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THE

LAW AND PRACTICE

OF

PATENTS

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By SIDNEY BILLING,

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

AND

ALEXANDER PRINCE,

OF THE OFFICE FOR PATENTS OF INVENTIONS, &c.
LINCOLN'S-INN FIELDS.

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ADDENDA.

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

ERRATA.

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

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

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

— 20, *for* being, *read* afterwards.

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

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

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

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

p. ix-x mis-placed.

TABLE OF CASES CITED IN THE WORK.

PREFACE.

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

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

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

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

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

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

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

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

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LAW OF PATENTS.

CHAPTER I.

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

Patent, origin of.

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

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

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

Monopolies are offences at common law.

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

Patent, what.

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

(*b*) Lingard's Hist. of Eng. vol. vii. p. 380. Dolman's ed.

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

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

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

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

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

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

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

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

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

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

Monopolies to be void.

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

(j) I. 'Forasmuch as your most excellent Majesty, in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did in the year of our Lord God One thousand six hundred and ten, publish in print to the whole realm, and to all posterity, that all grants and monopolies, and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant and agreeable to the ancient and fundamental laws of this your realm: And whereas your Majesty was further graciously pleased expressly to command, that no suitor should presume to move your Majesty for matters of that nature; yet nevertheless upon misinformations, and untrue pretences of public good, many such grants have been unduly obtained, and unlawfully put in execution, to the great grievance and inconvenience of your Majesty's subjects, contrary to the laws of this your realm, and contrary to your Majesty's most royal and blessed intention, so published as aforesaid:' For avoiding whereof, and preventing of the like in time to come, may it please your excellent Majesty, at the humble suit of the Lords spiritual and temporal, and the Commons in this present Parliament assembled, That it may be declared and enacted; and be it declared and enacted by authority of this present Parliament, That all monopolies, and all commissions, grants, licenses, charters, and letters patent heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of any thing within this realm, or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty to dispense with any others, or to give license or toleration to do, use, or exercise any thing against the tenor or purport of any law or statute; or to give or make any warrant for any such dispensation, license, or toleration to be had or made; or to agree or compound with any others for any penalty or forfeitures

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

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

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

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

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

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

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

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

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

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

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judgment to be stayed or delayed by colour or means of any order, warrant, power, or authority, save only by writ of error or attaint; that then the said person and persons so offending shall incur and sustain the pains, penalties, and forfeitures, ordained and provided by the statute and provision and *præmunire* made in the sixteenth year of the reign of King Richard the Second.

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

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

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

Privileges granted by Parliament.

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

Warrants to justices, &c. saved.

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

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

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

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

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

(*r*) VIII. Provided also, That this act shall not extend to any warrant or privy seal, made or directed, or to be made or directed by his Majesty, his heirs or successors, to the justices of the Courts of the King's Bench or Common Pleas, and Barons of the Exchequer, justices of assize, justices of *oyer and terminer* and gaol-delivery, justices of the peace, and other justices for the time being, having power to hear and determine offences done against any penal statute, to compound for the forfeiture of any penal statute, depending in suit and question before them, or any of them respectively, after plea pleaded by the party defendant.

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

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

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

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

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

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

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

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

Disclaimer of title to part of invention.

Sec. I. Any person who as grantee, assignee, or otherwise, who hath or shall obtain letters patent for sole making, &c., may, if he thinks fit, enter with the clerk of the patents of England, Scotland, or Ireland, having obtained leave, if an English patent, of the attorney or solicitor-general; if a Scotch patent, of the lord-advocate or solicitor-general of Scotland; if an Irish patent, of the attorney or solicitor-general of Ireland, certified by his fiat and signature; a disclaimer of any part of either the title of the invention or of the specification, stating the reason for such disclaimer—or with such leave as aforesaid, may enter a memorandum of any alteration in the said title or specification, such disclaimer or alteration not to extend (enlarge) the right acquired by the letters patent; and on being filed by the clerk of patents, and enrolled with the specification, shall be deemed a part thereof in all the courts: Provided always, any person may enter a *caveat* against such disclaimer or alteration, which shall give such person a right to have notice of the application being heard by the attorney-general, &c., &c. Such disclaimer or alteration not to be receivable in evidence in any action or suit (save and except in any proceeding by *scire facias*) pending at the time when such was enrolled; in such case the original title and specification alone are receivable in evidence. So also, before granting such fiat, the attorney-general, &c., may

England.

Scotland.

Ireland.

Alteration of specification.

Caveat against disclaimer or alteration, where not receivable in evidence.

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

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

Advertisement may be required before fiat.

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

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

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

Confirmation of, when.

Opposer, right to be heard.

Parties to suit, notice of petition.

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have been or shall have been granted: provided also, that it shall be lawful for the attorney-general or solicitor-general or lord-advocate, before granting such fiat, to require the party applying for the same to advertise his disclaimer or alteration in such manner as to such attorney-general or solicitor-general or lord-advocate shall seem right, and shall, if he so require such advertisement, certify in his fiat that the same has been duly made.

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

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

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

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

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

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

Proceeding for an extension of the term.

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

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order to give a certificate under his hand, that the validity of the patent came in question before him, which record or certificate being given in evidence in any other suit or action whatever touching such patent, if a verdict shall pass, or decree or decretal order be made, in favour of such patentee or his assigns, he or they shall receive treble costs in such suit or action, to be taxed at three times the taxed costs, unless the judge making such second or other decree or order, or trying such second or other action, shall certify that he ought not to have such treble costs.

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

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

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

Trial.

Notice of objections to patent.

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

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

Costs.

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

Imitating patentee's mark.

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

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such defendant or plaintiff respectively at such trial unless he prove the objections stated in such notice: provided always, that it shall and may be lawful for any judge at chambers, on summons served by such defendant or plaintiff on such plaintiff or defendant respectively to shew cause why he should not be allowed to offer other objections whereof notice shall not have been given as aforesaid, to give leave to offer such objections, on such terms as to such judge shall seem fit.

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

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

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

I. Reciting and repealing the 4th section of the 5 & 6 of Wm. 4.(*f*)

Repealed by sec. 4 of 5 & 6 Wm. 4, c. 83.

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

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

Power to renew patent.

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

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

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

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

CHAPTER II.

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

Patent different to a monopoly.

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

Patent right, grant of.

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

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

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

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

Inducement for the crown to grant letters patent.

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

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

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

Matters which may be the subject of a patent.

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

MANUFACTURE.

Manufacture, what.

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

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

Definition of Lord Kenyon.

Definition of Lord Tenterden.

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

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

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

Definition of Heath, J.

Buller, J.

Combination.

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

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

Tindal, C. J.

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

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

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

Quantity of invention.

Consideration in granting a patent.

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

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

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

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

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

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

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

Manufacture, what.

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

Construction of the statute.

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

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

(*x*) Supra, p. 499.

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

PRINCIPLE.

Principle, what.

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

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

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

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

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

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

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

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

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

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

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

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

Application of a principle.

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

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

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

METHOD.

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

Method, what.

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

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

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

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

Patent for a method, when good.

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

PROCESS.

Process, what.

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

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

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

Patent for a process, when not grantable.

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

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

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

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

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

Mere difference of manipulation insufficient to support a patent.

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

Process, definition of.

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

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

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

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(*t*) Supra. (*u*) 9 Jurist, 231.

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

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

Patent for a process, when obtainable.

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

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(*x*) Supra, Lord Tenterden.

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

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

NOVELTY.

Novelty. Discovery and novelty, difference between.

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

Publication in a book.

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

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

With all deference to the decision of the learned judge,

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

(*u*) Davies, Pat. Ca. 61.

(*v*) 13 Law Jour. N. S. C. P. 218.

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

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(*w*) Supra.

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

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

Evidence necessary to negative novelty.

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

Evidence of prior use.

to say, whether public use had been made of the machine; they found it had not, which verdict Lord Tenterden said

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

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

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

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

Simultaneous discovery, effect.

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

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

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

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

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

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

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

Combination of known materials to form a new manufacture.

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

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

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

New manufacture or not is a question for the jury.

Specification tending to mislead.

(*e*) 3 Bing. N. C. 587.

(*f*) 1 Gale & Davison, 736.

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

Fraudulent intent in framing specification.

Old process effected by different means.

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

(g) 1 Gale & Davison, 739.

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

Variation of an old principle.

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

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

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

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

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

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

If a patent is taken out for several inventions, and one of the inventions is found not to be new, the patent would be held bad, not for that only, though it was a distinct manufacture, but would extend throughout the whole patent, and would make it void, as well for those things which were new and meritorious inventions, as for that on which the proof failed, as was illustrated in the case of Brunton *v.* Hawkes and Others, (*m*) which was a patent for improvement in the manufacture of chain cables, anchors, and windlasses. It was proved at the trial, that the support within the links of the chain cable was not new,

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

but the method of inserting it was; the old plan being by perforation, the new by the insertion of a bar of iron across the interior of the links, by welding it to the sides, and that the patent cable would resist a much greater strain than those made by the old mode. That the patent mode of manufacturing anchors had never before been applied to ships' anchors, though it had to adze and mushroom an-

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

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

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

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

See the reports.

Patent for a new combination of known parts.

Invention sufficient to support a patent.

Entirety of the consideration.

New combination of old principles.

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

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

Combination of old means, without claiming a new mode.

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

Claim for an improvement.

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

New combination of known parts.

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

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

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

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

Patent for an addition.

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

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

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

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of the staple, and that the machines manufactured in accordance therewith were constructed with a reach of $4\frac{3}{4}$ inches.—Question for the opinion of the Court was, whether the plaintiff's patent was void in point of law. Held, the patent was not valid in law. "The new machinery appears to be a subject proper for a patent, but the latter part of the patent does not appear to be a subject upon which in law a patent can be taken out. Looking at the whole specification, it is not the use of the troughs, as used by him, on which he (plaintiff) relies, but it is the placing and retaining the respective rollers within $2\frac{1}{4}$ inches of each other. Whether for such a placing of the rollers under the circumstance stated in the case, a patent can be granted, is the real case between the parties. We think it cannot; for it appears by the indorsement, before the grant of the patent the reach was varied, and in cotton-spinning had been less than $2\frac{1}{4}$ inches; therefore, the application of a $2\frac{1}{4}$ inches reach to flax when in a state of maceration does not appear any new invention or discovery, but is the application of a piece of machinery, before in use, to the new macerated state of the flax; so also the application of moisture was not new, though exerted in a different mode. Suppose a patent had been obtained for an entire new method of reducing the fibres of flax to a short staple, we think a second patent could not be taken out for an improved mode of machinery in spinning flax, which consisted of nothing more than spinning of the short staple of flax by a spinning machine of a fixed reach, not less than already in use for spinning cotton, for the effect would be to prevent the patentee of the old machine from using his machine at the proper reach." (500.) Tindal, C. J. (judgment of the Court).

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

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

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

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

Patent for improvement upon a patent.

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

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

(*r*) Supra.

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

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

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

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

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

PUBLICATION.

Publication, what.

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

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

User. What vitiates a patent.

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

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

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

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

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

Sale in public market.

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

Sale of exported goods.

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

User in a small degree will vitiate a patent.

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

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

This point was decided by the case of Brown *v.* Annandale,(*f*) which

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

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

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

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

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

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

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

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

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

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

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

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

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

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

User in the colonies vitiates English patent.

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

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

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

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

Exposure for sale.

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

Private user, and after patent, effect.

After patent by a stranger.

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

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

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

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

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

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

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

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

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

Secret user of a machine, effect.

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

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

Publication, how judged.

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

Private user, by way of experiment.

Perfecting an invention by the improvement of others.

Suggestion of an important part of the process.

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

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

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

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

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

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

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

Employment of a person to work out a principle.

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

Disclosure of the secret.

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

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

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

(*z*) Vide infra, Caveat.

Experiments by other persons, effect on patent.

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

Prior publication in a specification, notice to the world.

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

Publication, a question for a jury.

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

An invention must be useful to support a patent.

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

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

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

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

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

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

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

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

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

Patent for an useless invention.

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

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

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

Patent for an useless invention, effect.

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

(*g*) Supra.

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

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

INTRODUCTION OF A NEW TRADE FROM ABROAD.

Introduction of a new trade from abroad.

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

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

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

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

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

CHAPTER III.

TITLE OF A PATENT AND ITS LEGAL CONSTRUCTION.

Title.

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

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

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

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

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

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

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

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

Vagueness of description.

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

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

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

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

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

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

Title, of what it should consist.

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

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

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

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

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

Choice of a title.

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

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

Necessity of a strict construction of the title.

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

Vague title.

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

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

Evil of adopting a vague title.

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

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

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

(*j*) Supra.

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

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

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

CHAPTER IV.

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

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

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

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

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

Caveat, where entered.

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

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

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

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

course directed by the crown officers.

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

Coalescing.

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

Inventions differing.

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

Caveat, use of.

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

Costs of entering the caveat.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

CHAPTER V.

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

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

Patents not demandable as of right; how obtained.

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

Persons entitled to apply for patents.

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

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

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

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

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

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

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

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

(*b*) Infra.

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

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

(*c*) Supra.

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

PRACTICE.

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

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

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

(*d*) See title, supra.

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

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

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

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

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

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

(*e*) Vide Caveat, supra.

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

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

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

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

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

Time taken to obtain letters patent.

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

Scotland.

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

Time required, and expense in obtaining a Scotch patent.

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

Ireland.

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

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

Time required, and expense in obtaining an Irish patent.

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

CHAPTER VI.

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

Patent a grant.

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

Construction of the specification.

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

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

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

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

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

Grant of letters patent, what.

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

Specification, use of.

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

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

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

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

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

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

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

Period of the invention of the clause for enrolling patent.

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

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

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

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

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

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

Sufficiency of the specification a matter of the greatest importance.

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

Great care necessary in preparing the specification.

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

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

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

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

Prolixity in a specification.

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

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

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

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

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

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

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

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

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

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

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

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

Omission to state matters within the knowledge of the inventor.

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

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

(*o*) Wood *v.* Zimmer (Holt's N. P. 60), which was a patent for making "verdigris."—The patentee had been accustomed to put aquafortis clandestinely into the boiler, for the purpose of more quickly dissolving one of the ingredients used, copper, but the verdigris produced was neither better nor cheaper than that made according to the specification. Gibbs, C. J.—A "man who applies for a patent, and possesses a mode of carrying out that invention in the most beneficial manner, must disclose the means of producing it in equal perfection, and with as little expense and labour as it costs

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

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

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

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

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

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

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

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

Inaccurate use of words.

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

Evidence as to intention to mislead.

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

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

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

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

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

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

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

Specification tending to mislead.

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

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

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

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

to be carried out by means of one machine, and it is proved the invention is not effected by one, but by several machines, though of the same character, it will be fatal.(*a*) In this case the matter was one of particular hardship; the usefulness of the invention was afterwards acknowledged by a parliamentary grant.

Seeking to cover more than patentee is entled to.

If more is sought to be covered by the patent than the patentee is strictly entitled to, it will be bad, not only for the extra claim,(*b*) but for that also to which he is fairly entitled.

Patent for an improvement.

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

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

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

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

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

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

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

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

Rule of law respecting improvements.

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

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

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

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

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

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

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

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

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

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

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

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

The claim must not be too large.

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

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

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

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

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

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

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

Morgan *v.* Seaward, supra.—"If certain inventions are suggested to be improvements, and one is not so, we think the patent would be void, on the ground of fraud upon the Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent, where such utility is not suggested in the patent itself as the ground of the grant. In the case of Lewis *v.* Marling, that the patent was void for false neglect, was not pressed upon the Court; the decision was, that want of utility of part did not vitiate a patent."

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

(*o*) Vide Disclaimer, infra.