

Conditions as
to the Specifi-
cation.

been already granted for the sole use, exercise and benefit thereof; it being Our will and pleasure that the said *A. B.*, his executors, administrators and assigns, and all and every other person and persons to whom like Letters-patent or privileges have been already granted^y as aforesaid, shall distinctly use and practise their several Inventions by them invented and found out, according to the true intent and meaning of the same respective Letters-patent and of these presents: Provided likewise, nevertheless, and these Our Letters-patent are upon this express condition, *that, if the said A. B. shall not particularly describe^z and ascertain the nature of his said Invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and cause the same to be filed in* within

^acalendar months next and immediately after the date of

these our Letters-patent, [that if the said instrument in writing filed as aforesaid does not particularly describe and ascertain the nature of the said Invention, and in what manner the same is to be performed,] and also if the said A. B., his executors, administrators or assigns, shall not pay or cause to be paid at the Office of Our Commissioners of Patents for Inventions the sums^b following; that is to say, the sum of

On nonpay-
ment of stamp
duty.

^y Hindmarch, 431. The express stipulation is needless, it being established Law, that "if the King by his Letters-patent grant the same thing to several persons, a *scire facias* lies for repealing the last Patent." 4 Inst. 88; Dy. 197 b, 198 a; Adm. Dy. 1336; 2 Rol. 191, c. 50, cont.; 39 Hen. VI. 33. See *Dobbs v. Penn* (1849), blind-rollers, 3 Exch. 427.

^z Where Letters-patent are obtained by means of a Provisional Specification, the portions within brackets are inserted,—when by means of a complete Specification, those in italics take their place.

^a 16 & 17 Vict. c. 115, s. 5. By 32 Geo. III. c. 73, Booth's Patent (1792) was allowed eight months to enrol, to prevent the invention getting to foreign countries.

^b By stat. 16 Vict. c. 5, s. 2, repealing stat. 15 & 16 Vict. c. 83, ss. 17, 44, 45, 46 and 53, and so much of the Schedule as relates to Fees and Stamp Duties payable under the act, it is enacted, that "all Letters-patent for Inventions under the said act shall be void, and their powers determine at the expiration of three and seven years respectively from the date thereof, unless before then the Stamp duties prescribed by the Schedule to the act be paid: and such Letters-patent, or a duplicate thereof, shall be stamped with proper stamps, showing the payment of such respective stamp duties, and shall, when stamped, be produced before the expiration of such three years and seven years respectively, at the Office of the Commissioners, and a

pounds on or before the day of
 A.D. and the stamp duty payable in
 respect of the certificate of such payment; and the sum of
 pounds on or before the day of A.D.
 and the stamp duty payable in respect of the certificate
 of such payment; and also if the said *A. B.*, his executors, adminis-
 trators or assigns, shall not supply^c or cause to be supplied for Our

Conditions of
 supplying arti-
 cles for Her
 Majesty's
 service.

certificate of the production of such Letters-patent or duplicate so
 stamped, specifying the date of such production, shall be endorsed by
 the Clerk of the Commissioners on the Letters-patent or duplicate, and
 a like certificate shall be endorsed upon the Warrant for such Letters-
 patent filed in the said Office."

Schedule of Stamp Duties to which this Act refers.

	£	s.	d.
On Petition for grant of Letters-patent	5	0	0
On Certificate of Record of Notice to proceed . .	5	0	0
On Warrant of Law Officer for Letters-patent . .	5	0	0
On the Sealing of Letters-patent	5	0	0
On Specification	5	0	0
On the Letters-patent, or a Duplicate thereof (meaning those issued 15 & 16 Vict. c. 83, s. 22, in lieu of those destroyed or lost), be- fore the expiration of the third year	50	0	0
On the Letters-patent, or a Duplicate thereof, before the expiration of the seventh year . .	100	0	0
On Certificate of Record of Notice of Objections . .	2	0	0
On Certificate of every Search and Inspection . .	0	1	0

^c Considerable difficulty has arisen under this provision, which does not,
 it appears, amount to a contract to purchase the articles of the Patentee.
 In a case before Lord Eldon (*Walker v. Congreve* (1816), powder-
 barrels, 29 Lond. Journ. 311; Carp. Pat. Rep. i. 356), the invention of
 the Patentee had been used in the Royal Laboratory at Woolwich,
 under the direction of Sir W. Congreve, Secretary to the Board of Ord-
 nance. An injunction to restrain its use was disobeyed. On a mo-
 tion to commit the defendant for its breach, Lord Eldon, C., remarked
 "Speaking with all due respect, I will treat Government here as I
 would any other suitor I recommend Government to pay the
 costs of this application. I can only recommend to Government;
 but by the use of this language I give it to be understood that if the
recommendation is not attended to, I will make an *order* for the de-
 fendant, Sir William Congreve, to pay the said costs." In the case
 of *Pering's Patent* (1836 (anchors), 6 N. & M. 472; 4 A. & E. 949),

Power to grant
licences.

service all such articles of the said Invention as he or they shall be required to supply by the Officers or Commissioners administering the department of Our service for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said Officers or Commissioners requiring the same, that then and in any of the said cases these Our Letters-patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by Law be granted: And lastly, We do by these presents, for Us, Our heirs and successors, grant unto the said *A. B.*, his executors, administrators and assigns, that these Our Letters-patent, on the filing thereof, shall be in and by all things good, firm, valid, sufficient and effectual according to the true intent and meaning thereof, and shall be taken, construed^c and adjudged in the most favourable and beneficial sense for the best advantage of the said *A. B.*, his executors, administrators and assigns, as well in all Our Courts of Record as elsewhere, and by all and singular the Officers and Ministers whatsoever of Us, Our heirs and successors, in Our

the invention was made use of by the Admiralty in the Royal Dockyards, with the consent of the Patentee, who gave instructions gratuitously in the employment of it. The Court of Queen's Bench refused to issue a *mandamus* to compel the Lords of the Admiralty to settle terms according to the Patent. "Such a *mandamus*," said Littledale, J., "would be a sort of *quantum meruit* for the use of the Patent, and that as not only debts but unliquidated damages may be recovered at Common Law against the Crown by Petition of Right; so, therefore, unless this complete and ordinary remedy be taken away by the Patent, the applicant is not entitled to avail himself of the extraordinary remedy by *mandamus*." (See Tapping on *Mandamus* (1848), 213, and authorities there cited.) The evidence of Mr. Westhead, M. P., before the Committee, in 1851 (2660), disclosed a case of great hardship on the part of Patentees from this arrangement.

^c *Travell v. Carteret*, 3 Lev. 135; *Alcock v. Cooke*, 5 Bing. 340. The King's Patents are usually construed strictly in favour of the Crown. (5 Bac. Abr. 602; Web. P. R. 26.) The grant of Letters-patent for inventions confers no *prima facie* right on the Patentee. (*Dobbs v. Penn*, 1849, 3 Exch. 427.) A recent case (Captain Carpenter's screw propeller, extended 1854) has directed the attention of Parliament to this subject. (Times, July 11th, 1854.)

new Act, the proceedings in the event of the original Letters-patent being destroyed or lost are much simplified, the Commissioners being empowered^h to issue other Letters-patent,ⁱ of the like tenor and effect and of the date of the original Patent.

R. v. Newton.

In the *Queen v. Newton*,^k a curious instance is afforded of rigorous adherence to ancient custom in deciding the practice as to Patents in the present day. It was an application to compel the defendant to bring the Patent into Court to have the same cancelled and the Seal cut therefrom. The question had been tried by action of *scire facias*,^l and judgment awarded, that the Patent was to be considered null and void. The Court inquired where precedents were to be found for the present application. It was admitted that there was no case upon record exactly similar to that before the Court, but one "bearing upon the point" occurred in the reign of Edward III., in reference to^m a Charter granted to the Friars Carmelites; this charter had been annulled by the Court of King's Bench, and the Friars were ordered "to take the Patent into the Court of Chancery (whence it had issued), there, according to form, to be *cancelled*, crossed with lines, and the Great Seal broken and cut off." After some further discussion it was decided, that the enrolment of the Patent should be cancelled, that a *vacatur* should be entered on the roll, and that the defendant should undertake not to bring a writ of error, or make any assignment of the Patent.

Revocation by
the Queen's
Bench.

Several precedents are to be found in the records of the Court of Queen's Bench of judgments given by that

^h 15 & 16 Vict. c. 83, s. 22.

ⁱ Copied from the Warrant which embodies the form of the Letters-patent, and is filed in the Commissioners' Office.

^k (1845) 26 Lond. Jour. 361, cor. Lyndhurst, L. C., assisted by Lord Langdale, M. R.

^l (1844) Lord Denman, Q. B.

^m No mention is made of this in *Dugdale* or *Stevens*.

Court to repeal Letters-patent. In *Mich. 3 & 4 Phil. & M., Roll. 16,*ⁿ is a record of *scire facias* to repeal Letters-patent, returnable in the King's Bench, '*quod literæ patentés revocentur, admittentur et evacuentur, et quod officium in manus Domini Regis seisiatur.*'

In *Bynner v. Queen,*^o the power of Courts of Common Law to order the cancelling of a Patent was argued at great length. In an elaborate judgment expressing the opinion of the Court, Tindal, C. J., said, "On the whole, we think the balance of authorities is decidedly in support of the position contended for on the part of the Crown; that the record is sent down to the Queen's Bench; that the Queen's Bench has authority to award the judgment, and afterwards to transmit either the record or the tenor thereof to the Court of Chancery, in order to be fully carried into execution; and that nothing remains to be done in the Court of Chancery but a mere ministerial act by the officers of that Court." The judgment of the Court below being complete, the Court of Chancery will not stay the necessary formal execution of that judgment.^p

The documents remaining of Record under the new practice are the Warrant of the Law Officer for the sealing, and the Specification, both of which are filed in the Office of the Commissioners.

Documents remaining of Record.

Transcripts of the Letters-patent are to be transmitted to the Director of Chancery in Scotland,^q and to the Court of Chancery in Dublin,^r for enrolment in the records of those Courts.

Transcripts of Letters-patent for Scotland and Ireland.

ⁿ To repeal a grant of the Office of Keeper of the Gaols of *Ilchester* and *Dorchester*.

^o Ex. Ch. 9 Q. B. 523. See 12 & 13 Vict. c. 109, ss. 35, 36 (Petty Bag, &c., Offices Amendment), and *post*, under head of "*Scire Facias*."

^p *R. v. Eastern Archipelago Company* (1854), L. C., 1 Eq. Rep. 513. The formality observed in this case was the proclamation three times by the Clerk of the Petty Bag for the defendants to bring in the Charter to be cancelled. No answer being returned, his Lordship named fourteen days as the period within which the Charter should be delivered up.

^q 15 & 16 Vict. c. 83, s. 18.

^r 15 & 16 Vict. c. 83, s. 29.

CHAPTER VI.

AMENDMENT AND DISCLAIMER.

Disclaimer
wrong in prin-
ciple.

A CONSIDERATION of Amendment and Disclaimer, from the point of view assumed in this Treatise, produces a strong conviction on the mind that the theory proceeded on is false, and the practice, beyond a doubt, highly prejudicial to public interests. Good policy requires that the invention at the period of the grant should be complete,^a and the proceedings connected with it such as to discourage all laxity in the Patentee. The very contrary appears to be at the foundation of the practice as at present established, as the terms of the Patent privilege, carelessly conceded in the first instance,^b may, with as little supervision, at any period of their continuance, be varied, almost arbitrarily, by the Patentee.

How neces-
sary.

That inaccuracies in the Specification, and misunderstandings as to the nature of some inventions in their earlier stages, are unavoidable, and that against such it is mere justice to protect the Patentee, is what no one will attempt to deny. The evils attendant on Disclaimers afford, however, a fair subject of complaint as an abuse of the remedy proposed, and an appropriation by parties never contemplated by the Act,^c of the relief devised

^a Co. Litt. 70 (1851), Evid. 1121, Fairbarn.

^b 2 Vent. 344; *Attorney-General v. Vernon*, 1 Vern. 277; 2 Ch. Rep. 353.

^c "The power to disclaim," says the Master of the Rolls (Sir J. Romilly), *Reg. v. Mill* (1851, 14 Beav. 315), "given by Lord Brougham's Act, is very valuable, and of great importance to Patentees; but it is a power which, if indiscriminately exercised, would

against hardships arising in the case of meritorious inventions and unforeseen inaccuracies. The necessity for allowing some mode of escape from the defects arising from the necessarily secret and hurried manner in which experiments were formerly conducted,^d is to a very considerable extent diminished by the institution of the new feature in Patent Law—Provisional Protection.

Admitting, however, the necessity of some such powers being placed within reach of the Patentee, it is much to be regretted that the practice^e has not followed the channel opened for it by section 2 of 5 & 6 Will. IV. c. 83, which provides for the *Confirmation* of Letters-patent where the invention is really meritorious, and the errors vitiating the grant have been involuntary on the part of the Patentee : an arrangement which, by substituting the jurisdiction of the Privy Council for that of the Law Officer, bade fair to place this branch of the Law on as satisfactory a footing as that connected with the Prolongation of Patents.

Inconveniences
of the present
practice.

Another reason for providing some such resource for work considerable injustice to the public. In many cases a person may make an Invention, some part of which may be comprised in another Patent, which he may be advised is wholly invalid, and yet by the effect of a subsequent disclaimer it may become perfectly good, and a liability created which did not previously exist. It is very desirable to afford protection to Patentees in consequence of the difficulties arising from the nature of the subject and the state of the Law. It is proper they should be allowed to correct errors in their Patents by removing from the Specification parts which are not material or substantial, or which they have since discovered not to be new inventions ; but this power ought to be exercised with great care and discretion."

Necessity for
enactments on
the subject.

^d (1841) Web. Law and Pr. 17.

^e The inclusion of the conditions of validity for Disclaimers in 7 & 8 Vict. c. 69, prescribing the powers of the Privy Council, evidences the intention of superseding the ordinary practice by a jurisdiction similar to that exercised by the Judicial Committee in the prolongation of Patents.

Powers of the
Master of the
Rolls.

Patentees is to be found in the technical difficulties with which the correction of the public records in this department was surrounded. At Common Law the power of the Master of the Rolls to amend^f the Records of the Court of Chancery was limited to the correction of clerical errors, and did not extend to the removing^g from those Records a memorandum of alteration enrolled under Stat. 5 & 6 Will. IV. c. 83, the terms of which were inconsistent with the provisions of the first section of that Statute. In a case of this kind Lord Langdale, M. R., said, with reference to the practice^h of the Court in the amendment of enrolments, "It would seem that it has always been usual to amend clerical errors. When errors have been made in grants, as was said, *per incuriam et ex inani inadvertentiâ scriptoris*, they have been amended by the Master of the Rolls, sometimes under the authority of a Warrant from the Crown, sometimes with the consent of the Attorney-General, sometimes in consequence of a reference to him by the Lord Chancellor; and there is an instance of an amendment being made by an order of the Lord Chancellor, pursuant to an order of the King."

The Lord
Chancellor's
power.

Even the powers of the Lord Chancellor were confined within narrow bounds. In *Ex parte Beck*ⁱ the question was whether there was to be an amendment of the enrolment or a new Patent. The Chancellor held his powers did not amount to effecting the former, but inti-

^f For instances of records so amended, see Web. P. R. 647, n. (l). Under the present practice no alteration is to be allowed in a Provisional Specification *at the instance of the applicant* after it has been recorded, except for the correction of clerical errors or of omissions made *per incuriam*. (2nd Set of Rules.)

^g *Re Sharp's Patent, Ex parte Wordsworth* (1840), flax spinning, Web. P. R. 641; 3 Beav. 245.

^h The cases referred to by his lordship are cited in Web. P. R. 647, note (l).

ⁱ (1784) Thurlow, L. C., 1 Br. Ch. Ca. 578; Web. P. R. 430, n.

mated an opinion that if the Petitioners applied for a new Patent, the Law Officers, under the circumstances, would forego their fees.

In a case before Lord Gifford,^k the Specification, in which the word "wire" had been written instead of "fire," was ordered to be amended. In one before Sir J. Leach, "which" for "wheel," and "increase" for "invert," were amended. There are other similar cases, in which the errors have been more or less numerous, but all of the same kind. The alterations were attended with much formality, and entailed consequently considerable expense. The cost of altering the word "pressing" into "dressing" is mentioned as having amounted to 30*l*.

Instances of trifling amendments.

Such was the posture of affairs^l previous to the enactment of 5 & 6 Will. IV. c. 83, an Act for which inventors are indebted almost wholly to the exertions of Lord Brougham. By section 1 of that Statute the Patentee was enabled to enter with the Clerk of Patents, by permission of the Crown, a Disclaimer of any part of the Title or Specification, or a Memorandum of any alteration therein. "The spirit of the Act," says Mr. Justice Maule,^m "is this, that inasmuch as there may be trifling defects in some small and insignificant portions of a Patent *which is in all other respects good*, in such case amendments may be made. The principle of the enactment seems to be that when there is some matter which the Attorney-General, in his judgment, may consider to be such a matter as may properly be amended by disclaimer or alteration, in such a case the Patent shall not be avoided, but may be amended. Before this Act the Master of the Rolls had the power of amending Letters-patent in some

Amendment of Patents.

Spirit of the Act.

^k *Whitehouse's Patent* (gas tubes).

^l *Gibson v. Brand* (1842), silk, Web. P. R. 640; *Morgan v. Seaward* (paddlewheels), 7 Lond. Journ. 182; *Rubery v. Burrs*, 3 Lond. Journ. 246; Carp. 94.

^m *Reg. v. Mill* (1850), C. B., instruments for marking, &c., 1 L. M. & P. 707.

trifling matters; under this Act, however, an amendment must be made with more formality."

Rubery's case. The emendation of clerical errors was, however, continued after the passing of the Act. In *Rubery's case*,ⁿ the Specification, reciting a false date (October for November) for the Grant, was amended by an order of the Master of the Rolls. In another^o the numbers of reference to a plan had by accident become transposed, the amendment was allowed.

Nickel's. In the case of *Nickel's Patent*,^p "recovering" had been written for "covering." The Chancellor and Master of the Rolls made a joint order for the resealing of the Letters-Patent with the alteration, on the undertaking of the Patentee to abandon an action then pending, and not to bring any action for infringement before the resealing.

In a recent case^q the engrossment of the Letters-patent bore date two days before the date of the Privy Seal, and the Patentee, not being aware of the discrepancy, was a day too late in enrolling his Patent. It was there ordered, that, as the mistake arose from the misprision of the clerk, the enrolment should be amended.

The practice relating to such Disclaimers and Memoranda of alterations is regulated by the provisions of the following Statutes, in addition to the provisions of the Act creating them, viz., 7 & 8 Vict. c. 94; 12 & 13 Vict. c. 109; 15 & 16 Vict. c. 83, and 16 & 17 Vict. c. 115. The distinction originally observed^r between Disclaimers and Memoranda of alterations has in the course of practice become obliterated, the terms being at present used indifferently or together.^s

ⁿ (1837), umbrellas, Langdale, M. R., Web. P. R. 649, n.

^o *Re Redmund* (1828), door hinges, 5 Russ. 44.

^p (1841), fibre covering, Langdale, M. R., Web. P. R. 656.

^q *Re Adams' Patent* (1853), L. C., 21 L. T. 38.

^r Hindm. 204.

^s *Reg. v. Newton* (1845), 26 Lond. Journ. 362.

The party eligible to act in the case of Amendment and Disclaimer was at the outset of the practice the subject of considerable difference of opinion,^t according to the interpretation affixed to the words "any person who as grantee, assignee or otherwise, hath obtained, or who shall hereafter obtain, Letters-patent."

Who is to disclaim.

In *Spilsbury v. Clough*,^u where the disclaimer had been enrolled by the grantee, who did not at the time possess the entire interest in it, Lord Denman, C. J., observed, "I think the grantee falls within the description given in the statute of the persons who may enter a disclaimer; any inconveniences which might arise from such a power may be obviated by the exercise of the discretion conferred upon the Attorney and Solicitor-General, who will, before they grant leave for that purpose, take cognizance of the name in which permission is given." The opinions expressed by the learned judges in that case amounted in effect to the position, that, irrespective of his interest in the Patent, the Patentee was the proper party to disclaim.

Patentee, after assignment, entering disclaimer.

To set at rest, however, all doubts as to whether under the above provisions a plaintiff, after assigning his interest, could enter a Disclaimer, the Stat. 7 & 8 Vict. c. 69 (Privy Council Appellate Jurisdiction), was enacted, by sect. 5 of which^v it is enacted, "That in case the original Patentee or Patentees hath or have departed with his or their whole, or any part of his or their interest, by assignment to any other person or persons, it shall be lawful for such Patentee, together with such assignee or assignees, if part only hath been assigned, and for the assignee or assignees, if the whole hath been assigned, to enter a Disclaimer and Memorandum of alteration,

7 & 8 Vict. c. 69.

^t *Russell v. Ledsam* (gas tubes), 1848, 1 H. of L. Cases, 687.

^u (1842), chloride of lime, 2 Gale & Dav. 17; 6 Jur. 579; Web. P. R. 255; 2 Q. B. 466.

^v Per Pollock, C. B., *Wullington v. Dule* (1852), Exch., gelatine, 19 L. T. 187.

under the powers of the said recited Act,"* which, when entered and filed as there prescribed, "shall be valid and effectual in favour of any person or persons in whom the rights under the said Letters-patent may then be, or thereafter become, legally vested; and no objection shall be made in any proceeding whatsoever, on the ground that the party making such Disclaimer or Memorandum of such alteration had not sufficient authority in that behalf."

Section 6.

By sect. 6, Disclaimers and Memoranda of alterations made before the passing of the act "by such Patentee with such assignee, or by such assignee as aforesaid," are declared valid.

Disclaimer part of Letters-patent.

The new Act extends to the Patentee[†] the advantages conferred by 5 & 6 Will. IV., amended by 11 & 12 Vict. c. 94, s. 14, and re-enacted by 12 & 13 Vict. c. 109, s. 15, whereby the grantee, assignee or otherwise proprietor of Letters-patent, may enter a "Disclaimer" of any part of either the title of the invention, or of the Specification, stating the reason for such Disclaimer, "which, being enrolled with the Specification, shall be deemed and taken to be part of such Letters-patent and such Specification in all Courts whatsoever." It also declares the filing of the Disclaimer or Memorandum of alteration by leave of the Law Officer to be, except in cases of fraud, conclusive as to the sufficient authority for the entry of the Disclaimer.[‡]

What may be disclaimed.

The next consideration is the matter to be disclaimed, or the nature and extent of the changes effected by Disclaimer or Memorandum of alteration. As in the case of the subject matter of the original grant, this is a matter with respect to which general rules are inapplicable, and

* 5 & 6 Will. IV. c. 83.

† 15 & 16 Vict. c. 83, s. 39.

‡ *Spilsbury v. Clough* (1842), chloride of lime, 2 Q. B. 466; *Perry v. Skinner* (1837), Exch., pens, 2 M. & W. 471; *Reg. v. Mill* (1850), C. B., instruments for marking, 1 L. M. & P. 444.

which must in each case^a depend upon the nature of the invention. The only restriction imposed by Statute is, that it must not be "such Disclaimer or such alteration as shall extend the exclusive right granted by the said Letters-patent."

The extent of the alterations in its description gives, as we have seen, a very inadequate idea of the extent of the alteration in the results of a manufacture. The real effect of any alteration in a Specification^b may, therefore, be to create a Patent right materially different from that intended to be conferred by the original Letters-patent.

The Act requires a statement of the reason for making the Disclaimer. This is usually complied with by setting out shortly in the Petition the points in which the Patentee believes the Title, the description, or the claims in the Specification of his Patent, to be defective. Inconsistency between the Provisional and Complete Specifications seems, in the present aspect of the Law, likely to constitute the main reasons for desiring an alteration in Letters-patent granted under the present system.

Reason for the Disclaimer.

The assent of the Crown to the entry of the Disclaimer or Memorandum of alterations is an indispensable preliminary. The Act originating the procedure^c provided for this assent by means of the *fiat* and signature of the Attorney or Solicitor-General in the case of an English, of the Lord Advocate or Solicitor-General of *Scotland* in the case of a Scotch, and of the Attorney or Solicitor-General of Ireland in that of an Irish, Patent. Patents being now granted for the United Kingdom, the assent of the Attorney or Solicitor-General alone is requisite for Patents granted under the new Act; Disclaimers must be assented to by the same Law Officers as before.

Assent of the Crown.

Applications for Disclaimer and alterations of Patents

Amendment of Patents granted under the old system.

^a 14 Jur. Pt. II., 462, *Heath's Patent* (steel), 10 M. & W. 444.

^b (1851) Evid. 2789, Sir J. Romilly, M. R.

^c 5 & 6 Will. IV. c. 83, s. 1.

granted under the old system (previously to 1st October, 1852) are not received at the Office of the Commissioners. The practice with regard to these is that obtaining^d previous to the operation of 15 & 16 Vict. c. 83—Petitions and *caveats*, with reference to English Patents, must be entered, as before that Act, at the chambers of the Law Officers.

Practice of disclaiming.

Application for leave.

The first step to be taken by the party entitled to disclaim is by an application for leave,^e in the following form, to be left at the Office of the Commissioners.

TO THE COMMISSIONERS OF PATENTS.

The petition of *A. B.* of _____, in the county of _____, showeth that your Petitioner hath obtained her Majesty's Letters-patent for _____, bearing date the _____ day of _____, and hath duly described the nature of his invention, and in what manner the same is to be performed, by an instrument in writing duly filed in the office of the Court of Chancery appointed by the Lord Chancellor for filing Specifications [*nature of and reasons for the alterations intended to be made*].

Your petitioner therefore prays leave to file in the Office appointed for filing Specifications in Chancery the said Disclaimer [*or "Memorandum of alteration"*], a copy of which, signed by your Petitioner, is left herewith, in the form in which your Petitioner is desirous the same should be entered as aforesaid. And your Petitioner, &c.

Caveat on opposition.

Parties interested may oppose the entry of a Disclaimer or Memorandum of alteration, the provisions of the Act^f being, "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 the Solicitor-General respectively." A *caveat*^g in the following form, left at the Office of the Commissioners, entitles the party leaving it to notice of

^d Hindmarch, Godson, Webster.

^e Subject to a stamp duty of 5*l.*

^f 5 & 6 Will. IV. c. 83, s. 1.

^g Subject to a stamp duty of 2*l.*

any application for leave to enter, and seven days notice of the next meeting appointed by the Law Officer.

Caveats may be lodged at any time before the actual issuing of the *fiat*. May be lodged until issue of the *fiat*.

CAVEAT AGAINST DISCLAIMER.

Caveat against any fiat or leave being granted to *A. B.* to enter any Disclaimer or Memorandum of alteration of any part of the Title or Specification in the Patent of the said *A. B.* for _____, dated the _____ day of _____, without notice to [*party opposing*].

The effect of the Patent Law Amendment Act, 1852, has been to substitute one *caveat* at the Office of the Commissioners for the *caveats* at the chambers of the Law Officers of the three kingdoms.^h Only one requisite.

The *caveats* lodged with the Commissioners are forwarded, with the Petition, the Disclaimer, and a copy of the original Specification, to the Law Officer,ⁱ who may, before granting his *fiat* for the entry of a Disclaimer or Memorandum of alteration, require the party applying to advertise^j in such manner as he may think fit. The following is the form in present use:— Law officer may require applicant to advertise.

Notice is hereby given, that *A. B.*, grantee [*or* “assignee”] of Letters-patent for _____, dated _____, has applied to her Majesty’s Commissioners of Patents [*or* “Attorney” *or* “Solicitor General”] for leave to enter a Disclaimer [*or* “Memorandum of alterations”] of certain parts of the Title or said Invention. Form of advertisement.

In the event of advertisements being required, the Law Officer will fix any time, not sooner than ten days from the first publication of any such advertisement, for resuming the consideration of the matter. Time for resuming the consideration of the matter.

In the absence of *caveats*, or non-appearance of opponents, the usual practice of the Law Officer is to allow the entry of the Disclaimer, which he does by putting Practice if unopposed.

^h 5 & 6 Will. IV. c. 83, s. 1.

ⁱ Ibid.

^j The regulations are similar to those observed by the Judicial Committee in the cases of Prolongation.

his signature to the *fiat*, authorizing its entry by the Clerk of the Commissioners.

The *fiat* is written or engrossed on the same parchment with the Disclaimer or alteration, and is filed with the Specification.

Record of Dis-
claimers, &c.

The Disclaimer is of no effect until entered of record. By Stats. 11 & 12 Vict. c. 94 (Petty Bag, &c., Office, Chancery), and 12 & 13 Vict. c. 109 (Petty Bag, &c., Offices Amendment), Disclaimers and Memoranda of alterations were directed to be enrolled in the Enrolment Office of the Court of Chancery, whether the Specification of the Invention to which such Disclaimer or memorandum of alteration related had or had not been enrolled there. The general changes effected by the Patent Law Amendment Act, 1852,^k affect the practice to the extent of substituting filing in the Office appointed for filing Specifications in Chancery, for the filing and enrolling required by preceding Acts. The filing of a copy of the Disclaimer is a sufficient compliance^l with the provisions of 5 & 6 Will. IV. c. 83, s. 1.

Effect of Dis-
claimer.

The effect of Disclaimer upon the privileges of the Patentee^m was the subject of considerable discussion, more especially with reference to the period from which the validity conferred by it was to date, and the consequent liability of parties who had used the Invention to the penalties of infringement. Letters-patent, it was clear by the wording of the original Act, where amended by Disclaimer, were of equal validity with, and stood on the same footing as, original valid Patents,ⁿ it being enacted by that Statute that "such Disclaimer or Memorandum of alteration, being filed by the said Clerk of the Patents, and enrolled with the Specification, shall be

^k Sect. 39.

^l *Wallington v. Dale* (1852), Ex. 23 L. J. 49; 19 L. T. 187.

^m *Morgan v. Seaward*, paddle-wheels, 7 Lond. Journ. 182; *R. v. Newton* (1845), 26 Lond. Journ. 362.

ⁿ See *Wallington v. Dale*, gelatinous substances, 6 Exch. 285.

deemed and taken to be part of such Letters-patent or such Specification in all Courts whatever."

"It appears to me," said Erle, J., "that where a Disclaimer is entered as to part of a Patent, the amended Patent has all the incidents of a valid Patent from the date of the original grant. It is amended for all purposes subsequent to the Disclaimer." In that case, however, the effect of a Disclaimer of part of a Specification upon rights acquired under a Patent granted to another person, although much discussed, was not decided.

The question was fully argued in *Perry v. Skinner*,^o which occurred soon after the passing of the Act. *Perry v. Skinner.*

"It cannot be doubted," said Lord Abinger, C. B., in the same case, "that the Act of Parliament is obscurely worded, and we are now called upon to put an interpretation upon it. The Act would be unjust if it made a man, who was acting consistently with the Law at a certain time, subsequently a wrongdoer by relation. We never can presume that such was the intention of the Legislature, and we are not at liberty to construe a doubtful Act by any such presumption. The only argument that can be offered is upon the proviso, which says 'that no Disclaimer shall be receivable in any action or suit pending at the time when such Disclaimer was enrolled.' We consider the sound way of interpreting that is, that it shows the Legislature did not intend to make a person a wrongdoer by relation, because it did not presume that any man would have the courage to bring an action after he had actually disclaimed for an infringement of a Patent long before such Disclaimer was thought of. The *intention of the Legislature*, doubtless, was, that he should not have the benefit of the Disclaimer as to infringements gone by long before such Disclaimer was made."

^o (1837) Exch., pens, 2 M. & W. 471; 1 C. B. 167; Web. P. R. 250; *Stocker v. Warner* (1845), pumps, 1 C. B. 148; 26 Lond. Journ. 110; *Clark v. Kenrick* (1843), Ex. glazed iron ware, 12 M. & W. 219.

“The construction contended for by the plaintiff” (that the Disclaimer should be deemed and taken for part of the Letters-patent as originally enrolled) “would lead,” said Mr. Baron Parke, “to the manifest injustice of a party who might have put himself to great expense in the making of machines or engines, the subject of the grant of the Patent, on the faith of that Patent being void, being made a wrongdoer by relation. That is an effect the Law will not give to any Act of Parliament unless the words are manifest and plain.”

Important principles are involved in what followed.

“The rule by which we are guided in construing Acts of Parliament is to look at the precise words, and to construe them in their ordinary sense, *unless it would lead to any absurdity or manifest injustice*; and if it should, *so to vary and modify them* as to avoid that which it *could certainly not have been the intention* of the Legislature should be done. We must engraft, therefore, a modification upon the words of the Act in this case for the purposes of its construction, and read it as though it had been ‘shall be deemed and taken as part of the said Letters-patent, &c. from thenceforth,’ so as not to make the defendant a wrongdoer.”

The Patent Law Amendment Act,^p however, with reference to this point expressly declares, “that no action shall be brought upon amended Letters-patent for infringements prior to the amendment, unless the Law Officer shall certify in his *fiat* that such action may be brought notwithstanding the entry or filing of the Disclaimer or Memorandum of alteration.”

Whether or not the entry of a Disclaimer is to be taken in presumption of Law as admission of the invalidity of the Patent previously to such entry is a matter which has elicited a great difference in the opinions of the Bench: “I can never consider,” says Chief Justice

Entry of Disclaimer no admission of invalidity of Patent.

^p 15 & 16 Vict. c. 83, s. 39.

Tindal,^q “that the entering of a Disclaimer, as to part of a Patent, *necessarily* imports that the Patent is bad; the object of the proceeding being, not merely to set right the description of the alleged invention where it is known to be wrong, but to obviate any doubts that may arise on the Specification as enrolled.” “I think,” says Sir J. Romilly, M. R.^r “on the other hand, that a Patentee who disclaims must take the consequence of *having it assumed*, in the absence of evidence, that the Patent was invalid previous to the Disclaimer.”

A Disclaimer is admissible in evidence in an action of *scire facias* for repeal, and the prosecutor is bound to read it as part of the Specification, even although the Disclaimer was enrolled after issue joined, and the parts disclaimed were objected to in the notice of particulars delivered with the Declaration.^s The entry of the Disclaimer need not be replied to a pleading alleging want of novelty or utility on the part of the invention.

Admissible in evidence in *scire facias*.

The judgment of Maule, J., in *R. v. Mill*,^t contains a very clear exposition of his reasons for this view. “A *scire facias*,” he says, “is a proceeding in which a person takes upon himself the part of a public prosecutor for the purpose of questioning the validity of a Patent. It is admitted that there may be a Patent for a meritorious invention which may be affected by some legal infirmity, arising from the strictness of the Patent Laws; and it was to meet such a case, and to enable Patentees to avoid the consequences of this strictness, that the Statute was passed. When, therefore, a person comes forward on behalf of the public and brings a *scire facias*, if the Patent

R. v. Mill.

^q (1845) *Stocker v. Warner*, pumps, 1 C. B. 166; 14 L. J., N. S., 10, C. B.

^r (1851) *Reg. v. Mill*, 14 Beav. 315.

^s *Reg. v. Mill* (1850), C. B., instruments for marking, 20 L. J. 16; 16 L. T. 2141; 10 C. B. 379; 1 L. M. & P. 695; *Wallington v. Dale* (1851), gelatinous substances, 6 Exch. 284.

^t (1850) C. B., instruments for marking, 1 L. M. & P. 705.

be for some useful invention"^u (such as this is admitted to be), but which has some vice, such as that imputed here—viz., that although some things are new and useful, yet inasmuch as the Patentee has made a mistake in claiming some things which have been discovered before, it seems to me that such a case is meritorious within the Act, and that such a person is a fit person to be protected; and it is to be observed that, except for the practice of requiring a bond to be given by the defendant, the prosecutor would, as soon as the Disclaimer or any alteration which has healed the vice of the Patent, is enrolled, would have all he asks. *He does not pretend to say that the Patent is null and void to all intents and purposes, and ought not, and cannot, be amended.*^x He must take the Patent as he finds it, and the Patent is subject to this Law, that as soon as the Disclaimer is enrolled, everything which the prosecutor ought to wish for^y on behalf of the public has been done. So that when the only fault is healed, the Patent, instead of being a bad Patent, which is a bad thing, is a good Patent, *which is a good thing.* Therefore as his object is only *to get a bad Patent cancelled*, he has got all he wishes for (?)—for he has the Patentee *confitentem reum.*" The proper course^z for the prosecutor in that case is, it appears, to give notice that he will discontinue, and that he will oppose any application to put the bond in suit.

^u The Specification in this case claimed nearly a dozen, comprising pens, pencils, seals and inkstands.

^x It would appear from this that an averment to this effect should be inserted in the Declaration.

^y The Specification having published the invention, the public interest is clearly in the suppression of the monopoly, and the object of the public prosecutor should be, as stated by the learned judge, "to get a bad Patent cancelled."

^z Per Williams, J., same case.

CHAPTER VII.

CONFIRMATION AND EXTENSION OF PATENTS.

THE powers conferred upon the Judicial Committee of the Privy Council with respect to the Confirmation and Extension of Letters-patent are well adapted to encourage inventors, by excepting them, in the case of ingenious and deserving inventions, from the operation of general rules, which would deprive them of reaping an adequate reward for their exertions.

Confirmation and Extension by Judicial Committee.

In the case of Confirmation they have been very sparingly resorted to, a circumstance to be regretted, from the evident intention of the devisers of those powers to substitute the mode of operation there prescribed for the present system of Amendment and Disclaimer.^a Forgotten discoveries, which have never led to any practical result, are, as we have seen, in strictness fatal to the claims of the Patentee. To relieve him in some degree from the hardships resulting from this rule provision is made by Stat. 5 & 6 Will. IV. c. 83, s. 2, for the case in which the Patentee is proved not to be the real inventor, though he believed himself to be so. It enacts, that "if in any suit or action it shall be proved or specially found 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

Powers of Confirmation little exercised.

Where Patentee believes himself to be the inventor.

^a See remarks on *Westrupp and Gibbins' Patent* (1836), distilling apparatus, P. C., Web. P. R. 551.

person had, unknown to such Patentee, invented or used the same or some part thereof before the date of such Letters-patent, it shall and may be lawful for such Patentee or his assigns to petition Her Majesty in Council to confirm the said Letters-patent or to grant new Letters-patent." The grounds on which the Committee may report in favour of the Petition are, if it shall be satisfied that such Patentee *believed himself to be* the first and original inventor, and that such invention had not been publicly or generally used before the date of such first Letters-patent. The Crown may then, if it see fit, accede to such Petition.

An alternative of two grounds, it is to be observed, is proposed on which to found the Petition. It must either have been found "not new" by a Court of Law, or the Patentee must "discover" that some other person, unknown to such Patentee, "has invented or used the same." The effect of the Act would seem to be to remove prior user from the list of elements that may dissolve the Patent, and to render *pro hâc vice* matters already known good subject matter for Patents. The provisions of the Act seem,^b however, only intended to apply to cases in which it shall appear that the Patentee, at the time he obtained his Patent, was ignorant of his title being defective. He must show that he believed himself to be the first and original inventor,^c by evidence of the course of experiments by which he arrived at the knowledge of the invention.

The recommendation is entirely discretionary with the Privy Council. It is exercised only in extreme cases, and then in such a manner as not to prejudice existing rights. The principle, however, on which the whole proceeding is founded appears a very questionable one. To admit the amount of knowledge in the Patentee to enter into the question, and adopt his ignorance as the

Confirmation
not to preju-
dice existing
rights.

Erroneous in
principle.

^b (1846) Hindm. 201.

^c *Re Card's Patent* (1848, P. C.), candlewicks, 6 Moo. 207.

standard of validity, is opposed to the essential principle of Patents, and creates an unnecessary deviation from general rules. The invention may be a very proper subject for the exercise of dispensing powers; but the amount of ignorance on the part of the Patentee surely ought not to be appealed to as a title to advance his position.

The Act continues, "and the said Letters-patent shall be available in Law and Equity to give to such Petitioner the sole right of using and making such invention, as against all persons whatsoever, any law, usage or custom to the contrary notwithstanding." The wording of the clause introduces some obscurity as to the course of practice intended by the Act with reference to the instrument itself, and the nature of the rights created by its operation. "The said Letters-patent" may mean either the original Letters-patent confirmed, notwithstanding the vitiating matter, or new ones, reducing the pretensions of the Patentee within legitimate bounds.

Effect of Confirmation.

The proceedings before the Judicial Committee are regulated by Rules dated Council Office, Whitehall, 18 Nov. 1835. By Rule I., the party intending to apply for the Confirmation of Letters-patent is required to give "public notice by advertising in the London Gazette three times, and in three London papers, and three times in some country paper published in the town where or near to which he carries on any manufacture of anything made according to his Specification, or near to or in which he resides in case he carries on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to petition" Her Majesty under the said section. The advertisement must state the object of such Petition, and give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his Petition (which day shall not be less than four weeks from the date of the publication of the last of the advertise-

Proceedings to obtain Confirmation.

Advertisement.

Object of Petition.

Notice of opposition.

ments to be inserted in the London Gazette); and that on or before such day notice must be given of any opposition intended to be made to the Petition. Any person intending to oppose the said application must lodge notice to that effect at the Council Office, on or before such day so named in the said advertisements, and, having lodged such notice, will be entitled to have from the Petitioner four weeks' notice of the time appointed for the hearing^e.

Petitions^f must be presented within one week from the insertion of the last of the advertisements required to be published in the London Gazette. All Petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of section 4 of the said Act, and the first and second of these Rules, and the matters in such affidavits may be disputed by the parties opposing, upon the hearing of the Petitions.^g

Notice to parties to suits or actions.

All parties^h to any former suit or action touching the Letters-patent, and all persons giving notice of opposition, are entitled to be served with a copy of the Petition, and no application to fix a time for hearing shall be made without affidavit of such service.

Opposition.

Parties served with Petitions are to lodge at the Council Office, on or before the days named in the advertisements, notice of intention to oppose; and within a fortnight of such service, noticeⁱ of the grounds of their objections to the granting of the prayer of such Petition. Such parties may be heard in opposition before the Privy Council. The Crown may object *ore tenus* at the hearing.^k

^e (1836) 3 Knapp. App. I. II. III.; Rules dated 18 Nov. 1835.

^f Rule III.

^g Rule IV.

^h Rule V. It seems doubtful whether licencees are entitled to notice; *Re Heurteloup's Patent* (1836), fire-arms, Web. P. R. 553.

ⁱ Rule VI.

^k *Re Card's Patent* (1848), candlewicks, 6 Moo. 207.

A Petition¹ presented shortly after the passing of the Act seems to have proceeded on an erroneous apprehension of the circumstances affecting the validity of the Letters-patent. It stated, that since the date of the Letters-patent (1834) the petitioner had discovered that a Patent had been granted *in France*, in 1821, for the same invention, but that the Specification of the French Patent was not to be found, except in a French work containing an account of expired Patents. No legal proceedings had been instituted by the Patentee. The Judicial Committee directed notice of the day of hearing to be furnished to the French Patentee, and on an affidavit that such notice had been sent through the Post Office, addressed "L. de Valdahon, Paris," recommended the Letters-patent to be confirmed.

*Heurteloup's
Patent.*

In the case of *Westrupp and Gibbins' Patent*,^m the application was by the assignee. The Letters-patent were dated 24th May, 1831, and assigned by the Patentees separately in 1833 and 1834. The Petition was accompanied by the affidavit of the surviving Patentee, stating his belief that they were the true and first inventors. In opposition it was contended that the invention was old, and that the proper course was by disclaimer of such parts of it as were incontestably known. The question of the invention being generally known was the point mainly in dispute. It was contended for the Petitioner that there was no later account of it than a letter from a learned French gentleman in the *Philosophical Transactions* of 1670, "concerning the way of making sea water sweet." On the other hand, copies of two Specifications dated 1806 and 1809 were produced, describing precisely, as was alleged, the subject matter of the Patent sought to be confirmed. The Petition was dismissed with costs, the following remarks being made by

*Westrupp and
Gibbins' Patent.*

¹ *Re Heurteloup's Patent* (1836), fire-arms, Web. P. R. 553.

^m (1836) Apparatus for making fresh water from salt, Web. P. R. 554.

Lord Lyndhurst, L. C., with respect to the costs :—“ If a party entitled to oppose does come and oppose, and opposes successfully, if we do not give costs we shall discourage persons coming to protect the interests of the public. We have the power to give costs in any matter referred to us : and sitting here as a Judicial Committee, we can give costs under the general Act, not under the Patent Act.”

Stead v. Carey.

A somewhat curious state of circumstances was produced by the direct interference of the Legislature,ⁿ confirming a Patent which had become void from non-enrolment of the Specification as required by the Letters-patent. Letters-patent, dated 19th May, 1838, containing a proviso for enrolment of the Specification within four months from their date, had been granted for the invention of wood-paving to S., who from inadvertence and misinformation omitted to enrol until 19th November, 1838, thereby avoiding his Patent. On the 29th January, 1839, Letters-patent for an improved pavement were granted to C., who duly enrolled his Specification.^o The Act recited the grant of the Letters-patent confirming the Patent of S., the enrolment of the Specification within *six* months from the date of the Patent, and the proviso for avoiding it if it should become vested in or in trust for more than twelve persons; and, after further reciting that certain persons had agreed to form a company to work the Patent, sanctioned the formation of the Company, and enabled the Patentee to assign the Patent to them, or license them to work it. A subsequent section, reciting the non-enrolment of the Specification within due time, from inadvertence and misinformation, and that it was expedient that the Patent should be rendered valid to the extent thereafter mentioned, enacted that the Letters-Patent should during the remainder of the term be considered, deemed and taken to be as valid and

ⁿ 4 & 5 Vict. c. 91, s. 31 (Local and Personal).

^o *Stead v. Carey* (1845), 1 C. B. 496.

effectual as if the Specification had been enrolled within four months. *Held*, that the Confirmation of the Patent was unconditional, and was not dependent on the formation of a company, and that the defendant was precluded from using the plaintiff's Patent.

An unsuccessful application for Confirmation of Letters-patent for Scotland was made by the assignee in the case^p of *Robinson's Patent*. The Petitioner had discovered, since the grant of the Letters-patent, that the invention had been used in England prior to their date,^q and was advised that, in consequence of the decision in *Brown v. Annandale*,^r such user would invalidate his Patent for the purpose of taking legal proceedings in Scotland. The assistance of the Committee was refused on the ground that "the Act of Parliament was meant to meet a totally different case."^s

*Robinson's
Patent.*

Upon an application for a Confirmation of *Card's Patent*,^t it was proved that the Patent article was not publicly and generally known prior to the Letters-patent, but that some persons *had systematically used an article identical with the Patent article for several years prior to the grant* of the Letters-patent, and that the subject of the Patent was little more than the application of a well-known article of trade. Under such circumstances, their Lordships refused to recommend the Confirmation of the Letters-patent. Caveats had been entered against this Petition, but, owing to the objections not having been lodged in time, were not prosecuted.

*Card's Patent
refused for
want of
novelty.*

In delivering the judgment of the Committee in that case, Lord Campbell said: "By the law as it stood prior

^p (1845) nipping lever, 5 Moo. 65.

^q 22 March, 1833.

^r (1842) paper, 8 Cl. & Fin. 437; Web. P. R. 433; and see *Roe-buck v. Stirling* (1774), oil of vitriol, 5 Browne's Supp. Morrison, 522, and cited 8 Cl. & Fin. 447, n.

^s Per Lord Campbell.

^t (1848, P. C.), candle-wicks, 6 Moo. 207; 12 Jur. 507.

to the Stat. 5 & 6 Will. IV. c. 83, it was necessary to the validity of the Patent that the invention should be new as well as that it should be useful; and if it could be proved that the invention had been practised publicly by any person before the Letters-patent were granted, the Patent was invalid. That Law led to hardships in many cases, because it often happened that after experiments had been tried and a certain progress made in the invention, and the experiments proving abortive, they were subsequently abandoned, some other ingenious man *de novo* took up the invention and completed the process, by which a great benefit was conferred upon the community, whereupon he obtained a Patent for his invention; but as soon as he began to reap the fruit of his invention his Patent was infringed; and when he brought an action for such infringement, the former abortive experiments were brought up to prove that the invention was not new. Some doubt existed in Westminster Hall whether, if the experiment, although it had been to a certain degree successful, had been abandoned, it would vitiate the after-acquired Patent: but to remove all doubt upon the subject this enactment was resorted to by the Legislature (5 & 6 Will. IV. c. 83), that, although there may have been a general knowledge of the invention, if it was not actually carried out and had been abandoned, that such knowledge should not vitiate the Patent which perfected and *rendered beneficial* the original discovery. The language used by the Legislature is this, that the Committee, 'upon examining the 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;’ probably with the words intended to be understood, notwithstanding any prior use of the said invention. It seems to us, that in this case the Petitioner has not afforded sufficient evidence from which we can reasonably infer that he was the first inventor.”

The invention had become partially known and adopted by persons not licencees. The injustice to such, of confirming the Letters-patent, was strongly dwelt upon. “Their Lordships are of opinion,” said the noble Lord, “that this is not a case which the Legislature had in contemplation when this enactment was passed; that it had in view the case where there had been an invention which had actually been practised, but which had not been continued to be practised; so that, under the circumstances, the Patent should not be rendered invalid by the attempts to use it in the first instance having been abortive, and where the Letters-patent, under those circumstances, are confirmed, no injury can be done to any one. The inventor who has obtained his Letters-patent and made his invention public for the benefit of the community has his fair reward for his ingenuity and his industry and the capital which he has employed, and no one suffers by justice being done to him. Therefore, in a case where it appears that an invention has been carried on to a certain degree and abandoned, the Act of Parliament may most beneficially be acted upon. But their Lordships are of opinion, that a case of this sort, where the invention was used before the Patent was considered beneficial by those who carried it out, and was proved to be beneficial by the persons so using it, never having been abandoned, but used by them down to the time at which this application is made, is a case to which the Act was never intended to apply.”

User discontinued at date of Patent.

Confirmation a reward for ingenuity, industry and capital.

Abandoned inventions.

^u *In re Card's Patent* (1848, P. C.), candle-wicks, 6 Moo. 214.

Extention of the term of Patent privileges.

Special Acts.

Stat. 5 & 6 Will. IV. c. 83, s. 4.

Advertisement of intention to apply.

Caveat.

Hearing.

An equally important function of the Judicial Committee with that of confirming Letters-patent, and one more frequently resorted to, is that of deciding on the extension of the term of Patent privileges. The term of fourteen years, prescribed by the Statute of James as the limit of their duration, is, as has been above remarked, in many cases inadequate for the remuneration of the Patentee. Till very recently, however, nothing short of a resort to the Legislature^v could extend that term. Frequent applications for such assistance suggested the advisability of framing some general measure to confer the requisite relief, and resulted eventually in the enactment of Stat. 5 & 6 Will. IV. c. 83; by section 4 of which it was declared, "that if any person, who now hath or shall hereafter obtain any Letters-patent as aforesaid," shall advertise in the 'London Gazette' three times and in three London papers, and three times in some country paper published in the town where or near to which he carried on any manufacture of anything made according to his Specification, or near to or in which he resides in case he carried on no such manufacture, or published in the county where he carries on such manufacture or where he lives, in case there shall not be any paper published in such town, that he intends to apply to His Majesty in Council for a Prolongation of his term of sole using and vending his invention, and shall petition His Majesty in Council, 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

^v See the instances cited Web. P. R. 38.

^w "As grantee, assignee or otherwise." Stat. 5 & 6 Will. IV. s. 1.

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 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.”

Report.
Seven years
additional
term.

A further term of seven years was added by a subsequent Act,^x which declared, that “it was expedient for the further encouragement of inventions in the useful arts to enable the time of monopoly in Patents to be extended in cases in which it can be satisfactorily shown that the expense of the invention hath been greater than the time now limited by Law will suffice to reimburse; and enacted, that if any person, having obtained a Patent^y for any invention, shall before the expiration thereof present a Petition to Her Majesty in Council, setting forth that he has been unable to obtain a due remuneration for his expense and labour in perfecting such invention, and that an exclusive right of using and vending the same for the further period of seven years, in addition to the term in such Patent mentioned, will not suffice for his reimbursement and remuneration,^z then, if the matter of such petition shall be by Her Majesty referred to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same after the manner and in the usual course of its proceedings touching Pa-

Increased to
fourteen years.

^x 7 & 8 Vict. c. 69, s. 2.

^y The term, it is to be observed, is used interchangeably with that of “Letters-patent.”

^z See Mitchell’s Patent for screw pile for erecting lighthouses, &c., on sands (1847), 30 Lon. Journ. 357.

tents; and if the said Committee shall be of opinion, and shall so report to Her Majesty, that a further period, greater than seven years, ought to be granted to the Petitioner, it shall be lawful for Her Majesty, if she shall so think fit, to grant an extension thereof for any time not exceeding fourteen years, in like manner and subject to the same rules as the extension for a term not exceeding seven years is now granted under the powers of the said Act of the sixth year of the reign of His late Majesty: provided always, that nothing herein contained shall prevent the said Judicial Committee from reporting that an extension for any period not exceeding seven years should be granted, or prevent Her Majesty from granting an extension for such lesser term than the Petition shall have prayed.”

Her Majesty may grant a lesser term than that prayed.

Powers of the Judicial Committee under 3 & 4 Will. IV. c. 41, s. 4.

Present jurisdiction.

The Judicial Committee has power under the Privy Council Act, 3 & 4 Will. IV. c. 41, s. 4, to entertain questions relative to the granting an extension of time in Letters-patent. The present jurisdiction of that body is exercised under Stat. 6 & 7 Vict. c. 38 (1843), by the first section of which it is enacted, “that in any appeal, application for Prolongation or Confirmation of Letters-patent, or other matter referred or hereafter to be referred by Her Majesty in Council to the Judicial Committee of the Privy Council, it shall be lawful for Her Majesty, by Order in Council or special direction under Her Royal Sign Manual, having regard to the nature of the said appeal or other matter, and in respect of the same not requiring the presence of more than three^a members of the said Committee, to order that the same be heard; and when so ordered, it shall be lawful that the same shall be accordingly heard by not less than three of the members of the said Judicial Committee, subject to such other rules as are applicable, or under this Act may be applicable, to the hearing and making

^a *In re Bodmer's Patent* (1849), P. C., cotton carding, 6 Moo. 468.

Reports on Appeals and other matters by four or more of the members of the said Judicial Committee.”

By the 15th section of the same Act, the Committee is empowered to make, repeal and alter the Rules, Orders and Regulations in respect of the matters referred to them, provided always that such shall be of no force or effect until the same shall have been approved by Her Majesty in Council.

Committee may
make Rules.

As an experiment, the jurisdiction of the Privy Council in the extension of Patents has proved extremely satisfactory. By resolutely disregarding technical rules^b established in other branches of the Law, and directing their attention rather to the adjustment and satisfaction of the claims (frequently complex in the extreme) of each particular case, the Court possesses beyond a doubt facilities of administering justice peculiar to itself and superior in some respects to those of any other branch of the executive.^c The careful scrutiny instituted into the merits of the invention, and the regard paid at once to the interests of the public and of individuals, present its jurisdiction on the whole in such satisfactory contrast to that occupied by the greater portion of Patent Law, as to suggest the propriety of extending its action to the limits proposed by the noble lord who originated it, by abolishing the present practice of disclaiming and substituting Confirmation of amended Letters-patent as originally proposed.

Jurisdiction of
the Privy
Council.

By the Statute^d originating the extension of Patents, the parties empowered to become Petitioners were stated to be “any person who now hath, or shall hereafter obtain, any Letters-patent, as grantee, assignee or otherwise.” To remove the doubts entertained as to the proper interpretation of this phrase,^e the Statute

The Petitioner.

^b *Lowe's Patent* (1846), naphthalized gas, 10 Jur. 363.

^c *Re Noble's Patent* (1850), wool-carding, 7 Moo. 191.

^d 5 & 6 Will. IV. c. 83, s. 4 (1835).

^e *Re Southworth's Patent* (1837), P. C., Web. P. R. 487.

7 & 8 Vict. c. 69, s. 2, was passed, declaring that Her Majesty might, in certain specified cases, extend the term on the Petition of either an assignee or assignees, or the original Patentee or Patentees, or of an assignee or assignees and original Patentee or Patentees conjointly. By sect. 5, the Patentee and assignee,^f or several such parties, may be joint petitioners.

By section 7, new Letters-patent, granted before the passing of the Act to assignees, are declared as valid as if granted subsequent to the passing of the Act; "provided always, that nothing herein contained shall give any validity or effect to any Letters-patent heretofore granted to any assignee or assignees, where any action or proceeding in *scire facias* or suit in equity shall have been commenced at any time before the passing of this Act, wherein the validity of such Letters-patent shall have been or may be questioned."

Who may petition.

Letters-patent have, since the institution of extensions, been renewed in favour of Patentees and assignees indifferently; it being the practice of the Committee to impose terms on the holders of the renewed Letters, where such a mode of proceeding seems required by the justice of the case. It has, however, been decided that the person who has the legal estate in the Letters-patent has the prior right to petition.^g The Privy Council does not otherwise recognize any distinction between legal and equitable titles, and there seems no reason why an equitable assignee should not be the sole Petitioner.^h To entitle an equitable assignee to appear with the legal assignee, his name must be included in the advertisements required by the act.

Noble's Patent.

The Petitioners for the extension of *Noble's Patent*^h

^f Turner on Patents, 49.

^g *In re Pettit Smith's Patent* (1850), screw-propeller, 7 Moo. 133; *Re Wright's Patent* (15th May, 1824), pins, Exch. 1837, Web. P. R. 562.

^h *Re Noble's Patent* (1850), wool-carding, P. C.; 15 L. T. 1; 7 Moo. 191.

were R., D. and L. The Patentee had, shortly after the grant, assigned to R. and D., and in 1842 an agreement was entered into by them to assign to L., but no legal assignment was executed. The advertisements of the notice of the Petition, and the intended application for a day to be fixed, contained only the names of R. and D. In *Bodmer's Patent*ⁱ the Petitioner was the executor of the surviving assignee of the Patentee. The Petitioners for the extension of *Berry's Patent*^k were the capitalists who had obtained the introduction of the invention, and worked the Patent at a loss of nearly 10,000*l.*, their outlay having exceeded 17,000*l.* The invention was well known in France, and was of considerable commercial value. Their lordships recommended its extension for six years.

The Judicial Committee will not consider a company ineligible for the renewal of a Patent grant. In the case of *Cook and Wheatstone's Patent*,^l the extension was refused on the ground only of the Patentees having been sufficiently remunerated, Lord Langdale remarking, that "if the company's speculation had been clearly made out to be a losing concern, it would perhaps have been matter for consideration whether there was not good ground for renewal." In the case of *Pettit Smith's Patent*,^m the Petition was presented by the Patentee, and the trustees and secretary of the Ship Propeller Company. The renewed Letters-patent were granted to two of the petitioning trustees.

Company may obtain extension of a Patent.

The importer of an invention is entitled to apply for an extension of the term, but the Judicial Committee will look with jealousy into the merits of the Invention

ⁱ (1849), cotton-carding, 6 Moo. 468.

^k *In re Berry's Patent* (1850), wheat-cleansing machine, 7 Moo. 187.

^l (Feb. 10, 1851), electric telegraph, 38 Lond. Journ. 223.

^m (1850), improved propeller for steam and other vessels, 7 Moo. 133.

imported. In a recent case,ⁿ the application by the trustees of a joint stock company, as assignees, was refused, the invention (asphalte) having been in common use in France, and no great risk or expenditure incurred by the Patentee or his assignees in introducing it into public use. An objection was there taken by Jervis, C. J., on the ground of the number of the persons who would be beneficially interested in the renewal.

Contents of the
Petition.

The Petition should state the position and title of the Petitioners, the novelty and the utility of the invention, the purposes to which it may be applied, the circumstances which have prevented the inventor from carrying his invention into full effect, the expenditure of large capital in its completion, and the absence of remuneration to the Patentee or the Petitioners.

Advertise-
ments.

The party intending to petition is required to give notice in the advertisements before mentioned of the day on which he intends to apply for a time^o to be fixed for the hearing of his Petition, which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the London Gazette, and that *caveats* must be entered on or before such day. Special notice seems to be required in the case of those particularly interested.^p

Notice to parties interested
in the opposi-
tion.

The object being simply to give those interested in the extension an opportunity of opposing, the Privy Council have very reasonably held that, in the event of the applicant (the Patentee) being resident abroad, and not himself carrying on the manufacture of his invention, adver-

ⁿ *In re Claridge's Patent* (1851), P. C., 7 Moo. 395. See also *Russell's Patent*, 2 Moo. 496; *Hardy's Patent* (1849), railway axles, 6 Moo. 441; *Bodmer's Patent*, *ibid.* 468.

^o The notice of the intention to apply for an extension, and of the day on which application will be made to fix the hearing of the petition, are now included in one advertisement. (Web. P. R. 559, n.)

^p *Re Southworth's Patent* (1837), calico, &c. drying machinery, Web. P. R. 486, extended for five years.

tisements in the neighbourhood of the licencees was a sufficient compliance with the requisition of the Act.⁹ The Attorney-General on these occasions represents the government and the public generally.^r On an application, at the hearing, by the Lords of the Admiralty for leave to enter a *caveat*, on the ground that they wished a condition of great importance to the public to be inserted in the grant, the Judicial Committee refused to comply with that request, or to postpone the hearing.^s

In the case of *Mackintosh's Patent*,^t the Petition was lodged 16th January, 1836, and on the usual application being shortly afterwards made for an early day to be fixed for the hearing, their Lordships intimated that as the English Patent did not expire until 17th June, 1837, the profits accruing in the meantime might materially affect the question of extension, and ordered the application to stand over for the present. In February, 1837, the application was renewed, the hearing was fixed for the 22nd April, but was before that date abandoned by the Petitioner. A question arose on the renewal of the application in 1837 as to the sufficiency of the notices given to the parties opposing the extension. Their Lordships declined giving any opinion, but intimated that the best plan would be to fix as late a day as convenient for the hearing, when the Petitioner should act as he should be advised as to proceeding on the old notices or issuing fresh. An application by the opposing party for the costs occasioned by the opposition on an affidavit of fact was granted.

Notice—advertisement.

⁹ *Derosne's Patent* (1844), sugar, 4 Moo. 416; *Whytock's Patent* (1846), figured carpets, 28 Lond. Journ. 449.

^r *In re Pettit Smith's Patent* (1850), screw-propeller, 7 Moo. 133; *In Re Wright's Patent* (1838), bleaching, 13 Lond. Journ. 371.

^s *In re Pettit Smith's Patent* (1850), screw-propeller, 7 Moo. 133.

^t (1837), waterproof substances, granted 17th June, 1823, Web. P. R. 738.

Practice—
presentation.

The petition must be presented at the Council Office, Whitehall, within one week from the insertion of the last of the advertisements,^u and must be accompanied with affidavits of advertisements having been inserted; the matters in the affidavits being open to be disputed at the hearing by the parties opposing.^v By a late rule,^w the applicant is required, not less than one week before the day fixed for hearing the application, to lodge at the Council Office four printed or written^x copies of his Specification, for the use of the Judicial Committee.

Opposition to
the application.

The opposition to an extension of Letters-patent is open to any person interested.^y Parties intending to oppose must enter a *caveat* at the Council Office on or before the day indicated in the advertisements for that purpose, and having entered such *caveat*, will be entitled^z to have from the Petitioner four weeks' notice of the time appointed for the hearing. All persons entering such *caveats* will be entitled^a to be served with copies of the Petition, and no application to fix a time for hearing will be made without affidavit of such service. Parties served with Petitions must,^b within a fortnight after such service, lodge at the Council notice of the grounds of their objections to the granting of the prayers of such Petitions. Parties may have copies^c of all papers lodged in respect of any application under Stat. 5 & 6 Will. IV. c. 83, at their own expense.

^u Rule III., 18th November, 1835, Council Office, Whitehall.

^v Rule IV., 18th November, 1835.

^w Dated Council Office, Whitehall, December 21st, 1835.

^x All Specifications and Drawings being published by the Commissioners under the new system, the remaining part of this Rule is superseded.

^y *In re Gibson's Patent, re Shlumberger's Patent* (1853), 1 Eq. R. 1; *Ex parte O'Reilly* (1790), L. C., 1 Ves. jun. 112.

^z Rule II., Council Office, Whitehall, 18th November, 1835.

^a Rule V., *ibid.*

^b Rule VI., *ibid.*

^c Rule VII., *ibid.*

The period at which the steps should be taken for obtaining extension is a point to be attended to. In the case of *Mackintosh's Patent*^d before alluded to, an application by the Patentee eighteen months before the expiration of his Patent was ordered to stand over as premature, while, in the case of *Faulkner's Patent*,^e the refusal to appoint a day for hearing the Petition was accompanied with remarks upon the lateness of the application (within two months from the expiration of the Patent).

Period of application for extension.

The proviso of the original Act stipulated,^f that the application by Petition should be "made and prosecuted with effect" before the expiration of the term originally granted. The interpretation affixed to these words in the case of *Bodmer's Patent*,^g where the delay arose from causes wholly beyond the Petitioner's control (the want of a *quorum* in the Judicial Committee), resulted in such hardships to the Patentee that an Act^h was passed repealing the provision in that respect,ⁱ and enacting, 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 hear-

"Made and prosecuted with effect."

^d (1836) 17 June, 1823, waterproof substances, Web. P. R. 739.

^e (1849) 35 Lon. Journ. 64, per Lord Brougham.

^f 5 & 6 Will. IV. c. 83, s. 4.

^g (1838) spinning machinery, Web. P. R. 740.

^h Stat. 2 & 3 Vict. c. 67, s. 2.

ⁱ Stat. 5 & 6 Will. IV. c. 83, s. 4.

ing 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 inventions¹ specified in such original Letters-patent, for a term not exceeding seven years after the expiration of the term mentioned in the original Letters-patent: provided always, that no such extension or new Letters-patent shall be granted if a petition for the same shall not have been presented, as by the said recited Act directed, before the expiration of the term sought to be extended, nor, in case of petitions presented after the 30th day of November, 1839, unless such petition shall be presented six calendar months at the least before the expiration of such term, nor in any case unless sufficient reason shall be shown, to the satisfaction of the said Judicial Committee, for the omission to prosecute with effect the said application by Petition before the expiration of the said term."

Extension not a matter of course.

Great pains were taken by the Judicial Committee, at the earlier stage of their jurisdiction, to impress upon Patentees that the prolongation of Patents was to be regarded as anything but a matter of course,^m and that the cases in which an extension of the term would be made must be exceptional. A strong case, either as regards merit or success in the Patentee, or importance to the welfare, safety or convenience of the public in the invention, must in general be made out. A combination of these qualities, and loss from the manufacture of the invention, are the points usually pressed by the applicant.ⁿ The uniform practice of the Court has been to

¹ See 2nd Set of Rules under 15 & 16 Vict. c. 83.

^m See *Re Pettit Smith's Patent* (1850), screw-propeller, 7 Moo. 133.

ⁿ *Re Erard's Patent* (1835), pianoforte, Web. P. R. 559. The Letters-patent, extended for seven years, were as follows:—For Eng-

require the party applying, first, to show some invention ; secondly, that the invention is of a nature to benefit the public ; and, thirdly, that the inventor has not received an adequate reward.^o The points considered by the Court on these occasions were thus stated by Lord Langdale, M. R., in the case of an application^p opposed by the assignees of a rival Patent :—“ First, the merits of the invention ; secondly, the utility of the machinery which has been invented ; and, lastly, whether the Patentee has received a sufficient remuneration for the merit which he has displayed.

Principles on which the Judicial Committee act.

The validity of Letters-patent being in dispute at the period of the application, the Judicial Committee will not enter upon that question, but in the absence of their repeal will assume them to be valid.^q In the case of *Kay's Patent*^r an extension was granted on the merits of the invention, pending a suit^s putting the validity of the Letters-patent in question ; Lord Brougham observing, “ that if the Judicial Committee had seen that the Patent was manifestly and grossly illegal, they would not advise Her Majesty to grant an extension of it, though such extension would not benefit the party obtaining it, if the Patent in the first instance was invalid ; but that if they postponed giving their decision until the results of the suits then pending were

Validity not determined on extension.

land, 22nd December, 1821 ; for Scotland, 6th April, 1822 ; and for Ireland, 14th December, 1822. Their Lordships refused to extend a second Patent granted to the same party in 1825.

^o Per Lord Brougham, *Derosne's Patent*, sugar (1844), 4 Moo. 416.

^p *In re Pinkus's Patent* (1848), atmospheric railway, 12 Jur. 233.

^q *Heath's Patent*, (1853), P. C., steel, M. M. 131.

^r *In re Kay's Patent* (1839), flax-spinning machine, 3 Moo. 24 ; Web. P. R. 572 ; *Pinkus's Patent*, atmospheric railway, 12 Jur. 233.

^s *Kay v. Marshall* (1836), L. C., 1 M. & Cr. 373 ; (1838) C. B., 5 Bing. N. C. 492 ; (1839) M. R., 1 Beav. 535.

Where validity
of the Patent is
doubtful.

known, the Patent would in the meantime expire ;¹ and being of opinion that upon the merits shown the Patentee ought to have some extension, their Lordships would advise such for a period of three years." The Patent was ultimately² declared invalid on the ground of want of novelty. "On an occasion of this kind," said Lord Langdale, M. R., in a case³ in which extension was refused, "the Court has, in no very direct way, to consider whether the Patent is or is not valid at Law. Unless clearly invalid, so that it would be altogether nugatory to prolong the Patent, the Court has been rather inclined to assume that the Patent may be good, and so leave the question to any legal considerations that may arise between the parties who are interested in it."

*Woodcroft's
Patent.*

This view of the Court is coincident with that expressed by Lord Brougham in the case of *Woodcroft's Patent* :⁴—"In all cases where there is a disputed right as to the Patent, and where the validity of the Patent may come into question, there are two things to be considered ; the first is, whether the case to prove the invalidity of the Patent is so clear as to remove all ordinary doubt ; the second, whether the case is so doubtful that the Court would rather retire from its consideration than decide it. In the former case they would not grant the extension, because they did not see the merits and because they would not put the opposing parties to the vexatious process of bringing their *scire facias* in the Law Courts. But where the matter is doubtful, where conflicting evidence and questions of

¹ See *Bodmer's Patent* (1838), cotton carding, 2 Moo. 471, and 2 & 3 Vict. c. 67.

² (1841) House of Lords, 8 Cl. & Fin. 245.

³ (1848), *Pinkus's Patent*, atmospheric railway, 12 Jur. 233; 28 Lond. Journ. 448.

⁴ (1846), screw-propeller, 28 Lon. Journ. 203.

Law arise, this Court will not refuse the discretionary power vested in it by Parliament merely because it was a case in which the validity of the Patent was questioned.”

In the case of *Woodcroft's Propeller*² the application was successful in the face of a powerful opposition (Ship Propeller Company, who had adopted Smith's Patent), principally from the merit of the invention. The Patentee had expended £1,200, and received only £460. Their Lordships granted an extension of the Patent for six years, and refused to put the Patentee under conditions, “the invention being a most ingenious application of mathematical principles to mechanical ends.”

*Woodcroft's
Propeller.*

The expense of experiments instituted by the Patentee, in addition to the interruption to his ordinary business, forms another item of considerable importance in certain classes of inventions.^a In *Heath's Patent*^b large sums had been expended in experiments, and as the articles manufactured at first were given away, to prove the excellence of the steel, the return had been very small—200*l.*, it was said, would cover all the receipts. The application was by the widow of the Patentee, and was opposed by the defendant to an action for infringement,^c then pending. Scientific witnesses deposed to the improvement effected by the use of manganese in converting iron into steel, and persons conversant with the trade proved that, previously to the invention, the best cutlery could only be made with shear steel, as no means were known of welding cast steel with iron. The Committee, while cautiously abstaining from expressing any opinion as to

*Expensive ex-
periments.*

² (1846), screw, 28 Lond. Journ. 196, per Lord Brougham, P. C.

^a *Southworth's Patent* (19th April, 1823), machinery for drying calicoes, linen, &c., Exch. (1837), Web. P. R. 487; *Lowe's Patent* (1846), naphthalized gas, 10 Jur. 363.

^b (Feb. 8, 1853, P. C.), steel, M. M. 131.

^c *Heath v. Smith* (1854), Ex. Ch., 18 Jur. 601.

the validity of the Patent, considered the invention one of great merit and fraught with considerable advantage to the public, and recommended its extension for seven years.

Loss from litigation.

The trouble and expense of litigation forms, also, a favourite item with the Judicial Committee, who look with great suspicion on an applicant who has compromised legal proceedings.^d Their Lordships require generally to have a satisfactory explanation of the length of time during which no steps^e have been taken against infringers. In the case of Smith's screw-propeller,^f their Lordships' commiseration was excited, from the Patentee's "great misadventure in steering through the Courts of Law." There was no clear proof of any great amount of infringement, but the Patentee had taken proceedings against the wrong parties, and at a cost of 2,000*l.* had failed in his suit. The Ship Propeller Company, assignees of the Patent, had opposed the extension of a rival Patent.^g The Admiralty had employed the invention extensively, and owed 25,000*l.* for its use, but they refused to pay the Patentee in consequence of the litigation and the claims of other parties to the originality of the invention. They adopted the somewhat singular course^h of paying a large sum of money to a banker for the purpose of distribution among such persons as could substantiate a claim to it.ⁱ The invention was admitted to be of great merit and public utility. The Patent had, however, not been remunerative. Extended for five years.

Pinkus's Patent.

Piracy, through unavoidable exposure during the ex-

^d *Re Simister's Patent* (1842), cloth for stays, 4 Moo. 164.

^e *Re Pinkus's Patent* (1848), atmospheric railway, 12 Jur. 233.

^f *Re Pettit Smith's Patent* (1850), screw-propeller, 7 Moo. 133.

^g *Woodcroft's Patent* (1847), screw-propeller, 28 Lond. Journ. 196.

^h Mentioned on the extension of *Carpenter's Patent*, screw-propeller, M. M. April, 1854.

ⁱ Sup. p. 174.

perimental construction of the Line, was put forward as a strong ground in the case of *Pinkus's Atmospheric Railway*, but disallowed from the absence of assertion of rights at Law.^k

The determination of the Patent is frequently, from the peculiar nature of the manufacture, the period at which the returns from the invention begin to remunerate the Patentee. In the case of *Hardy's Patent*,^l the Patentee, after having lost largely by carrying on the manufacture, assigned to the Petitioners, who spent 36,000*l.* in establishing the manufacture. They realized very considerable profits, and at the period of application were, from their position in the trade, likely to command a very large sale of the Patent article. The invention being one of high merit and of great service to public safety, the Patent was extended in favour of the four Petitioners on condition of their securing to the original Patentee half the profits of their sales, including those for exportation. "It is true," the Court remarked, "they have made large profits, but at the same time there have been some risks." In *Derosne's case*,^m the benefit resulting to the public (a reduction of 20 *per cent.* in price) weighed so strongly with their Lordships, that, even in the absence of any great amount of skill in the invention or risk in the manufacture to counterbalance considerable profits,ⁿ their Lordships were induced to grant an unconditional extension of the Patent for six years. The application in this case was unopposed.

Insufficient remuneration.

On the extension of Porter's anchor Patent,^o it was stated that the loss in working the Patent up to that

Porter's anchor.

^k (1848) 12 Jur. 233.

^l (1849), railway axles, 6 Moo. P. C. 441; 13 Jur. 177; *Re Steaine's Patent* (1837), mineral waters, Web. P. R. 561.

^m (1844), sugar, 4 Moo. 416.

ⁿ The Patentee had expended 4,000*l.* in perfecting the invention. The profits from Licences amounted to 7,920*l.*

^o July 19, 1852.

date had been no less than 15,000*l*. The petitioner was the assignee. The application was not opposed, and the extension was granted for six years. Some improvements effected by Trotman, the nephew of the applicant, were amalgamated with the original Patent.

The case^p of *Carpenter's Patent* (dated 1840, screw-propeller) was somewhat peculiar. The Admiralty had used the invention extensively, but paid nothing for its use to the Patentee, although, as stated in the petition, the propeller was adopted in the Royal Navy, in consequence of the experiments conducted by Captain Carpenter before the Admiralty at his own expense, and had till the present time been in constant use in Her Majesty's service. The Attorney-General, on behalf of the Admiralty, opposed, but offered to withdraw his opposition, provided Captain Carpenter would consent to the introduction into the extension of a clause prohibiting him from making any claims on the Admiralty for the future use of his Patent, as it was stated was the usual course with other Patentees. Their Lordships granted the extension of the Patent unconditionally for a period of six years.

Patent not worked.

The length of time which has elapsed, and the efforts made by the Patentee in bringing the invention before the public, and reducing it to practical operation,^q is also a point much dwelt upon at the hearing,^r and one which must be satisfactorily explained. In *Patterson's case*^s the application was refused, the invention not having

^p Judicial Committee of the Privy Council, April, 1854; and see Debates, July, 1854. See also *In re Pettit Smith's Patent* (1850), screw-propeller, 7 Moo. 133; and *In re Woodcroft's Patent* (1846), screw-propeller, 28 Lond. Journ. 196.

^q See supra, 98.

^r *Re Pinkus's Patent* (1848), atmospheric railway, 12 Jur. 233.

^s (Dat. 1835), hide-tanning by blackberry brambles (1849), 6 Moo. 459; 13 Jur. 593.

been prosecuted until a short time before the expiration of the Patent, owing to dissensions between the Patentee and the parties who were to assist in working it. In *Bell's case*,[†] the manufacture was unprofitable for the first ten years of the Patent, from a defect in the composition employed. An improved composition was then made use of, and the Patent showed signs of becoming remunerative. The Court, however, refused the application, notwithstanding great losses of the Patentee by fire and considerable expenses.

The difficulties experienced by the Patentee from prejudice against the introduction of his invention forms frequently a very strong argument in favour of his application.[‡] In the case of Roberts's self-acting mule, the labor of the inventor, and the difficulties to be contended with, were very great. The machine^x was devised to supersede manual labor in the mills. A year's incessant labor ended in its construction early in 1825. In July of that year a fire (supposed to be the work of an incendiary) destroyed the premises of the Patentee at a loss of 10,000*l.* beyond the insurance. The offices refused to insure again. From 1826 to 1831, there being no matters in dispute, few machines were required. In 1831, owing to extensive combinations among the head spinners, many machines were ordered, and the Patent in consequence became remunerative. The prejudice against

Loss from prejudice.

Great merit in the inventor.

[†] (1846), lucifer matches, 10 Jur. 363. Delay in the reduction of an invention into practical use constitutes, as was recently remarked by Lord Campbell, a case in which, 'if prejudice were permitted to exist in a Court of justice, it might be expected to exist against the Patentee.' *Crossley v. Potter* (1851), carpets, printed case, 51.

[‡] *Cookworthy's Patent* (1719), porcelain, granted to Champion, assignee, Web. P. R. 39; *Stafford's Patent* (24th December, 1824), carriage springs, Web. P. R. 563; extended, 1838; *Jones's Patent* (1840), carriage wheels, Web. P. R. 577; see *Jones v. Pearce* (1832), Godson, 2nd ed., 190; Web. P. R. 124; *Wright's Patent* (1843), encaustic tile, 25 Lond. Journ. 466; Web. P. R. 737.

^x Sup. p. 145.

its novelty was so strong as to remove it from the operation of what was apparently the interest of the manufacturers. The invention performed fifty per cent. more work, and that of a better kind than the old mule, yet the offers of the Patentee^y were met with "We are as well off as our neighbours, we will not be the first to make the experiment." The application was unopposed, and was granted^z unconditionally for seven years. A very recent case^a met with an extension of five years, on the grounds that the Patentee had used every exertion in his power to introduce the invention, and had expended large sums in so doing; but by reason of the distrust with which the public viewed preparations of that nature, the inadequacy of the Patentee's pecuniary means, and his want of influence with public boards, he had been prevented from obtaining such a fair trial as would lead to the adoption by the public of his invention.

Ledsam v. Russell.

The case of *Ledsam v. Russell*^b was important from the variety of jurisdictions resorted to and the unanimity of decisions at successive stages. The case was brought before the House of Lords on a writ of error, upon a judgment of the Exchequer Chamber^c affirming a judgment of the Court of Exchequer.^d The Patent, dated 26th February, 1825, was in 1835 assigned to *Russell*, and established after considerable litigation. On Petition by the assignee new Letters-patent, dated 26th February, 1839, were issued to him for six years, contingent upon his securing to the original Patentee an annuity of 500*l.*, and releasing him from a covenant to work for the assignee. In 1841 *Russell* filed a Bill against *Ledsam* and others for an injunction and account,

^y (1851) Evid. 1311, Roberts.

^z (1839) Web. P. R. 575; 13 Lond. Journ. 370.

^a *Payne's Patent* (July 12, 1854), P. C., preserved meats.

^b (1848), gas tubes; *Whitcomb's Patent*, 1 H. of Lds. Cas. 687.

^c (1847), Exch., 16 M. & W. 633

^d (1845), Exch., 14 M. & W. 574.

which was refused, the novelty and usefulness of the invention being contested. *Russell* then instituted an action,^e and at a trial before Alderson, B., obtained a verdict, with points reserved, which were argued in Trinity Term, 1845, and decided in favour of the Patentee. The case was then carried to the Court of Exchequer Chamber, the grounds of error relied upon being—that the Act did not authorize the grant of extension to an assignee; that the declaration did not show that an application for renewal had been “prosecuted with effect” before the expiration of the original term; that the condition as to Whitehouse’s annuity was not shown to have been performed; that the old Patent had expired before the grant of the new Patent was made, and that these Letters-patent granted a renewal on a condition subsequent, whereas the recommendation of the Privy Council was for a renewal on a condition precedent. A decision, affirming the judgment below with costs, established the following positions:—

That assignees might obtain a renewal of Letters-patent.

That the Statute did not authorize the Judicial Committee to impose terms; their authority being limited to reporting on matters as between the Petitioner and the public.^f

^e 24th June, 1844.

^f “I can find,” said Cottenham, L. C., in this case, “nothing in the Act of Parliament which authorizes the Judicial Committee of the Privy Council to impose any terms or make any recommendation to His Majesty with respect to the parties seeking for the grant of the new Letters-patent, except the fact of whether the Letters-patent shall be extended or not. What the Judicial Committee is to report upon is merely as to matters between the public and the party applying, whether the party applying has made out a case as against the public to have the old Letters-patent renewed. But as to imposing any conditions upon the Crown, which has otherwise the right to make the grant, there is nothing in the Act to restrain the Crown from exercising any discretion it pleases. If this objection could prevail it would be upon this ground, that the Crown had no right to make the new grant unless upon the terms recommended by the Judicial Committee; in

That there is nothing in the Statute to fetter the discretion of the Crown, except as to the limit of the period of renewal.

That an application for renewal is "prosecuted with effect" if the party applying *obtains the report of the Judicial Committee* before the expiration of the original Patent. The Crown is not restricted as the time in which it may act upon such report; and renewed Letters-patent are not void because dated after the expiration of the original Letters-patent.

Baxter's Patent.

Baxter's⁵ colour-printing Patent was opposed by the apprentices of the Patentee, who alleged that they had become such on the faith of being able to practise the invention on the expiry of the Patent. It appeared, however, the instruction they had received was not exclusively in the use of the patented invention, and that some were since employed in delicate work, one at wages as high as 52s. a week. The invention was acknowledged to be of great merit and utility, and the Patentee was shown to have made nothing by the Patent. Their Lordships recommended its extension unconditionally for five years.

other words, that if terms were recommended by the Judicial Committee, the Crown must be bound by them. What the Act of Parliament meant the Judicial Committee should do, was merely to recommend that the Crown should grant an extension of the term or not; and if an extension was recommended to be granted, then it was to be kept within certain limits."

Lord Brougham, who drew the Act, entirely agreed with this exposition of it. "The Crown," his Lordship remarked (p. 703), "is not bound to grant the renewal of the Patent in the very terms that are stated in the report of the Lords of the Privy Council, or to see that the terms mentioned in that report have been complied with."

The Judicial Committee have established it as a rule to impose conditions on an assignee only where the inventor and Patentees have made nothing by the invention. (Per Lord Brougham (1849), *In re Bodmer's Patent*, carding cotton, 6 Moo. 468.

⁵ *Re Baxter's Patent* (1849), combination of copperplate and wood cut, 13 Jur. 593.

At the hearing, the petitioner and parties opposing may appear either by themselves or by counsel.^h The Attorney-Generalⁱ or other counsel will be heard on behalf of the Crown in opposition to the application for the extension of Letters-patent, in case it shall be thought fit to oppose the same on such behalf.^k As a rule of practice their Lordships have decided, that where several *caveats* are entered, only two counsel will be heard on either side, unless the parties opposing do so on separate and independent grounds.^l

The hearing.
Attorney-General heard on behalf of the Crown.

The evidence usually adduced in favour of the novelty and utility^m of the invention is, that of persons most conversant with its effects. Where the improvement has been of a sanitary character, medical and scientific men attest the improved qualities of the invention.ⁿ

Evidence.

In the case of mechanical inventions, persons conversant with the manufacture, or engaged in the trade, give evidence to the saving of time in labour or expense, or to the superiority of the workmanship effected by the employment of the principle of the Patentee.^o

^h A noble Lord, himself a leading member of the Judicial Committee, has on this point the following observations:—"The course which a Patentee ought to pursue, if there be no opposition to his claim of extension, is to employ no solicitor and no counsel, but to appear in person before the Judicial Committee, as my gallant and truly ingenious friend, Lord Dundonald (better known as Lord Cochrane), lately did. Their Lordships always favour such a course, the rather as they thus obtain the advantage of hearing the explanations required from the persons best able to give them. In opposing cases professional aid is requisite." (Lord Brougham, *Men of Letters, &c.*, 1845, p. 379, n.)

ⁱ *Re Bodmer's Patent* (1849), cotton-carding, 6 Moo. 468; *Re Berry's Patent* (1850), wheat-cleansing machine, 7 Moo. 187.

^k Further Rule, Council Office. Dec. 21, 1835.

^l *Re Woodcroft's Patent* (1841), yarn-printing, 3 Moo. 171.

^m *In re Bodmer's Patent* (1849), cotton-carding, 6 Moo. 468.

ⁿ *Swaine's Patent* (dat. 9th October, 1822), mineral waters (1837), Web. P. R. 561; *Lowe's Patent* (1845), naphthalized gas, 28 Lond. Journ. 448.

^o *Southworth's Patent*, (1837), Web. P. R. 487.

Profit and loss.

The evidence as to the absence of remunerative return from the Patent is usually given by the Patentee or persons engaged in the manufacture or sale of the patent article.¹⁰ The Committee is rigorous in examining the accounts, and any suspicion as to their genuineness, or any laxity apparent in the mode of conducting them, will prove fatal to the application.¹¹ The books, in fact, form frequently the most reliable information as to the history of the Patent, and the difficulties, embarrassments and rivalries contended with by the Patentee. In *Downton's Patent*¹² the numbers of the Patent article sold were, in 1825 (the date of the Patent) and subsequent years, 19, 33, 90, 92, 38, 44, 46, 63, 74, 84, 113 (in 1835), 73, 70, 69, 22 (in 1839). The diminished returns in the fifth year were attributed to the prevalence of piracy, and the falling off in 1835 to the death of the Patentee and the transfer of the Patent to his widow, the Petitioner.

Downton's Patent.

Presumption in the absence of evidence.

The presumptions on which the Privy Council act in the absence of evidence are chiefly these. The fact of an invention when known not getting into general use is a presumption against its utility,¹³ while that of an article having been extensively sold at a high price is *prima facie* evidence of it.¹⁴ Both are however capable of being rebutted by the circumstances of the case. An application on behalf of a patented knapsack was supported by very favourable reports from officers who had examined it. It was deposed by Mr. Angelo, that the

¹⁰ *Re Lowe's Patent* (1846), naphthalized gas, 10 Jur. 363. Evidence was given by the manager of the gas company that they had paid the Patentee nothing for his gas.

¹¹ *Re Quarrill's Patent* (1840), lamps, Web. P. R. 740; *Re Noble's Patent* (1850), wool-carding, 7 Moo. 191.

¹² (1839), water-closets, Web. P. R. 567.

¹³ *Re Simister's Patent* (1842), cloth for stays, 4 Moo. 164; *Re Pinkus's Patent* (1848), atmospheric railway, 12 Jur. 233.

¹⁴ *Re Downton's Patent* (18th June, 1825), water-closets (1839), Web. P. R. 567.

fact of nine out of ten men in our infantry becoming flat-chested was to be attributed to the one in ordinary use. Some hundreds had been expended on it by the Patentee, but hitherto without return. The Committee, allowing their doubt as to its utility (arising from its not having been adopted by the Government) to be slightly founded, in the absence of evidence of its failure recommended its extension for five years.^u In the case of *Woodcroft's Screw Propeller*,^v Lord Brougham remarked,—“It is not enough to object that the Patent has been long in coming into operation, for the steam-engine and many other discoveries are open to the same observation.”

Insufficiency in the Specification, it should be remarked, is a point frequently urged,^y and, in some instances, successfully, by the opponents of the application.^z Specification.

The costs incurred for a contemplated opposition, will, on the abandonment of the Petition, be ordered *ex parte*.^a A *caveat* having been entered by Messrs. Ashton & Co., grounds of opposition were duly lodged Costs of opposition.

^u *Re Berrington's Patent*, P. C., July 5th, 1852. See also, as to extensions on the ground of loss sustained by the manufacture, *Stafford's Patent* (1838), carriage springs, Web. P. R. 563; *Kollman's Patent* (1838), P. C., pianofortes, Web. P. R. 564.

^x (1846) P. C., 28 Lond. Journ. 196.

^y *Wright's Patent* (1838), bleaching, 13 Lond. Journ. 371.

^z *Re Pinkus's Patent* (1848), atmospheric railway, 12 Jur. 233; but see *Re Heath's Patent* (1853, Feb. 8), steel, M. M. 151.

^a *Re Hornby's Patent, Ex parte Ashton* (Letters-patent dated 26th September and 11th December, 1839), cotton, wool, &c., sizing for weaving (1853), L. C., 1 C. L. Rep. 519.

By Rule VIII., Council Office, Whitehall, 18th November, 1835, the Master of the High Court of Chancery, or other officer (now the Clerk to the Privy Council), to whom it may be referred to tax the costs incurred in the matter of any Petition presented under the said act, shall allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly. See Stat. 6 & 7 Vict. c. 38, s. 12.

at the Council Office. On 11th May, Petitioners informed Messrs. A. that 16th June was appointed for the hearing. Considerable expenses were incurred by Messrs. A. in preparations for opposing the extension. The Petition was subsequently abandoned. On affidavit of these facts, and that, on 15th June, notice of this motion had been duly served, an order was made directing a reference to the Registrar of the Judicial Committee to tax the costs of Messrs. A. incidental to the opposition, and payment of such taxed costs by the Petitioner.

Renewed Letters-patent.

Scotch Patents.

Renewed Letters-patent are dated as of the day after the expiration of the term granted by the original Patent. They extend only over the district included under the original grant.^b Letters-patent for Scotland previously to the late Act were in Latin. The renewed Letters-patent for that country (prepared in the Office of the Commissioners) are in English. In *Whytock's* case^c the application was for the extension of English, Scotch and Irish Patents of various dates, the latter being dated some months after the enrolment of the English Specification. On the authority of *Brown v. Annandale*,^d and *Saunders's* case,^e it was contended the Irish Patent was void. The Committee, however, granted an extension for five years on the Petitioner submitting to grant a licence to a rival Patentee.

Alteration of the subject matter in the new Letters-patent.

As might be expected from the nature of the case, various modifications of the original scheme of the Patentee are found to be beneficial after the test of some years actual practice. The Judicial Committee seem not disinclined to admit of considerable variations in the subject matter of the extended Letters-patent. In the case of

^b 5 & 6 Will. IV. c. 83, s. 4; 2 & 3 Vict. c. 67; 7 & 8 Vict. c. 69, s. 4; 15 & 16 Vict. c. 83, s. 40.

^c (1846), figured carpets, 28 Lond. Journ. 449.

^d 1 Web. P. R. 433.

^e Hind. 434.

Taylor's Patent,^f their Lordships decided on dividing the invention, refusing the application as regarded the flat-bladed propeller, but granting an extension of the Patent in respect of the hollow trunk through which the screws were raised, as of that part Mr. Taylor appeared to be the original inventor. An application for renewed Letters-patent to combine the substance of two Patents held by the Petitioner has been refused, although it is to be remarked that in that case the profits had attained the large amount of 12,000*l*.^g

In some instances the conditions on which the Patent is to be renewed is that the Patent article is to be sold at a prescribed price. In extensions by Act of Parliament before the Act 5 & 6 Will. IV. c. 83, such terms were frequently imposed.^h In the case of *Hardy's Patent*ⁱ the renewed Letters-patent fixed the price of the axles relatively to the price of bar iron, as settled by the Staffordshire iron-masters at their quarterly meeting last preceding the contract for sale. The condition annexed to the extension of *Smith's Patent*^k was that the Patentee should supply the invention to Her Majesty's service at such reasonable prices as should be settled for that purpose by the Lord High Admiral of the United Kingdom, or the Lords Commissioners of the Admiralty, and that the Admiralty should have the right of manufacturing the invention without licence from the Patentee.

Parties using the invention in the interval between the expiration of the old term and the grant of the new Letters-patent are not guilty of infringement. They are entitled to oppose the renewal, and are usually ex-

Price of article prescribed.

Use of invention pending the grant of new Letters-patent.

^f Feb. 1852, M. M.

^g *Smith's Patent* (21st June, 1847), cotton-spinning machinery, 30 Lond. Journ. 451. And see sup. p. 218, *Potter's Patent*.

^h Hartley's Act, 17 Geo. III. c. 6, fire-proof buildings.

ⁱ *In re Hardy's Patent* (1849), railway axles, 6 Moo. P. C. 441; 13 Jur. 177.

^k *In re Pettit Smith's Patent* (1850), screw-propeller, 7 Moo. 133.

Existing rights preserved.

cepted in the conditions from the restrictive operation of the new Letters-patent.¹ The provisoes in general are directed to secure the rights of persons in actual possession of the invention, on the principle originally stated, that a privilege of the nature of a Patent will not be conceded to the detriment of existing rights.

Bulmer's Patent.

Where the executor of the surviving assignee of a Patentee petitioned for an extension of the term of Letters-patent, and it was established that a valuable consideration had been given for the assignment, and that the assignee had sustained considerable loss, the Judicial Committee, in granting an extension of the term for five years, *refused to impose terms upon the Petitioner* in favour of the Patentee.^m

Change in practice of issuing new Letters-patent.

Under the old practice the same trouble and expense was incurred in procuring the renewed as the original Letters-patent. To alter the Letters-patent the Great Seal had to be cut off, and the alterations having been made the Great Seal was again affixed as in the original sealing. The 40th section of the new Act, however, provides a very simple remedy for this evil by enacting, "that in the granting any such new Letters-patent Her Majesty's order in Council shall be a sufficient warrant and authority for the sealing of any new Letters-patent, and for the insertion in such new Letters-patent of any restrictions, conditions and provisions in the said order mentioned; and the Lord Chancellor, on the receipt of the said order in Council, shall cause Letters-patent, according to the tenor and effect of such order, to be made and sealed in the manner herein directed for Letters-patent issued under the Warrant of the Law Officer."

Power of the Crown.

On a proper case being made, the Crown may, at any time before the Great Seal is actually affixed, interfere to prevent the grant of such Letters-patent.ⁿ

¹ *Ledsam v. Russell* (1843), Exch., gas tubes, 11 M. & W. 647.

^m *In re Bodmer's Patent* (1849), cotton-carding, 6 Moo. 468.

ⁿ *Re Schlumberger's Patent* (1853), silk weaving, 1 Eq. Rep. 36.

CHAPTER VIII.

SCIRE FACIAS TO REPEAL A PATENT.

PATENT right, involving the variety of considerations above adverted to, litigation connected with it is, as might be expected, especially arduous and expensive;^a a circumstance attributable in the first place to the peculiar character of the tribunals,^b and in the next to the

Litigation of
Patent rights.

^a The following, from the First Report of the Committee of the Society of Arts on the rights of inventors (1851), expresses the deficiencies then popularly complained of, in the means for the adjustment of Patent rights:—"The Committee are unanimously of opinion that for the satisfactory settlement of disputes arising out of inventions protected by Law, which demand specific scientific acquirements in the tribunal, the present judicial arrangements are insufficient, productive of enormous and unnecessary expense, and a source of anxiety and needless delay to the unfortunate possessors of the right. The great difficulty, expense and trouble of obtaining redress in case of infringement, is a premium inducing dishonest persons to run the risk of infringing on the rights of Patentees. It leads to vexatious lawsuits and to loss of money from the unfair competition of the infringer before he can be stopped."

^b Before the passing of the Statute of Monopolies Patent rights were tried in the Star Chamber, that Court having, as Clarendon remarks (Hist. Reb. bk. iii.), "extended its jurisdiction from riots, perjury and the most notorious misdemeanors, to the assertion of all proclamations and orders of State, to the vindicating illegal commissions and grants of monopolies." (Co. 4 Inst. 62; Hall. Const. Hist. i. 73; Bacon's Works, ii. 290. No mention, however, is found of such decisions among the cases in *L'Authoritie et Jurisdiction des Courts de la Majestie de la Roygne*, 1637.) By that Act, however, (21 Jac. I., c. 3, s. 2,) it was enacted, that "Monopolies, Letters-patent, &c., and their force and validity, ought to be and shall be examined, heard, tried and determined by and according to the Common Law of this realm, and not otherwise." (Chitty's P. C. ch. 10, s. 2.)

The same difficulty is experienced in France, from the diversity

nature of the evidence it puts in requisition. With regard to the former, there seems every desire to give a fair trial to the system of Registration which has been recently introduced, and which in the sister subject of Designs has worked with very fair success, before creating a special tribunal for adjudicating on inventors' rights. Relief from the second evil must be looked for on a wider field, as involving the vexed question of trial by jury.^c Although here presented in the strongest light, exceptional legislation in this respect is hardly to be expected, an almost superstitious veneration for this mode of trial having debarred the judges of the Superior Courts, in cases of a similar character, from a discretion freely entrusted to inferior magistrates.^d

Radical
changes in
Patent Law.

Recent legislation with reference to Patents has on the whole effected so fundamental a change in legal procedure, that it may be questioned whether anything further than public convenience remains to be consulted in prescribing the course through which future practice is to run; the equitable powers placed at the disposal of

of tribunals, as Patents, from their involving matters of fact and not of Law, cannot be brought under the cognizance of the Cour de Cassation. (1851, Evid. 2511, Wolowski.)

^c In *Lorell v. Hicks* (1836, Exch. Eq., economical baking apparatus, 2 You. & Coll. 46), Mr. Baron Alderson observed,—“Although I am not insensible of the disadvantage which a Court of Equity labours under in not having the benefit of oral examination, which I own I have long thought might, with great advantage, be given to it, to be exercised by it at its discretion, and applied to such parts of a case only as might be found after discussion to require it: yet when I compare the counterbalancing advantage of long and calm deliberation and of dispassionate inquiry, which a judge possesses, who can at leisure weigh all the circumstances, with the sudden and hasty decision of a jury at *Nisi Prius*, even though assisted by oral examination, I have no doubt upon the whole, in nice and complicated questions such as this, I should not do real justice to the parties by directing an issue.”

^d See Designs Acts, Stats. 5 & 6 Vict. c. 100, and 6 & 7 Vict. c. 65; *Kennedy v. Coombs* (1845), ink box, 26 Lond. Journ. 110.

Courts of Law,^e and the increased efficiency given to Courts of Equity,^f having removed the chief barriers to their independent and complete jurisdiction. *Scire facias* it seems needless to retain. Based on the importance of the physical possession of Letters-patent,^g it is clearly incompatible with a system which deprives that possession of significance, and a practice^h which has devised a mode of counteracting its effect. There seems, indeed, no valid reason why the power of repealing Letters-patent should not be added to those already bestowed on the Courts of Equity and Common Law. On the whole, for reasons we shall subsequently consider, Courts of Equity seem the better adapted of the two for dealing with property so peculiar in its nature as that which exists in patented inventions.

Scire facias unnecessary.

The theoretical defect in the proceeding we are about to consider arises out of the ambiguous part taken by the principal actor in it, the Attorney-General, and the depositary in that officer of discretionary power with reference to rights, on the hypothesis of Patents essentially conflicting. As the adviser of the Crown, on the one hand, he is supposed to contend for the maintenance of the Prerogative, while his duties as the general guardian of public rights necessarily involve a jealous opposition of that Prerogative on the other. In practice the action of the Executive is too circuitous and slow, and the limits of the constitutional powers involved very indis-

Defective in theory.

The Attorney-General.

In practice, ineffective.

^e Stats. 12 & 13 Vict. c. 109, s. 39; 15 & 16 Vict. c. 83, s. 42.

^f 1 Fonbl. Eq. 8, n.; Stat. 15 & 16 Vict. c. 86, s. 61. It is in contemplation still further to increase the powers of Courts of Equity by enabling them to give damages in cases in which by the present practice they may grant injunctions." Hansard, House of Lords, August 8, 1854.

^g *Sir Robert Sidnie's case*, Dyer, 167 a; *Sir T. Wroth's case*, ib.; *Kemp v. Makewilliams*, Dyer, 195 a; Com. Dig. Pat. E. G.; *R. v. Newcastle-upon-Tyne*, 1 Sand. Ord. in Chan. 390.

^h *R. v. Mill* (1850), C. B., instruments for marking, 1 L. M. & P. 695.

Power of the
Law officer.

tinctly defined. On one theory the Attorney-General is entirely responsible for the institution of the proceedings, and even after his *fiat* has been granted, and *scire facias* has been sued out, retains as complete control over the action as he would in the case of an ordinary information, where there is no relator. As depending from the discretionary exercise of the Royal Prerogative, the Lord Chancellor has, on this supposition, no authority in the matter.ⁱ The alternative hypothesis would place corresponding powers in the Lord Chancellor in virtue of the connection of the Letters-patent with the Great Seal,^k even in matters connected with the issue of the writ. The subsequent proceedings are all before him as if there be a demurrer, and it is only when there are issues in fact that the record is sent to the Court of Queen's Bench. It is said that in case of a demurrer and issues in fact, judgment on the whole is given in the Court of Queen's Bench.^l In days when the Sovereign had personal interest in the repeal of Royal grants, a vigorous but irregular power existed to move the machinery requisite for the purpose. In attempting to employ *scire facias* as an engine in the present economy of the State, we are driven to compose on constitutional principles, a substitute for the Royal will; a power to put in motion and control this curious compound of various independent jurisdictions, the relations between which, never probably settled on very definite principles,^m have from successive piecemeal emendations become peculiarly complex and confused. Practically this whole power is vested in the discretion of the Attorney-General; the virtual effect of the decision in *R. v. Mill*ⁿ being to transfer the whole question to the arbitration of that officer, on

ⁱ *R. v. Prosser* (1848), M. R., iron tubes, 11 Beav. 306; 18 L. J., N. S., Ch. 55.

^k *Cancellarius, a cancellando*, 4 Inst. 88; Hindm 380.

^l Saunders, 6 a; *R. v. Neilson* (1842), L. C., iron, Web. P. R. 669.

^m *Countess of Pembroke's case*, 42 Ass. fo. 262, pl. 22.

ⁿ (1850), C. B., seals, pens, &c., 1 L. M. & P. 695.

the contest between the prosecutor and the Patentee, as to the admissibility of the Disclaimer the latter may choose to propose after the institution of the action.

Annexed to every Crown grant by the Common Law is an implied condition,^o that in the event of its being either contrary to Law,^p void for uncertainty in its terms, obtained by deception^q of the Crown, or injurious to the rights of other subjects, the grant thus made may be repealed by *quo warranto*^r or *scire facias*, instituted

Royal grants at
Common Law.

^o "Although the privilege" (the use of the Prerogative of the Crown in *scire facias* upon the *fiat* of the Attorney-General) "is not enforceable by *mandamus*, it is so much of common right that in no case has it been refused to my knowledge. Indeed, in the somewhat analogous case of a Petition of Right, it has of late years been the practice at the Home Office to endorse 'Let right be done,' as a matter of course, without ever referring the matter to the Attorney-General." Per Jervis, C. J. [Attorney-General from July, 1846, to July, 1850], *Eastern Archipelago Company v. R.* (1853), Ex. Ch., 1 C. L. Rep. 185. "By Stat. 11 & 12 Vict. c. 94, s. 26, no writ of *scire facias* is to issue without the *fiat* and leave of the Attorney-General; and although *mandamus* does not lie to compel that officer to grant his *fiat*, it appears that in the event of his improperly withholding it, he might be questioned in Parliament and punished." Per Campbell, C. J., *Ibid.* "The Attorney-General, who exercises the power of the Crown in this respect, has no option: he simply decides the question of a *prima facie* right." *Ibid.*, per Parke, B. It was contended, in this case, that the *fiat* of the Attorney-General for issuing the writ of *scire facias*, so far from being equivalent to a writing under the Great Seal or Sign Manual, was not evidence that such writing had issued, or any signification of the Queen's will at all.

^p *R. v. Butler*, 3 Lev. 220; *Legat's case*, 10 Co. Rep. 113 b; *Magdalen College case*, 11 Co. Rep. 74 b. See authorities as to the powers of the Crown at Common Law cited in Hind. 378.

^q That a grant may be avoided by concealment in the recital in an action by the grantee against a third party, appears from *Alcock v. Cook*, 3 Bing. 234.

^r *Quo warranto*, it is said, is always founded on an usurpation, and supposes a party in actual, but not legal possession (*Peter v. Kendal*, 6 B. & C. 708); *scire facias* proceeds on the supposition that a body in legal possession of certain powers is acting in abuse of these powers. *Eastern Archipelago Company v. R.* (1853), Ex. Ch., 1 C. L. Rep. 152.

either by the Crown, or by a subject aggrieved using the Prerogative of the Crown^s upon the *fiat* of the Attorney-General.

Scire facias.

By *scire facias* the fact of forfeiture and the sufficiency of the grant in point of Law are tried, and the Letters-patent, if invalid, revoked and cancelled by the Court. "It is laid down," says Lord Campbell, C. J., "by all writers of authority, that if Letters-patent under the Great Seal have been granted on any false representation by which they are void, or if after the grant there has been a breach of any condition subsequent whereby they are voidable, the Prerogative writ of *scire facias* to repeal them may be sued out either directly by the Crown or with the consent of the Crown, on the relation of an individual who may be the relator, and in subsequent proceedings it is wholly immaterial whether the *scire facias*, which in all cases must be in the name of the King, is issued with or without a relator."^t

Unaffected by reserved powers of the Crown.

The reservation by the Crown in its grant of the power of summary revocation in no way impedes the action of *scire facias* for their repeal at the instance of a subject. "It would, as it seems to me," says Platt, B.,^u "be a new doctrine to hold that the Crown, merely by reserving to itself certain powers in a grant to one subject, could take away from all other subjects those rights which by the Common Law are in their favor annexed to such grant. The dangerous effect of this is clear—a Patentee

^s Chitty, P. C. 330 ; 1 Hawk. P. C. 627.

^t *Eastern Archipelago Company* (1853), Q. B., 22 L. T. 33.

^u (1853), Ex. Ch., *Eastern Archipelago Company v. R.*, 1 C. L. Rep. 171. In the Court below (Queen's Bench) it had been held (1853, 21 L. T. 33), by Coleridge and Erle, Js., that such a proviso in a Charter operated as a restraint upon the general right to repeal Letters-patent for a breach of their conditions by *scire facias* in the first instance, and that the Crown must revoke the grant under the Great Seal, or by writing under the Sign Manual, before a private person could prosecute a *scire facias*, even with the leave of the Attorney-General.

is induced to await the movement for rectifying his claims from the public, instead of himself taking steps.”

By Stat. 15 & 16 Vict. c. 83, s. 15, the writ of *scire facias* lies for the repeal of any Letters-patent issued under that Act, in the like cases as the same would lie for the repeal of Letters-patent which before that Act were issued under the Great Seal. The remedies for parties in Ireland by *scire facias* are (s. 29) to be as complete as though the Letters-patent had been granted to Ireland only. In any proceeding in Scotland to repeal any Letters-patent, service of all writs and summonses are to be made according to the existing forms and practice.

Under the new Act

Coke, in his Institutes, lays down the cases in which such action lies: *Firstly*, where the King by his Letters-patent doth grant by several Letters-patent one and the selfsame thing to several persons, the former Patentee shall have a *scire facias* to repeal the second Patent; *Secondly*, where the King granteth anything that is grantable upon a false suggestion, the King, by the Prerogative *jure regio*, may have a *scire facias* to repeal his own grant; *Thirdly*, where the King doth grant anything which by Law he cannot grant, he *jure regio*, for the advancement of justice and right, may have a *scire facias* to repeal his own Letters-patent.*

Coke.

In the form now applicable to Patents for inventions, the employment of this process is of no long standing. On the trial of *Arkwright's Patent*[†] in 1785, Mr. Justice Buller observed:—“The proceeding of *scire facias* to repeal a Patent is somewhat new in our time. None such has occurred within my memory, though in former times they certainly were very frequent.” It soon afterwards was brought into general use, and employed with such formidable effect, that until recently no Patent had

Practice recent.

* 4 Inst. 88; 2 Rol. 191, l. 35; 2 Wms. Saund. 6th ed., 72, n.; Dyer, 197 b, 198 a; Com. Dig. F. 6.

† Spinning machinery, Dav. Pat. Cas. 144; Web. P. R. 74.

survived the ordeal.² Disclaimer, however, now furnishes the Patentee with an efficient weapon of defence. Although filed after issue joined it is admissible in evidence, need not be pleaded *puis darrein continuance*, but is to be read as part of the original Specification.^a

The prosecutor.

A *scire facias*, it is said, may be sued by any person who is prejudiced by a Patent as well as by the Crown.^b No matter whence the movement for its suppression, the Crown is bound to lend it its support. An illegal monopoly being, as was observed by Lord Langdale,^c a public nuisance, the Crown, when informed of such grievance, and having the power and the duty to remove it, ought not to be disabled from directing the necessary proceedings to ascertain the truth, because the information was given by an alien or by a person who had no special or direct interest in the matter, or was endeavouring to promote the interest of some other person, or was actuated by some improper motive. Two persons cannot however, it appears, join in the prosecution, unless they have a joint interest.^d

The writ as of right.

The right,^e however, of the subject to the writ can

² Turner, 72.

^a *R. v. Mill* (1850), instruments for marking, 1 L. M. & P. 695.

^b *Brewster v. Weld* (1705), 3 Anne, rectory of *Aldgate*, 6 Mod. Ca. 334.

^c *R. v. Prosser* (1818), M. R., 11 Beav. 317.

^d *R. v. Neilson* (1842), L. C., iron, Web. P. R. 673, n.; 3 M. & R. 460.

^e In *scire facias* for the repeal of grants of lands, royalties and offices by the Crown, it is said to have been the practice to commence by a memorial to the Crown (2 Saund. 72), and that a warrant then issued to the Attorney-General, who thereupon granted, *ex debito justitiæ* (Web. P. R. 669, n.), his *fiat* for the issue of the writs. The practice has, however, fallen into desuetude (Hindm. 385), and never appears to have been usual in the case of Patents for inventions. *Sir Oliver Butler's case*, 1 Vent. 44; Dy. 276; Staundforde's Prerog. cap. 23; Bro. Abr. tit. *Repellance*; 1 Richardson's Pract. C. P. 391; *R. v. Aires*, 10 Mod. 354; *Earl of Kent's case*, H. 21, E. 3, fo. 47, pl. 68, T. 44, E. 3, fo. 16, pl. 3; Fitz. *Traverse*, pl. 41; Bro. *Petition*, pl. 11; *Challer's case*, M. 9, H. 4, fo. 4, pl. 17, and see authorities cited *Smith v. Upton* (1843), C. B., 6 M. & G. 252, n.

hardly be said to be a settled point,^f considerable doubts existing both as to this and as to the effect of the special power of summary revocation reserved by the grant on the ordinary process for its repeal.^g Unless the breach were of some substantial condition of the grant, it appears the Attorney-General would be justified in refusing it,^h as he would be in a similar exercise of his discretion in refusing a writ of error in a criminal case. He might also stop the proceedings by means of a *nolle prosequi*.

Of the mode in which Patentees have availed themselves of this process for the purpose of tormenting one another, we have instances in *R. v. Lister* and *R. v. Hadden*,ⁱ *R. v. Fussell* and *R. v. Daniell*,^k and others. To guard against the perversion of the Prerogative to the purpose of mere vexatious annoyance, it has been the practice of late^l to require the prosecutor in this action to enter into a bond with two sureties to secure to the defendant his costs in the event of the failure of the prosecution. The bond is executed at the Office of the Petty Bag or before a Master Extraordinary in Chancery, the prosecutor's solicitor certifying to the sufficiency of the sureties. It is, however, not to be deposited or filed in the Office of the Petty Bag unless the intended obligors,

Abuse of *scire facias*.

The bond.

^f *Eastern Archipelago Company v. R.* (1853), Ex. Ch., 1 C. L. Rep. 145.

^g *Cardigan v. Armitage*, per Bayley, J., 2 B. & C. 197; *Hodgson v. Field*, 7 East, 613.

^h See per Lyndhurst, L. C., *R. v. Neilson* (1842), iron, Web. P. R. 672.

ⁱ (1826), Godson, 274.

^k (1827), *Ibid.*

^l The bond was first required in 1790, the amount being 500*l.*; but, since 1836, it has been increased in ordinary cases to 1000*l.* It rests, however, entirely in the discretion of the Law officer for the conditions under which liberty will be given to put the bond in suit. (General Orders, Aug. 1849, No. 18. See *R. v. Mill* before alluded to (1851), 11 Beav. 312; and form of the writ in Abbott's Forms, No. 88; Hind. 708.)

and the sums for which they are to give security, are named by the Attorney-General.^m

Check upon the
prosecutor.

Considerable care is taken in other respects to ensure the responsibility of the parties conducting the proceedings. The prosecutor's name or that of his attorney must be indorsed on the writ and copy,ⁿ and each attorney employed in the action must, before acting as such, enter at the Office of the Petty Bag his name and address, or some place where pleadings, notices, &c., may be left for him.^o Any party changing or ceasing to employ his attorney in the course of an action, suit, or proceeding, is to cause an entry of such change or cessation of employment to be made and entered with the Clerk of the Petty Bag,^p and to cause notice of such change or cessation of employment and of such entry to be served on every party to the action, suit or proceeding; and until such entry and notice shall have been made and served, the former attorney is to be deemed and taken for all purposes of the action, suit or proceeding, to be and remain the attorney of the party.^q

The defendant.

The defendants must be the proprietors^r of the Patent,^s the object of the *scire facias* being the revocation of the privilege they collectively represent. The return of the original Letters-patent into Chancery for the purpose of cancellation being also contemplated in the proceeding, the person having the custody of that instrument should also be made defendant. If any of the parties so appearing on the "Register of Proprietors" have died or become bankrupt or insolvent, the executors, administrators and assignees must be made defendants,

^m General Orders, Aug. 1849, No. 17.

ⁿ Stat. 11 & 12 Vict. c. 94, s. 26. See Abbott's Forms, Introd.

^o Stat. 12 & 13 Vict. c. 109, s. 44.

^p General Orders, 3rd August, 1849, No. 9.

^q *Ib.* No. 10.

^r Holroyd on Pat. 138.

^s Hindm. 388, 398.

the interest vesting in them by operation of law.[†] Judgment against the Patentee after assignment of his whole interest or against a deceased Patentee will not it appears invalidate the Patent.[‡]

According to a practice recently introduced, the Attorney-General on petition will interpose to stay proceedings in case of the security for costs being insufficient, or to reform the writ where it contains improper suggestions.^{*} A bill for an injunction being filed, the defendant, before the motion came on to be heard, commenced proceedings by *scire facias*; the Attorney-General refused to allow them to be proceeded with.[‡] In *R. v. Bynner*,[‡] the rule for setting aside the verdict for the Crown having been discharged on the ground that the Specification claimed too much, Sir F. Pollock, Attorney-General, stayed the proceedings, a Petition to amend the Patent by Disclaimer under Stat. 5 & 6 Will. IV. c. 83, s. 1, having been presented to him. The Attorney-General may enter a *nolle prosequi* on his own responsibility. The most that a Court of Equity will do will be to stay proceedings, to give that officer time for deliberation.[¶] It has no authority to overrule his decision when formed.[¶]

Attorney-General's control over the action.

Bill for injunction on the file.

Various reasons have been alleged for limiting the source whence the *scire facias* may issue to the Court of Chancery, the chief being that the writ is founded on some matter of record, and that that Court has the enrolment of the Patent.[¶] Coke, however, cites an instance[¶]

Writ issues out of Chancery.

[†] *Supra*, 115, 116.

[‡] *Web.* 22.

^{*} *Smith v. Upton* (1843), C. B., 6 M. & G. 260, n.

[‡] *Newall v. Smith* (1841), wire rope, not reported.

[‡] (1846) lamps, 9 Q. B. 523.

[‡] *R. v. Neilson* (1842), L. C., iron, *Web.* P. R. 665.

[¶] *R. v. Prosser* (1848), M. R., iron tubes (*Cutler's Patent*), 11 *Beav.* 306.

[¶] *Year Book*, 21 *Edw.* III. fol. 47, pl. 68; *Bro. Abr.* tit. *Petition*, pl. 11; *Jenkins' Rep.* p. 134; 3rd *Cent.* case 74; 14 *Edw.* IV. 1.

[¶] *Year Book*, 3 *Hen.* IV. fol. 6, pl. 29; *Hindm.* 381.

in which a *scire facias* was sued in the King's Bench. Upon a recognizance acknowledged in Chancery, and a transcript of it sent to the Common Pleas, the Common Pleas cannot award a *scire facias* upon this recognizance, lest the conusor should be twice vexed: for the Chancery may issue another *scire facias*. But it is otherwise if a transcript be sent out of the Treasury, for another *scire facias* cannot be granted out of the Treasury.

Obtaining the
Attorney-
General's *fiat*.

The prosecutor or his solicitor, having prepared a draft of the writ,^e must lay a fair copy of it before the Attorney-General, together with a statement of the facts on which it is founded, in order to obtain his *fiat*.^f The *fiat* and a true copy of the writ, and of any drawings or plans to be annexed thereto (to be verified by affidavit),^g are to be filed in the Petty Bag Office.

Permission of
the Crown.

"The Attorney-General," said Mr. Justice Wightman in a recent case,^h "on behalf of the Crown, authorizes the proceedings at the instance of a private prosecutor, which might and ought to have been brought by himself directly in the name of the Crown. The assent therefore of the Attorney-General is of the same effect as if he had himself, on behalf of the Crown, directed the proceeding."

Defendant may
show cause.

The proceedings are not entirely *ex parte*. The defendant may be heard before the Attorney-General to show cause previous to his granting the *fiat*. A *caveat*

^e Stat. 12 & 13 Vict. c. 109, s. 38. It was formerly the practice for the Clerk of the Petty Bag to prepare the writ from information furnished him by the prosecutor's solicitor. Hindm. 385. By stat. 12 & 13 Vict. c. 109, ss. 4 and 5, however, the Clerk of the Petty Bag is disqualified from acting as solicitor or attorney in the office of the Petty Bag on behalf of any person.

^f Foster, *Sci. Fa.* 249; 2 Wms Saund. 71, n. 4.

^g By Stat. 12 & 13 Vict. c. 109, s. 45, affidavits, affirmations and declarations to be used on the Common Law side of the Court of Chancery must be made before the Clerk of the Petty Bag or a Master Extraordinary in Chancery, and filed in the office of the Petty Bag.

^h *R. v. Eastern Archipelago Company* (1853), Q. B., 21 L. T. 33.

entered at the chambers of that officer confers no other right than that to notice of any application for issuing the writ.ⁱ

Common Law proceedings of the Court of Chancery, in matters similar to the repeal of Patents, have hitherto been conducted in the Office of the Petty Bag.^k The practice of that Court is for the most part regulated by Statute 12 & 13 Victoria and the General Orders in Chancery of 29th Dec. 1848, and 3rd August, 1849. (See Appendix.) The principal Officer of the Court is the Master of the Rolls, who exercises functions analogous to those of a judge at chambers.^l Solicitors of the Court of Chancery practise as its attornies.^m

Petty Bag
Office. See
below.

Although empowered to sit as a Common Law Judge when holding pleas in *scire facias* to repeal Letters-patent in the Office of the Petty Bag, the Lord Chancellor was unable to summon a jury.ⁿ A peculiar affinity was, therefore, by a fiction of Law, supposed to exist between the Court of Chancery and the Court of Queen's Bench, for the purpose of obtaining decisions as to questions of fact or Law. They were for this object said to form "one and the same place," so that the Chancellor could deliver *propria manu* a record into the Queen's Bench, although to take the same record into the Common Pleas required a writ of *mittimus*.^o All such distinction is now, however, abolished by the Statute investing all the Superior Courts with the powers possessed previously by the Court of Queen's Bench.^p

Relations of
Chancery and
the Queen's
Bench.

ⁱ *R. v. Cutler* (1847), Q. B., tubular flues, 3 C. & K. 215.

^k 4 Inst. 80.

^l 4 Inst. 82, 97; Hindm. on Pat. 377.

^m Stat. 11 & 12 Vict. c. 94, s. 21, re-enacted by Stat. 12 & 13 Vict. c. 109, s. 24. Formerly the Six Clerks acted as the attornies of the Court. Statute 5 & 6 Vict. c. 103, s. 1 substituted for them the Clerks of the Petty Bag.

ⁿ See note to *Smith v. Upton* before referred to, 6 M. & G. 257.

^o 2 Saund. 27; Dict. in C. P., per *Shardelow*, Justice, M. 10 Edw. III. fo. 59, pl. 62.

^p Stat. 12 & 13 Vict. c. 109, s. 35.

Action of *scire facias*.
The writ.
Suggestions of the writ.

The action of *scire facias* for the repeal of Letters-patent is commenced by an original writ issuing out of the Office of the Petty Bag.^q The writ sets out the petition of the Patentee and the grant of the Letters-patent, with the conditions it contained. It then proceeds to the suggestion of various grounds on which the Patent is void. These suggestions are substantially the same with the pleas in an action for infringement.^r A suggestion, that the grant is prejudicial and inconvenient to the Queen's subjects in general, is so far insufficient in precision that evidence will not be allowed to be given under an issue taken on it.^s The prosecutor may get rid of any suggestion in the writ by entering a *nolle prosequi*^t as to it, either at the time of declaring or subsequently. The suggestions are followed by allegations as to their effect on the validity of the Patent.^u After stating the defendants' claim to interest in the Letters-patent, the writ concludes with a command to the sheriff to summon each of them to appear in Chancery and show cause why the Patent should not be revoked.

Direction of the writ.

On the theory that the record on which the writ was founded remained at Westminster, the old practice was to direct the writ first issued to the sheriff of Middlesex,^v and on the return of *nihil* by the sheriff to that writ, to issue a second, called a *testatum* writ, directed to the sheriff of the county in which the defendant resided. The writ may, however, now be directed in the first instance^w to the sheriff of any county of England or

^q Bro. Abr. *Scire Facias*, pl. 8.

^r See Chapter IX. Hindm. 389.

^s *R. v. Arkwright* (1785), spinning machinery, Dav. Pat. Cas. 79; Web. P. R. 74, per Buller, J.

^t For Form of *Nolle Prosequi* as to some of the Suggestions after Declaration and before Plea, see Hindm. 718.

^u For forms of *scire facias*, see Abbott's Forms of Writs on the Common Law Side of the Court of Chancery, Form 87; Hindm. 170.

^v Hindm. 388.

^w Foster on *Scire Facias*, 254; 12 & 13 Vict. c. 109, s. 29.

Wales in which the grantee or grantees resided at the date of the Letters-patent.

The writ, before issuing, is to be sealed with the Chancery Common Law Seal,^x in the custody of the Clerk of the Petty Bag.^y It may be issued and tested in term time or vacation,^z and must be tested or dated on the day on which it is sealed;^a after which it will be given to the prosecutor's solicitor, by whom it must be taken to the sheriff to be executed.

Sealing the writ.

A summons is then sent to the defendant by the sheriff,^b in pursuance of the writ, informing him that it has issued, and warning him to appear to it.^c A copy of the writ and summons left at the defendant's last known dwelling or place of business is good service.^d In case of the grantee or grantees not residing in the United Kingdom, it is sufficient to file the writ in the Petty Bag Office, and serve notice thereof in writing at the last known residence or place of business of such grantee or grantees.^e

Service.

* Stat. 12 & 13 Vict. c. 109, s. 14. The writ was formerly sealed with the Great Seal. Hindm. 390. By Stat. 12 & 13 Vict. c. 109, s. 11, it is provided, that there shall be provided a seal, to be called "The Chancery Common Law Seal," of which all Courts, tribunals, judges, justices, officers and other persons shall take notice and receive impressions in evidence, in like manner as impressions of the Great Seal are received. By sects. 12 and 13, certificates of enrolment and office copies of documents sealed with such seal are to be admitted as *prima facie* evidence of such enrolment and as true copies of such documents.

^y New Orders in Chancery, 1849, No. 4.

^z Stat. 12 & 13 Vict. c. 109, s. 26.

^a New Orders in Chancery, 1849, No. 6.

^b For Form of Sheriff's Warrant to his Bailiffs to summon the Defendant, see Hindm. 716; and notes to *Underhill v. Devereux* (1682), 2 Wms. Saund. 67 b—72 lh, containing a store of learning on the head of *scire facias* generally.

^c Godson, 271; Tidd's Pr. 1158—1172.

^d *Weatherhead v. Landles* (1836), 3 Scott, 407; 5 Scott, 189.

^e Stat. 15 & 16 Vict. c. 83, s. 35.

Return of the
sheriff.

Scire feci.

The sheriff, having summoned the defendant, returns *scire feci*.^f In the event of his neglecting to make such return, a rule of Court, obtainable on application at the Petty Bag Office, will compel him to do so. Where the sheriff returns *scire feci*, the Court will not, it is said, inquire upon motion into the validity of the summons, but will leave the party moving to his action against the sheriff for a false return.^g If the defendant be not summoned (it is not absolutely necessary that he should be), the sheriff returns *nihil*.^h Appeals by or on behalf of any defendant who has been summoned by the sheriff must be entered within eight days after the writ has been returned and filed.ⁱ

Nihil.

Return of the
writ.

The writ is returnable into Chancery wherever the Court may be on the return day.^k It may, however, be made returnable into any of the Superior Courts of Common Law,^l it being enacted by 12 & 13 Vict. c. 109, s. 27, "that every writ, of any description whatsoever, hereafter to be issued out of the said Office of the Petty Bag, whether the same shall or may be returnable and returned on any day certain, to be in such writ mentioned (not being a Sunday, Good Friday or Christmas Day), whether such day shall be in term time or in vacation, or forthwith after the execution thereof; and every such writ which shall be made returnable or returned on any day in vacation, and which, according to

^f Tidd's Pr. 1092.

^g 2 Wms. Saund. 72 y, citing *Barr v. Satchwell*, K. B., 2 Geo. II., 2 Str. 813. See, however, *Pool v. Wills*, 2 T. R. 758; *Webb v. Harvey*, *Ibid.* 757.

^h *R. v. Eston*, Dyer, 198, a.; Foster on *Scire Facias*, 256.

ⁱ Orders in Chancery, 3rd August, 1849, No. 19.

^k *Ubiunque tunc fuerit*. For Form of Rule to return the writ, see Hindm. 390, 717; *R. v. Hare*, 5 Geo. I., 1 Strange, 146. But when made returnable wheresoever the Chancery should be in *Great Britain*, it was held bad. *Ibid.*, and see *Sir C. Moore's case*, 1 Stra. 153.

^l *Brewster v. Weld* (1705), Q. B., rectory of *Aldgate*, 6 Mod. 229; Jenkins' Rep. 134, 3rd Cent. pl. 74; Stat. 12 & 13 Vict. c. 109, s. 27.

any present law or usage or practice of or in the said Office of the Petty Bag, ought to be made returnable or to be returned on some day in term time, shall be of the like validity, force and effect, as if the day upon which the same writ shall or may be returned or made returnable was actually a day in term time: provided always, that in every case in which any particular period of time ought to elapse between the *teste* and return of any writ, such writ, if made returnable forthwith after the execution thereof, shall be returned immediately after the execution thereof and after such period shall have elapsed."

Within eight days after the return and filing of the writ the defendant must enter an appearance.^m If the defendant does not appear, judgment by *nil dicit* may be signed against him, and the Patent will be avoided.ⁿ Provided, however, the writ has been duly returned, the more prudent course for the prosecutor, before proceeding to sign judgment against him by default of appearance, would be to give him notice of the writ; otherwise, if he could show to the Court that he had had no notice of the proceedings, the judgment would probably be set aside, and he would be let in to plead and defend the action.^o Upon the return of the writ it is the practice to enter a rule to answer. It is the only rule necessary to compel the defendant to plead, as the defendant answers upon the writ.^p It seems that judgment signed without entering such rule might be set aside.^q

Immediately upon the appearance^r of the defendant the prosecutor may deliver his declaration. The decla-
The declara-
tion.

^m General Orders in Chancery, 1849, No. 19.

ⁿ Vin. Abr. *Sci. Fa.* Prerog. X. 6; Bro. Abr. Patents, 20; *R. v. Toly*, Dyer, 197 b; *Hunt v. Coffin*, Ibid.; *R. v. Blage*, Ibid.; *R. v. Eston*, Dyer, 198 a; *Penwarren v. Thomas*, Ibid.; *R. v. Amery*, 2 T. R. 515, 554, 567.

^o Hindm. 392.

^p For Form of Rule to answer, see Hindm. Pat. 718.

^q *R. v. Newcastle-upon-Tyne*, 1 Sand. Ord. in Chanc. 390.

^r Stat. 12 & 13 Vict. c. 109, s. 30.

ration^s sets out the writ, the return of the sheriff, and the appearance of the defendant. It then proceeds to aver the various grounds of invalidity in the Patent, and concludes with a prayer for judgment by the Attorney-General, with a view to cancellation of the Patent.

Notice of objection.

With his declaration the prosecutor must deliver a notice of the objections^t on which he means to rely at the trial. The notice being substantially the same with that given by a defendant in an action for infringement, the requisites of such notice will be found under that head in the Chapter on the Action for Infringement.

Time to plead.

The defendant has eight days from the delivery of the declaration to plead.^u An extension of time may be obtained on application to the Master of the Rolls or one of the Judges of the Superior Courts.^x If he fail to plead within such time, judgment may be signed against him by default.^y The defendant must plead or demur to all the suggestions^z in the declaration. He may plead to some and demur to others. He may plead in abatement or in bar.^a If there be several defendants they may sever in pleading, one demurring the other pleading. In such a case the Attorney-General may try which issue he pleases first.^b

Pleas.

The defendant's pleas and demurrers may be prepared

^s For Form of Declaration, see Abbott's Forms of Writs on the Common Law Side of the Court of Chancery, 97, Form 90; Hindm. on Pat. 717. According to *Blake v. Dodemeat*, 13 Geo. I., 2 Stra. 776, it seems questionable whether there be any declaration on a *scire facias*. The plea, it was there argued, "is to the writ, and *narratio* and *breve* are in this case the same."

^t Stat. 5 & 6 Will. IV. c. 83, s. 5.

^u Foster's *Sci. Fa.* 259.

^x Stat. 12 & 13 Vict. c. 109, s. 39; *R. v. Nickels*, Hindm. 396.

^y Hindm. on Pat. 396.

^z *Sir Oliver Butler's case*, 3 Lev. 221; 2 Tidd's Pr. 8th ed. 1144; Com. Dig. Patent, F. S.

^a *R. v. Betts* (1850), Q. B., bottles, 19 L. J. (N. S.) Q. B. 531; 15 Q. B. 547; *R. v. Hare* (1719), 1 Stra. 146.

^b *R. v. Hare*, 6 Geo. I., 1 Stra. 266.

by the defendant or his solicitor,^c and are to be delivered to the prosecutor, and not to be filed as before in the Office of the Petty Bag.^d Special pleas require to be signed by counsel. If the defendant plead several matters, the pleas will be set aside for irregularity.^e

In *scire facias* against A. and B. for the repeal of a Patent granted to both, A. cannot plead in abatement that B. assigned all his share and interest in the Patent to A. before the writ was sued out, and has not since had any interest therein.^f If in fact a party having no interest is joined in order that he may collusively prejudice another defendant, application should be made to the Court for remedy as against abuse of process.^g In *R. v. Betts* an unreported case was cited by the Attorney-General from counsel's brief and notes in the cause, in which the writ stated, without any objection being taken on the point, that judgment had passed against one party, and called upon others to show why the Patent should not be vacated as to them and so far as their interests were concerned. "The Crown," said the Lord Chief Justice, "has a right to call upon those who obtained the Patent to show cause why it should not be cancelled. The suggestion is, that the Queen has been deceived—whom should the writ call upon but those who are supposed to be guilty of the deception?"^h

With regard to the more ordinary applications of the writ, it is laid down that a general allegation of non-tenure is no plea in a *scire facias* upon a fine,ⁱ or to have execution in a personal action; and generally, that

^c Stat. 12 & 13 Vict. c. 109, s. 24.

^d *Ib.* s. 31.

^e *R. v. Nickels*, M. R., Hindm. 400, 430; *R. v. Archbishop of York*, Willes, 533.

^f *R. v. Betts* (1850), bottles, 15 Q. B. 541.

^g S. C., per Lord Campbell, C. J., and Erle, J.

^h *R. v. Betts* (1850), bottles, 15 Q. B. 541. The case was that of *R. v. Hamilton*, tried about three years before in the Queen's Bench.

ⁱ Com. Dig. *Abatement* (F. 14), and see Rast. Ent. 365.

if a writ abates by plea of matter of fact against one, it does not abate as to others. If in a *præcipe quod reddat* against two, one pleads non-tenure and the other takes the whole tenancy on himself, the writ will stand good as to that other, because there is a proper defendant.^j

The prosecutor may of course demur to any of the defendant's pleas if they are insufficient in Law.^k As the pleas generally simply traverse the suggestions of the writ, the common joinder in issue is usually the only replication required. The prosecutor's demurrer or replication may be prepared either by himself or his solicitor, and must be delivered to the defendant or his solicitor.^l

Issue.

The issue may be made up and delivered by either party or his attorney to the opposite party or his attorney. Formerly, as above stated, when there were issues of Law and fact in the Petty Bag Office, the whole record was sent into the Queen's Bench for determination, as there could not be a judgment of the Chancellor upon one part of the record, and a judgment of the Queen's Bench as to another part of the same record.^m By Stat. 12 & 13 Vict. c. 109, the issue is in all cases to be sent into one of the Superior Courts of Common Law. The record of the issues must be made up and filed in the Office of the Petty Bag.ⁿ A transcript from the record containing the issues is then sealed with the Common Law Chancery seal, and delivered out to the prosecutor or his attorney, by whom it is taken to the Court of Common Law,^o and there filed. In the case of the Queen's Bench, the filing takes place in the Crown Office. The transcript is a sufficient record to enable the Court of Common Law to give judgment.^p Another

The record.

^j 1 Bac. Abr. 20 (7th ed.), *Abatement* (L.) in marg.

^k Hindm. on Pat. 401.

^l 12 & 13 Vict. c. 109, s. 31.

^m *Smith v. Upton* (1843), C. B., 6 M. & G. 258, n. (a).

ⁿ Stat. 12 & 13 Vict. c. 109, s. 33.

^o *Ib.* s. 32.

^p *Bynner v. R.* (1846), 9 Q. B. 551.

record, setting out the Chancery record, is then made out, and the cause is set down in the usual manner.^a

Proceedings may be taken and trial had either in term time or vacation^r in any one of Her Majesty's Superior Courts of Common Law. The name of the Court fixed on by the party applying to have the writ sealed^s must be endorsed on the writ, and a memorandum thereof entered with the Clerk of the Petty Bag, before any further proceedings are taken in the action.^t The Court may issue a commission to examine witnesses.^u

Proceeding to trial.

If the prosecutor be guilty of delay in carrying the cause to trial, he will, on application being made to the Court,^x have to pay costs.^y The Attorney-General's warrant for a *tales*,^z obtainable as of course,^a should be procured by each party. If no *tales* be prayed and the cause goes off for want of a jury, neither party is liable to pay costs. The defendant is not bound to make use of the warrant.^b

Delay.

Notice of trial must be given according to the practice Notice of trial.

^a Abbott's Forms, &c. 105; Stat. 15 & 16 Vict. c. 76, s. 102; Corner's Cro. Pr. 99—128.

^r Stat. 12 & 13 Vict. c. 109, s. 27; *Ex parte King*, 1 Sand. Ord. in Chanc. 355.

^s General Orders of Chancery, 3rd Aug. 1849, No. 13.

^t *Ibid.* No. 14.

^u As to the practice with respect to issues transmitted from Chancery to the Queen's Bench for trial, see Mr. Hardy's note in the Second Appendix to the Seventh Report (1846) of the Deputy Keeper of the Public Records, 277. See also *Bourdeaux v. Rowe* (1835), 1 Bing. N. C. 721; *Hargrave v. Hargrave* (1847), 4 C. B. 654.

^x *R. v. Dyle*, 7 T. R. 661; *R. v. Macleod*, 2 East, 202; *R. v. Masters*, Parker, 51; *R. v. Banks*, 6 Mod. 247.

^y Corner's Crown Pr. 141; *R. v. Bartrum*, 8 East, 269; *R. v. Waring*, 5 T. R. 454.

^z 2 Hawk. c. 41, s. 18; *Varni v. ———*, 1 Lev. 223; Corner's Cro. Pr. 142.

^a Hindm. 411.

^b *R. v. Righton* (1765), K. B., 3 Burr. 1695.

of the Court^c in which the issue is to be tried.^d Notice to admit documents proposed to be used as evidence on the trial should be also given.

The trial.

The trial may be either at bar or *Nisi Prius*,^e as the Court shall think fit, and either by special or common jury. Being on a record it must be tried in Middlesex.^f

Right to begin.

The defendant is entitled to begin and give evidence in support of his Letters-patent.^g The defendant cannot demur to the evidence for the Crown, unless by consent of the counsel for the Crown; if that be refused, the Court ought to direct the jury to find the special matter

Right to reply.

upon which the Law may afterwards be adjudged.^h If evidence is adduced by the prosecutor impeaching the validity of the Letters-patent, the defendant is entitled to the reply.ⁱ

Evidence.

The remarks on the evidence in actions for infringement in the next chapter will be found to include that in cases of *scire facias*. The prosecutor must show that the Patent is void on some one of the grounds contained in the suggestions.^k

Notice of objection no part of the record.

The notice of objections in *scire facias*, although part of the transcript sent from Chancery, is no part of the record in a Court of Common Law, so as to form parcel of the issues to be tried, nor can it be resorted to for the purpose of narrowing any of the issues to one claim.^l

^c Abbott's Forms, &c. 101.

^d Stat. 12 & 13 Vict. c. 109, s. 24. For forms of *subpœna ad testificandum*, see Corner's Cro. Pr. App. 198.

^e Stat. 12 & 13 Vict. c. 109, s. 32. See Stat. 17 & 18 Vict. c. 125, s. 1.

^f 2 Chitty, P. C. 337.

^g Stat. 15 & 16 Vict. c. 83, s. 41.

^h *Baker's case*, 5 Co. 104 a; *Middleton v. Baker*, Cro. Eliz. 752; Co. Litt. 72 a; *Fitzharris v. Boiun*, 1 Lev. 87; Doct. Plac. 119.

ⁱ Stat. 15 & 16 Vict. c. 83, s. 41.

^k *R. v. Cutler* (1847), Q. B., tubular flues, 3 C. & K. 215.

^l *R. v. Mill* (1850), C. B., instruments for marking, 1 L. M. & P. 695.

A count in a *scire facias* contained suggestions of want of novelty and utility in a certain part of the invention. The objections filed with the declaration pointed out the sixth claim in the Specification as wanting novelty and being useless. The pleas traversed all the suggestions in the count. After issue joined, a disclaimer was entered by the defendant. It was held that the disclaimer was receivable in evidence, and that being received, the defendant was entitled to a verdict upon all the issues.^m

Disclaimer receivable in evidence.

Effect of.

If issue be taken upon each of several suggestions in the writ, a verdict on any one of them entitles the Crown to judgment.ⁿ It was held that other issues being then immaterial, the judge may properly discharge the jury from returning a verdict upon them. If the jury cannot agree, the judge at *Nisi Prius* has power to discharge them.^o If the jury think the case doubtful, they must find for the defendant.^p

Verdict.

The Clerk of the Petty Bag, upon receiving the return of the transcript of the verdict of the jury and proceedings or judgment of any Court of Common Law upon any issue in law or in fact, is to file the same in the Petty Bag Office, and is to cause an entry to be made of such verdict and proceedings or judgment, and such transcript is to be annexed to the original record in the Petty Bag Office; and thereupon the judgment of the Court of Common Law is to be entered on or annexed to the same record, in conformity with the judgment of the Court from which the transcript is returned.^q

Proceedings after verdict.

The Court in which the action is tried has power to *Nisi Prius*.

^m *R. v. Mill* (1850), instruments for marking, 10 C. B. 379.

ⁿ *R. v. Johnson* (1836), Exch. Ch., *Quo warranto* Office of Alderman of London, 5 A. & E. 488, *Eastern Archipelago Company v. A.* (1853), Exch. Ch., 1 C. L. Rep. 145.

^o *Cook v. Caldecott* (1830), N. P. Trover, 4 C. & P. 315; but see *Tolson v. Kaye* (1843), 6 M. & G. 589.

^p *R. v. Cutler* (1847), Q. B., tubular flues, 3 C. & K. 215.

^q General Orders, No. 8, 3rd Aug., 1849.

grant a new trial^r on payment of costs.^s If the trial be had in vacation, motion for a new trial must be made within the first four days of term.^t If a rule *nisi* be granted, but judgment has been regularly signed on the ground that notice of motion was not given pursuant to Reg. Gen. Mich. 12 Vict., the party obtaining the rule cannot be heard in support of it while the judgment stands.

Judgment for
the Patentee.

If the Patentee be successful in the Court of Common Law, final judgment is entered up in that Court, nothing remaining to be done in the Court of Chancery.^u

If judgment be given for the Crown, and the defect in the Patent prove such as the remedies provided by Stat. 5 & 6 Will. IV. c. 83, can repair, application should be made to the Court to suspend judgment.

Judgment.

If unsuccessful, the defendant may move in arrest of judgment,^x or the prosecutor for judgment *non obstante veredicto*. Application should be made to the Master of the Rolls to stay the entry pending such motion.

It has been doubted whether the defendant is entitled to tender a bill of exceptions^y in any case where the

^r The first case of a new trial found in the books is that of *Wood v. Gunston* (1665), Styles, 462. See, as to misdirection, *Yarmouth v. Durrell*, 1 & 2 Jac. II., monopoly printing blank writs, 1 Vern. 77; *Wullington v. Dale* (1852), Exch., gelatine, 19 L. T. 187.

^s Hullock on Costs, 396; *R. v. Arkwright* (1785), Dav. P. C. 141; *R. v. Wheeler* (1819), 2 B. & Ald. 345; *R. v. Bynner* (1846), 9 Q. B. 529; *R. v. Bewdley* (1712), 1 P. Wms. 207. This was after a trial at bar in the Crown Office of the Court of Queen's Bench.

^t *R. v. Macleod* (1816), 3 Price, 203. A new trial was granted on the grounds that the verdict was against the direction of the Court.

^u The King's Warrant before alluded to expressly reserved power after conviction to suspend the entry of any judgment to vacate the Patent.

^x *Eastern Archipelago Company v. R.* (1853), Exch. Ch., 1 C. L. Rep. 145.

^y Hindm. 413; and see the correspondence (1711) between the Lord Keeper and the Lord Chief Justice, there cited; *R. v. Archbishop of York*, Willes, Rep. 535, and cases there cited; *R. v. Cutler* (1847), Q. B., tubular flues, 3 C. & K. 215; 2 Inst. 427.

Queen is a party, the Crown not being expressly named^z in the Statute which gives the Bill of Exceptions (13 Edw. I. c. 31, Statute of Westminster the Second).

Error lies from the judgment of the Court of Chancery in the Petty Bag Office to the House of Lords,^a and from the Court of Common Law to the Court of Exchequer Chamber.^b When judgment is given in Chancery upon a demurrer, a writ of error, it is said,^c lies to the Queen's Bench to revoke such judgment for errors of process or errors of fact, as error *coram nobis* lies for errors of process or in fact in judgments given in the Court of Queen's Bench.^d It would appear, however, that writs of error upon judgments in Chancery for errors of fact or in process *may* be made returnable in Chancery. For errors in Law the appeal is direct from the Court of Chancery to the House of Lords.^e

Writ of error.

Writ of error on demurrer.

The contest for the jurisdiction and formalities^f attendant on the revocation of Letters-patent invalidated by *scire facias* have been already alluded to.^g In the case of *R. v. Steiner*,^h after three formal citations, the defend-

Cancellation of the Patent.

^z 2 Hawk. P. C. c. 46, § 20; *R. v. Vane*, 1 Sid. 85; Kel. 15; 1 Keb. 32; 1 Lev. 68; Foster, *Sci. Fa.*, bk. ii. c. 7.

^a The fiat of the Secretary of State for the writ must be obtained, Abbott's Forms, 45. See note to *Smith v. Upton*, 6 M. & G. 257.

^b *Bynner v. R.*, 9 Q. B. 523; *Eastern Archipelago Company v. R.* (1853), Exch. Ch., 1 C. L. Rep. 145.

^c *Smith v. Upton* (1843), C. B., lamp, *Bynner's Patent*, 6 M. & G. 257. See cases on all these points cited, *ibid.* 258. See *Jefferson v. Dawson*, temp. Chas. II. 1 Siderf. 436, and notes to *Jeffreson v. Morton*, 2 Wms. Saunders, 6.

^d *Countess of Pembroke's case*, 42 Ass. fo. 262, pl. 22; *Dewkes v. Peyton*, Style's Rep. 218.

^e Bro. Abr. *Error*; Macqueen, Pr. House of Lords, 371.

^f See Hindm. 313; *R. v. Toly*, Dyer, 1976; *R. v. Blage*, *ibid.*

^g *Supra*, p. 177, *Baron de Bode's case*, 8 Q. B. 208; *The Baron de Bode v. R.* (1649), 13 Q. B. 380; *Jeffreson v. Morton*, 2 Saund. 6 a, 27; and see Corner's Crown Practice, 252; Tidd's Practice, 9th ed. 1095; 1 Eq. Ca. Abr. 128; *R. v. Newton* (1845), Hindm. 426; 5 L. T. 261, cited 9 Q. B. 528.

^h (1852) L. C., 18 L. T. 267.

ant not appearing, entry was made of his default, and an order made that the defendant should show cause on a day named why in default of the production of the Letters-patent the enrolment should not be vacated, and an attachment issue for the commitment of the defendant. The Patent was subsequently brought into Court. In *R. v. Bynner* interlocutory judgment was entered at the Crown Office and signed by one of the Masters on the Nisi Prius Record. The continuance and verdict, together with a judgment thereon drawn and settled by counsel, were entered by the attorney on the Queen's Bench Roll, and a transcript was then made and returned into Chancery.^f In the case of *Nichel's Patent*,^g the question of cancellation after judgment on *scire facias* came before the House of Lords, but the case being compromised, no decision was given.^h The Petty Bag Amendment Act confers upon all the Courts of Common Law the power "to give judgment and execute judgment as the Court of Queen's Bench might have done," without at all stating what that power was. Filing being substituted for enrolment in the case of the Specification, and the Attorney-General's warrant filed in the Office of the Commissioners alone retaining the form of the grant, the practice in future will probably be somewhat similar to that of removing a bill from the file.

Costs.

As a general rule the Crown neither pays nor receives costs.ⁱ If, however, in a *scire facias* to repeal a Patent, judgment be given for the defendant, the prosecutor will have to pay the costs of the action, according to the

^f Corner's Crown Practice, 202.

^g (1841) 1 Phil. 36.

^h Corner's Cr. Pr. 202.

ⁱ Statutes 8 & 9 Will. III. c. 11, s. 3, and 3 & 4 Will. IV. c. 42, s. 34, which give costs of *scire facias*, are held to apply only to civil suits, where there are plaintiff and defendant.—Foster on *Scire Facias*, 276; *R. v. Miles* (1797), *lamp*, 7 T. R. 367.

terms of the bond. If after action commenced the defendant render his Patent valid by the entry of a disclaimer, he will be entitled to the costs of the action subsequently to such entry.^k

Every attorney or party practising on the Common Law side of the Court of Chancery is entitled to the same charges as are allowed to attornies or parties for business of a similar nature in Her Majesty's Superior Courts of Common Law.^l By section 37 of the Stat. 12 & 13 Vict. c. 109, it is enacted, that "in all cases where any party shall be entitled to the costs of any such issues or of any other proceedings or matters provided for by this Act in any of the said Courts, such costs shall be taxed and regulated by one of the Masters of the said Court respectively, who shall endorse his *allocatur* on the rule or order, as the case may be, or upon the *postea*, before the same shall be taken or returned into the Court of Chancery as aforesaid."

The costs of motions and interlocutory proceedings are often granted by the Court. In *R. v. Nickels*,^m Lord Langdale, M. R., granted the costs of an application to set aside an irregular plea; and in *R. v. Crawford*,ⁿ Lord Lyndhurst, L. C., granted the prosecutor his costs of opposing a motion to rescind an order of the Master of the Rolls. The order of the Court of Chancery may be enforced as a rule of Court under Stat. 1 & 2 Vict. c. 110, s. 18.^o

Of motions.

^k *R. v. Mill* (1851), M. R., instruments for marking, 14 Beav. 315.

^l Stat. 12 & 13 Vict. c. 109, s. 25.

^m Hindm. on Pat. 430.

ⁿ *Ib.*

^o Foster on *Scire Facias*, 89.

CHAPTER IX.

ACTION FOR INFRINGEMENT.

What infringement is.

WHAT has been already said as to the subject matter of a Patent may serve to show the principles which determine the acts constituting infringement on the right. The privilege consists in the monopoly of an article of commerce created or improved by the Patentee. Any act, therefore, which interferes or tends to interfere with this monopoly, is an infringement.

Sale is infringement.
Manufacture.

Actual sale of a counterfeit of the patented article is of course an infringement.^a The manufacture of it for the purposes of trade in the mode prescribed by the Specification,^b even although it be confined to a single instance, is also an infringement.^c It seems difficult, therefore, to supply the grounds on which "exposure for sale," which presupposes its manufacture for the purposes of trade, should be excepted^d from that category. The adoption of any one of the material improvements effected by the Patentee, where several such are included in the invention, is an infringement,^e as also, it would appear from a remark of Tindal, C. J.,

^a *Gibson v. Campbell* (1842), silk, 11 J. (N. S.), C. B. 177.

^b *Huddart v. Grimshaw* (1803), rope, Web. P. R. 102; *Crossley v. Beverley* (1829), gas apparatus, 1 Russ. & Myl. 166, n.; Web. P. R. 119. See, however, *Delondre v. Shaw* (1828), sulphate of quinine, 2 Sim. 213.

^c *Gillett v. Wilby* (1839), N. P., cab, 9 C. & P. 334.

^d *Minter v. Williams* (1835), K. B., chair, 1 Carp. 647; 4 Ad. & El. 251.

^e *Newton v. Grand Junction Railway Company* (1845), Ex., iron axles, 5 Ex. 331; *Sellers v. Dickinson* (1850), Ex., power-loom, 5 Ex. 312.

in *Gibson v. Brand*, is the ordering such goods to be made by the process of the Patentee.^g A making, however, for private use, somewhat within the limits established in the decisions on Stat. 5 Eliz. c. 4, or for the purpose of amusement or scientific pursuits,^h would seem to be excepted, the wrong done to the Patentee by an infringer consisting *quasi in tradendo*, or delivering over for sale.ⁱ

Making for private use.

Piracy of the invention, however, in the exact shape laid down in his Specification by the Patentee, is not the usual shape in which infringement on his rights occurs. More frequently it is that of a modification of the means prescribed, and necessarily involves for its determination a knowledge of *what constitutes the essence of the invention*.^k This manifestly must depend upon the circumstances of each case. In some, a mere hint at the idea developed by the Patentee would enable a scientific and practical person to effect the desired end, by a variety of means; in others, the invention consists in an elaborate arrangement of details, and can scarcely be said to be founded on any single idea. In the former, the attention must be fixed on the principle, in the latter, on the material parts of the machine or substance produced, in determining the question of infringement.

Infringement by variation of the invention.

In a Patent for the means of stopping power-looms when the shuttle stopped in the shed, the principle of the invention was to transfer the momentum of the slay

Principle the essence.

^g "The old rule clearly applies, *qui facit per alium, facit per se*" (1841), N. P., silk, 4 M. & G. 179; Web. P. R. 627. See also *Electric Telegraph Company v. Brett* (1851), 10 C. B. 838.

^h *Jones v. Pearce* (1832), wheel, Web. P. R. 125.

ⁱ 8 Rep. 129; Vin. Abr. "Trade" (B.); Bac. Abr. "Master;" *Waggoner v. Fish* (1610), C. B., candles, 2 Brownl. 289; *Hobbs v. Young* (1690), K. B., cloth, Carthew, 162. See per Story, J., *Whittemore v. Cutter*, 1 Gall. 429.

^k *Gamble v. Kurtz* (1846), C. B., sulphate of soda, muriatic acid, chlorine and chlorides, 3 C. B. 435; *Bramah v. Hurdcastle* (1789), watercloset, 1 Carp. 168.

to a brake acting on the fly-wheel. This was held to be infringed by a machine where the same purpose was effected, by bringing the stop-rod finger into contact with a lever, which, pressing a brake on the fly-wheel, threw the driving strap off the driving shaft.¹ A Patent, the claim for which was the drawing a tube at a welding heat through dies without internal support, was held to be infringed by performing the like act by means of grooved rollers.^k An invention was described as consisting of a mode of forming a wheel of one solid piece of wrought iron, by welding pieces of wrought iron together so as to form the rim, spokes and nave into one compact mass. The defendant used a wheel, forming the nave in the same way; but the mode of forming the rim was different. Held to be an infringement by the defendant, although in the Specification, after describing the whole structure, the invention was stated to consist of the centre, "&c., being composed of iron welded into the solid mass "in manner hereinbefore described."¹

Barber v. Grace. The Specification in the case of "improvements in the process of hosiery and other goods manufactured from lambswool," stated the invention to consist in submitting hosiery and other similar goods "to the finishing process of a press heated by steam, &c. in the manner hereinbefore mentioned." A description was then given with reference to a drawing, which represented a press consisting of a box heated by steam, up to which another box similarly heated was pressed by hydraulic pressure, steam, or other well known means. After describing the method of pressing the goods between the hot boxes, the Specification concluded by confining the inventor's process as above described. It was held, that the adoption of the

¹ *Sellers v. Dickinson* (1850), powerloom, 5 Ex. 312.

^k *Russell v. Cowley* (1833), L. C., gas tubes, 1 Carp. 531. Compare this with *Huddart v. Grimshaw* (1803), rope, Web. P. R. 102, and *Hall v. Booth* (1822), lace, Web. P. R. 100; and see *supra*, p. 83.

¹ *Smith v. London and North Western Railway Company* (1853), Q. B., 2 E. & B. 69.

method of finishing hosiery goods by pressing them through heated rollers was no infringement of the Patent.^m

The defendant's process being an improvement on the Patentee's makes it an infringement none the less.ⁿ The fact that until the introduction of the defendant's improvements the invention of the Patentee was incomplete, and that doubts exist as to its having been capable of being used for any purpose but for such improvements, would, it appears, affect the validity of the Patent rather than the question of infringement on it.^o

An improvement is infringement.

The employment of chemical or mechanical *equivalents* to effect the improvements introduced by the Patentee is an infringement, no matter how ingeniously the exterior of the production may be varied from that of the Patentee's manufacture.^p In *Heath v. Unwin*^q it was held by the judges in the Exchequer Chamber, that not only the use of carburet of manganese itself, but also of its elements, viz., oxide of manganese and carbon, when applied to the manufacture of steel, was an infringement on the Patent.

Use of chemical or mechanical equivalents.

No action can be maintained for infringement committed before the Letters-patent were actually granted,

Infringement before the grant.

^m *Barber v. Grace* (1848), Exch., 1 Exch. 339; 17 L. J. (N. S.), Exch. 122.

ⁿ *Neilson v. Harford* (1841), iron, Web. P. R. 310; *Hancock v. Somervell* (1851), caoutchouc, 39 Lond. Journ. 158.

^o *Sellers v. Dickinson* (1850), powerloom, 5 Ex. 312; *Cochrane v. Brathwait* (1830), engine-boilers, 1 Carp. 493; *Walton v. Potter* (1841), caoutchouc, Web. P. R. 591.

^p See per Gibbs, C. J., in *Bovill v. Moore* (1816), L. C., bobbin net, Dav. Pat. Ca. 405; and per Tindal, C. J., in *Walton v. Potter* (1841); Web. P. R. 594.

^q Ex. Ch. (cast steel), 12 C. B. 522; 16 Jur. 996; *Galloway v. Bleaden* (1839), paddlewheel, Web. P. R. 523; *Crossley v. Potter* (1851), carpets, printed case, p. 61; *Heath v. Unwin* (1845), Ex., steel, 13 M. & W. 583; *Morgan v. Seaward* (1836), eccentric axis substituted for crank carrying a disc, Web. P. R. 171; *Hill v. Thompson* (1817), L. C. 3 Mer. 622; (1818), C. B. 8 Taunt. 393.

except in the case where a complete Specification has been deposited. Yet from the language employed by Campbell, C. J., in the recent case of *Heath v. Smith*, it would appear as if there might be an infringement even before the grant is made. "I wish it to be understood," said his Lordship on that occasion, "that if we had held this Patent to be valid, the five firms which used the process before the Patent was taken out would be liable to an action for infringement of it. There is nothing either in the Statute or in the Patent, or in the decisions, which would have exempted them from that liability."^a The remarks may, however, with greater probability, be construed into a *reductio ad absurdum* of the alternative course to that taken by the decision, than taken as a statement of the results to be anticipated from it; the evidence of public user adduced being amply sufficient to destroy all claim to novelty in the invention.^t

Trade-marks
false analogy.

The subject of Trademarks is one of those before alluded to, as occupying adjacent ground to that of Patents.^u As regards infringement, however, little advantage is derived from the connexion, their intrinsic difference being so great as to prevent any deduction being made from their similarity. A comparison of the decisions in *Minter v. Williams*^x and *Blofield v. Payne*,^y for instance, will show the extent to which the principles of the one have been imported into the other.^z

^a *Heath v. Smith* (1854), Q. B., cast steel made by carburet of manganese, 18 Jur. 603.

^t See *Cornish v. Keene* (1835), per Tindal, C. J. (elastic fabrics), Web. P. R. 44; Stat. 15 & 16 Vict. c. 83, s. 9.

^u Turner on Patents, 12, 110; 3 Steph. Com. 543.

^x (1834) chair, Web. P. R. 137.

^y (1833) K. B., metallic hone, 4 B. & Ad. 410.

^z See Stat. 5 & 6 Will. IV. c. 83. Continental Governments are very careful to preserve clearly the line between privileged and unprivileged traders. The "Zeit," of Berlin, of date January 14, 1854, contains an announcement, that in the Bill for the protection of Trade-marks then under consideration, all stamps were to be prohibited

Flavell v. Harrison^a may be said to be upon the boundary of the two classes of rights. F., without taking out a Patent, manufactured and sold an article, which he termed "F.'s Patent Kitchener." His servant, having surreptitiously obtained lists of his customers and plans of the grate, constructed and sold it under the name of "F.'s Patent Kitchener." It was not, however, proved that he represented the goods sold by him as the actual manufacture of F. On a Bill filed by F. to restrain the defendant by injunction from using F.'s name, the Court refused to interfere summarily, on the ground that the Plaintiff had allowed four months to elapse without taking steps in the matter. The Bill was retained for six months, with liberty to bring an action in the mean time. The confusion thus existing is to be attributed to the defects above observed in the practice of obtaining the grant—Patents being constantly taken out for the mere purpose of puffing the sale of articles destitute of any qualifications entitling them to enter in the rank of "new inventions."

Flavell v. Harrison.

In the mode of protecting their respective rights there is a wide difference between the position of a mere trader and the Patentee. The former may have recourse to a summary proceeding by criminal information for fraudulent representations connected with articles of sale. In

Protection.

which contained any recommendation of the goods, "as, for instance, 'patent,' 'wasanted,' 'very bat' (sic)"! See, for some of the principal decisions as to Trademarks, *Ransome v. Bentall* (1834), Ch., ploughshares, 3 L. J., N. S., 161; *Holloway v. Holloway* (1850), Ch., pills, 13 Beav. 209; *Perry v. Truefitt* (1842), Ch., hair oil, 6 Beav. 66; *Barley v. Walford* (1846), silk goods, 9 Q. B. 197; *Crawshay v. Thompson* (1842), C. B., bar iron, 4 M. & G. 357; *Millington v. Fox* (1838), Ch., steel, 3 My. & Cr. 338; *Motley v. Dowman* (1837), Ch., tin plates, 3 My. & Cr. 1; *Taylor v. Taylor* (1854), V. C. W., Persian thread, 22 L. T. 271; *Burgess v. Burgess* (1853), L. J., fish sauce, 21 L. T. 53; *Knott v. Morgan* (1836), M. R., omnibus, 2 Keen, 213.

^a (1853) V. C. W., stove, 17 Jur. 368; *Edelsten v. Vick* (1853), V. C. W., pins, Eq. R. 413.

a case recently before Lord Campbell,^c the sale by the defendants of a spurious article under the labels of Messrs. A. having been proved, the jury found them guilty of a conspiracy to defraud; his Lordship sentenced them to imprisonment, with hard labour, for one year. A similar case of fraud, tried before Mr. Justice Erle in the summer assizes of 1853, met with a sentence of imprisonment, with hard labour, for two years,^d the indictment being for obtaining money under false pretences.

Remedies for
infringement of
the right.

Infringement of Patent right, as a misdemeanor for which no special punishment^e was appointed either by the Common or Statute Law, was originally cognizable in the Court of Star Chamber, under its general jurisdiction for the repression of "cozenage."^f Its repression was summary and severe.^g In an Ordinance of the year 1650^h it was enacted, with reference to a Patent for boiling liquors, that if any persons should "make use of the said invention in the making of salt, brewing or boiling of liquor, or any other occupation, and proof be thereof made by the oath of two or more witnesses, to be taken before two or more justices of the peace within the county, city, borough, town corporate or privileged place, within the Commonwealth of England or Ireland, where the

^c *R. v. Gray and Goslin*, Alsopp's ale, tried at the Guildhall Sitings, May 17th, 1854; 23 L. T. pt. 2, p. 77.

^d See 23 L. T. pt. 2, p. 91. The subject in this case was Everett's premier blacking.

^e "The punishment of this is arbitrary, as in our Realme, so likewise by the Civill Law, as appeareth by the twentieth Title of the 17th booke of the Digests, and *Wefenbeccius* parat. upon the same." *Star-chamber Cases* (10), printed for John Grove at Furnival's Inn Gate, 1630.

^f "'Cozenage' is an offence whereby any thing is done guilfully in or out of contracts which cannot fitly bee termed by any speciall name. *West. part 2, Symbol. Tract.*" *Ib.*

^g In the case of apprentices or servants of the Patentee attempting to reap the fruits of his ingenuity, they were to be treated as "first rogues and then whipped." *Com. Jour.* May 4, 1614.

^h *Scobell's Acts and Ordinances*, 149 (A. D. 1650).

fact shall be done, which said justices of the peace have hereby power, and are upon complaint required to administer, that then such vessels and works shall be broken and pulled down by warrant of such justices of the peace; and the said George Manby, his executors, administrators and assigns, shall and may bring in his or their action of debt against any person or persons, bodies politique or corporate, offending herein, within any Court of Record, for the penalty of ten pounds lawful English money for setting up of such works, and twenty shillings for every day's using or continuing any vessel or work by the said George Manby invented as aforesaid."

Until very recently the remedy of the Patentee in case of infringement was dilatory and expensive, involving the double procedure of an action at Law for the damages sustained from the invasion, and a suit in Equity for an injunction to restrain the illegal use of the invention and an account of the profits already made by the infringer from such use.ⁱ Even so the redress afforded seldom proved equal to the injury sustained by the Patentee.^j It formed, however, his only means of protection, and could not with any degree of safety be dispensed with if the fact of infringement were brought to his notice.^k The improvements introduced by the recent enactments in Law and Equity are, it will be seen, very considerable.

Remedy of Patentee by action for damages.

An action for damages in general will lie, although no Damage.

ⁱ Chitty, P. C. ch. x. § 2; Mitford's Chan. Pleadings, 124.

^j On the occasion of his introducing the Patent Law Amendment Bill, 1835, in the House of Lords, Lord Brougham observed, that of his own knowledge, "stock purses were not unfrequently made by those who pirated an invention of the kind, to harass the inventor with actions in Courts of Law and Equity, and driving him to despair, to carry off the fruits of his skill and labour." (28 Hansard, 475.) The cost of defending *Muntz's* (ship-sheathing) Patent is stated to have exceeded 10,000*l.* As to the loss from irresponsible infringers, see *supra*, p. 82.

^k See *supra*, p. 217, Hindm.

Intention.

specific damage is alleged,¹ and although the infringement has not been intentional on the part of the defendant,^m if *any* damage have been sustained by the plaintiff.ⁿ In *Heath v. Unwin*, the Court seemed to think it material to inquire into the intention of the defendant. The evidence in that case, however, negatived any such intention.

Parties to the action.
Plaintiff.

The party whose legal interest has been affected is the proper Plaintiff in an action for infringement. The right of action, however, not being assignable, an assignee can sue only for infringements committed subsequently to the assignment.^o A proprietor under the Patent may sue solely for the injury done to his interest under it. The assignees of Letters-patent, in respect of which a Disclaimer has been enrolled by a grantee not at the time possessing the entire interest in the Patent, may maintain an action for infringement.^p A Patentee and Licencee may be co-plaintiffs, as having an entire joint damage, although their interests are several.^q A mere Licencee, however, not being able, covenants should be in the deed of licence enabling him to sue in the inserted name of the Patentee for the damages he has sustained.

¹ *Rochdale Canal Company v. King* (1849), Ex. Ch., 18 L. J., Q. B., 293; *Rodgers v. Nowill* (1847), C. B., cutlery, 17 L. J. (N. S.), C. B., 52; 5 C. B. 109; 6 Hare, 325; *Sykes v. Sykes* (1824), K. B., shot-belt, &c., 3 B. & C. 541.

^m See Turner on Patents, 73, 108; *Heath v. Unwin* (steel), 13 M. & W. 593; 14 L. J. (N. S.), Ex., 153 (1847), 15 Sim. 552; 16 Jur. 996; 22 L. J. (N. S.), C. P., 7.

ⁿ Per Wilde, C. J., *Stead v. Anderson* (1847), wood-paving, 16 L. J. (N. S.), C. P., 251.

^o Brown on Parties to Actions, 213. As to misjoinder or non-joinder of plaintiffs, see Stat. 15 & 16 Vict. c. 76, ss. 34—36; Archb. N. Pr. 23; 1 Saund. 291 f, g.

^p *Spilsbury v. Clough* (1842), chloride of lime, 2 Gale & Dav. 17; 6 Jur. 579; Web. P. R. 255; *Bovill v. Moore* (1816), C. B., bobbin net, Dav. Pat. Ca. 361; 2 Marsh. 211.

^q *Coryton v. Lithebye*, 22 Car. II. (1670), 2 Saun. 115. See 2 Vin. 55, pl. 46.

The defendant must be the person infringing the Patent. Foreigners in this country infringing on Patents granted by the Crown according to the Law of this country are equally liable with British subjects to actions for such infringement.^r If several persons commit a joint infringement, the plaintiff may sue all or any of them at his election. The person physically using the invention, and not the person giving instructions and plans which include its use, is the party to be sued,—the contractor, for instance, and not the architect, in the case of a contrivance employed in housebuilding.^s No objection can be taken on the score of misjoinder or non-joinder of defendants. In the former case the party misjoined will of course be entitled to a verdict.^t An application to compel the plaintiff to give security for costs must, in ordinary cases, be made before issue joined.^u

Defendant.
Foreigners in
this country.

Security for
costs.

If there be two or more plaintiffs or defendants, and one or more of them should die, if the cause of action survive to the surviving plaintiff or plaintiffs, or against the surviving defendant or defendants, the action does not thereby become abated; but such death being suggested on the record, the action may proceed at the suit of the surviving plaintiff or plaintiffs against the surviving defendant or defendants.^x In the case of the death of a sole plaintiff, the suit may be continued by his legal representative;^y in that of a sole defendant, where the action survives, by service on the executor or administrator of a copy of the writ, and suggestion of the death of such defendant.^z The death of either

Death of plain-
tiffs or defend-
ants.

^r *Caldwell v. Vanvlissingen* (1851), V. C. T., screw-propeller, 9 Harc, 415.

^s *Denley v. Blore* (1851), N. P., Jervis, C. J., fireplace flues, 38 Lond. Journ. 224.

^t Archb. N. Pr. 27.

^u General Rules, Hil. Term, 1853, No. 22.

^x Stat. 15 & 16 Vict. c. 76, s. 136; Archb. New Pr. 303.

^y Stat. 15 & 16 Vict. c. 76, s. 137.

^z *Ibid.* s. 138.

party between verdict and judgment is not to be alleged for error,^u so as such judgment be entered within two terms after such verdict. In the event of the death of any party between interlocutory and final judgment, the suit may be continued by the personal representatives by a writ of revivor.^x Marriage of a feme sole does not cause the action to abate.^y The bankruptcy or insolvency of the Plaintiff is not pleadable in bar to the action, unless the assignees shall decline to continue and give security of costs upon a judge's order to be obtained for that purpose, within such reasonable time as a judge may order, but the proceedings may be stayed until such election is made; and in case the assignees neglect or refuse to continue the action and give such security within the time limited by the order, the defendant may, within eight days after such neglect or refusal, plead the bankruptcy.^z The defendant or person against whom the suit may be so continued may apply by summons to compel the plaintiff or his representative to proceed with the action within such time as the judge shall order; and in default of such proceeding may enter a suggestion of such default and of the representative character of the person by or against whom the action may be proceeded with, and have judgment for the costs of the action and suggestion.^a

Proceedings on
the part of the
defendant.

Declaration.

The Declaration is in case.^b It recites the grant of the Letters-patent, the filing of the Specification,^c the acquisition of the plaintiff's title, and the infringement of the Patent right by the defendant. It is not necessary to aver that any conditions imposed by the Judicial Com-

^u Stat. 15 & 16 Vict. c. 76, s. 139.

^x Ibid. s. 140.

^y Ibid. ss. 141, 142.

^z Ibid. s. 142.

^a Stat. 17 & 18 Vict. c. 125, s. 92.

^b 3 Stephen's Com. 524.

^c *Muntz v. Foster* (1843), Exch., ship sheathing, 7 Scott, N. R. 471.

mittee of the Privy Council have been complied with.^d The breaches should be alleged in the words of the Letters-patent.^e Where a Specification claimed nine several improvements, and the Declaration alleged that the defendant had counterfeited the said 'invention,' it was held that that amounted to charging the using or counterfeiting of the said nine improvements.^f No venue is to be changed without a special order of the Court, unless by consent of the parties.^g The venue.

By the Common Law Procedure Act, 15 & 16 Vict. c. 76, the form of declaration, in case of infringement of a Patent, is prescribed^h to "commence as follows, or to the like effect" :—

[Venue.] A. B. by E. F. his attorney [or in person, as the case may be], sues C. D. for [here state the cause of action].

The statement of cause of action prescribed in the schedule of the Act, c. 76, is as follows :— Statement of cause of action.

That the plaintiff was the first and true inventor of a certain new manufacture, that is to say, of "certain improvements in the manufacture of sulphuric acid," and thereupon her majesty Queen Victoria, by Letters-patent under the Great Seal of England, granted the plaintiff the sole privilege to make, use, exercise and vend the said invention within England for the term of fourteen years from the day of _____, A.D., subject to a condition that the plaintiff should, within six calendar months next after the date of the said Letters-patent, cause to be enrolled in the High Court of Chancery an instrument in writing under his hand and seal, particularly describing and

^d *Ledsam v. Russell* (1848), gas tubes, 1 H. of L. Cas. 687.

^e *Minter v. Williams* (1834), K. B., 4 A. & E. 251. As to declaration on an extended Patent, see *Russell v. Ledsam* (1843), Exch., 11 M. & W. 647.

^f *Electric Telegraph Company v. Brett* (1851), 10 C. B. 838.

^g No. 18, Rules of Practice, Hilary Term (1853). See *Cameron v. Gray* (1795), 6 T. R. 363; 1 Carp. 173, where a rule was refused to change the venue to Northampton; and *R. v. Haine* (1789), L. C., 2 Cox, 235; *Brunton v. White* (1825), 7 D. & R. 103; *Chitty's Forms*, 170.

^h Sect. 59.

ascertaining the nature of his said invention, and in what manner the same was to be and might be performed, and the plaintiff did within the time prescribed fulfil the said condition, and the defendant during the said term did infringe the said Patent right.

The Declaration is to conclude as follows :—

And the plaintiff claims £ [or if the action is brought to recover specific goods,^f the plaintiff claims a return of the said goods or their value, and £ for their detention.]

Inspection.

Previously to framing the declaration it may frequently be desirable for the plaintiff to inspect the defendant's machinery or place of manufacture. Hitherto such inspection has chiefly been granted by a Court of Equity in aid of a trial at Law. Until very recently all such orders by a Court of Equity had been by consent.^g

Courts of Common Law may grant injunction, inspection, or account in case of infringement.

An improvement is introduced into the practice of Courts of Common Law by the Patent Law Amendment Act, 1852, the importance of which it is not easy to overrate. By the 42nd section of that Act it is provided, that, in any action in any of her Majesty's Superior Courts of Record at Westminster or in Dublin for the infringement of Letters-patent, it shall be lawful for the Court in which such action is pending, if the Court be then sitting, or if the Court be not sitting, then for a judge of such Court, on the application of the plaintiff or defendant respectively, to make such order for an injunction, inspection or account, and to give such direction respecting such action, injunction, inspection and account, and the proceedings thereon respectively, as to such Court or judge may seem fit.^h A Scotch caseⁱ seems to have carried the doctrine of inspection to its extreme. There, as in *Hud-*

^f Stat. 17 & 18 Vict. c. 125, s. 78.

^g See 7 Jarman by Sweet, 550; *Russell v. Cowley*, Web. P. C. 457.

^h See Stat. 17 & 18 Vict. c. 125, s. 79; 18 Jur. pt. 2, 337.

ⁱ *Russell v. Crichton* (1837), decisions of the Court of Sessions, vol. 15, 1271.

dart v. Grimshaw, it was alleged that the process, as practised in the works of the defendant, was one not known. An inspection was, however, given of the works of both parties to their opponents. An order for inspection of the machinery of the plaintiff or defendant, in an action for infringement, may now, by the provisions of the Patent Law Amendment Act, 1852, be made by a Court of Common Law. A rule nisi for such order will be granted on motion.^k Application for it may be made at any time after action brought, even before declaration. It is not of course, and must be supported by an affidavit that it is material to the case.^l The affidavit must also swear that the machine is in the possession of the opposite party, and is believed to be an infringement. The machinery inspected must be at work. A second inspection will not, in ordinary cases, be granted.^m Disobedience to the order is a contempt of the Court; it cannot, however, be executed by force. In Equity such disobedience operates only on the person as a foundation for taking the bill *pro confesso*, if necessary.ⁿ The "inspection" here mentioned does not extend to the books of the opposite party.^o Production and inspection of documents, in cases in which such inspection would have been granted in Equity, may be obtained under the provisions of the Common Law Procedure Acts of 1852 and 1854.^p

^k Per Pollock, C. B., *Shaw v. Bank of England* (1852), Ex., paging machine, 1 B. C. Ca. 123; 20 L. T. 115; and see *Crossley v. Beverley* (1833), L. C., gas-meter, 1 Carp. 531; *Harrison v. Spire* (1853), Ex., loom, 22 L. T. 92.

^l *Amies v. Kelsey* (1852), B. C., braid machine, 16 Jur. 1047; 22 L. J. (N. S.), Ex., 36; 20 L. T., Ex., 76, 227; see also *Brown v. Brown*, decisions of the Court of Sessions, 2nd Series, vol. 2, 1356.

^m *Shaw v. Bank of England* (1852), 1 B. C. Ca. 123; 20 L. T. 115.

ⁿ *East India Company v. Kynaston* (1821), L. C., 3 Bligh, 153.

^o *Vidi v. Smith* (1854), Q. B., aneroid barometer, 23 L. T. 231.

^p Stats. 15 & 16 Vict. c. 99, s. 6, and 17 & 18 Vict. c. 125, s. 46.

Injunction
under the Com-
mon Law Pro-
cedure Act.

By Stat. 17 & 18 Vict. c. 125,^q general equitable powers are conferred on Courts of Law in all cases in which the plaintiff could file a bill and move for an injunction. Notice of the plaintiff's intention to that effect having been indorsed on the writ and copy, the plaintiff may, in default of appearance by the defendant, besides proceeding to judgment and execution for damages and costs, apply for and obtain a writ of injunction. Judgment may be given that the writ of injunction do or do not issue, as justice may require; and in case of disobedience, the writ of injunction may be enforced by attachment by the Court or a judge.^r The writ of injunction may be obtained at any stage in the cause at which it becomes necessary, on application by the plaintiff *ex parte*, either before or after judgment. On such application the writ may be granted or refused, on such terms as to its duration, or an account, security or otherwise as may seem reasonable and just. The order of a judge issuing such writ may be discharged, varied or set aside by the Court.^s

The rule *nisi* for an injunction and an account under this section is a four days' rule, of which notice must be given to the defendant.^t In a case recently before the Court of Exchequer, the plaintiff having recovered a verdict, an order for an injunction was obtained and made a rule of Court. Upon the defendant continuing the infringement after personal service of the order on him, a rule was made absolute for an attachment.^u

Holland v. Fox.

In a recent case,^x on an application after a verdict with damages, but before final judgment, Mr. Justice

^q Stat. 17 & 18 Vict. c. 125, ss. 79, 80.

^r *Ibid.* s. 81.

^s *Ibid.* s. 82.

^t *In re Howard v. Brown*, Q. B., Jan. 24, 1853.

^u *Clayton v. Percy* (1854), 48 Leg. Obs. 150.

^x *Holland v. Fox* (1854), umbrellas, 23 L. T. 228. See Form of Prayer in Bill for Injunction, Appendix.

Erle, in accordance with section 42, although refusing to grant an inspection of books without any sufficient reason being shown to suspect the accuracy of the account ordered, granted an order in the following form:—

That the defendant should within ten days render to the plaintiff, his attorney or agent, on oath, a full and particular account of all umbrella and parasol frames made and manufactured by him, his workmen and agents, with ribs and stretchers of tubes or hollows, denominated by the defendants troughlike elastic steel, or other metal, in imitation of the invention of the plaintiff, and for which Letters-patent were granted to him dated 7th May, 1840, showing in such account the quantity or number so made, sold or disposed of by the defendant, his workmen, agents and others by his authority or connivance; and that the defendant shall pay to the plaintiff, his attorney or agent, all moneys received or agreed to be received and paid by reason of such manufacture and sale, and that defendant should pay to the plaintiff on all frames which may remain in stock or unsold at the date hereof, such sum or sums of money as may be equal to the sums received or agreed to be received in respect of like frames sold or disposed of.

On a motion to set aside^y the order thus obtained, Lord Campbell, in delivering the judgment of the Court to make a modification of the rule absolute, made the following remarks: "It is proper to consider what has been the practice of Courts of Equity with reference to this part of their jurisdiction. The plaintiff has failed to show that after a verdict has been obtained the Court of Equity had received a bill against the defendant without any fresh infringement of the Patent being alleged, or that it had ordered accounts to be kept, as now prayed. The Court thinks that the result of the proposed proceedings would not afford a just measure of the loss sustained by the plaintiff or of the profits acquired by the defendant, profits of which he must be considered a trustee for the plaintiff. The only account which equity would grant under such circumstances would be in the shape of an interlocutory order to keep

^y Q. B., 15 June, 1854.

an account of the articles sold pending the suit; and, under such circumstances, that account of the profits would be taken as the basis of the decree, supposing the decree ultimately to be made against the defendant. This Court does not think the Legislature has used any language authorizing it to grant the application in its present form. All the loss sustained by the plaintiff would be considered as compensated by the sum, however small, which the verdict awarded as damages."

In the exercise of these and other equitable powers of injunction and account the Court has declared its intention of adopting the precedents established by Courts of Equity in the cases above mentioned.² It is naturally *Crofts v. Peach.* very cautious in granting such inspection. In *Crofts v. Peach*,³ the Court refused to compel the plaintiff to produce a specimen of the patent lace, to enable the defendant to prepare his defence of the action. "The effect of this application," said Tindal, C. J., "is to ascertain the evidence which the Plaintiff will produce at the trial. The defendants may plead that the invention is not new, if that is the fact. The Specification gives the necessary information."

Particulars.

Formerly, in an action for infringement, the defendant could plead only the general issue.^b To provide against the surprise which was constantly occurring from the ignorance in which parties were left as to the real point intended to be urged against them at the trial, it is now required^c that the plaintiff in an action for infringement shall deliver with his declaration particulars of the breaches he complains of. Similarly, the defendant to

² See 18 Jur. pt. 2, p. 337; Stat. 17 & 18 Vict. c. 125, ss. 79—82.

³ (1836) C. B., lace, 2 Hodges, 110.

^b *Losh v. Hague* (1838), railway wheel, Web. P. R. 203.

^c Stat. 5 & 6 Will. IV. c. 83, s. 5. For the nature of the particulars in the analogous case of set-off in actions of debt, see Archb. N. Pr. 56.

the action, or the prosecutor in the case of *scire facias*, must deliver with his pleas or declaration respectively the particulars of the objections he is prepared to urge to the validity of the Patent. No evidence is admissible in these respects on the trial which is not contained in such particulars.

A plaintiff cannot be compelled to give particulars of infringement, showing in effect on what grounds and principles he means to argue that the defendant has infringed his Patent. When the dates between which the instances of infringement are said to have taken place are given, and the defendant must know the articles made and sold by him within that time which can be said to be infringements of the Patent, the Plaintiff will not be compelled to give the particular instances of infringement.^d

Particulars of infringement.

Similar remarks apply to the defendant's notice of objections. If description of the invention in books and writings is to be objected to the Patent, the notice of the particulars must give the names of the books. An objection that the Specification does not particularly describe the nature of the invention, is sufficiently precise; one to the effect that the Patentee has not caused any Specification to be enrolled, is insufficient, for ambiguity. That the Patentee has not stated the most beneficial method of practising his invention is sufficient, as also is the objection that he has not distinguished in his Specification between what is old and what is new.^e If any particular part of the invention is to be attacked for want of novelty it must be specified.^f A notice that the invention had been used by the plaintiff himself, by A., B., C. "and D., and by candlemakers generally

Particulars of objection.

^d *Tulbot v. Laroche* (1854), C. B., talbotype, 23 L. T. 145.

^e Per Tindal, C. J., *Jones v. Berger* (1843), C. B., rice starch, 5 M. & G. 208.

^f *Betts v. Walker* (1849), Q. B., 14 Jur. 647; *Bodmer v. Butterworth* (1844), Q. B., 2 L. T. 368.

in the vicinity," is sufficient, although the defendant is bound at the trial to prove a user by some one at least of the persons named, or a general user in London and its vicinity, in support of the particulars of objection.⁹ The plaintiff's particulars of infringement cannot be called in aid of the defective particulars of objection.^r

"Place and manner."

Names of parties.

The stipulations in the Patent Law Amendment Act, with reference to these particulars, is,^s that they shall state "the place or places at or in which and in what manner the invention is alleged to have been used or published prior to the date of the Letters-patent." The names of the parties using the invention are not required,^t but the notice must, it appears, identify the street or factory where it has been used, either by name or by description. To state it has been used "at various places, and amongst other places at S. B. and London," is not sufficiently precise.^u Parke, B., is said on one occasion^x to have ordered the names of certain firms which had been dealing in the Patent article to be given. The words "elsewhere" and "others," &c., are frequently struck out, to reduce the notice to greater precision, their insertion tending often to mislead rather than assist. A summons for particulars and order thereupon may be obtained by a defendant before appearance, and may be made, if the judge think fit, without any affidavit.^y

Object of the particulars.

The object of the particulars being not to limit the range of action in the party delivering them, but to limit the expense by confining the parties on trial to well-defined issues, the extent of the information to be afforded

⁹ Per Alderson, B., *Palmer v. Wagstaff* (1853), Exch., candles, 1 C. L. Rep. 448.

^r *Palmer v. Cooper* (1854), candles, 9 Ex. 231.

^s Stat. 15 & 16 Vict. c. 83, s. 41.

^t *R. v. Walton* (1842), 2 Q. B. 969; see *Fisher v. Dewick* (1838), 4 Bing. N. C. 706; Web. P. R. 265-6; S. C. 593.

^u *Holland v. Fox* (1853), Q. B., umbrellas, 1 C. L. Rep. 440.

^x *Hancock v. Moulton* (1852), waterproof goods, 20 L. T. 102.

^y General Rules, No. 20, Hilary Term, 1853.

by them should, it has been said, be that to which a plaintiff would be entitled on a bill in equity for discovery.² It is difficult, as was observed by Mr. Justice Maule,^a to define the exact degree of particularity which ought to be required in the notice. It should in general be more explicit than the pleas,^b although there is nothing to prevent matters being so fully expanded on the record (as is the practice in the Courts of Scotland), as to guard sufficiently against surprise. It should, however, not amount to a disclosure of the evidence on which either party relies.^c It ought, perhaps, not to exceed what the knowledge of the party objecting may be presumed to enable him to give.^d If, from previous proceedings, the party for whose benefit the particulars were to be furnished has had the means of adequate information with respect to the infringement, the Court will refuse the particulars.^e The notice should, it appears, specify the pleas to which the objections are intended to apply.^f

Amount of precision requisite.

If the particulars are insufficient, the party to whom they are delivered may take out a summons, or move for a rule to show cause why better particulars should not be delivered. Either party may obtain leave, on appli-

Amendment of particulars.

² See *Attorney-General v. Corporation of London*, 2 M. & G. 247.

^a *Bentley v. Keighley* (1844), C. B., carding engine, 7 M. & G. 652.

^b *Heath v. Unwin* (cast steel), 10 M. & W. 684; *Jones v. Berger* (1843), C. B., starch, 5 M. & G. 215; 6 Sc. N. R. 210; *Neilson v. Harford* (1841), iron, 8 M. & W. 806; Web. P. R. 264; *Russell v. Ledsam* (1843), 11 M. & W. 647: see, however, *Betts v. Walker* (1849), Q. B., jars, &c., 14 Jur. 647.

^c *Leaf v. Topham* (1845), Ex., elastic fabrics, 14 M. & W. 146, per Parke, B.; *Russell v. Ledsam* (1843), Ex., 11 M. & W. 649, per Alderson, B.

^d Per Maule, J., *Bentley v. Keighley*, supra.

^e *Electric Telegraph Company v. Nott* (1847), C. B., 4 M. G. & S. 462.

^f *Walton v. Bateman* (1842), Web. P. R. 268, n., per Cresswell, J.

cation to any judge at chambers,ⁿ to add to his objections at any time before the trial. Where the defendant had omitted to deliver his notice of his objections with his pleas, an order was made that the pleas should be considered as pleaded *de novo*, and the objections added, as if delivered with the pleas.^o A defendant is allowed the same time for pleading after the delivery of particulars under a judge's order which he had at the return of the summons, unless otherwise provided for by such order.^v

The defendant is not bound to urge before the jury all the objections in his notice, that being merely intended to apprise him of the extent to which he must be prepared at the trial.^q Neither can he, on the other hand, avail himself of them at the trial to raise any defence on which issue is not joined in the pleadings.^r The objections, as before stated, form no part of the record.^s

The defence.

The defence consists in endeavouring to rebut the averments in the declaration, either by denying the validity of the grant to the plaintiff, or by denying the acts laid as infringements. The defendant is allowed to plead several pleas, in order to raise the question of the validity of the Patent in every form. They must, however, be such as are necessary and issuable.^t On an application for leave to plead several matters^u by way of traverse, an affidavit by the defendant's attorney that he

Rule to plead several matters.

ⁿ Stat. 15 & 16 Vict. c. 83, s. 41. For practice under Stat. 5 & 6 Will. IV. c. 83, s. 5, see per Tindal, C. J., *Bulnois v. Mackenzie* (1837), *cab*, Web. P. R. 260.

^o *Losh v. Hague* (1838), railway wheel, Web. P. R. 203.

^p General Rules, Hilary Term (1853), No. 21.

^q *Losh v. Hague* (1838), railway wheel, Web. P. R. 203.

^r *Gillett v. Wilby* (1839), *cab*, 9 C. B. 334; Web. P. R. 270.

^s *R. v. Mill*, 20 L. J. (N. S.), C. B. 16; 10 C. B. 379.

^t Hind. 280; *Beddels v. Massey* (1844), elastic fabrics, C. B., 2 D. & L. 322; *Nickels v. Ross* (1849), braid, 8 C. B., 679; *Bunnett v. Smith* (1844), Ex., 13 M. & W. 552.

^u As to pleading several pleas, see Chitty's Pleading, 24, n. (p).

Seem, it would have been good had the words of the Statute been followed.

Patentee not
the inventor.
Communica-
tion from
abroad.

To a declaration alleging that the plaintiff was the inventor, the defendant pleaded (after setting out the Specification, which recited that the Queen had granted to the plaintiff a Patent for improvements in machinery for covering fibres applicable to the manufacture of braid and other fabrics, communicated to him by a foreigner residing abroad), that before the granting of the Patent the plaintiff reported to Her Majesty, that in consequence of a communication made to him by a certain foreigner residing abroad, he, the plaintiff, was in possession of an invention of improvement in machinery for covering fibres applicable in the manufacture of braids and other fabrics; that Her Majesty, believing and confiding in the truth, and acting upon the suggestion so made by the plaintiff as aforesaid, and in consideration thereof, granted the Letters-patent in the declaration mentioned, and that such representation was false, whereby the Letters-patent were null and void. The plaintiff was held entitled to a verdict on the issue, without any proof of the communication.^d

True and first
inventor.

Pleas denying that the plaintiff was the true and first inventor, and that the manufacture is new, do not bind the plaintiff to the description of the invention as given in the Specification, so as to preclude him from giving evidence to show that the invention does not consist, as might be inferred from the Specification, in the use of several new matters, but in the new combination of several old matters.^e

Invention of
no use.

A plea that the invention is not of such use to the public as to make it a sufficient consideration for the grant of Letters-patent, is bad as being too general.^f

Invention not
duly specified.

It is very material to plead that the Patentee has not

^d *Nickels v. Ross* (1849), braid, C. B., 8 M. G. & S. 679.

^e *Bateman v. Gray* (1853), valves and plugs, 1 C. L. Rep. 512.

^f *Betts v. Walker* (1849), bottles, jars, &c., Q. B., 14 Jur. 647.

specified. In *Bateman v. Gray*^g it would, it appears, if pleaded, have proved fatal to the Patentee.^h The following plea has been very recently disallowed: "That the plaintiff, having petitioned for Letters-patent, represented to the Solicitor-General, to whom the matter was referred, that the invention consisted of matters mentioned in a paper-writing" (set out in the plea) "exhibited to the Solicitor-General, who, confiding therein, reported that the Letters-patent might be granted; that, after the grant of the Letters-patent, the plaintiff enrolled his Specification in certain terms falsely describing his invention; and that so much of his invention as was stated in the Specification was not part of the invention in the paper-writing and Letters-patent mentioned, and was not part of the invention for which the Letters-patent were granted."ⁱ

In *Muntz v. Foster*,^k the declaration, after setting out the Letters-patent, with the usual proviso for making them void in case of the non-enrolment of a Specification within six calendar months, alleged that the plaintiff did, in pursuance of the proviso, by an instrument in writing under his hand and seal, particularly describe and ascertain the nature of his said invention, and in what manner the same was to be and might be performed; and afterwards, and within six calendar months next after the date of the Letters-patent, cause the said instrument in writing to be enrolled in Chancery. The plea averred that the plaintiff caused to be enrolled in Chancery, within six calendar months after the date of the Letters-patent, to wit, on, &c., a certain instrument in writing, in the words and to the effect following (setting it out); and that the plaintiff caused to be enrolled in Chancery, within six months

*Muntz v.
Foster.*

^g (1853) valves and plugs, 1 C. L. Rep. 515.

^h *Betts v. Walker* (1849), Q. B., 14 Jur. 647.

ⁱ *Hancock v. Noyes* (1854), caoutchouc, 23 L. J. 110, Exch. See *Hancock v. Smith* (1854), 23 L. T. 93.

^k (1843) metal sheathing for ships, 6 M. & G. 734.

from the date of the Letters-patent, no instrument in writing other than and except the said instrument in writing thereinbefore set forth and contained, whereby and by reason of the premises the said Letters-patent in the declaration mentioned ceased and determined, and became and were and still are of no force and effect; concluding with a verification. On special demurrer the plea was held bad, on the ground that it was an argumentative traverse of the enrolment alleged in the declaration.

The subject-matter and claims.
Nature of the invention.

The subject-matter of the Patent and the claims of the Patentee are proved by the terms of the Specification taken as a whole.^m The description of the invention is to be looked for in the Specification, and not in the Patent.ⁿ The Specification is to be read in connection with the Patent, and with a view to support it.^o Working drawings and models used in the actual manufacture are also frequently introduced. Such evidence, however, it must be considered, has a tendency to contract the claims of the Patentee in the event of their being entirely confined to one mode of developing the inventor's discovery.^p On a recent trial, in which the Patentee claimed generally the manufacture of woven fabrics by means of his machine, the drawing produced was that of a coach-lace loom only. The opinion of the Court was very decided that the evidence restricted the claims of the

^m *Newton v. Grand Junction Railway Company* (1846), railway axles, 5 Exch. 331.

ⁿ *Arkwright v. Nightingale* (1785), C. B., spinning machinery, 1 Carp. 38.

^o "I consider the Patent and Specification so connected together as to make part of each other, and that to learn what the Patent is I may read the Specification and consider it as incorporated with the Patent." Per Grose, J., *Hornblower v. Boulton* (1799), steam-engine, Dav. P. C. 230; *Househill Company v. Neilson* (1843), iron, Web. P. R. 679; *Hill v. Thompson* (1817), L. C., iron, 1 Carp. 369.

^p Per Pollock, C. B., *Crossley v. Potter* (1851), weaving machine, printed case, p. 51.

Patentee to this branch of the manufacture. "If ever," it was observed, "prejudice did exist in a Court of Justice, it might exist against a man who pretends that he has made an invention and never applied it for ten years to the subject of carpets."⁹

The terms of the Specification must be interpreted according to the state of knowledge at the time.⁵ The term "other substances" must be understood as substances *ejusdem generis* in use at the time, and which practical men would employ.⁶ If the Specification in its fair construction excludes the use of a particular instrument or process, it will be presumed that the Patentee does not claim its use.⁴ The Specification should be read consistently with the fair import of language, to make the claim co-extensive with the actual discovery.¹⁰

Sufficiency of the Specification.

If the sufficiency of the Specification be not denied by his pleas, the defendant must be taken to have admitted it, and is not consequently entitled to avail himself at the trial of the fact of the Specification being defective.⁸

The sufficiency of the Specification as a means of im-
parting the invention to the public is proved by Patent
agents and others, who state that the directions it con-
tains are sufficient to enable persons to arrive at the
result. A drawing or figure is not required to the suffi-
ciency of a Specification, if the invention can be made
clear without it;⁷ but if it enable a workman to avail

Proof.

Drawings.

⁹ Per Pollock, C. B., *Crossley v. Potter* (1851), weaving machine, printed case, p. 51.

⁵ *Crossley v. Beverley* (1830), K. B., gasmeter, Web. P. R. 106.

⁶ *Crossley v. Beverley* (1829), K. B., gas apparatus, 1 Carp. 480.

⁴ *Russell v. Cowley* (1833), L. C., gas tubes, 1 Carp. 531, 597; *Beard v. Egerton* (1847), photograph, 2 C. & K. 667.

¹⁰ *Haworth v. Hardcastle* (1833), C. B., calico-drying machine; *Bainbridge v. Wigley* (1810), K. B., flageolet, 1 Carp. 270; *Mcfaurlane v. Price* (1816), umbrella, 1 Stark. 199.

⁸ *Bateman v. Gray* (1853), Exch., plugs and valves, 1 C. L. Rep. 512. See, however, *Turner v. Winter* (1787), per Buller, J., 1 T. R. 602; Roscoe, Evid. 6th ed. 350.

⁷ *Boulton v. Bull* (1795), C. B., steam engine, 1 Carp. 117.

himself of the benefit of the invention, it may alone be as good a Specification as any written description.² The drawings and Specification may afford mutual assistance, by explaining any ambiguity either separately might create. In *Lowe v. Penn*,^a the drawings were rather defective, but the Specification clear. It was proved that the screw-propeller could be constructed from the joint information.

Not guilty.

The plea of Not guilty amounts, under the present practice, to a denial only of the acts alleged as breaches in the declaration, and does not attempt to assail the validity of the Patent. Upon an issue of Not guilty, the question of whether there was a fraudulent evasion of the Patent does not arise.^b

Allowance of pleas.

Where Letters-patent are granted to different parties for substantially, though not in every particular, the same invention, and the Letters-patent latest in date contain a proviso that they shall not give any privilege to use or imitate any invention already patented, and that all other persons entitled may continue to use inventions previously patented, a person using the first patented invention cannot, in addition to the pleas of not guilty and that the invention was not new, plead specially to an action brought for an infringement of the second patented invention a plea setting out the above proviso, and alleging that the defendant had used the previously patented invention, such plea amounting to a plea of not guilty, and meaning that the defendant had used the first, and therefore not the second.^c

Bentley v. Keighley.

In a case where the invention included six distinct

² *Brunton v. Hawkes* (1821), K. B., chain cable, 1 Carp. 410; *Bloxam v. Elsee* (1825), K. B., paper, 1 Carp. 434.

^a (1848) N. P., Lord Denman, screw-propeller, 32 Lond. Journ. 140. See *Crompton v. Ibbotson* (1828), N. P., paper, 1 Carp. 458.

^b *Stead v. Anderson* (1847), wood-paving, 16 L. J. (N. S.), C. P., 250.

^c *Holmes v. London and North Western Railway Company* (1852), C. B., 19 L. T. 158.

improvements on an old machine, the defendants were allowed to plead that two parts of the invention were not, nor was either of them, a new manufacture within the Statute of *James*. But the Court refused to allow them to plead, that as to *a part* one A. B. was the first and true inventor, and that before the grant of the Patent A. B. and others publicly used and exercised in England *a part* of the said invention.^d

The defendant will not be allowed to annex copies of drawings to a plea setting out the Specification. Drawings annexed to the plaintiff's Specification being copied into the pleas, the Court granted a rule calling on the defendant to show cause why such pleas should not be struck out, or why such drawings should not be struck out as surplusage, and as contrary to the rules of pleading. The rule was afterwards enlarged, but arrangements having been entered into between the parties, which rendered the trial of the cause unnecessary, it never came on for argument.^e

Insertion of drawings in the pleas.

In an action by an assignee the declaration alleged, that, after assignment, the grantee of the Patent, pursuant to Stat. 5 & 6 Will. IV. c. 83, entered with the Clerk of the Patents a disclaimer of part of the title of the invention. The defendant pleaded, that, before the making of the disclaimer, the grantee had assigned the Patent to the plaintiff, and at the time of making the disclaimer was not a person who could lawfully enter such disclaimer; without this, that, pursuant to the Statute, he entered the disclaimer. It was held, that under this traverse the only issue raised was whether, in point of fact, a *disclaimer* was entered by the grantee.^f

Disclaimer.

^d *Bentley v. Keighley* (1844), C. B., cotton-carding machine, 6 M. & G. 1039.

^e *Sealy v. Browne* (1845), B. C., per Williams, J., 14 L. J. (N. S.), Q. B., 169.

^f *Wallington v. Dale* (1851), gelatine, 6 Ex. 281. As to plea that the infringement was before Disclaimer, see *Perry v. Skinner* (1837), Ex., pens, 2 M. & W. 471.

Power to deliver written interrogatories.

Written interrogatories as to matters on which discovery is sought may, by order of the Court or a judge, be delivered by either plaintiff or defendant to the opposite party, provided such party would be liable to be examined as a witness upon such matters. The answers to such interrogatories must be made in writing on affidavit within ten days of such delivery, unless the time for answering be extended by the Court or a judge. In the case of a body corporate any officer of such body may be required to answer. Neglect or refusal to answer is a contempt of Court.^p

Affidavits of the party proposing to interrogate.

The application for such order must be made upon an affidavit of the party proposing to interrogate, and his attorney or agent, or, in the case of a body corporate, of their attorney or agent, stating the deponent's belief that the party proposing to interrogate will derive material benefit in the cause from the discovery which he seeks, that there is good cause of action or defence upon the merits, and, in the case of application by the defendant, that the discovery is not sought for the purposes of delay. The Court may, under certain circumstances, dispense with the affidavit of the plaintiff or defendant.^q

Oral examination.

If the party interrogated fail, without having good cause, to answer sufficiently, the Court or a judge may order such party to be orally examined, and produce documents, before a judge or master, as to such points as they or he may direct.^r Such judge or master, if required, to report specially, if need be, to the Court the conduct or absence of any witness or other person.^s The costs of the rule and examination are in the discretion of the Court.^t The depositions taken on such examination are to be returned to the office of the master of the Court.^u

Postponement of trial, *scire facias* pending.

Notice of trial by proviso having been given in an

^p Stat. 17 & 18 Vict. c. 125, s. 51.

^q Ibid. s. 52.

^r Ibid. ss. 53, 54.

^s Ibid. s. 56.

^t Ibid. s. 57.

^u Ibid. s. 55.

action brought by an assignee, in which action the validity of the Patent was put in issue, the Court, at the instance of the plaintiff, postponed the trial on the ground that in a *scire facias* brought by the defendant a rule was pending in the Court of Queen's Bench for entering a verdict for the Patentee.^x But the Court will not, except under very peculiar circumstances, order the trial of an action brought to try the validity of a Patent to be postponed till *scire facias* brought to repeal the Patent has been disposed of.^y The adjournment of the trial is, however, by a recent Act, placed entirely at the discretion of the Court or judge.^z

A leading feature in the new Common Law Procedure Act is the decision of matters in question by arbitration. At any time after the issuing of the writ, if it be made appear to the satisfaction of the Court or a judge, upon the application of either party, that the matter in dispute consists wholly or in part of matters of mere account which cannot conveniently be tried in the ordinary way, the Court or judge may either decide the matter in a summary way or order such matter wholly or in part to be referred to an arbitrator to be appointed by the parties or to an officer of the Court, or, in country causes, to the judge of any County Court; the decision or order of such Court or judge, or the award or certificate of such referee, to be enforceable by the same process as the finding of a jury on the matter referred.^u By section 4, power is given to the Court or judge, in the event of the allowance or disallowance of any items in such account depending on a question of Law fit to be decided by the Court, or upon a question of fact fit to be decided by a jury or by a judge acting under the provisions of sec-

^x *Smith v. Upton* (1843), C. B., Bynner's Patent, 6 M. & G. 251.

^y *Muntz v. Foster* (1843), C. B., metal ship-sheathing, 6 M. & G. 734; 7 Scott, N. R. 471; 1 D. & L. 737.

^z Stat. 17 & 18 Vict. c. 125, s. 19.

^u *Ibid.* s. 3.

tion 1, to direct a case to be stated or an issue or issues to be tried, the decision of the Court and the finding of the jury or judge to be taken and acted upon by the arbitrator as conclusive.

Powers of arbitrator.

The mode of proceeding and powers of the arbitrator are similar to those previously existing upon a reference made by consent under a rule of Court or judge's order.^b The award is to be made within three months from the date of the reference, unless the parties or the Court enlarge the time.^c It may be stated in the form of a special case for the opinion of the Court.^d Applications to set aside the award made on a compulsory reference must be made within the first seven days of the term following its publication.^e It may, by the authority of a judge, on such terms as he may prescribe, be enforced at any time after seven days from the time of publication, notwithstanding the period for setting it aside has not elapsed.^f If, after all parties have agreed to submit to arbitration, any one should commence an action, the Court or judge may stay proceedings.^g If either party refuse or neglect to appoint according to the terms of the document authorizing the reference, a judge of any of the Superior Courts of Law or Equity at Westminster may appoint an arbitrator, umpire or third arbitrator, as the case may be, with powers such as he would have had if appointed by consent of all parties.^h If the reference be to two arbitrators, one to be appointed by either party, and one fail to appoint for seven clear days after the other shall have appointed, the award of the one arbitrator so appointed shall be binding on both parties, subject however to the revocation of the powers to such arbitrator, on such terms as shall seem just.ⁱ If the reference be to two arbitrators, they may choose an um-

^b Stat. 17 & 18 Vict. c. 125, s. 7.

^c *Ibid.* s. 15.

^d *Ibid.* s. 5.

^e *Ibid.* s. 9.

^f *Ibid.* s. 10.

^g *Ibid.* s. 11.

^h *Ibid.* s. 12.

ⁱ *Ibid.* s. 13.

pire.^k Unless otherwise provided by the parties, every agreement for or submission to arbitration may be made a rule of Court.^l

A rule for the costs of the day for not proceeding to trial, pursuant to the notice, or not countermanding in sufficient time, may be drawn upon affidavit without motion.^m The defendant may move for this rule, although he has given notice of trial by proviso.ⁿ

Costs of the day.

Cases for infringement have hitherto usually been tried by a special jury. The mode of summoning and empanelling juries is prescribed by the Common Law Procedure Act of 1852.^o

The jury.

The statute above mentioned has however, among other very considerable changes in practice, introduced an alteration in the mode of trial, by allowing the parties to any cause, by consent in writing, to dispense with the employment of a jury and to leave the decision of any issue in fact and the assessment of damages to the Court,^p the Court, upon a rule to show cause or a judge on summons, thinking fit to allow such trial.

Changes in practice.
Trial by the Court.

By section 6, the judge, in the performance of such functions, is empowered to direct a reference at the time of trial, if the matters in question involve accounts which cannot conveniently be settled by him; and, by section 8, to send back the matters referred for the re-consideration of the referee.

In how far this provision will be effective in substituting the decision of an intelligent judge for that of a jury, too frequently incompetent to grapple with the merits of the matter in dispute,^q must rest with the par-

^k Stat. 17 & 18 Vict. c. 125, s. 14.

^l Ibid. s. 17.

^m Stat. 15 & 16 Vict. c. 76, s. 99.

ⁿ *Blow v. Wyatt* (1838), Ex., 4 M. & W. 407.

^o Stat. 15 & 16 Vict. c. 76, ss. 104—115.

^p Stat. 17 & 18 Vict. c. 125, s. 1.

^q See *Gamble v. Kurtz* (1846), sulphate of soda, muriatic acid, &c. 3 C. B. 425; *Lovell v. Hicks* (1836), baking apparatus, 2 Yo. & Coll. 472; *Beard v. Egerton* (1846), photograph, 3 C. B. 97.

Godson.

ties themselves, the clause not being compulsory and requiring the agreement in writing of both parties.⁷ With regard to the respective efficiency of the modes of trial, few persons can entertain a doubt. The remarks of Mr. Godson² in deprecation of the appointment of a Court of Commissioners for the decision of Patent cases, however far they fall short of establishing the proposition he contends for, are very just, as pointing out the far greater capability for the task in a judge than in a jury: "The judges possessing," as he remarks, "as a part of their education, a knowledge of the first principles of every science. Science is, however, a part only, and not the greater part, of the qualifications requisite for the decision of these questions. Practical acquaintance with the whole range of manufacturing art is the great requisite, and these neither judge nor jury can be expected to possess."

Unfitness of a jury.

It is unreasonable to expect that a jury^a can be obtained competent to express an opinion as to the novelty or improvements of inventions such as (to take the first instances that may occur) formed the subject of *Beard v. Egerton*,^b *Gamble v. Kurtz*,^c *Heath v. Unwin*.^d Neither judge nor jury can, by the evidence capable of being produced at the trial, gain a thorough acquaintance with

⁷ In the County Courts it is to be observed that the normal case is the trial by the judge, but either party having the power to demand a jury. By a return printed by order of the House of Commons in 1848, it appeared that out of a total of 267,447 causes tried in the County Courts in the preceding year, only 800 were tried before a jury, and that in those verdicts were in 427 instances obtained by the party requiring the jury.

² Godson on Patents, 230.

^a "With respect to the statement of the jury, it would be a most dangerous precedent to take the explanatory language of the foreman as having the effect of a legal judgment." Per Shadwell, V. C., *Rubery v. Barrs* (1845), umbrella tips, 27 Lond. Journ. 374.

^b (1846) photographs, 3 C. B. 97.

^c (1846) sulphate of soda, muriatic acid, &c., 3 C. B. 425.

^d (1854) Exch. Ch., cast steel, 3 C. & K. 522.

all the circumstances of the manufacture; and as the object of their employment is to ascertain a fact, it seems difficult to understand how any division of the labour can attain the end. So many and so subtle are the elements that enter into the great majority of the cases connected with Patent right, that the matter is safe only when left to the arbitration of persons practically conversant with the commercial bearings of the case.

The regulations of the Common Law Procedure Act, 1854, with regard to the addresses to the jury, are as follows:—The party who begins may, if at the close of his case his opponent does not give notice of his intention to adduce evidence, address the jury a second time, for the purpose of summing up the evidence; and the party on the other side may open the case, and also sum up the evidence, if any. The right of reply to remain the same as before.^e

Speeches to the jury.

The defendant cannot at the trial go beyond his pleas, or adduce evidence not included in his notice of objections.^f There are, however, some objections which may be raised at the trial without notice; as, for instance, that the act complained of is no infringement of the Patent.^g

Trial.

A witness may refresh his memory by reference to a drawing, when asked if he has such a recollection of a machine he made as to be able to say that the drawing correctly represented it.^h He cannot be asked whether he did not learn from a person under whom the plaintiff claimed title something respecting the contents of a deed.ⁱ

Witness may look at a drawing to refresh his memory.

^e Stat. 17 & 18 Vict. c. 125, s. 18.

^f *Macnamara v. Hulse* (1842), Q. B., wood pavement, 1 Car. & Marsh, 471.

^g *Nickels v. Ross*, per Tindal, C. J. (1849), braid, 8 C. B. 679; Hindm. 438.

^h *R. v. Hadden* (1826), C. B., woolspinning machine, 1 C. & P. 184; 1 Carp. 447.

ⁱ *Bloram v. Elsee* (1825), paper, Ry. & Moo. N. P. C. 187; 1 C. & P. 563.

Competency of witnesses.

By the second section of Stat. 14 & 15 Vict. c. 99 (section 1 having repealed 6 & 7 Vict. c. 85), it is enacted, that "on the trial of any issue joined, or of any matter or question, or on any inquiry arising in any suit, action or other proceeding in any Court of Justice, or before any person having by law or by consent of parties authority to hear, receive and examine evidence, the parties thereto and the persons in whose behalf any such suit, action or other proceeding may be brought or defended, are made competent and compellable to give evidence, either *vivâ voce* or by deposition, according to the practice of the Court, on behalf of either or any of the parties to the said suit, action or other proceeding.

Scientific evidence.

Notwithstanding the precision which might not unreasonably be expected from persons conversant with the mechanism and chemistry of manufactures, the evidence on very important points is often perfectly irreconcilable. "The jury," said the learned Chief Baron, on an occasion of this kind, "must not be astonished at the apparently contradictory nature of the evidence of the scientific gentlemen, as those gentlemen had their own way of looking at these matters." His lordship, however, congratulated the jury on having had an opportunity of witnessing the operation of both models, and seeing pieces of wood cut by them: "they could, therefore, judge for themselves, and that was always the best way, where it could possibly be done."^d Much of this uncertainty is no doubt owing to the nature of invention; but more, in many instances, to the peculiar views entertained by the professional persons under examination. As Mr. Turner observes,^e Columbus's egg might very significantly be displayed before the jury-box on the investigation of Patent cases.

Non concessit.
Evidence of the grant.

If *non concessit* be pleaded, the plaintiff must give evidence of the grant by the production of the original

^d *Hamilton v. Cochran* (1848), key saw, 33 Lond. Journ. 136.

^e *Turner on Patents*, 4.

Letters-patent. In the case of Patents granted before October 1, 1852, the proof may be by an exemplification or *constat* of the enrolment of it in Chancery under the Great Seal.^f The Commissioner's Seal is also, by the late Act, taken notice of judicially, as sufficient evidence that the document is what it purports to be. In the case of Patents subsequently granted, the proof, in the absence of the Letters-patent, must be by a new Patent, procurable at the office of the Commissioners.^g

Under the new practice copies of Specifications, disclaimers and memoranda of alterations and drawings, printed by the Queen's printer, are *primâ facie* evidence of the existence and contents of the documents to which they purport to relate.^h By Stat. 12 & 13 Vict. c. 109, s. 12, a certificate of the Clerk of the Petty Bag Office, sealed with the Chancery Common Law Seal, is made "*primâ facie* evidence that the Specification, deed, instrument or document therein mentioned, was duly enrolled in the Petty Bag Office on the day mentioned in such certificate." Office copies, sealed with the Chancery Common Law Seal, are evidence "for the purpose of proving the contents of such record or other document, as also proving such record or other document to be a record or document of or belonging to the said Court of Chancery, but not further or otherwise."ⁱ The due enrolment of Specifications, &c., in the Enrolment Office in Chancery is proved by the certificate of the Clerk of the Enrolment Office endorsed on those documents, and sealed with the seal of the Chancery Enrolment Office.^k Copies of the enrolments, drawings, &c.,^l stamped with

Proof of Petty
Bag Office
enrolment.

^f Tidd's Pract. 3rd ed. 690; Gilb. Law Ev. 14; *Edin's case*, 6 Co. Rep. 156; Plowd. 252.

^g See on this head Stats. 3 & 4 Edw. VI. amended by 13 Eliz. c. 6, s. 2; *Page's case*, 5 Rep. 53 b; Co. Litt. 225 b; Hindm. 591.

^h Stat. 15 & 16 Vict. c. 83, s. 22.

ⁱ Stat. 12 & 13 Vict. c. 109, s. 13.

^k *Ibid.* s. 18.

^l *Ibid.* s. 19.

the seal of the Chancery Enrolment Office, are evidence to prove the contents of such documents and the date of their deposit.

Enrolment in
the Rolls
Chapel.

Copies of enrolments in the Rolls Chapel Office, examined and certified by the Deputy Keeper of Records or one of the Assistant Record Keepers, and purporting to be sealed with the seal of the Record Office, are evidence, without further or other proof, in every case in which the original record could have been received as evidence.ⁿ The due enrolment of Specifications, &c., which have not been transferred to the Office for filing Specifications in Chancery, may, under the provisions of Stat. 14 & 15 Vict. c. 99, s. 14, be proved by copies and extracts signed and certified by the officer to whose custody the original is entrusted, "at a charge not exceeding fourpence for every folio of ninety words."^o

Until this, Specifications are provable only by the production of the documents themselves—entry of disclaimer provable by the production of the original copy entered.

Register unsafe
guide.

Evidence of the title of the plaintiff is supplied by a copy of the entry in the "Register of Proprietors," certified under the Seal of the Commissioners. Registration of the deed of assignment, therefore, must precede any steps taken for infringement by the assignee. As at present kept, the Register is, however, an unsafe guide for ascertaining the parties interested in the Patent. No provision is made with reference to the time within which wills must be registered, or the footing on which they stand, to prove registered conveyances.^p There are no formalities attendant on the presentation of a deed for registration.^q The whole deed is entered verbatim.

ⁿ Stat. 1 & 2 Vict. c. 94, s. 13.

^o The charge in the Great Seal Patent Office is two pence per folio.

^p Sugden on Vendors and Purchasers, 204.

^q The following was the form in which this oath was required to be taken before the Registrar or a Master in Chancery, on registering the memorials of deeds and conveyances in Middlesex:—"You swear that

As a general maxim, the burden of proof is upon the party impeaching the validity of the Patent, the prosecutor in a *scire facias* or the defendant in an action for infringement. On the question of novelty, therefore, in the invention, he is bound to prove user by the positive evidence of persons who can testify to the public use and exercise of the invention,^r or the identity in all the material particulars of the articles claimed by the Patentee in his Specification with those contained in other Patents.^s If originality in the inventor only be disputed, he must show the source whence the information could have been drawn.^t

Burden of proof.

Novelty.

The novelty of the subject-matter is impeachable during the whole duration of the Patent, the length of enjoyment^u under it forming no additional security to the title. A proposal to relieve the Patentee from this state of suspense was made by the noble lord who introduced the Patent Law Amendment Bill of 1845,^x to the effect that, after a certain time had elapsed, and a certain number of advertisements had been inserted in the public papers, giving an account of the Specification and referring to a place in London or in the town at which was the residence of the Patentee, where models and drawings could be inspected by the public for one month during the time of the advertisements, and for one month afterwards, there should be a limitation of the right of a third party to try the question of the validity of the Patent on the score of its originality; so that after eighteen months from the making of the Specification, in

Time does not cure a title defective in respect of novelty.

you saw this Memorial signed, sealed and delivered, and that the deed to which it refers was duly executed by the parties thereto."

Rigge, 74. Wills were required to be registered within five years.

^r *Heath v. Smith* (1854), Q. B., cast steel, 18 Jur. 603.

^s *Bush v. Fox* (1854), Exch. Ch., caissons, 22 L. T. 349.

^t *Nickels v. Ross* (1849), C. B., braid, 8 M. G. & S. 679.

^u *Newall v. Wilson* (1852), L. J., wire rope, 2 Ch. Ca. 283.

^x (1835) 28 Hansard, 677.

no suit or action on the subject of the invention should any evidence of the want of originality be admissible.

Bush v. Fox.

In the case of a Patent^y for "Improvement in the Means of Working under Water," the Specification claimed the mode of constructing the interior of a caisson in such a manner that workpeople might be supplied with compressed air, and be able to raise materials, excavate and construct foundations under water. It was proved, that as to the manner of using the compressed air, the invention was not new; that a machine similar to the plaintiffs, the interior of which was *not* constructed with air chambers, as the interior of the plaintiff's was, had already been invented; that nevertheless that *machine* and the plaintiff's were *substantially the same*, but that the *purposes* to which the two inventions were applied were *different*, the one being applied to working in mines and on land, and the plaintiff's in laying foundations under water. Held, that the evidence did not support the novelty of the invention.

Evidence of novelty.

The only evidence the plaintiff can give on this issue is that of persons who are conversant with the manufacture, and would in all probability have heard of the invention had it existed, being ignorant of it.^z Its value depends of course entirely on the character of the witnesses, and cannot at best amount to establishing the non-existence of the invention prior to the grant. Fifty witnesses, as was remarked by Gibbs, C. J.,^a proving that they never saw the invention before would be of no avail, if one were called who had seen and practised it.

Heath's Patent consisted in cast steel, made in an improved manner by the use of carburet of manganese,

^y *Bush v. Fox* (1854), Exch. caisson, 23 L. T. 349.

^z *Cornish v. Keene* (1835), elastic fabrics, Web. P. R. 44; *Carpenter v. Smith* (1811), lock, Web. P. R. 530; *Tennant's case* (1798), bleaching liquid, Web. P. R. 125, n.; *Galloway v. Bleaden* (1839), paddlewheel, Web. P. R. 521, per Tindal, C. J.

^a *R. v. Arkwright* (1785), spinning machinery, Dav. Pat. Ca. 350.

either in its complete state or of its constituents, so as to form carburet of manganese before the iron was in a state of fusion. At least five houses in the trade, for eight or ten years before and at the date of the grant, manufactured the patented article, by introducing carburet of manganese into the crucible with the iron, as directed in the Specification, one to the extent of one hundred tons, and others eight or ten tons annually.^b

The solution of a *quære* by Mr. Justice Erle in *Heath v. Smith* involves fundamental principles of Patent Law. It was as to whether, viz. a Patent for improvements in a manufacture would be valid if one person had previously perfected the article and sold it to the public, though he kept the process secret. His Lordship appears to have expressed himself on the side of the invalidity of the Patent. Assuming, however, the doctrine above^c referred to, as laid down in *Williams v. Williams*^d by Lord Eldon, and in *Neilson v. Harford*^e by Tindal, C. J., the Patent is clearly good, as enabling the whole public within a definite time to improve the manufacture in question. The secret still being with the Patentee, there is still the same good consideration in the divulging of the method by which the excellence of the material is attained. The risk of its discovery by rival manufacturers^f is sufficient, in almost all cases, to prevent such a mode of proceeding by the discoverer of an important improvement in manufactures.^g The question is, solely, was the public in possession of the inventor's discovery. The manufacture and deposit of an article, such as a penholder of novel construction, in a warehouse for sale,

^b *Heath v. Unwin* (1852), Ex. Ch., 12 C. B. 522; 16 Jur. 996.

^c *Supra*, p. 41.

^d (1817) L. C., 3 Mer. 157.

^e (1841) Web. P. R. 341.

^f *Hancock v. Somervell* (1851), waterproofings, 39 Lond. Journ. 158.

^g *Heath v. Smith* (1854), Q. B., cast steel, 18 Jur. 603.

even although no sale actually take place, is a publication of the invention.^g

Use of machinery.

The execution by machinery of work hitherto performed by hand is usually conclusive as to the novelty of the invention. In a case recently before Lord Campbell, C. J., the utility of the Patent (Donisthorpe's) was established by its success;^h it being proved that the invention had revolutionized the trade to such an extent, that, whereas before its date all wool had been carded or combed by hand, that operation had since been almost exclusively performed by machinery.

New manufacture.

A Patent cannot be supported for the application of a process already known producing a known result, unless the object to which the process is applied is different to the object to which it was formerly applied. Whether the object is different is a question for the jury.ⁱ

Novelty ruling.

In *Templeton v. Macfarlane*^j it appeared that one of the processes was old. The judge directed the jury that, if one of them was new, the Patent could be supported for the combination of them, and would be invalid only if there had been a public use of both before the date of the Patent. The House of Lords, on appeal, dealing with this as a general proposition, pronounced the direction as erroneous and the Patent void.

Proofs of foreign Patents.

A clause providing that user abroad should vitiate the grant in this country was inserted in the Patent Law Amendment Bill of 1852. It was, however, struck out by the Select Committee in the Commons. The words of the Act are, "that no Letters-patent for or in respect of any invention for which any such Patent or like privilege as aforesaid shall have been obtained in any foreign country, and which shall be granted in the said United Kingdom after the expiration of the term for which such Patent or privilege was granted or was in force, shall be

^g *Mullins v. Hart* (1852), N. P., Jervis, C. J., 3 C. & K. 297.

^h *Lister v. Todd* (1852), N. P., 40 Lond. Journ. 235.

ⁱ *Steiner v. Heuld* (1853), Ex. Ch., garancine, 17 Jur. 875.

^j (1848) 1 H. of Lords Ca. 595, silk and cotton fabrics.

of any validity." This limitation, at variance with the general principle of the Law of Patents, will probably remain inoperative, except for the purpose of creating embarrassment to the Patentee in this country. In Prussia,^k for instance, Specifications are studiously kept secret, and proof of their contents can therefore not be obtained. In the words of Mr. Webster,^l "the practical difficulties it creates are very great. The moment an action for infringement is brought, there will be a pretence of user abroad, a commission will issue, and the plaintiff will be delayed under that pretence."

It is for the jury to say whether the Specification contains a reasonably sufficient description of the invention.^m

Sufficiency of description in the Specification is for the jury.

A claim for a Patent for improvements in the mode of doing something by a known process is sufficient to entitle the claimant to a Patent for his improvements when applied, either to the process as known at the time of the claim or to the same process altered and improved by discoveries not known at the time of the claim, so long as it remains identical with regard to improvements claimed and their application.ⁿ

The objection that the Patent is void, inasmuch as the Specification describes a different and more extensive invention than that for which the Letters-patent are granted, may be taken, either on a plea that the Patentee did not particularly describe the nature of his invention, or on a plea that the invention described was not the invention for which the Letters-patent were granted. The relation of the title to the Patent has been above^o dis-

Discrepancy between Letters-patent and the Specification.

^k (1851) Evid. Weddige, 2176. The Commissioners of Patents' Journal contains a list of the Titles of all Patents granted in Prussia and the Zollverein, officially communicated. See, as to the view taken of foreign judgments by Courts in this country, *Martin v. Nicolls* (1830), V. C., 3 Sim. 461; *Vallée v. Dumergue* (1849), Exch., 18 L. J. 398.

^l Evid. 1851, No. 2783.

^m *Wallington v. Dale* (1852), gelatine, 7 Exch. 888.

ⁿ *Electric Telegraph Company v. Brett and Little* (1851), 10 C. B. 838.

^o *Croll v. Edge* (1850), C. B., gas, 14 Jur. 453.

cussed. In the absence of fraud, the title, being larger than the Specification, will not invalidate the Patent.^e

The infringement.

It is said that the question of fact, whether the Patent is infringed, is for the jury,^f the legal question of what constitutes an infringement depending on the construction of the Specification by the Court; and the Court will say to a jury, "The question for your consideration is, whether the principle is the same: whether the effect obtained by stopping the apertures is the same means, whether the means differ in shape or not, is not material."^g The burden of proof on this issue rests with the plaintiff.^h

Proof necessarily difficult.

The proof of infringement is necessarily difficult. Its detection is often no easy task; the ingenuity of the infringer in the variation of his machinery, or the disguise of his occupation, rivalling in many instances that displayed by the inventor himself.ⁱ In *Hall v. Jarvis*^k the infringer had obtained admission into the plaintiff's workroom through his servant,^l had taken a plan of the

^e *Nickels v. Haslam* (1844), C. B., braid, 3 L. T. 76.

^f *Bramah v. Hurdcastle* (1789), K. B., water-closet, 1 Carp. 168.

^g *Cochrane v. Braithwaite* (1830), L. C., steaming in boilers, 1 Carp. 492. See also per Tindal, C. J., *Walton v. Potter* (1841), Web. P. R. 591.

^h Hindin. on Pat. 433.

ⁱ The *ruses* resorted to by the injured Patentee are frequently not inferior in refinement. The following account of the detection of an infringement on Morris's silk and cotton net Patent, 1764 (see *Morris v. Bransom* (1776), N. P., lace, 1 Carp. 30), is from Henson's History of Framework Knitters. The Patentee, "observing that the windows of Bransom's shop (at the top of the house) fronted the fields, he took notice that in the heat of the summer the workmen laboured with them open, and, on the Castle Hill, Morris and his witnesses took their station with a powerful telescope early in the morning, when Bransom usually worked the most diligently, lest his frames should be discovered by their noise. He by this means saw Bransom diligently employed in using the tickler machine, and immediately entered an action against him."

^k (1822) lacegassing machine, Web. P. R. 100.

^l Piracy by such agency is visited in France with peculiar severity.

machine and constructed one exactly similar. The difficulty was how to use it in the way of trade,^m the peculiarity of the work executed by the machine rendering its secret use impracticable. He proposed to enter into partnership with a bleacher, that, under cover of practising that trade, and sending some little lace to be gassed by the Patentee, he might render his machine profitably available in the lace trade.

In his Patent for "improvements in the manufacture of candles, and in apparatus for applying light," the Patentee in his first Specification claimed, first, the mode of manufacturing candles by the application of peculiarly formed plaited wicks; secondly, the mode of manufacturing candles by the application of two or more plaited wicks, so disposed that the ends always turned outwards; and, thirdly, the mode of applying lenses to lamps, in order to concentrate and conduct a portion or portions of the rays of light to a distance.ⁿ The plaintiff afterwards entered a disclaimer as to the first and third parts of his invention, and sued the defendant for an infringement of the second part. At the trial the plaintiff produced a candle purchased of the defendant, the wicks of which were so plaited that the ends always turned outwards. It was held, that the Patent was not for the candle itself, *but for the mode of manufacturing it*;^o and that the mere production of a candle made by the defendant, in which the wicks were so plaited that the ends always turned outwards, was no evidence of an infringement of the plaintiff's Patent.

Evidence of
infringement.

By the Law of 5 July, 1844, Titre V., Art. 43, if the infringer be a workman or servant in the establishment of the Patentee, or have obtained the knowledge of the invention by means of such servant or workman, an imprisonment of from one to six months is added to the usual punishment by fine.

^m *Sellers v. Dickinson* (1845), power-loom, 5 Exch. 312; (1851) Evid. 1450.

ⁿ *Palmer v. Wagstaff* (1854), 9 Exch. 94.

^o Compare *Huddart v. Grimshaw* (1803), K. B., cables, Carp. 200; and see *supra*, 138.

Presumptive
evidence.

The similarity of an article manufactured by a defendant to that made under a Patent is presumptive evidence of infringement—in a case in which it was contended that, where a mode of manufacture was secret, it would be a hardship to compel parties deriving great advantage from it to come forward and divulge it.¹ This, however, can be most satisfactorily met. If the defendant had made a valuable discovery, entirely independent of the plaintiffs, he was entitled to a Patent for securing the profits of it. Improvements by the infringer in adopting the invention render it an infringement none the less.^m To prove the identity of principle in two contrivances, mechanics may be called as witnesses.ⁿ

In *Heath v. Unwin*^o it was held, that the *modus operandi* given by the Patentee in his Specification was *only one instance* of how it might be used, and *did not limit the Patent*; that the defendant's process was only a neater and cheaper *modus operandi*, and that in that process he had used the carburet of manganese, and had directly infringed the Patent.

Mode of
making.

In the absence of direct evidence also, especially where the manufacture of the article is studiously concealed, the jury may infer that a manufacture sold by a defendant is an infringement of a Patent, from any peculiar character common to the Patent and to the article made or sold by the defendant, coupled with other circumstances. "I should state," said Lord Ellenborough, in *Huddart v. Grimshaw*, "that this is certainly *primâ facie* evidence of its having been made by that method. When one sees it agree in all its qualities, when it is produced

¹ *Huddart v. Grimshaw*.

^m *Electric Telegraph Company v. Brett* (1851), 10 C. B. 838; and see *Heath v. Unwin*, Exch. (1852), cast steel made with carburet of manganese, 19 L. T. 272.

ⁿ *Webster v. Uther* (1824), Godson on Pat. 232. See per Story, J., in *Odiorne v. Winkley*, 2 Gallison, Rep. 51; Curtis on Pat. 263.

^o (1852) Ex. Ch. (cast steel), 19 L. T. 272; (1845) 13 M. & W. 583.

with a rope actually made upon Mr. Huddart's plan, it is *primâ facie* evidence, until the contrary is shown, that it was made upon his method; and therefore, as against him, as it should seem, supposing this Patent in full force and a valid one, it is reasonably fair evidence, in the absence of contrary evidence, to presume that it was made in that way."^p

A Specification described the improvements effected by the Patentee as consisting in "the use of carburet of manganese in any process whereby iron is converted into cast steel." The course followed by the Patentee was "by introducing into a crucible bars of steel broken into fragments, mixtures of cast and malleable iron, or malleable iron and carbonaceous matter, along with from one to three per cent. of their weight of carburet of manganese." The defendant produced the same result, a superior and more valuable description of cast steel, as certainly and more cheaply by substituting for the carburet of manganese oxide of manganese and coal tar, which, being put into the crucible with the iron, according to the evidence of chemists would form "carburet of manganese" before the iron was in a state of fusion, and consequently before any combination therewith could take place. It was held, on a bill of exceptions, that the judge was wrong in telling the jury that there was no evidence of infringement.^q

As a general rule, questions of Law, including the construction of written instruments, are for the judge, matters of fact for the jury, to decide. The meaning, however, attached to particular words in the Specification may, especially where it is of a local or customary character, be matter of fact for the jury. In *Hill v. Thompson*,^r Lord Eldon intimates that the intelligibility of the Specification is entirely for the jury. In *Lowell*

Judge's ruling.
Province of
the jury.
Law and fact.

^p (1803) K. B., rope, 1 Carp. 231.

^q *Heath v. Unwin* (1854), Ex. Ch., 3 C. & K. 522.

^r (1817) iron, 3 Mer. 630.

v. *Lewis*^c it was ruled by Mr. Justice Story, that it was matter for the consideration of the Court whether the invention was described with reasonable certainty. In *Hornblower v. Boulton*,^d the sufficiency of the directions in the Specification as to the construction of the machine was said to be purely a question for the consideration of the latter, and one as to which the Court would not subsequently interfere with its decision.

Direction.

The following remarks made by the learned Chief Baron in a case frequently before referred to^e are well worthy of attention. The learned judge at the trial had directed the jury that, in order to find infringement, they must find that some part of the Patent, that is, some new and material part of it, had been used by the defendants. If a judge, when a Patent case is before him, is to read a lecture on the natural philosophy which belongs to the Patent, and to be strictly correct in every remark he makes, I am afraid few Patent cases would stand. No doubt he is to construe the Specification and tell the jury what the Patent is for, but it is for them to say whether the facts brought before them do or do not amount to an infringement.

Question for the jury.
Judge's direction.

On a plea denying the novelty of an invention, it appeared, from the evidence of witnesses for the defendant, that for eight or ten years before the grant of the Patent three firms had manufactured steel in the manner described in the Patent, and had used and sold the steel so manufactured in the way of their trade and without concealment. The judge directed the jury that, if they believed the witnesses for the defendant, the Patent was void. Held, that there was no other question for the

^c (1817) pump, 1 Mason, 190.

^d (1799) Ex. Ch., steam engine, Watts', per Lawrence, J., *Webster v. Uther* (1824), gun lock, Godson, 232; *Barton v. Hall* (1827), *ibid.* *Barber v. Grace* (1848), Exch., hosiery, woollen, 1 Exch. 339; 17 L. J. Exch. 122.

^e *Newton v. Grand Junction Railway* (1847), iron axles, 5 Exch. 335.

jury, and that there was such a public use of the invention as invalidated the Patent.^f

In *Barton v. Hall*^g the judge directed a nonsuit, taking upon himself to decide that the pistons which were alleged to be infringements were not the same invention as that described in the Specification of the plaintiffs.

It is an erroneous direction to charge that the evidence of prior public use, to invalidate the Patent, must show that "the use must continue to the time when the Patent was granted, not to the very exact period, but that it must have been known and used as a useful thing at the time."^h On an issue arising from a plea that the invention was not an invention of a manner of new manufacture, the direction that, if the jury believed the evidence, the invention was not any manner of new manufacture, and the action could not be maintained, is right, if the plaintiff's claim to novelty in the construction of his machine be not supported by the evidence.ⁱ

Misdirection.

Bloxum v. Elsee.

In *Allen v. Rawson*,^j two portions of the invention claimed by the Patentee (Williams) were disputed, as founded on the suggestions made by others. The learned judge, Erle, J., told the jury that, in his opinion, these suggestions were mere subordinate improvements accessory to the main principle of the invention, and tending to carry it out more conveniently, and, therefore, such as the Patentee had a right to adopt and embody in his Specification; and he left it to the jury to say whether *Williams* was the inventor of that which he claimed. The jury returned a verdict for the plaintiff's assignees of the Patent. In discharging a rule obtained for a new trial on

^f *Heath v. Smith* (1854), Q. B., cast steel, 18 Jur. 601.

^g (1827) metallic pistons, Godson, 233.

^h *Househill Company v. Neilson* (1843), H. of Lords, iron, 9 Cl. & Fin. 788.

ⁱ *Bush v. Fox* (1854), Exch., caissons, 22 L. T. 349, per Pollock, C. B.

^j (1845) C. B., woollen fabrics, 1 C. B. 551.

the ground of misdirection by the judge, Maule, J.,^k remarked, "A judge undoubtedly has no right to state his own assumptions of fact to the jury as matters of law, but he has a right to give his opinion, and it is his duty to do so; and unless the jury is misled by what he says, there is no reason for granting a new trial." With reference to the direction he had given, Erle, J., remarked, it "was not laying down any principle of law, but merely making a very direct statement upon the facts."

Verdict.

Objections to the verdict on the ground of mistake in the panel must be taken before verdict. The effect of an unqualified person serving on the jury is to render the proceeding a mis-trial, and necessitates a *venire de novo*.^l

Interpretation
by the Court.

Frequently the effect of the finding of the jury upon the question of infringement has to be determined by the Court. In *Sellers v. Dickinson*^m the Specification claimed a "novel arrangement of mechanism, designed for the purpose of instantaneously stopping the whole of the working parts of the loom whenever the shuttle stops in the shed." The jury found specially, that the plaintiff's arrangement of machinery for stopping looms by means of the action of the clutchbox, in combination with the action of the break, was new and useful; also that the plaintiff's arrangement of machinery for bringing the break into connection with the fly-wheel was new and useful, and that the defendant's arrangement of machinery for the latter purpose was substantially the same as the plaintiff's. The Court of Exchequer held upon these findings, first, that the Specification was good; secondly, that the defendant had infringed the Patent. In *Nickels v. Ross*ⁿ the finding of the jury, that the plaintiff's machine was new, but that the use of a hollow

Special finding.

^k Page 576.

^l *Ashburnham v. Michael* (1851), 16 A. & E., N. S., 620.

^m (1850) power-looms, 5 Exch. 312.

ⁿ (1849) C. B., braid, 8 M. G. & S. 679.

revolving spindle was *not* new, was held not to negative the novelty of the plaintiff's invention, inasmuch as his claim was not for the hollow spindle *generally*, but *fixed*.

As may be expected, in many instances it requires the greatest nicety to distinguish points of Law from points of fact—the province of the Judge from that of the jury—a difficulty which, it is to be hoped, the recent enactments will go far to remove in Patent trials. Prior to the date of Plaintiff's Patent, madder dye had been obtained from fresh madder by the application of hot water, but there still remained in the dye vats a residuum called "spent madder," which was known to contain some colouring matter, but which had never been extracted from it. The "spent madder" was consequently thrown away as useless. Some time prior to the plaintiff's Patent, a process was discovered which, by the application of hot water and acid to fresh madder, produced a dye called garancine, which possessed different properties to the old madder dye. This process extracted the whole colouring matter from the fresh madder. The plaintiff by his Patent claimed the application of his process to "spent madder," whereby he obtained garancine, and the "spent madder" thereby became of much value. Held, in error, that as "spent madder" might be in its nature and properties the same as or different from "fresh madder," it did not follow *as matter of law* that the plaintiff's Patent was void, but that it was a question of fact for the jury whether the plaintiff's invention was a new manufacture of garancine.^o And that the learned judge (Pollock, C. B.) was wrong in treating the conclusion to be drawn from the evidence as *matter of law*, and that the exception was well pointed in treating it as a matter of fact, which should have been left to the jury, with such remarks, of course, as the learned judge might think proper to make for their assistance.

^o *Steiner v. Heald*, Exch. Ch. (1851), garancine, 6 Exch. 607.

Presumption. The jury proceed on the assumption that plans and
 Special findings. models submitted to them are correct." In many cases
 their verdict consists in a series of special findings. They
 may find that the use of certain mechanical contrivances
 is not new, but that the plaintiff's mode of connecting or
 combining them is new. In a case before alluded to, the
 Defendant having pleaded, 1. Not guilty; 2. A traverse
 that the plaintiff was the inventor; 3. A traverse that
 the invention was new, the Plaintiff at trial put in his
 Specification, which claimed three well-known things.
 He proved by his own evidence that the invention which
 he really claimed, and which he thought he had described
 in his Specification, was the combination of the three
 things. It was held, that the Specification was evidence
 for the jury, but not conclusive, and that they were jus-
 tified in finding that the invention consisted in the com-
 bination.ⁿ

The jury may find that the invention is no manner of
 new manufacture, if the evidence show that the articles
 claimed by the plaintiff in his Patent and those contained
 in other Patents are the same in the material particulars,
 although they differ in the mode, place and manner of
 their being employed.^p A finding by the jury that there
 is infringement necessarily imports novelty in the inven-
 tion.^q The jury may find that the Patent is valid, but
 that the defendant has not infringed the Patent.^r A
 finding that the only novelty in a railway turntable in-
 vented by the Plaintiff consisted in the *suspending rods*
 (all the rest of the machine having been described in the
 Specification of a Patent previously granted to another

ⁿ *Gamble v. Kurtz* (1846), C. B., soda, sulphate, muriatic acid, 29 Lond. Journ. 57.

^o *Bateman v. Gray* (1853), Exch., plugs, valves, &c., 1 C. L. Rep. 512.

^p *Bush v. Fox* (1854), Exch. Ch., caissons, 22 L. T. 349.

^q *Newton v. Grand Junction Railway Company* (1847), Exch., iron axles, 5 Exch. 335.

^r *Hyde v. Trent* (1854), cocoa-nut fibre, 45 Lond. Journ. 135.

person), was held to amount to a verdict on a plea taking issue on the sufficiency of the Specification.³

The fact of a *scire facias* pending is a ground for refusing a nonsuit on an objection to the validity of the Patent.⁴ Nonsuit.

The damages given in most cases of infringement, until recently, were nominal,⁵ the object of the Patentee in his action at Law being simply to establish his Patent, as a first step to receiving the assistance of equity towards his pecuniary reimbursement for the loss suffered from the infringement. In some, however, the damages have been exemplary. In *Lewis v. Marling*⁶ they were assessed at 200*l.*; in *Newton v. Grand Junction Railway Company*⁷ they amounted to 1,000*l.* In the United States it seems the custom to award large damages.² Damages.

The judge before whom any action for infringement in any of her Majesty's Superior Courts of Record at Westminster or in Dublin is tried, may certify on the record that the validity of the Letters-patent in the declaration mentioned came in question; and the record with such certificate being given in evidence in any suit or action for infringing the said Letters-patent, or in any proceeding by *scire facias* to repeal the Letters-patent, shall en- Judge may certify that the validity of the Patent came in question. Full costs.

³ *Holmes v. London and North Western Railway Company* (1852), C. B., 3 C. & K. 831.

⁴ *Haworth v. Harcastle* (1834), calico-drying machine, 1 Bing. N. C. 182.

⁵ Usually for forty shillings at least, a less sum not entitling, under 3 & 4 Vict. c. 24, to the costs in the action.

⁶ (1829) K. B., plush, 1 Carp. 475.

⁷ (1845) Exch., railway axles, 5 Exch. 331; 27 Lond. Journ. 221.

² *McCormick v. Scymour* (1851), reaping machine, damages 3,575 dollars; *Emerson v. Hogg* (1845), submerged wheel propeller, 26 Lond. Journ., damages 17,606 dollars. By an Act of Congress of 1836 (cap. 357, ss. 13 and 14) the jury was required to assess the actual damages sustained by the Patentee, which were then trebled by the Court. A similar provision was made in the Act of 1800 (cap. 25). See per Story, J., *Whittemore v. Cutter* (1813), cotton cards, 1 Gall. 483, and *Lowell v. Lewis* (1817), pump, 1 Mas. 182.

title the Plaintiff in any such suit or action, or the Defendant in such proceeding by *scire facias*, on obtaining a decree, decretal order or final judgment, to his full costs, charges and expenses, taxed as between attorney and client, unless the judge making such decree or order, or the judge trying such action or proceeding, shall certify that the Plaintiff or Defendant respectively ought not to have such full costs.^a If after a verdict with contingent damages, on the argument of the demurrer the Court hold the declaration to be insufficient, the plaintiff is not entitled to deduct the costs of the trial from the defendant's costs on the demurrer.^b In taxing the costs in any action for infringement in any of her Majesty's Superior Courts at Westminster or in Dublin, regard is to be had to the particulars delivered in such, and the plaintiff and defendant respectively shall not be allowed any costs in respect of any particular, unless certified by the judge before whom the trial was had to have been proved by such plaintiff or defendant respectively, without regard to the general costs of the cause.^c

Particulars to be regarded in taxation of costs.

Treble costs.

The provisions of Stat. 5 & 6 Will. IV. c. 83, s. 3, gave the parties in the like cases treble costs, "to be taxed at three times the taxed costs." The peculiar nature of the evidence required and the technical rules regulating taxation of costs seem to have devised treble costs, in the case of Patents, with the view of thus reimbursing the Patentee his actual expenses. The rule was, however, abused. Mr. Godson mentions an instance in which a successful Patentee commenced no less than forty actions. As to suing *in formâ pauperis*, see *Rubery v. Morris*.^d

^a Stat. 15 & 16 Vict. c. 83, s. 43. See *Gillett v. Wilby* (1839), *cab*, 9 C. & P. 334.

^b *Partridge v. Gardner* (1849), 18 L. J., Exch. 415, and affirmed (1851), 6 Ex. 621, overruling *Bird v. Higginson* (1836), K. B., 5 A. & E. 83.

^c Stat. 15 & 16 Vict. c. 83, s. 43.

^d 1 Russ. & Myl. 415. See Tidd's Practice, and Chitty's Archbold Pr. tit. Treble Costs; *Gillett v. Wilby* (1839), *cab*, 9 C. & P. 334.

Costs of experiments, models and scientific evidence are disallowed in taxation when made for the purpose of affording evidence on a point in dispute new to scientific men.^e In *Moor v. Adam*^f and *Willis v. Peckham*,^g scientific and professional men, not being medical men, were declared disentitled to compensation for loss of time. Costs of scientific evidence.

After a verdict in a successful action^h for infringement, the Plaintiff produced the record of a former trial, in which the Patent had been affirmed, and claimed treble costs. Held, that the evidence of such former trial was admissible, and that the proper course was to produce such record after the trial, and not before it. Production of record of former trial.

A Court of Equity regards the indorsement on the *postea* of the facts found by the jury as much as the verdict, the whole inquiry being merely for the information of the Court of Equity.ⁱ Indorsement on the postea.

When exceptions are taken to the direction of a judge, it is not enough to state in the bill of exceptions that he declined to direct the jury in the way suggested, without showing what his direction was.^k If, upon a bill of exceptions to the Judge's charge, the superior Court see that there was a misdirection calculated to mislead the jury, the Court has no discretion, but must allow the exception and grant a new trial, even although the verdict be right. Not so, however, in the case of a motion for a new trial on the ground of misdirection. Bill of exceptions must state what the direction was.

In all cases of rules to enter a verdict or nonsuit upon a point reserved at the trial, if the rule to show cause be New trial, even if verdict right.

^e *Severn v. Olive* (1821), sugar boiling by heated oil, 3 Br. & B. 72.

^f (1816), K. B., 5 M. & S. 156.

^g (1820) 1 Br. & B. 515.

^h Per Campbell, C. J., *Newall v. Wilkins* (1851), N. P., wire rope, 17 L. T. 20.

ⁱ Per Cottenham, L. C., *Kay v. Marshall* (1841), flax spinning, 8 Cl. & Fin. 241.

^k *M^r Alpine v. Mungnall* (1846), C. B., weaving machinery, 3 C. B. 496.

refused, or granted and then discharged, or made absolute, the party decided against may appeal.^a In all cases of motions for a new trial on the ground that the judge has not ruled according to Law, if the rule to show cause be refused, or, if granted, be then discharged or made absolute, the party decided against may appeal, provided any one of the judges dissent from the rule being refused, or, when granted, being discharged or made absolute, as the case may be; or provided the Court in its discretion think fit that no appeal should be allowed.^b Notice of appeal must be given within four days of the decision complained of, or such further time as may be allowed by the Court or a judge.^c The appeal is to be upon a case to be stated by the parties, in which is to be set forth so much of the pleadings, evidence and the ruling or judgment objected to as is necessary to raise the question for the decision of the Court of Appeal.^d

Notice of appeal.

Proceedings in the Court of Appeal.

The Exchequer Chamber and House of Lords are the Courts of Appeal.^e Where the appeal is from the refusal of the Court below to grant a rule to show cause, and the Court of Appeal grants such rule, the rule is to be argued and disposed of in the Court of Appeal.^f The judgment of the Court of Appeal is to be such as should have been given in the Court below, and further proceedings in the action are to be taken upon it as if that judgment had been given by the Court in which the record originated.^g The Courts of Appeal may adjudge payment of costs, order restitution, and award process.^h The House of Lords will not allow parties to raise objections on appeal which they did not raise in the Court below.ⁱ

Appeal.
House of Lords.

^a Stat. 17 & 18 Vict. c. 125, s. 34.

^b Ibid. s. 35.

^d Ibid. s. 39.

^f Ibid. s. 40.

^h Ibid. s. 42.

^c Ibid. s. 37.

^e Ibid. s. 36.

^g Ibid. s. 41.

ⁱ *Kay v. Marshall* (1841), flax spinning, 8 Cl. & Fin. 244.

The questions arising out of licences differ but little from those connected with contracts in general.^k During the continuance of the licence the Plaintiff may sue at any time for the breaches in any former year, but if the licence be at an end he must include in one action the whole *gravamen* he would probably sustain therefrom.^l With respect to estoppel,^m the before-mentioned analogy, drawn from the relation of landlord to tenant in a lease, has been adopted as the standard of reference by Courts of Law in deciding matters at issue between the proprietors of Patent right and the Licencee. In a case before Lord Kenyonⁿ it was held, that a Patentee having conveyed away his interest under the Patent, and subsequently infringed the Patent right, was estopped from denying that he had a good title to convey. In *Hayne v. Maltby*^o the Defendant was held not to be estopped by covenants to use the invention in a particular manner, and not to use any other, from pleading in bar to the action that the invention was not new or that the Patentee was not the inventor. In deciding the case with reference to this analogy, Mr. Justice Buller observed, "The facts disclosed by the pleas are equivalent to an eviction of the tenant. A tenant enjoys the land leased until he is evicted, but Licencees, in the event of large infringement

Licences.

Contracts.

Estoppel.

Analogy of a lease.

^k Turner on Pat. 70.

^l *Clossman v. Lacoste* (1854), Q. B., 23 L. T. 91.

^m So called, according to Lord Coke, "because a man's own act or acceptance stoppeth or closeth up his mouth to allege or plead the truth raised by implication." Among the rules laid down respecting estoppels are these: "Every estoppel that concludeth a man to allege the truth must be certain to every intent, and not be taken by argument or inference;" also, "every estoppel ought to be a precise affirmation of that which maketh the estoppel, and not to be spoken impersonally." Co. Litt. 325 b; Ib. 352 a; Com. Dig. "Estoppel" (A 2); *Willoughby v. Brook* (1600), Cro. Eliz. 756; *Rainsford v. Smith* (1560), Dyer, 196 a; *Taylor v. Zamira* (1816), C. B., 6 Taunt. 524.

ⁿ *Oldham v. Langmead* (1789), 3 T. R. 439.

^o (1789) K. B., point net, 3 T. R. 438; Dav. Pat. Cas. 156.

by the trade, find that they are paying valuable consideration for the grant which all the world use without it, so that in fact it is by analogy equivalent to eviction. In the common action for use and occupation, the tenant is not allowed to dispute his landlord's title."

By recitals.

In *Bowman v. Taylor*^o the defendants were held to be estopped by recitals in the deed of licence from disputing that the Plaintiff was the inventor, the invention was new, and that the Specification had been duly enrolled. But where issue is taken upon facts stated in a plea, which facts the Defendant is estopped in point of Law from pleading in bar, a judge cannot refuse to hear evidence upon that issue, but the Defendant is entitled to have his evidence submitted to the jury.^p Where, however a motion for an injunction against an equitable assignee of the whole interest of a Licencee is ordered to stand over, with liberty to the Plaintiff to bring an action, the equitable Licencee will not be required in Equity to admit the validity of the Patent or the fact of his being a Licencee.^q

Determination
of the licence.

In deciding the question of the determination of a licence by breach of the covenants the same analogy guides the Court. In *Warwick v. Hooper*^r the Plaintiffs were the assignees of the Patent. The Defendant accepted a licence upon certain terms; amongst others, to pay rent or royalty to the amount of 2,000*l.* a year, to be made up at the end of each year in the manner stated in the licence, the Plaintiffs reserving to them-

^o (1831) K. B., powerloom, 4 L. J., N. S., 58; 2 Ad. & E. 278; 1 Carp. 655: see also *Bowman v. Rostron* (1835), K. B., 2 Ad. & E. 295; and *Lainson v. Tremere* (1834), K. B., 1 Ad. & E. 792; 3 N. & M. 603.

^p *Bowman v. Rostron* (1834), K. B., 4 L. J., N. S., 59.

^q *Pidding v. Franks* (1849), L. C., coffee and cocoa, 18 L. J., N. S., 295.

^r (1850) powerloom, 3 M. & G. 67. With regard to the relation of express to implied covenants, see *Line v. Stephenson* (1838), C. B., 5 Bing. N. C. 183; 7 L. J., N. S., 263.

selves the power, in default of such payment, of determining the licence. The Defendant made default. The Plaintiffs notwithstanding allowed him for several years to use the Patent, and received from him a less annual sum than that stipulated. At length they determined the licence, having subsequently to the expiration of the previous year received from the Defendant payment on the footing of the reduced rent. By so doing, the Plaintiffs were held to have elected not to treat the previous breach as a forfeiture of the licence. "The principle," observed the Lord Chancellor, "upon which this position depends has been frequently recognized and adopted in cases between landlord and tenant; as where a tenant has committed a breach of covenant in a lease which the landlord by a proviso in the lease was authorized to treat as a forfeiture, and the landlord, with full knowledge of the breach of covenant, has afterwards treated the term as continuing, and received rent under the lease which had grown due for a period of time commencing subsequently to his knowledge of the cause for forfeiture. In such cases the receipt and acceptance of such rent under such circumstances has been held to be a conclusive election on the part of the landlord not to treat the breach of covenant as a forfeiture, and to preclude him from afterwards avoiding the lease by reason of the previous breach of covenant. I cannot perceive any distinction between the present case and the case of a landlord and tenant under a lease."

In *Bower v. Hodges*⁸ the declaration stated, that by deed, A., the Patentee of certain machinery for making pipes, granted B. and his assigns the exclusive licence to manufacture iron pipes, yielding a royalty of so much for every ton of pipes made or sold by B. or his assigns, "to be paid" within twenty-one days of the end of each quarter, B. covenanting for himself and his assigns to render an account in writing within seven days

⁸ (1853) C. B., 22 L. J., N. S., 194.

of the end of each quarter of the amount manufactured, and to pay within twenty-one days the sum which should appear due on the face of the account; that B. transferred his interest in the licence to the plaintiff, who transferred it to M. and R., in trust for the defendants, who were to carry on business as the W. I. T. Company; that the defendants covenanted with the plaintiff to perform the covenants made by B. to A. in the first deed; that the W. I. T. Company made quantities of iron tubes in pursuance of the licence, whereby royalties became due to the plaintiff. Breaches alleged, that the Defendant did not pay the royalties and did not render an account. It was held, that the covenant to render an account was only auxiliary to and did not control the preceding covenant to be implied from the words "to be paid." The declaration was on general demurrer held good, although it did not directly aver that any iron pipes were made by B. or his assigns.

*Cutler v.
Bower.*

In the recent case of *Cutler v. Bower*, in the Queen's Bench, the question of estoppel, in the case of a Licence, was also much discussed; but, an objection taken to the pleas of the Defendant prevailing, remained undecided. Some other points of interest connected with the covenants were however decided. The circumstances were these:—By indenture of the 11th October, 1842, reciting the grant of Letters-patent to the Plaintiff, and a deed of the 23rd July, 1842, by which Plaintiff granted to Defendant the sole licence to make and vend the Patent invention, subject to the payment of a royalty, with a proviso keeping the royalty at an average of 16*l.* 13*s.* 4*d.* per month; and also reciting that Defendant had agreed with plaintiff for the purchase of one-half of the Patent, subject to the deed of the 23rd July, 1842, but with the benefit to Defendant of one-half of the royalty thereby reserved, Plaintiff, in consideration of 2,200*l.*, assigned to a trustee for Defendant the Letters-patent and the matters intended to be assigned as therein mentioned.

The action was brought upon the covenant to pay the sum of 2,200*l.* by instalments. The defence attempted to be set up by the pleas was failure of consideration, on the ground that the Patent was invalid, and the Defendant therefore not bound by his covenant to pay purchase-money for a Patent which it was said turned out to be worthless. "It appears to me," said Lord Denman, C. J., in delivering the judgment of the Court, "that there are two decisive objections to this defence. The first is, that there not having been any eviction, the consideration does not wholly fail, for the defendant was at all events bound by the indenture of the 23rd July to pay 16*l.* 13*s.* 4*d.* a month for royalty to the plaintiff, whether the Patent were valid or not, as he would be estopped in an action upon that deed from denying the validity of the Patent; and by the deed upon which the action is brought he becomes entitled to half that royalty;" and, in the next place, the proposed defence would only be available in case the covenant upon which the action is brought was a dependent covenant, to be performed only if some condition is observed by the other party; but in this case the covenants of the plaintiff relating to the Patent, and that of the defendant for the payment of the purchase-money, are wholly independent of each other, and each party may recover against the other for a breach of their respective covenants. There is no plea of fraud^u or eviction, and it appears to us that upon this deed and these pleadings the invalidity of the Patent, as stated in the pleas, affords no ground of defence at Law to an action upon the covenant in question, which may be considered in effect as a mere covenant in gross for the payment of money.^u

In *Haddan v. Smith*^x the plaintiff granted a licence to *Haddan v. Smith.*

ⁱ (1818) Q. B., tubular flues, 12 Jur. 723.

^u See *Lovell v. Hicks* (1837), Eq. Exch., baking apparatus, 2 Yo. & Coll. 481.

^x (1817), V. C. railway wheel, 16 Sim. 44.

S. to use the invention on payment of a certain royalty for every wheel made, with a proviso that the licence was to be void in the event of S. taking a partner. This provision was, however, dispensed with on the occasion of S. taking W. into partnership. The Plaintiff filed a bill against S. & W. for an account on the footing of the licence, and for an injunction to restrain the Defendants from using the invention in case they should dispute his right to the payments reserved by the licence, on the ground that the licence had become void. A general demurrer to the bill on account of inconsistency in the relief prayed, the account being sought on the ground that the licence was good, and the injunction, on the ground that it was void, was overruled, the question raised by the bill being held to be, not whether the licence was void, but whether a contract made by the Plaintiff and one of the Defendants was binding on the other Defendant also.

Patent void.

Payments under the licence.

In the case of *Taylor v. Hare*^y it was held, that in the event of the Patent proving void, the Licencee was not entitled to receive back the money paid under the licence. It rested, however, much on the *bonâ fide* nature of the proceedings as far as the Defendant, the Patentee, was concerned, and the advantage the Plaintiff had derived from the use of the invention. "There never has been a case, and there never will be," observed Mr. Justice Heath, "in which a Plaintiff, having received benefit from a thing which has afterwards been recovered from him, has been allowed to maintain an action for the consideration originally paid. It might as well be said, that if a man lease land, and the lessee pay rent and afterwards be evicted, that he shall recover back the rent, although he has taken the fruits of the land." "The Plaintiff," said Mr. Justice Chambre, "has had

^y (1805) C. B., brewing copper, Dav. Pat. Cas. 310; 1 N. R. 260; *Hayne v. Maltby* (1789), K. B., point net, Dav. Pat. Cas. 156; 3 T. R. 438.

the enjoyment of what he stipulated for, and in this action the Court ought not to interfere unless there be something *ex æquo et bono* which shows that the defendant ought to refund.”

Where parties mutually enter into various covenants, and further covenant that on breach of any one covenant by either of the parties covenanting, a certain sum shall be paid as liquidated damages for breach of the covenant, it is in the discretion of the Court to restrain breach of covenant. In *Smith v. Dickinson*² it was said, that if a party agree not to do some specified act under a “penalty” of 100*l.*, such sum cannot be considered in the nature of liquidated damages.

Injunction.

Liquidated damages.

² (1804) C. B., 3 B. & P. 630. See, as to Licences in these respects, *Astley v. Welden* (1801), C. B., 2 B. & P. 346; *Barton v. Glover* (1815), Holt, N. P. C. 43; *Harrison v. Wright* (1811), K. B., 13 East, 343; *Coles v. Simms* (1854), L. J., 23 L. J., Ch., 258; 22 L. T. 277.

CHAPTER X.

REMEDY OF PATENTEE BY BILL IN EQUITY.

Suit in Equity. THE alternative remedy for a Patentee, whose rights have been infringed on, is by a Bill in Equity,^a praying an injunction of the Court to restrain the infringer from further violation of those rights, and an order to him to account for and pay over to the plaintiff the profits derived from the infringement.^b

Injunction. The injunction is in the nature of a special injunction of the Court, restraining persons from committing damage or injury to property.^c It is said not to be an original jurisdiction, but exercised solely in aid of a legal right,^d on principles similar to those obtaining in the cases of nuisance, breach of contract and waste, the invasion of copyright or the property in secrets of trade and trade marks. Its exercise is not necessarily confined to the terms of the Patent right, the Court interfering even after its expiration to restrain the sale of articles made during

^a An injunction will not be granted on a claim. *Holden v. Culcraft* (1850), V. C., K. B., 14 Jur. 846.

^b 3 Steph. Com 524.

^c And not on account of the Patent being an exclusive privilege. *Culcraft v. West* (1845). L. C., Dublin Theatre Patent, 2 Jones & Lat. 128. "The proper officer of the Court, upon an application for an injunction, is not to ascertain the existence of a legal right, but solely to protect the property until that right can be ascertained by the jurisdiction to which it properly belongs." Per Cottenham, L. C., *Harman v. Jones* (1841), 1 Cr. & Ph. 299; Mitford's Ch. Pl. (5th ed.), 158; *Sparrow v. Oxford, Worcester and Wolverhampton Railway Company* (1851), 9 Hare, 441.

^d 2 Story, Eq. Jur. 209; Jeremy, Eq. Jur., bk. iii., c. 2, s. 1; 1 Fonb. Eq. 34, n.; Drewry, Inj. 220; *Bacon v. Jones* (1839), L. C., gas-burner, 4 My. & Cr. 436; *Saunders v. Smith* (1838), L. C., copyright, 3 My. & Cr. 728.

its continuance in fraud of the Patentee.^e The Plaintiff is entitled to an injunction although the defendant may promise to commit no further infringement and offer to pay the costs of the Bill.^f

In tracing the course of this jurisdiction in its exercise with respect to Patents, we find the explanation of much that strikes us at first sight as anomalous in its practice, particularly in the position assumed by the Court in connection with proceedings at Law. Here, as in other branches of our Law before alluded to, the practice of the Court of Chancery has survived the state of things for which it was originally designed. Long after the Patentee had ceased to be a Royal favourite, obnoxious to the public interests from having a monopoly of the necessities of life, the Court^g refused to enforce a right claimed under Letters-patent or Charter from the Crown, until the right had been tested by the ordeal of a trial at Law.^h History.

^e *Crossley v. Beverley* (1829), L. C., 1 Russ. & My. 166, n.; 13 L. J., N. S., 25.

^f *Frudell v. Weller* (1831), M. R., 2 Russ. & My. 247.

^g In Coke's note (3 Inst. 181) on the clause of the Statute of Monopolies, declaring that cases of Patent right "shall be for ever hereafter examined, heard, tried and determined by and according to the Common Laws of this realm, and not otherwise," we find an explanation of the reasons of thus restricting the trial. "This Act having declared against all Monopolies, &c., to be void by the Common Law, hath provided by this clause that they shall be examined, heard, tried and determined in the Courts of the Common Law, according to the Common Law, and not at the *Councill Table, Starchamber, Chancery, Exchequer Chamber or any other Court of like nature*, but only according to the Common Laws of this realm, with words negative and not otherwise. For such boldnesse the Monopolists took, that often at the Councill Table, Starchamber, Chancery and Exchequer Chamber, petitions, informations and bills were preferred in the Starchamber, &c., pretending a contempt for not obeying the commandments and clauses of the said grants of Monopolies, and of the proclamations, &c., concerning the same; for the prevention of which mischief this branch was added." Dan. Ch. Pr. 2nd ed. 1511; Godson, 2nd ed. 251; *Prodgers v. Phrazier* (1682), L. K., 1 Vern. 137.

^h *Blanchard v. Hill* (1742), L. C., cardmakers' charter, 2 Atk. 484.

Without reference to its origin the principle had become a maxim of the Court; and in process of time a fictitious inability^l was the cause on which it founded its refusal to decide questions involving the validity of the grant, the claim of the Plaintiff to the property it conferred, and the fact of infringement. By degrees, however, the Court advanced to the position it was entitled to assume. In *Hicks v. Raincock*^k a demurrer to a Bill for an injunction to stay the infringement of a Patent, on the ground that the Plaintiff had not established his right at Law, was overruled;^l and in *Newman v. Milner* it was said by the Lord Chancellor never to be the right of a defendant to have a case transmitted for trial at Law, but that where the title of the party was clear a Court of Equity would act without a reference.^m

At a much later periodⁿ we find Lord Eldon thus asserting the inability of the Court,—“Where the Patent is but of yesterday, and upon an application being made for an injunction it is endeavoured to be shown in opposition to it that there is no good Specification or otherwise that the Patent ought not to have been granted, the Court will not, *from its own notions respecting the matter in dispute*, act upon the presumed validity or invalidity of the Patent without the right having been ascertained by a previous trial, but will send the Patentee to Law and oblige him to establish the validity of his Patent in a Court of Law before it will grant him the benefit of an injunction;” and, again, in *Wilkins v. Aikin*,^o—“Where a fair doubt appears as to the Plaintiff’s legal right, the Court always directs it to be tried, making some pro-

^l Fonb. Eq. 43.

^k (1785) Thurlow, L. C., stocking, 2 Dick. 647.

^l See also the recent case of *Soltau v. De Held* (1851), 2 Sim. N. S. 133, and cases there cited.

^m (1794) 2 Ves. jun. 486.

ⁿ (1817) iron, 3 Mer. 622.

^o (1810) copyright, 17 Ves. 481.

vision, the best that may be, for the benefit of both parties.”

In point of fact, the Court of late has acted independently of references to Law. If, upon a special case stated, the opinion of one Court was not satisfactory, it was sent to another, sometimes to a third; and cases have occurred in which, after obtaining the opinion of more than one, the Court has acted upon its own impressions as to the case in preference to adopting any of them. In *Wilson v. Tindal*^p the Master of the Rolls said, when directing an action at Law, he entertained no doubt whatever as to the power of the Court to grant an injunction *simpliciter*.

Virtual independence of the Court of Equity.

Certain rules were, however, adopted with respect to the effect of the proceedings directed at Law. If a Bill of Exceptions were properly tendered, the Court would await its disposal before granting an injunction in consequence of a verdict for the Patentee.^q In *Mangnall v. Benecke*,^r however, an injunction was granted notwithstanding a Bill of Exceptions had been tendered and was undisposed of. Similarly, a rule *nisi* for a new trial having been obtained and then pending, the Court, in *Collard v. Allison*, considered the legal title as still incomplete.^s

Verdict not sufficient.

The points upon which a reference was had to trials in Courts of Law previous to the injunction were mainly three—the validity of the Patent, the title of the Plaintiff; and the fact of infringement by the Defendant. Where, upon any of these points, the Court was doubtful, it has of late years shown great reluctance to exercise its powers of injunction.^t A very usual course has been to refuse

Three points.

^p (1841) cocoa-nut oil, Web. P. R. 730, n. See also *Sanxter v. Foster* (1841), M. R., 1 Cr. & Ph. 302.

^q *Bridson v. M'Alpine* (1845), M. R., machinery for drying wove fabrics, 8 Beav. 229.

^r (1849) M. R., same Patent, 34 Lond. Journ. 295.

^s (1839) pianoforte, 4 My. & Cr. 487.

^t 18 Jur. pt. 2, 338. See as to the cases of copyright in which the

the injunction until an action at Law has been tried to establish the right, the Defendant in the meantime undertaking to keep an account.⁴ By these means, assuming the solvency of the Defendant,⁵ the Plaintiff can be recouped for the loss he has sustained without running the risk of committing an irreparable injury to the Defendant by disturbing the *status in quo* of the parties.⁶

Expediency.

Oftentimes, when conflicting affidavits⁷ render it impossible for the Court to arrive at conclusions satisfactory, it is driven to decide on the principle of expediency,⁸ and to weigh the probabilities of injustice to either party from the granting or refusing the injunction, in the event of the hypothesis on which it acted proving subsequently incorrect. In some cases the injunction, by stopping extensive works, may do a mischief to the Defendant, if in the right, which can never be repaired; while, in the case of a Defendant whose circumstances are such as to render it improbable that he would be able to meet the pecuniary demands to which he would be liable if unsuccessful at Law, the Court naturally inclines to a more

legal title has been in dispute, *Campbell v. Scott* (1842), V. C., 11 Sim. 31; *Lewis v. Langdon* (1835), V. C., 7 Sim. 421; *Sunderland v. Newton* (1830), V. C., 3 Sim. 450.

⁴ See as to account, *Crossley v. Derby Gas Company* (1834), V. C., gas metre, 3 My. & Cr. 420; *Morgan v. Seaward* (1835), V. C., paddle-wheel, Web. P. R. 168; *Bacon v. Spottiswoode* (1839), M. R., gas, 1 Beav. 387; *Neilson v. Fothergill* (1811), L. C., iron, Web. P. R. 290; *Macrae v. Holdsworth* (1848), V. C., design, 2 De G. & S. 496; *Mitchell v. Barber* (1851), M. R., looped fabrics, 39 Lond. Journ. 531.

⁵ *Newall v. Wilson* (1852), L. J., wire rope, 19 L. T. 161.

⁶ *Saxter v. Foster* (1841), M. R., 1 Cr. & Ph. 302; *Midland Railway Company v. Ambergate, Nottingham and Boston and Eastern Junction Railway Company* (1853), 10 Hare, 359.

⁷ *Hill v. Wilkinson* (1817), L. C., cited in a note to *The Electric Telegraph Company v. Nott* (1847), L. C., 2 Coop., C. C., 57.

⁸ *Wilkins v. Aikin* (1810), L. C., copyright, 17 Ves. 424; *Harmer v. Plane* (1807), L. C., woollen cloth machine, 14 Ves. 132; *Hill v. Thompson* (1817), L. C., iron, 3 Mer. 622; *Coles v. Simms* (1854), L. J., 22 L. T. 277.

ready exercise of its powers.¹ The various courses which may be taken by the Court on application for an injunction are thus laid down by Lord Langdale, M. R.—“ In such cases it will cautiously consider the degree of convenience and inconvenience to the parties by granting or not granting the injunction.² The right between the parties is a legal right, and the Court is naturally anxious to obtain the decision of a Court of Law, where the matter is properly cognizable, before it interferes to prevent a party exercising his *primâ facie* rights. According to the doubt which may exist in the mind of the Court upon the facts, and according to the degree of inconvenience to the parties, the Court, not thinking fit to grant the injunction, may take one of several courses—it may either refuse to grant the injunction simply, or it may refuse it on the terms of the party undertaking to keep an account, or it may direct the motion to stand over on the terms of the Plaintiff proceeding to a trial at Law. When it has been determined that the Plaintiff must first establish his right at Law, the Court does not generally interfere with the mode of trying the legal question, though in some cases it may require the parties to make the necessary admission of facts to facilitate the trial. It is to be remembered that the proceeding is not like the trial of an issue, but an action in the ordinary form, with which the Court will not interfere until the legal right has been determined at Law. I must, however, qualify this by saying, that in case of overwhelming mischief this Court has authority to interfere at any time.”

With regard to the validity of Patents, the Court, has, on the whole, been guided by the result of the proceedings at Law, and been inclined to grant injunctions in cases where the Plaintiff has been repeatedly successful in them. It still, however, to a certain extent, took cognizance of the merits of the case and the points put in

Validity of the Patent.

¹ *Newall v. Wilson* (1852), L. J., wire rope, 19 L. T. 161.

² *Bridson v. M'Alpine* (1845), Ch., 8 Beav. 239.

New point raised.

issue in the action. In *Crosskill v. Ivory*^a the Plaintiff had succeeded in former actions, but one raising a new question as to the infringement was then pending. Until its decision the Court refused an injunction. In *Newall v. Wilson*,^b on the other hand, although a new point in the validity was attacked in an action then pending, the Patentee was, from his success in four previous actions, and twelve years enjoyment of the Patent, held entitled to the injunction. Strict proof in either particular is, as may be supposed, rarely obtainable; and, from the form in which the case comes before the Court, the grant or refusal of the injunction is generally a question for the exercise of its discretion, in the face of various conflicting probabilities.

Admissions of the Defendant.

If the Defendant admit the validity of the Patent, the title of the Plaintiff, and his own infringement, the Court will at once issue its injunction.^c If, after admitting his infringement, the Defendant offer to undertake that there shall be no further infringement, the Plaintiff is nevertheless entitled to the usual order for an injunction.^d The Patent having been worked by the Plaintiff and Defendant as partners, under circumstances affording a presumption that the Defendant did not, during the existence of the partnership, dispute that the Patent was valid, the Court will, upon an interlocutory application for an injunction, assume that the Patent is valid.^e

Validity of the Patent.

With respect to the validity of the Patent, the rules proposed for its guidance by the Court have hitherto been almost entirely negative; the merits of the inven-

^a (1848) M. R., crushing machine, 10 L. T. 479; Drewry on Inj., Sup., 41, n.

^b (1852) L. J., wire rope, 2 Ch. Ca. 283.

^c *Jones v. Hughes*, 1 Hare, 383; *Bentinck v. Wellink*, 2 Hare, 11; *Dircks v. Mellor* (1845), V. C. E., boiler and furnace, 26 Lond. Journ. 268.

^d *Losh v. Hague* (1837), V. C., railway wheel, 2 Coop. C. C. 59, n.

^e *Muntz v. Grenfell* (1842), V. C. K. B., shipsheathing, 2 Coop. C. C. 61, n.

tion as a manufacture never being in any degree entered upon. Long undisputed enjoyment of the invention gave, in the absence of a successful assertion of his rights at Law, a colour as well of validity to the Patent as of title in the Patentee.^f For these reasons the Court never granted an injunction at once, if the Patent was of recent creation and the Defendant disputed its validity; and, on the contrary, granted it, even in the face of some material doubt, if the user of the Patent without challenge has been long and uninterrupted.^g In *Curtis v. Cutts*,^h where there had been nearly fourteen years enjoyment under the Patent, Lord Cottenham observed, in dissolving an injunction granted by the Vice-Chancellor, that the rule acted on by the Court, where the validity of the Patent alone is disputed, requires not merely that there shall have been possession and enjoyment under the Patent, but such possession and enjoyment must have been undisturbed and exclusive.

With regard to the second point, the title of the Plaintiff to the relief claimed, the Court exacts a jealous watchfulness and prompt proceedings in vindication of his rights.ⁱ The legal right of a Plaintiff, it was said by Lord Cottenham,^k ought to be established beyond all possibility of doubt before the Court will be justified in granting an injunction, which, by stopping extensive works, will do a mischief to the Defendant, that, if the Plaintiff do not succeed, can never be repaired. The

Plaintiff's title.

^f *Electric Telegraph Company v. Nott* (1847), 2 Coop. 41; *Hill v. Thompson* (1817), L. C., iron, 3 Mer. 630; *Caldwell v. Vanvlissingen* (1851), V. C. S., screw propeller, 16 Jur. 115.

^g *Wilkins v. Aikin* (1810), L. C., 17 Ves. 424; *Boulton v. Bull*, 2 H. Bl. 453.

^h (1839) L. C., cotton, &c., carding machine, 2 Coop. C. C. 60, n.

ⁱ *Stevens v. Keating* (1847), stucco, 2 Ph. 333; *Soltau v. De Held* (1851), V. C. K., 2 Sim. (N. S.) 161; *Rochdale Canal Company v. King* (1851), V. C. K., 2 Sim. (N. S.) 79.

^k *Neilson v. Forman* (1841), iron, 2 Coop. C. C. 61, n.; but see, as to presumption of good title, *Morris v. Kelly* (1820), L. C., copyright, 1 J. & W. 402.

Court will, however, consider the recovery of nominal damages in some cases sufficient evidence of good title to warrant the issue of its injunction.¹

Laches.

Where the summary interference of the Court by injunction is invoked, it must be invoked promptly. Parties who have laid by and permitted a large expenditure to be made in contravention of the rights for which they contend, cannot call upon the Court for its summary interference. The jurisdiction to interfere is purely equitable, and must be governed by equitable principles. One of the first of those principles is, that parties coming into equity must do equity. If parties cannot come into equity without submitting to do equity, *à fortiori* they cannot come for the summary interference of the Court where their conduct before coming has been such as to prevent equity being done.^m In a recent case the Bill was dismissed with costs, it being proved that the Patentees had during a long period been cognizant of the infringement without taking any steps in vindication of their position.ⁿ Omission to take active steps for the repeal of a subsequent Patent will not be construed as negligence on the part of the Patentee, unless such subsequent Patent be put in practice.^o He need not bring an action in respect of each act of infringement; but if the infringer have been suffered to go on for a long time, and no actions have been brought against him, distinct notice must have been given him that the Patentee will seek to enforce his right.^p Similarly, acquiescence in the monopoly of the Patentee, by the ab-

¹ *Rochdale Canal Company v. King* (1851), V. C. K., 2 Sim. (N. S.) 78; *Soltau v. De Held* (1851), V. C. K., 2 Sim. (N. S.) 133.

^m Per Lord Justice Turner (1853), *The Great Western Railway Company v. The Oxford, Worcester and Wolverhampton Railway Company*, 3 De G., M. & G. 359.

ⁿ *Smith v. London and North Western Railway Company* (1854), V. C. W., carriage wheel, 23 L. T. 10; *Bacon v. Jones* (1839), L. C., gas-burner, 4 My. & Cr.

^o *Newall v. Wilson* (1852), L. J., wire rope, 2 Ch. Ca. 283.

^p *Hancock v. Moulton* (1852), V. C. T., M. Dig. 506.

stention of manufacturers in the same trade from the patented process or machine, has been held by the Court to be the strongest grounds for believing in the originality of the invention.^a

In the absence of rights established at Law, length of undisputed possession has, as has been observed, great weight with the Court. The question is whether such possession is on the part of the public or the Patentee. In *The Universities of Oxford and Cambridge v. Richardson*,^r Lord Eldon said, that if the party gets his Patent, puts his invention in execution, and proceeds to a sale, that may be called possession under the Patent. In the case of *Boulton v. Bull*,^s the Court, on the strength of seven-and-twenty years' possession under the Patent, enjoined the defendants during the pendency of proceedings at Law, although the title was open to considerable doubt, the Court of Common Pleas^t having been equally divided upon the validity of the Patent, and the Court of King's Bench^u on the first argument inclining to hold it bad, although subsequently deciding in favour of it. In *Harmer v. Plane*^x his Lordship remarked, that where the public had admitted a reasonably long and undisputed possession under colour of the Patent, the Court thought, upon the fact of that possession proved against the public, that there was less inconvenience in granting the injunction until the legal question could be tried, than in dissolving it at the hazard that the grant of the Crown might in the result prove to have been valid.

Of the infringement on the Patent right by the party to be enjoined, the Court requires a very strong *primá* Evidence of the infringement.

^a *Collard v. Allison* (1839), pianoforte, 4 My. & Cr.

^r (1802) L. C., 6 Ves. 707; *Newall v. Wilson* (1852), L. J., wire rope, 19 L. T. 161; *Stocking v. Llewellyn* (1844), V. C., cab, 3 L. T. 33; *Lukie v. Robson* (1835), V. C., glass matches, 2 Jur. 221; *Stevens v. Keating* (1847), L. C., cement, 2 Ph. 333.

^s (1796) L. C., 3 Ves. 140.

^t (1795) Dav. Pat. Cas. 162; 2 H. Bl. 453.

^u *Hornblower v. Boulton* (1799), Dav. Pat. Cas. 221; 8 T. R. 95.

^x (1807) L. C., woollen cloth machine, 14 Ves. 132.

facie case in the absence of actual proof.^y It has indeed been said that the Court would not, before a trial at Law, grant an injunction on evidence less strong than that on which it would commit for a breach of it.^z

In *The Electric Telegraph Company v. Nott*,^a Lord Cottenham stated it to be the rule of the Court not to give its aid to a legal right by an injunction, unless satisfied, the legal title being disputed, that in the result such legal right would be established, or, the legal right not being disputed, that the acts complained of were a violation of it. The exception to this rule, it was said, was where the sole question in issue was the validity of a Patent, under which there had been exclusive enjoyment for a reasonable time; in which case the Court would interfere by injunction until the validity of the Patent has been ascertained at Law. Where, however, the validity of the Patent is not disputed, but the evidence as to the question of infringement is conflicting, the general rule again applies, and the Court will not grant an injunction until it has been ascertained by a trial at Law that there has been infringement. It would, indeed, appear that the Court was less willing to exert its own powers of discrimination on this head than on either of the others. In *Wood v. Cockerell*,^b where the affidavits were also directly contradictory, Lord Eldon, on refusing an injunction, observed, "where there is one question whether a Patent is valid, and another question whether it has been infringed, this Court would be going a great way if it took upon itself to grant an injunction."

Notwithstanding the change effected by recent enact-

Practice not greatly changed.

^y Per Eldon, L. C., in *Hill v. Thompson* (1817), 3 Mer. 622.

^z In cases of copyright the usual course was to refer the publications to the Master for comparison, *Carman v. Bowles*, 2 Bro. C. C. 80. Sometimes, however, the Court undertook the decision of the question of piracy itself, *Whittingham v. Wooler*, 2 Swanst. 428; *Sheriff v. Coates* (1830), L. C., 1 R. & M. 149.

^a (1847) 2 Coop. 41.

^b Cited in note to *Electric Telegraph Company v. Nott* (1847), L. C., 2 Coop. 57.

ments in the powers and relative position of the Courts of Equity and Common Law, it seems not improbable that the practice in the former with regard to injunctions will vary but little from that formerly obtaining, and actions will still no doubt be directed to be tried for the establishment of legal rights.^c It is, however, no longer necessary. By Stat. 15 & 16 Vict. c. 86, s. 61, it is enacted, that "it shall not be lawful for the said Court of Chancery in any cause or matter to direct a case to be stated for the opinion of any Court of Common Law, but the said Court of Chancery shall have full power to determine any questions of Law which in the judgment of the said Court of Chancery shall be necessary to be decided previously to the decision of the equitable question at issue between the parties." And further, by section 62, that "in cases where, according to the present practice of the Court of Chancery, such Court declines to grant equitable relief until the legal title or right of the party or parties seeking such relief shall have been established in a proceeding at Law, the said Court may itself determine such title or right without requiring the parties to proceed to Law to establish the same." The Statute, it will be observed, is not retrospective in operation.^c

Present power
of the Court.

To render effective this jurisdiction in cases of Patents it will, however, be necessary to adopt to a great extent the practice of examining witnesses *vivâ voce* in open Court,^d the inefficacy of affidavits, hitherto the Court's

Vivâ voce evi-
dence in Court.

^c *Hobson v. Neale* (1853), 22 L. J. 175, Exch.; 16 Jur. 1023.

^d "This species of evidence is of all others the most unsatisfactory. All the circumstances which give to the system of English procedure its peculiar and characteristic merits—*vivâ voce* interrogation, cross-examination, publicity, examination in presence of the tribunal, whereby an opportunity is afforded of examining the demeanour of a witness—are here wanting; and not only this, but the testimony is often not even the spontaneous statement of the witness: the affidavit is prepared for and sworn to by the deponent, often without the sense of responsibility which would be felt by a witness when delivering a statement in his own words." (Chancery Commiss. Rep. p. 32.) See *Smith v. Pockocke* (1854), V. C. K., 2 Eq. Rep. 371; *Wilkinson v. Stringer* (Nov. 1852), 20 L. T. 76.

only guide, having been usually alleged as the reason for directing issues at Law.^f

Plaintiff.

The proprietors of the Patents are the parties entitled to the equitable relief sought by the Bill. Although different portions of the Patent right are vested in different persons by different titles, they may all be joined as co-Plaintiffs in a suit. There seems no reason why any of such parties might not alone maintain a suit for the protection of his own share in the Patent.^g A Bill filed by the Plaintiff on behalf of himself and all other shareholders will, however, be demurrable, unless it state that all the Plaintiffs are shareholders.^h On the general principles influencing the Court, it may be presumed that in a suit by several of the proprietors seeking an account against the party working the Patent for the benefit of the proprietors, the Court will refuse to interfere by injunction to restrain the Defendant from working the Patent, there being no dispute as to the shares, but only as to the power of the owners *inter se*. A receiver also, it seems probable,ⁱ would be appointed by the Court without determining the ultimate rights of the parties, with the view of preserving the property until those rights can be ascertained. The party working the Patent might, it seems, be continued as such receiver, but he would then be an officer of the Court, having given due security to account for the monies he should receive.^k

Defendants.

A separate Bill must be filed against each infringer, although it would appear that if, after injunction obtained, the pirated articles have been transferred, the Court would give leave to amend by making the transferee a party, without prejudice to the injunction.^l Such of the parties

^f *Smith v. Effingham* (1847), M. R., 10 L. T. 1; *Moons v. De Bernales* (1826), M. R., 1 Russ. 301; *Lloyd v. Wait* (1841), 1 Phil. 61.

^g Hindm. 308.

^h *Banks v. Parker* (1848), V. C., 16 Sim. 176.

ⁱ *Blakeney v. Dufaur* (1851), M. R., 15 Beav. 41.

^k *Castelli v. Cook* (1849), V. C., 7 Hare, 89; 18 L. J. (N. S.) Ch. 148.

^l *Dilly v. Doig* (1794), L. C., copyright, 2 Ves. jun. 486.

interested in the Patent as are not joined as Plaintiffs should be made Defendants in the suit.^m

The Bill is to contain, as concisely as may be, a narrative of the material facts, matters and circumstances on which the plaintiff relies, such narrative being divided into paragraphs, numbered consecutively, and each paragraph containing, as nearly as may be, a separate and distinct statement or allegation, and should pray specifically for the relief which the plaintiff conceives himself entitled to, and also for general relief. The Bill is not to contain interrogatories.ⁿ It should allege the validity of the Patent,^o the title of the Plaintiff to the relief prayed, and the infringement of the Patent right by the Defendant. Special damage need not be alleged to entitle the plaintiff to an injunction.^p

Form of Bill.

A Bill^q contained allegations to the effect that the *Times* newspaper stated it as its opinion that the Plaintiff was the inventor of the process; that a prize medal had been awarded him by the Jurors of the Great Exhibition; that in their Report he was stated to be the inventor, and that various scientific persons had expressed their opinion as to the novelty of the invention. The Bill, after alleging that such representations were true, and that such would appear if the Defendants would answer the Bill, sought discovery of the process employed by the defendants in their manufacture. The Defendants pleaded, that the Plaintiff was not the true and first inventor, and accompanied this plea by an answer to those parts of the Bill not covered by the plea. They did not answer the interrogatories founded upon the above allegation, nor did

Materiality of allegations.

^m Hindm. 308.

ⁿ Stat. 15 & 16 Vict. c. 86, s. 10. Report of the Chancery Commissioners, p. 25. See Form in Appendix.

^o *Kay v. Marshall*, 1 My. & Cr. 373.

^p *Dickenson v. Grand Junction Railway Company* (1852), 15 Beav. 260.

^q *Young v. White* (1853), M. R., paraffine oil, 18 Jur. 277; 23 L. J. 190. See as to the pleading, *Hunt v. Penrice* (1853), M. R., 18 Jur. 4.

they give the discovery sought. Upon exceptions to the plea and answer for insufficiency, it was held, that the allegations in the Bill, not stating facts which could be laid before a jury in an action brought by the Plaintiff under an order of the Court, upon the question whether the Plaintiff was the first inventor, were covered by the plea and did not require to be answered; but that if the Defendants had set up the defence that they had not infringed the Patent, the interrogatories seeking discovery must have been answered. The Defendants having waived one of the grounds of defence originally set up, namely, that they had not infringed the Plaintiff's Patent, leave was given to amend the order of the Court, under which the Plaintiff was to bring an action at Law for the purpose of confining the issue at Law to the single question raised by the plea.

Licences.
Specific performance.

A party seeking relief by injunction on the ground of an agreement must state in his Bill all the documents on which that agreement was founded, or he will not be entitled to the relief prayed. Where the stipulations of an agreement between the parties have been systematically violated by both parties for a long course of time, the Court will not interfere at the instance of one of the parties to enforce an isolated portion of the stipulations.^r Where a wrong arises from a breach of contract or confidence, the Court enjoins at once, without awaiting the establishment of the title at Law.^s On an application *ex parte* for an injunction, the Plaintiff omitted to state a material fact. On motion, the Court dissolved the injunction with costs, although the Plaintiff swore that he had forgotten the circumstance: it being held, that it was no excuse for the suppression.^t

Delivery of counterfeits.

The Bill usually contains a prayer that the articles made on the principle or in imitation of a Patent may be

^r *Sheard v. Webb* (1854), V. C. S., 23 L. T. 48.

^s *Prince Albert v. Strange* (1849), L. C., 1 M. N. & G. 25; 13 Jur. 109; *Lewis v. Smith* (1848), L. C., 1 M. N. & G. 417.

^t *Clyton v. Robinson* (1853), M. R., 16 Beav. 355.

delivered up to the Patentee. Judging from the analogy of copyright, it seems doubtful if the Court would order the counterfeits to be delivered up in a suit to which the person at whose expense and on whose account they were manufactured was not a party.^u

On an affidavit that the Defendant is out of the jurisdiction, the Court will, without any affidavit of merits, allow substituted service of the Bill on his attorney.^x

Substituted service of bill.

An injunction may be applied for at any stage of the proceedings in vacation or term time.^y In urgent cases, where irreparable injury is likely to be the result of delay,^z a written copy of the Bill may be filed, on the personal undertaking of the Plaintiff or his solicitor to file a printed copy of such Bill within fourteen days.^z Motion for the injunction may immediately thereupon be made, upon a certificate of the Bill having been filed and affidavits verifying the statements it contains, and without serving the Defendant with process or notice of motion. If the injunction be obtained, the Plaintiff should serve the Defendant, or some person substituted for him by the Court, with a notice in writing, stating that an injunction has been granted, and that it will be sealed and served as soon as it can be passed; or a copy of the minutes of the order, signed by the registrar, may be served personally, at the same time showing the original, either of which will be sufficient to stop the defendant's proceedings, provided the Plaintiff loses no time in serving the injunction.^a In *Vansandau v. Rose* the Defendant was committed for a breach of an injunction after a notice of it had been obtained, although the order for the injunc-

When to be applied for.

If urgent, *ex parte*.

^u *Colburn v. Simms* (1843), V. C. W., 2 Hare, 543; 12 L. J. (N. S.) Ch. 388; 7 Jur. 1104. By the French law, the party infringing forfeits the articles made in violation of the Patent right. Renouard (Ed. 1825), 361. A similar provision exists in Spain, Art. 27, Law of 27th March, 1826.

^x *Sergison v. Beavan* (1852), V. C. S., 16 Jur. 111.

^y *Temple v. Bank of England* (1802), L. C., 6 Ves. 70.

^z Stat. 15 & 16 Vict. c. 86, s. 6. See *Drewry, Inj.*, Sup. 45.

^a *Vansandau v. Rose* (1820), L. C., 2 J. & W. 264.

tion had not been served. Applications *ex parte* are at all times closely scrutinized by the Court, and are in no case granted after appearance of the Defendant.^b In some cases the Court will give leave to serve notice of motion before the Bill is filed.^c The Plaintiff must not rely on the answer of the Defendant for continuance of the injunction.^d Its refusal at this stage does not prevent its being obtained on the answer coming in.^e

Practice.

The motion for an injunction may be treated by consent of both parties as the hearing of the cause, and the decision in that case has the effect of a decree on the hearing.^f

Lord Mansfield.

The modern practice of the Court is very materially different from that formerly obtaining. In *Millar v. Taylor*^g Lord Mansfield said, that whoever attended the Court of Chancery must know that if an injunction in the nature of an injunction to stay waste is granted upon motion or continued after answer, it is vain to go to hearing; for such injunction is never granted upon motion unless the legal property of the Plaintiff is made out,^h nor continued after answer unless it still remains clear, allowing all the Defendant has said. In such a case the Defendant is always advised to acquiesce or ap-

^b *Langham v. Great Northern Railway Company* (1847), 1 De G. & Sm. 486.

^c *Fosbrook v. Woodcock* (1849), 12 Jur. 956.

^d *Curtis v. Cutts* (1839), L. C., wool cards, 8 L. J. 184.

^e *Isaac v. Humpage* (1792), 1 Ves. jun. 430.

^f *Dickinson v. Grand Junction Railway Company* (1852), 15 Beav. 200.

^g (1769) 4 Burr. 2400. See cases cited in note to *Electric Telegraph v. Company v. Nott* (1847), L. C., 2 Moo. 41.

^h "If one who has Letters-patent for an invention files a bill for an injunction to restrain another from pirating his invention, he must state by his bill that he has brought his action at law, and so established his right by a good verdict, or a demurrer to his bill, for want of equity, shall be sustained." Old MSS. cited 2 Coop. C. C. 61, n.; and see the remarks there made on the case of *Hicks v. Raincock* (1783), L. C., looped stockings, 2 Dickens, 647, and 1 Cox, 40.

peal, for he can never make a better defence than is stated in his answer.

The judgment of Lord Cottenham in *Bacon v. Jones*ⁱ contains a summary of the grounds on which the Court at that time exercised its jurisdiction. “When the application is for an interlocutory injunction, several courses are open. The Court may at once grant the injunction *simpliciter*, without more, a course which, though perfectly competent to the Court, is not very likely to be taken where the Defendant raises a question as to the validity of the Plaintiff’s title; or it may follow the more usual, and, as I apprehend, the more wholesome practice in such a case of either granting an injunction, and, at the same time, directing the Plaintiff to proceed to establish his legal title, or of requiring him first to establish his title at Law and suspending the grant of the injunction until the result of the legal investigation has been ascertained, the Defendant in the mean time keeping an account. Which of these several courses ought to be taken must depend entirely upon the discretion of the Court according to the case made. When the cause comes to a hearing, the Court has also a large latitude left to it; and I am far from saying that a case may not arise in which, even at that stage, the Court will be of opinion that the injunction may properly be granted without having recourse to a trial at Law. The conduct and dealings of the parties, the frame of the pleadings, the nature of the Patent right and of the evidence by which it is established,—these and other circumstances may combine to produce such a result, although this is certainly not very likely to happen, and I am not aware of any case in which it has happened. Nevertheless, it is a course unquestionably competent to the Court, provided a case be presented which satisfies the mind of the judge that such a course, if adopted, will do justice be-

Bacon v. Jones.

When to be applied for.

ⁱ (1839) gas-burner, 4 My. & Cr. 436; S. C. (1839), M. R., 1 Beav. 382.

tween the parties. Again, the Court may, at the hearing, do that which is the more ordinary course,—it may retain the Bill, giving the Plaintiff the opportunity of first establishing his right at Law. There still remains a third course, the propriety of which must also depend upon the circumstances of the case, that of at once dismissing the Bill.”

Injunction on
notice.
Delay.

On motion for injunction on notice, the Plaintiff is also required to act promptly, although somewhat less so than in applying for an injunction *ex parte*. “I think,” said the Master of the Rolls in *Bridson v. Benecke*,^j “that a party coming for the assistance of this Court to protect a legal right not absolutely established against the party who is alleged to have infringed it, ought to come at an early period. I do not say at the earliest possible period, because that would be putting an application for an injunction on notice, where all parties have an opportunity of being heard, in the same position as an injunction *ex parte*, which it would not be expedient to do.” A special injunction was consequently refused on the ground of delay, notwithstanding the Court had a strong impression in favour of the plaintiff’s right. Leave was reserved to revive the motion. An action (*Magnall v. Benecke*)^k was accordingly brought. The Plaintiff succeeded. Defendants tendered a Bill of Exceptions. An injunction was granted under the circumstances before the Bill of exceptions was disposed of.

Affidavits.

The affidavits in support of the application must swear that, to the best of the applicant’s belief, the Patent is valid,^l and has been infringed by the Defendant.^m They must not be sworn until after the filing of the Bill. The Defendant, previous to filing his own affidavits, may cross-examine the parties making them under Stat. 15 & 16

^j (1849) machine for stretching wove fabrics, 12 Beav. 3.

^k (1849) before Coleridge, J., 34 Lond. Journ. 281.

^l *Hill v. Thompson* (1817), L. C., iron, 3 Mer. 622.

^m *Sturtz v. Delarue* (1828), L. C., paper, 5 Russ. 322.

Vict. c. 86, s. 4.ⁿ An alteration of some importance in the practice is effected by the provisions of Stat. 15 & 16 Vict. c. 86, s. 59, enacting, that upon any application by motion or petition to the Court in any suit depending therein for an injunction, or to dissolve an injunction, the answer of the defendant shall, for the purpose of evidence on such motion or petition, be regarded merely as an affidavit of the defendant, and affidavits may be received and read in opposition thereto. Where the legal title is denied by the answer, the Plaintiff may move for leave to try the legal right, without asking for an injunction in the mean time.^o

In cases of an injunction granted *ex parte*, the party obtaining it must, immediately upon the receipt of a written request and undertaking, or within such time as may be specified in such request or may have been directed by the Court, deliver copies of the affidavits upon which it is granted upon payment of the proper charges.^p

The terms on which a motion for injunction stands over are generally that the plaintiff shall forthwith commence an action to try the right at Law, and that the defendant in the mean time shall keep an account.^q The Court will not in such a case exact any admissions from the defendant as to the matters in dispute.^r Retaining a Bill is not in itself a determination that relief in Equity must ultimately be given.^s

In cases in which the Plaintiff requires an answer to the Bill, interrogatories for his examination are to be

Motion for injunction stands over.

Interrogatories for examination of defendant.

ⁿ *Bescmeres v. Bescmeres* (1853), V. C. W., 2 Eq. 668; 2 Week. Rep. 124.

^o *Rodgers v. Nowill* (1846), V. C. W., trademark, 6 Hare, 333.

^p Order I., 25 Oct. (1852), Rule 8.

^q *Normanville v. Williams* (1854), V. C. W., railway wheel, Aug. 1.

^r *Pidding v. Franks* (1849), 1 M'N. & G. 56. But see *Hilton v. Granville* (1841), L. C., Cr. & Ph. 293.

^s *Curtis v. Cutts*, cited 2 Coop. C. C. 62, (n.); *Harwood v. Oglan-der* (1801), L. C., 6 Ves. 225.

filed within eight days after the time limited for the appearance of such Defendant.⁵ After that time no interrogatories can be filed for his examination without special leave of the Court, to be applied for upon notice of motion.

Answer, plea or demurrer of defendant.

The defendant, if required to answer the Bill, must put in his plea, answer or demurrer thereto, not demurring alone, within fourteen days from the delivery to him or his solicitor of a copy of the interrogatories.⁶ The Court has power to enlarge the time on application.⁷

In a case in which the Plaintiff allowed the cause to come to a hearing without having taken any steps to obtain an interlocutory injunction, the Defendant's answer denying the validity of the Patent and the fact of the infringement, the Master of the Rolls, being of opinion that the Plaintiff, upon the evidence, had not made out a case which would have supported an injunction if applied for in the interlocutory stage, refused to give him an opportunity of establishing his title at Law, by retaining the Bill with liberty to bring an action, and dismissed his Bill with costs.⁸

Equity confessed upon the answer.

The rule of the Court requiring that there should be an equity confessed by the answer in order to sustain an injunction, does not require that the equity so appearing should constitute such admission by the defendant as on the face of the answer would entitle the plaintiff to a decree. By an equity confessed upon the answer was meant, under the old practice, that the Defendant had thereby admitted such facts as sufficed to show the Court that there was a question to be tried at Law.⁹

⁵ General Orders in Chancery, 7 Aug. (1852), No. 16.

⁶ Ibid. No. 20.

⁷ Ibid. No. 19.

⁸ *Bacon v. Jones* (1839), gas-burner, 4 My. & Cr. 433; affirmed, L. C., 1 Beav. 382; 3 Jur. 476, 994.

⁹ Per Wigram, V. C., *Bentinck v. Willink* (1842), 2 Hare, 11.

The right to an injunction is not lost by not applying for it till the hearing.^y If previously obtained, the Court may continue it on the undertaking of the plaintiff to be answerable in damages or by way of compensation in the event of the injunction being dissolved.^z The Court will at any time previous to the hearing postpone the hearing in order to allow time for filing affidavits; but no affidavits filed after the hearing is begun can be read.^a And similarly at the hearing, the plaintiff may move to have the injunction already obtained *ex parte* made perpetual, or the defendant may move to have it dissolved. If the plaintiff has not accompanied his Bill in the first instance with a sufficient affidavit as to his belief^b that he was the inventor, it will now be dismissed with costs.^c If, having obtained the injunction *ex parte*, on the terms of speedily trying the right, he has been guilty of *laches* with respect to the trial, it will be dissolved.^d No reference will be allowed to affidavits filed on the application for the injunction;^e but, under Stat. 15 & 16 Vict. c. 86, s. 59, such affidavits may be made evidence in the cause.

The hearing.

Affidavit.

Where a case before the Court is not such, upon the evidence, that it would direct an issue on a matter of fact raised by the pleadings, the Court will not examine witnesses *vivâ voce* on the mere speculation as to the evidence which may be elicited on such examination.^f

Vivâ voce examination.

Where the Vice-Chancellors are to work out questions

Scientific assistance.

^y *Bacon v. Spottiswoode* (1839), 1 Beav. 382; 4 M. & Cr. 433.

^z *Morrison v. Mout* (1851), L. J., medicine, 18 L. T. 164.

^a *Electric Telegraph Company v. Nott* (1841), V. C. C., 11 Jur. 272.

^b *Newall v. Wilson* (1852), L. J., wire rope, 19 L. T. 161.

^c *Sturtz v. Delarue* (1828), paper, 5 Russ. 322.

^d *Stevens v. Keating* (1847), cement, 2 Ph. 333.

^e *Barfield v. Kelly* (copyright), 4 Russ. 359; and see *Dunstan v. Patterson* (copyright), 2 Ph. 341.

^f *Wilkinson v. Stringer*, 20 L. J. 76, Ch.

of reference which were formerly sent to the Masters, they will do so in Chambers, with, if necessary, the assistance of accountants, merchants, architects, &c., as provided for by Stat. 15 & 16 Vict. c. 80, s. 42. Mere questions of detail will be worked out by the Chief Clerk: questions of Law or of a grave nature arising will be discussed in open Court.^h

Interim order. On a motion *ex parte* in the analogous case of staying waste, although an injunction was refused, an interim order was made, with leave to discharge it.ⁱ Considerable care is necessary in the wording of the order—a party being entitled to move to dissolve the injunction, if from ambiguity in its terms he may, under any construction of the order, be prejudicially affected.^k

Writ of injunction. The order for injunction having been obtained, the writ, prepared by the solicitor^l and endorsed with his name and address, must be sealed^m by the Clerk of Records and Writs, whose duty it is to ascertain that it is correct, and that the party presenting it is entitled to sue out the same.ⁿ

Service. Each party enjoined should be served personally. As to substituted service, where the Defendant is not to be found, see *Kirkman v. Honour*.^o

Order. It is material that the order should extend to the defendant, his agents, servants and workmen. Unless such be expressed in terms the Court will not commit the defendant's agent for a breach of the injunction.^p

^h *Mildmay v. Methuen* (1852), V. C. K., 20 L. T. 63; 16 Jur. 965.

ⁱ *Anwyl v. Owens* (1853), L. J., 20 L. J. 995.

^k *Dulghish v. Jarvic* (1850), Lords' Com., 2 M.N. & G. 231.

^l Order XVI., Oct. (1842).

^m The fee for sealing the writ is 1*l.*, payable by means of a stamp. Order VI., 25 Oct. (1852).

ⁿ Order IV., Oct. (1842).

^o 6 Beav. 400; 12 L. J. (N. S.) 336.

^p *Wellesley v. Lord Mornington* (1849), waste, 11 Beav. 180; 12 Jur. 367.

If the plaintiff neglect to proceed at Law^q or be unsuccessful, the Bill should be dismissed with costs.^r Matters at issue on the direction to proceed at Law, if neither decided, put in a train of investigation, nor reserved, must be considered by the Court as points either abandoned or on which the plaintiff was entitled to no order.^s In a recent case^t the Bill had been retained for a year, with liberty to bring an action, and it had been ordered, that if the plaintiff should not proceed to trial within that period, the Bill was to stand dismissed. The Court ordered the defendant's motion to dismiss to stand over, and, on a cross motion by the plaintiff, enlarged the time after it had expired. The defendant was allowed the costs of the original motion, those of the plaintiff being costs in the cause. In some cases an order will be made on motion by the defendant for the dismissal of the Bill, on the defendant submitting to the plaintiff's demand and paying the costs of the suit as between party and party,^u or under very special circumstances without costs.^x

Dismissal of bill.

Although the course of dissolving the injunction by demurring to the Bill is open to him,^y it is not obligatory on the defendant. He may move to dissolve upon affidavits^z before answer^a or upon the answer coming in.^b Notice of such motion must be served on all parties

Dissolving injunction.

^q *Bickford v. Skewes* (1839), L. C., miners' safety fuse, 4 My. & Cr. 499.

^r *Chappell v. Purday* (1847), L. C., copyright, 2 Ph. 227.

^s *Passingham v. Sherborn* (1839—1846), M. R., 9 Beav. 424.

^t *Swanger v. Gardner* (1850), V. C., 3 De G. & S. 696; Seton on Decrees, 526.

^u *Pemberton v. Topham* (1838), M. R., 1 Beav. 316.

^x *Holden v. Kynaston* (1840), M. R., 2 Beav. 205.

^y *Drewry on Inj.*, supra, 102.

^z *Barnsley Canal Company v. Twibell* (1844), M. R., 7 Beav. 19; *Hudson v. Maddison* (1841), V. C., 12 Sim. 416.

^a *Drewry on Inj.* 428.

^b But see *Curtis v. Cutts* (1839), L. C., cards for woolcarding, 8 L. J. 184.

likely to be affected by the dissolution.^c If there appears to be any material inconsistencies in the plaintiff's case, the injunction will be dissolved with costs.^d Such dissolution does not preclude the plaintiff from reviving the injunction after a successful action at Law;^e or, if the injunction has been obtained *ex parte*, from making a fresh application upon the merits.^f If the injunction be dissolved on the answer coming in, it will not be revived as of course without special motion or amendment verified by affidavit.^g In *Storer v. Jackson*^h the Court refused to hear a motion to dissolve, pending a motion, of which the plaintiff had given notice, for production of documents, no unnecessary delay having taken place on the plaintiff's part.

Demurrer.
Motion to dis-
solve.

It is the duty of a party asking for an injunction to bring under the notice of the Court all facts material to the determination of his right to that injunction, and it is no excuse for him to say that he was not aware of the importance of any facts which he has omitted to bring forward. Thus, where a plaintiff obtained *ex parte* an injunction on the facts stated in the Bill, but other facts came out in the defendant's answer raising a question of Law on which the right of the plaintiff to the injunction depended, it was held, that the omission of the plaintiff to bring these facts under the notice of the Court was of itself a sufficient ground for dissolving the injunction.ⁱ

Costs.

If after an injunction obtained on motion the defendant do not offer to pay the costs of it, the plaintiff may bring

^c *Service v. Castenada* (1845), V. C. K. B., 9 Jur. 367.

^d *Stocking v. Jewelllyn* (1844), V. C., eab, 3 L. T. 33.

^e *Neilson v. Harford* (1841), L. C., iron, 2 Coop. C. C. 61, n.

^f *Fitch v. Rochfort* (1849), 18 L. J. 458.

^g *James v. Downes* (1811), L. C., 18 Ves. 522.

^h (1842) V. C., 12 Sim. 503. See as to costs, where the injunction is dissolved with liberty to plaintiff to bring an action, *Sunxter v. Foster* (1841), 1 Cr. & Ph. 302.

ⁱ *Dalglisch v. Jarvie* (1850), Lords Commissioners, 2 M.N. & G. 231.

the suit to a hearing, and will be entitled to the costs of it.^k Where, on the injunction being obtained, the plaintiff gives an undertaking to bring an action, and that action fails and the Bill is dismissed with costs, the defendant's costs of opposing the motion for the injunction are costs in the cause.^l If the plaintiff dismiss his Bill, the defendant, though a pauper, is entitled to *dives* costs.^m Where, however, the Bill becomes nugatory from events subsequent to its filing, the Court may dismiss it without costs.ⁿ

From the language of Lord Cottenham in *Bacon v. Spottiswoode*^o it appears that a plaintiff at the hearing of the cause is expected to have already obtained the decision of a Court of Law upon the points at issue between him and the defendant. It is, however, to be remarked, that in the case alluded to the Bill was filed in October, 1835, and that the hearing was not until May, 1839. In adducing the cases of some standing in the Court, it is to be noticed, that the recent changes in the increase of judicial power has rendered the proceedings more speedy.

If an injunction until further order have been obtained on motion, the Court may, at the hearing, refuse to make it perpetual, if not satisfied on any point. It may retain the Bill for a limited period, giving the plaintiff liberty to bring such action as he may be advised, continuing the injunction in the mean time.^p If no interlocutory application have been made, the Court, if in doubt, may, as in *Rodgers v. Nowill*,^q give the defendants the option

^k *Gcury v. Norton* (1816), V. C., shawl, 1 De G. & S. 9; *Fradella v. Weller* (1831), M. R., 2 R. & My. 247.

^l *Stevens v. Keating* (1850), L. C., 1 M'N. & G. 659.

^m *Rubery v. Morris* (1819), L. C., 16 Sim. 433.

ⁿ *Sutton Harbour Improvement Company v. Hitchens* (1852), M. R., 15 Beav. 161.

^o (1839) gasburner, 1 Beav. 382.

^p *Beaufort v. Morris* (1847), V. C. W., 6 Hare, 340.

^q (1818) trademark, 6 Hare, 325.

of having the Bill dismissed against them without costs or of having the right tried at Law. The defendants in that case declined the former alternative. The Bill was ordered to be retained for a year, with liberty to the plaintiffs to bring an action.

Breach of injunction,
Contempt of Court.

Disregard of an injunction is a contempt of Court, punishable by attachment and imprisonment.^r The usual mode of purging such contempt is by payment of the costs of the adverse party. In the case of corporations aggregate^s or persons entitled to the privilege of Parliament,^t a sequestration will be ordered on breach of an injunction.

Practice.

If the party enjoined be not a corporation or person entitled to the privilege of Parliament, the usual course is to serve upon him, personally if possible,^u a notice of motion that he shall stand committed.^x It is not the practice to move that he shows cause why he should not be committed.^y Where the breach of the injunction has arisen from error or mistake,^z or if there have been acquiescence or neglect on the part of the plaintiff,^a the Court will not commit. An injunction improperly obtained cannot be disobeyed with impunity.^b The proper course is to move to discharge it for irregularity.^c

Injunction operates from time of being pronounced.

The injunction becomes operative from the time of the order for the issue of the writ being pronounced, and not

^r Hindm. 306; Dan. Ch. Pr. 1550.

^s *Partington v. Booth* (1817), L. C., 3 Mer. 149.

^t *Robinson v. Byron* (1788), L. C., 2 Dick. 703.

^u *Durant v. Moore* (1830), L. C., 2 R. & My. 33; *Pearce v. Crutchfield* (1807), L. C., 14 Ves. 206.

^x *Ellerton v. Thirsk* (1820), L. C., 1 J. & W. 376.

^y *Angerstein v. Hunt* (1801), L. C., 6 Ves. 488.

^z *Devonshire v. Sandys* (1801), L. C., 6 Ves. 107.

^a *M. is v. Cobby* (1815), L. C., 1 Mer. 3. See *Rodgers v. Nowill* (1852), L. J., trademark, 22 L. J. 401.

^b *Devonshire v. Sandys* (1801), L. C., 6 Ves. 107.

^c *Robinson v. Byron* (1788), L. C., 2 Dick. 703; *Partington v. Booth* (1817), L. C., 3 Mer. 149.

from the date of its sealing and being issued. The plaintiff must not be guilty of unnecessary delay, either in getting the order drawn up or serving it on the defendant, or a motion to commit will be refused with costs.^d

In the event of its appearing to the Court that the party enjoined is endeavouring to evade the personal service of the writ, it will allow service at the last place of abode^e or on the wife of the defendant.^f If, indeed, the presumption is strong that the parties are apprised of the order, the Court will commit them, notwithstanding there has been no formal service of the injunction.^g If the matter be urgent, a copy of the minutes of the order, or a notice of its having been passed, will subject the party enjoined to the effect of the injunction.^h

With regard to costs after an offer of compensation by the defendants for their infringement, the observations of Lord Cottenham in *Millington v. Fox*ⁱ are important. The parties there were perfectly unconscious that they had committed a wrong by the use of the plaintiffs' trademark. His Lordship, after saying that the plaintiffs were entitled to their decree, adds, that this abstract right of the plaintiff was not the only right he had to guard. There was another object which the Court must keep in view,—that of repressing unnecessary litigation, of keeping litigation within the bounds essential to the esta-

^d *James v. Downes* (1811), L. C., 18 Ves. 522.

^e *Pearce v. Crutchfield* (1807), L. C., 14 Ves. 206.

^f *Pulteney v. Shelton* (1799), L. C., 5 Ves. 147.

^g *Anon.* (1747), 3 Atk. 567; *Skip v. Harwood* (1747), 3 Atk. 564; *Powell v. Tollett*, *ibid.*; *M'Neil v. Garrett* (1811), L. C., Cr. & Ph. 99; *Ellerton v. Thirsk* (1820), L. C., 1 J. & W. 376; *Scott v. Becker* (1817), Eq. Exch., 4 Pr. 346; *Hearn v. Tennant* (1807), L. C., 14 Ves. 136; *James v. Downes* (1811), L. C., 18 Ves. 522; *Kimpton v. Eze* (1813), L. C., 2 V. & B. 349.

^h Dan. Ch. Pr. 1547.

ⁱ (Trademarks) 3 My. & Cr. 353; *Colburn v. Simms* (1813), V. C., copyright, 2 Hare, 561.

blishment and vindication of the rights of the parties. In *Kelly v. Hooper*^k the only question was, up to what point the plaintiff was justified in prosecuting his suit.

Account.

Besides asking for an injunction, the Bill usually prays for an account^l of the profits made by the defendant from the use of the invention.^m Where the title to the exclusive use of the invention is in dispute, a very usual course is to refuse an injunction until the Court is satisfied as to the title, directing the defendant in the mean time to keep such an account.ⁿ Such account, it is evident, is in many cases a very inexact mode of measuring the loss sustained by the Patentee. In some, however, it is the nearest approximation to justice that can be made.^o It is, in general, incident to the injunction,^p and to obtain it the plaintiff must establish a case which would entitle him to an injunction.^q

Must be complete and clear.

The account rendered must be complete. It is not sufficient to render the plaintiff the account books, and leave him to deduce from them the information he seeks.^r The defendant must himself examine the books and make out a reasonable account, referring to the books for verification in details.^s

^k (1841) V. C., copyright, 1 Yo. & Coll. C. C. 197; *Whittingham v. Wooler* (1817), M. R., copyright, 2 Swanst. 428.

^l As to the jurisdiction of equity in matters of account, see 1 Fonb. Eq. 13, n.; *Jesus College v. Bloome*, 3 Atk. 262; *Piers v. Piers*, 1 Ves. 521; *Lee v. Alston*, 1 Bro. C. C. 194; 3 Bro. C. C. 37.

^m Dan. Ch. Pr. 2nd Ed. 1500.

ⁿ *Bridson v. M'Alpine* (1845), M. R., 8 Beav. 229; *Hill v. Thompson* (1817), L. C., iron, 3 Mer. 628.

^o See the remarks of the Vice-Chancellor in *Colburn v. Simms* (1843), copyright, 2 Hare, 260.

^p *Parrott v. Palmer* (1834), L. C., 3 My. & K. 633; but see *Sheriff v. Coates* (1830), L. C., 1 K. & M. 159; 18 Jur. pt. 2, p. 185.

^q *Baily v. Taylor* (1829), M. R., copyright, 1 R. & M. 73.

^r See as to notice of wrong doing in general, *Attorney-General v. East Retford* (1833), M. R., 2 M. & K. 35.

^s Wigram on Discovery, s. 283; *White v. Williams* (1803), L. C. 8 Ves. 193.

CHAPTER XI.

NOTICES OF FOREIGN LAW.

By a before-mentioned provision of the Patent Law of 1852, the conditions attached by foreign states to the grants of special trade privileges in the nature of Letters-patent for inventions enter as an element into English Law. Where the subject-matter of an English Patent has, previously to the grant, been patented in a foreign state, the English Patent is to become void on the expiration of such foreign Patent. Two cases of exception, however, are made to this rule. The subject-matter must have been "first invented" abroad or by the subject of a foreign state. It may therefore be inferred that those inventions would be excepted which can be shown to have been perfected, although not published, in this country previous to the foreign grant, or which, if first patented abroad, were the inventions of British subjects.

Foreign Patents, in connexion with English Patents.

Excepted cases.

The section in question enacts as follows:—"Where upon any application made after the passing of this Act Letters-patent are granted in the United Kingdom for or in respect of any invention first invented in any foreign country, or by the subject of any foreign power or state, and a Patent or like privilege for the monopoly or exclusive use or exercise of such invention in any foreign country is there obtained before the grant of such Letters-patent in the United Kingdom, all rights and privileges under such Letters-patent shall (notwithstanding any term in such Letters-patent limited) cease and be void immediately upon the expiration or other determination of the term during which the Patent or like privilege obtained in such foreign country shall continue in force; or where more than one such Patent or like

Stat. 15 & 16
Vict. c. 83,
s. 25.

privilege is obtained abroad, immediately upon the expiration or determination of the term which shall first expire or be determined of such several Patents or like privileges: Provided always, that no Letters-patent for or in respect of any invention for which any such Patent or like privilege as aforesaid shall have been obtained in any foreign country, and which shall be granted in the said United Kingdom after the expiration of the term for which such Patent or privilege was granted or was in force, shall be of any validity."

To state with anything approaching to accuracy the various causes which in the principal states of Europe work a forfeiture of the grant would be entirely out of character with the relation of such considerations to the other questions discussed in the present Treatise. All that has been here attempted is to enumerate the chief enactments regulating the grant, and to point out the leading peculiarities attendant on it.

Notwithstanding the wide variety to be observed between the provisions of the several Laws, they bear the leading features of our own, which have served as the model to almost all.^b In all, the privilege confers on the grantee a transferable right to the profits derivable from the exclusive use of his invention. The rights of the public, it will be observed, are in general more carefully guarded than is the case with us, while in several provisions existing for this purpose, as compared with our own, the advantages cannot be said to be wholly on our side.

Evidence of
Foreign Law.

As to the admissibility and effect of proceedings in foreign Courts generally, see 2 Phillips on Evidence, 61—78. As a rule, Judgments of a foreign state given by a Court of competent jurisdiction are *primâ facie* evidence of the facts declared by them, although in particular instances they are impeachable.^c Satisfactory.

^b Renouard, p. 136.

^c See Story on the Conflict of Laws, s. 584, *et seq.*; 1 Greenl. Evid. s. 540, *et seq.*

evidence of the Laws in force in foreign states can only be given by persons who have themselves practised it, and not by those whose knowledge of it is derived only from books.^d If judicial notice is to be taken of the seals of a foreign Court, the witnesses called must have known the seal used on other occasions.^e Seals.

AMERICA (UNITED STATES).

The United States of North America have adopted the principles prevalent in this country with respect to property in inventions. The legislation on the subject originates in the provision of the Constitution,^f which authorizes Congress "to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries," and "to make all laws which shall be necessary and proper for carrying into execution the foregoing powers." Legislation.

The first Act of Congress was passed April 10th, 1790 (chap. 7). It was repealed by that passed February 21st, 1793 (chap. 9), which, with the subsequent Acts passed June 7th, 1794 (chap. 8), April 17th, 1800 (chap. 25), February 15th, 1819 (chap. 19), July 3rd, 1832 (chap. 162), and July 13th, 1832 (chap. 203), was repealed by the Act passed July 4th, 1836 (chap. 357), and which forms the groundwork of the Law at the present time. The subsequent enactments have been those of March 3rd, 1837 (chap. 41), March 3rd, 1839 (chap. 88), August 29th, 1842 (chap. 263), and that of May 27th, 1848 (chap. 47).

The application is by petition, accompanied by an

^d *Bristow v. De Secqueville* (1850), N. P., 3 C. & P. 64; 1 Phil. Evid. 464.

^e *Ibid.*

^f *Constit. U. S., A. 1, s. 8, No. 8.* A more extensive proposition, empowering Congress "to establish public institutions, rewards and immunities for the promotion of agriculture, commerce and manufactures," was silently abandoned in the Convention that framed the Constitution. 3 Story, *Com. on Const.* 50; *Journal of Convention*, 261.

United States. affidavit verified by two witnesses before any sitting magistrate, and a general description of the invention. This is sent by the applicant to Washington, together with a receipt of the United States Treasury Bank for the duty payable upon the Patent. Time is allowed to the petitioner for the preparation of his Specification, which is forwarded by him with the necessary drawings, specimens or models, and takes its turn for examination.⁸

The Grant.

The Patent issues in the name of the United States, under the hand of the Secretary of State, and is sealed with the seal of the Patent Office, and countersigned by the Commissioner of Patents.

A rigorous preliminary examination (productive sometimes of considerable delay^h) is instituted by the Commissioner of Patentsⁱ (with functions analogous to those of the Law Officers in this country) and a permanent Board of Examiners (appointed by the Government for a term of years), consisting of one member practically acquainted with chemistry and three others generally conversant with manufacturing art. Their decision is only conclusive as to novelty, and is not expressive of any opinion as to the utility of the Patent. Their report, together with the Specification, &c., is forwarded to the Patent Office, whence the Patent issues.

Caveats against the grant may be lodged at the Patent Office. They entitle the party lodging them to notice of application within a year of their deposit. On such notice being given, Specifications, drawings and models must be filed by the objector within three

⁸ (1851) Evid. 502—510.

^h (1851) Evid. 2325. Frequently from six to twelve months.

ⁱ The staff of the Commissioner's Office (all of whom are interdicted during their employment from acquiring interests under Patents otherwise than by operation of Law) consists of a chief clerk, an examining clerk, three others, two draughtsmen, a machinist and a messenger.

The Commissioner is charged with the additional duty of collecting agricultural statistics, which are included in his annual Report. Act of March 3, 1839, s. 9.

months. Opponents are heard before the Board,^j and a large number of Patents are constantly refused^k for want of novelty.^l An appeal lies from the decision of the Commissioner to the Chief Justice of the United States for Columbia.^m An annual report is made by the Commissioner, containing, among other matters, abstracts of the Specifications.ⁿ The Specifications

^j (1851) Evid. 478.

^k The number of Patents issued from the United States' Patent Office in each year, from 1790 to 1850, was stated before the Committee, in 1851, as follows:—

In 1790 . . .	1	In 1810 . . .	222	In 1830 . . .	551
1791 . . .	31	1811 . . .	218	1831 . . .	575
1792 . . .	11	1812 . . .	245	1832 . . .	473
1793 . . .	21	1813 . . .	167	1833 . . .	579
1794 . . .	21	1814 . . .	206	1834 . . .	608
1795 . . .	13	1815 . . .	178	1835 . . .	746
1796 . . .	41	1816 . . .	209	1836 . . .	677
1797 . . .	51	1817 . . .	173	1837 . . .	429
1798 . . .	29	1818 . . .	227	1838 . . .	509
1799 . . .	44	1819 . . .	157	1839 . . .	410
1800 . . .	39	1820 . . .	159	1840 . . .	452
1801 . . .	46	1821 . . .	167	1841 . . .	494
1802 . . .	64	1822 . . .	203	1842 . . .	517
1803 . . .	94	1823 . . .	117	1843 . . .	553
1804 . . .	83	1824 . . .	224	1844 . . .	502
1805 . . .	54	1825 . . .	300	1845 . . .	502
1806 . . .	64	1826 . . .	327	1846 . . .	619
1807 . . .	98	1827 . . .	334	1847 . . .	572
1808 . . .	160	1828 . . .	366	1848 . . .	660
1809 . . .	199	1829 . . .	439	1849 . . .	1,076

(1851) Evid. 2270.

The number of applications and grants in the years 1847—9 were as follows:—

In 1847	Applications . . .	1,531	Patents granted . .	572
1848	„ . . .	1,628	„ . .	660
1849	„ . . .	1,955	„ . .	1,076

The average number in England during the same period was under 500. (1851) Evid. 411, 501, 1022, 2404.

^l (1851) Evid. 591.

^m Act of March 3, 1839, s. 11.

ⁿ (1851) Evid. 512.

United States. themselves are not published,^o but the claims of the Patentee only.^p The publication is by means of a monthly circular, which is given gratuitously or sent post free on application.^q Indices of the titles (arranged according to subject-matter) of all grants made in the United States as well as those abroad may be inspected at the Office of Patents at Washington,^r where also are exhibited drawings, specimens and models of already patented inventions. The library attached to the Office is a large collection of foreign and native works on scientific and manufacturing topics.

The remedy of the Patentee in case of infringement is by action in the Circuit Courts of the United States, or any District Court having the power and jurisdiction of a Circuit Court,^s which Courts have power to grant injunctions. Copies of records, books, papers and drawings under the seal of the Patent Office are evidence in any case where the originals would be. Writs of error or appeal lies to the Supreme Court at Washington.^t

Transfers of the whole interest or any undivided part thereof may be made by any instrument in writing; to be valid they must be recorded in the Patent Office within three months from the execution thereof.^u An assignment of the right before the Patent is taken out will, it appears, enable the assignee to take out the Patent originally.^x

Subject-matter. Prior user in foreign countries does not invalidate the

^o (1851) Evid. 459.

^p Ibid. 2326.

^q Ibid. 502.

^r The original Patent Office was, with its contents, destroyed by fire, December 15, 1836. The present edifice is of white marble, built after the model of the Parthenon at Athens.

^s Act of 1836, s. 17.

^t (1851) Evid. 2327.

^u Act of May 27 (1848); C. Rep. 47, s. 2.

^x Digest of the Decisions on Patents (1831), No. 20, p. 26.

subject-matter for Patent in the United States,^y although a similar provision to that made in our recent Act exists with reference to the duration of the Patent where the subject-matter is patented in foreign states. Patents, in point of fact, are constantly granted for inventions in use elsewhere, and also for such as have during a considerable period been sold by the inventor previous to his application.^z United States.

Patents are granted to citizens of the United States, to aliens who have resided one year next preceding and who shall have made oath of their intention of becoming citizens, and also to foreigners who are the inventors or discoverers of the subject-matter. The distinction hitherto made to the prejudice of British subjects will, we may hope, now that the assigned cause has been removed, soon cease to be observed.^a The Patentee must be the meritorious inventor or his assignee. He is required to make an affidavit that he believes himself to be the inventor. Corporations may become Patentees.^b In the case of the death of the inventor his personal representatives may take out a Patent.^c Patentee.

Although, as in other states, the Specification of a Patentee is required to contain a full description of the invention and the means employed by the inventor, yet Specification.

^y By the Act of Congress of March 3 (1839), chap. 263, s. 3, it is enacted, that no person shall be debarred from receiving a Patent by reason of the invention having been patented in a foreign country more than six months prior to the application.

^z See, as to previous user in the United States by the Patentee, *Evans v. Weiss*, 3 Evans, Law J. 180, per Washington, J.

^a The fee for citizens or inchoate citizens is . . . 30 dollars.
 for British subjects 500 „
 for any other foreigner 300 „

The reason assigned for this exception was the high cost of British Patents. (1851) Evid. 642. In the event of the Patent being declared invalid, if the Patentee be a foreigner, two-thirds of the money paid is returned. Godson, 277.

^b Act of March 3 (1839), chap. 88, s. 7.

^c Act of August 29 (1842), chap. 263, s. 3.

United States. in the absence of an intention to deceive, a defective Specification will not avoid a Patent.^d Explanatory models and drawings must, where necessary, be added to the Specification.^e

Duration of the grant. The term of the Patent is for fourteen years,^f renewable for five or six years upon evidence adduced that the inventor has not benefited sufficiently by the use of his invention. If the Patent be for subject-matter previously patented abroad, the American Patent expires with the foreign Patent.^g

AUSTRIA.

Legislation. The Laws of Austria with respect to Patents are,—an Ordinance of December 8th, 1820; the Supreme Decree of July 16th, 1829, published together with the Decree of the Upper Chamber of July 24th of the same year (No. 32661—1327); the Supreme Patent of March 31st, 1832, Sections 70 (No. 1) and 206 of the Stamp and Tax Law of January 27th, 1840; the Decree of the Upper Chamber, March 30th, 1840 (No. 13084); the Decree of the Justiciary Court of May, 1840 (No. 2273); and the Law of August 15th, 1852. The last, although intitled an Amendment of the Law of 1832, has in reality repealed or re-enacted almost every provision of preceding enactments.

Property. The Patent extends over the whole empire.^h The right is assignable by deed or will.ⁱ The deed of assign-

^d See *Whittemore v. Cutter* (1813), 1 Gallisen, 429, per Story, J.; Phillipps, 60.

^e The following rule with respect to models was issued in 1852 from the American Patent Office:—"The model must be of durable materials and firmly constructed, so as to bear the frequent handling to which it is necessarily exposed. If of any soft wood, it should be painted, stained or varnished. It is not to exceed, if practicable, one cubic foot. The name of the inventor or of the assignee, if the Patent issue to him, should be permanently affixed to it, either by engraving or otherwise."

^f (1851) Evid. 611.

^g Act of March 3 (1839), chap. 88, s. 6.

^h Law of 1852, Art. 24.

ⁱ *Ibid.* Art. 35.

ment, properly certified, is required on each assignment to be forwarded with the Patent to the Office of the Minister of Commerce. The assignment is recorded in the register, and a notice of it indorsed on the Patent. A special certificate is issued on the assignment of a partial interest under the Patent.¹ All registered assignments are published without delay.^m It also confers the power of licensing others to use the invention.ⁿ The Patent must be worked within a year, and must not during the term be suspended for two whole years.^o

Grants and prolongations of Patents are officially published by the President of the Board of Trade.^p A monthly report of new Patents, prolongations, &c., is made to the minister, who communicates it to the provincial governments and chambers of commerce throughout the empire. An annual report on the same subject is published.^q Descriptions of inventions or discoveries which are no longer patented, affecting important or useful manufactures, are published annually.^r

A register of Patents, open to public inspection,^s is kept at the Board of Trade.^t Copies of the Specifications of expired Patents, or those which are not decreed to be kept secret, may be taken.^u

The application (which must be addressed to the respective provincial governments,^x or to the prefectures, &c.) is by petition, stating, (1) the description of the petitioner or his representative in Austria, and the house of business in which the manufacture is to be carried on; (2) the title of the invention; (3) the period for which the Patent is desired; and (4) whether or not the

¹ Law of 1852, Art. 37.

ⁿ Ibid. Art. 22.

^p Ibid. Art. 28.

^r Ibid. Art. 34. (1851) Evid. 2258.

^s Ibid. Art. 32.

^u Ibid. Art. 32.

^m Ibid.

^o Ibid. Art. 29.

^q Ibid. Art. 33.

^t Ibid. Art. 31.

^x Ibid. Art. 8.

Austria.

Specification is desired to be kept secret.^y The petition must be accompanied by (1) a receipt for the duty payable for the term demanded; (2) a legal authorization where the application is through an agent; (3) the foreign Patent, or an authenticated copy, in the case of an imported invention; (4) the Specification under seal, having inscribed the title of the invention and the residence of the petitioner or his agents, together with the drawings, models, &c., if necessary, to render the description intelligible.^z

The date, day and hour of the presentation of the petition, &c., is endorsed, by the authority applied to, on the Specification, and signed by the petitioner or agent. A certificate (the date of which is decisive on the question of priority) is also issued to him, containing the name and residence of the petitioner, the day and hour of the presentation of the petition, &c., the payment of the dues and the title of the invention.^a

Where the application is not directly to the government authorities, it must be notified within three days at the latest to the provincial governments.^b

The government examination is conducted with reference to two considerations only,—first, whether the article is capable of being patented; second, whether the accompaniments of the petition are conformable to the conditions prescribed. If the subject-matter be found not patentable, notice is given to the petitioner that the description under seal and the dues already paid by him will be restored to him on application, or that he must address himself to the Minister of Commerce within the time prescribed by the Law.^c

The Minister of Commerce, to whom the entire articles deposited are forwarded, is the only person authorized to open the sealed description and decide whether all the

^y Law of 1852, Art. 9.

^z Ibid. Art. 7.

^a Ibid. Art. 13.

^b Ibid. Art. 14.

^c Ibid. Art. 15.

formalities and conditions of the Law have been faithfully complied with.^d The grant is without the guarantee of the government either as to novelty or utility.^e The Patent is issued and signed by the Minister of Commerce. If refused, the grounds of its refusal are communicated to the petitioner, and the amount of the dues paid returned.^f Austria.

The Minister of Commerce is the sole judge of the nullity of a Patent, both with respect to the novelty of the invention or the identity or similarity of two Patents.^g

Infringement consists in imitation or manufacture of the article patented, as described in the Specification (even by the grantee of a subsequent Patent for the article), in the importation of counterfeits for the purpose of sale, and in undertaking to sell such articles or expose them for sale.^h If the Specification be not kept secret, the penalty for the first infringement, in addition to the confiscation of counterfeits, is a fine of from 25 to 1,000 florins, or, in default of payment, imprisonment at the rate of five florins per day on the fine pronounced. The fine is paid to the Poor-box of the parish where the infringement is committed. The apparatus used by the infringer is displaced or destroyed, unless an arrangement be otherwise made with the Patentee. Abuse of confidence by the infringer is considered a circumstance of aggravation.ⁱ If the Specification be kept secret, the Patentee is entitled to an injunction to restrain the manufacture and sale, and to an undertaking that the counterfeits shall not be sold or employed in Austria during the Patent, and that those imported shall be re-exported.^k Proceedings are taken in the Courts of First Instance. An appeal from their decision lies within a fortnight to the Provincial Government—a final appeal to the Mi- Infringement.

^d Law of 1852, Art. 16.

^e Ibid. Art. 17.

^f Ibid. Art. 18.

^g Ibid. Art. 42.

^h Ibid. Art. 38.

ⁱ Ibid. Art. 39.

^k Ibid. Art. 40.

Austria.

nister of Commerce. Execution of the judgment is suspended during an appeal.¹

The Court of First Instance may refer the matter to persons conversant with the manufacture, and, on the motion of the Patentee, order the immediate seizure of the counterfeits and tools of manufacture.^m If the decision involve the proceedings preliminary to the grant, the Court may suspend proceedings, and refer the matter directly to the Minister of Commerce. Such reference does not prevent the seizure or other preventive measures at the disposal of the Courts.ⁿ If a civil action be instituted by the Patentee, the Civil Court may, after proof of the infringement, on motion of the Patentee, order the seizure of the counterfeits and other preventive measures. Such seizure, &c. must be followed within a week by proceedings against the Defendant, failing which the Defendant will be entitled to claim the suspension of the order made and damages from the Patentee.^o If necessary, the parties to the suit may apply to the Minister of Commerce for a decision of any point.^p Infringements on the rights of others by the Patentee is punishable by the authorities appointed to judge in the case.

The competent Courts decide whether the party obtaining a Patent for the invention of another is guilty of a fraud, or punishable by other action.^q

Subject matter.

Patents are granted for every discovery, invention or improvement having for its result—(1), a new industrial product; (2), a new means of production; (3), a new mode of manufacture.

The disclosure of an industrial process in practice in former times, but lost or generally unknown in the Empire, ranks as a *discovery*. The manufacture of a new article by a new process, or of a new article by known

¹ Law of 1852, Art. 43.^m Ibid. Art. 44.ⁿ Ibid. Art. 45.^o Ibid. Art. 47.^p Ibid. Art. 48.^q Ibid. Art. 50.

means, or of a known article by means not hitherto employed, is defined to be an *invention*. Every addition of a process or arrangement to an article known or patented, by means of which the result is more successfully or economically obtained, is considered as an *improvement*. Austria.

Novelty, for the purpose of the grant, consists in the discovery, invention or improvement not having been reduced to practice in the Empire of Austria, nor described in any printed work.^r Aliments, liquors and medicines cannot be subjects of the grant. All inventions also are excluded whose practice would be injurious to the morals or health of the people, or would contravene the Laws of the State.^s

An invention imported into Austria is patentable only when it is the subject of a Patent in a foreign State.^t Patents of importation confer on the Patentee an exclusive right only to the use of the part of the article improved by the Patent.^u No Patent will be accorded for a theory or principle, although it be capable of being immediately employed in manufactures. But every new application of such principle is patentable if it constitutes a new industrial product, a new means of production or a new process of manufacture.^x The inclusion under one Patent of two inventions, discoveries or improvements, is admissible only in cases in which they are employed as necessary and indispensable to its production.^y

Austrians and aliens are placed on the same footing as regards Patents of invention.^z Patents of importation are granted only to the Patentee of the foreign Patent, or his assigns.^a The Patentee's rights are not affected Patentee.

^r Law of 1852, Art. 1.

^t Ibid. Art. 3.

^x Ibid. Art. 5.

^z Ibid. Art. 1.

^s Ibid. Art. 2.

^u Ibid. Art. 4.

^y Ibid. Art. 6.

^a Ibid. Art. 3.

Austria.

by his subsequently procuring a Patent in a foreign State.^b

Specification.

The requisites for the Specification are—(1.) It must be in German, or the language of the Province in which the application is made and must be signed by the Petitioner or his agent. (2.) It must contain a detailed analysis of the invention. (3.) Of such a character as to enable a person conversant with the trade to manufacture the article. (4.) It must point out precisely each particular of the invention. (5.) Disclose the invention, &c. clearly and unequivocally. (6.) Without any concealment either as to the means or mode of manufacture, —without enumeration of dearer or less efficacious materials than those known to him, and without suppressing any process material to the success of the operation.^c The Specifications, models, &c. are kept in the Patent Record Office.^d The Specification is decisive as to the claims of a Patentee in the event of infringement. In case of litigation, the desire of the Patentee for the secrecy of the Specification is disregarded.^e

Duration.

The term of a Patent can never exceed fifteen years, unless on special grounds adduced by the Patentee.^f Patents of importation expire with the foreign Patent.^g The term is computed from the date of the Patent.^h The proprietor of a Patent, with a term of less than fifteen years, may obtain its prolongation by applying before the expiration of the term, and paying in advance the dues for the prolongation. The clause of prolongation is inserted in the original Patent, which must, for this purpose, be forwarded to the Office of the Minister of Commerce.ⁱ

^b Law of 1852, Art. 22.^d Ibid. Art. 20.^f Ibid. Art. 25.^h Ibid. Art. 26.^c Ibid. Art. 12.^e Ibid. Art. 41.^g Ibid. Art. 9 (3).ⁱ Ibid. Art. 27.

The following are the dues payable:—

Austria.

	Florins.
For the first five years, 20 florins each year .	100
„ sixth year	30
„ seventh	35
„ eighth	40
„ ninth	45
„ tenth	50
„ eleventh	60
„ twelfth	70
„ thirteenth	80
„ fourteenth	90
„ fifteenth	100

Total tax for privilege of fifteen years . . Fl. 700

Payment for the term demanded must be made in advance. The money is returnable only in the event of the Patent being refused or declared null.^k

BELGIUM.

The Belgian Patent Laws are those which have received the latest attention of the Legislature of Europe. They consist of a Law passed by the Chambers in 1854, and a Royal Decree, dated May 24th, 1854, regulating its execution in detail. Belgium.

Application for the Patent is made by Petition, through the Principal Prefect or District Commissary of Arrondissement of the Province in which the applicant resides.^l Duplicate certified copies of the Specification and drawings, with the necessary models and specimens, and an inventory of such documents and articles, must accompany the Petition, which is required to be upon stamped paper. A payment of ten francs, the duty for the first year, must precede the deposit of the documents, &c.; the receipt for which forms part of the de-

^k Law of 1852, Art. 11.

^l Law of 1854, Art. 1.

Belgium.

posit.^m The Petition sets forth the name, profession and residence of the party making the application, and the subject matter and object of the invention. If the Patent be one of importation, it should set forth the date, term and locality of the foreign Patent. A legally executed power to act for the foreign Patentee must be annexed in this case to his Petition by the applicant.ⁿ A Certificate is thereupon prepared by the Registrar of the Prefect or Commissary, verifying the date of the deposit, and containing a short statement of the principal circumstances under which the application is made.^o A copy of this Certificate is given gratuitously to the Petitioner; the original being forwarded, with the documents and articles deposited and transmitted in company with them, within five days, to the Ministry of the Interior.^p They are registered on their arrival in the order of their date of deposit, in a Register open to public inspection daily.^q A Decree of the Minister of the Interior, which is delivered to the applicant, constitutes his Patent.^r The first copy of such Patent is issued gratuitously; subsequent copies must be paid for. The Patent contains a declaration that the Government does not, by its Patent, guarantee the accuracy of any of the assertions put forward by the Petitioner, and that the grant is without prejudice to any existing rights.^s

Property.

The right is transferable.^t Any assignment or change of proprietorship (either total or partial) under the Patent must be notified to the Department of the Interior. The notice must be accompanied by an authenticated copy of the deed affecting it. The duty of ten francs is payable on the registration thereof.^u

Patents of importation and improvement are granted, which confer the same rights as Patents of invention.

^m Law of 1854, Art. 2.ⁿ Ibid. Art. 6.^o Ibid. Art. 7.^p Ibid. Art. 10.^q Ibid. Art. 11.^r Ibid. Art. 13.^s Ibid. Art. 14.^t Ibid. Art. 4 (a).^u Ibid. Art. 21; Royal Decree, Art. 19.

Specifications are published by the Government, either Belgium. in substance or in full, in a special publication, three months after the date of the Patent. Usually the substance only is given. The Patentee may, however, procure the publication *in extenso* of the whole or any part of his Specification, by giving notice to the Government at least one month before the period for such publication, and paying the expenses.^v On the expiration of this term of three months the Specifications are open to the inspection of the public, and copies may be obtained on payment of the expenses.* Specifications, drawings, &c. of expired Patents are placed in the Musée de l'Industrie. Royal Decrees inserted in the *Moniteur* announce the avoidance of Patents.

The Patent must be worked in Belgium within a year of its being worked abroad. On cause shown to the Minister of the Interior, two months at least before its expiration, the Government may extend the time for a period not exceeding one year. If within such time the Patent be not worked in Belgium, or if being worked abroad it ceases to be worked in Belgium for the space of one year, except on good cause shown for the inaction, the grant is annulled by Royal Decree. All official communications relative to Patents are inserted in the *Moniteur*.^y

The Law with respect to infringement in Belgium is somewhat peculiar. It is defined as being manufacture of the products, employment of the means prescribed in the Specification, exposing for sale or importing counterfeit articles.^z The Courts take cognizance of Patents as matters of urgency. If the infringement have been wilful, the Courts of First Instance pronounce the confiscation, for the benefit of the Patentee or his assigns, of the articles manufactured and the instruments em-

^v Royal Decree (1854), Art. 16.

^x *Ibid.* Art. 17.

^y Law of 1854, Art. 25.

^z Law of 1854, Art. 4 (b).

Belgium.

ployed in contravention of the Patent. They have power also to award a money compensation to be paid in respect of the articles sold.^a If the infringers have acted in ignorance of the rights of the Patentee, they are enjoined by the same Courts, under a warning of such confiscation, to abstain from further infringements. In this case, however, damages may be awarded to the proprietor of the Patent.

The proceedings to be taken by the Patentee in cases of infringement are thus prescribed by Articles 6—13 inclusive:—The Patentee or his assigns, having obtained upon petition an order of the Tribunal de Première Instance, is, with the assistance of one or more experienced persons sworn before the President of the Tribunal, to prepare an inventory of the articles alleged to be made or used in contravention of the Patent right. The order may forbid the removal of the articles therein named and empower the Patentee to appoint the person in whose custody they shall remain, or may decree them to be placed under seal. The President may require security from the Patentee. In the case of foreigners security is always to be required. If admission be refused by the infringer to his premises, proceedings are to be taken conformably with Art. 587 of the Code of Civil Process. If the act of taking such inventory be not followed within eight days by citation of the Defendant before the Tribunal, the order made becomes void, and the party holding the articles described may require the remission of the original memorandum, with prohibition to the Patentee from making use of the contents or rendering it public;^b the whole being without prejudice to the question of damages.

Subject-matter.

Patents of invention are granted only for such inventions as have not been employed within the kingdom, or put in operation for commercial purposes, by another

^a Law of 1854, Art. 5.^b Ibid. Art. 6.

person than the applicant.^c Such Patents will not be granted where the subject-matter has been described with correct drawings in works printed and published prior to the application.^d Each patent is confined to one principal object and the details and applications incident thereto.^e The government, having the monopoly of railroads, until very recently refused to permit articles applicable thereto to become the subjects of Patents.^f Belgium.

The author of an invention patented abroad may, personally or by his assigns, obtain a Patent of importation. The grantee of a Belgian Patent may at any time during the term take out a Patent of improvement. Patentee.

The Specification must be in French, Flemish or German. If in either of the latter it must be accompanied by a translation in French, unless the inventor be a Belgian resident. Alterations and erasures must be counted and verified, and the pages and passages noted. It is required to describe the invention in a clear and complete manner, and is to conclude with a concise statement of its characteristics.^g The drawings must be to a scale, and are to represent the subject matter of the Patent as nearly as possible in plan, section or elevation. The parts specially characterizing the invention must be shown by a difference of colour.^h *Intentional* omissions or misdirections avoid the Patent.ⁱ Specification.

Patents of importation are limited to the term of the foreign Patent.^k Patents of invention are for twenty years if the Patentee choose to continue the annual payments as follows :— Duration.

For the 1st year	10 francs.
„ 2nd „	20 „
„ 3rd „	30 „

and so on up to the 20th year, for which the Patent is

^c Law of 1854, Art. 24 (a).

^d Ibid. Art. 24 (c).

^e Royal Decree (1854), Art. 3.

^f Urling, Introd. xviii.

^g Law of 1854, Art. 4.

^h Ibid. Art. 5

ⁱ Ibid. Art. 24 (b).

^k Ibid. Art. 14.

Belgium.

200 francs. The duty must be paid in advance, and is in no case refunded.¹ Patents of improvement taken out by the original Patentee are not subject to any fresh duty. They expire at the same time with the original Patent.^m The term of the Patent is computed from the date of the registrar's certificate before alluded to.ⁿ

DENMARK.

Denmark.

In the kingdom of Denmark and duchies of Schleswig and Holstein no special Patent Laws are in existence.^o Every industrial inventor is however entitled to the exclusive use of his invention effecting an improvement in manufactures, and special concessions are made in consideration of such improvements.

FRANCE.^p

France.

The history of trade privileges in France is very similar to that of England, although its corresponding incidents follow far behind. Alike moreover in this,—that the abolition of the abuses they had given rise to in both countries was the precursor of vast political revolutions. Corporations and favourites under an absolute *régime* monopolized there as here the products of the industrial arts. The spirit of invention was deadened and commercial enterprize stagnant.

A first instalment of the rights of industry was conceded by the Royal Ordinance of 1762, which, among other things, reduced to the term of fifteen years such privileges as had been arbitrarily granted, and revoked all those that had not been exercised.

To Turgot, the minister of Louis XVI., is due the honour of still further enfranchising industry. Yielding to the solicitations of the Third Estate, he obtained the

¹ Law of 1854, Art. 3.^m Ibid. Art. 15.ⁿ Ibid. Art. 8.^o Loosey, 95.^p Ibid. 173.