & L. 942.

(b) 15 & 16 Vict. c. 83, s. 41.

(c) *Reg. v. Cutter*, 3 C. & K. 215.

(d) 2 C. & P. 184.

(e) 6 Scott (N. R.) 804 S. C.

(f) See also *Walton v. Bateman*, 1 Webs. P. R. 613.

(g) *Reg. v. Mill*, 14 Q. B. 312.

according to his own discretion. In *Reg. v. Prosser*, (a) Lord Langdale said: "The Attorney-General proceeding regularly and being correct in such respects as these, conducts an action of *scire facias* or permits it to be prosecuted according to his own judgment and discretion, and may when he thinks fit stay the proceedings, or enter a *nolle prosequi*. The control is his, subject only to the responsibilities to which every public servant is liable in the discharge of his duty, and subject to the jurisdiction which the courts may have over him upon a charge properly brought against him for a negligent or erroneous performance of his duty. But I am of opinion that, in the ordinary course of proceeding upon a writ of *scire facias* to repeal letters patent, it is within his discretion to determine upon what or upon whose information, or on what terms or security, he will permit the action to be prosecuted, and that the exercise of his discretion in the conduct of the action is not subject to the control of the courts in which the proceeding takes place."

Where judgment is given for the Crown on a writ issued out of Chancery, which has been sent to a Court of Common Law for trial, final judgment may be given in that Court to cancel the patent, though the letters patent remain in the Court of Chancery. The Court has authority to award the judgment, and afterwards to transmit either the record or the terms thereof to the Court of Chancery, to be fully carried into execution, and the judgment may be that the letters patent be revoked, cancelled, vacated, disallowed, annulled and held void, and that the enrolment be cancelled and annulled,

(a) 11 Beav. 314.

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and that the letters patent be restored into the Court of Chancery there to be cancelled, (a) and after such judgment the Lord Chancellor has no jurisdiction to stay the execution of the judgment, his duty in cancelling the enrolment being only ministerial. (b)

(a) *Bynner v. Reg.* 9 Q. B.
523.

(b) *Reg. v. The Eastern Archipelago Co.* 4 D. M. G. 199.

APPENDIX.

21 JAC. I. c. 3.

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

[A. D. 1623.]

FORASMUCH as your most excellent Majesty in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did, in the year of our Lord God 1610, publish in print to the whole realm, and to all posterity, that grants and monopolies, and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant and agreeable to the ancient and fundamental laws of this your realm: and whereas your Majesty was further graciously pleased expressly to command that no suitor should presume to move your Majesty for matters of that nature: yet, nevertheless, upon misinformations and untrue pretences of public good many such grants have been unduly obtained and unlawfully put in execution, to the great grievance and inconvenience of your Majesty's subjects, contrary, to the laws of this your realm, and contrary to your Majesty's most royal and blessed intention, so published as aforesaid: For avoiding whereof and preventing of the like in time to come, may it please your excellent Majesty, at the humble suit of the Lords Spiritual and Temporal, and the Commons in this present Parliament assembled, that it may be declared and enacted, and be it declared and enacted by authority of this

Monopolies
contrary to the
laws of the
realm.

All monopolies, &c., shall be void.

present Parliament, that all monopolies, and all commissions, grants, licences, charters, and letters patent heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of anything within this realm or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty to dispense with any others, or to give licence or toleration to do, use, or exercise anything against the tenor or purport of any law or statute; or to give or make any warrant for any such dispensation, licence, or toleration to be had or made; or to agree or compound with any others for any penalty or forfeitures limited by any statute; or of any grant or promise of the benefit, profit, or commodity of any forfeiture, penalty, or sum of money that is or shall be due by any statute before judgment thereupon had; and all proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things whatsoever, any way tending to the instituting, erecting, strengthening, furthering, or countenancing of the same, or any of them, are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in nowise to be put in use or execution.

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

II. That all monopolies, and all such commissions, grants, licences, charters, letters patent, proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things tending as aforesaid, and the force and validity of them, and of every of them, ought to be and shall be for ever hereafter examined, heard, tried and determined, by and according to the common laws of this realm, and not otherwise.

All persons disabled to use monopolies, &c.

III. And be it enacted by the authority aforesaid that all person and persons, bodies politic and corporate whatsoever, which now are or hereafter shall be, shall stand and be disabled, and incapable to have, use, exercise, or put in use any monopoly, or any such commission, grant, licence, charter, letters patent, proclamation, inhibition, restraint, warrant of assistance or other matter or thing tending as aforesaid, or

any liberty, power or faculty grounded or pretended to be grounded upon them, or any of them.

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

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

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

grounded upon this statute to be stayed or delayed before judgment by colour or means of any order, warrant, power, or authority, save only of the court wherein such action as aforesaid shall be brought and depending, or after judgment had upon such action shall cause or procure the execution of or upon any such judgment to be stayed or delayed by colour or means of any order, warrant, power, or authority, save only by writ of error or attain; that then the said person and persons so offending shall incur and sustain the pains, penalties, and forfeitures ordained and provided by the statute of provision and *præmunire* made in the sixteenth year of the reign of King Richard the Second.

16 R. II. c. 5.

Letters patent before then granted to use new manufactures saved.

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

What new patents to be good.

VI. Provided also, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patent, and grants of privilege for the term of fourteen years or under, hereafter to be made of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manu-

factures which others at the time of making such letters patent and grants shall not use, so as also they be not contrary to the law, nor mischievous to the state, by raising prices of commodities at home or hurt of trade, or generally inconvenient; the said fourteen years to be accounted from the date of the first letters patent or grants of such privilege hereafter to be made, but that the same shall be of such force as they should be if this act had never been made, and of none other.

VII. Provided also, and it is hereby further enacted, declared, and enacted by authority, that this act or anything therein contained, shall not in anywise extend or be prejudicial to any grant or privilege, power, or authority whatsoever heretofore made, granted, allowed, or confirmed by any act of parliament now in force, so long as the same shall so continue in force.

Act not to extend to grants confirmed by Act of Parliament.

VIII. Provided also, that this act shall not extend to any warrant or privy seal made or directed, or to be made or directed by his Majesty, his heirs, or successors to the justices of the courts of the King's Bench or Common Pleas, and Barons of the Exchequer, justices of assizes, justices of *oyer and terminer* and gaol delivery, justices of the peace, and other justices for the time being, having power to hear and determine offences done against any penal statute, to compound for the forfeitures of any penal statute depending in suit and question before them, or any of them respectively, after plea pleaded by the party defendant.

Warrants granted to justices saved.

IX. Provided also, and it is hereby further intended, declared, and enacted, that this act, or anything therein contained, shall not in anywise extend or be prejudicial unto the City of London, or to any city, borough, or town corporate within this realm, for or concerning any grants, charters, or letters patent to them, or any of them made or granted, or for or concerning any custom or customs used by or within them or any of them; or unto any corporations, companies, or fellowships of any art, trade, occupation, or mystery, or to any companies or societies of merchants within this realm erected for the maintenance, enlargement, or ordering

Charters granted to corporations saved.

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

Letters patent that concern printing, salt-petre, gun-powder, great ordnance, shot, or offices, saved.

X. Provided also, and be it enacted that this act, or any declaration, provision, disablement, penalty, forfeiture, or other thing before mentioned, shall not extend to any letters patent or grants of privileges heretofore made, or hereafter to be made of, for, or concerning printing, nor to any commission grant, or letters patent heretofore made or hereafter to be made of, for, or concerning the digging, making or compounding of saltpetre or gunpowder; or the casting or making of ordnance, or shot for ordnance; nor to any grant or letters patent heretofore made, or hereafter to be made, of any office or offices heretofore erected, made, or ordained, and now in being; and put in execution, other than such offices as have been decreed by any of his Majesty's proclamation or proclamations; but that all and every the same grants, commissions, and letters patent, and all other matters and things tending to the maintaining, strengthening, and furtherance of the same or any of them, shall be and remain of the like force and effect, and no other, and as free from the declarations, provisions, penalties, and forfeitures contained in this act, as if this act had never been had nor made, and not otherwise.

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

5 & 6 WILL. IV. C. 83.

An Act to amend the Law touching Letters Patent for Inventions.
[10th Sept. 1835.]

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

I. That any person who as grantee, assignee, or otherwise, hath obtained or shall hereafter obtain letters patent, for the sole making, exercising, vending, or using of any invention, may, if he think fit, enter with the clerk of the patents of England, Scotland or Ireland, respectively, as the case may be, having first obtained the leave of His Majesty's Attorney-General or Solicitor-General in case of an English patent, of the Lord Advocate or Solicitor-General of Scotland in case of a Scotch patent, or of His Majesty's Attorney-General or Solicitor-General for Ireland in the case of an Irish patent, certified by his fiat and signature, a disclaimer of any part of either the title of the invention or of the specification, stating the reason for such disclaimer, or may, with such leave as aforesaid, enter a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent; and such disclaimer or memorandum of alteration, being filed by the said clerk of the patents, and enrolled with the specification, shall be deemed and taken to be part of such letters patent or such specification in all courts whatever: Provided always, that any person may enter a *caveat* in like manner as *caveats* are now used to be entered, against such disclaimer or alteration; which *caveat* being so entered shall give the party entering the same a right to have notice

Any person having obtained letters patent for any invention may enter a disclaimer of any part of his specification, or a memorandum of any alteration therein, which, when filed, to be deemed part of such specification. Caveat may be entered as heretofore. Disclaimer not to affect actions pending at the time. Atty.-Gen. may require advertisement of disclaimer.

of the application being heard by the Attorney-General or Solicitor-General or Lord Advocate respectively: Provided also, that no such disclaimer or alteration shall be receivable in evidence in any action or suit (save and except in any proceeding by *scire facias*) pending at the time when such disclaimer or alteration was enrolled, but in every such action or suit the original title and specification alone shall be given in evidence, and deemed and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted: Provided also, that it shall be lawful for the Attorney-General, or Solicitor-General, or Lord Advocate, before granting such fiat, to require the party applying for the same to advertise his disclaimer or alteration in such manner as to such Attorney-General or Solicitor-General or Lord Advocate shall seem right, and shall, if he so require such advertisement, certify in his fiat that the same has been duly made.

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

II. That if in any suit or action it shall be proved or specially found by the verdict of a jury, that any person who shall have obtained letters patent for any invention, or supposed invention, was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same, or some part thereof, before the date of such letters patent, or if such patentee or his assigns shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof, before the date of such letters patent, it shall and may be lawful for such patentee or his assigns to petition His Majesty in council to confirm the said letters patent or to grant new letters patent, the matter of which petition shall be heard before the Judicial Committee of the Privy Council; and such committee, upon examining the said matter, and being satisfied that such patentee believed himself to be the first and original inventor, and being satisfied that such invention, or part thereof, had not been publicly and generally used before the date of such first letters patent, may report to His Majesty their opinion that the prayer of such petition

ought to be complied with, whereupon His Majesty may, if he think fit, grant such prayer; and the said letters patent shall be available in law and equity to give such petitioner the sole right of using, making, and vending such invention as against all persons whatsoever, any law, usage, or custom to the contrary thereof notwithstanding: Provided, that any person opposing such petition shall be entitled to be heard before the said Judicial Committee: Provided also, that any person, party to any former suit or action touching such first letters patent, shall be entitled to have notice of such petition before presenting the same.

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

If in any action a verdict, &c., shall pass for the patentee, the judge may grant a certificate, &c.

IV. That if any person who now hath or shall hereafter obtain any letters patent as aforesaid shall advertise in the "London Gazette" three times, and in three London papers, and three times in some country papers published in the town where or near to which he carried on any manufacture of anything made according to his specification, or near to or in which he resides in case he carried on no such manufacture,

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

or published in the county where he carries on such manufacture or where he lives in case there shall not be any paper published in such town, that he intends to apply to His Majesty in council for a prolongation of his term of sole using and vending his invention, and shall petition His Majesty in council to that effect, it shall be lawful for any person to enter a *caveat* at the council office; and if His Majesty shall refer the consideration of such petition to the Judicial Committee of the Privy Council, and notice shall first be by him given to any person or persons who shall have entered such *caveats*, the petitioner shall be heard by his counsel and witnesses to prove his case, and the persons entering *caveats* shall likewise be heard by their counsel and witnesses; whereupon and upon hearing and inquiring of the whole matter, the Judicial Committee may report to His Majesty that a further extension of the term in the said letters patent should be granted, not exceeding seven years and His Majesty is hereby authorized and empowered if he shall think fit, to grant new letters patent for the said invention for a term not exceeding seven years after the expiration of the first term, any law, custom, or usage to the contrary in anywise notwithstanding: Provided that no such extension shall be granted if the application by petition shall not be made and prosecuted with effect before the expiration of the term originally granted in such letters patent. (a)

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

V. That in any action brought against any person for infringing any letters patent the defendant on pleading thereto shall give to the plaintiff, and in any *scire facias* to repeal such letters patent the plaintiff shall file with his declaration, a notice of any objection on which he means to rely at the trial of such action, and no objection shall be allowed to be made in behalf of such defendant or plaintiff respectively at such trial unless he prove the objections stated in such notice: Provided always, that it shall and may be lawful for any judge at chambers, on summons served by such defendant

(a) This proviso is repealed by 2 & 3 Vict. c. 67, s. 1.

or plaintiff on such plaintiff or defendant respectively to show cause why he should not be allowed to offer other objections whereof notice shall not have been given as aforesaid, to give leave to offer such objections, on such terms as to such judge shall seem fit.

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

VII. That if any person shall write, paint, or print, or mould, cast, or carve, or engrave or stamp upon anything made, used or sold by him, for the sole making or selling of which he hath not or shall not have obtained letters patent, the name or any imitation of the name of any other person who hath or shall have obtained letters patent, for the sole making and vending of such thing, without leave in writing of such patentee or his assigns, or if any person shall upon such thing, not having been purchased from the patentee or some person who purchased it from or under such patentee, or not having had the license or consent in writing of such patentee, or his assigns, write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word "patent," the words "letters patent," or the words "by the king's patent," or any words of the like kind, meaning, or import, with a view of imitating or counterfeiting the stamp, mark, or other device of the patentee, or shall in any other manner imitate or counterfeit the stamp or mark or other device of the patentee, he shall for every such offence be liable to a penalty of £50, to be recovered by action of debt, bill, plaint, process, or information in any of His Majesty's courts of record at Westminster or in Ireland, or in the court of session in Scotland, one half to His Majesty, his heirs and successors, and the other to any

As to costs in actions for infringing letters patent.

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

person who shall sue for the same: Provided always, that nothing herein contained shall be construed to extend to subject any person to any penalty in respect of stamping or in any way marking the word "patent" upon anything made, for the sole making or vending of which a patent before obtained shall have expired.

2 & 3 VICT. C. 67.

An Act to amend an Act of the Fifth and Sixth Years of the Reign of King William the Fourth, intituled an Act to Amend the Law touching Letters Patent for Inventions. [24th August, 1839.]

WHEREAS by an act passed in the fifth and sixth years of the reign of His Majesty King William the Fourth, intituled "An Act to amend the Law touching Letters Patent for inventions," it is amongst other things enacted (reciting s. 4 of the said act): And whereas it has happened since the passing of the said act, and may again happen, that parties desirous of obtaining an extension of the term granted in letters patent of which they are possessed, and who may have presented a petition for such purposes in manner by the said recited act directed, before the expiration of the said term, may nevertheless be prevented by causes over which they have no control from prosecuting with effect their application before the Judicial Committee of the Privy Council; and it is expedient therefore that the said Judicial Committee should have power, when under the circumstances of the case they shall see fit, to entertain such application, and to report thereon, according to the provisions of the said recited act, notwithstanding that before the hearing of the case before them the terms of the letters patent sought to be renewed or extended may have expired; be it therefore enacted,

Repealing provision re-

I. That so much of the said recited act as provides that no

extension of the term of letters patent shall be granted as therein mentioned if the application by petition for such extension be not prosecuted with effect before the expiration of the term originally granted in such letters patent, shall be and the same is hereby repealed.

II. That it shall be lawful for the Judicial Committee of the Privy Council, in all cases where it shall appear to them that any application for an extension of the term granted by any letters patent, the petition for which extension shall have been referred to them for their consideration, has not been prosecuted with effect before the expiration of the said term from any other causes than the neglect or default of the petitioner, to entertain such application and to report thereon as by the said recited act provided, notwithstanding the term originally granted in such letters patent may have expired before the hearing of such application; and it shall be lawful for Her Majesty, if she shall think fit, on the report of the said Judicial Committee recommending an extension of the term of such letters patent to grant such extension or to grant new letters patent for the invention or inventions specified in such original letters patent, for a term not exceeding seven years after the expiration of the term mentioned in the said original letters patent: Provided always, that no such extension or new letters patent shall be granted if a petition for the same shall not have been presented as by the said recited act directed before the expiration of the term sought to be extended, nor in case of petitions presented after the 30th day of November, 1839, unless such petition shall be presented six calendar months at the least before the expiration of such term, nor in any case unless sufficient reason shall be shown to the satisfaction of the said Judicial Committee for the omission to prosecute with effect the said application by petition before the expiration of the said term.

quiring 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.

7 & 8 VICT. C. 69.

An Act for amending an Act passed in the Fourth Year of the Reign of His late Majesty, intituled An Act for the better Administration of Justice in His Majesty's Privy Council; and to extend its Jurisdiction and Powers.

[6th August, 1844.]

WHEREAS the act passed in the fourth year of the reign of his late Majesty, intituled "An Act for the better Administration of Justice in His Majesty's Privy Council" hath been found beneficial to the due administration of justice: And whereas another Act, passed in the sixth year of the said reign intituled "An Act to amend the Law touching Letters Patent for Inventions" hath also been found advantageous to inventors and to the public.

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

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

sion thereof for any time not exceeding fourteen years, in like manner and subject to the same rules as the extension for a term not exceeding seven years is now granted under the powers of the said act of the sixth year of the reign of his late Majesty.

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

Her Majesty may grant extension for a lesser term than that prayed.

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

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

V. That in case the original patentee or patentees hath or have departed with his or their whole or any part of his or their interest by assignment to any other person or persons, it shall be lawful for such patentee, together with such assignee or assignees, if part only hath been assigned, and for the assignee or assignees if the whole hath been assigned, to enter a disclaimer and memorandum of alteration under the powers of the said recited Act; and such disclaimer and memorandum of alteration, having been so entered and filed as in the said recited Act mentioned, shall be valid and effectual in favour of any person or persons in whom the rights under the said letters patent may then be or thereafter become legally vested; and no objection shall be made in any proceeding whatsoever, on the ground that the party making such disclaimer or memorandum of alteration had not sufficient authority in that behalf.

Disclaimer and memorandum of alteration under 5 & 6 W. IV. c. 83, may be made, notwithstanding original patentee may have assigned his patent right.

VI. That any disclaimer or memorandum of alteration before the passing of this Act, or by virtue of the said recited

Disclaimer and memorandum

of alteration
already made
valid.

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

New letters
patent granted
under 5 & 6
W. IV. c. 83,
to assignees
before passing
of this act de-
clared valid.

Proviso.

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

15 & 16 VICT. c. 83.

*An Act for Amending the Law for Granting Patents for
Inventions.* [7th July, 1852.]

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

Certain per-
sons con-

I. The Lord Chancellor, the Master of the Rolls, her Majesty's Attorney-General for England, her Majesty's

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

stituted Commissioners of Patents for Inventions, three of whom may act, the Chancellor or Master of the Rolls being one.

II. It shall be lawful for the commissioners to cause a seal to be made for the purposes of this Act, and from time to time to vary such seal, and to cause to be sealed therewith all the warrants for letters patent under this Act, and all instruments and copies proceeding from the office of the commissioners; and all courts, judges, and other persons whomsoever shall take notice of such seal, and receive impressions thereof in evidence, in like manner as impressions of the Great Seal are received in evidence, and shall also take notice of and receive in evidence, without further proof or production of the originals, all copies or extracts, certified under the seal of the said office, of or from documents deposited in such office.

Seal of the Commissioners.

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

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

meeting of Parliament; and the commissioners shall cause a report to be laid annually before Parliament of all the proceedings under and in pursuance of this Act.

Treasury to provide offices.

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

Commissioners, with consent of Treasury, to appoint clerks, &c.

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

Petition and declaration to be accompanied with a provisional specification.

VI. Every petition for the grant of letters patent for an invention, and the declaration required to accompany such petition, shall be kept at the office of the commissioners, and there shall be left therewith a statement in writing, hereinafter called the provisional specification, signed by or on behalf of the applicant for letters patent, describing the nature of the said invention; and the day of the delivery of every such petition, declaration, and provisional specification shall be recorded at the said office, and endorsed on such petition, declaration, and provisional specification, and a certificate thereof given to such applicant or his agent; and all such petitions, declarations and provisional specifications shall be preserved in such manner as the commissioners may direct, and a registry thereof, and of all proceedings thereon, kept at the office of the commissioners.

Applications to be referred to law officer.

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

The provisional specification to be referred to the law officer, who, if satisfied, may give

VIII. The provisional specification shall be referred to the law officer, who shall be at liberty to call to his aid such scientific or other person as he may think fit, and to cause to be paid to such person by the applicant such remuneration as the law officer shall appoint; and if such law officer be satis-

filed that the provisional specification describes the nature of the invention, he shall allow the same, and give a certificate of his allowance, and such certificate shall be filed in the office of the commissioners, and thereupon the invention therein referred to may, during the term of six months from the date of the application for letters patent for the said invention, be used and published without prejudice to any letters patent to be granted for the same, and such protection from the consequences of use and publication is hereinafter referred to as provisional protection: Provided always that in case the title of the invention or the provisional specification be too large or insufficient, it shall be lawful for the law officer to whom the same is referred to allow or require the same to be amended.

a certificate of his allowance, which shall be filed.

IX. The applicant for letters patent for an invention instead of leaving with the petition and declaration a provisional specification as aforesaid, may, if he think fit, file with the said petition and declaration an instrument in writing under his hand and seal (hereinafter called a complete specification) particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed, which complete specification shall be mentioned in such declaration, and the day of the delivery of every such petition, declaration, and complete specification, shall be recorded at the office of the commissioners, and endorsed on such petition, declaration and specification, and a certificate thereof given to such applicant or his agent, and thereupon, subject and without prejudice to the provisions hereinafter contained, the invention shall be protected under this Act for the term of six months from the date of the application, and the applicant shall have during such term of six months the like powers, rights, and privileges as might have been conferred upon him by letters patent for such invention, issued under this Act, and duly sealed as of the day of the date of such application; and during the continuance of such powers, rights and privileges under this provision such invention may be used and published without prejudice to any letters patent

Inventor may deposit, in lieu of a provisional specification, a complete specification, such deposit to confer for a limited time the like rights as letters patent.

to be granted for the same; and where letters patent are granted in respect of such invention, then in lieu of a condition for making void such letters patent in case such invention be not described and ascertained by a subsequent specification, such letters patent shall be conditioned to become void if such complete specification, filed as aforesaid, does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed; and a copy of every such complete specification shall be open to the inspection of the public, as hereinafter provided, from the time of depositing the same, subject to such regulations as the commissioners may make.

Letters patent granted to the first inventor not to be invalidated by protection obtained in fraud of the first inventor.

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

Commissioners to cause protections to be advertised.

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

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

XII. The applicant for letters patent, so soon as he may think fit after the invention shall have been previously protected under this Act, or where a complete specification has been deposited with his petition and declaration, then so soon as he may think fit after such deposit, may give notice at the office of the commissioners of his intention of proceeding with his application for letters patent for the said invention, and thereupon the said commissioners shall cause his said application to be advertised in such manner as they may see fit;

and any persons having an interest in opposing the grant of letters patent for the said invention shall be at liberty to have particulars in writing of their objections to the said application at such place, and within such time, and subject to such regulations, as the commissioners may direct.

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

Specification and objection to be referred to law officer.

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

Power to law officer to order by or to whom costs shall be paid.

XV. It shall be lawful for such law officer, after such hearing, if any, as he may think fit, to cause a warrant to be made for the sealing of letters patent for the said invention, and such warrant shall be sealed with the seal of the commissioners, and shall set forth the tenor and effect of the letters patent thereby authorized to be granted, and such law officer shall direct the insertion in such letters patent of all such restrictions, conditions, and provisoes as he may deem usual and expedient in such grants, or necessary in pursuance of the provisions of this Act; and the said warrant shall be the warrant for the making and sealing of letters patent under

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

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

Writ of *scire facias*.

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

Letters patent to be made subject to avoidance on non-fulfilment of certain conditions.

this Act according to the tenor of the said warrant: Provided always, that the Lord Chancellor shall and may have and exercise such powers, authority, and discretion in respect to the said warrant, and the letters patent therein directed to be made under this Act, as he now has and might now exercise with respect to the warrant for the issue under the Great Seal of letters patent for any invention and with respect to the making and issuing of such letters patent; and the writ of *scire facias* shall lie for the repeal of any letters patent issued under this Act, in the like cases as the same would lie for the repeal of letters patent which may now be issued under the Great Seal.

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

XVII. All letters patent for inventions granted under the provisions hereinbefore contained shall be made subject to the condition that the same shall be void, and that the powers and privileges thereby granted shall cease and determine, at the expiration of three years and seven years respectively from the date thereof, unless there be paid, before the expira-

tion of the said three years and seven years respectively the sum or sums of money and stamp duties in the schedule of this Act annexed; and the payment of the said sums of money and stamp duties respectively shall be endorsed on the warrant for the said letters patent; and such officer of the commissioners as may be appointed for this purpose shall issue under the seal of the commissioners a certificate of such payment, and shall endorse a receipt for the same on any letters patent issued under the authority of the said warrant; and such certificate, duly stamped, shall be evidence of the payment of the several sums respectively. (a)

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

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

(a) This section is repealed by 16 & 17 Vict. c. 5.

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

wise provided: Provided always that nothing in this Act contained shall be deemed or taken to give any effect or operation to any letters patent to be granted under the authority of this Act in any colony in which such or the like letters patent would be invalid by the law in force in the same colony for the time being: Provided always that a transcript of such letters shall, so soon after the sealing of the same and in such manner as the commissioners shall direct, be transmitted to the director of Chancery in Scotland, and be recorded in the Records of Chancery in Scotland, upon payment of such fees as the commissioners shall appoint, in the same manner and to the same effect in all respects as letters patent passing under the seal appointed by the treaty of union to be used in place of the Great Seal of Scotland have heretofore been recorded, and extracts from the said Records shall be furnished to all parties requiring the same, on payment of such fees as the commissioners shall direct, and shall be received in evidence in all courts in Scotland to the like effect as the letters patent themselves.

Letters patent not to be issued after three months from date of warrant.

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

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

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

patent, then such letters patent may be sealed at such time as the Lord Chancellor shall direct.

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

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

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

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

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

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

XXIV. Any letters patent issued under this Act sealed and bearing date as of any day prior to the day of the actual sealing thereof shall be of the same force and validity as if

Letters patent where ante-dated to be of the same

validity as if sealed on the day of the date.

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

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

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

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

XXVI. No letters patent for any invention (granted after the passing of this Act) shall extend to prevent the use of such invention in any foreign ship or vessel, or for the navigation of any foreign ship or vessel, which may be in any port of her Majesty's dominions, or in any of the waters within the jurisdiction of any of her Majesty's courts, where such

invention is not so used for the manufacture of any goods or commodities to be vended within or exported from her Majesty's dominions: Provided always that this enactment shall not extend to the ships or vessels of any foreign state of which the laws authorize subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British ships or vessels, or in or about the navigation of British ships or vessels, while in the ports of such foreign state, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture of goods or commodities to be vended within or exported from the territories of such foreign state.

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

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

Specifications to be filed instead of being enrolled.

XXVIII. Every specification to be filed in pursuance of the condition of any letters patent shall be filed in such office of the Court of Chancery as the Lord Chancellor shall from time to time appoint, and every provisional specification and complete specification left or filed at the office of the Commissioners on the application for any letters patent, shall forthwith after the grant of the letters patent, or if no letters patent be granted then immediately on the expiration of six months from the time of such application, be transferred to and kept in the said office appointed for filing specifications in Chancery; and in case reference is made to drawings in any specification deposited or filed under this Act, an extra copy of such drawings shall be left with such specification.(a)

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

XXIX. The Commissioners shall cause true copies of all specifications (other than provisional specifications, disclaimers, and memoranda of alterations filed under or in pursuance of this Act, and of all provisional specifications after the term of

As to filing extra copies of drawing.

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

(a) The latter part of this section repealed by 16 & 17 Vict. c. 115, s. 1.

the provisional protection of the invention has expired, to be open to the inspection of the public at the office of the Commissioners, and at an office in Edinburgh and Dublin respectively, at all reasonable times, subject to such regulations as the Commissioners may direct; and the Commissioners shall cause a transcript of the said letters patent to be transmitted for enrolment in the Court of Chancery, Dublin, and shall cause the same to be enrolled therein, and the transcript or exemplification thenceforward shall have the like effect to all intents and purposes as if the original letters patent had been enrolled in the Court of Chancery in Dublin, and all parties shall have all their remedies by *scire facias* or otherwise, as if the letters patent had been granted to extend to Ireland only.

Specifications and other documents to be printed and published.

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

As to presenting copies of publications to public libraries.

Enrolments, &c., may be removed to the office for specifications.

XXXI. It shall be lawful for the Lord Chancellor and the Master of the Rolls to direct the enrolment of specifications, disclaimers, and memoranda of alterations heretofore or hereafter enrolled or deposited at the Rolls Chapel Office, or at the Petty Bag Office, or at the Enrolment Office of the Court of Chancery, or in the custody of the Master of the Rolls as

keeper of the public records, to be transferred to and kept in the office appointed for filing specifications in Chancery under this Act.

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

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

XXXIII. Copies, printed by the printers to the Queen's Majesty, of specifications, disclaimers, and memoranda of alterations shall be admissible in evidence, and deemed and taken to be *primâ facie* evidence of the existence and contents of the documents to which they purport to relate in all courts and in all proceedings relating to letters patent.(a)

Copies of specifications, &c., as printed by Queen's printers, to be evidence.

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

Register of patents to be kept.

XXXV. There shall be kept at the office appointed for filing specifications in Chancery under this Act a book or books

A register of proprietors to

(a) Repealed by 16 & 17 Vict. c. 115, s. 1.

be kept at the
office for filing
specifications.

entitled "The Register of Proprietors," wherein shall be entered, in such manner as the commissioners shall direct, the assignment of any letters patent, or of any share or interest therein, any licence under letters patent, and the district to which such licence relates, with the name or names of any person having any share or interest in such letters patent or licence, the date of his or their acquiring such letters patent, share, and interest, and any other matter or thing relating to or affecting the proprietorship in such letters patent or licence; and a copy of any entry in such book, certified under such seal as may have been appointed or as may be directed by the Lord Chancellor to be used in the said office, shall be given to any person requiring the same, on payment of the fees hereinafter provided; and such copies so certified shall be received in evidence in all courts and in all proceedings, and shall be *prima facie* proof of the assignment of such letters patent, or share or interest therein, or of the licence or proprietorship, as therein expressed: Provided always, that until such entry shall have been made the grantee or grantees of the letters patent shall be deemed and taken to be the sole and exclusive proprietor or proprietors of such letters patent, and of all the licences and privileges thereby given and granted; that certified duplicates of all entries made in the said register of proprietors shall forthwith be transmitted to the office of the commissioners in Edinburgh and Dublin, where the same shall also be open to the inspection of the public; and any writ of *scire facias* to repeal such letters patent may be issued to the sheriff of the county or counties in which the grantee or grantees resided at the time when the said letters patent were granted; and in case such grantee or grantees do not reside in the United Kingdom it shall be sufficient to file such writ in the Petty Bag Office, and serve notice thereof in writing at the last known residence or place of business of such grantee or grantees; and such register or a copy shall be open to the inspection of the public at the office of the commissioners, subject to such regulations as the commissioners may make: Provided always, that in any proceeding in Scotland

to repeal any letters patent, service of all writs and summonses shall be made according to the existing forms and practice; provided also, that the grantee or grantees of letters patent to be hereafter granted may assign the letters patent for England, Scotland, or Ireland respectively as effectually as if the letters patent had been originally granted to extend to England or Scotland or Ireland only, and the assignee or assignees shall have the same rights of action and remedies, and shall be subject to the like actions and suits as he or they should and would have had and been subject to upon the assignment of letters patent granted to England Ireland or Scotland before the passing of this Act.

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

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

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

Falsification or forgery of entries a misdemeanor.

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

Entries may be expunged.

such order for expunging, vacating or varying any such entry, shall expunge, vacate, or vary the same, according to the requisitions of such order.

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

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

XXXIX. All the provisions of the Acts of the session holden in the fifth and sixth years of King William IV., chapter eighty-three, and of the session holden in the seventh and eighth years of her majesty, chapter sixty nine, respectively, relating to disclaimers, and memoranda of alterations in letters patent and specifications, except as hereinafter provided, shall be applicable and apply to any letters patent granted, and to any specification filed under the provisions of this Act: Provided always, that all applications for leave to enter a disclaimer or memorandum of alteration shall be made, and all *caveats* relating thereto shall be lodged at the office of the commissioners, and shall be referred to the respective law officers in the said first recited Act mentioned: provided also, that every such disclaimer or memorandum of alteration shall be filed in the office appointed for filing specifications in Chancery under this Act, with the specification to which the same relates, in lieu of being entered or filed and enrolled as required by the said first recited Act, or by the Act of the session holden in the twelfth and thirteen years of her Majesty, chapter one hundred and nine, and the said Acts shall be construed accordingly: provided also, that such filing of any disclaimer or memorandum of alteration, in pursuance of the leave of the law officer in the first recited Act mentioned, certified as therein mentioned, shall, except in case of fraud, be conclusive as to the right of the party to enter such disclaimer or memorandum of alteration under the said Acts and this Act; and no objection shall be allowed to be made in any proceeding upon or touching such letters patent, specification, disclaimer, or memorandum of alteration, on the ground that the party entering such disclaimer or memorandum of alteration had not sufficient authority in that behalf: provided also, that no action shall be brought upon any letters patent in which, or on the specification of which any disclaimer or memorandum of alteration shall have been filed in respect of any infringement committed

prior to the filing of such disclaimer or memorandum of alteration, unless the law officers shall certify in his fiat that any such action may be brought, notwithstanding the entry or filing of such disclaimer or memorandum of alteration.

XL. All the provisions of the said Act of the fifth and sixth years of King William IV. for the confirmation of any letters patent, and the grant of new letters patent, and all the provisions of the said Act, and of the Acts of the session holden in the second and third years of her Majesty, chapter sixty-seven, and of the session holden in the seventh and eighth years of her Majesty, chapter sixty-nine respectively, relating to the prolongation of the term of letters patent, and to the grant of new letters patent for a further term, shall extend and apply to any letters patent granted under the provisions of this Act, and it shall be lawful for her Majesty to grant any new letters patent, as in the said Acts mentioned; and in the granting of any such new letters patent, as in the said Act mentioned; and in the granting of any such new letters patent her Majesty's Order in Council shall be a sufficient warrant and authority for the sealing of any new letters patent, and for the insertion in such new letters patent of any restrictions, conditions, and provisions in the said order mentioned; and the Lord Chancellor on the receipt of the said order in council shall cause letters patent, according to the tenor and effect of such order, to be made and sealed in the manner herein directed for letters patent issued under the warrant of the law officer: Provided always, that such new letters patent shall extend to and be available in and for such places as the original letters patent extended to and were available in; provided also, that such new letters patent shall be sealed and bear date as of the day after the expiration of the term of the original letters patent which may first expire.

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

XLI. In any action in any of her Majesty's superior courts of record at Westminster or in Dublin for the infringement of letters patent the plaintiff shall deliver with his declaration, particulars of the breaches complained of in the said action, and the defendant, on pleading thereto, shall deliver with his

In actions for infringement of letters patent, particulars to be delivered, and no evidence

allowed not mentioned therein.

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

Courts of common law may grant injunction in case of infringement.

XLII. In any action in any of Her Majesty's Superior Courts of Record at Westminster and in Dublin for the infringement of letters patent, it shall be lawful for the court in which such action is pending, if the court be then sitting, or if the court be not sitting then for a judge of such court, on the application of the plaintiff or defendant respectively, to make such order for an injunction, inspection, or account, and to give such direction respecting such action, injunction, inspection, and account, and the proceedings therein respectively, as to such court or judge may seem fit.

Particulars to be regarded in taxation of costs.

XLIII. In taxing the costs in any action in any of Her Majesty's Superior Courts at Westminster or in Dublin, commenced after the passing of this Act for infringing letters patent, regard shall be had to the particulars delivered in

such action, and the plaintiff and defendant respectively shall not be allowed any costs in respect of any particular unless certified by the judge before whom the trial was had to have been proved by such plaintiff or defendant respectively without regard to the general costs of the cause; and it shall be lawful for the judge before whom any such action shall be tried to certify on the record that the validity of the letters patent in the declaration mentioned came in question; and the record, with such certificate, being given in evidence in any suit or action for infringing the said letters patent, or in any proceeding by *scire facias* to repeal the letters patent, shall entitle the plaintiff in any such suit or action, or the defendant in such proceeding by *scire facias* on obtaining a decree, decretal order, or final judgment, to his full costs, charges, and expenses, taxed as between attorney and client, unless the judge making such decree or order, or the judge trying such action or proceeding, shall certify that the plaintiff or defendant respectively ought not to have such full costs: Provided always, that nothing herein contained shall affect the jurisdiction and forms of process of the Courts in Scotland in any action for the infringement of letters patent, or in any action or proceeding respecting letters patent hitherto competent to the said courts: Provided also, that when any proceedings shall require to be taken in Scotland to repeal any letters patent, such proceedings shall be taken in the form of an action of reduction at the instance of Her Majesty's advocate, or at the instance of any other party having interest with concurrence of Her Majesty's advocate, which concurrence Her Majesty's advocate is authorized and empowered to give upon just cause shown only.

XLIV. There shall be paid in respect of letters patent applied for or issued as herein mentioned, the filing of specifications and disclaimers, certificates, entries, and searches, and other matters and things mentioned in the schedule to this Act, such fees as are mentioned in the said schedule; and there shall be paid unto and for the use of Her Majesty, her heirs and successors, for or in respect of the warrants and

Payments and
stamp duties
on letters.

certificates mentioned in the said schedule, or the vellum, parchment, or paper on which the same respectively are written, the stamp duties mentioned in the said schedule; and no other stamp duties shall be levied or fees except as hereinafter mentioned, taken in respect to such letters patent and specifications, and the matters and things in such schedule mentioned. (a)

Duties to be under management of Commissioners of Inland Revenue.

XLV. The stamp duties hereby granted shall be under the care and management of the commissioners of inland revenue; and the several rules, regulations, provisions, penalties, clauses, and matters contained in any Act now or hereafter to be in force with reference to stamp duties shall be applicable thereto. (a)

All moneys received to be paid to the Consolidated fund.

XLVI. The fees to be paid as aforesaid shall from time to time be paid into the receipt of the Exchequer, and be carried to and made part of the consolidated fund of the United Kingdom. (a)

Not to prevent payment of fees to law officers in case of opposition, &c.

XLVII. Provided always, that nothing herein contained shall prevent the payment as heretofore to the law officers in cases of opposition to the granting of letters patent, and in cases of disclaimers and memoranda of alterations, of such fees as may be appointed by the Lord Chancellor and Master of the Rolls as the fee to be paid on the hearing of such oppositions, and in the case of disclaimers and memoranda of alterations respectively, or of such reasonable sums for office or other copies of documents in the office of the Commissioners, as the Commissioners may from time to time appoint to be paid for such copies, and the Lord Chancellor and Master of the Rolls and the Commissioners are hereby respectively authorized and empowered to appoint the fees to be so paid in respect of such oppositions, disclaimers, and memoranda of alterations respectively, and for such office or other copies.

Fees and salaries of officers.

XLVIII. It shall be lawful for the Commissioners of Her Majesty's Treasury from time to time to allow such fees to the law officers and their clerks (for duties under this Act

(a) This section is repealed by 16 & 17 Vict. c. 5, s. 1.

in respect of which fees may not be payable to them under the provisions lastly hereinbefore contained) as the Lord Chancellor and Master of the Rolls may from time to time appoint, and to allow such salaries and payments to any clerks and officers in respect of any additional duties imposed on them by this Act, as the said Commissioners of the Treasury may think fit.

XLIX. It shall be lawful for the Commissioners of her Majesty's Treasury to allow from time to time the necessary sums for providing offices under this Act, and for the fees, salaries, and payments allowed by them as aforesaid, and for defraying the current and incidental expenses of such office or offices; and the sums to be so allowed shall be paid out of such moneys as may be provided by Parliament for that purpose.

Sums for defraying salaries and expenses under this Act to be paid out of moneys provided by Parliament.

L. And whereas divers persons by virtue of their offices or appointments are entitled to fees or charges payable in respect of letters patent as heretofore granted within the United Kingdom of Great Britain and Ireland, or have and derive in respect of such letters patent, or the procedure for the granting thereof, fees or other emoluments or advantages: It shall be lawful for the said Commissioners of the Treasury to grant to any such persons who may sustain any loss of fees, emoluments, or advantages by reason of the passing of this Act, such compensation as, having regard to the tenure and nature of their respective offices and appointments, such Commissioners deem just and proper to be awarded; and all such compensations shall be paid out of such monies as may be provided by Parliament for that purpose: Provided always, that in case any person to whom any yearly sum by way of compensation shall be awarded and paid shall after the passing of this Act be appointed to any office or place of emolument under the provisions of this Act, or in the public service, then and in every such case the amount of such yearly sum shall in every year be diminished by so much as the emoluments of such person for such year from such office or place shall amount to, and provision in that behalf shall be made in the award to him of such yearly sum.

Power to Treasury to grant compensation to persons affected by this Act.

Account of salaries, fees, and compensation allowances to be laid before Parliament.

LI. An account of all salaries, fees, allowances, sums, and compensations to be appointed, allowed, or granted under this Act shall, within fourteen days next after the same shall be so appointed, allowed, or granted respectively, be laid before both Houses of Parliament, if Parliament be then sitting, or if Parliament be not then sitting, then within fourteen days after the next meeting of Parliament.

Not to extend to patents applied for before the commencement of Act.

LII. Letters patent may be granted in respect of applications made before the commencement of this Act in like manner and subject to the same provisions as if this Act had not passed.

As to letters patent granted before commencement of this Act for England, Scotland, or Ireland.

LIII. Where letters patent for England or Scotland or Ireland have been granted before the commencement of this Act, or are in respect of any application made before the commencement of this Act hereafter granted for any invention, letters patent for England or Scotland or Ireland may be granted for such invention in like manner as if this Act had not been passed: Provided always, that in lieu of all the fees or payments and stamp duties now payable in respect of such letters patent, or in or about obtaining a grant thereof, there shall be paid in respect of such letters patent for England or Scotland or Ireland on the sealing of such respective letters patent a sum equal to one-third part of the fees and stamp duties which would be payable according to the schedule to this Act in respect of letters patent issued for the United Kingdom under this Act, on or previously to the sealing of such letters patent; and at or before the expiration of the third year and the seventh year respectively of the term granted by such letters patent for England or Scotland or Ireland, sums equal to one-third part of the fees and stamp duties payable at the expiration of the third year and the seventh year respectively of the term granted by letters patent issued for the United Kingdom under this Act; and the condition of such letters patent for England or Scotland or Ireland shall be varied accordingly; and such fees shall be paid to such persons as the Commissioners of her Majesty's

Treasury shall appoint, and shall be carried to and form part of the said consolidated fund. (a)

LIV. The several forms in the schedule to this Act may be used for and in respect of the several matters therein mentioned, and the Commissioners may, where they think fit, vary such forms as occasion may require, and cause to be printed and circulated such other forms as they may think fit to be used for the purposes of this Act.

Forms in schedule may be used.

LV. In the construction of this Act the following expressions shall have the meanings hereby assigned to them, unless such meanings be repugnant to or inconsistent with the context; (that is to say:)

Interpretation of term.

The expression "Lord Chancellor" shall mean the Lord Chancellor or Lord Keeper of the Great Seal, or Lords Commissioners of the Great Seal.

The expression "the Commissioners" shall mean the Commissioners for the time being acting in execution of this Act.

The expression "law officer" shall mean Her Majesty's Attorney-General or Solicitor-General for the time being for England, or the Lord Advocate, or Her Majesty's Solicitor-General for the time being for Scotland, or Her Majesty's Attorney-General or Solicitor-General for the time being for Ireland.

The expression "invention" shall mean any manner of new manufacture the subject of letters patent and grant of privilege within the meaning of the Act of the twenty-first year of the reign of King James the First, chapter three.

The expressions "petition," "declaration," "provisional specification," "warrant," and "letters patent" respectively shall mean instruments in the form and to the effect in the schedule hereto annexed, subject to such alterations as may from time to time be made therein under the powers and provisions of this Act.

(a) This section is repealed by 16 & 17 Vict. c. 5, s. 1.