

peared that the patent was for an invention to do three things in one process, it was objected that one of the things, viz. white lead, could not be produced at all; and Mr. Justice *Buller* told the jury, that if the objection was well founded it would avoid the patent. The jury having found a verdict for the plaintiff, the defendant moved the Court of King's Bench for and obtained a rule for a new trial. Mr. Justice *Ashurst* said, in delivering his judgment, "The patent is for making white lead and two other things by one process; if the process, as directed by the specification, does not produce that which the patent professes to do, the patent itself is void." And Mr. Justice *Buller* said, "If the patentee says that by one process he can produce three things, and he fails in any one, the consideration of his merit, and for which the patent was granted, fails, and the Crown has been deceived in the grant."

Bloxam v.
Elsee.

In the case of *Bloxam v. Elsee* (x), the patentee had represented that his invention was a machine for making paper in single sheets, without seam or joining, *from one to twelve feet and upwards wide*, and from one to forty-five feet and upwards in length. It appeared in evidence that the machine was so constructed as to be capable of producing paper of one definite width only, and that in order to vary the width a new machine was required. It was held by the Court of King's Bench that the meaning of the patentee's representation was, that paper of various widths might be obtained by one and the same machine; and as that representation was not true, the patent was void. In delivering judgment the Lord Chief Justice *Abbott* said, "By the patent it appears that the patentee had represented to the Crown that he was in possession of a machine for making paper in single sheets without seam or joining, from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length. Upon this representation the patent is granted. The consideration of the grant is the invention of a machine for making paper in sheets of width and length varying within the limits designated. If any material part of the representation was not true, the consideration has failed in part, and the grant is consequently void, and a defendant in an action for infringing the patent has a right to say that it is so."

(x) 6 B. & C. 169.

And in the case of *Morgan v. Seaward* (y), it appeared that the plaintiff, by his patent and specification, claimed two separate inventions under the title of "improvements in steam-engines, and in machinery for propelling vessels, which improvements are applicable to other purposes." The defendant pleaded that the invention was not an improvement in steam-engines, and the jury having found a verdict for the defendants on that plea, the Court of Exchequer held, that although the jury by their verdict had found that one part of the invention was an improvement in machinery for propelling vessels, yet one of the inventions not being an improvement, the grant was wholly void. Mr. Baron *Parke* said, in delivering the judgment of the Court, "We cannot help seeing, upon the face of this patent as set out in the record, that an improvement in steam-engines is suggested by the patentee, and is part of the consideration for the grant, and we must reluctantly hold that the patent is void for the falsity of that suggestion."

Morgan v. Seaward.

In the case of *Losh v. Hague* (z), in the Court of Exchequer, the invention was of improvements in wheels for railway carriages. The defendant by his second plea alleged that the improvements were only trifling and insignificant alterations in the mode of making wheels before known, and were not legal subjects of a patent. Upon the issue raised by this plea, Lord *Abinger*, C. B., left it to the jury to consider whether the invention was worth a patent or not. The question thus raised in this case seems to have been in effect, whether the representation made to the Crown, that the invention was improvements in the construction of railway carriage wheels, was true or not; for the representation must mean some substantial improvements in such wheels, and if the improvements were trifling and insignificant, the representation was false, and the patent would have been void.

Losh v. Hague.

The Statute of Monopolies, it has been seen (a), provides that grants of privilege shall not be "contrary to the law; nor mischievous to the state by raising prices of commodities at home, or hurt of trade, or generally inconvenient."

Useless invention is mischievous and contrary to law.

And in the case of *Morgan v. Seaward* (a), the Court of Exchequer said, that "A grant of a monopoly for an inven-

Morgan v. Seaward.

(y) 2 M. & W. 544.
(z) 1 Webs. R. 202.

(a) *Ante*, p. 134.

tion which is altogether useless, may well be considered as 'mischievous to the state, to the hurt of trade, or generally inconvenient,' within the meaning of the statute of James I., which requires, as a condition of the grant, that it should not be so, for no addition or improvement of such an invention could be made by any one during the continuance of the monopoly, without obliging the person making use of it to purchase the useless invention."

An invention for an illegal purpose not the subject of a privilege.

This clause of the statute seems also to mean that the excepted grants must not be for the sole making of any thing which is to be used for any purpose which is illegal, or "contrary to law," such as implements for house-breaking, picking pockets, locks, &c. Such grants, however, it is clear would be void, not only on the ground of want of public utility, but also because they are contrary to the policy of the law; and indeed it would be absurd if, by one law, patents might be granted to reward persons for providing the means of violating any other law.

CHAPTER VI.

OF THE DURATION OF THE PRIVILEGE GRANTED BY A PATENT FOR AN INVENTION, AND THE PROLONGATION OF IT.

SEC. I.—*Of the Term which may be granted by Patent in the first instance.*

II.—*Of the Extension of the Term by New Letters Patent.*

III.—*Of the Prolongation of the Term by Act of Parliament.*

SECTION I.

Of the Term in a sole Privilege which may be granted by Patent in the first instance.

BEFORE the passing of the Statute of Monopolies, the Crown had power by the Common Law to grant the sole use of an invention for a reasonable time (a). Duration of a patent at Common Law.

The 6th section of the Statute of Monopolies (b) contains a saving of this prerogative of the Crown, as to “letter patents and grants of privilege for the term of fourteen years or under,” thereafter to be made; and it is declared that the fourteen years are “to be accounted from the date of the first letters patents or grants of such privilege,” thereafter to be made, but with the proviso, that “the same shall be of such force as they should be,” if the Act had not been made, “and of none other.” Duration of a patent since the Statute of Monopolies.

This statute, therefore, limited the prerogative of the Crown so far, that a patent could not be granted for more than four-

(a) Noy, 182; 3 Inst. 184; 2 Rol. R. 4; 3 Shep. Abr. 61; Bac. Abr. Monop. (A). Prerog. (F 4); 1 Hawk. P.

Cr. c. 79, s. 6.

(b) 21 Ja. I. c. 3.

teen years, but still leaving the question open for consideration whether a patent for fourteen years was for a reasonable term; and good at the Common Law.

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

It seems from this commentary as if *Sir Edward Coke* thought that the inventor ought to be rewarded by a term in proportion to the benefit of his invention to the commonwealth. The other reason which he gives against the legality of the term of fourteen years mentioned in the Act, has never been attended to; and patents for inventions have always, in practice, been granted for the full term of fourteen years allowed by law, and no patent has ever been decided to be invalid, on the ground of the term of the grant being too long.

Grants may be made for less than fourteen years.

There can be no question, however, that the Queen may grant the use of an invention for any term less than fourteen years; and the provision in the statute that the term of fourteen years is to be computed from the date of the *first* letters patent or grant, seems to show that the Queen might grant

several terms shorter than fourteen years, provided the terms do not altogether exceed in duration the fourteen years allowed by the statute.

SECTION II.

Of the Extension of the Term by New Letters Patent.

BEFORE the passing of the statute 5 & 6 Will. IV. c. 83 (d), Stat. 5 & 6 Will. IV. c. 83. the only mode by which the duration of a patent privilege in an invention could be extended, was by Act of Parliament. By the fourth section of that statute it is in effect provided, Sec. 4. that if any person who shall obtain any letters patent, shall publish such advertisements as therein mentioned, and shall apply by petition to the Queen in council for a prolongation of his term; and if the consideration of the petition shall be referred to the Judicial Committee of the Privy Council, the petitioner, and also persons entering *caveats* against the prolongation are to be heard by their counsel and witnesses; whereupon the Judicial Committee of the Privy Council may report to the Queen, that a further extension of the term should be granted, not exceeding seven years. And her Majesty is thereby authorized and empowered, if she shall think fit, to grant new letters patent for the invention, for a term not exceeding seven years after the expiration of the first term (e). Upon report of judicial committee further term not exceeding seven years may be granted.

We have seen that the object of our Patent Law is to reward those who give to the public the knowledge of new and useful inventions, and in this manner to encourage others to give the public the benefit of such inventions (f). Object of the law to reward inventors.

The principle upon which an extension of a patent privilege is granted to a patentee, is, that he has not been rewarded or sufficiently rewarded for the benefit which the invention has conferred upon the public. Extension granted because patentee not rewarded.

When an inventor has obtained his patent, he must in the first place apply himself to the task of bringing his invention Time lost in bringing inventions to perfection.

(d) See the statute in the Appendix, Chapter I. s. 1.

Chap. XII.; and for the construction of the act see *Russell v. Ledsam*, not yet reported.

(e) For the proceedings to be taken in order to obtain the prolongation of a patent term, see the Practice, *post*,

(f) Vide *ante*, Chap. III.

to such a degree of perfection as to make it useful to the public, and in doing so, must necessarily incur expense and expend a considerable portion of the term granted by the patent.

Difficulty of introducing new articles.

And however useful and meritorious an invention may be, it is generally very difficult to introduce new articles into such general use as to remunerate the patentee for his necessary outlay; and in many instances a patentee does not during the term of fourteen years, allowed by law to be granted to him in the first instance, receive anything like an adequate reward for the benefit which he confers upon the public.

Justice of following act, the principle of the law.

It is but just, therefore, that the law should follow out the principle upon which patents for inventions are granted; and where it is shown that a patentee without any fault of his own has not been remunerated for his labour, and necessary outlay, or has not been adequately rewarded for the benefit which the invention has conferred upon the public, he ought to have such a further term granted to him as will be sufficient for effecting both those objects.

Intent of the statute to provide more adequate rewards.

Considering the general object of our Patent Law, and the preamble of the statute 5 & 6 Will. IV. c. 83, there can be no doubt that the intent of the 4th section of that Act was to provide for the more adequately rewarding of inventors, where they have given the public useful inventions, and have received no sufficient remuneration. And there can be no question respecting the good policy of granting such extensions, in proper cases, for obtaining "the more ample benefit of the public" (*g*) from such meritorious inventions.

Petitioner must show both utility of invention and want of remuneration.

Acting upon this intent of the law, and also in accordance with the grounds upon which Acts of Parliament have been granted for extending the terms granted by patents, the Judicial Committee of the Privy Council require every petitioner, for the prolongation of a patent term, to show not only that the invention is of considerable benefit to the public, but also that he has been unable to obtain any sufficient remuneration for his ingenuity and necessary outlay (*h*). And the practice of the Judicial Committee has been to report in favour of

(*g*) These words are in the preamble of the statute 5 & 6 Will. IV. c. 83.

(*h*) See further, as to what must be

proved in support of a petition for prolongation of a patent term, Practice, Chapter XII.

extensions for such terms as the merits of inventions, and the exigencies of the cases, require. In some cases the full term of seven years has been granted, but in many others, the extension has been for shorter periods.

Cases have occurred in which the extra term of seven years authorized by the statute 5 & 6 Will. IV. c. 83, s. 4, would entirely fail to remunerate an inventor sufficiently, and therefore the power granted to the Queen in Council, was, by s. 2, of the stat. 7 & 8 Vict. c. 69 (i), extended so as to authorize grants being made in such cases for terms not exceeding fourteen years.

Power of prolongation extended to 14 years by 7 & 8 Vict. c. 69. s. 2.

The object of this enactment also clearly appears on the face of it to be, to enable inventors to obtain a due remuneration for their expense and labour in perfecting their inventions in cases where an additional term of seven years would be insufficient for that purpose.

The object to remunerate patentees.

The object of the Patent Law being to reward meritorious inventors, the Privy Council will sometimes, in case of an application by an assignee of a patent for a prolongation, carry the object of the law into effect by annexing a condition in favour of the original patentee to the grant of the prolongation which the assignee seeks to obtain.

The privy council will sometimes require an assignee to reward the original patentee.

Thus, in the case of *Whitehouse's* patent (k), the application for an extension of the term was made by the assignee of the patent, and it appeared that the assignment under which he claimed reserved an annuity of 300*l.* a year to the patentee. The Judicial Committee of the Privy Council deemed the case to be a fit case for an extension of the term for six years, but granted it only upon condition that the patentee had an annuity of 500*l.* a year secured to him during the continuance of the additional term, which was granted in pursuance of their Lordship's report. Upon the new patent being granted, the securing of this annuity to the first patentee was recited as part of the consideration for the grant of the patent to the assignee, and the performance of the assignee's agreement to pay the annuity was secured by a proviso in the patent, that the patent should be void if the assignee failed to perform his

Whitehouse's patent.

(i) See the statute in the Appendix, Chap. I. s. 1.

(k) 1 Webs. R. 473.

agreement (l). Such cases as this are calculated to produce a very beneficial effect, as evincing a determination on the part of those who so ably administer the law to do justice to meritorious inventors, and reward them (as far as the law enables them) according to the degree of their merits.

Privy council will consider the position of licensees.

In granting a prolongation of a patent term, the Judicial Committee of the Privy Council will also take into consideration the position of licensees, and see that they are not unfairly prejudiced by the prolongation. A person who obtains a licence to use a patent privilege, only purchases the right during the continuance of the patent privilege; but he also makes the purchase, and perhaps invests considerable capital in machinery, or stock for working the invention, with the expectation that he will be at liberty to enjoy the unrestricted use of the invention at the end of the term.

New privilege would prejudice licensees.

But if a new privilege be granted to the patentee, to take effect from the expiration of the first, licensees under the first patent would be unable to continue the use of the invention without the consent of the patentee under the new patent, who might impose oppressive terms upon them, or altogether refuse a renewal of their licences. The fair and equitable mode of adjusting the respective rights of a patentee and his licensees in such a case seems to be, that every licensee should have the privilege of using the invention during the continuance of the new patent upon the same terms as he enjoyed his former licence.

Patentee must arrange with licensees.

Therefore, whenever there are several licensees entitled to use a patent invention, the patentee will not be able to obtain an extension of his term, unless he makes some arrangement with them, or undertakes to grant them licences upon the same terms as their former licences. It was for this reason that in the case of *Southworth's* patent (m), the petitioner proved in evidence that arrangements had been made with all the licensees that they should have licences on the same terms in the event of the term of the patent being extended.

Privy council will not interfere with legal or equitable claims.

But the Judicial Committee of the Privy Council will not, in other cases, interfere in favour of parties who, not being inventors, set up legal or equitable claims to participate in the

(l) 1 Webs. R. 476, n. (h).

(m) 1 Webs. R. 486, 487.

benefits to arise from the prolongation of a patent privilege, but will recognize the legal proprietors of the first patent only, leaving other parties to pursue their legal or equitable claims before the ordinary tribunals (n).

Some doubt having arisen in the construction of section 4 of the statute 5 & 6 Will. IV. c. 83, respecting the power conferred by that Act to grant prolongations in cases where patentees have wholly or partly assigned their privileges (o), the question was set at rest by the statute 7 & 8 Vict. c. 69, s. 4 (p), by which it is declared that an extension may be granted either to an assignee or assignees, or to the original patentee or patentees, or to an assignee or assignees and patentee or patentees conjointly.

Doubts as to power to grant extensions to assignees of patents obviated by 7 & 8 Vict. c. 69, s. 4.

SECTION III.

Of the Prolongation of the Term in a Patent, by Act of Parliament.

BEFORE the Crown was enabled to grant an extension of a patent term, by the statute 5 & 6 Will. IV. c. 83, s. 4, (mentioned in the preceding section of this Chapter,) the terms of patents for inventions were frequently prolonged by Parliament. The practice of prolonging patents in this manner seems to have originated soon after the passing of the Statute of Monopolies (1623), for we find an order of the House of Commons respecting petitions for bills to extend the terms in patents dated as far back as 1685.

Patent terms formerly prolonged by parliament.

Many of the Acts which have been passed for this purpose are mentioned in the Appendix to the Report of the Committee of the House of Commons in 1829, respecting the Law of Patents.

Almost all (if not all) the Acts which have been passed to extend the terms granted by patents, have been granted by Parliament upon the ground of the utility or benefit of the inventions to the public, and the Acts themselves recite this

Acts were granted because inventions useful.

(n) See the case, *Wright's patent*, 1 Webs. R. 561.

(o) In *Southworth's case* however Lord Brougham said, that the new letters patent ought to be granted to

the parties who had a legal interest in the existing patent.

(p) See the stat. in the Appendix, Chap. I. s. 1.

to be the reason or motive for granting the extension sought by the patentees.

In granting extensions under the 5 & 6 Will. IV. c. 83, s. 4, and 7 & 8 Vict. c. 69, s. 2, the Judicial Committee of the Privy Council seem to have considered themselves (as in truth they are) merely acting in the place of Parliament; and in execution of the powers thus delegated to them, have granted extensions of terms in patents in such cases only as Parliament would have granted them.

No Acts passed since 5 & 6 W. IV. c. 83.

There have been no Acts passed for prolonging such terms since the statute 5 & 6 Will. IV. c. 83 came into operation; and since the statute 7 & 8 Vict. c. 69, extends the power of the Queen in Council so as to authorize a prolongation for an additional term of fourteen years, there seems to be very little probability of any application to Parliament for such an Act being successful.

And it is clear that such an application would not succeed in any case except under extraordinary circumstances, and in all probability not until the patentee has obtained an extension of his term by a new patent under the recent statutes and found that the extended term is insufficient to procure him an adequate remuneration.

CHAPTER VII.

OF THE SPECIFICATION OF AN INVENTION WHICH IS MADE THE
SUBJECT OF A PATENT PRIVILEGE.

SPECIFICATIONS were unknown until the reign of Queen Anne; but before that time, it was usual in a patent, granting the sole use of an invention, to insert a recital containing a description of the invention which was made the subject of the grant (*a*). And there can be little doubt that a patent without such a recital, and also without a condition requiring a specification or description of the invention in some way or other for the use of the public, would be absolutely void for want of consideration. Specification unknown until the reign of Queen Anne.

The descriptions of inventions which were formerly contained in patents were, however, very meagre and unsatisfactory, and the practice being found inconvenient, about the middle of the reign of Queen Anne it became usual to insert in patents merely a short description or title of the invention, but at the same time with a proviso requiring that the patentee should enrol a particular description of the invention in Chancery, within a short time after the date of the patent. Origin of specification.

This was the origin of the instruments which are now generally denominated specifications.

The specification or description of a patent invention, by instrument enrolled in Chancery, is not however required either by the Common Law or by the Statute of Monopolies, as has frequently been supposed, but only by the condition or proviso which is contained in the patent itself. Specification required by proviso in the patent only.

The form of this condition in patents (*b*) invariably provides that if the patentee shall not *particularly describe and ascertain the nature of his invention, and in what manner it is to be performed* by an instrument in writing under his hand and Form of proviso.

(*a*) Vide *ante*, Chap. IV. p. 69.

(*b*) See the Form, *ante*, Chap. IV. p. 68.

seal, and cause the same to be enrolled in Chancery within the time named (four or six months) after the date of the patent, then the patent and the privilege granted by it are to cease and become void.

Two things required.

There are two things required by this proviso: *first*, That the patentee shall describe his invention by an instrument in writing, usually termed a specification; and, *second*, That this instrument shall be enrolled in Chancery, within a limited time, so as to become a record for the benefit of the public. We will first consider the specification itself.

If patentee dies before specification the patent is void.

The condition requires that the specification shall be under the hand and seal of the patentee (c), or if there be two or more patentees, then under the hand and seal of the patentees; or of one of them. But no executor, administrator, assignee, nor any other person except the patentee himself can make a valid specification of the invention. And, therefore, in case of the death of the patentee before specification of the invention, the patent must become void for want of a compliance with this condition.

Must be in writing.

A specification is also required to be in writing, and it may be written upon parchment, vellum, or paper, but it is apprehended not upon any other substance (d). But, although it must be in *writing*, it is not necessary that it should be entirely in *words*, it may be made partly in writing, and partly by means of plates, drawings, or figures.

Drawings or figures may also be used.

Macfarlane v. Price.

In the case of *Macfarlane v. Price* (e), Lord *Ellenborough*, C. J., said, that the patentee in his specification ought to inform the person who consults it, what is new and what is old; he should say, my improvements consist in this, describing by words if he can, or if not, by reference to figures.

Bloxam v. Elsee.

In the case of *Bloxam v. Elsee* (f), Lord Chief Justice *Abbott* said, "An inventor of a *machine* is not tied down to make such a specification, as, by words only, would enable a skilful mechanic to make the machine, but he is to be allowed to call in aid the drawings which he annexes to the

(c) Although a specification is, in pursuance of the condition, always made under the hand and seal of the patentee, it seems that it is not a deed, for an instrument requires delivering as well as sealing in order to become a deed;

Shep. Touch. 54, 55; Co. Lit. 36, a; Perkins, s. 137.

(d) Vide Shep. Touch. 54; Co. Lit. 229, a.

(e) 1 Stark. R. 199.

(f) 1 C. & P. 558, 564.

specification; and if, by a comparison of the words and the drawings, the one will explain the other sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient."

In the case of *The King v. Arkwright (g)*, Mr. Justice Buller directed the jury, that in determining the specification they were to consider it in conjunction with the plan annexed. And Mr. Baron Alderson directed the jury in a similar manner in the case of *Morgan v. Seaward (h)*.

It is, however, no objection to a specification that it has no drawing annexed to it, if it sufficiently describes the invention (i). Nor is it any objection that the drawings annexed to a specification are roughly executed, if they are sufficient with the specification to enable a competent person to use the invention (k).

There is no particular form requisite for a specification, nor are there any technical words necessary to be used in describing a patent invention.

The instrument must, however, in some way at least refer to the patent intended to be specified, or contain words which sufficiently indicate an intention to perform the condition in the patent.

Custom has, however, sanctioned a particular form for the commencement or introductory part of specifications, which patentees, with great prudence, almost invariably adopt.

Specifications framed in the usual way commence in the same form as a deed poll, with a direction such as the following:—"To all to whom these presents shall come, or be made known, I, James Gowland, of Leathersellers Buildings, London Wall, in the City of London, Chronometer Maker, send greeting." And this direction is proper, because all persons are interested in the subject of the patent, and are at their peril bound to take notice of the contents of the specification as enrolled (l); and it will become essentially a part of the patent itself, if it be a sufficient and legal compliance with the condition upon which the patent was granted.

(g) Dav. P. C. 128.

(h) 1 Webs. R. 173, 176.

(i) Per Rook, J., in *Boulton v. Bull*, Dav. P. C. 188, 189.

(k) Per Gibbs, C. J., in *Bovill v. Moore*, Dav. P. C. 359.

(l) 1 Co. R. 45, a.

Recital of
patent.

The specification then proceeds to recite the grant by patent of the invention intended to be specified in a form substantially as follows:—“Whereas her most excellent Majesty, Queen Victoria, by her letters patent, under the Great Seal of Great Britain, bearing date at Westminster, the day of _____ in the _____ year of her said Majesty's reign, did give and grant unto me the said James Gowland, my executors, administrators, and assigns, her especial licence, full power, sole privilege and authority, that I, the said James Gowland, my executors, administrators, and assigns, and such others as I, the said James Gowland, my executors, administrators, and assigns, should at any time agree with, and no others, from time to time, and at all times thereafter during the term of years therein mentioned, should, and lawfully might make, use, exercise, and vend, within that part of the United Kingdom of Great Britain and Ireland, called England, the Dominion of Wales, and Town of Berwick-upon-Tweed [the Islands of Guernsey, Jersey, Alderney, Sark and Man, and all her said Majesty's colonies and plantations abroad], my invention of ‘*a certain improvement, or certain improvements in the mechanism of Timekeepers,*’ in which said letters patent there is contained a proviso, that I, the said James Gowland, shall particularly describe and ascertain the nature of my said invention, and in what manner the same is to be performed, by an instrument in writing, under my hand and seal, to be enrolled in her said Majesty's High Court of Chancery, within [six] calendar months next, and immediately after the date of the said in part-recited letters patent, as reference being thereunto had will more fully and at large appear.”

This recital is amply sufficient to identify the patent, and the invention which is intended to be described. It is also useful, if not indeed necessary, in order to give notice to the public of the grant and authority in pursuance of which the description is made and enrolled amongst the public records of the country.

Declaration of
intent.

The specification then, according to the usual form, proceeds to declare the intent of the instrument thus:—

Without draw-
ings.

“Now, know ye, that in compliance with the said proviso, I, the said James Gowland, do hereby declare that the nature

of my said invention, and the manner in which the same is to be performed, are described and ascertained as follows (that is to say): my said invention consists," &c.

Then follows the description of the invention which is intended to be given in compliance with the condition in the patent.

But if the patentee makes use of drawings to aid him in describing his invention, the form is as follows:— With drawings.

"Now, know ye, that in compliance with the said proviso, I, the said James Gowland, do hereby declare that the nature of my said invention, and the manner in which the same is to be performed, are described and ascertained with the aid of the drawings annexed hereto (or appearing on the margin of these presents) by the words, letters, and figures following (that is to say): my said invention," &c.

After which follows the description of the invention, referring from time to time to the drawings when necessary.

This commencement of an ordinary specification is sufficient to show that the intent is to specify the invention comprised in the patent which is recited. This commencement sufficient to show intent.

Some such declaration of the intent or purpose of the instrument is clearly necessary, for if a specification was entirely without such a declaration, it would be difficult, if not impossible, to ascertain to what it referred, and therefore it could not be a sufficient compliance with the condition in the patent. Some declaration of intent necessary.

The effect of this commencement is, *primâ facie*, to claim as part of the invention every thing comprised in the following description (*m*). And therefore, if anything is comprised in the description which forms no part of the invention, it becomes necessary afterwards to disclaim it, in order to prevent the patent from being void by reason of the claim being too extensive. Effect of the commencement.

Having examined the formal commencement of a specification, we now come to the consideration of the essential or substantial part of it.

The condition already stated requires that this instrument shall "*particularly* describe and ascertain" the invention, Must particularly describe the invention.

(*m*) *Bovill v. Moore*, Dav. P. C. 399.

and that it shall describe and ascertain not only "the nature of the invention," but also "the manner in which it is to be performed."

The patent itself merely contains what is called the title of the invention; but the terms in which titles usually describe inventions in patents, do not descend to any particularity, and they never give any precise information respecting the nature of the inventions, much less as to the manner in which they are to be carried into effect.

Must show what the invention is.

The condition in a patent, therefore, requires that the specification shall contain a *description* of the invention, and the description is required to be *particular*, so that it may clearly *ascertain* what the invention is.

Must show how it is to be performed.

We have seen that the subject of every patent, granting the sole use of an invention, is in fact a sole privilege of using an art for manufacturing vendible articles (*m*). The condition for specification, therefore, requires that that instrument shall describe not only the nature of the art or invention, but *the manner in which it is to be performed*.

Object of the proviso requiring a specification.

The object of the proviso or condition which requires the enrolment of a specification is two-fold: first, That the public may know what it is they are prohibited from using during the term granted by the patent (*n*); and, secondly, That after the term has expired, the public may have the full benefit of the invention which forms the consideration for the grant.

Harmar v. Playne.

Thus, in the case of *Harmar v. Playne* (*o*), Lord *Ellenborough*, C. J., said, that the object of requiring a specification to be enrolled seemed to be to enable persons of reasonable intelligence and skill in the subject-matter to tell, from the inspection of the specification itself, what the invention was for which the patent was granted, and how it was to be executed. And in the case of *Bovill v. Moore* (*p*), Lord Chief Justice *Gibbs* said, that the object of the condition which requires the specification is, that the patentee shall thereby describe the mode of the manufacture, so as to enable any person to make it after his term is expired.

Bovill v. Moore.

Public entitled to know what

The patentee is required to enrol a specification of his in-

(*m*) Vide *ante*, Chap. V. s. 1, p. 77

(*n*) *Macfarlane v. Price*, 1 Stark. R. 201.

(*o*) Dav. P. C. 316.

(*p*) Dav. P. C. 398.

vention, because the public is entitled to know what the patent has been granted for, what they are prohibited from doing during the existence of the patent privilege, and what they are to become entitled to when it expires, as the consideration for the grant which has been made by the Crown on their behalf.

The vague description of an invention in the title of it contained in a patent, gives little if any notice to the public of the real nature of the manufacture they are prohibited from using, and unless some specific information were to be given to persons respecting what they are commanded by the patent to refrain from doing, they could not be punished for any violation of the patent right committed in ignorance of its nature and extent.

Whenever therefore an action is brought against a party for infringing a patent, in order to ascertain whether he is guilty of an infringement or not, it is necessary to ascertain whether the thing which is complained of as a contravention of the patent, is really or substantially described in the patentee's specification, as the whole or part of the invention for which the patent was granted (q). And if the specification does not sufficiently describe some art of manufacturing which is substantially the same as that used by the party charged with the infringement, no action can be maintained against him for such an alleged violation of the patent privilege.

In the case of *Morgan v. Seaward*, Mr. Baron Alderson held (r), that the patentee ought to state in his specification the precise way of doing every thing which is part of his invention; and that if any thing cannot be completely done by following the specification, then a person will not infringe the patent by doing it.

And in the case of *Nielson v. Thompson* (s), Lord Cottenham, L. C., said that the public are entitled to know for what it is that the patentee claims as the invention, that they may be saved inconvenience upon the subject; therefore the specification must tell the public for what it is that he claims protection.

A patent for an invention in fact contains a bargain made between the Queen acting on behalf of the public, and an in-

(q) See further as to what is an infringement, *post*, Chap. XI.

(r) 1 Webs. R. 182.

(s) *Ibid.* 283.

Title gives little if any information.

Description must include infringement.

Morgan v. Seaward.

Nielson v. Thompson.

Patent contains a bargain to be construed as other bargains.

ventor, by means of which the inventor obtains the sole right for a limited time to use the art which he has discovered, in consideration of his giving to the public a knowledge of his invention (t), so as to enable other persons to use it after the expiration of his privilege. And such bargains are to be judged on the principle of keeping good faith by making a fair disclosure of the invention, and to be construed as other bargains (t).

Law relating to specification much discussed.

No branch of Patent Law has undergone more discussion or consideration than that relating to the specification, and more patents have failed by reason of defects in their specifications than from any other cause.

Specification for some purposes part of patent.

For many purposes the specification must be considered as part of the patent itself, for it is enrolled in pursuance of an authority contained in the patent, and therefore it may perhaps be laid down, that for all purposes except for showing its own sufficiency or proving a due compliance with the proviso, by which it is required to be enrolled, it must be considered as part of the patent itself.

Hornblower v. Boulton.

Thus in case of *Hornblower v. Boulton* (u), Mr. Justice *Grose* said, "I consider the patent and specification so connected together as to make a 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." There are indeed no other means of obtaining any definite information respecting the invention which is comprised in a patent, than by having recourse to the specification; and therefore for the purpose of a patentee showing what his invention is; and, (in answer to any objections made to it,) that it possesses all the qualities of novelty, utility, &c., required by law; as well as that any act which he complains of was really an infringement of his patent, the patentee is at liberty to refer to his specification, and to treat it as part of his patent.

Crossley v. Beverley.

Thus, in the case of *Crossley v. Beverley* (x), which was an action for the infringement of a patent, Mr. Justice *Bayley* said, "I think the specification and the patent are to be taken

(t) See the observation of Lord *Eldon*, C. J., in *Cartwright v. Amatt*, Dav. P. C. 317, 318; *Harmar v. Playne*, 14 Ves. 131, 136.

(u) 8 T. R. 105; Dav. P. C. 230, S. C.

(x) 9 B. & C. 62; 1 Webs. R. 117, S. C.

as one munitment in enforcing this claim on the part of the patentee." Unless there be some variance between the title in the patent and the description contained in the specification, the specification must be deemed *prima facie* to describe the same invention, as that in respect of which the patentee originally petitioned the Crown for a patent privilege, and the description must, for all purposes, be deemed a part of the patent, except for the purpose of determining whether the patentee has sufficiently described the nature of the invention, and the manner in which it is to be used or performed according to the stipulations contained in the proviso in the patent, in pursuance of which he has enrolled it.

In considering the requisites of a specification, it is necessary to have regard not only to the words of the proviso in the patent, but also to the object with which a specification is required, and which has already been mentioned, *viz. the furnishing of sufficient and certain information to the public respecting what they are prohibited from doing whilst the privilege continues, and what they will be enabled to do after it is expired.*

Object of specification to be considered.

Object.

Many rules have been laid down by different writers respecting the requisites of a specification, but it is difficult, if not impossible, to lay down such a set of rules as will be applicable to every possible case.

Difficult to frame a perfect set of rules.

All that can be done is to state such rules as are of most general application; and by citing the decided cases and dicta of the judges on the subject, the reader will be better enabled to apply those rules in practice to the construction of the instrument. It ought always, however, to be borne in mind, that the enrolment or publication of the specification is to be the performance by the patentee of his part of the bargain which he has made with the public, and that part of the bargain *he is expected to perform with perfect good faith.*

General rules only can be given.

1. The patentee must in his specification describe the invention which is comprised in his patent, and not any other; and if it appears that there is any variance, or that the invention as described in the specification is not precisely similar to that mentioned in the patent, the patent will be void.

Must describe the same invention as the patent.

Thus, in the case of *The King v. Wheeler (y)*, it appeared *R. v. Wheeler.*

(y) 2 B. & Ald. 345.

that the invention was described by the title in the patent as "a new or improved method of drying and preparing malt." The specification stated the invention to consist in heating malt to a high degree, so that it should be changed to a deep brown colour. The jury having, by direction of Lord Chief Justice *Abbott*, returned a verdict for the Crown, the defendant moved for a new trial, which the Court of King's Bench refused, and the Lord Chief Justice, in delivering the judgment of the Court, said, "The defendant has represented himself to the Crown to be the inventor 'of a new or improved method of drying and preparing malt.' Malt was an article of common use before the granting of this patent, possessing qualities long and well known, and prepared or made by a process practised for many years, of which drying was one of the last stages. And it is in our opinion impossible to read this patent without supposing the patentee to claim the merit of having invented some new or improved method, either of organ or process of preparing, or at least of drying this old and well known article. Then, has the patentee by his specification shown himself to be the inventor of any method of drying or preparing this well known article? For this we are to look at the specification; and we there find that he claims to be the inventor, not of a method of drying or preparing this well known article, but of a method of giving to it, when previously prepared, some qualities which it did not possess before, or which it possessed only in a very slight degree; namely, the qualities of being soluble in water, and colouring the liquor in which it shall be dissolved, which latter is the object in view. And this is to be effected by a second and additional process, the application of a very high degree of heat. We think *the invention mentioned in this specification so entirely different from that mentioned in the patent, as that the latter (if any such there be) remains wholly undescribed and unspecified, and consequently that the issue (respecting the sufficiency of the specification) could not be found for the defendant.*"

The invention mentioned in the specification being different from that mentioned in the patent, the specification is insufficient.

Campion v. Benyon.

If in the specification there is

So in the case of *Campion v. Benyon* (2), Lord Chief Justice *Dallas* said, with respect to the specification of an invention, that if there be any departure in terms from the

(2) 6 B. Mo. 82.

patent, the whole is void; it must be commensurate with the patent itself. And in the same case, Mr. Justice *Burrough* said, that it is clear that the specification must cover and support the patent.

any departure in terms from the patent, the whole is void.

2. The patentee must in his specification make a full and complete disclosure of the nature of his invention, and of the manner in which it is to be performed.

Patentee must make a full and complete disclosure.

In the case of *The King v. Arkwright* (z), Mr. Justice *Buller* said, that the public have a right to a fair, full, and true description of the invention in the specification.

R. v. Arkwright. Public have a right to a full description.

So also in the case of *Turner v. Winter* (a), Mr. Justice *Ashurst* said, that it is incumbent on a patentee to give a specification of his invention in the clearest and most unequivocal terms of which the subject is capable. And his Lordship added, that "It is certainly of consequence that the terms of the specification should express the invention in the clearest and most explicit manner." And in the same case (b), Mr. Justice *Buller* said, "Many cases upon patents have arisen within our memory, most of which have been decided against the patentees, upon the ground of their not having made a full and fair discovery of their inventions. Whenever it appears that the patentee has made a fair disclosure, I have always had a strong bias in his favour, because in that case he is entitled to the protection which the law gives him."

Turner v. Winter.

Specification must be clear and explicit.

In the case of *Lewis v. Marling* (c), Mr. Justice *Bayley* said, that in order to support a patent, it is necessary that the specification should make a full disclosure to the public; but if he makes a full and fair disclosure, as far as his knowledge at the time extends, he has done all that is required.

Lewis v. Marling.

Must make a full disclosure.

So also in the case of *Morgan v. Seaward* (d), Mr. Baron *Alderson* laid it down, that the public have a right to expect and require that the specification shall be fair, honest, open, and sufficient, and contain a full description of the way in which the invention is to be carried into effect. And his Lordship told the jury that the question respecting the specification was, whether upon the whole evidence they were of

Morgan v. Seaward.

Must fairly and fully describe the invention.

(z) Dav. P. C. 61.

(a) Dav. P. C. 151.

(b) *Ibid.* 153.

(c) 10 B. & C. 22; 1 Webs. R. 496.

(d) 1 Webs. R. 174, 179.

opinion that the specification did fairly and fully give to the public that information which the public were entitled to receive.

Specification must be intelligible.

Must describe every part accurately.

Hill v. Thompson.

Must be clear and intelligible.

Turner v. Winter.

When fusion necessary, not sufficient to direct heat to be continued until effect produced.

Campion v. Benyon.

Must contain full accurate explanations.

Claims to be stated minutely.

Morgan v. Seaward.

Every part must be accurately described.

3. The specification must be intelligible, so that every person may be able to understand it, and learn from a perusal of it, what the art or invention is to which the patent is intended to apply. It must also describe the invention accurately so that no person shall be deceived or misled, and if the invention consists of several parts, it must contain a sufficient and correct description of every part.

In the case of *Hill v. Thompson (e)*, Lord *Eldon*, L. C., laid it down that a specification must be intelligible, and clearly express what the patentee claims as his invention.

In the case of *Turner v. Winter (f)*, it appeared that fusion was necessary to one part of the patent process. The specification directed heat to be continued until the effect was produced; but although it spoke of calcination, it did not mention fusion, and Mr. Justice *Buller* held that the omission rendered the specification insufficient.

In the case of *Campion v. Benyon (g)*, Lord Chief Justice *Dallas* said, with respect to the specification, that it must contain a full and accurate explanation how the invention is to be carried into effect. And in the same case, Mr. Justice *Park* said, that in the specification of a patent, the nature of the invention must be accurately and particularly described, and *the statement of the claims* of the patentee must be set forth in the most minute detail.

In the case of *Morgan v. Seaward (h)*, Mr. Baron *Alderson* said, that if either of the patentees' inventions (there were two comprised in the patent) was insufficiently specified, the patent would fail; for if a person runs the hazard of putting two inventions into one patent, he cannot hold his patent unless each can be supported as a separate patent. And in order to support the patent, each invention must be described in the specification in such a manner as to enable people clearly to know what the invention is, and how it is to be carried into effect.

(e) 3 Mer. 626; 1 Webs. R. 237, S. C.

(f) Dav. P. C. 154.

(g) 6 B. Mo. 82, 83.

(h) 1 Webs. R. 173.

So in the case of *Jones v. Ripley* (i), Lord Denman, C. J., held that if a specification be silent as to part of an invention stated in the title, or as to any part of the invention which is essential, the plaintiff will be nonsuited.

Jones v. Ripley.
Must not be silent as to any part of invention.

But in the case of *Nickels v. Haslam* (k), in which the invention was intituled "improvements in the manufacture of plated articles," and the specification described one improvement only, the Court of Common Pleas held that the specification was sufficient (l).

Nickels v. Haslam.

4. In making the claim of invention, the specification must accurately point out what is claimed, and if the claim be wrong, the patent cannot be sustained, although the specification describes (without claiming) what the patentee really invented.

If the claim in a specification is inaccurate the patent is bad.

Thus, in the case of *Sanders v. Aston* (m), it appeared that the patent was for "improvements in constructing or making buttons." The specification claimed the invention to be an improvement (upon a prior invention of the plaintiffs) by substituting flexible for metal shanks to buttons. The substitution of flexible for metal shanks, however, was not new, and therefore not sufficient to support the patent. The specification described the application of a toothed collet in the production of the flexible shanks in a particular way, which was new; but it did not any where appear in the specification that the patentee relied upon the collet as a material part of his invention, and there were other modes in which the object of the invention could be accomplished. The Court of King's Bench held that as the patentee had not claimed the use of the particular mode of substituting the flexible shank by means of the toothed collet, the patent was void.

Sanders v. Aston.

If the only thing which is new be not claimed as the invention, the patent is void.

So in the case of *The King v. Cutler* (n), it appeared that the defendant's patent, (of January, 1815,) was for an invention of "improvements applicable to fire-places, stoves, &c." (o). It appeared also, from the specification, that the invention consisted of a new mode of feeding the fire in a grate by a supply of fuel from below, instead of from above in the usual way. The

R. v. Cutler.

If the claim contained in the specification is incorrect, the mistake is fatal.

(i) 2 Rep. Arts. 150, N. S.; 5 L. Jour. C. S. 35; Webs. P. L. 137, (108*).

(k) 8 Jur. 474.

(l) See *Bainbridge v. Wigley*, Rep. Pat. 1829; Appendix, p. 197; 18 Rep.

Arts. 127.

(m) 3 B. & Ad. 881.

(n) 1 Stark. R. 354.

(o) See Pritchard's list of patents, p. 103, No. 1405.

coals intended to be consumed in the course of the day were to be deposited in a chamber beneath the grate, so placed, that the higher surface of the chamber was to be on a level with the lower surface of the grate. The fire being afterwards lighted in the grate, as the coals in the grate were gradually consumed, their place was to be supplied by winding up the coals from the chamber by means of a rack and pinion. The coals, as long as they remained in the box, were unignited, the air being excluded from below, and they did not become ignited until, by being wound up into the grate, they had been brought into contact with the coals previously ignited, and exposed to the access of the air. The defendant, in his specification, summed up his claim thus: "My invention consists in this, that the fuel necessary for supplying the fire shall be introduced at the lower part of the grate in a perpendicular, or in an oblique direction. As to the manner of performing it, it is set forth in the annexed descriptions and drawings." Before the date of the patent, a grate had been made for cooking, which was furnished with a door; when this door was open, the grate in no respect differed from an ordinary one (*p*), but when the door was shut, no part of the grate was visible except a few of the highest bars; and the whole of the grate having been filled with coals, and the coals within the bars above the door having been lighted, the coals in the lower part of the grate were carried up for the purpose of supplying the consumption above by means of a rack and pinion, at the discretion of the cook. The principle of this grate, it was contended, was precisely the same with that for which the patent was claimed; the lower part of the grate when the door was shut being in effect a closed chamber to which the air had no access, and the coals being gradually wound up from this chamber so as to afford a supply to the fire above. The same principle had been applied to a common grate long before the date of the patent. It was contended for the defendant that his invention went beyond that exhibited in these grates; in the latter there was no fresh introduction of fuel into the grate, so as to give a perpetual supply, there was nothing more than a means of contracting or compressing coals already

(*p*) The grate must have been deeper than ordinary grates.

within the grate, which could not be done without gradually diminishing the size of the grate itself. According to the defendant's construction, on the contrary, the chamber was independent of the grate, placed below it, and the fuel was gradually wound up from the chamber, without at all contracting the size of the grate itself. Lord *Ellenborough*, C. J., was of opinion that "The principle on which the two grates were constructed, was *identical with that described in the terms of the specification*, which was for a mode of supplying fuel from below, and there was nothing predicated in the specification of raising the fuel from below the grate; it was merely for elevating a supply of fuel from below, and that the defendant had confined himself, by thus summing up the extent of his invention, to the benefit of this principle."

5. The language of a specification must not be ambiguous; but must be as clear and precise as the nature of the subject will admit. Specification must not be ambiguous.

Thus in the case of *Turner v. Winter (q)*, Mr. Justice *Ashurst* said, that it is incumbent on a patentee to give a specification of his invention in the clearest and most unequivocal terms of which the subject is capable. And that if there is any unnecessary ambiguity affectedly introduced into the specification, the patent is void. And in the case of *Campion v. Benyon (r)*, Lord Chief Justice *Dallas* expressed himself nearly to the same effect. Turner v. Winter.
Unnecessary ambiguity will avoid a patent.
Campion v. Benyon.

So in the case of *Galloway v. Bleaden (s)*, the Lord Chief Justice *Tindal* said, that if there is a want of clearness in a specification so that the public cannot afterwards avail themselves of, much more if there is any studied ambiguity in it, so as to conceal from the public that which the patentee for a term is enjoying the exclusive benefit of, the patent itself would be completely void. Galloway v. Bleaden.
Want of clearness, or studied ambiguity will render a patent void.

6. When an inventor applies for his patent, he describes the nature of his invention in general terms, and it is to be presumed, in the absence of any thing to show the contrary, that he has contracted to give the public the whole of his discovery, and all his knowledge on the subject, as the consideration for the privilege granted to him by the Crown. It is indeed ab- Specification must give the best of patentee's knowledge.

(q) Dav. P. C. 151.
(r) 6 B. Mo. 81.

(s) 1 Webs. R. 524.

absolutely essential for the protection of the public, that this rule should be adopted and acted upon, for patentees would otherwise be enabled to commit great frauds, by concealing the most important parts of their inventions.

The specification must therefore describe the invention according to the best of the patentee's knowledge.

R. v. Arkwright.

Thus in the case of *The King v. Arkwright* (t), Mr. Justice Buller said, that a specification must put the public in possession of the invention in as ample and beneficial a way as the patentee himself uses it. So in the case of *Turner v.*

Turner v.
Winter.

Winter (u), the same learned Judge said, that if the patentee makes the article for which the patent is granted, with cheaper materials than those which he has enumerated in his specification, although the latter will answer the purpose equally well, the patent is void because he does not put the public in possession of his invention, or enable them to derive the same benefit which he does himself.

Bovill v. Moore.

Must enable the public to use the invention to the extent most beneficial within the knowledge of the patentee at the time.

And in the case of *Bovill v. Moore* (x), Lord Chief Justice Gibbs said, "There is another consideration respecting the specification which is also a material one, and that is, whether the patentee has given a full specification of his invention, not only one that will enable a workman to construct a machine answering to the patent, but one that will enable a workman to construct a machine answerable to the patent *to the extent most beneficial within the knowledge of the patentee at the time*; for a patentee who has invented a machine useful to the public, and can construct it in one way more extensive in its benefit than another, and states in his specification only that mode which would be least beneficial, reserving to himself the more beneficial mode of practising it, although he will have so far answered the patent as to describe in his specification a machine to which the patent extends; yet he will not have satisfied the law by communicating to the public the most beneficial mode he was then possessed of for exercising the privilege granted to him."

Morgan v.
Seaward.

Must state the mode by which invention most

And in the case of *Morgan v. Seaward* (y), Mr. Baron Alderson said, that if a patentee is acquainted with any particular mode by which his invention may be most conve-

(t) Dav. P. C. 106.

(u) *Ibid.* 154.

(x) Dav. P. C. 400; 2 Marsh. 211.

(y) 1 Webs. R. 174.

niently carried into effect, he ought to state it in his specification. conveniently carried into effect.

7. And if the patentee omits or conceals any material part of the invention, or anything which he knows to be useful, the specification will not be sufficient. If any thing omitted or concealed the patent void.

Thus, in the case of *Liardet v. Johnson* (z), which was an action for infringing a patent for steel trusses, the patentee omitted what was very material for tempering the steel, which was rubbing it with tallow. And because this was omitted the specification was held to be insufficient, and the patent was avoided. Liardet v. Johnson.
Omission of any thing material is fatal.

So in the case of *Neilson v. Harford* (a), Mr. Baron Parke told the jury that if they thought the patentee knew that partitions were useful (in their blowing apparatus which he had invented), and omitted to state that in the specification, that would make the specification void. His Lordship also said, that if the partitions were necessary to make the apparatus operate beneficially, in that case the patent would be void, because it was not introduced as a necessary circumstance into the specification. And that if the patentee had known that the tubular form (of a part of the apparatus) would answer best, he ought to have introduced it, and the specification would have been bad upon the ground that he concealed the best mode of working out his own discovery. Neilson v. Harford.
If patentee omits anything he knows to be useful the patent is void.
Or if he omits anything which is necessary.

The case of *Wood v. Zimmer* (b), was an issue out of Chancery to try the validity of a patent granted to Jacob Zinok, in which the invention was described as a method of manufacturing verdigrease. The specification stated it to be produced from certain proportions of granulated copper and oil of vitriol, boiled a certain time in a copper of a particular construction (which was described), and afterwards strained off and mixed with a solution of potash or soda. It appeared, however, that Zinck was accustomed clandestinely and unobserved by his workmen to put aquafortis into the boiler, by means of which the copper was dissolved more rapidly, but the specification did not mention aquafortis in any way whatever. Wood v. Zimmer.
If anything which the patentee knows to be useful is omitted the patent is void.

Lord Chief Justice Gibbs said, "A man who applies for a patent, and possesses a mode of carrying on that invention in

(z) Buller, N. P. 76; Dav. P. C. 155.
(a) 1 Webs. R. 321, 322.

(b) Holt, N. P. C. 58.

the most beneficial manner, must disclose the means of producing it in equal perfection, and with as little expense and labour as it costs the inventor himself. The price that he pays for his patent is, that he will enable the public, at the expiration of his privilege, to make it in the same way, and with the same advantages. If any thing which gives an advantageous operation to the thing invented be concealed, the specification is void. Now, though the specification should enable a person to make verdigrease substantially as good without aquafortis as with it; still, inasmuch as it would be made with more labour by the omission of aquafortis, it is a prejudicial concealment, and a breach of the terms which the patentee makes with the public." And the jury having found that aquafortis was used by the inventor as an ingredient in the verdigrease, his Lordship held that the patent was void.

Bovill v. Moore.
Concealment of anything beneficial will render the patent void.

So also in the case of *Bovill v. Moore* (c), already cited, Lord Chief Justice *Gibbs* held, that if at the time when the patentee obtained his patent he was apprized of a more beneficial mode of working his invention, and did not by his specification communicate it to the public, that would be a fraudulent concealment from the public, and would render his patent void. And his Lordship told the jury, that if they thought that the patentee had studiously kept it back from the public, in order that he might have an advantage over others, that would be a suppression that would avoid his patent.

Lewis v. Marling.
Must not suppress anything.

In the case of *Lewis v. Marling* (d), Mr. Justice *Bayley* said, that if a patentee suppresses any thing, or if he does not communicate all he knows, his specification is bad.

Morgan v. Seaward.

And in *Morgan v. Seaward* (e), Mr. Baron *Alderson* also held, that a patentee ought to give to the public all the knowledge he himself has respecting his invention.

Must give all his knowledge.

Must give the whole of patentee's knowledge up to the time of specification.

8. And the rule that a patentee must give the public the benefit of all his knowledge respecting his invention, has been carried so far, that in the case of *Crossley v. Beverley* (f), it was laid down that he must give to the public all improvements which he may invent after obtaining his patent, and before the enrolment of his specification. In that case the

Crossley v. Beverley.

(c) Dav. P. C. 401; 2 Marsh. 211, S. C.

(d) 10 B. & C. 22; 1 Webs. R. 496.

(e) 1 Webs. R. 182.

(f) 9 B. & C. 63.

invention was of "an improved gas apparatus," and it appeared that between the date of the patent and the specification, the patentee invented improvements in the apparatus, which he described in the specification as part of his invention. The improvements clearly came within the meaning of the title contained in the patent, and all formed part of the same apparatus, the effect being in fact more completely to carry into effect the object which the patentee had in view when he made his invention. It was objected, that the patent was void by reason of the patentee having inserted improvements in his specification which formed no part of the invention for which he had obtained his patent. The Court of King's Bench, however, held, that the insertion of these improvements in the specification not only did not render the patent void, but that it was the duty of the patentee to communicate them to the public. Lord *Tenterden*, C. J., said, in giving judgment, "I do not see myself why time is allowed to prepare the specification, except upon the idea that the person, at the time he took out his patent, has not brought his machine, or whatever he has invented, to that degree of perfection which it may be supposed he is capable of bringing it to, and therefore he is allowed further time to do it." And Mr. Justice *Bayley* said, "I think it is most beneficial to the public to say, that it is the duty of the inventor, if, between the period of taking out the patent and enrolling the specification, he makes discoveries which will enable it better to effectuate the thing for which the patent was obtained, not only that he is at liberty to introduce them into his patent, but that it is his bounden duty so to do, and that it is not sufficient for him to communicate to the public the knowledge which he had at the time he obtained the patent, but he ought to communicate to the public the knowledge he has obtained before the specification."

So also in the case of *Jones v. Heaton (g)*, Lord Chief Justice *Tindal* held, that a patentee is bound to give in his specification the most improved state of his invention up to the time of enrolling his specification.

Jones v. Heaton.
Must give most improved state of invention at the time of specification.
Every thing

9. Everything necessary to the working of the invention must

necessary must
be described.

be described, for if that be not done, the specification will not particularly ascertain the manner in which it is to be performed; as required by the proviso in the patent. The patentee must therefore give the public every information which is necessary to enable them completely to perform every part of the patent process which is now, although it may be sufficient to refer in general terms to such things as are old or well known.

*De Rosne v.
Fairie.*

If specification
omits anything
necessary to
carry the in-
vention into
effect the patent
is void.

In the case of *De Rosne v. Fairie* (*h*), it appeared that the plaintiff's patent was for an invention intituled "improvements in extracting sugar or syrups from cane juice, and other substances containing sugar, and in refining sugar and other syrups." The specification stated the invention to consist in a means of discolouring (depriving of colour) syrups of every description by means of charcoal produced by the distillation of bituminous schistus alone, or mixed with animal charcoal, and even of animal charcoal alone; the charcoal to be disposed of on beds very thick on a filter of any suitable form. After describing the process, the patentee in the specification said, "The carbonization of bituminous schistus has nothing particular, it is produced in close vessels, as is done for producing animal charcoal; only it is convenient, before the carbonization, to separate from the bituminous schistus the sulphurets of iron which are mixed with it." But the patentee did not describe any mode by which the sulphurets of iron could be separated from bituminous schistus. It did not appear clear upon the evidence whether bituminous schistus was or was not capable of being purified from the sulphurets of iron with which it is mixed, so that it should not be prejudicial to the sugar by colouring it in the course of the operation. The defendant objected to the sufficiency of the specification, because it did not show in what manner bituminous schistus could be purified from iron. Lord *Abinger*, C. B., directed the jury to find a verdict for the plaintiff or defendant according as they found the description of the bituminous schistus to be sufficient, or insufficient, so that all the world could or could not use it. The jury gave a verdict for the plaintiff, but the Court of Exchequer set it aside, and granted a new trial.

(*h*) 5 Tyr. 393.

Lord *Abinger* in giving judgment, said that his impression at the trial was strong that there was no evidence to go to the jury in support of the patent, and that it was incumbent on the plaintiff to show either that there was some bituminous schistus found in this country, which, after having been exposed to the process of distillation described in the specification, might be used with effect, and without detriment to the sugar, though one of its component parts, iron, was not entirely removed from it; or that there was some known process of removing that iron from it. It appeared by the evidence that in all the various forms in which the article (bituminous schistus) exists in this country, sulphuret of iron is found; and the witnesses not describing any known process by which it could be extracted, his Lordship was of opinion that the plaintiff ought to have proved one of two things, either that the sulphuret of iron in bituminous schistus is not so absolutely detrimental as to make its presence disadvantageous to the process, (in which case the patent would be good,) or that the process of extracting the iron from it is so simple and known, that a practical man would be able to accomplish it with ease. And his Lordship added, that as the plaintiff had not given any evidence to show that bituminous schistus, in the state in which it is found and known in England, could be used in the process with advantage, the defendant was entitled to a nonsuit. The rest of the Court (Mr. Baron *Parke*, Mr. Baron *Bolland*, and Mr. Baron *Alderson*) entirely agreed with the Lord Chief Baron; and Mr. Baron *Alderson* added, that if it had been shown that bituminous schistus, deprived of iron, could be made by a process known to ordinary chemists of skill, or that it was a substance capable of being ordinarily purchased in the market as an article of commerce, it would have been unnecessary to have shown (in the specification) the operation of separating the iron from it.

So in the case of *Macnamara v. Hulse* (i), Lord *Abinger*, Macnamara v. Hulse. C. B., was of opinion that the specification was bad, because it did not mention the angles at which the patentee's paving blocks were to be cut according to his invention.

And in the case of *Neilson v. Harford* (k), Mr. Baron Neilson v. Harford.

(i) Car. & Marsh. 478.

(k) 1 Webs. R. 317, 321.

Bad if anything necessary omitted.

Purke laid down as law, in his charge to the jury, that if the patentee had omitted to make mention, in his specification, of anything which was necessary for the beneficial use or enjoyment of the invention, the specification would be bad.

Known parts need not be minutely described.

Harmar v. Playne.
Unnecessary to describe well known things.

10. When a patent is obtained for an improved machine or other article, it seems to be unnecessary minutely to describe all the known parts of the old machine. In case of *Harmar v. Playne* (l), Lord *Ellenborough*, C. J., said, "It may not be necessary in stating a specification of a patent for an improvement, to state precisely all the former known parts of the machine, and then to apply to those the improvement; but on many occasions it may be sufficient to refer generally to them. As in the instance of a common watch, it may be sufficient for the patentee to say, take a common watch, and add or alter such and such parts, describing them."

Must enable others to practise the invention.

11. The specification must be sufficient to enable persons not only to understand the nature of the invention, but also to put it into successful practice.

Newberry v. James.
Must enable others to use the invention.

Thus in the case of *Newberry v. James* (m), Lord *Eldon*, J. C., said, that in order to support a patent, the specification should be so clear as to enable all the world to use the invention as soon as the term for which it has been granted it at an end. So it was laid down in *Liardet v. Johnson* (n); that the question respecting a specification is, whether it is sufficient to enable others to make the patent article, for the meaning of the specification is, that others may be taught to do the thing for which the patent is granted, so that after the term, the public shall have the benefit of the discovery.

Liardet v. Johnson.
Must enable others to make the patent article.

R. v. Arkwright.
Must be sufficient to teach others to use the invention.

In the case of *The King v. Arkwright* (o), Mr. Justice *Buller* said, that "It is clearly settled as law, that a man, to entitle himself to the benefit of a patent for a monopoly, must disclose his secret and specify his invention in such a way that others may be taught to do the thing for which the patent is granted; for the end and meaning of the specification is to teach the public, after the term for which the patent is granted, what the art is."

Morgan v. Seaward.

And in the case of *Morgan v. Seaward* (p), Mr. Baron

(l) Dav. P. C. 318.
(m) 2 Mer. 451.
(n) Bull. N. P. 76.

(o) Dav. P. C. 106.
(p) 1 Webs. R. 173.

Alderson said, that the invention must be described in the specification in such a manner as to lead people clearly to know what the invention is, and how it is to be carried into effect.

In the case of *Bovill v. Moore* (q), Lord Chief Justice *Bovill v. Moore*. *Gibbs* said, that a patentee ought in his specification to describe the mode of the manufacture, so as to enable any person to make use of it after his term has expired.

And in the case of *Galloway v. Bleaden* (r), Lord Chief Justice *Tindal* laid it down, that if there was a want of clear- *Galloway v. Bleaden*.
ness in the specification, so that the public could not afterwards avail themselves of the invention, the patent would be completely void.

12. The specification must be understood as addressed to persons of ordinary skill and ordinary knowledge of that branch of the useful arts to which the invention relates. *Specification addressed to persons of ordinary skill.*

Thus in the case of *Morgan v. Seaward* (s), Mr. Baron *Alderson* said to the jury in summing up, "A specification is addressed to all the world; and therefore all those possessed of a competent skill ought to be able to construct the machine by following the specification. The specification should be such as to enable a workman of ordinary skill to make the machine." And the learned Judge afterwards added (t), that the question respecting the specification was, whether a man of ordinary knowledge and skill, bringing that ordinary knowledge and skill to bear upon the subject, would be able to make the patent machine from the instructions contained in the specification. *Morgan v. Seaward.*
Must enable persons of ordinary knowledge to use the invention.

And in the case of *Neilson v. Harford* (u), Mr. Baron *Parke* said, in summing up to the jury, that if a person of ordinary and competent skill would be enabled by the specification to erect the patent machine, the specification would be good. And the learned Judge went on to say, that the jury were not to ask themselves the question, whether persons of great skill—a first-rate engineer or a second-class engineer—whether they could do it; because generally those persons are men of great science and philosophical knowledge, and they *Neilson v. Harford.*
Specification not addressed to persons of great skill and knowledge.

(q) Dav. P. C. 361.

(r) 1 Webs. R. 524.

(s) 1 Webs. R. 176.

(t) *Ibid.* 178.(u) *Ibid.* 314-322.

would, upon a mere hint in the specification, probably invent a machine which would answer the purpose extremely well; but that is not the description of persons to whom a specification may be supposed to be addressed; it is supposed to be addressed to a practical workman, who brings the ordinary degree of knowledge, and the ordinary degree of capacity, to the subject; and if such a person would construct an apparatus that would answer some beneficial purpose, according to the terms of the specification, then the specification is good, and the patent may be supported.

It is addressed to persons of ordinary knowledge and capacity.

Elliott v. Aston. And in *Elliott v. Aston* (x), Mr. Justice *Coltman*, speaking of the specification, said, that the question was, whether the patentee had given such a description in his specification as would enable a workman of competent skill to carry the invention into effect.

Manton v. Manton. And in the case of *Manton v. Manton* (y), Lord Chief Justice *Gibbs* said, that it was necessary that the patentee should show that he had accurately explained the nature of his invention in his specification, so as to enable a person of tolerable skill to make the thing by means of his specification.

Brooks v. Ripley. In the case of *Brooks and another v. Ripley and another* (z), Lord *Lyndhurst*, C. B., said, that if the specification was not sufficiently clear to be understood by an ordinary workman, witnesses will not be allowed to be called to explain the intention of the patentees, and the plaintiffs will be nonsuited.

Not necessary to be so minute as to instruct ignorant persons.

13. But it is not necessary that a specification should describe an invention, and the manner in which it is to be performed, so fully as to instruct persons wholly ignorant of the subject.

Arkwright v. Nightingale. Thus, in the case of *Arkwright v. Nightingale* (a), Lord *Loughborough* said, that a specification is addressed to persons having skill in the subject, not to men of ignorance; and if it is understood by those whose business leads them to be conversant in such subjects, it is sufficient.

R. v. Arkwright. In the case of *The King v. Arkwright* (b), Mr. Justice *Buller* said, that if the specification be such that *mechanical men* of common understanding can comprehend it to make a machine by it, it is sufficient; but then it must be such, that:

(x) 1 Webs. R. 224.

(y) Dav. P. C. 349.

(z) 2 Lon. J. C. S. 35; Webs. P. L.

134 (102).

(a) Dav. P. C. 56.

(b) *Ibid.* 106.

mechanics may be able to make the machine by following the directions of the specification.

In the case of *Hornblower v. Boulton* (c), Mr. Justice *Grose* said, that if the specification be such as to enable artists to adopt the invention, and make the manufacture, it is sufficient.

Hornblower v. Boulton.

In the case of *Huddart v. Grimshaw* (d), Lord *Ellenborough*, C. J., said, that the specification must convey to the public a corresponding advantage with that of the patentee, whose sole right is protected for a time, so that any person who is skilled in the subject, upon looking at the specification, may be able to accomplish the end.

Huddart v. Grimshaw.

Persons skilled on the subject.

In the case of *Harmar v. Playne* (e), Lord *Ellenborough*, C. J., said, that the object of requiring a specification to be enrolled, seemed to be to enable persons of reasonable intelligence and skill in the subject-matter to tell, from the inspection of the specification itself, what the invention was for which the patent was granted, and how it was to be executed. And also, that when Lord *Mansfield* said (in the case of *Leardet v. Johnson* (f),) that the meaning of the specification was, that others might be taught to do the thing for which the patent was granted, it must be understood to enable persons of reasonably competent skill in such matters to make it; for no specification would probably enable a ploughman, utterly ignorant of the whole art, to make a watch. And his Lordship afterwards said, that a person must carry a reasonable knowledge of the subject-matter with him, in order clearly to comprehend specifications of inventions though intended to be fairly made.

Harmar v. Playne.

Must enable persons of reasonable intelligence and skill to know what the invention is, and how used.

A person must carry with him a reasonable knowledge of the subject.

So also, in the case of *Rowntree v. ———* (g), before Lord *Eldon*, which was an action for infringing a patent for a method of applying fire for heating boilers, &c., the patent was held to be void, because the jury was of opinion that the specification was not sufficiently clear to enable an ordinary tradesman to put the invention in practice.

Rowntree v. ———

If the specification not sufficient to instruct an ordinary tradesman the patent void.

In the case of *Morgan v. Seaward* (h), Mr. Baron *Alderson* said, in his charge to the jury, that a specification ought to

Morgan v. Seaward.

(c) Dav. P. C. 228.

(d) *Ibid.* 279.

(e) *Ibid.* 316.

(f) Bull. N. P. 76.

(g) Parl. Rep. 192.

(h) 1 Webs. R. 174.

Must be framed so as not to require more than the ordinary knowledge of a competent workman.

be framed so as not to call on a person to have recourse to more than those ordinary means of knowledge (not invention) which a workman of competent skill in his art and trade may be presumed to have. You may call upon a man to exercise all the actual existing knowledge common to the trade, but you cannot call upon him to exercise any thing more.

Bickford v. Skewes.
Not addressed to persons entirely ignorant.

So in the case of *Bickford v. Skewes* (i), Lord Denman, C. J., said, in delivering the judgment of the Court of Queen's Bench, the specification is addressed, not to persons entirely ignorant of the subject-matter, but to artists of competent skill in that branch of manufactures to which it relates.

Specification must be sufficient without addition.

14. And a specification must be sufficient to enable persons of ordinary skill to use the invention *without any new inventions or additions of their own, or any assistance from others.*

R. v. Arkwright.
Must be sufficient without requiring any addition or invention.

Thus, in the case of *The King v. Arkwright* (k), Mr. Justice Buller laid it down as law, that the specification ought to be such that mechanics might be able to make the (patent) machine, by following the directions of the specification without any new inventions or additions of their own; and this was strongly approved of by Mr. Baron Alderson, in the case of *Morgan v. Seaward* (l), in which his Lordship said, that the public ought to be told the manner in which the thing may be done in respect of which the patent is granted, not by themselves becoming inventors of a method of carrying it into effect, but by following the specification, without making any new invention, or any addition to the specification.

Specification ought to be sufficient according to the knowledge of workmen at the time it is given.

Mr. Baron Alderson also held, in *Morgan v. Seaward*, that the specification ought to be sufficient to enable workmen of ordinary and competent skill and knowledge to use the patent invention without any other instructions. And that, in judging of the sufficiency of the specification, the criterion is, whether *at the time when the specification is given to the world* a person would be able by means of it and his ordinary knowledge and skill, to use the invention without deriving information from any other source.

Neilson v. Harford.

And in the case of *Neilson v. Harford* (m), the Court of Exchequer held, that to be valid, a specification should be

(i) 1 Webs. R. 218.
(k) Dav. P. C. 106.

(l) 1 Webs. R. 173, 174.
(m) 1 Webs. R. 371; 8 M. & W. 806.

such as if fairly followed out by a competent workman without invention or addition, would produce the article for which the patent is taken out.

15. The specification must not cast upon the public the trouble of making experiments to enable them to use the invention; nor will it be sufficient if it merely suggest something as likely to be useful. The representation of the patentee to the Crown that he had made an invention must be taken to mean, that he had made a complete invention; and it therefore was his duty to give the public such complete information as would render it unnecessary for them to make experiments to enable them to carry the invention into effect.

Specification must not describe the invention so as to render experiments necessary.

Thus, in the case of *Turner v. Winter* (n), Mr. Justice *Ashurst* said, that the terms of the specification should express the invention in the clearest and most explicit manner; so that a man of science may be able to produce the thing intended without the necessity of trying experiments.

Turner v. Winter.

Must enable persons to use the invention without trying experiments.

In the case of *Morgan v. Seaward*, Mr. Baron *Alderson* held, that if a specification does not give such information as will render it unnecessary for parties to make experiments, it is insufficient (o). And his Lordship also said, that a specification must not merely suggest something that will set the mind of an ingenious man at work, but it must actually and plainly set forth what the invention is, and how it is to be carried into effect so as to save a party the trouble of making experiments and trials (p).

Morgan v. Seaward.

Must give sufficient information to render experiments unnecessary.

So in the case of *Neilson v. Harford* (q), Mr. Baron *Parke* told the jury, that if experiments were necessary in order to enable a person to construct the patent machine, the specification was defective. But if experiments are only necessary in order to produce the greatest beneficial effect, the specification would not for that reason be insufficient (r).

Neilson v. Harford.

In the case of *Crompton v. Ibbotson* (s), Lord *Tenterden*, C. J., said, "The patent was obtained for the discovery of a proper conducting medium. The plaintiff found, after repeated trials, that nothing would serve the purpose except

Crompton v. Ibbotson.

If specification states anything which will lead

(n) Dav. P. C. 152.
 (o) 1 Webs. R. 180.
 (p) *Ibid.* 175.
 (q) *Ibid.* 320, 326.

(r) See also *Macnamara v. Hulse*,
 Car. & Marsh. 477.
 (s) Dan. & Lloyd, 33.

others to make
useless experi-
ments it will be
bad.

the cloth described in his specification; yet he says the cloth may be made of any suitable material, and merely that he prefers the particular kind there mentioned. *Other persons, misled by the terms of this specification, may be induced to make experiments which the patentee knows must fail; and the public, therefore, has not the full and entire benefit of the invention,—the only ground on which the patent is obtained.*"

False represen-
tation in speci-
fication avoids a
patent.

16. It has already been shown in a former part of this work (*t*), that a false representation or suggestion to the Crown of anything material respecting the invention will render the patent void by reason of the fraud practised upon the Crown. And as against the patentee it must be presumed that when he applied for the patent, he made the same statements to the Crown as those contained in the specification. And if a specification be false or untrue in any material particular, or if it be framed so as to mislead or puzzle, the patent will be void. The patent being a bargain between the public and the patentee, the specification is the price which he pays for the privilege granted to him in his invention. And if he inserts anything in his specification which is untrue, or calculated to mislead or puzzle, he commits a breach of good faith, and the specification being a fraud upon the public the patent is void.

Anything which
is false or mis-
leads renders
a patent void.

R. v. Arkwright.
If false or de-
fective the
patent is void.

Thus in the case of *The King v. Arkwright*, Mr. Justice *Buller* said, in his charge to the jury, that if the specification in any part of it was materially false or defective, the patent could not be supported (*u*). His Lordship also held, that if certain things mentioned in the specification were of no use, and merely thrown in to puzzle, the patent was void (*x*).

Turner v.
Winter.

Anything which
tends to mislead
avoids the
patent.

In the case of *Turner v. Winter* (*y*), Mr. Justice *Ashurst* said, that if there was anything in the specification which tended to mislead the public, or if the process as directed by the specification did not produce that which the patent professes to do, the patent was void. And in the same case Mr. Justice *Buller* said (*z*), that if the patentee could only make the patent article with two or three of the ingredients mentioned in the specification, and if he had inserted others which

(*t*) *Ante*, Chap. IV. p. 42.

(*u*) *Dav. P. C.* 106.

(*x*) *Ibid.* 118.

(*y*) *Ibid.* 151, 152.

(*z*) *Ibid.* 154.

would not answer the purpose, that would avoid the patent (a). The same law was laid down by the Court of Queen's Bench in the case of *Bickford v. Skewes* (b).

Bickford v. Skewes.

In the case of *Lewis v. Marling*, Lord Tentorden, C. J., said (c), that if a patentee mentions that as an essential ingredient in the patent article which is not so, nor even useful, and whereby he misleads the public, his patent might be void; and indeed there can be little doubt that it would be so. And in the same case, Mr. Justice Bayley said (d), that if a patentee by his specification misleads the public, his specification is void. So if he says that there are many modes of doing a thing, when in fact one only will do, this will avoid the patent.

Lewis v. Marling.

If specification misleads the public the patent is void.

In the case of *Neilson v. Harford* (e), Mr. Baron Parke held at Nisi Prius that a material statement in the specification being incorrect or untrue would avoid the patent. And in the same case (f), the Court of Exchequer held that a specification would be bad which contains a false statement in a material circumstance, of a nature that if literally acted upon by a competent workman would mislead him, and cause the experiment to fail.

Neilson v. Harford.

If a material statement incorrect the patent is void.

In the case of *Savory v. Price* (g), it appeared that the patent was for an invention of a neutral salt, which is called seidletz powder. The new salt or medicine was composed of three ingredients: 1st, Rochelle salts; 2nd, Carbonate of soda; and 3rd, Tartaric acid. These ingredients were well known substances before the date of the patent, but the patentee, instead of describing them by any of their known names, inserted in his specification three recipes numbered 1, 2, and 3, the produce of which respectively were the three substances already mentioned. The specification then described the modes and proportions in which the three ingredients produced by the three recipes were to be mixed together in order to produce the "seidletz powder;" and it was proved that the mixture answered the purpose stated by the patentee. Lord Chief Justice Abbott, however, held that the

Savory v. Price.

If unnecessary descriptions are introduced in order to mislead, the patent is void.

(a) See also *Crompton v. Ibbotson*, Dan. & Lloyd, 33, cited *ante*, p. 177.

(b) 1 Webs. R. 218; 1 Q. R. 938.

(c) *Ibid.* 495.

(d) *Ibid.* 496.

(e) 1 Webs. R. 295.

(f) 8 M. & W. 806.

(g) Ry. & Mo. N. P. C. 1.

Patentee ought to point out the plainest and most easy way of using the invention.

If he leads people to suppose a laborious process is necessary when in fact it is very simple, the specification is bad.

Need not particularize every thing which will produce the effect.

Bickford v. Skewes.

De Rosne v. Fairrie.

Form need not be described unless essential.

Neilson v. Harford.

Things necessarily implied need not be described.

patent was void, and said, "It is the duty of any one to whom a patent is granted to point out in his specification the plainest and most easy way of producing that for which he claims a monopoly; and to make the public acquainted with the mode which he himself adopts. If a person on reading the specification would be led to suppose a laborious process necessary to the production of any one of the ingredients, when, in fact, he might go to a chemist's shop and buy the same thing as a separate simple part of the compound, the public are misled. If the results of the recipes, or of any one of them, may be bought in shops, this specification, tending to make people believe an elaborate process essential to the invention, cannot be supported" (h).

17. Although the condition which requires the specification makes it necessary that it should describe the invention with particularity, it seems that it is not necessary that the specification should particularize every thing which will produce the effect intended by the patentee.

Thus, in the case of *Bickford v. Skewes* (i), the Court of Queen's Bench held, that it was immaterial if other materials not specified, but within the description given in the specification, would answer the purpose, and that it was certainly not necessary to specify all articles that would answer the purpose.

But in the case of *De Rosne v. Fairrie* (k), Mr. Baron Alderson said, that a specification must state one or more methods which can be followed for the purpose of accomplishing and carrying into effect the invention.

18. The particular form of a machine or patent article need not be described, if the shape does not form an essential part of the invention.

Thus in the case of *Neilson v. Harford* (l), the patentee stated, that the shape of the vessel in which the air was to be heated was immaterial, and the Court of Exchequer held that the specification was sufficient.

19. It seems that things necessarily implied need not be particularized in the specification.

(h) See also *Crompton v. Ibbotson*, Dan. & Lloyd, 33, cited *ante*, p. 177.

(i) 1 Webs. R. 218; 1 Q. B. 938.

(k) 5 Tyr. 407.

(l) 1 Webs. R. 295-328.

Thus, in the case of *Boulton v. Bull* (m), Lord Chief Justice *Eyre* said, "Suppose a new invented chemical process, and the specification should direct that some particular chemical substance should be poured upon gold in a state of fusion, it would be necessary, in order to this operation, that the gold should be put into a crucible, and should be melted in that crucible; but it would be hardly necessary to state in the specification the manner in which, or the utensils with which, the operation of putting gold into a state of fusion was to be performed. They are mere incidents with which every man acquainted with the subject is familiar."

Boulton v. Bull.

In the case of *Crossley v. Beverley* (n), the patent was for an invention of "an improved gas apparatus." It appeared from the evidence that the specification did not give any directions respecting a condenser, which was well known to be an essential part of every gas apparatus. It was objected for the defendant, that the things comprised in the specification would not make a gas apparatus, because it would be incomplete for want of a condenser. Lord *Tenterden*, C. J., said, that a workman who was capable of making a gas apparatus would know that he must put that in. And his Lordship held, that although the specification did not direct a condenser to be put in, yet, as it did not say that it was to be left out, the specification was sufficient.

Crossley v. Beverley.

20. Although a specification must describe an invention with sufficient precision to make it a compliance with the condition in the patent, yet it seems that absolute or perfect precision is not practicable, and cannot therefore be required.

Absolute precision impracticable.

Thus, in *Boulton v. Bull* (o), Lord Chief Justice *Eyre*, after observing as to the specification in that case that more precision was not necessary, said that absolute precision was not practicable.

Boulton v. Bull.

In the case of *Arkwright v. Nightingale* (p), Lord *Loughborough* said, that "the clearness of the specification must be according to the subject-matter of it," and if it is understood by those whose business leads them to be conversant in such subjects, it is sufficient.

Arkwright v. Nightingale.
Clearness must be according to the subject.

(m) Dav. P. C. 215.
(n) 3 C. & P. 515.

(o) Dav. P. C. 216.
(p) Dav. P. C. 56.

There must be no misdescription.

R. v. Metcalfe.
If the invention is incorrectly described the patent is void.

21. There must be no misdescription of the invention, or of any part of it. And if any part of the invention is misdescribed in any material particular, the specification will be bad.

In the case of *The King v. Metcalfe* (q), the patent was obtained for the manufacture of hair brushes, which were described to be tapering brushes (r). It appeared from the specification that the mode of manufacturing the patent brushes differed from the common mode, chiefly in this respect: that the specification directed, that the hairs or bristles were to be taken of the length of an inch and a quarter, and before their insertion in the holes in the stock of the brush, were to be mixed up together; so that when they were collected and drawn through the holes, and secured by a brass wire, the bristles would be of unequal lengths; whereas, according to the usual mode, the bristles were to be inserted in the stock, so as to be as nearly of the same length as possible, and were afterwards cut down, so as to be of the same length. Lord *Ellenborough*, C. J. held, that the invention was 'not properly described, and said, "Tapering means gradually converging to a point. According to the specification, the bristles would be of unequal length, but there would be no tapering to a point, which the description assumes." It was contended for the defendant, that the description was sufficient, as each tuft of hairs converged to a point, and the brushes were known in the trade by the description of tapering brushes. Lord *Ellenborough* said, "If the word tapering be used in its general sense, the description is defective; there is no converging to a point. If the term has had a different meaning annexed to it by the usage of trade, it may be received in its perverted sense. At present, however, I cannot hold out any prospect that the difficulty arising from the grammatical construction can be removed." The defendant having failed to give any evidence to remove the difficulty, Lord *Ellenborough* advised the jury to find that the brush was not a tapering, but only an unequal brush, and there was a verdict for the Crown accordingly. The defendant

(q) 2 Stark. R. 249.

(r) The patent described the invention to be of "a tapered hair or head

brush."—Pritchard's List of Patents, No. 1592, p. 115.

afterwards moved the Court of King's Bench for a new trial on this point, but the Court refused even to grant a *rule nisi*.

In the case of *Felton v. Greaves* (s), it appeared that the patent had been obtained for an invention of a machine for sharpening knives, razors, scissors, and other cutting instruments. The machine described in the specification was proved to be useful for sharpening knives, but would not do for sharpening scissors, and for this reason Lord Tenterden, C. J., held that the patent was void.

Felton v. Greaves.

If invention is not applicable in the way represented the patent is void.

So also in the case of *Bainbridge v. Wigley* (t), in which it appeared that the patent was for improvements on the flageolet or English flute. In the specification it was stated that by the improvements the instrument produced notes not before produced on the old instrument. It also appeared in evidence that the invention was a great improvement, but only one new note was produced. Lord Ellenborough, C. J., held that this was fatal to the patent, the consideration on which it was granted not being truly stated. For the patentee had stated that by his improvement he had given new notes, when in fact he had given but one new note (u).

Bainbridge v. Wigley.

If invention is described as improvements, and the specification describes only one improvement, the patent is void.

It is to be observed, that in each of the cases of *R. v. Metcalfe* (x), *Felton v. Greaves* (y), and *Bainbridge v. Wigley* (z), just cited, the patentee had made a false representation to the Crown respecting his invention, and that false representation avoided the patent (a).

False representations in the cases just cited.

22. If an invention be properly and sufficiently described in a specification, it seems that if any unnecessary matter which may have been inserted will not vitiate the specification, if the public is not misled in any way, but will be rejected as surplusage.

Surplusage immaterial.

Thus, in the case of *Boulton v. Bull* (b), Lord Chief Justice Eyre said, that if there was a specification which went to the subject of the invention as described in the patent, he thought that the rest might very well be rejected as superfluous.

Boulton v. Bull.

23. But if the specification describes more than the

Must clearly point out what

(s) 3 C. & P. 611.

(t) Parl. Rep. 1829, p. 197.

(u) *Sid* vide *Nickels v. Haslans*, 8 Jur. 474, cited *ante*, p. 163.

(x) 2 Stark. R. 249.

(y) 3 C. & P. 611.

(z) Parl. Rep. 1829, p. 197.

(a) Vide *ante*, Chap. IV. p. 48, and in this Chap. p. 178.

(b) Dav. P. C. 216.

is new, and distinguish the invention from what is old.

Invention must be particularly ascertained.

invention itself, it must clearly point out which of the things described are old and which of them are new. And if the subject of the patent privilege be an addition to, or an improvement upon, an old machine or other article, the specification must not describe the whole machine or article without distinguishing between the old and the new parts. For the proviso in the patent (c) requires that the invention shall not only be ascertained, but ascertained with particularity, and it is impossible to contend that an invention is so ascertained by a specification, if it describes without distinction many things which are old, as well as the invention itself.

Williams v. Brodie.

Old and new parts described without distinction patent void.

Thus, in the case of *Williams v. Brodie* (d), the invention was an improvement upon an old stove, but in the specification the whole stove was described, including both the old and the new parts, without describing the invention as a new improvement upon an old thing, and it was held that the patent was therefore void.

Manton v. Manton.

Specification must separate new from old.

In the case of *Manton v. Manton* (e), Lord Chief Justice *Gibbs* said, that in order to support a patent, the party who takes it out must show that he has accurately explained the nature of his invention in his specification, *separating that which is new from that which is old*.

Hill v. Thompson, in Chancery patent for a combination must not claim the old materials.

In the case of *Hill v. Thompson* (f), Lord *Eldon*, L. C., said, that there may be a valid patent for a new combination of materials previously in use for the same purpose, or for a new method of applying such materials. But in order to its being effectual, the specification must clearly express that it is in respect of such new combination or application, and of that only, and not lay claim to the merit of original invention in the use of the materials.

Hill v. Thompson, C. P. Specification must distinguish between an entirely new discovery and an improvement.

And in *Hill v. Thompson* (g), in the Court of Common Pleas, the Lord Chief Justice *Dallas* said, "This, like every other patent, must undoubtedly stand on the ground of improvement or discovery. If of improvement, it must stand on the ground of improvement invented; if of discovery, it must stand on the ground of the discovery of something altogether new; and the patent must distinguish and adapt itself accord-

(c) Vide *ante*, p. 151, 155.

(d) Dav. P. C. 96, 97.

(e) *Ibid.* 319.

(f) 3 Mer. 622.

(g) 8 Taunt. 375; 2 B. Mo. 413.

ngly. If the patent be taken out for discovery, when the alleged discovery is merely an addition or improvement, it is scarcely necessary to observe that it will be altogether void."

So in the case of *Minter v. Wells* (h), the invention claimed was the application of self-adjusting leverage to the back and seat of a chair, and Mr. Baron Alderson held, that if any self-adjusting leverage had been, before the plaintiff's patent, applied to a chair, the patent would be void, because the specification, by describing self-adjusting leverage, generally claimed too much.

Minter v. Wells.
Claim too general if any thing coming within the description was known before.

In the case of *Carpenter v. Smith* (i), Lord Abinger, C. B., laid it down that a patentee should state in his specification what he claims to be new, and what he admits to be old; for if the specification states simply the whole machinery which he uses, and which he wishes to introduce into use, and does not state that he claims either a particular part, or the combination of the whole as new, then his patent must be taken to be a patent for the whole, and for each particular part, and his patent will be void if any particular part turns out to be old, or the combination itself is not new.

Carpenter v. Smith.
Patentee must state what he claims to be new and what he admits to be old.

In the case of *Macfarlane v. Price* (k), it appeared that the patent was for an invention of improvements in the making of umbrellas and parasols. The specification professed to set out the improvements as specified in certain descriptions and drawings annexed. The subjoined description contained a minute detail of the construction of umbrellas and parasols, partly including the usual mode of stretching the silk of the umbrella by means of metallic stretchers or rods attached to a tube moveable along the stem, and also certain improvements, which consisted chiefly in the insertion of the stretchers, which were knobbed at the end, in sockets formed in the whalebone, instead of attaching them to the whalebone in the usual way, by means of forked ligaments, which came in contact with the silk, the advantage of which was, that by the specified mode, the bone being interposed between the stretcher and the silk, the stretcher did not wear the silk in spreading the umbrella, as it was apt to do in umbrellas of the old construction, where the stretcher came in contact with

Macfarlane v. Price.

(h) 1 Webs. R. 130.

(k) 1 Stark. R. 199.

(i) *Ibid.* 532.

Specification
ought to inform
the public what
is new and what
is old.

the silk. Some other advantages, of minor importance, were also stated, and drawings were given of the umbrellas and parasols in their improved state. Throughout the whole specification, no distinction was made between what was new and what was old. Upon an objection taken by the defendant that the specification was insufficient, it was contended for the plaintiff that the specification was sufficient, since one of the annexed drawings contained a representation of the particular invention, which had been pirated, and was confined to the exhibition of the insertion of the knobbed stretchers in the whalebone sockets, from which an artist would be able to construct an umbrella on the improved plan. But Lord *Ellenborough*, C. J., said, "The patentee in his specification ought to inform the person who consults it what is new and what is old. He should say, My improvement consists in this, describing it by words if he can, or if not, by reference to figures. But here the improvement is neither described in words nor by figures, and it would not be in the wit of man, unless he were previously acquainted with the construction of the instrument, to say what was new, and what was old. The specification states that the improved instrument is made in manner following: this is not true, since the description comprises that which is old as well as that which is new. Then it is said, that the patentee may put in aid the figures, but how can it be collected from the whole of these in what the improvement consists. A person ought to be warned by the specification against the use of the particular invention; but it would exceed the wit of man to discover from what he is warned in a case like this." And his Lordship held, that the patent was void, and nonsuited the plaintiff.

R. v. Nickels.

In the case of *The Queen v. Nickels* (1), the patent had been obtained for an invention entitled, "improvements in machinery for recovering fibres applicable in the manufacture of braid and other fabrics;" the defendant's specification commenced in the usual form, viz. by declaring that the nature of the invention, and the manner in which it was to be performed, were "described and ascertained in and by the following statement thereof, reference being had to the drawing

(1) MS.

annexed, and to the figures and letters marked thereon (that is to say), the invention relates "to certain improvements in, or additions to, the apparatus or parts constituting what is called braiding or plaiting machines, whereby I am enabled, &c." The defendant then proceeded to describe different kinds of braided fabrics which the machinery would produce, after which he proceeded as follows: "The construction of braiding or plaiting machinery, wherein all the threads partake of like movements, and all aid in forming the fabric of plaited threads, being well known in the manufacture of braids, it will not be necessary to enter into a long description of the same. *All that will be required to make the invention clear, and enable a workman acquainted with such machinery, readily to perform my invention.*" It would be expected from this, that the specification was about to declare what it is, which would be sufficient to enable a workman to perform the invention; but the sentence is not completed, the patentee merely proceeding to say "which is (*m*) only applicable to such machines as work with four or more heads or circular tables for actuating a system or series of bobbins, &c." The specification then proceeded to describe the uses of the machinery for making the various fabrics which it was intended to produce, after which it described the drawing annexed. The specification did, in fact, describe the whole of the machinery, including both the old parts, and those claimed by the patentee to be new; but it did not in any part of it point out which of the parts were new, and which of them were old. At the end of the specification the defendant stated, that he made no claim to any of the parts of the apparatus constituting the machine separately, nor combined so far as the same had been before known; but there was nothing in the specification which could enable any person to ascertain to which of the parts of the machinery the disclaimer was intended to apply. It was objected by the counsel for the prosecutor, that the specification was insufficient, because it clearly appeared upon the face of it that some parts of the machinery de-

(*m*) These words, "which is," &c. follow immediately after the portion of the specification ending with the words

"perform my invention," as given above.

scribed were old, and there was no part of that document which either pointed out what was the new invention claimed by the patentee, or the old parts which he disclaimed. It was contended for the defendant, that he was at liberty to give evidence to show what was new and what was old; but the cases of *The King v. Wheeler* (n), and *Neilson v. Harford* (o), were cited to show that the construction of the specification was for the Court, and not the jury, and that such evidence was not admissible. Lord *Denman*, C. J., adopted the language of Lord *Ellenborough*, in the case of *Macfarlane v. Price* (p), and said, that the alleged improvements were not sufficiently ascertained or described, either by words or by figures, and that it would not be in the wit of man to discover from the specification what was new, or what was old, or what he was warned from doing. His Lordship also held, that parol evidence was not admissible to explain the specification, and show what was new, and he directed the jury to give a verdict for the Crown, which was done accordingly.

Must not claim more than patentee is entitled to.

24. The patentee must not in the specification claim more than is granted by the patent, or more than he is fairly entitled to; and if he attempts to appropriate more to himself than he is actually entitled to, the grant of privilege contained in the patent will be wholly void.

Hill v. Thompson.

If specification claims too much the patent is void.

Thus in the case of *Hill v. Thompson* (q), Lord *Eldon*, L. C., said, that the specification must not attempt to cover more than that which is the only proper subject for the protection of a patent. And his Lordship said, that he was compelled to add, that if a patentee seeks by his specification any more than he is strictly entitled to, his patent is thereby rendered ineffectual, even to the extent to which he would be otherwise fairly entitled.

R. v. Elsee.
If the claim in the specification is so general in terms as to include anything before known, the patent is void.

In the case of *The King v. Elsee* (r), the patent was for a new invented manufacture of lace called French or ground lace. The specification went generally to the invention of mixing silk and cotton thread upon the frame. On the part of the prosecutor it was clearly shown that, prior to the pa-

(n) 2 B. & Ald. 345.

(o) 8 M. & W. 806.

(p) 1 Stark. R. 199, cited ante,

p. 185.

(q) 3 Mer. 622.

(r) Dav. P. C. 144.

tent, silk and cotton thread had been used together, and intermixed upon the same frame, and the defendant's counsel acknowledged the fact; but said he could prove clearly that the former method of using the silk and cotton thread was quite inadequate to the purpose of making lace, on account of its coarseness, and that the defendant alone had invented the method of intermingling them, so as to unite strength with firmness. Mr. Justice *Buller* said, "It will be to no purpose. The patent claims the exclusive liberty of making lace composed of silk and cotton thread mixed, not of any particular mode of mixing it, and therefore, as it has been clearly proved and admitted that silk and cotton thread were before mixed on the same frame for lace in some mode or other, the patent is clearly void, and the jury must find for the Crown." And a verdict was given for the Crown accordingly.

So in the case of *Minter v. Mower* (s), the Court of Queen's Bench held the patent to be void, because the specification claimed more than the patentee had invented, and would have included something which was known before the date of the patent. Minter v. Mower.

In *Jessop's* case (t), the patent was held to be void, because it extended to the whole watch, and the invention was of a particular movement only. And in *Boulton v. Bull* (u), Mr. Justice *Buller* said, that when a patent is taken for an improvement only, the public have a right to purchase that improvement by itself, without being incumbered with other things. So in the case of *Losh v. Hague* (x), Lord *Abinger*, C. B., said, a man can always take out a patent for a new improvement, but when he makes his specification, he must take care that he does not put among his improvements that which another man had before made, or had got a patent for. Jessop's case.
Boulton v. Bull.
Losh v. Agne.

In the case of *Huddart v. Grimshaw* (y), Lord *Ellenborough*, C. J., said, that if a patentee in his specification oversteps his right, and appropriates more than is his own, he cannot avail himself of it. And if he states that which of itself is not new, but old and known to the world, though it was unnecessary for him to do so, yet having done so, he has overstepped Huddart v. Grimshaw.
If patentee oversteps his right the patent is void.

(s) 6 A. & E. 735.

(t) Dav. P. C. 203.

(u) *Ibid.*

(x) 1 Webs. R. 206.

(y) Dav. P. C. 279.

his right, and has included in his patent that which is not his invention, and his patent would be void.

Campion v. Benyon.

In the case of *Campion v. Benyon* (z), the Court of Common Pleas held the plaintiff's patent to be void, because it had been taken out for more than he had invented or discovered.

Bovill v. Moore.

If patentee exceeds the limits of his invention the patent is void.

In the case of *Bovill v. Moore*, Lord Chief Justice Gibbs laid it down (a), that if the patentee in his specification had exceeded the limits of what he had invented, and of which he was entitled to the sole privilege, though in other respects there might be no objection to his patent, that would overturn it, for he would not then have registered (enrolled) a specification of his invention, it would be irregular in having exceeded the limits of the invention. And his Lordship afterwards said, that if the patentee had, in his specification, asserted to himself a larger extent of invention than belonged to him; if he stated to himself to have invented that which was well known before, then the specification would be bad, because it would affect to give him, through the means of the patent, a larger privilege than could legally be granted to him. In this case the invention was stated to be of a machine or machines for manufacturing lace, and the specification described the whole machine, without pointing out any particular part or parts of it, as the invention of the patentee. And the Lord Chief Justice held (c), that if a combination of a certain number of the parts of the machine up to a given point had existed before the date of the patent, and if the patentee's invention sprung from that point, and added other combinations to it, then the specifications stating the whole machine as his invention was bad. And his Lordship left it to the jury to say whether they thought the patentee had in his specification described an invention to a greater extent than the proof went to establish. And his Lordship said, in answer to an observation by a juryman, that even if the patentee had claimed too much inadvertently, and not fraudulently, yet he must answer for his inadvertence. The jury found a verdict for the defendant, and upon a motion for a new trial, the Court of

If invention be an addition or improvement, and the specification describes the whole machine, the patent is void.

If patentee claims too much inadvertently the patent is void.

(z) 6 B. Mo. 71; and see the words of *Richardson, J.*, *Ibid.* p. 86.

(a) Dav. P. C. 398.

(b) *Ibid.* 404.

(c) *Ibid.* 413.

Common Pleas approved of the direction given to the jury by the Lord Chief Justice, and refused to grant even a rule nisi (d).

It is no objection to a specification, however, that the patentee has described in it improvements which he has made between the date of the patent and the date of the specification. And indeed it seems rather to be the patentee's duty to give the public the full benefit of all his knowledge respecting the invention at the time when he specifies it (e).

No objection that improvements made between the patent and specification are described.

There is one case, *Harmar v. Playne* (f), in which it was held, that a specification was sufficient, although it could not be ascertained what the patentee's improvements were, except by comparing the specification with a prior specification which had been enrolled by the same patentee, and to which he referred. The circumstances of that case were peculiar, and the decision does not break in upon the principle of any of the cases which have been cited.

Specification made sufficient by reference to a former specification.

In *Harmar v. Playne* (f), a case was stated by the Lord Chancellor for the opinion of the Court of King's Bench, from which it appeared that "by letters patent dated 20th March, 1787, the King granted to John Harmar, the plaintiff, for fourteen years, the sole privilege of making, using, and vending a certain machine by him invented for raising a shag on all sorts of woollen cloths, and cropping or shearing them, which, together, come under the description of dressing woollen cloths; and also for cropping and shearing of fustians, with the usual proviso or condition for avoiding the patent on failure of enrolling a specification. In pursuance of this proviso, Harmar duly enrolled a specification of the said invention, with drawings of the machine in the margin thereof. On the 29th March, 1794, his Majesty granted another patent to Harmar, whereby, after reciting that Harmar had obtained letters patent of the 20th March, 1787, authorizing him to make, use, and vend his invention of a machine for raising a shag on all sorts of woollen cloths, &c., for fourteen years; and further, that he had invented considerable improvements in the said machine, for which improvements in the said

Harmar v. Playne.

First patent, 20 March, 1787.

Second patent 29 March, 1794, reciting first patent.

(d) 2 Marsh. 211.

(e) Vide ante, p. 168, and the cases of *Crossley v. Beverley*, and *Jones v.*

Heaton, there cited.

(f) 11 East. 101; and Dav. P. C. 311, S. C.

Specification of
second patent.

machino: he prayed his Majesty's letters patent for the exclusive enjoyment thereof for fourteen years, pursuant to the statute; the letters patent, therefore, granted to him the sole privilege and authority to make use and vend his said invention, and have the whole profit thereof. The letters patent also contained a proviso that if Harmar should not particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, by an instrument in writing under his hand and seal, and cause the same to be enrolled in the Court of Chancery, within one calendar month next, and immediately after the date of the said letters patent, then they should become void. In pursuance of this proviso, Harmar did, in due time, enrol a specification in Chancery, with drawings of the machine in the margin thereof: the introductory part of which specification was as follows: 'To all to whom, &c. I, John Harmar, of Sheffield, send greeting, Whereas his Majesty, by his letters patent, dated the 29th day of March, in the thirty-fourth year of his reign, hath granted to me his special licence, &c., that I, my executors, administrators and assigns, at all times during the term of years therein expressed, should and lawfully might make, use, and vend the machine by me invented and found out, for raising a shag on all sorts of woollen cloths, &c., and that I should enjoy the whole profit, &c., of the said invention for fourteen years, from the date of the said letters patent, according to the statute, &c. And whereas in the said letters patent there is a proviso or condition, that if I, the said John Harmar, should not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, by an instrument in writing under my hand and seal, and cause the same to be enrolled in the Court of Chancery within one calendar month after the date of the said letters patent, that then the said letters patent, and all liberties, &c. thereby granted, should be void. Now, know, ye, that in obedience to the said letters patent, and proviso therein contained, I, the said John Harmar, do, by these presents, particularly describe and ascertain the nature of the said invention, referring to the drawings in the margin of these presents, which I explain as follows.' The specification then proceeds under different letters of the

alphabet, corresponding with similar letters on the drawing; to set forth a full description of the whole of the machine; and the specification ends with these words: "And I, the said John Harmar, do hereby declare that my said invention is intended to be worked in the manner hereinbefore particularly mentioned." *It was admitted by the defendant, that the improvements for which the second patent was granted are included in the general description of the second or improved machine, as set forth in the specification of the second patent; and that the second specification does contain a full and proper description of the whole machine in its improved state. But the second specification does not in any manner point out or describe the improvements upon the former machine by any verbal description, or by any delineation or mark in the drawing; and which drawing is not a representation of the improvements alone, but of the whole machine in its improved state; nor are the improvements in any manner substantively and individually explained by the second specification; nor is the machine in the improved state contradistinguished from the state and condition of it under the former patent by any explanation whatever, nor by any delineation or mark in the drawing. But what the former machine was, and what were the said improvements thereupon, are ascertainable and appear by referring to the first specification and the drawings thereon, and comparing the second specification and the drawings thereon with the same. The defendants insisted that the second specification was not a due performance of the condition of the second patent; and the question, therefore, for the opinion of the Court was, whether the proviso or condition in the letters patent of the 29th of March, 1794, had been duly performed by the enrolment of the said specification thereof."*

It was contended for the patentee, that as the second patent and specification referred to the first, and therefore directed a party to the source from which information might be obtained, the second specification was a "sufficient compliance with the condition in the patent. *That the patentee had only an exclusive right to the whole combination for which his (second) patent was granted, and the use of particular parts only would be no breach of his rights; that the description, therefore, of the particular improvements, distinct*

from the parts in general use before, would be useless to all, and less intelligible to many." During the course of the argument, Lord *Ellenborough*, C. J., said, "The difficulty which presses most is, whether this mode of making the specification be not calculated to mislead a person looking at it, and induce him to suppose that the term for which the patent is granted may extend to preclude the imitation of other parts of the machine than those for which the new patent is granted; when he can only tell by comparing it with some other patent what are the new and what are the old parts: and if this may be done by reference to one, why not by reference to many other patents, so as to render the investigation very complicated? It may not be necessary, indeed, in stating a specification of a patent for an improvement, to state precisely all the former known parts of the machine, and then to apply to those the improvement; but, on many occasions, it may be sufficient to refer generally to them. As in the instance of a common watch, it may be sufficient for the patentee to say, take a common watch, and add or alter such and such parts, describing them." For the defendant it was contended that the specification ought to have informed the public what the thing was for which the patent was granted, and how it was to be made, and not merely inform them where else that information was to be acquired, as that would not be a compliance with the condition in the patent. And also that the true sense of the condition was to give the public direct and complete information of the manner of executing the invention, without further search or trouble. Mr. Justice *Le Blanc* said; "There lies the difficulty; for, suppose the specification had merely described the improvement, such as the addition of a crank or a screw to such or such a part, must not the party still have referred to the original specification, or at least have brought a full knowledge of it with him, before he could understand truly how to adopt the new parts described to the old machine?"

Lord *Ellenborough* also said, "I own I was disposed to think that it was a departure from the terms of the proviso for the patentee merely to tell the inquirer who came to consult the specification, how he might learn what the invention was, instead of giving him that information directly. But

I feel impressed by the observation of my brother Le Blanc, that the trouble and labour of referring to and comparing the former specification with the latter, would be fully as great if the patentee only described in this the precise improvements upon the former machine. Reference must, indeed, often be necessarily made in these cases to matters of general science, or the party must carry a reasonable knowledge of the subject-matter with him in order clearly to comprehend specifications of this nature, though fairly intended to be made. We will, however, consider the case and certify our opinion."

The Court afterwards certified to the Lord Chancellor that they were of opinion that the condition in the second patent had been performed by the enrolment of the specification.

The reasons of the Court for their opinion in this case were not given, and therefore it is not quite certain whether they held the specification to be made good by the reference to the prior patent and specification, or whether the second patent was in fact not for the improvements themselves separate and apart from the former machine, but for the new combination of parts (*h*), in which case the description of the entire machine was correct and proper. If the Court was of opinion that the patent was for the improvements separate and distinct from the previously known parts of the machine, then they must have held that the specification was made good by the reference to the prior patent. And if this be so, it is to be observed, that this case does not, as has been supposed, amount to a decision that parol evidence may be given to show which of the parts of the machinery were new and which were old. The specification must be deemed by the reference to include all that was contained in the former specification, *which is recorded in the same place as the second specification*, and the reference to the former patent and specification shows most clearly that the patentee did not intend in his second specification to claim those parts of the machinery which were comprised in the first, and which were therefore clearly old at the date of the second patent. The former parts then being in effect disclaimed, and it being admitted by the defendant

Observations
upon *Harmar*
v. Playne.

(*h*) See what was contended for the patentee, stated *ante*, p. 193.

that the specification did sufficiently describe all parts of the machinery, the only effect of the decision in *Harmat v. Playne* is, that reference being made to a former specification which is contained amongst the records of the same Court as the second, the first specification may be used as evidence to show which of the parts or things mentioned in the second specification are not intended to be claimed as part of the second invention.

Claim of invention or disclaimer.

In specifying an invention, it is generally necessary, in order to make the instrument intelligible, to describe things which form no part of the invention; and it has consequently become usual, at the end of a specification, to insert a clause, whereby the patentee particularly points out all that he claims as his invention, or disclaims all that is not of his invention; and many specifications contain both a claim and a disclaimer.

Any material mistake in the claim or disclaimer, in a specification, is fatal: the patentee cannot be entitled to anything more than he claims, and if he claims more than he ought, the patent is void.

R. v. Cutler.

In the case of *The King v. Cutler* (i), the defendant's invention was materially different from what was known before the date of the patent, but in summing up his claim, he confined himself to that which was old, and his patent was, consequently, held to be void.

R. v. Elsee.

In the case of *The King v. Elsee* (k), the patentee made his claim too extensive, and his patent was, therefore, held to be void.

So also the patents were held to be void by reason of the claims being too extensive in the cases of *Campion v. Benyon* (l), *Bovill v. Moore* (m), *Minter v. Mower* (n), and several other cases.

Saunders v. Aston.

And in the case of *Saunders v. Aston* (o), the specification omitted to claim the only thing which was new, and the patent was held void.

Construction of specifications.

The various cases which have been cited show the requisites of a specification as a performance of the condition contained in the patent, in pursuance of which it is enrolled. The

(i) 1 Stark. R. 354, cited *ante*, p. 182.

(k) Dav. P. C. 144.

(l) 6 B. Mo. 71.

(m) Dav. P. C. 361.

(n) 6 A. & E. 735.

(o) 3 B. & Ad. 881.

general rule for the construction of a specification, (the object or purpose of the instrument being borne in mind,) is precisely the same as that which applies to all other instruments, and which was so clearly expressed by Lord *Ellenborough*, C. J., in the case of *Robertson v. French* (p), in which that eminent judge, speaking of a policy of assurance, said, “The same rule of construction which applies to all other instruments applies equally to this instrument, of a policy of insurance, viz. that it is to be construed according to its sense and meaning, as collected in the first place from the terms used in it, which terms are themselves to be understood in their plain, ordinary, and popular sense, unless they have generally, in respect to the subject-matter, as by the known usage of trade, or the like, acquired a peculiar sense distinct from the popular sense of the same words; or, unless the context evidently points out that they must, in the particular instance, and in order to effectuate the immediate intention of the parties to that contract, be understood in some other special and peculiar sense.”

General rule.
Robertson v. French.

Specifications and patents were formerly construed more strictly against patentees than they are now, which induced Lord *Tenterden*, C. J., in the case of *Hullett v. Hague* (q), to say, “I cannot forbear saying, that I think a great deal too much critical acumen has been applied to the construction of patents, as if the object was to defeat and not to sustain them.”

Specifications formerly construed more strictly.

In the case of *Russell v. Cowley* (r), Mr. Baron *Packe* said, in giving judgment, that, “In the construction of a patent, the Court is bound to read the specification so as to support it, if it can fairly be done.” Mr. Baron *Alderson* concurred, and said, “We ought not to be astute to deprive persons of the benefits to be derived from ingenious and new inventions.”

Russell v. Cowley.

The use of words in an improper sense will not vitiate a specification if the intention be clear, and the public is not misled.

Construction of words.

In the case of *Bloxam v. Elsee* (s), the specification contained several Gallicisms; as, the French word “vice,” for a screw, &c.: but the specification does not appear to have been held bad on that ground.

Bloxam v. Elsee.

(p) 4 East, 135-136.
(q) 2 B. & Ad. 377.

(r) 1 Cr. M. & R. 864.
(s) 1 C. & P. 563, 568.

*De Rosne v.
Fairrie.*

So in the case of *De Rosne v. Fairrie* (t), the patentee, who was a Frenchman, in his specification, used the word "discolouring," to signify depriving of colour, and the word "baked," instead of the word crystallized, but the specification, was not held to be defective on that ground.

*Neilson v.
Harford*

And in the case of *Neilson v. Harford* (u), the Court of Exchequer construed the word effect in one part of the specification as meaning beneficial effect, because it was evidently used in that sense in some other parts of the specification (x). And Lord *Lyndhurst*, L. C., afterwards approved of that construction of the specification (y).

(t) 5 Tyr. 393; 2 C. M. & R. 476.

(u) 8 M. & W. 806.

(x) And see *Neilson v. Harford*, 1

Webb. R. 340, 369.

(y) 1 Webb. R. 373.

CHAPTER VIII.

OF THE CONFIRMATION OF PATENTS, AND THE ALTERATION AND AMENDMENT OF PATENTS, SPECIFICATIONS, AND ENROLMENTS.

SEC. I.—*Of the Confirmation of Patents under the Stat. 5 & 6 Will. IV. c. 83, sec. 2.*

II.—*Of the Alteration of Patents and Specifications by Memorandum or Disclaimer under the Stat. 5 & 6 Will. IV. c. 83, sec. 1.*

III.—*Of the Alteration and Amendment of Patents, Specifications, and Enrolments at Common Law.*

SECTION I.

Of the Confirmation of Patents under the Statute 5 & 6 Will. IV. c. 83, sec. 2.

It has been shown in a former part of this work (a), that a want of novelty in the whole or any part of an invention which is made the subject of a grant by patent, renders the patent entirely void. And if it can be shown that a description of any part of the invention was contained in any document published in any part of Great Britain or the colonies before the date of the patent, the patent cannot be sustained, even if it be shown that the invention has not been used in any way whatsoever. Thus if any part of the invention was described in a work printed and published in British North America before the grant of the patent, the patent is void, even if the invention has never been known or used in England (b).

This strict rule of the law was, in some cases, productive of great hardship, but until the passing of the statute 5 & 6 Will. IV. c. 83, the patentee was without remedy.

By section 2 of that statute it was enacted, "That if in any

(a) *Ante*, Chap. V. s. 2, p. 102.

(b) See *Brown v. Annandale*. 1 Webs. R. 433.

Want of novelty avoids a patent.
Stat. 5 & 6 Will. IV. c. 83, provides a remedy for cases of hardship. Sec. 2.

If invention was unknown to patentee discovered or used before the patent.

Upon petition of patentee the patent may be confirmed if invention not publicly used before date of patent.

New or confirmed patent to be available.

Persons entitled to be heard in opposition.

Act only applies when patentee was ignorant of the defect in his title.

Act does not apply if the patentee was not the *true* inventor.

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

This provision of the Act is 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, and believed himself to be the *first and original* inventor.

If the defect in the patentee's title arise from the circumstance of his not having been a *true and actual* inventor, he cannot have been ignorant of the fact, and the statute is inapplicable to such a case (b). But if the patentee did actually

(b) Vide *ante*, Chap. III. as to who is the true and first inventor of an

invention within the meaning of the law.

make the invention, and if at the time when he obtained his patent, he did really believe that he was the *first* inventor, he is enabled by the Act upon discovering that he was not the *first* inventor, to petition for a confirmation of his patent.

Does apply if he was not, but believed he was the *first* inventor.

The defects which may be cured by a confirmation are such as arise out of the fact of an invention having been invented or used before the date of the patent. A confirmation would therefore obviate any objection to a patent, either on the ground of the patentee not being the *first* inventor, or the invention not being new at the date of the patent, provided the invention or some part of it had not been publicly and generally used before the date of the patent.

Applies to defects arising out of prior invention or prior use; but not if invention publicly and generally used.

A confirmation is to render the patent available to give the petitioner "the sole right of using, making, and vending the invention as against all persons whatsoever, any law, usage, or custom to the contrary thereof notwithstanding." Although these words are very general and would seem to cure any defect in the patentee's title, yet it is evident that the intent is that a confirmation should only have the effect of obviating objections arising from the invention having been invented or partially used before the date of the patent, leaving the patent still open to all other objections to which it may be liable.

Effect of a confirmation.

The granting of a confirmation is entirely discretionary with the Judicial Committee of the Privy Council, and will only be exercised in extreme cases, and where the confirmation will not prejudice any existing rights.

Confirmation discretionary with privy council.

In *Baron Heurteloup's* case (c), it appeared that the petitioner had, in May, 1834, obtained a patent for an invention of "improvements in certain parts of certain descriptions of fire-arms." A portion of the invention consisted of a small tube made of soft metal, and filled with detonating powder for priming the gun, the end of the tube being advanced to the touch-hole by the action of cocking the gun, while a small piece is cut off just by the touch-hole, and detonated there by the falling of the hammer, without exploding the powder in the remaining part of the tube. The petitioner had discovered that a prior patent was granted in France to one Valdahon for an invention, part of which consisted of a straw filled with

Baron Heurteloup's case.

detonating powder brought to the touch-hole of the gun, and cut off, as required, to prime and fire; but the mode of bringing the straw tube to the touch-hole was totally different from the petitioner's, and did not constitute the gun a self-priming gun. Valdahon's invention had never been used in France, England, or elsewhere, and was not known in England otherwise than by a French work, a copy of which had been deposited in the British Museum two years before the date of the petitioner's patent. Under these circumstances, the Judicial Committee of the Privy Council, after notice to Valdahon, recommended a confirmation of the petitioner's patent, which was granted accordingly.

Wells' case.

In *Wells'* case (*d*), it appeared that the petitioner was assignee of a patent, granted in May, 1831, to Gibbins and Westrupp, for an invention of "improvements in an apparatus for converting sea water, or otherwise impure water, into fresh and pure water." The application was opposed on the ground that part of the invention had been published many years before the patent in a well known book, and had also been made the subject of two prior patents, but had not been publicly or generally used. It was also objected, that the petitioner's proper remedy was by disclaimer of that part of the invention which was old (*e*). Lord *Lyndhurst* said, that he did not think the clause of the Act was ever intended to apply to the case where the patentees chose to shut their eyes, when they might have gone to the office and seen the prior specifications. The Act could never be intended to apply to a case when two patents have been taken out for the same thing; that the subsequent patentee should have a right to come to the Court to apply to have the exclusive benefit of the invention adversely to the rights and interests of the former patentee. And the petition was dismissed with costs.

(*d*) 1 Webs. R. 554.

(*e*) As to Disclaimers, see the second section of this Chapter.

SECTION II.

Of the Alteration of Patents and Specifications by Memorandum or Disclaimer under the Statute 5 & 6 Will. IV. c. 83, s. 1.

If a patent is granted for two inventions, and either of them does not possess the requisite degree of novelty, the patent is entirely void, and cannot be sustained for the other invention, even if it be perfectly free from objection. So if any part of what a patentee claims by his specification as part of his invention, was not new at the date of the patent, the patent is entirely void (*f*). When the title of an invention is inaccurate, and misdescribes the invention in any one respect, the patent is void on the ground of a misrepresentation, although there may have been no intention whatsoever to deceive either the Crown or the public (*g*).

Want of novelty in any part of invention renders a patent void.

Misdescription of invention also avoids a patent.

And if a specification is insufficient as to any part of the invention comprised in the patent, or if it contains any misstatement respecting any material particular relating to the invention (however inadvertently inserted) the patent is entirely void (*h*).

Insufficiency also renders a patent void.

Before the passing of the statute 5 & 6 Will. IV. c. 83, such defects as these were incurable, and there are several instances of parties losing the benefit of highly meritorious inventions in consequence of such objections being taken to part of the invention which were perfectly immaterial to the real merits of the case. This was a great defect and a serious reproach to our Patent Law, but it has been to a great extent, if not wholly, removed by recent statutes.

Such defects incurable before the stat. 5 & 6 Will. IV. c. 83.

By section the first of the statute 5 & 6 Will. IV. c. 83 (*i*), it was enacted, (so far as the enactment relates to England,) "That any person who as grantee, assignee, or otherwise, hath obtained, or shall hereafter obtain, letters patent, for the sole

Sec. 1.

Any person having obtained a patent for an invention may,

(*f*) As to the novelty of an invention, vide *ante*, Chap. V. p. 102.

(*g*) As to the title of an invention, vide *ante*, Chap. IV. p. 43.

(*h*) As to the requisites of a specifi-

cation, vide *ante*, Chap. VII. pp. 151, 159, 162, 178.

(*i*) See the statute in the Appendix, Chap. I. s. 1.

with leave of attorney-general, enter a disclaimer or alteration of part of title or specification.

Disclaimer or memorandum of alteration to be deemed part of the patent or specification.

Caveat may be entered against disclaimer or alteration.

No disclaimer or alteration receivable in evidence in any action pending except *scire facias*.

Attorney-general may require applicant to advertise.

Two proceedings, disclaimer and memorandum of alteration.

making, exercising, vending, or using of any invention, may, if he think fit, enter with the Clerk of the Patents of England, having first obtained the leave of his Majesty's Attorney-general or Solicitor-general, certified by his fiat and signature,—a disclaimer of any part of either the title of the invention or of the specification, stating the reason for such disclaimer,—or may with such leave as aforesaid enter a memorandum of any alteration in the said title or specification; (not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent;) and such disclaimer or memorandum of alteration being filed by the said Clerk of the Patents, and enrolled with the specification, shall be deemed and taken to be part of such letters patent, or such specification in all Courts whatever: Provided always that any person may enter a caveat, in like manner as caveats are now used to be entered, against such disclaimer or alteration; which caveat, being so entered, shall give the party entering the same a right to have notice of the application being heard by the Attorney-general or Solicitor-general respectively: Provided also that no such disclaimer or alteration shall be receivable in evidence in any action or suit (save and except in any proceeding by *scire facias*) pending at the time when such disclaimer or alteration was enrolled; but in every such action or suit the original title and specification alone shall be given in evidence, and deemed, and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted: Provided also that it shall be lawful for the Attorney-general, or Solicitor-general, before granting such fiat, to require the party applying for the same to advertise his disclaimer or alteration in such manner as to such Attorney-general or Solicitor-general shall seem right, and shall, if he so require such advertisement, certify in his fiat that the same has been duly made.”

There are two proceedings made available to a patentee under this section of this Act:—*firstly*, a *disclaimer* by means of which he may get rid of any objectionable part either of the title in the patent, or of the description in the specification; and, *secondly*, a *memorandum of alteration* by which he may cure any misdescription of the invention either in the patent or in the specification.

1. *Disclaimer.*

A disclaimer may be entered by any person, who, as "grantee, assignee, or otherwise," has obtained a patent. Who may enter a disclaimer.

In the construction of this part of the enactment it was decided, in the case of *Spilsbury v. Clough* (k), that a patentee who had assigned over the whole of his interest in his patent, and afterwards obtained a re-assignment of a portion only, is competent to enter a disclaimer under the Act of Parliament. Spilsbury v. Clough.
 Mr. Justice *Patteson* in that case expressed an opinion that the patentee is the proper person to enter a disclaimer under the Act, even if he have parted with all his interest in the patent, assignees being in the opinion of that learned Judge, and also the rest of the Court, sufficiently protected by the power given them to enter *caveats* and oppose a disclaimer before the Attorney or Solicitor-general.

The opinions expressed by the Judges in the case of *Spilsbury v. Clough* (l), just cited, raised great doubt whether an assignee of a patent was enabled to enter a disclaimer under the statute, but all doubt and difficulty on this subject has been obviated by the subsequent Act of 7 & 8 Vict. c. 69 (m); Doubts whether assignee could enter a disclaimer.
 by section five of which it was 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 assigns, if part only hath been assigned, and for the assignee or assignees, if the whole hath been assigned, to enter a disclaimer and memorandum of alteration under the powers of the said recited Act; and such disclaimer and memorandum of such alteration having been so entered and filed, as in the said recited Act mentioned, shall be valid and effectual in favour of any person or persons in whom the rights under the said letters patent may then be, or thereafter become legally vested; and no objection shall be made in any proceeding whatsoever on the ground that the party making such disclaimer or memorandum of such alteration had not sufficient authority in that behalf." Obviated by 7 & 8 Vict. c. 69, s. 5. If part of a patent has been assigned, disclaimer may be entered by patentee and assignee jointly, or if the whole, then by the assignee alone.

(k) 2 Q. B. 466.

(l) *Ibid.*

(m) See the statute in the Appendix, Chap. I. s. 1.

The granting of leave to enter a disclaimer is discretionary.

In order to enter a disclaimer, the leave of the Attorney or Solicitor-general must be obtained, and the granting of leave is entirely discretionary with either of those officers to whom the application may be made. The leave to enter a disclaimer must be certified by the fiat and signature of the Attorney-general (*n*), before it can be entered by the Clerk of the Patents, or enrolled in the manner required by the Act.

Cases in which disclaimers are applicable.

It is difficult to lay down any certain rule respecting the cases in which disclaimers are available or expedient. The power granted by the statute, is, however, chiefly applicable to cases in which patentees after they have obtained their patents or enrolled their specifications, find that they have included something for which a patent cannot be sustained. Thus, if a patentee finds that a part of his invention does not contain the requisite degree of novelty, he may by a disclaimer obviate an objection which would have the effect of avoiding his patent entirely. So if he finds that he has inadvertently omitted to describe in his specification a portion of the invention particularly mentioned in the title, that part of the title may be got rid of by a disclaimer.

Or if the patentee discovers that he has made his claim of invention more extensive than is warranted by the title, the redundant part may be disclaimed (*o*). Want of utility in any part of an invention will render a disclaimer necessary, if the useless part be a separate portion of the invention, or if the utility of that particular part appears to have formed part of the consideration for the patent grant (*p*). So if a portion of the invention will not produce the effects stated by the patentee, he may disclaim the objectionable part.

Disclaimer must not extend the patent right.

But a disclaimer must not be such as will extend the right granted by the patent. This was a very necessary provision to make for the protection of the public and subsequent patentees; for if a patentee's power of disclaiming had not been limited in this way, he might, under pretence of disclaiming something contained in the title or specification, really extend the operation of the patent much beyond the original invention for which it was granted.

(*n*) See the Forms in the Appendix, Chap. II. s. 2.

Chap. IV. *ante*, p. 43.

(*o*) As to the titles of inventions, see

(*p*) See Chap. V. s. 3, p. 132, as to the utility of inventions.

A party entering a disclaimer must take especial care that it does not violate the statute in this respect, for he enters the disclaimer at his own peril, and if it be contrary to the statute, it will be void, notwithstanding the leave granted by the Attorney or Solicitor-general (q). And if a disclaimer does not come within the provision of the Act in this respect, it will not only be void, but may be very prejudicial to the patentee. It may contain (amongst the reasons for the disclaimer) an admission that there is something comprised in the title or specification for which the patent cannot be sustained.

A party enters a disclaimer at his own peril.

If contrary to the act it will be void.

The disclaimer must show the reason for making it, as, for instance, that the patentee has discovered that the parts disclaimed were not new, or are not useful, or that they will not produce the effects stated, or that doubts are entertained respecting such matters. And it seems that a patentee is required to state his reason not only that the Attorney or Solicitor-general may be better able to judge of the propriety of assenting to it, but also that the public may be better enabled to understand how it varies the effect of the patent.

Reasons to be stated in disclaimers.

Advertisements may be and always are required to be published, giving notice of the application for a *fiat* (r). *Caveats* may be entered against leave being given to enter a disclaimer, and the application for leave may be opposed by parties who have entered *caveats*. This provision is intended not only for the benefit of the public, but also for the protection of assignees and licensees having an interest in the patent (s), so that they may be enabled to oppose leave being granted to enter any disclaimer which may operate to their prejudice.

Notice of application.

When the disclaimer is completed and the *fiat* obtained, it is to be filed by the Clerk of the Patents, and enrolled with the specification, and then it becomes in effect a part of the patent and specification to which it relates. But the entry of a disclaimer will not have the effect of making a void patent good, *ab initio*, as to the undisclaimed parts of the invention, so as to make any person a wrong doer by relation. This was decided in the case of *Perry v. Skinner* (t), in which it was

Effect of a disclaimer when enrolled.

Does not make patent good *ab initio*.

(q) See the observations of the Master of the Rolls in *re Sharpe's patent*, 1 Webs. R. 641.

(r) See the rules of practice on this subject in the Appendix, Chap. I. s. 2;

see also the practice, *post*, Chap. XII.

(s) See *Spilsbury v. Clough*, 2 Q. B. 466.

(t) 2 M. & W. 471.

Act did not intend to make a party a wrong doer by relation.

held that although the Act is obscurely worded, yet the intent could not have been to make a party a wrong doer by relation, and therefore that the Act must be understood as if it had said that after a disclaimer had been filed and enrolled, the disclaimer should be "deemed and taken to be part of such letters patent, or such specification, *from thenceforth* in all Courts whatsoever." The chief difficulty in construing this section of the Act of Parliament arises from the introduction of the proviso that a disclaimer should not be receivable in evidence in any action (except an action of *scire facias*) pending at the time when it is enrolled, and which would seem to be unnecessary if a disclaimer could not affect any thing done prior to the enrolment. But notwithstanding this difficulty, the Court of Exchequer held, in the case of *Perry v. Skinner* (u), just cited, that an Act of Parliament cannot be construed, so as to make a party a wrong doer by relation unless the words showing such an intent are manifest and plain. The object of a disclaimer must always be to cure some defect in a patent, or obviate some doubt respecting its validity, and as it must state the reason why it is made, it will in some cases bear evidence upon the face of it of an admission by the patentee, that there was something for which he could not sustain the patent.

Object of disclaimer.

Admission that patent was void prevents any action for a prior infringement.

With respect to the disclaimed parts in such cases, it is clear that the patentee by the disclaimer abandons all right to them; and as to the residue of the invention, he will be debarred from proceeding against any one for a prior infringement of the privilege, if he has admitted that it was void until the defect was cured by the disclaimer.

Action may be maintained if patent not admitted to be void.

There may however be cases in which a disclaimer will contain no admission of the prior invalidity of the patent; and in such cases it seems that the disclaimer will not affect the patentee's right to recover damages for an infringement of the undisclaimed parts of the invention before the enrolment of the disclaimer (x).

In what suits a disclaimer to be given in evidence.

The proviso declares that a disclaimer is not to be receivable in evidence in any action or suit pending at the time it is enrolled (except an action of *scire facias*), and that in such

(u) 2 M. & W. 471.

(x) See per Tindal, C. J., in *Stocker v. Waller*, 9 Jur. 136.

actions or suits the original title and specification alone are to be given in evidence. The intent of this proviso is, that a patentee shall not be enabled to give a disclaimer in evidence to the prejudice of any party against whom he may then have any action or suit pending, but it could hardly be intended that the defendant in such a suit should not be at liberty to make use of a disclaimer as evidence against the patentee, if it contains any admission respecting the prior invalidity of the patent. In such a case the disclaimer shows that the supposed privilege which the defendant is alleged to have infringed had no legal existence at the time when the alleged infringement was committed, and the patentee ought not to be permitted to enforce a patent against a defendant which he admits contained something that rendered it void; and it may be that that part of the invention which the defendant is charged with pirating, may be the very part which the patentee has disclaimed.

Patentee prevented from giving evidence of disclaimer in actions pending.

Defendant may use disclaimer in evidence.

2. *Memorandum of Alteration.*

The provisions of the statutes 5 & 6 Will. IV. c. 83, and 7 & 8 Vict. c. 69, are precisely the same with respect to a memorandum of alteration as with respect to a disclaimer. The same persons who are enabled to enter disclaimers may also enter memorandums of alterations, provided they obtain the requisite leave.

Memorandum of alteration.

A memorandum of alteration is available for the purpose of correcting any mistake or misdescription in the title of the invention, or in the specification, or for the purpose of explaining anything in the specification which is not sufficiently intelligible.

For what purpose a memorandum of alteration available.

The patentee must be careful to see that any alteration he may seek to make, will not be such as, if valid, would have the effect of extending the exclusive right granted by the patent. The Attorney or Solicitor-general will only examine a proposed alteration or disclaimer with a view to see how far it may affect the rights and interests of other parties, and the public in general, leaving the patentee to take care of his own interest, and if he enter a memorandum of alteration

Alteration must not extend the patent right.

which is not warranted by the statute, it will be void, and may be very prejudicial to his interests.

The provision in the Act that a disclaimer or alteration shall not be such as to extend the patent right, must however be understood with some qualification; for if a disclaimer or memorandum of alteration has the effect of rendering a void patent valid, it may be said in one sense to extend the patent right. It seems that the true question in all cases will be, whether a disclaimer or alteration made by a patentee would have the effect of extending the patent privilege, if the patent were a valid patent at the time the disclaimer or alteration is filed and enrolled. If the disclaimer or alteration could not produce such an effect, then it would not be void as having a tendency to extend the patent right; but if the patent and specification, and the disclaimer or alteration, taken and construed together, purport or appear to be more extensive in effect than the patent and specification alone, then the disclaimer or memorandum of alteration is not warranted by the statute, and is therefore null and void.

Reason for alteration need not be stated.

The Act requires that the reason for a disclaimer should be stated, but is silent with respect to any statement of the reason for an alteration, and that was probably because it would be difficult to make any alteration beneficially for the patentee, without the reason being apparent in some way or other. It is however usual in practice to state the reason why an alteration is made.

A proposed memorandum of alteration must be advertised in the same way as a disclaimer, and may be opposed in a similar manner (*y*).

Effect of a memorandum of alteration.

The observations which have been made (*z*) respecting the effect of a disclaimer apply also to a memorandum of alteration. It is clear from the express provisions of the Act of Parliament, that a memorandum of alteration could not be used in evidence in any action pending at the time it was enrolled. But if the alteration which has been made does not show that the patent was void before the making of the alteration, there does not seem to be any reason for concluding that the memorandum of alteration should have the effect of de-

(*y*) Vide *ante*, p. 204, and the rules in the Appendix, Chap. I. s. 2.

(*z*) Vide *ante*, p. 205.

priving the patentee of any remedy against prior infringers (a). Thus suppose a patentee to make an alteration for the purpose of rendering his specification more clear and explicit, and obviating any doubt respecting its sufficiency, he does not admit the invalidity of his patent, but he thinks it prudent to provide against an adverse decision on a doubtful point. In such a case it would be hard to deprive a patentee of his remedy against parties for prior infringements, if it should turn out that the patent was really valid and sufficient, without the alteration which he has only made by way of precaution. But if a patentee were under such circumstances to proceed against any person for a prior infringement, he must show that the patent was sufficient without the aid of the memorandum of alteration, which he could not be permitted to give in evidence, but the defendant would be at liberty to give the instrument in evidence against the plaintiff if it contained any admission respecting the prior invalidity of the patent.

It frequently happens that a patentee desires not only to make a disclaimer, but also an alteration in some part of the title or specification of his invention; and in such a case the disclaimer and alteration may both be effected by one instrument.

Disclaimer and alteration may be in one instrument.

SECTION III.

Of the Alteration and Amendment of Patents, Specifications, and Enrolments at Common Law.

THE statute 5 & 6 Will. IV. c. 83, left untouched the Common Law power of altering and amending the entries and proceedings relating to patent grants; and there are several alterations and amendments which can only be made at Common Law.

Alterations and amendments at Common Law.

In three out of the four superior Common Law Courts the records are supposed to be in the custody of the chief Judge of the Court, and therefore all writs of error are directed to him alone, commanding him to return the records into the Court of Error; and he alone has the power of appointing the officers of the Court. But in the Chancery, which is the other

Chancery records in custody of the Master of the Rolls.

(a) See *Perry v. Skinner*, and *Stocker v. Waller*, cited *ante*, p. 208.

superior Common Law Court, the records are not in the custody of the Lord Chancellor, (who is, properly speaking,) the sole Judge of the court) (*b*); but they are placed in the custody of the Master of the Rolls, who is, by virtue of his office, keeper of the records of that Court (*c*).

Lord Chancellor has jurisdiction to order alterations or amendments.

As sole Judge of his Court, the Lord Chancellor clearly has jurisdiction over the Chancery records, to order any alterations or amendments which may be found necessary, in the same way as the Judges of the other Common Law Courts at Westminster order such alterations or amendments to be made in the records of their Courts, although the records are in the custody of the chief Judge only, or of the officers of the Court, who are for that purpose his deputies.

Master of the Rolls has also jurisdiction to order alterations or amendments.

And the Master of the Rolls, as the keeper of the records of the Court, has authority over all the officers whose duty it is to prepare, examine, and preserve the records; and has jurisdiction to order such alterations or amendments in the rolls of the Court as may be necessary in order to make them correct records of the acts or judgments of the Court, which are intended to be therein recorded.

It would be beside the purpose of this work to enter into much detail respecting the Common Law power of amendment possessed by our Courts; ample information on the subject will be found in several of our abridgments, digests, and books of practice (*d*).

Records relating to patent grants.

The records of the Court of Chancery relating to a patent grant are, first the Privy Seal bill, or writ of Privy Seal, directed to the Lord Chancellor, and by virtue of which he makes the patent, and this writ when filed in Chancery becomes a record of that Court. Upon this writ is written the *recepti* required by the statute 18 Hen. VI. c. 1, which is also an entry of record. The patent made by the Lord Chancellor in pursuance of the writ of Privy Seal, is also a record of the Court of Chancery (*e*), although it is delivered to the

(*b*) 4 Inst. 79.

(*c*) The Master of the Rolls is now, under the statute 1 & 2 Vict. c. 94, the keeper of all the public records of the kingdom.

(*d*) See the title "Amendment," in Bacon's Abridgment, Comyn's Digest,

and Viner's Abridgment; see also the Chapter on Amendment in Tidd's Practice, and *Blackmore's case*, 8 Co. R. 156, a; and *Wynne v. Thomas*, Willes, 563.

(*e*) Vide *ante*, Chap. IV. p. 36.

grantee as a muniment of his title. Letters patent are always enrolled or entered upon rolls called Patent Rolls, and such enrolments are records of this Court. A specification must also be enrolled within the time limited by the patent, and that enrolment is also a record of the Chancery. A disclaimer or memorandums of alteration must be enrolled with the specification, and must be considered as part of the same record.

All these records, except the letters patent, pass into and remain in the custody of the Master of the Rolls, as keeper of the records of the Court.

With respect to the Privy Seal bill, or writ of Privy Seal, the Master of the Rolls has merely a right to the custody of it, in order to preserve it amongst the other records of the Court, but he has no authority to alter or amend it in any way. It is the writ upon which the Lord Chancellor's authority to make a patent was founded, and it is preserved amongst the records of the Court, in order to show by what authority the patent was made (*f*), the patent itself always referring to the writ by the usual conclusion, "By writ of Privy Seal" (*g*). This writ is issued by the Lord Privy Seal, under the seal of his office, and it can only be altered or amended by the same authority as that which made it, *viz.* the Lord Privy Seal. The Master of the Rolls will in all proper cases allow the Lord Privy Seal or his officer to have access to the writ for the purpose of altering or amending it in any way that may be necessary in pursuance of any authority received from the Crown (*h*), but by the alteration it becomes in effect a new writ (*i*), and must be again delivered to the Lord Chancellor, as his authority to alter and reseal the patent, and another *recipi* must be written upon the writ, or recorded in some other way in pursuance of the statute 18 Hen. VI., c. 1 (*j*). And when a party is applying to have a writ of Privy Seal altered, it seems to be proper that he should be required to deliver the letters patent to the proper officer of

Writ of Privy Seal.

Patent ought to be delivered into Court before the writ of Privy Seal is altered.

(*f*) See 8 Co. R. 18, b. 2 Inst. 555, 556.

(*g*) See Chap. IV. p. 74.

(*h*) There must be a fiat or warrant of the Attorney or Solicitor-general to show the consent of the Crown.

(*i*) See the case of *Knight v. Warren*, 7 Dowl. 663.

(*j*) This is in accordance with what was stated by Lord *Cottenham*, L. C., in *Nickels'* case, Turner & Phillips, 47; 1 Webs. R. 662, 663, S. C.

the Court before the writ is altered; for otherwise the party might afterwards neglect to carry in the patent to have it altered and resealed, and then there would be a patent in existence which would appear not to be warranted by the writ of Privy Seal.

Patent.

The patent we have seen is a record of the Court of Chancery, containing the Queen's grant made by the Court in pursuance of the writ of Privy Seal (*l*). This record does not remain in the Court, but is delivered into the custody of the grantee, immediately after it is made as an evidence of his title to the privilege which the Queen has granted him. It is scarcely necessary to observe, that the grantee himself has no authority to alter or amend the patent in any respect; indeed the alteration of it by him or any other person without lawful authority would be a serious offence (*m*).

Patent can only be altered or amended by the Lord Chancellor.

The writ of Privy Seal for the making of a patent is directed to the Lord Chancellor alone, and confers authority upon no other person; the letters patent which he makes in pursuance of such a writ never pass into the custody of the Master of the Rolls, and therefore the Master of the Rolls has no jurisdiction whatever over the patent (*n*). The Lord Chancellor is, in fact, the only person who has any jurisdiction over a patent, and that jurisdiction he has over the patent as well as over all the other records of his Court. Therefore, whenever a patent is to be altered or amended in any respect, the alteration or amendment can only be made by the Lord Chancellor, and he can only give effect to any alteration or amendment of it by the same means that he made the patent, *viz.* by affixing to the patent, as altered, the Great Seal, which is in his custody (*o*).

Must be resealed after alteration.

Alteration of a patent.

Whenever the Lord Chancellor has executed a writ of Privy Seal, by making a patent in the form commanded, and it is afterwards discovered that a patent in that form is not that which was intended, the whole of the previous proceedings may, by her Majesty's command, be altered so as to make them according to the intent; and the altered writ of Privy Seal being redelivered to the Lord Chancellor, his Lordship

(*l*) Vide Chap. IV. *ante*, p. 36.

(*m*) See stat. 11 Geo. IV. & 1 Will. IV. c. 66, s. 2; Hawk. P. C. c. 70, ss. 1, 8 & 9; 1 Hale, 178, 184; 3 Inst. 16.

(*n*) *Nickels' Case*, Turner & Phillips, 44; 1 Webs. R. 659, S. C.

(*o*) *Beames' Orders*, 67.

thus acquires jurisdiction to make the patent correspond with the now form given him in the writ, if he thinks it lawful or proper so to do (*p*). What may thus be done by the Lord Chancellor, in pursuance of this new command, will properly be termed an *alteration* of the patent, and not an amendment of it, for the writ of Privy Seal having previously been fully executed, his Lordship has no power to make the alteration without a new command from her Majesty, and the altered patent is, in fact, a new patent (*q*). If any authority were necessary to show that the Lord Chancellor must have a new warrant to alter a patent, it would be furnished by the case of *ex parte Beck* (*r*), in which it appeared that a *caveat* had been entered against putting the Great Seal to a patent for an invention which was afterwards made, bearing date 12th August, 1784; the Lord Chancellor, upon hearing the petition, took some time to consider of it, and did not make his order until the 27th August. The patentee did not enrol his specification until the 18th of December, 1784, supposing that the patent bore date the day the final order was made by the Lord Chancellor, but he then found that the four months limited for the enrolment of his specification had expired. The patentee then petitioned the Lord Chancellor to alter the patent by making it bear date the 27th of August instead of the 12th; but his Lordship (Lord *Thurlow*) refused, and said, that although he was perfectly satisfied that the patentee was well entitled to his patent, and that his case was a very hard one, yet he could not make such a use of his power as Keeper of the Great Seal, as to alter a patent in any degree upon an application of that sort.

In Beames' Orders (*s*), the form of order in *Sir Kenelm Digby's* case is given, from which it appears that the King had by letters patent granted to Sir K. Digby certain lands escheated to his Majesty by the death of *J. C.*, without heir, part of which lands were in Kent, and were so mentioned in the office found, and in the bill signed for the patent, but at the Signet Office, "by mistake of the clerk taking the L for a K,

(*p*) Vide *ante*, Chap. IV. p. 37, as to the act of the Court of Chancery in making a record of the Queen's grant.

(*q*) See the case of *Knight v. Warren*,

cited, *ante*, p. 213, n. (*i*).

(*r*) 1 Br. 78.

(*s*) P. 66.

Mode of altering a patent.

If patent not made in pursuance of writ of Privy Seal, Lord Chancellor may amend it.

It is not imperative upon the Lord Chancellor to alter a patent.

If alteration opposed, Lord Chancellor must exercise his judgment.

Nickels' case.

are mentioned to lie in com. Kank," and by that error were so mentioned both in the writ of Privy Seal, and the patent, and in the enrolment. Sir K. Digby then petitioned the King for a warrant to amend the patent, which was granted (signed by the Attorney-general), and upon seeing the King's bill, and the Signet bill, as altered in pursuance of the King's command, the Lord Chancellor ordered the writ of Privy Seal and the patent to be amended and resealed, and the enrolment to be also amended accordingly. It is also stated by the order in this case, that *the seal was to be taken from the patent*, and that it was then to be altered and resealed, which shows that when resealed, it would, in effect, be a new instrument.

But if a patent should happen by mistake to be made in a form different from that commanded by the writ of Privy Seal, the writ has not been executed, and the Lord Chancellor has jurisdiction without further authority from the Crown to reform the error which has been committed, because until that is done he has not executed the writ of Privy Seal, and the alteration which he may thus make will properly be termed an amendment of the patent.

The redelivery of an altered Privy Seal bill to the Lord Chancellor, does not make it imperative upon him to alter the patent accordingly, unless he is of opinion that the alteration will not unfairly prejudice third parties, and will not make the patent contrary to law. If the alteration sought to be made is unopposed, the patent will be altered and resealed, as a matter of course, unless the alteration appears to be objectionable to the Chancellor or his officers. If the alteration is opposed, as it may be on a *caveat* entered for that purpose (s), the Lord Chancellor must then exercise his judgment on the matter, and make or refuse the alteration as he may think just or expedient under the circumstances. Thus in *Nickels' case* (t), it appeared that the patentee had petitioned the Crown for a patent for an invention of "improvements in machinery for covering fibres applicable in the manufacture of braid and other fabrics;" but a mistake was made by a clerk in the Secretary of State's office, who prepared the Queen's warrant, and who introduced the word

(s) See the practice as to such oppositions, *post*, Chap. XII.

(t) Turner & Phillips, 36; 1 Webs. R. 662, 650, S. C.

“recovering” into the title of the invention instead of the word “covering.” This mistake was not discovered at the time, and not only the Queen’s warrant, but all the other proceedings, including the Privy Seal bill, the patent, and the enrolment of the patent, contained the word “recovering” in the title instead of the word “covering;” and the docket-book, which is open to the public, and which is always resorted to by the public to obtain a knowledge of what a patent has been obtained for, also stated the patent to have been granted for improvements in machinery for *recovering*, &c. The patent was obtained in this way in April, 1838, and a specification was enrolled in October of the same year, in which the patent was referred to as a patent for “improvements in machinery for *covering*, &c.” In the month of June, 1840, the patentee commenced proceedings against the London Caoutchouc Company for an alleged infringement of his patent, and the Company soon afterwards sued out a writ of *scire facias* to repeal the patent. Pending these proceedings, the patentee procured the Privy Seal bill and the prior proceedings to be altered by substituting the word “covering” for “recovering” in the title, and then without the writ of Privy Seal having been redelivered, he petitioned the Lord Chancellor to amend the patent accordingly, and carried the patent into Court to be resealed, when it was discovered that the patent had been altered after it was sealed, by erasing the letters “re” from the commencement of the word “recovering” in the title of the invention, but no explanation was given respecting the manner in which this alteration had been made (u). The petition being opposed by the London Caoutchouc Company, Lord *Cottenham*, L. C., (without hearing the counsel for the Company,) said, that he would do nothing but what was usual, that is to say, that he should at all events only reseat the patent upon the Privy Seal bill being properly brought before him, and that he should not even do that without taking care that it should not prejudice other persons. And on a subsequent day his Lordship said, that the only terms on which he would entertain the application to amend the patent at all were, that the patentee should abandon and pay the

(u) This fact is omitted in Mr. Webster’s report of the case.

costs of all proceedings then pending, and undertake not to bring any other action for the infringement of his patent up to that time. The petitioner declined to accede to these terms, and the Lord Chancellor, therefore, not only refused to grant the petitioner any relief, but also ordered him to pay the costs of the London Caoutchouc Company in opposing the petition (x).

At a subsequent period the action against the London Caoutchouc Company came on for trial, and at the suggestion of the learned Judge who presided, a compromise was effected between the parties; and the Privy Seal bill, having been redelivered to the Lord Chancellor, his Lordship, with the consent of the Company, ordered the patent to be amended and resealed, *the petitioner undertaking to bring no action for any infringement before the resealing*, and the patent was afterwards amended and resealed accordingly.

Effect of the
Alteration in
Nickels' case.

It is difficult to say what is the effect of such an alteration and resealing of a patent as in *Nickels'* case. The statute 18 Hen. VI. c. 1, requires that the day of the delivery of the writ of Privy Seal to the Chancellor shall be entered of record, which is always done by the usual *recepti* being written in the margin of the writ. When an alteration has been made in the writ of Privy Seal, it must be redelivered to the Chancellor, and a new *recepti* written upon it (y). It seems therefore that the alteration in the writ of Privy Seal makes it essentially a new writ. The statute just cited also enacts, that a patent made in pursuance of the writ shall bear date the day of the delivery so recorded, *and not before*; and that if any letters patent be made to the contrary *they shall be void*. In *Nickels'* case the redelivery of the writ of Privy Seal was recorded by a *recepti* in the usual way, but the patent, after it had been altered, was resealed as of the same date as before; and therefore the altered patent bore date on a day before the day of the redelivery of the writ of Privy Seal, which seems to be contrary to the provisions of the statute of 18 Hen. VI. c. 1, just cited. The patentee however was in a difficult position, for his patent was void for want of a proper specification, and therefore it was necessary to procure an alteration

(x) The order for the payment of these costs is not stated in either of the reports of the case.

(y) Vide *ante*, p. 214.

in the patent; if he had procured the altered patent to be resealed as of the day when the altered writ of Privy Seal was delivered to the Lord Chancellor, the patent would have borne date on a day long after the enrolment of the specification, and the patent would thus have been avoided by reason of the want of novelty in the invention at the date of the patent. The course which the patentee took was that which was the best under the circumstances, but it is very doubtful whether the alteration has given him any better title than he before possessed. The apparent want of jurisdiction in the Lord Chancellor to make a valid amendment of a patent under such circumstances is a serious defect in the law, which ought to be remedied by Parliament.

In the course of the argument of *Nichols'* case, Lord *Cottenham* said (z), that he had some doubt as to the mode in which an alteration was to be made when the letters patent had been actually enrolled. His Lordship added, however, that he had been furnished with the only instance of the kind which he was told existed, and it was effected in this way. An application had been made to Lord *Alvanley* when he was Master of the Rolls to alter the enrolment. He thought he could not do it, because it would make the enrolment vary from the letters patent; and afterwards, on communication with the Lord Chancellor, who thought the case was one in which an alteration ought to be made in the patent, the Master of the Rolls came into the Lord Chancellor's Court, and under the authority of the Lord Chancellor, the patent having been altered was resealed, and then the Master of the Rolls made the enrolment correspond with the patent so altered.

Mode of making an alteration.

The enrolment of a patent is an entry of the patent upon record, which is made for the purpose of showing what the Lord Chancellor has done in pursuance of the Queen's writ of Privy Seal. This entry is made upon one of the rolls called the Patent Rolls, for the current year of the Queen's reign: and although the enrolment is, in practice, (for the sake of convenience merely,) copied from the writ of Privy Seal, it is in fact an enrolment of the patent, and not of the writ of

Enrolment of patent.

(z) *Turner & Phillips*, 48; 1 *Webs. R.* 663, *S. C.*

Privy Seal (a). After the enrolment has been prepared; it passes into the custody of the Master of the Rolls, who thus acquires jurisdiction over it (b).

Enrolment of patent examined and corrected by Clerk of Petty Bag.

The writ of Privy Seal comes into the custody of the Master of the Rolls as well as the enrolment, and the officers of the Petty Bag (to which office the enrolment is transmitted after it is prepared) examine it in order to see that it has been properly prepared by the enrolment clerks, and if it is found erroneous or defective, the officers, as deputies of the Master of the Rolls, have authority to make the necessary corrections.

Master of the Rolls has power to order amendments.

So also if the enrolment should at any time afterwards be found to be erroneous in any respect, the Master of the Rolls clearly has jurisdiction to correct the error. The Master of the Rolls has indeed exercised this jurisdiction from a very early period, several instances of which will be found referred to in a note to the report of *Nichels'* case, before the present Master of the Rolls (c). So if it becomes necessary at any time to alter or amend the patent, the enrolment must be altered or amended in the same manner, and the Master of the Rolls will see that the enrolment is made to correspond with the altered patent.

Lord Chancellor has jurisdiction to order amendments and rescind or vary orders made by the Master of the Rolls.

The Lord Chancellor has also jurisdiction, not only to order any alteration in an enrolment which may be necessary in order to make it in accordance with the patent, but has power to vary or rescind any order for an amendment made by the Master of the Rolls.

Thus in *Nichels'* case (d), the Master of the Rolls had ordered an alteration to be made in the enrolment of the patent, which had the effect of making the enrolment vary from the patent; and upon an appeal to the Lord Chancellor against this order of the Master of the Rolls, it was objected by the respondents that the Lord Chancellor had no jurisdiction, but Lord *Cottenham*, L. C., held that he had jurisdiction, and said that the Master of the Rolls either had jurisdiction or no jurisdiction; if he had jurisdiction, then the Lord Chancellor had jurisdiction also upon appeal against his order; and that if the Master

(a) See *Nichels'* case, Turn. & Phil. 36.

(b) See the practice, *post*, Chap. XII.

(c) 4 Beavan, 567, 570; see the same cases mentioned in a note to Mr. Webster's report of *Sharp's* case, 1 Webs.

R. 647, n. (b).

(d) See the reports of the case in 4 Beavan, 563; Turn. & Phil. 36; 1 Webs. R. 650-656. The point above stated is not however mentioned by any of the reporters.

of the Rolls had no jurisdiction, the Lord Chancellor had jurisdiction to set aside his void order.

It is of the utmost importance that the enrolment of a patent should be strictly in accordance with the patent itself, for by the statute 3 & 4 Ed. VI. c. 4, amended by 13 Eliz. c. 6, an exemplification or constat of the enrolment may be pleaded and given in evidence in the same manner as the patent itself. Importance of enrolment being in accordance with patent.

In *Nichols' case* (e), it appeared that the patentee had procured a mistake in the title of his invention to be rectified in all the proceedings prior to the patent, including the writ of Privy Seal; but in consequence of difficulties already alluded to (f), he was desirous of avoiding any alteration in the patent itself. He therefore applied to the Master of the Rolls (g) to have the enrolment altered so as to make it correspond with the writ of Privy Seal, intending to offer the enrolment in evidence, but he did not procure the patent to be altered. The Master of the Rolls, upon proof that it was the practice to prepare the enrolment from the writ of Privy Seal (which always contains the form of the patent), ordered that the enrolment should be altered so as to make it conformable with the altered writ of Privy Seal, and the enrolment was altered accordingly. Upon the argument of the case, the Master of the Rolls (Lord *Langdale*) had great doubt respecting his authority to make the alteration in the enrolment without a previous alteration in the patent, but being impressed with the peculiar hardship of petitioner's case, and after a conference with the Lord Chancellor, his Lordship thought it best to raise the question respecting the legality of such an alteration in the enrolment by making an order, and thus compelling the opposing party to carry the case before the Lord Chancellor by way of appeal. Nichols' case.

Upon an appeal to the Lord Chancellor (Lord *Cottenham*), this order was discharged, and his Lordship said in delivering judgment, "I have communicated with the Master of the Rolls since the case was argued, and the Master of the Rolls entirely concurs with me in the opinion which I understand that he intimated when the case was before him, that nothing can Enrolment must not differ from the patent.

(e) 4 Beavan, 563; Turner & Phil. 36; 1 Webs. R. 650, S. C.

(f) *Ante*, p. 218.
(g) 4 Beavan, 563.

be permitted to remain which will enable the party to produce an enrolment differing from the letters patent. If any doubt could exist upon that point upon other grounds, it would be removed by the statute of Elizabeth (*h*), which enables parties, by producing the enrolment (*i*), to dispense with the necessity of producing the letters patent, that provision evidently proceeding on the assumption, that the enrolment correctly represents what is contained in the letters patent. The title of the party derived from the Crown rests on the authority of the letters patent, the enrolment being only permitted to be used for the purpose of showing what the patent was, or rather of preventing the danger which might otherwise arise from attempts to alter the letters patent, which, being in the possession of the party, are of course more exposed to frauds and other casualties than the enrolment, which is kept in this Court, can be." And after suggesting an application for an amendment of the patent, his Lordship added, "The patentee may be assured that he will, in no event, be permitted to produce, as evidence of his patent, an enrolment which does not represent what the letters patent contain."

The Lord Chancellor accordingly afterwards discharged the order of the Master of the Rolls, and Lord *Langdale*, M. R., concurred with the Lord Chancellor in discharging it, and in ordering the enrolment to be restored to its former state, which was done accordingly.

Enrolment of specification.

The specification is an instrument in writing under the hand and seal of the patentee, describing his invention in the manner required by a proviso in the patent (*k*). The enrolment of that instrument is an entry of it upon record, also made in pursuance of the proviso contained in the patent, for the purpose of informing the public of the nature of the invention, and the manner in which it is to be exercised. This entry is made upon one of the rolls, called the Rolls of Surrenders and Specifications, which are prepared in several offices in Chancery (*l*).

(*h*) 13 Eliz. c. 6.

(*i*) That is an exemplification of the enrolment.

(*k*) Vide *ante*, Chap. VII. p. 151, re-

specting the specification.

(*l*) They are the Enrolment Office, the office of the Rolls Chapel, and the office of the Petty Bag.

These records or rolls also pass into the custody of the Master of the Rolls, and as the keeper of them he has jurisdiction to make any alteration or amendment which may be necessary to make the enrolment correctly represent what the specification was at the time when it was brought into Court to be enrolled. Cases of this kind have occurred in which the enrolments have been amended by order of the Master of the Rolls, and there can be no question about the legality of such amendments.

These rolls in custody of the Master of Rolls, who may order amendments.

There are also several instances in which amendments or rather alterations of a very different description have been authorized by the Master of the Rolls.

Alteration of enrolments of specifications.

Thus in *Redmund's* case (*m*), it appeared that the clerk who had copied the specification, had by mistake transposed some of the references to the plan, and nearly seven years after the date of the patent the specification having been corrected, the enrolment was by order of Sir *John Leach*, the Master of the Rolls, altered so as to make it conformable with the altered specification.

Redmund's case.

So in *Whitehouse's* case (*n*), it appeared that in the original specification the word "wire" was by mistake substituted for the word "fire," and was so enrolled. Nearly five years afterwards, and of course long after the expiration of the time within which the patentee was bound to enrol his specification, the mistake in the specification was corrected, and the enrolment of it altered accordingly, by order of Lord *Gifford*, the then Master of the Rolls.

Whitehouse's case.

Similar alterations were also made in *Rubery's* case (*o*), in *Green's* case (*p*), in *Faulkner's* case (*q*), in *Fisher's* case (*r*), and in several others.

Other cases.

In *Sharp's* case (*s*), Lord *Langdale*, M. R. said, speaking of these cases of amendment, or rather alterations:—"In every case which has occurred, it has plainly been intended to do no more than amend mere slips or clerical errors made by the parties, or the agents of the parties, who, intending to make an accurate enrolment, have, by mere inadvertence,

Sharp's case.

(*m*) 5 Russ. 44.

(*n*) 1 Webs. R. 649, n. (*m*).

(*o*) *Ibid.*

(*p*) 13 Jan. 1830.

(*q*) 15 April, 1836.

(*r*) 17 August, 1836.

(*s*) 1 Webs. R. 646.

made an enrolment which was not what it purported to be, a true statement of that which the party intended at the time; and not only has strict evidence of error been required, but in order to enable any third party to dispute the validity of the amendment, and of the order, it has been directed that the order itself should be indorsed on the enrolment."

Observations
upon cases.

It seems however that in making these orders, some objections to them have been lost sight of. The proviso in a patent which requires the specification, makes it necessary that the patentee should do two things, which are perfectly distinct from each other. He must firstly ascertain and describe the nature of his invention, and the manner of using it, by an instrument under his hand and seal, and that he must do within the time limited in the proviso. He must also, within the same time, cause that instrument to be enrolled or entered upon the rolls of the Court for the benefit of the public. These two things are perfectly separate and distinct; and in actions at Law issues are frequently taken separately upon each of them (s). When the fact is put in issue, the patentee must show that he had made a sufficient specification within the time limited by the patent, and that quite independent of the question respecting the enrolment. If the patentee has made a sufficient specification within due time, it is unnecessary to alter it; and if the specification was not sufficient, then the patentee has not complied with the proviso, and his patent is void. But it is a principle in Law that a record cannot be contradicted, so far at least as it alleges an act done by the Court; and a record must always be presumed to have been in the same state ever since it was made (t). It may therefore appear in a case such as those alluded to, that a sufficient specification was enrolled on a certain day, and if so, no person can be permitted to deny the record in that respect, even if the specification itself, and also the enrolment of it, were ever so vicious, until long after the time limited for the enrolment had elapsed. And the indorsement upon the roll of the order under which an alteration may have been made will not in any way assist a person who may desire to object to the en-

(s) Vide *post*, Chap. X. s. 2, and the forms of pleas in the Appendix, Chap. II. s. 4.

(t) See Com. Dig. tit. Record, (A), (E).

rolment, for the order forms no part of the record; and it would be contrary to all principle to allow a record to be contradicted or varied by anything which is not of as high a nature as itself. By allowing such an amendment as this, therefore, it seems that a patentee is enabled by the record to prove the performance of part of the condition contrary to the fact, and the opposite party is estopped by the record from denying what the record thus untruly alleges.

The Court has no jurisdiction whatever to alter the specification itself, any more than this or any other Court of Common Law can alter or amend a deed between parties (*u*); and not only is there nothing to amend by in such a case (*x*), but the amendment is made contrary to the fact.

Such alterations seem not to have been permitted without considerable doubt; for it will be seen from the observations of Lord Langdale, M. R., in *Sharp's* case (*y*), that the object in authorizing such alterations has been, to allow patentees to make them at their own peril, and under the (at least questionable) presumption that the indorsements upon the rolls would enable other parties to show the real state of the facts. Doubt respecting such alterations.

Courts of Record have long exercised jurisdiction in making such alterations and amendments in their records as may be necessary for the purpose of relieving parties who may be prejudiced by any act of the Courts, or of their officers.

Thus a judgment may be signed *nunc pro tunc* when a judgment has been delayed by the act of the Court, but not if the delay has arisen from the act of the parties (*z*). And the same reason entitles a patentee to have the enrolment of his specification corrected if erroneously prepared by the mistake or neglect of an officer of the Court, but not where the error has arisen from his own negligence.

These observations are made with the utmost deference to the very eminent Judges who have allowed alterations to be made; and with respect to the law, as the writer humbly conceives it to be, not as it ought to be. There can be no question that the Master of the Rolls ought to be authorized

(*u*) See the case of *Steel*, demandant, *Clenell*, tenant, and *Benn*, vouchee, 6 Taunt. 145.

(*x*) See the case of *Wynne and Another*, demandants, *Thomas*, tenant, and

Apperley and Wife, vouchees, Willes, 563.

(*y*) Cited *ante*, p. 223.

(*z*) See *Tidd's Practice*, *Archbold's Practice*, and the other books of practice.

to allow such alterations to be made, and all doubt on the subject ought to be set at rest by the Legislature.

Enrolments of disclaimers and memorandums.

Disclaimers and memorandums of alteration under the statute 5 & 6 Will. IV. c. 83, sec. 1, must be enrolled in like manner as specifications; and most of the observations which have been made respecting the enrolments of specifications, are also applicable to the enrolments of disclaimers and alterations.

Disclaimers and memorandums of alteration not records.

Disclaimers and memorandums of alteration are, in pursuance of the statute just mentioned, filed with the Clerk of the Patents; but as the statute does not direct them to be filed of record, it seems that they cannot be considered as records of the Court of Chancery.

Can only be amended by the leave of the Attorney-general and the Lord Chancellor or Master of the Rolls.

A disclaimer or memorandum of alteration could not be altered or amended without the order or consent of the Attorney or Solicitor-general; and as the document is filed with the Clerk of the Patents, who is an officer of the Court of Chancery, it seems that no alteration or amendment of it ought to be made without the order or consent of the Lord Chancellor or Master of the Rolls.

Master of the Rolls may amend the enrolment.

No jurisdiction to order disclaimer or memorandum to be taken off the file or expunged from the roll.

The Master of the Rolls has jurisdiction to amend the enrolment of a disclaimer or memorandum of alteration, so as to make the enrolment correspond with the document itself; but he has no authority to alter it in any other way. Nor has the Master of the Rolls jurisdiction to order a memorandum of alteration which has been enrolled in pursuance of the statute to be taken off the file, or to order the enrolment of that document, or any part of it, to be expunged from the records of the Court.

Sharp's case.

Master of the Rolls no jurisdiction to remove a memorandum of alteration from the rolls of the Court.

Thus in *Sharp's case* (z), application was made to the Master of the Rolls to remove from the rolls of the Court a memorandum of alteration which had been enrolled under the provisions of the statute, in pursuance of the fiat of the Solicitor-general. It was contended that the effect of the memorandum was to extend the right granted by the patent, and that it was therefore contrary to the statute and *vād.* Lord *Langdale*, M. R., however decided that the memorandum was to be considered as part of the specification, and that he had no jurisdiction to make the order which was prayed for.

(z) 3 Beavan, 245; and 1 Webs. R. 641.

CHAPTER IX.

OF THE NATURE OF THE RIGHT OR PROPERTY OF AN INVENTOR
IN HIS INVENTION, AND THE DISPOSITION THEREOF.

SEC. I.—*Of the Nature of the Right or Property.*

II.—*Of Assignments in Fact and in Law.*

III.—*Of Licences.*

IV.—*Of Surrenders.*

SECTION I.

*Of the Nature of the Right or Property of an Inventor in
his Invention.*

It has frequently been contended that every person has as much natural and moral right to the produce of his mental exertions, as to the profits of his corporeal labour or industry. The subject was much discussed in the copyright case of *Millar v. Taylor* (a), to which the reader is referred. The composition of a literary work is not, however, quite analogous to the invention of a new manufacture. The author of a literary work, it may correctly be said, actually creates the work which is the produce of his labour; he does not merely invent or discover it, for it could not have any previous existence. An author, therefore, may very fairly contend that he has a natural right of property in his work, and the law gives him an exclusive copyright as a reward for his labour, *without the aid of any grant from the Crown*. But a person who invents or discovers any new manufacture, merely discovers an art of practically applying some of the laws of nature in the manufacture or production of articles of commerce. The laws or principles which an inventor thus ap-

Inventor's right to his invention.

Difference between the author of a literary work and an inventor.

An author creates the produce of his labours.

An inventor discovers that which before had existence although unknown.

(a) 4 Burr. 2303.

plies must have had existence, and must have been capable of the practical application invented, prior to the discovery being made; although, perhaps, both the laws or principles themselves, and the particular application of them, may have been unknown to the world.

An inventor does not create, but finds out something which had prior existence.

An inventor, in fact, does not create, but only invents or finds out something which had a prior existence, although unknown to the world, in precisely the same way as persons make discoveries in geography and astronomy. If Milton had not written "Paradise Lost," it is extremely improbable that it would ever have been written at all. But if Watt had never published his invention, it would most probably have been discovered, long ere now, that a condensing steam-engine is worked with more economy when the steam is condensed in a separate vessel, and not in the cylinder.

Inventor has no right independent of a grant.

The expediency of encouraging persons to make discoveries in the useful arts and manufactures cannot for a moment be doubted; but an inventor has no right, independent of a grant made to him by authority of a positive law, to prevent other persons from using an art or making any particular application of the laws of nature, merely because he was the *first* person to discover the art or application which he claims as his invention.

No natural right to prevent any other person from *making* and using the invention.

No inventor can, in fact, have any natural right to prevent any other person from *making* and using the same, or a similar invention, and therefore the law does not recognize any right or property whatsoever in an invention which is not made the subject of a grant by patent.

Inventor may keep his discovery secret.

It is true that an inventor may keep his discovery secret from all the world, and if he can he may use it in secret for his own advantage and profit.

Few inventions can be profitably used in secret.

But few arts or inventions are of such a description as to be capable of being profitably used in secret so as to prevent them from becoming known to the public. Sooner or later an invention will either be divulged by persons employed by the inventor, or be detected by an examination of its results or products which the inventor must vend for the purpose of making his invention profitable.

The law does not deprive an

The law does not deprive an inventor of any advantage he may obtain from the secret use of his invention, but it will

not recognize anything like a right of property in his invention, nor will it interfere to prevent others from using the invention, if they obtain a knowledge of it without being guilty of any breach of trust.

The law in fact says, that in order to acquire any right or privilege in an invention, such as can be recognized or protected, an inventor must give the public the benefit of the invention after a certain time. But if once the inventor rejects the advantage which the law holds out to him in the shape of a temporary privilege, and uses his invention for his own profit, he can never afterwards acquire any right or property in his invention which the law will protect or recognize (b).

In the case of *Canham v. Jones* (c), a bill was filed in Chancery by the plaintiff as proprietor of a recipe for preparing Velno's Vegetable Syrup, which it was stated had been purchased by Mr. Swainson, and bequeathed to the plaintiff. The bill prayed for an injunction to restrain the defendant from selling an article under the same name as the plaintiff's. The defendant demurred to the bill, and Sir *Thomas Plumer*, V. C., in giving judgment, said, "This bill proceeds upon an erroneous notion of exclusive property, now subsisting in this medicine, which Swainson having purchased, had a right to dispose of by his will; and, as it is contended, to give the plaintiff the exclusive right of sale of. If this claim of monopoly can be maintained without any limitation of time, it is a much better right than that of a patentee; but the violation of right, with which the defendant is charged, does not fall within the cases in which the Court has restrained a fraudulent attempt by one man to invade another's property,—to appropriate the benefit of a valuable interest in the nature of good-will, consisting in the character of his trade or production, established by individual merit; the other representing himself to be the same person, and his trade or production the same, as in *Hogg v. Kirby* (d), combining imposition on the public with injury to the individual. This is not that sort of case. The observation is correct, that the bill stating the defendant's medicine to be spurious, asserts it not to be the

inventor of the right to a secret use of his invention, but will not recognize any property in it.

To acquire a right, an inventor must give a consideration to the public.

Canham v. Jones.

No exclusive property in a medicine.

(b) See *Morgan v. Seaward*, 2 M. & W. 559.

(c) 2 Ves. & B. 218.
(d) 8 Ves. 215.

same as the plaintiff's. The defendant does not hold himself out as the representative of Swainson, setting up a right in that character to the medicine purchased by him; but merely represents, that he sells not the plaintiff's medicine, but one of as good a quality. He is perfectly at liberty to do so. If any exclusive right in this medicine ever existed, it has long expired. The foundation of this bill therefore, the exclusive right asserted by the plaintiff, failing, all the consequential relief falls with it; and the demurrer must be allowed."

Newberry v.
James.

In the case of *Newberry v. James (e)*, it appeared from the bill filed in the Court of Chancery, that by certain articles of agreement between Dr. James, the inventor and proprietor of certain pills for the gout, rheumatism, &c., and Newberry the plaintiff's deceased father, it was agreed that James should prepare the aforesaid pills, and sell and deliver them to Newberry at a certain rate, to supply his customers, and that James should not sell any of such medicines to any other person except in the course of his private practice. Newberry was also to be instructed in the secret of preparing the pills, but it was not to be disclosed by him except to his representatives after his death. It also appeared that letters patent had been granted in 1747, to James, for the exercise of his invention; and that James had assigned to Newberry, his executors, &c., one moiety of the invention during the term of fourteen years. The agreement contained in the articles was to be continued so long as either of the parties, their executors, &c., or any or either of them, should desire. Newberry bequeathed to the plaintiff all his interest in the preparing and vending the medicines. The defendants had succeeded to the rights of James who died in 1776. The bill prayed a specific performance of the agreement, and an injunction to restrain the defendants from disclosing the secret of preparing the medicines except to the persons mentioned in the agreement. An injunction was granted *ex parte*, only as to the sale of the medicines, expressly without prejudice to any question that might be made as to the possibility of sustaining such an injunction. On a motion to dissolve the injunction, Lord *Eldon*, L. C., said, "That the difficulty in such a case was, how

Equity cannot
decree the

(e) 2 Mer. 446.

to decree the specific performance of the agreement. Either it was a secret, or it was none. If a secret, what means did the Court possess, of interfering so as to enforce its own orders? If none, there was no ground for interfering. In this case, the medicines in question were the subject of a patent which had expired; and the agreement which the bill sought to enforce was an agreement by which, independently of the patent, the proprietors had entered into covenants not to sell that which was the subject of the patent except to each other. But in order to support a patent, the specification should be so clear as to enable all the world to use the invention so soon as the term for which it has been granted is at an end." Lord *Eldon* concluded by saying that "He thought he ought not to continue the injunction; and that, if he did not mention the case again, (which he did not do,) his opinion must be considered to be that the injunction must be dissolved."

In the same case a similar agreement had been made between James and the plaintiff respecting an invention by James of certain pills called *Analeptic Pills*, but for which no patent had been obtained. Lord *Eldon* remarked, that "With regard to the *Analeptic Pills*, if the art and method of preparing them were a secret, what signified an injunction, the Court possessing no means of determining, on any occasion, whether it had or had not been violated? The Court of Chancery could do nothing but put the parties in a way to try their legal rights by an action. That was the utmost extent to which it would go, and he would not even order the injunction to be continued in the mean time, till an action should be tried. The only way by which a specific performance could be effected would be by a perpetual injunction; but this would be of no avail, unless a disclosure were made to enable the Court to ascertain whether it was or was not infringed; for if a party comes here to complain of a breach of injunction, it is incumbent on him first to show that the injunction has been violated."

In the case of *Williams v. Williams* (*f*), the plaintiff in his bill (filed in Chancery) stated that he had intrusted the defendant (his son) with a secret of making a medicine. Upon a motion to dissolve an injunction which had been obtained, Lord *Eldon*, L. C., said, "So far as the injunction

(*f*) 3 Mer. 157.

Patentee ought to be protected because he is a purchaser from the public.

Whether a party is entitled to protection by restraining a party to a contract from divulging a secret, *quære*.

Yovatt v. Winyard.

When there has been a breach of trust respecting a secret medicine, the Court of Chancery will grant protection.

goes to restrain the defendant from communicating the secret, upon general principles, I do not think that the Court ought to struggle to protect this sort of secrets in medicine. The Court is bound indeed to protect them in cases of patents to the full extent of what was intended by the grant of the patent, because the patentee is a purchaser from the public, and bound to communicate his secret to the public at the expiration of the patent. Then whether the principle can be extended to such a case as this—whether a contracting party is entitled to the protection of the Court in the exercise of its jurisdiction to decree the specific performance of agreements, by restraining a party to the contract from divulging the secret he has promised to keep, that is a question which would require very great consideration. But the present case is not one which calls for the determination of it. If the defendant has already disclosed the secret, the injunction can be of no use. If he only threatens to disclose, it then becomes necessary to look at his affidavit; and by that he insists that what he has to disclose is no secret at all—then how is the Court to try this question? Or what can the Court do with the case altogether?” And his Lordship dissolved the injunction.

In the case of *Yovatt v. Winyard (g)*, a motion was made for an injunction to restrain the defendant from making use of or communicating certain recipes for veterinary medicines, and from printing and publishing certain papers of directions for the mode of administering them. The plaintiff who was the proprietor of the medicines had employed the defendant as an assistant under an agreement, by which he was to be instructed in the general knowledge of the business, but was not to be taught the mode of composing the medicines; afterwards the defendant left the plaintiff, and the latter had lately discovered that he had while in his service surreptitiously got access to his book of recipes and copied them, and was selling the medicines with printed papers for administering them, which were almost literal copies of those composed by the plaintiff. Lord *Eldon* granted the injunction upon the ground of there having been a breach of trust and confidence; but confined it, so as not to prevent the defendant from adminis-

tering the medicine to any animals then under course of treatment, it being stated in the papers of directions, that a sudden discontinuance would be prejudicial.

It appears from the cases which have been used, that an inventor has no property in his invention; and has no interest in it, which can be recognized by law, except under a patent grant, or for the purpose of obtaining such a grant.

Inventor no property except under a patent.

Although an inventor has no property in his invention except that which is given him by the Patent Law, yet he has such an interest in his invention *for which he proposes to take out a patent*, as to enable him to maintain an action for a violation of a contract respecting it. Thus in the case of *Smith v. Dickenson* (*h*) an action was brought upon an agreement by the defendant, not to avail himself of or to take any undue advantage of a communication made to him by the plaintiff, of an invention for which the plaintiff intended to take out a patent. It appeared that the defendant had committed a breach of the agreement by fraudulently obtaining a patent for the invention in his own name; and the Court of Common Pleas held that the plaintiff was entitled to recover damages against the defendant for this breach of the agreement.

Inventor may maintain an action for breach of an agreement respecting an invention, for which he intends to take a patent.

Smith v. Dickenson.

It has already been shown (*i*), that the subject of the grant by patent of an invention, is the sole right or exclusive privilege to use the invention, and which must be a new art of manufacturing vendible articles or commodities.

Subject of a patent grant is a privilege.

The privilege which a patent thus confers upon an inventor, has existence merely by force of the patent, which, in fact, creates the right, as well as grants it to the patentee.

Privilege has existence only by force of the patent.

Such a privilege is of an incorporeal or metaphysical nature, exists merely in idea and abstracted contemplation, and entirely apart from all physical and corporeal existence whatsoever. It is, in fact, a mere naked right, which if the patent itself did not make assignable, would be inseparable from the person of the grantee (*k*). It may properly be defined to be an incorporeal chattel, which the patent impresses with all the characters of personal estate, by limiting it to the grantee, his executors, administrators, and assigns.

Is of an incorporeal nature.

Incorporeal chattel.

(*h*) 3 B. & P. 630.

(*i*) *Aule*, Chap. IV. p. 53, and Chap. V. s. 1, p. 78.

(*k*) See the judgment of *Littledale, J.*, in *Duvergier v. Fellows*, 10 B. & C. 829.

SECTION II.

Of Assignments of Patent Rights in Fact and in Law.

THE right or privilege granted by a patent is of a personal nature, and but for an express provision in the patent, by which it is granted, it would be inalienable (*l*). Thus in the case of *Duvergier v. Fellows* (*m*), Mr. Justice *Littledale* said, that such a privilege cannot be assigned at all unless power to that effect is given by the Crown.

Limitation of the privilege.

The words of limitation make the privilege assignable.

Patent may be assigned either by deed or by act of law.

Assignment by act of the patentee must be *by deed*.

Patent requires licences to be under seal.

Power *v.* Walker.

If licence must be under seal, *a fortiori*, an assignment must be so.

A patent privilege in an invention is always granted to the patentee, his "executors, administrators, and assigns." The words "executors, administrators, and assigns" are words of limitation, which communicate an assignable quality to the privilege granted by the patent.

A patent privilege may be assigned either by the act or deed of the patentee himself, or by act and operation of law.

The patent makes no provision as to the form or manner in which assignments may be made of the privilege which it grants. But it seems clear that an inventor cannot assign or grant over his patent privilege except by deed. For it is a privilege of such a nature as cannot be granted without deed (*n*); and the rule of law is, that things which can only be granted or created by deed, can only be assigned by deed (*o*).

The patent requires that licences granted by the patentee shall be under his hand and seal (*p*), and it seems difficult to avoid coming to the conclusion that an assignment is intended to be made in at least as solemn a manner as a licence.

Lord *Ellenborough*, C. J., said in the case of *Power v. Walker* (*q*), respecting the assignment of a copyright, "if the licence which is the lesser thing must be in writing, *a fortiori*, the assignment which is the greater thing must also be" (*r*).

(*l*) Br. Abr. Franch. pl. 38; Shep. Touch. 239, 240; see the preceding section of this Chapter, *ante*, p. 233.

(*m*) 10 B. & C. 829; and see the observation of *Dampier, J.*, in *Power v. Walker*, 3 M. & S. 9, as to the assignment of a copyright.

(*n*) Co. Lit. 9, b. 172, a.; Shep.

Touch. 229-231.

(*o*) 3 Co. R. 63, a. *Lincoln College case*.

(*p*) Sed vide *Chanter v. Dewhurst*, 8 M. & W. 823.

(*q*) 3 M. & S. 9.

(*r*) The stat. 8 Ann. c. 19, requires that licences to use copyrights shall be in writing.

The same principle seems to be clearly applicable to assignments of patent rights; and as the patent requires a licence to be granted under hand and seal, that is by deed, the conclusion seems almost irresistible that an assignment must also be made by a deed or instrument under hand and seal.

Although an assignment of a patent right by the act of the patentee himself must be made by deed, there is no particular form of words necessary in order to effect the transfer of the right (s); the ordinary rule of law respecting the construction of deeds being, "that the construction be favourable, and as near to the minds and apparent intents of the parties as possible it may be and law will permit" (t).

No particular form of assignment.

Thus, from the case of *Cartwright v. Amatt* (u), it seems that a covenant to assign a patent upon the happening of a given event, will as soon as the event happens amount to an actual assignment of the patent.

Cartwright v. Amatt.

Covenant to assign may amount to an assignment.

There is no limitation contained in a patent as to the persons who may exercise the power of assigning, and therefore a patent right may be assigned not only by the patentee himself, but also by any person who may become entitled to it as assignee.

No limit as to the persons who may assign.

But every patent contains a condition limiting the number of persons who may at any one time become legally entitled to the privilege which it grants. The condition formerly contained in patents restrictive of assignments was much more stringent than that which has been adopted for some years past.

A condition in the patent limits the number who may be entitled to the privilege.

By the old condition the patent was declared to be void in case of any assignment to more than five persons; but the condition now always inserted permits assignments to be made to twelve persons. The old form also provided that the patent should become void for many causes respecting which patents are now silent (x).

The condition formerly allowed only five persons to be interested, but now extends to twelve.

The condition now inserted in patents provides, that if the patent, or the liberties and privileges thereby granted, shall become vested in, or in trust for more than twelve persons, or their representatives, at any one time, as partners dividing

Effect of condition now inserted in patents.

(s) See Forms in the Appendix, Chap. II.

(u) 2 B. & P. 43.

(t) Shep. Touch. 86, 83, and the authorities there cited.

(x) See the present form of condition, *ante*, Chap. IV. p. 66.

or entitled to divide the benefits or profits obtained by reason of the patent (reckoning executors or administrators for the single person they represent) then the patent is to be void.

Object of the condition.

Assignment to more than twelve only vitiates the patent if they become entitled as partners.

This condition seems to be inserted with the object of preventing a patent from being made the means of creating an oppressive monopoly by a large number of persons associating together for the purpose of working the patent privilege. By this clause in a patent it seems that the patentee is not prevented from assigning to more than twelve persons if the assignees do not become entitled to the profits arising from the patent *as partners*, for if the assignees are entitled severally, and work the patent privilege independent of each other, and not as partners, there will be such a competition amongst them, that the public will be protected, and will not suffer from the effects of any monopoly.

If the condition is violated, the patent becomes void.

If a patent right is once dealt with contrary to the condition upon which the patent is granted, it is clear that the privilege is not merely suspended, but becomes absolutely void and can never afterwards be enforced. And if the parties, who were possessed of a patent right, which has become void by reason of a violation of the condition respecting assignments, attempt to enforce it by action in a Court of Law, the defendant may plead that the patent has been avoided as a defence to the action (*y*).

Patentee cannot, after assignment, contest the validity of the patent.

The patentee or assignor of a patent (which we have seen can only be assigned by deed) cannot, after the assignment, be permitted to contest the validity of the patent, for he is estopped by his deed afterwards denying its validity (*z*). The doctrine of estoppel, as applicable to such cases, was much discussed in the case of *Bowman v. Taylor* (*a*), to which, and the cases there cited, the reader is referred.

Bowman v. Taylor.

Covenants for title.

Upon the assignment of a patent right, the person making the assignment usually enters into covenants with the assignee respecting his title, and the validity of the patent; and if the deed does not contain any express covenant on the subject, it seems that a covenant for title on the part of the assignor will not be implied from the words, "bargain, sell, and as-

(*y*) *Duvergier v. Fellows*, 5 Bing. 439; *Bowman v. Taylor*, 2 A. & E. 218; S. C., in error, 10 B. & C. 826. 278.

(*z*) *Oldham v. Langmead*, cit. 3 T. R. (*a*) 2 A. & E. 278.

sign," contained in the operative part of the instrument (b). For the law will not create any covenant respecting anything merely of a personal nature.

Parties making assignments ought therefore to have covenants for title inserted according to their intent, and see that they are restricted or unrestricted in such a manner as may be actually agreed upon.

In the case of *Hesse v. Stevenson* (c), it appeared that the assignor of certain shares in a patent entered into a covenant with the assignee, that he had good right, full power, and absolute and lawful authority to assign and convey the shares; and that he had not by any means directly or indirectly forfeited any right or authority he ever had or might have had over the shares; and it was held that the generality of the former words in the covenant were not restrained by the latter words, and therefore the want of title in the assignor was a breach of the covenant, although the defect was not occasioned by any forfeiture committed either directly or indirectly by the assignor.

Hesse v. Stevenson.
Effect and construction of covenants for title.

Assignments by act and operation of law take place where a person becomes entitled to a patent privilege without any deed of conveyance from the person to whom he succeeds, or under whom he claims.

Assignments by act and operation of law.

The form of a patent itself expressly provides that the devolution of the patent right shall be to the patentee, his executors, administrators, and assigns. These words of limitation make the patent right an assignable chattel interest, assignable by act and operation of law, in the same manner as any other chattel. In case of the death of the patentee or his assignee, the privilege descends to his executor if he made a will, and if not, then to his administrator, as an assignee in law.

Words of limitation in a patent.

In case of patentee's death the privilege vests in his executor or administrator.

A patent does not mention all the cases in which persons may become assignees in law; but the words executors, administrators, and assigns, which are added after the name of the patentee, and which are clearly words of limitation, sufficiently indicate the intention of the Crown that the patent privilege is to be of an assignable nature; and the law im-

The limitation makes the privilege assignable.

(b) See Bac. Abr. tit. Covenant (B.) Ro. Abr. 519, l. 49.

(c) 3 B. & P. 565.

plies therefore that it is to be assignable either by deed or in law, in the same way as other chattel interests.

Patent of a bankrupt or insolvent patentee passes to his assignees.

If therefore the owner of a patent privilege becomes bankrupt, his assignees become entitled to the property by virtue of their appointment (*d*). So if he takes the benefit of the Act for the Relief of Insolvent Debtors, all his right will vest in the assignee appointed by the Court for the relief of insolvent debtors. And if a patentee after his bankruptcy, but before he obtains his certificate, obtains a patent for an invention, the right to it vests in the assignees appointed under his previous bankruptcy (*e*).

SECTION III.

Of Licences.

Doubtful whether licences could be granted without a power in the patent.

WE have already seen (*f*) that a patent right would not be assignable, but for an express provision contained in the patent itself. It may be questionable whether a patentee would have authority to grant licences if there was no express power in the patent enabling him to do so, but the patent does in fact contain such a power.

Patent grants the sole privilege to the patentee, his executors, &c. and prohibits all others from using the invention without licence.

The patent grants (*g*) unto the patentee, his executors, administrators, and assigns, the especial licence, full power, sole privilege, and authority, that he and they, *or such others as he or they shall agree with*, and no others, shall use, exercise, and vend the invention; and immediately after the grant a prohibition is inserted in the patent (*h*), which commands all persons that they shall not, during the term granted by the patent, either directly or indirectly, make, use, or put in practice the invention, or any part of it, nor in anywise counterfeit, imitate, or resemble the invention, nor make, nor cause to be made, any addition to, or subtraction from, the invention, whereby to pretend themselves the inventors or devisors thereof, *without the consent, licence, or agreement* of the patentee, his executors, administrators, or assigns, *in writing, under his or their hands and seals*, first had and obtained.

(*d*) See *Hesse v. Stevenson*, 3 B. & P. 565; *Bloxam v. Elsee*, 6 B. & C. 169; 1 C. & P. 558, S. C.

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

(*f*) *Ante*, p. 234.

(*g*) *Vide ante*, p. 52.

(*h*) *Vide ante*, Chap. IV. p. 59.

The power of granting licences is thus expressly conferred upon a patentee, and those claiming under him. And provision is made that the power shall be granted only in a particular manner, that is under hand and seal. Every instrument under hand and seal is not a deed, but as the patentee must by the instrument make a GRANT of an authority or permission, it seems that a *deed* must be intended.

Power of licensing thus granted to be executed by deed.

In the recent case of *Chanter v. Dewhurst* (i), it was held by some of the Judges that a licence must not be under seal. Mr. Baron *Parke*, however seems to have entertained some doubt, but it was not necessary to decide the point.

Chanter v. Dewhurst.

Under the old form of condition against an assignment to more than five persons, it was considered doubtful whether a grant of a licence to more than five persons was not such an assignment, within the meaning of the condition, as would avoid the patent (k). In order to obviate this doubt a clause is now inserted in all patents, whereby it is provided, that nothing therein contained shall prevent the granting of licences in such manner, and for such considerations, as they may by law be granted (l).

Old form of condition.

Clause now inserted respecting licences.

A licence to use an invention comprised in a patent is in fact a grant of a right by the patentee to the licensee (m); and during the time it is in force, it exempts the licensee either from the whole or some portion of the prohibition contained in the patent, and enables him to exercise the whole or some particular part of the privilege granted by the patent.

Licence to use an invention is a grant.

Licences are sometimes granted generally, and therefore include a right to use every part of the patent privilege, but they are frequently granted in a restricted form.

Various kinds of licences.

Thus, a licence may be granted so as to continue in force during the whole of the term mentioned in the patent, or for any shorter term. So it may extend over all parts of the realm comprised in the patent, or it may be restricted to some particular district or districts. And a licence may be granted so as to entitle the licensee to use the whole of the invention,

(i) 12 M. & W. 823.

(k) See 6 Jarm. Byth. Conv. 188, n. (a).

(l) Vide *ante*, Chap. IV. pp. 66, 68.

(m) See respecting the difference between a licence and a grant, 15 Vin. Abr. tit. Licence (A).

or only some particular portion of it, or to use it only for some particular purpose.

Licences
revocable or
irrevocable.

Licences are sometimes made revocable, and are sometimes expressed to be irrevocable. If a licence be granted generally, without expressing it to be irrevocable, it may be doubtful whether it could be revoked or not (n). But if, from an examination of the whole of the instrument, it appears that the parties must have intended the licence to be irrevocable, the licensee would be entitled to retain his licence notwithstanding any attempt by the patentee to revoke it.

Revocation how
to be made.

The revocation of a licence, it seems, ought to be by instrument under the hand and seal of the patentee, for it is a general rule that a deed cannot be altered or varied except by deed (o). But that does not prevent the parties to a licence from providing for the determination or cesser of the licensee's privilege, either by notice, or in any other manner, without the solemnity of a deed.

Exclusive
licence.

An exclusive licence is sometimes granted by a patentee for the whole or some particular part of the invention, and for the whole or some particular part of the kingdom comprised in the patent. Such a licence vests in the licensee the sole right to exercise the patent privilege, or that particular part of it to which the licence extends.

Usually con-
tains a covenant
not to grant
any other
licence, &c.

Doubtful
whether it
divests the
patentee of
power to grant
a licence incon-
sistent with it.

Exclusive
shows that
licensee
is to have the
sole right.

An exclusive licence usually contains a covenant by the patentee, that he will not grant any other licence to interfere with the licensee's privilege. But it is doubtful whether such a licence or covenant divests the patentee of all power to grant a licence contrary to his covenant, although he would clearly render himself liable to an action, if he were to grant a licence contrary to his covenant.

Unless the patentee retains a right to use the invention himself, an exclusive licence for the entire term of the patent shows that the parties to it intended the licensee to have the *sole* right to exercise either the whole or some particular portion of the privilege comprised in the patent; and also, that the patentee should not have power to grant any other licence to use the

(n) See *Wood v. Ledbitter*, 9 Jur. 187.

(o) See Noy, Max. p. 4, dial. ten, p.

45; *Winter v. Foweracres*, 2 Rol. R. 39; *Thompson v. Brown*, 7 Taunt. 656,

read the cases there cited.

patent privilege, or the portion of it which is comprised in the licence.

The whole of the patentee's interest in the patent privilege, or in a particular portion of it, is therefore intended to be vested in the licensee; and if there is nothing in the licence to indicate an intention to the contrary, it would seem that the instrument ought to be construed as amounting to an assignment of the whole or of that part of the patent privilege which is comprised in it.

If the whole of patentee's interest is vested in the licensee, the licence will amount to an assignment.

And if the licence contains no reservation to the patentee, or any condition to avoid the licence, the sole right vested in the licensee must have been intended to be indefeasible, and there would be nothing which could render it necessary that the patentee should continue even in the nominal possession of the patent privilege, or of that part of it which is comprised in the licence.

If there is no reservation, it is unnecessary that patentee should continue possessed of the privilege.

It seems that such an exclusive licence operates as a grant of the whole, or of some particular part, of the patent privilege; and that it amounts to an assignment to the licensee, in the same way that a demise by a lessee of the premises comprised in his lease for the whole of the term granted to him, amounts to an assignment to the under lessee (*p*). For an assignment is a transfer or making over to another of the whole right of the assignor in the thing transferred (*q*); and any words which show a sufficient intent to transfer that part of the patent privilege would be sufficient to cause an instrument to operate as an assignment (*r*).

An exclusive licence seems to operate in the same way as a demise by a lessee for the whole of his term.

It was determined in the case of *Protheroe v. May* (*s*), that an exclusive licence granted to more than twelve persons does not invalidate the patent under the condition against assigning to more than twelve persons. But there were reservations to the licensees made by the licence in that case, and also provisos for determining the licence, from which it is to be inferred that the parties did not intend the instrument to operate as an assignment, and if it did not operate as an assignment, it could not affect the validity of the patent. The reservation of a sum of 2*l.* for every ton of soap made by the

Protheroe v. May.

Exclusive licence to more than twelve persons will not avoid a patent if the licence does not amount to an assignment.

(*p*) See *Palmer v. Edwards*, 1 Doug. 187, n.; *Parminter v. Webber*, 8 Taunt. 593; 2 B. Mo. 656; Shep. Touch. 266.

(*q*) 2 Bl. Com. 326.

(*r*) Vide *ante*, s. 2, p. 235.

(*s*) 5 M. & W. 675.

licensees in that case *during the continuance of the licence*, shows that the intent of the parties was, that the instrument should operate as a licence and not as an assignment; and indeed the payments to be made by the licensees, shows that they were not to be entitled to divide the profits to be obtained by reason of the patent, in such a way as to bring them within the meaning of the condition against an assignment to more than twelve persons.

An exclusive and irrevocable licence to more than twelve persons, extending to the whole of the privilege would be such an assignment as would render the patent void.

An exclusive licence extending only to a part of the privilege would not render the patent void.

Whether a licence can be assigned without an express power.

Licences to licensees, their executors, &c., assignable.

An exclusive and irrevocable licence to use a patent invention, and extending to the whole of the district comprised in the patent, would, it seems, amount to an assignment of the whole of the patent privilege for the reasons already given (*t*), because the licensee would obtain the whole right which was vested in the patentee. And if such a licence, or rather assignment, were made to more than twelve persons, it seems that the effect of it would be to avoid the patent (*u*).

But such a licence granted only for a part of the invention comprised in the patent privilege, or for a portion of the district comprised in the patent, does not seem to be in violation of the condition in the patent, even if it should amount to an assignment, for the licensees or assignees would not be entitled to divide the profits or benefits arising from the whole of the patent privilege amongst themselves, nor would they be entitled as partners with the patentee or grantor of the licence to divide the profits arising from the privilege within the meaning of the condition in the patent.

We have seen that the privilege granted by a patent could not be assigned unless it was made assignable by the patent itself (*x*). And it seems that the same rule is applicable to a licence granted under the authority of the patent. For a licence merely grants a power, or dispenses with a right or remedy, and therefore confers a mere personal right upon the licensee which cannot be transferred to any other person, unless the grantor in the instrument itself makes the privilege which he grants assignable.

Licences are, however, frequently granted to licensees, their executors, administrators, and assigns, and then they become of course assignable and transmissible in the same way as a

(*t*) Vide *ante*, p. 241.

(*u*) Vide *ante*, s. 2. p. 236.

(*x*) Vide *ante*, s. 2. p. 234.

patent privilege (*y*). And it would seem that the assignment of a licence, like the assignment of a patent, ought to be made by deed under hand and seal.

There does not appear to be any restriction with respect to the consideration for which a licence to use a patent privilege may be granted. A deed in itself imports a consideration (*z*), and as a licence must be granted by deed, it seems that no consideration is necessary to render it valid (*a*). Nor does the grant of such a licence seem to be within the meaning of the statutes of 13 Eliz. c. 5, and 27 Eliz. c. 4.

A patentee, however, generally receives a consideration of some description for the grant of a licence, and frequently reserves an annual or periodical payment, either of an amount certain, or varying according to the extent to which the licensee may use the invention.

A licence usually contains mutual covenants between the patentee and licensee. If a consideration is paid for the licence the patentee usually enters into covenants respecting his right to grant the licence, and frequently also respecting the validity of the patent (*b*).

If a licence contains no express covenant by the patentee, the words give and grant usually inserted in the instrument, will not, it seems, import a covenant in law by him, that he had good right to grant the privilege expressed in the instrument, for it is laid down in our law books (*c*), that the law will not create a covenant respecting a personal thing. And the privilege granted by a patent being limited to the patentee, his executors, administrators and assigns, it has the nature of personalty impressed upon it.

Therefore, in all cases in which a licensee intends to have the benefit of covenants by the patentee for his title to grant the licence, care should be taken to insert express covenants to the effect intended by the parties (*d*). And in some cases licensees are fairly entitled to such covenants, especially where

(*y*) As to the assignment of a patent, see in this Chap. s. 2, p. 234, *ante*.

(*z*) See Plowd. 308.

(*a*) The proviso in a patent, stated, *ante*, p. 66, declares that nothing in the patent contained shall prevent the granting of licences in such manner, and for such considerations, as they

may by law be granted.

(*b*) See the Form in the Appendix.

(*c*) See Com. Dig. tit. Covenant (A 4).

(*d*) See the Form of a Licence in the Appendix, Chap. II., which contains the usual covenants for title by the patentee.

being themselves without the means of ascertaining the validity of the patent, they may, on the faith of the licence and the validity of the patent, embark considerable capital in business for the manufacture of the patent article.

Covenants by licensees.

When a licence is granted in consideration of periodical or other payments, it usually contains covenants on the part of the licensee with the patentee to pay the sums reserved. And where the payments reserved are to vary according to the extent to which the licensee shall use the privilege, the licence also contains covenants by the licensee to render accounts, to be properly verified, and sometimes to permit periodical inspections of premises, machinery, &c. And in cases where payments are reserved, and covenants are entered into by the licensees, it is usual to insert conditions avoiding the licences if the licensee shall fail to pay any of the sums reserved, or to perform any of the covenants (e).

Conditions for avoiding licences.

Covenants and conditions are absolutely necessary for the protection of the patentee.

The covenants on the part of the licensee and proviso for avoiding the licence, are indeed absolutely necessary for the security of the patentee in all cases where there are any payments reserved. If a licence be assignable, the licensee might after assigning his licence become insolvent or quit the country, so that the patentee could not have any remedy against him for the non-payment of the reservations contained in the licence. And as the assignee would not be bound by the covenants of the licensee (f), the patentee would have no remedy against him in a Court of Law, and would be driven to have recourse to a suit in Equity.

Provisions for proceedings to protect the patent.

In an exclusive licence the licensee should take care to make provision for proceedings to be taken against persons who may infringe the patent. The licensee himself could have no adequate remedy without the assistance of the patentee, unless the exclusive licence could be construed to amount to an assignment. It is usual in exclusive licences for the patentee to covenant with the licensee to proceed against persons who infringe, or to permit the licensee to do so in the patentee's name (g).

Licensee cannot dispute the

We have seen (h), that a patentee cannot, as between him-

(e) See the covenants in a Form of Licence contained in the Appendix.

(f) See 5 Co. R. 16, b, and 17, a.

(g) See Forms in the Appendix.

(h) Vide *ante*, p. 236, and the case of *Oldham v. Langmead*, cit. 3 T. R. 439.

self and a person to whom he has assigned his patent, be permitted to question the validity of the patent. And it has been held that the same doctrine is applicable as between a patentee and his licensee (i).

validity of patent.

Whenever a licence is about to be granted, the parties should determine whether the licensee is to be at liberty to question the validity of the patent or not, and care ought to be taken that the instrument is framed accordingly.

If the deed of licence contain recitals or statements which amount to admissions, that the patent is valid in any respect; such as—that the patentee was the true and first inventor, that the invention was new, or useful, or that the specification was sufficient, the licensee will be bound by estoppel not afterwards to deny that the patent is invalid for anything which is contrary to what is asserted by the deed (k).

Licensee estopped by statements in licence.

And it does not signify whether the matter of estoppel is stated by way of recital or otherwise, if the words appear to be the words of the party who is sought to be bound by estoppel. And when a person is thus estopped or prevented from asserting anything contrary to his admission under his hand and seal, the estoppel is conclusive in a Court of Law, if properly pleaded by the other party. But if a patentee joins issue upon an allegation made by a licensee contrary to an admission in his deed, instead of pleading the estoppel, the deed will be *evidence* for the patentee, but will not as evidence be *conclusive* (l).

Estoppel may be by recital.

A licensee who has paid an annuity in consideration of a licence, to use a patent privilege which afterwards turns out to be void, cannot however recover back the money he has paid in an action for money had and received (m). But if a licensee is not estopped by his deed from disputing the validity of the patent, he may, in answer to an action of covenant for money reserved by the licence, plead anything which shows that the patent is void. This was decided in the case of *Hayne v. Maltby* (n); and although some doubt was expressed

Licensee cannot recover back payments he has made. But if not estopped, may dispute the validity of the patent in an action for money reserved by the licence. *Hayne v. Maltby.*

(i) *Baird v. Neilson*, 8 Cl. & Fin. 726. 295.

(k) *Bowman v. Taylor*, 2 A. & E. 278.

(m) *Taylor v. Hart*, 1 N. R. 260.

(n) 3 T. R. 438.

(l) *Bowman v. Rostron*, 2 A. & E.

by the Court of Queen's Bench respecting the authority of that case in *Bowman v. Taylor* (o), yet it is conceived that the only doubt is whether the defendant, in *Hayne v. Maltby*, was not estopped from denying the validity of the patent, not whether he might not set up the invalidity of the patent as an answer to the action in case he was not estopped.

Chanter v.
Leese.

And in the case of *Chanter v. Leese* (p), it appeared that a licence had been granted to the defendants by a memorandum of agreement, (not under seal,) to use the inventions comprised in several patents, a yearly payment of 400*l.* being reserved. In an action to recover a half-yearly payment of the 400*l.*, the defendant pleaded that the invention comprised in one of the patents was not new, and the Court held the plea to be a good answer to the action. No notice seems to have been taken in that case of another ground of defence, of which the defendants might have availed themselves. The licence being by memorandum only, and not under seal, was void (q); and therefore the defendants had no consideration for the payment of the tribute money reserved by the licence (r).

A patentee ought never, therefore, to grant a licence by any instrument not under seal; because the licensee might, in answer to any action for money reserved by the patent, plead that the instrument was not under seal, and therefore void.

SECTION IV.

Of the Surrender of a Patent.

Patentee may
surrender his
privilege.

A PATENTEE or his assignee may also dispose of his patent privilege by a surrender to the Crown; and the effect would be to extinguish the privilege.

If there are several patentees or assignees, they must all join in making a surrender; but it is conceived that a joint patentee or assignee might surrender his part of the patent.

The surrender of a patent must be made by deed, enrolled

(o) 2 A. & E. 278.

(p) 4 M. & W. 295.

(q) But see *Chanter v. Dewhurst*, 12

M. & W. 823.

(r) See *Bird v. Higgenson*, 2 A. & E. 696; and *id S.C.* in error, 6 A. & E. 824.

in Chancery (s). A surrender is of no effect until it is enrolled, even if the patent be cancelled (t), for the rule of Law is, that nothing can be conveyed to the Queen except by matter of record (u).

(s) See Com. Dig. Pat. (G), and the authorities there cited.

(t) Com. Dig. Pat. (E) (G).

(u) Noy, Max. p. 18, dial. ten, p. 34.

CHAPTER X.

OF THE REMEDIES FOR PATENTEES, AND FOR THE PUBLIC
RESPECTIVELY.

- SEC. I.—*Of the various Remedies provided by Law for Patentees and the Public.*
- II.—*Of an Action for the Infringement of a Patent.*
- III.—*Of a Suit in Equity to restrain the Infringement of a Patent, and obtain an Account of Profits.*
- IV.—*Of an Action for Penalties for counterfeiting a Patentee's Name or Device.*
- V.—*Of other Remedies for Patentees.*
- VI.—*Of an Action of scire facias to repeal a Patent.*
- VII.—*Of the Revocation of a Patent.*

SECTION I.

Of the various Remedies provided by Law for Patentees and the Public respectively.

Patent privileges worthless without legal remedies.

Patent privilege entirely dependent upon the law.

Imperfections in remedies for patentees.

Cause of imperfections.

It is evident that a privilege, such as that granted by a patent for an invention, would be worthless if the law did not provide some remedy for the patentee against those who may invade it. The right to any species of corporeal property may to a great extent be vindicated by the physical means at the command of the owner; but with respect to an incorporeal chattel right, such as a patent privilege, which is a mere creature of the law, the proprietor must depend almost entirely upon the law itself for vindication and support.

It is to be regretted that the remedies which the law has provided for patentees are very imperfect, and insufficient for the protection of their rights from invasion.

Many of the imperfections of those legal remedies, however, have arisen from the peculiar nature of patent rights,

and the difficulty of providing adequate remedies for patentees without producing too great an invasion of the rights of the public. We have seen (a), how much doubt and uncertainty has prevailed as to what can be made the subject of a patent privilege, and there has been nearly as much uncertainty (b) respecting the degree of novelty, and the utility which an invention must possess in order to support a patent. When the existence of so much perplexity and confusion in the law respecting the nature and effect of patent privileges is remembered, it cannot be considered extraordinary that the remedies provided for patentees and the public are very far from being perfect.

Doubts respecting subject of privileges.

Many of the grievances under which patentees formerly laboured have been recently removed by the legislature (c), and others have ceased to exist since our Courts have begun to construe the law more liberally in favour of patentees.

Several of patentee's grievances removed.

In former times slight defects were held sufficient to avoid patents, and our Courts seemed always to look upon patent rights with the utmost jealousy. This feeling against patentees was doubtless produced by the widely spread and deeply rooted aversion to all monopolies which was engendered by the monstrous oppression practised by means of patent grants previous to the passing of the Statute of Monopolies. That statute completely suppressed all unlawful grants, and most effectually guarded the rights of the public against illegal monopolies; but notwithstanding the securities which the statute provided for the public against illegal monopolies, it is singular enough that a period of two centuries should have elapsed before the public prejudices against grants of patent privileges to inventors disappeared, and before the Judges began to determine questions respecting patent rights fairly between the patentees and the public.

Public feeling against monopolies formerly extended to patents.

Statute of Monopolies suppressed illegal grants.

Two centuries required to extinguish public feeling against patent privileges.

Our Courts now universally adopt the principle laid down by Lord *Eldon*, L. C., in the case of *Cartwright v. Eamer* (d), that a patent contains a bargain made between the public (represented by the Crown) and the patentee, to be judged of

Principle that patent a bargain to be judged of as other bargains now adopted.

(a) Vide *ante*, Chap. V. sec. 1, p. 77.

(b) Vide *ante*, Chap. V. ss. 2 & 3, pp. 102, 149.

(c) See 5 & 6 Will. IV. c. 83; 2 & 3 Vict. c. 67; and 7 & 8 Vict. c. 69.

(d) 14 Ves. 131, 136.

like other bargains. And accordingly any question which may now arise respecting the validity of a patent for an invention will be determined fairly and impartially between the parties in litigation, and without any strained or strict construction being put upon the law, or patent, in favour of or against either party.

Patents formerly failed chiefly by reason of insufficient specifications.

Specifications formerly very imperfect.

Specifications now much more perfect.

If the reported patent cases which have been decided in our Courts of Law are examined, it will be found that in a great majority of those which were formerly determined against patentees, the parties failed to support their patents on the ground of the insufficiency of their specifications. And, indeed, if we look at the vague and meagre descriptions of their inventions which patentees were formerly in the practice of inserting in their specifications, we cannot be surprised that our Courts should have held that those instruments did not sufficiently comply with the conditions or provisos contained in patents by which they are required to be enrolled.

But the decisions of our Courts avoiding patents on the ground of insufficient specifications, have been productive of great benefit to the public, and indeed to patentees themselves. For specifications are now drawn in a manner much more perfect than they were formerly, (although there is still room for very considerable improvement), and consequently not only are the public now more frequently put in possession of the information they are entitled to receive, but patentees much less frequently fail to support their patents, on the ground of the insufficiency of their specifications.

Remedies for patentees.

The chief remedies of which a patentee may avail himself in case his privilege is invaded, are, an action at Law, and a suit in Equity, against the violators of his privilege, both or either of which he is at liberty to adopt.

Action at law.

By an action at Law a patentee may recover, from a person who has violated his patent, damages for the injury which he has sustained by the violation of his right. In a suit in Equity, the patentee may not only compel a person who has infringed his privilege to account for all the profits which he has made by the piracy, but may also obtain an injunction, restraining the guilty party from again infringing the patent.

Suit in equity.

Action for penalties.

Patentees are also enabled by the statute of 5 & 6 Will. IV.

c. 83, s. 7, to maintain actions for penalties against those who may counterfeit any names or devices upon their patent articles.

The remedies which the law provides for the public against illegal patents are twofold:—*firstly*, Any one against whom proceedings may be taken by a patentee, is enabled to defeat the action or suit by showing that the patent in question is void; and, *secondly*, Any person prejudiced by an illegal patent is entitled, upon certain terms, to bring an action, called an action of *scire facias*, in the name of the Queen, against the patentee or his assignee, for the purpose of repealing the patent.

Remedies
against
patentees.

Patents always contain a proviso under which they may be avoided by the Queen or her Privy Council, if they are found to be contrary to law (*d*).

SECTION II.

Of an Action at Law for the Infringement of a Patent.

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

Infringement
entitles
patentee to an
action for
compensation.

Such injuries are in law technically denominated *torts*, but as the wrongful act is not committed with any direct force or violence, and the injury is only the indirect effect of the wrongful act of the defendant, the form of action which a patentee can maintain is that description of action of *tort* called an action of *case*, or *trespass on the case* (*f*).

Form of action.

In such an action, the patentee or other party in whom the legal right to the patent privilege was vested at the time of the infringement, must be made plaintiff, and the person who has directly or indirectly committed or authorized the alleged wrongful act must be defendant.

Parties to
action.

A patentee who has not assigned any part of his privilege must be the sole plaintiff. But if a patentee has assigned over to another the whole of his privilege, he ceases to have any interest, and cannot maintain an action for the infringe-

Who to be
plaintiff.

(*d*) See the condition, *ante*, p. 62, and in the Form of Patent in the Appendix, Chap. II. s. 1.

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

(*f*) See Chit. on Pl. Vol. I.

ment of the patent. And if a patent be assigned to a single person, he alone must be plaintiff in an action for infringing it; and the patentee cannot be made a co-plaintiff, for he has ceased to have any interest in it. If there are several patentees, they may all join in bringing the action; and if a patentee has assigned a part only of his patent right, he and his assignee may be joined as plaintiffs in any action for infringing the patent (*h*).

And if a patent has been assigned in several shares, all the assignees may join in bringing an action; and it is conceived that it makes no difference whether the title of the several assignees accrues to them by only one or by several deeds. But it has never been decided whether one of several patentees, or an assignee of a portion of a patent privilege, can sue alone for the damages which he has sustained by the infringement of the patent. There does not seem to be any good reason why such a part proprietor should not be able to sue alone, although the language of the Court of King's Bench in a somewhat similar case (*i*) seems to be an authority to the contrary.

Executors and administrators.

If a patentee dies during the existence of his patent right, we have seen that his interest vests in his executor or administrator (*h*), and the executor or administrator will of course have the same right to an action for an infringement of the patent as the deceased patentee had, or would have had, if living. If there are several executors, all must join in bringing an action, for a probate obtained by one of such executors inures to the benefit of all (*l*). If there are several administrators, they must all be joined as plaintiffs in the action.

Assignees of a bankrupt or insolvent patentee.

The assignees of a bankrupt or insolvent patentee may maintain an action for a violation of his patent right (*m*); for, as we have seen (*n*), the whole of the bankrupt or insolvent patentee's interest passes to his assignees by virtue of their appointment. All the assignees must of course join in bringing any action.

(*h*) See *Boulton & Watt v. Bull*, 2 H. Bl. 463, and several subsequent cases in which patentees and assignees have joined in bringing actions.

(*i*) *Weller v. Baker*, (Case of Dippers, at Tunbridge Wells,) 2 Wils. 423.

(*k*) Vide *ante*, Chap. IV. p. 58; Chap. IX. s. 237.

(*l*) See *Williams's Law of Executors*.

(*m*) See the case of *Bloxam v. Elce*, 1 C. & P. 558; 6 B. & C. 169.

(*n*) Vide *ante*, Chap. IX. s. 2, p. 238.

It has never been decided whether the assignees in Law of a proprietor of part of a patent privilege can be joined as plaintiffs with the other proprietors, but there seems to be no reason why they should not.

The action may be brought against several defendants, where they have been guilty of any joint act of infringement, but not otherwise. And if several persons have been guilty of a joint infringement, the plaintiff may, at his election, sue all or any number of them at his election (o). Who may be made defendants.

The declaration (p) usually commences with an averment, that the patentee was the true and first inventor of the invention comprised in his patent, and that it was a new invention. Such an introductory averment does not, however, seem to be essential; and it is sometimes omitted, particularly when brevity is desired. The declaration then states the grant contained in the patent upon which the defendant is sued, and that may be done either by setting out the operative words of the patent, or by stating the effect of the instrument as a grant to the patentee and a prohibition to all other persons. Declaration.

In declaring upon a patent it must be shown under what seal it was made (q). English patents for inventions granted since the union with Ireland, must have been made under the Great Seal of the United Kingdom (r). A declaration upon such a patent therefore describes it as "letters patent under the Great Seal of the United Kingdom of," &c. (s). English letters patent are always dated at Westminster, (being the place where the Court of Chancery usually sits,) and of the day they are sealed with the Great Seal. A declaration therefore usually describes the patent to bear date at Westminster, of the day upon which they purport to be made. A date is not necessary to the validity of a patent (t), but if it be not dated, the plaintiff, in declaring upon it, must show when it was made, for otherwise it would not be certain whether the Act complained of as an infringement was done within the term granted by the patent. In such a case the plaintiff may have recourse to the writ of Privy Seal and *recepti*, the enrolment Must show under what seal patent made.

Date or time of making must be stated.

(o) 1 Saund. 291, e.

(p) See the Forms of Declaration, *post*, Appendix, Chap. II. s. 4.

(q) Com. Dig. Pat. (H).

(r) See *R. v. Bullock*, 1 Taunt. 71 ;

R. v. Yandell, 4 T. R. 521.

(s) See the Form of Declaration in the Appendix, Chap. II. s. 4.

(t) Plowd. 231; Vin. Abr. prerog. (G. b, 3).

of the patent, and the docket paper, and state the time of the making of the patent as accurately as possible. In ancient times the clerks in Chancery not unfrequently omitted the dates of letters patent, but such mistakes are now of very rare occurrence.

Profert.

In declaring upon letters patent it is necessary to make profert of them, that is, to make an offer to prove what the plaintiff is about to state respecting the effect of them, by producing and showing them to the Court (u). If profert be omitted, the declaration will be bad on special demurrer; and before the statute 4 & 5 Ann. c. 16, the omission was a good cause of general demurrer (x).

Statement of specification.

An action is never brought for the infringement of a patent until after the invention has been specified; and as the general language of the title gives little or no information respecting the real nature of an invention, if such an action were to be brought before specification, it is most probable that a jury would not give him a sufficient amount of damages to carry costs. The time for specification then having passed before the commencement of the action, it seems that the plaintiff must show that he has performed the condition of the patent, which requires him to enrol a specification (y); and therefore the declaration in such an action always states in what manner the patentee has complied with that condition. It is not, however, usual to set out the specification in the declaration at full length, but merely to allege that the patentee has, in pursuance of the proviso contained in the patent, described the invention by an instrument under his hand and seal, and has caused that instrument (which is commonly called the specification) to be enrolled in Chancery, within the time limited by the patent.

Not usual to set out specification at length.

In some cases desirable, if not necessary to set out the description.

In some cases, however, it is desirable, if not necessary, to set out the description of the invention contained in the specification; as, for instance, where there has been a disclaimer or memorandum of alteration filed and enrolled under the statute 5 & 6 Will. IV. c. 83, s. 1, which perhaps could not be understood without reference to the specification.

(u) Dyer, p. 29, b, pl. 199, and p. 54, a, pl. 17; 10 Co. 94, b.

(x) Dr. Leyfield's case, 10 Co. R. 88, a, 94, b.

(y) See per Tindal, C. J., in *Mentz v. Foster*, 1 Dowl. & Low. 742, and Com. Dig. Pleader, C. 62.

Although a specification is an instrument under hand and seal, yet it is not a deed, nor is it an instrument of which the plaintiff need to make profert in his declaration. Profert of specification not necessary.

When any part of the title or specification has been disclaimed or altered under the statute 5 & 6 Will. IV. c. 83, s. 1, the disclaimer or memorandum of alteration must be stated in the declaration, for the statute provides that the disclaimer or memorandum of alteration shall be deemed and taken to be part of the patent or specification. Statement of disclaimer or alteration.

If the plaintiff, or any one of several plaintiffs, claims under an assignment of the patent declared upon, the assignment must be stated in the declaration, so as to show his title to the patent right. An assignment, we have seen, must be made by deed (*z*), and should be so stated in the declaration. But the omission to state that an assignment was made by deed is only matter of form, and is aided after verdict (*a*). And when an assignment by deed is pleaded in the declaration, the plaintiff must make profert of it in the ordinary way (*b*). Statement of assignment.

If the action is brought for an infringement of a new patent, granting an extension of the original term, the declaration must, of course, set out the new patent, or state the effect of it. But it seems that it is not necessary in such a case to allege in the declaration that the grantee of the new patent has complied with all the preliminaries required by the statute 5 & 6 Will. IV. c. 83, s. 4; and that if the patentee has not complied with them, the defendant must plead the non-compliance with the statute in defence to the action (*c*). Declaration upon a patent for the prolongation of a privilege.

The plaintiff's title to the privilege he claims, having been shown by stating the patent, the specification and the assignments (if any) under which he claims, and also any disclaimer or memorandum of alteration varying his privilege, he must next show in respect of what injury he complains against the defendant. This is done in that part of the declaration called the breach, in which the plaintiff points out the particular breach of duty committed by the defendant. Breaches.

It was formerly the practice to insert several counts in a declaration upon a patent, each count alleging the infringement. Formerly usual to insert several counts in a declaration.

(*z*) *Ante*, Chap. IX. s. 2, p. 234.

(*a*) *Keene v. Cornish*, MS.

(*b*) See the Forms of Declaration in

the Appendix, Chap. II. s. 4.

(*c*) See *Russell v. Ledsam*, in the Exchequer; but not yet reported.

Several breaches now inserted.

Allegation of time in breach.

Breach in a declaration after a disclaimer.

Perry v. Skinner.

Breach in a declaration after an assignment.

Chose in action cannot be assigned.

ment in a different form. Since the pleading rules of H. T., 4 Will. IV. 1834 (*d*), it has not been usual or proper to insert more than one count in a declaration for infringing a patent, but a plaintiff is at liberty to insert as many breaches as he pleases, and it is usual to allege several (*e*).

In every breach the wrongful act of the defendant is alleged to have been committed after the making of the patent, and within the term of years which it grants, and this is necessary because the allegation of time in the breach is immaterial, and therefore it would not sufficiently appear, that the alleged grievance was committed during the existence of the patent, unless there was an express allegation to that effect, and without such an allegation, the breach would be bad on special demurrer.

If there has been any disclaimer or alteration of any part of the title or specification, the plaintiff ought generally to allege in every breach, that the grievance was committed after the disclaimer, or memorandum of alteration, was enrolled under the provisions of the statute. For if the disclaimer or memorandum of alteration shows that, until it was enrolled, the patent was void, the defendant could not be liable to an action for any infringement committed before the enrolment.

Thus in the case of *Perry v. Skinner* (*f*), where the patentee had disclaimed part of the invention described in the specification, the Court of Exchequer held that the defendant was not liable for any infringement committed by him before the enrolment of the disclaimer, although the part of the invention which he had infringed had not been disclaimed.

So also if the plaintiff, or any one of several plaintiffs, is an assignee, it should be alleged in the breaches that the infringements were committed after the making of the assignment under which he claims; for an assignee cannot recover damages for any infringement of a patent prior to the time when his title accrued to him by virtue of his deed of assignment, which, we have seen, must be stated in the declaration (*g*). And even if the assignment of a patent were also to contain an assignment of the patentee's right to damages for infringements committed prior to the assignment, the

(*d*) See Charn. N. R. 125.

(*e*) See the various Forms of Breach in the Appendix, Chap. II. s. 4.

(*f*) 2 M. & W. 471.

(*g*) *Ante*, p. 255.

assignees could not recover such damages in an action at Law, for the assignment of such a *chose in action* would be held to have no operation in a Court of Law, whatever it might have in a Court of Equity.

The wrongful acts stated in the breaches are always alleged to have been done, not only "wrongfully and injuriously," (as in all actions on the case), but also with the intent to deprive the plaintiff of "the profits, benefits, and advantages which he might and otherwise would have derived and acquired from the making, using, exercising, and vending his invention." This is done, because it is necessary to show, on the face of the declaration, that the acts complained of were not only wrongful; but also that they were injurious to the plaintiff by depriving him of the profits of his invention. But it is unnecessary to prove this allegation of intent to injure the plaintiff further, than by giving evidence of the acts of infringement complained of; for every person must be presumed to be aware of the existence of the patent, and to intend what must necessarily be the effect of the wrongful acts which he is about to commit.

Breach alleges acts to have been done wrongfully and to deprive patentee of his profit.

Every breach must also show that the acts complained of were done without the licence of, and against the will of, the patentee, or those claiming under him, because the patent only prohibits those from using the invention who have not the licence, consent, or agreement, of the patentee, his executors, administrators, or assigns.

Must show that wrongful acts were done without licence.

A person is guilty of a breach of a patent privilege when he has directly or indirectly used the art or invention which has been made the subject of the privilege, or applied it in any way for his own profit or benefit. And if the defendant has employed means only colourably different to produce the same or a similar result, yet he is guilty of an infringement if he has in fact used the art which is the subject of the privilege. The nature of the art or invention which can be made the subject of such a privilege has been considered in a former part of this work (g), and it is always necessary to determine what is the subject of the privilege comprised in a patent, in order to see whether the defendant has committed a breach of the

What is a breach of a patent privilege.

(g) *Ante*, Chap. V. s. 1, p. 77.

privilege. It is a very common mistake to confound the purposes or objects of an invention with the art or invention itself. And it frequently happens that the use of the produce of an art or invention is erroneously deemed to be the use of the art or invention itself. To be an infringement of a patent privilege, the defendant's act must be either a use of the art invented by the patentee, or a fraudulent imitation of it, made for the purpose of evading the privilege, and not such a distinct art or invention as would be sufficient to support a patent (*h*).

Breaches usually alleged in terms of granting, and prohibitory parts of patent.

It is usual in declarations for infringing patents to allege breaches in the terms of the granting and prohibitory parts of the patent; that the defendant did "use," "exercise," or "put in practice" the invention, or some part of it; or did "make" articles according to the invention, or some part of it; or did "vend" or sell such articles; or did "counterfeit," "imitate," or "resemble" the invention; or make some "addition unto," or "subtraction from," the invention, "whereby to pretend himself the inventor or deviser thereof" (*i*). And in the case of *Minter v. Williams* (*k*); it was laid down by the Judges of the Court of Queen's Bench, that this is the proper mode of alleging the breaches of a patent.

Signification of the word invention in a breach.

When it is alleged in a breach respecting an infringement, that the defendant has used, exercised, or practised *the plaintiff's invention*, the word invention must be understood in the sense in which it is used in the patent (*l*); that is, as signifying the art which has been invented by the patentee, and which has been made the subject of the privilege comprised in the plaintiff's patent.

If alleged act not an infringement, defendant may demur.

If the plaintiff alleges a supposed wrongful act in a breach which does not, *as alleged*, amount to an infringement of the patent, the defendant may demur to the breach.

Minter v. Williams.

Thus, in the case of *Minter v. Williams* (*m*), the plaintiff

(*h*) The various acts which amount to infringements of patent privileges are more particularly examined in Chap. XI. respecting the evidence upon a plea of not guilty.

(*i*) See the various forms in the Appendix, Chap. II. s. 4; and the evidence

to be given upon the plea of not guilty, *post*, Chap. XI. s. 1.

(*k*) 4 A. & E. 251; 1 Webs. R. 135, *infra*.

(*l*) Vide *ante*, Chap. V. s. 1, p. 91.

(*m*) 1 Webs. R. 135.

alleged as a breach, in one count of the declaration, that the defendant *exposed to sale* divers chairs which were intended to imitate and resemble, and did imitate and resemble, the plaintiff's invention. To this the defendant demurred, and the Court of Queen's Bench held, that the breach was insufficient, and gave judgment for the defendant.

For the defendant in that case, it was contended that the word vend in the patent meant to sell (*), or expose for sale, and several dictionaries were cited in order to show that the word vend has both these significations. It was also contended, that exposing to sale is comprehended within the words, "use" and "exercise," in the granting part, and the words "use or put in practice" in the prohibitory part of the patent. In giving judgment in this case, Mr. Justice Patteson said, "In drawing declarations for the infringement of a patent, pleaders have always used the words of the patent, either those in the granting or prohibiting part of it. I cannot doubt, for a moment, that there is a clear distinction between vending and exposing to sale, notwithstanding the authority of the dictionaries referred to. The plaintiff should in his declaration use the words either of the granting or prohibiting part of the patent. This is quite a new course of pleading to put in a word which does not occur in the patent. If the word vend really does mean 'to expose to sale,' as well as to 'sell,' the count should have charged the defendant with vending; and the act of exposing to sale might have been proved in support of it." Mr. Justice Coleridge said, "In the granting part of this patent the words are, 'make, use, exercise, and vend,' and then in the prohibiting part the words are rather different, for an obvious purpose; they are, 'make, use, or put in practice.' Now we are to see whether this count, either referring to the granting or prohibiting part, necessarily imports an offence. The words of the count are, that the defendant did 'wrongfully and unjustly expose to sale,' &c.; and it is said that these words necessarily import a vending within the granting part of the patent. It is argued that an exposing to sale is included within the meaning of the word 'vending'; but even upon

Vending and exposing to sale not the same.

(*) The sale of articles is commonly alleged as an infringement in patent actions.

that construction the court would be defective, inasmuch as the evidence instead of the words of the patent is put upon the record. It seems to me that 'vending' imports the habit of selling, and 'selling,' the act of sale. If we read the word 'vend' as expressly inserted in the prohibitory part of the grant (o), we ought only to give it there the meaning which would effectuate the purpose of the patent—the prevention of acts injurious to the patentee, with as little restraint on the public as possible. It must be taken here that the defendant has only exposed for sale; that whatever may have been his original purpose in so doing, or whatever motive has supervened, he has abstained from selling. Now I cannot say that such a mere exposure to sale is necessarily injurious to the patentee; it may, on the contrary, be very beneficial; it is not, therefore, necessarily the vending which is exclusively granted to him. As to 'using and exercising,' those words cannot be fairly resorted to, when we find with them (p) the word 'vending,' and that is passed by (q). But if they could the argument would be the same; this might be an innocent using and exercising, and so not prohibited."

Usual to allege a selling.

It has, however, been customary in some cases to depart from the exact terms of the patent in alleging breaches; thus it is usual to allege as a breach that the defendant did "sell" articles made according to or by means of the invention. And this seems to be sufficient, for a selling must clearly be a vending within the meaning of the patent (r).

Infringements must be alleged to have been in breach of the patent.

The infringements stated in a breach must also be alleged to have been committed in breach of the patent privilege, or, in the ordinary language of the forms, in breach of the said letters patent, and against the privileges thereby granted.

Allegations of breach are divisible.

The allegations contained in a breach are divisible; and a plaintiff may maintain his action, although he does not prove every thing alleged in a breach, if he proves such a part of it as actually amounts to an infringement of the patent. Thus,

(o) A patent grants to the patentee the sole right to "make, use, exercise, and vend" the invention; but in the prohibition to others it commands that they shall not "make, use, or put in practice," the invention, the word "vend," being in that part of the pa-

tent wholly omitted; vide *ante*, Chap. IV. pp. 52, 59.

(p) In the granting part of the patent.

(q) That is, passed by in the prohibitory part.

(r) Vide *ante*, Chap. IV. pp. 54, 55.

in *Gillett v. Wilby* (s), it was held, that an allegation that the defendant had imitated the plaintiff's improvements was a divisible allegation; and proof that the article made by the defendant imitated one of the plaintiff's improvements, was sufficient to enable him to support the action. *Gillett v. Wilby.*

At the end of the breach or of the breaches (if there is more than one) the plaintiff states the amount of damage which he has sustained by the wrongful acts of the defendant. It is usual to allege damage to a large amount, but the only object in so doing seems to be, not to prejudice the plaintiff's right afterwards to recover a large sum in Equity for the loss he has sustained; the amount of damages recovered in an action at Law being almost always merely nominal. Statement of damage.

If the plaintiff sues as an executor or administrator he must, at the end of the declaration, make a profert of his probate, or of his letters of administration, so as to prove his right to sue in his representative capacity. Profert of probate or administration.

In some actions, when the breaches in the declaration describe the alleged wrongful acts of the defendant in very general terms, the Courts will order the plaintiff to deliver to the defendant particulars of the breaches of contract, or wrongful acts of which he complains (t). The reason why the Courts order particulars in such cases is, that the defendant cannot know with certainty what the plaintiff intends to prove against him at the trial, and therefore may be unable to prepare for his defence, and liable to be taken by surprise at the trial. The power of the Courts to order such particulars is derived from their general jurisdiction over the proceedings before them, and not from the provisions of any statute. Acting upon this practice, the Court of Exchequer, in the recent case of *Perry v. Mitchell* (u), ordered the plaintiff to deliver to the defendant a particular in writing of the infringements on which he intended to rely. In that case, the action was for infringing two patents for improvements in pens, and the specification set forth and described thirteen different pens, containing an indefinite number of slits and adjustments. The declaration assigned as breaches, the making, &c., of pens and nibs, in imitation of parts of the invention, with Particulars of breaches or infringements.

(s) 9 Q. & P. 334.

books of practice.

(t) See Tidd's Practice, and the other

(u) 1 Webs. R. 269.

Perry v. Mitchell.
Particulars of infringements ordered to be delivered.

divers additions thereto and subtractions therefrom. Upon an affidavit for the defendant of the circumstances, and stating that inasmuch as neither the parts, nor the additions or subtractions were mentioned, it would be impossible to prepare the notice of objections to be delivered with the pleas, or to know what evidence to adduce; the Court made a rule absolute, ordering the plaintiff to deliver particulars of the infringements, and to specify and point out the particular pens, &c., in respect of which such infringements had taken place.

Plaintiff will not be ordered to produce a specimen.

But the Courts will not order the plaintiff to produce to the defendant a specimen of his patent article, for the specification gives all the information the defendant can require; and the effect of such an order would merely be to enable the defendant to ascertain the evidence which the plaintiff will produce at the trial (x).

Oyer.

R. v. Amery.

It has been laid down in all the modern books of practice, upon the authority of the case of *The King v. Amery* (y), that oyer of letters patent cannot be demanded. It will be observed, however, that it was not necessary to determine the point in the case of *The King v. Amery*, for the demand of oyer was too late, and therefore not admissible in that case. We have seen (z) that a plaintiff must in his declaration make profert of his patent; and the rule is, that a defendant is entitled to demand oyer of any instrument of which the plaintiff necessarily makes profert (a).

Defence to an action for an infringement.

A defendant in a patent action is at liberty to avail himself of two different kinds of defence to the action: *firstly*, he may deny that the plaintiff has any title to the privilege stated in the declaration, either on the ground that there is no such patent in existence as the plaintiff alleges, or that the patent is defective and void, and therefore the same as if there were no patent at all; and, *secondly*, he may deny that he has committed any infringement of the plaintiff's patent right. And every defendant may avail himself of both or either of these different lines of defence to a patent action.

Pleas in bar to declaration.

In order to defend himself in such an action, the defendant

(x) *Crofts v. Peach*, 2 Hodg. 110; 1 Webs. R. 268.

(y) 1 T. R. 149.

(z) *Ante*, p. 254.

(a) Tidd's Prac. c. xxiii. p. 586; and see the observation of Tindal, C. J., in *Muntz v. Foster*, 1 Dowl. & Low. 741, 742.

must state his grounds of defence in one or more pleas, which he pleads to the declaration (h) in bar of the plaintiff's claim to recover damages against him.

Before the pleading rules, made in pursuance of the statute 3 & 4 Will. IV. c. 42, s. 1 (c), the only plea used in patent actions was the plea of not guilty, under which the defendant might take any objection he pleased to the validity of the patent.

Not guilty formerly the only plea.

Since the pleading rules above mentioned (d) came into force (e), the plea of not guilty has ceased to have such an extensive effect as it had formerly; and that plea now merely amounts to a denial, that the defendant has been guilty of the wrongful acts complained of by the plaintiff in the breach or breaches alleged in the declaration, and does not raise any question respecting the validity of the patent.

Not guilty only denies the breach.

We have seen (f) that a patent is a record; and if it be pleaded by the patentee with a profert, (which supposes a production of the instrument, and showing it in open Court,) the other party cannot plead *nul tiel record* to it (g). Because the patent being in contemplation of law in Court at the time of pleading, it manifestly appears that there is a record; and therefore the defendant cannot be permitted to say that there is no record (h). In cases in which the plea of *nul tiel record* is admissible, the plaintiff has stated a judgment, or other matter which he has offered to prove *by the record* of it, the record not being in Court at the time, the plea in such case alleging that there is no record of the judgment or other matter alleged, and thus compelling the plaintiff to prove his allegation, by causing the record to be produced in Court. But the words "letters patent under the Great Seal," import an instrument which is and must be a record; and to say that there is no record of a patent, would be to say that there is no record of a record, which would be absurd.

Nul tiel record cannot be pleaded to a patent.

And if a patent be pleaded in the declaration with a profert, the defendant cannot deny it by saying that there is no

A patent cannot be denied, for the Great Seal proves itself.

(b) In a work of this description it is unnecessary to say anything respecting pleas in abatement. For information respecting such pleas see Com. Dig. tit. Abatement; Chit. on Pleading, vol. i.

(c) See Charnock's New Rules.

(d) Reg. Gen. H. T. 4 Will. IV. 1834.

(e) 15 April, 1834.

(f) *Ante*, Chap. IV. p. 36.

(g) 6 Co. R. 15, b; Doct. pl. 307, 308; Plow. 232.

(h) Co. Lit. 260, a.

patent (i). For the Great Seal (which must be attached to a patent) proves itself (k); and the patent being (in contemplation of Law) in Court at the time of declaring, it appears to the Court that there is a patent under the Great Seal, and therefore the defendant cannot be permitted to deny an allegation which the Court and the parties must see is perfectly true.

But the effect of the patent may be denied.

But a patent for an invention is in the nature of a grant as well as a record, and therefore the defendant is permitted to deny that it has the effect stated by the plaintiff in his declaration. The plaintiff must state the purport of the patent as a grant of privilege to the inventor, his executors, administrators, and assigns; and the defendant is permitted to deny the statement by a plea of *non concessit* (l), alleging in substance that the Queen did not make such grant as stated by the plaintiff, in manner and form as in the declaration mentioned (m).

Plea of *non concessit* may be pleaded to a patent for an invention.

Beddells v. Massey.

And if a plaintiff does not correctly set out the form or effect of his patent, the only way in which the defendant can object to the misstatement is by pleading a plea of *non concessit*. It was supposed by some persons that although *non concessit* might be pleaded to a patent granting land, &c., yet that it was inapplicable as a plea to a patent granting the sole use of an invention. The recent case of *Beddells v. Massey* (n) however decides that the plea is proper in a patent action. In that case the plaintiff obtained a rule *nisi* to strike out the plea of *non concessit*, on the ground that it could not be pleaded in a patent action; but after argument the Court of Common Pleas discharged the rule with costs. And in the case of *Bunnett and Corpe v. Smith* (o), a Judge at Chambers refused the defendant leave to plead this plea, but the Court of Exchequer afterwards held that the defendant ought to be permitted to plead the plea.

Bunnett v. Smith.

If a plaintiff have no such patent as he alleges, it may be denied by a plea of *non concessit*.

If a person should proceed by action upon a pretended grant of an invention by patent, when, in fact, no such grant was ever made, it is scarcely necessary to observe that the

(i) 4 Co. R. 71, b.; Doct. plac. 352; Plow. 232.

(k) Vide *ante*, Chap. IV. p. 36.

(l) Co. Lit. 260, a; Doct. plac. 307, 308; 4 Co. R. 71, b; 2 Rol. Abr. 191, b,

20; Dyer, 242, a.

(m) See the Forms of such Pleas in the Appendix, Chap. II. s. 4.

(n) 8 Jur. 808; 2 Dowl. & L. 322.

(o) 13 M. & W. 552.

defendant may show, by way of defence to the action, that there never was any such patent as alleged. The mode of doing this is by a plea of *non concessit* (*p*), by which the defendant denies that her Majesty did make such gift or grant of privilege as in the declaration alleged; and the plaintiff being thus put to the proof of the allegation contained in his declaration, he will fail at the trial if he cannot produce a patent containing the alleged grant of privilege.

The plea of *non concessit* seems, also, to be applicable in every case in which the patent was void *ab initio*, and therefore never had any operation as a grant (*r*). But if the patent was originally good, and only became void by matter subsequent, as the nonperformance of some condition contained in it, the plea of *non concessit* is inapplicable; for, although the grant may have become void, it could not be said that the Queen did not make such a grant.

Non concessit applicable whenever patent void, *ab initio*.

Cannot be pleaded if patent originally good.

It is a principle in law, that the Queen cannot be considered to intend wrong to any one; or, as it is sometimes expressed, the Queen can do no wrong (*q*). And the law provides that any patent which is contrary to law, or prejudicial to the public, shall be absolutely void, not only by virtue of the law itself, but as being contrary to the Queen's intent. To allow such a patent to be put in force would be contrary to the Queen's intention; and, therefore, the formal grant it contains is unavailing in a Court of Law, if the party proceeded against can show any valid objection to it. Every grant made by patent has this condition, either expressly or tacitly annexed to it;—that it shall not be contrary to law, or operate to the prejudice of her Majesty's subjects. And if the grant be contrary to this condition, it cannot be enforced against any person in any Court of Law or Equity.

Reason why a defendant is permitted to question the validity of a patent.

In an action brought upon a patent objections may be taken to it on three different grounds: *first*, that it is contrary to the express provisions of the Common or Statute Law; *secondly*, that the Queen has been deceived in some material particular, respecting the grant contained in the patent; and, *thirdly*, that some of the conditions or provisoes contained in the

Grounds upon which a defendant may take objections to a patent.

(*p*) See the Forms in the Appendix, Chap. II. s. 4.

(*q*) Vide *ante*, Chap. IV. p. 38.

(*r*) Vide *post*, p. 268.

patent have been violated (*r*). There are several objections, however, which may be taken to a patent on more than one of these three grounds, and some which may be taken upon all three of them.

Objections usually taken.

The principal objections usually taken to a patent are the following:—

1st. That the patentee was not the inventor or importer of the alleged invention.

2nd. That the title misrepresents or improperly describes the invention.

3rd. That the invention is not an invention of such a nature as may be made the subject of a patent privilege.

4th. That the invention was not new to the public at the date of the patent.

5th. That the invention is of no use to the public.

6th. That the patentee has not properly specified his invention.

Other objections may however be taken to the validity of a patent, some of which will be noticed hereafter.

Objection that patentee was not the inventor.

The first of these objections, *viz.*, that the patentee was not the inventor or importer of the invention, shows that a patent is void because the patentee was not a person who was capable of taking such a grant of privilege as comprised in the patent (*s*).

This objection to a patent invalidates it upon each of the three grounds already adverted to.

Patent can only be granted to an inventor.

According to both the Common Law and the Statute of Monopolies (*t*), the grant of the sole use of an invention can only be made to the person who is the true and first inventor of a new manufacture, or who first imports a knowledge of such a manufacture from abroad; and the Statute of Monopolies (*t*) avoids all such patent grants to any other person (*u*).

A false representation that patentee, the inventor, avoids the grant.

A patent always shows by the recital of the petition upon which it was founded, that the patentee represented that he was the true and first inventor of the alleged invention; or

(*r*) Vide *ante*, Chap. IV. p. 36, respecting the construction of patents.

(*s*) Vide *ante*, Chap. III. ss. 2, 3.

(*t*) 21 Ja. I. c. 3, s. 6.

(*u*) Vide Chap. III. *ante*, p. 21.

that he had acquired a know'edge of it from a foreigner residing abroad, and therefore was the importer of it into this country; and if the representation was untrue the Queen was deceived, and therefore her grant is void (x).

And every patent contains a proviso, that if the patentee was not the true and first inventor or importer (as the case may be) of the invention comprised in it, the grant and patent may be avoided (y). Proviso that patent shall be void if patentee not inventor.

The usual form of plea for raising this objection, alleges that the patentee was not the true and first inventor of the invention mentioned in the declaration (z). If the declaration contains an allegation that the patentee was the true and first inventor, the plea is merely a traverse or denial of that allegation; and therefore the defendant concludes by putting himself upon the country (z), so as to tender an issue in fact for trial by a jury. But when the declaration contains no such allegation, the plea must aver that the patentee was not the true and first inventor of the invention, and that by reason thereof the patent is void; and then conclude with a verification, as it is called, whereby the defendant offers to prove the matters alleged in the plea (z). Plea that patentee was not the inventor.

When the patent is set out on oyer, or when the declaration states the recital contained in the patent, by which it appears that the patentee represented to the Crown that he was the true and first inventor, a plea in the usual form is sufficient to enable the defendant to take this objection to the patent, on the ground that the patentee made a false suggestion to the Queen. But if the recital is not stated in the declaration, the defendant must in his plea aver that the patentee did make such a representation to the Queen, and that the Queen made the grant upon that representation; and then the plea must allege that the representation was false, and that the patent is therefore void (a). The plea must of course conclude with a verification. Plea of false representation that patentee was the inventor.

When the patentee has imported the invention, the plea that he was not the true and first inventor, would be sufficient to Plea that patentee was not the importer.

(x) Vide *ante*, Chap. III. p. 21; Chap. IV. p. 39.

(y) See Chap. IV. p. 62, *ante*, and the Form of a Patent in the Appendix, Chap. II. s. 1.

(z) See the Forms in the Appendix, Chap. II. s. 4.

(a) See the Form in the Appendix, Chap. II. s. 4.

raise the question whether he was the true and first inventor within the meaning of the Statute of Monopolies (b). In many cases, however, the best course for the defendant to adopt, is to plead a plea, setting out the representation made to the Crown by the patentee, and alleging that the representation was false, that the Crown was deceived in making the grant, and that the patent is therefore void (c).

Effect of the pleas.

In whichever of these forms the plea is pleaded, it will be sufficient if the plaintiff joins issue upon it to enable the defendant to take advantage of this objection, on the ground that the patent is contrary to both the Common Law and the Statute of Monopolies.

The objection that patentee not the inventor may be taken under a plea of *non concessit*.

It seems, however, that this objection, that the patentee was not the true and first inventor, may also be taken under the plea of *non concessit*, which has already been mentioned (d). That plea alleges that the Queen did not make the grant alleged in the declaration; and if it can be shown that the patent mentioned in the declaration was void; at the time it was made, it could not grant the privilege which the plaintiff alleges, for nothing could pass by a void instrument (e). And it is clear that if a patent were to be granted to a person who was not the true and first inventor, or importer of the invention, it would be absolutely null and void, for it would not be within the exception contained in the sixth section of the Statute of Monopolies (f), and therefore it would be made void, and of none effect, by the first section of that statute.

Objection that patentee was not the inventor is different from an objection that the invention was not new.

It is a very common error to suppose that the objection to a patent, that the patentee was not the true and first inventor, is the same as the objection that the invention was not new at the date of the patent. The two objections are however perfectly distinct, and different from each other. The one objection is applied to the patentee, and shows that he is not a person capable of sustaining such a grant; and the other objection is applied to the invention, and shows that it could not be made the subject of a patent privilege.

It is true that if it be shown that the invention comprised

(b) Vide *ante*, Chap. III. s. 3, p. 26.

(c) See the Form in the Appendix, Chap. II. s. 4.

(d) *Ante*, p. 264, 265.

(e) Vide Co. Lit. 260, a, and the other authorities, cited *ante*, p. 264, n. (d).

(f) Vide *ante*, Chap. III. p. 21.

in a patent was known to the public before the date of the patent, although the patentee may in fact have invented it, yet he cannot have been the *first* inventor, for some one must have invented and given the invention to the public before the date of his patent (g). But an invention may be perfectly new to the public, and yet the patentee may not be the *true* and *first* inventor. For he may have purloined it from another, or it may have been communicated to him by one of his fellow-subjects, in either of which cases he could not be the *true* inventor.

The objection that the patentee was not the true and first inventor, is, in fact, something more than the objection that the invention is not new, for it shows that the patentee did not make the invention (h).

The objection that the title in a patent misrepresents the nature of the invention, or improperly describes it, is taken to the patent, on the ground that the Queen has been deceived by a false representation or suggestion of the patentee.

Objection that title misrepresents the nature of invention.

It is the duty of a petitioner for a patent to see that the Queen is properly informed respecting the nature of his invention, and the grant which he seeks to obtain (i); he gives a title to his invention, in his petition, at his own risk and peril, and if he makes any misrepresentation respecting it, his patent will be absolutely void.

This objection is most frequently taken in cases in which the inventions are intituled or represented by the patentee to be improvements in something previously known, or to be applicable to some particular purposes, as in the following instances:—"improvements in elastic fabrics;"—"improvements in the manufacture of iron;"—"improvement in machinery for covering fibres applicable in the manufacture of braid and other fabrics," &c., &c.

Cases in which inventions are intituled improvements and are not so.

Patentees who have obtained patents for inventions described in this manner, must have represented to the Crown that their inventions were such improvements, or were applicable in the particular manner mentioned in the titles of their inventions (k); and if their inventions were not such improve-

(g) Vide *ante*, Chap. III. s. 4, p. 33.

(h) Vide *post*, Chap. XI. Evidence.

(i) Vide *ante*, Chap. IV. p. 42.

(k) Vide *ante*, Chap. IV. p. 45; and the Form of Petition for a Patent in the Appendix, Chap. II. s. 1.

ments as represented, or were not applicable in the way alleged, their patents are void by reason of the false representation or suggestion made to the Crown.

Form of plea for raising this objection.

Non concessit.

This objection is best taken by a plea, setting out the representation made to the Queen by the patentee respecting his invention, being improvements in some description of manufacture; stating also that the Queen acted upon the representation in making the grant, and then alleging that the representation, or some part of it, was false, and that by means thereof the patent is void (*l*). But the objection may also be taken under the plea of *non concessit*; for if the representation was false the patent is void, and therefore has no operation as a grant of privilege in manner stated in the declaration (*m*). And where an invention is misdescribed in the title, the plea of *non concessit* seems to be the proper plea for taking that objection to the patent; for the patent expresses a grant different from that which the Queen must have intended, and therefore it is null and void (*n*).

Title of invention too large.

When the title contained in a patent is too large, and includes more than the patentee has actually invented, it is clear that the patent purports to make a more extensive grant than the Queen can have intended, and therefore the patent is wholly void (*o*). And a defendant may, in an action upon such a patent, avail himself of the objection either by the plea of *non concessit*, or by a plea showing that the Crown was deceived by a false representation. The objection it seems is also admissible under a plea denying the sufficiency of the specification.

Morgan v. Seaward.

In the case of *Morgan v. Seaward* (*p*), it appeared that the patent had been obtained for an invention of "certain improvements in steam-engines, and in machinery for propelling vessels, which improvements were applicable to other purposes." The defendant pleaded (thirdly) that the alleged invention was not an improvement in steam-engines, and the defendant at the trial obtained a verdict upon that plea. The plaintiff moved for judgment, *non obstante veredicto*, or a

(*l*) See the Form of Plea in the Appendix, Chap. II. s. 4.

(*m*) Vide *ante*, p. 264, 268, respecting this plea.

(*n*) That a patent is void if it be con-

trary to the intent of the Queen; vide *ante*, Chap. IV. p. 48.

(*o*) Vide *ante*, Chap. IV. p. 46.

(*p*) 2 M. & W. 544.

repleader upon the finding upon the third issue; and in delivering the judgment of the Court of Exchequer, Mr. Baron Parke said, "The suggestion in the letters patent is, that Galloway had invented certain improvements in steam-engines, and in machinery for propelling vessels, which improvements were applicable to other purposes; and the patent is granted for the invention of those improvements. But unless the specification be referred to, to explain the title of the patent, it is doubtful whether the invention claimed is of improvements in steam-engines, as connected with other machinery only, or of improvements in steam-engines for whatever purpose they may be employed. Upon reference to the specification there is no doubt that the claim is of the latter description; but that instrument is not stated in the record, and upon what appears on the record, it is by no means clear that the patentee does claim an improvement in steam-engines, unconnected with the machinery. And if he does not, the plea would probably have been bad on demurrer, as it is uncertain whether it does not deny the invention to be an improvement in steam-engines, unconnected with the machinery. But after verdict, this objection is removed: for it is a rule that if an issue could have been material, the Court, after verdict, ought to intend it to be so, *Kempe v. Crews* (q); and as the plaintiff did not demur, it must be taken that he admits that the plea is to be understood as denying the invention to be an improvement in steam-engines in that sense in which it is used in the patent itself; and the jury must be intended so to have found." And the Court gave judgment for the defendant on the third issue.

Uncertainty in the plea cured by the verdict.

In the case of *Morgan v. Seaward* (r), just cited, it was also held by the Court of Exchequer, that a plea denying that the invention was such an improvement as alleged by the patentee was different from a plea alleging that the invention was of no use to the public. And the same law was laid down by the Court of Common Pleas in the case of *Bedells v. Massey* (s).

Plea denying an invention to be an improvement, different from a plea that it is of no use.

If the invention mentioned in the declaration in a patent action, is not an invention of such a nature as may be made

Objection that the invention is not of such a

(q) 1 Ld. Ray. 167.

(s) 2 Dowl. & Low. 322.

(r) 2 M. & W. 544-560.

nature as may
be made
the subject of a
privilege.

Pleas for rais-
ing this
objection.

the subject of a patent privilege, the defendant may take the objection by a plea in bar to the action (*t*). The nature of the inventions which may be made the subject of such privileges has already been considered in a former part of this work (*u*), to which the reader is referred. It has been usual to raise this objection by a plea alleging that the invention is not an invention of any manner of manufacture, and that the patent is therefore void (*t*); and that plea is intended to raise the question whether the invention be an invention within the meaning of the exception contained in the *sixth* section of the Statute of Monopolies (*x*).

It seems, however, that the proper form of plea for this purpose would be a plea alleging that the privilege granted by the patent is not a privilege for the sole working or making of any manner of manufacture (*y*). Whatever may be the form of plea which is adopted, the objection is taken to the patent on the ground that it is contrary to the express provisions of the Statute of Monopolies (*z*).

This objection, it seems, may also be taken to a patent under the plea of *non concessit*, for if the invention is one which cannot be made the subject of a patent privilege, the patent is rendered void by the express provisions of the Statute of Monopolies, and cannot operate as a grant in the way alleged by the plaintiff (*a*). It seems that the objection may also be taken under a plea alleging that the invention is not an invention of a *new* manufacture (*b*), but not under a plea which merely alleges that the invention is not new to the public (*c*), nor under a plea alleging that the specification is insufficient (*d*).

A plea that an invention was not at the time of the making of the patent a manufacture within this realm within the meaning of the statute (*e*), has, however, been decided to be a bad plea, on the ground that it is ambiguous, and uncertain whe-

(*t*) See the Forms of Pleas in the Appendix, Chap. II. s. 4.

(*u*) *Ante*, Chap. V. s. 1, p. 77.

(*x*) 21 Jas. I. c. 3.

(*y*) See the Form of Plea in the Appendix, Chap. II. s. 4.

(*z*) 21 Ja. I. c. 21, s. 6.

(*a*) As to the effect of this plea, vide *ante*, p. 264, 268.

(*b*) *Walton v. Bateman*, 3 M. & G. 773.

(*c*) *Walton v. Potter*, 1 Webs. R. 585; 3 M. & G. 411; and see *Elliott v. Aston*, 1 Webs. R. 223.

(*d*) *Jupe v. Pratt*, 1 Webs. R. 150; 151.

(*e*) 21 Ja. I. c. 3, s. 6.

ther it is intended to raise the question of the invention being new, or a manufacture within the meaning of the statute (*f*).

The objection that the invention comprised in a patent privilege is not new to the public, is taken both on the ground that the patent is contrary to the Common Law and the Statute of Monopolies, and also that the patentee has made a false representation to the Crown. The Statute of Monopolies, we have seen (*g*), expressly provides that a patent shall be void if the invention comprised in it was not new at the time of the making of the patent; and the Common Law also required that an invention should be new, in order to be made the subject of a grant by patent (*h*). A patent also shows that the patentee represented to the Crown that his invention was new, and if it was not so, the falsehood of the representation rendered the patent absolutely void (*i*).

Objection that the invention is not new.

When this objection is taken on the ground that the patent is contrary to the Common Law or Statute of Monopolies, it is sufficient for the defendant in his plea to state that the invention was not new to the public at the time of the making of the grant, and that by reason of such want of novelty the patent is void (*h*). The objection may also be taken under a plea alleging that the invention is not an invention of a new manufacture (*l*). And on the ground that the patent was originally void (*m*), it seems that it might also be taken under a plea of *non concessit*.

Pleas for raising the objection of want of novelty.

We have seen in preceding parts of this work (*n*), that an invention must be useful in some degree in order to be made the subject of a valid patent privilege.

Invention not useful.

The objection to a patent because the invention is not useful, it seems may be taken on the ground that the patent is contrary to law (*o*), and that it is contrary to the intent of the Queen (*p*). And if the patentee appears by the recital of his petition to have represented his invention to be useful, the

(*f*) *Spilsbury v. Abbott*, 1 Webs. R. 255.

(*g*) *Ante*, Chap. V. s. 2, p. 106.

(*h*) *Ante*, Chap. V. s. 2, p. 102.

(*i*) *Ante*, Chap. IV. p. 48, and vide *ante*, p. 63.

(*k*) See the Form of Plea in the Appendix, Chap. II. s. 4.

(*l*) *Walton v. Bateman*, 3 M. & G. 773.

(*m*) Vide *ante*, p. 264.

(*n*) *Ante*, Chap. I. p. 3, and Chap. V. s. 3, p. 132.

(*o*) See *Morgan v. Seaward*, 2 M. & W. 544.

(*p*) See Chap. V. s. 3, *ante*, p. 132.

patent will be void if the invention is not useful at all, or not useful in the way alleged by the patentee.

Plea for raising the objection of a want of utility to the public.

If the objection be taken on the ground that the grant is contrary to law, it cannot be sustained unless there is a total want of utility (*q*); and therefore a plea for raising that objection must allege, that the invention is not of *any* use, benefit, or advantage to the public (*r*). When the objection is taken on the ground that the patent is void by reason of a false representation, the plea for raising the objection must be framed according to circumstances. If the false representation appears on the face of the declaration, a plea alleging the want of utility may be sufficient; but if not, the plea must state the false representation made to the Crown, and then allege that it was false, and the patent therefore void (*s*).

And it seems that this objection may also be taken to a patent under the plea of *non concessit*, for if the patent be void in consequence of the inutility of the invention, it could not operate as a grant of privilege to the patentee in the manner alleged by the plaintiff (*t*).

But the utility of an invention is not put in issue by a plea denying that the invention is a new manufacture (*u*).

Morgan v. Seaward.

In the case of *Morgan v. Seaward* (*x*), the Court of Exchequer intimated a doubt as to whether the proper form of plea ought not to be in the words of the statute, that the patent was contrary to Law, or mischievous to the State, &c. (*y*), and not merely to plead the want of utility.

Jupe v. Pratt.

And in the case of *Jupe v. Pratt* (*z*), Mr. Baron Alderson intimated an opinion that it is not sufficient for such a plea to say that the invention is not useful, and that it ought to allege the invention to be prejudicial, as in *Arkwright's* case (*a*). The learned Judge seems to refer to the first suggestion in the writ of *scire facias*, in the case of *The King v. Arkwright* (*a*), but Mr. Justice Buller in that case held, that

(*q*) See Chap. I. p. 3, and Chap. V. s. 3, p. 102.

(*r*) See the Form of the Plea in the Appendix, Chap. II. s. 4.

(*s*) See the Form of such a Plea in the Appendix, Chap. II. s. 4.

(*t*) Vide *ante*, pp. 264, 268, as to the effect of this Plea.

(*u*) *Walton v. Bateman*, 1 Webs. R. 623.

(*x*) 1 Webs. R. 187-197; 2 M. & W. 544.

(*y*) See 21 Ja. I. c. 21, s. 6.

(*z*) 1 Webs. R. 151.

(*a*) Dav. P. C. 61.

the suggestion was too general, and that the prosecutor could not be permitted to give evidence in support of it (b).

Notwithstanding these authorities, a plea merely denying the utility of the invention in general terms, is pleaded in almost every action for the infringement of a patent; and it is probable that whenever the sufficiency of the plea is made the subject of judicial determination, it will be held to be valid on the ground stated in a former part of this work (c).

In the case of *Losh v. Hague* (d), the defendant raised an objection to the validity of the patent, by a plea alleging that the improvements invented by the plaintiff were trifling and insignificant, and not legal subjects for the grant of the patent. No decision was, however, necessary respecting the sufficiency of the plea, for the plaintiff joined issue upon it, and the issue was found for the plaintiff.

In the cases of *Morgan v. Seaward* (e) and *Beddells v. Massey* (f), it was held, that a plea denying the utility of an invention is quite different from a plea alleging that the plaintiff had falsely alleged his invention to be improvements.

Every patent for the sole use of an invention contains a proviso or condition, requiring that the patentee shall particularly describe and ascertain the nature of his invention, and the manner in which it is to be performed, by an instrument (usually called a specification), and to cause it to be enrolled in Chancery within a certain time after the date of the patent; and it is expressly declared that the patent shall be void if the condition is not complied with (g).

The objection that the patentee has not enrolled a sufficient specification can only be taken to the patent on the ground that the non-performance of the condition has rendered the patent void, for a specification is not required either by the Common Law or the Statute of Monopolies.

There are two objections which may be taken to a patent under this condition: the one upon the ground that there is no specification at all, or no sufficient specification; and the other upon the ground that the specification was not enrolled at all, or was not enrolled in due time. These two objections

(b) Dav. P. C. 79.

(e) 2 M. & W. 544.

(c) Vide *ante*, Chap. I. and Chap. V.

(f) 2 Dowl. & Low. 322.

sec. 3.

(g) Vide *ante*, Chap. IV. p. 68, and

(d) 1 Webs. R. 202.

Chap. VII. p. 151.

are frequently taken by separate pleas. The total want of a specification is a thing which rarely occurs, and therefore the common form of the objection is, that the specification which the patentee has made is insufficient.

Plea for raising the objection.

Plea that specification insufficient.

Plea setting out the specification.

This objection is sometimes raised by a plea alleging that the patentee did not, by the instrument in writing under his hand and seal in the declaration mentioned, particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, in manner and form as in the declaration alleged (*h*). A plea in this form merely questions the sufficiency of the particular specification mentioned in the declaration, and must conclude to the country (*i*).

It is frequently desirable that the specification should be put upon the record, in order that the defendant may have the benefit of objections arising from defects appearing on the face of it, either on demurrer or in a Court of Error. In order to do this, it is usual to set out the specification in the plea, and annex any plans or drawings contained in the specification; and then to conclude with a special traverse alleging that the plaintiff did not by the specification particularly ascertain and describe his invention as alleged in the declaration (*k*).

And in the case of *Muntz v. Foster* (*l*), the Court of Common Pleas held, that such a plea concluding with a common instead of special traverse, was bad on special demurrer.

Reference to specification as set out in a previous plea.

But if the specification has been set out in any previous plea, it will be sufficient to refer to the instrument as there set out, and conclude with a traverse of the performance of the condition in the patent as alleged in the declaration (*k*).

Plea that the specification was not enrolled.

The objection that the specification has not been enrolled, or not enrolled within due time, may be taken by a plea alleging that the specification or instrument in writing in the declaration mentioned was not enrolled within six (or four) calendar months after the date of the patent, as alleged in the declaration (*m*). And such a plea seems to be the proper plea for merely putting in issue the plaintiff's allegation of an enrolment of his specification in due time. It will be observed

(*h*) See the Form in the Appendix, Chap. II. sec. 4.

(*i*) *Bentley v. Goldthorp*, 9 Jur. 470.

(*k*) See the Form of Plea in the Ap-

pendix, Chap. II. s. 4.

(*l*) 1 Dowl. & Low. 737.

(*m*) See the Form of Plea in the Appendix, Chap. II. s. 4.

that the condition requiring the enrolment of a specification is not a condition precedent; but it seems that it is necessary for the patentee to allege that he has complied with the condition (n).

The usual form of plea alleges that the patentee did not cause any sufficient specification to be enrolled within the time limited by the patent, and that by reason thereof the patent became void (o). Plea that no sufficient specification has been enrolled.

A patentee is bound to describe every part of the invention comprised in his patent, and if he fail to describe any part of it sufficiently, the patent is void (p). Where a patent contains a title too large for the actual invention of the patentee, the defendant may in some cases take advantage of the objection under a plea denying the sufficiency of the specification (q). Title too large.

For if it appears upon the face of the specification, that the patentee has neglected to describe something comprised in the patent privilege, the patent must be void by reason of the non-compliance with the condition. But the objection cannot be taken under that plea, unless it clearly appears upon the face of the specification, that the patentee has not described some part of the invention. Part of invention not described.

In addition to the objections which have already been mentioned, there are others which may be taken to a patent by proper pleas, such as, that the patent has become void by an assignment to or in trust for more than twelve persons, contrary to the condition of the patent; that the object of the invention was contrary to law, as for instance an invention of implements for housebreaking; or that the patentee has refused to supply articles for the public service, contrary to the condition in his patent. Other objections to a patent.

A defendant in an action for the infringement of a patent may, under some circumstances, be precluded from taking any objection to the validity of the patent. Defendant may be precluded from taking any objection to the patent.

Thus, in the case of *Oldham v. Langmead* (r), which was an Oldham v. Langmead.

(n) See the judgment of Tindal, C. J., in *Muntz v. Foster*, 1 Dowl. & Low. 741, 742; and vide ante, p. 254.

(o) See the Form in the Appendix, Chap. II. s. 4.

(p) Vide ante, Chap. VII. p. 162.

(q) See the case of *Neilson v. Harford*, 1 Webs. R. 373.

(r) Cit. 3 T. R. 439.

In an action by an assignee, the patentee is estopped from objecting to the patent.

action brought by the assignee of a patent against the patentee, it was held by Lord *Kenyon*, that the defendant, the patentee, could not be permitted to show that the invention was not new, contrary to his own deed by which he had assigned the patent to the plaintiff (s).

Bowman v. Taylor.

A licensee estopped from objecting to the patent.

So also in the case of *Bowman v. Taylor* (t), in which it appeared that by a deed made between the plaintiff and the defendant, after reciting that the plaintiff had invented certain improvements in power-looms for which he had obtained a patent, and had enrolled a specification of the invention in pursuance of the patent, the plaintiff, for the consideration mentioned in the deed, agreed to permit the defendant to use the invention, and the defendant covenanted with the plaintiff to pay him certain sums of money for the use of the invention. The plaintiff brought the action for certain sums which had become due in pursuance of the deed, but which the defendant had not paid. The defendant pleaded three pleas in which it was alleged, that the patent was void on the ground that the invention was not new, that the plaintiff was not the inventor, and that the plaintiff had not enrolled a specification. And it was held upon demurrer that the defendant was estopped by the deed from taking the objections to the patent, which were mentioned in the pleas (u).

Not guilty.

The last plea which it is necessary particularly to mention, is the plea of not guilty; by which the defendant says that he is not guilty of any of the grievances alleged in the declaration. This plea, as already stated (x), had formerly a much more extensive operation in a patent action than it has at present: before the new pleading rules (y), made in pursuance of the stat. 3 & 4 W. IV. c. 42, s. 1, this plea had the effect of compelling the plaintiff to prove every thing necessary to support a patent for an invention; and also enabled the defendant to raise any objection he might think fit to the patent, and to make almost every possible defence to the action.

Effect of the plea limited to a denial of the breach.

By the new pleading rules, the effect of this plea is now limited to a denial of the wrongful acts complained of in the

(s) See Chap. IX. s. 2, *ante*, p. 236.

(t) 2 A. & E. 278.

(u) See also the case of *Baird v. Neilson*, 8 Cl. & Fin. 726, in the House of Lords, which was an appeal from a

decision of the Court of Session in Scotland.

(x) Vide *ante*, p. 263.

(y) R. G. H. T. 4 Will. IV. 1834; Charn. New Rules, p. 125.

declaration; it does not therefore put in issue or deny the making of the invention, its novelty or utility, the grant of the patent, or the enrolment of the specification, or any other thing alleged in the declaration, except the breaches. The effect therefore of the plea is merely to deny the allegations contained in the breaches, it being admitted for the purposes of the issue raised on this plea, that the plaintiff is possessed of the patent privilege he alleges, and that it is a good and valid privilege (z).

There are also other matters of defence which a defendant may avail himself of in a patent action, some of which may here be mentioned. Other defences to a patent action.

Thus, if a patent has been repealed by *scire facias*, the defendant in an action upon the patent will be at liberty to plead the judgment to repeal the patent in bar of the action (a). So if a patent has been made void by a declaration under the Privy Seal, or under the hands of six Privy Counsellors (b), such a declaration would be a defence to an action for infringing the patent. And if the patentee has been convicted of an offence which causes a forfeiture of the patent, it is apprehended that the forfeiture might be set up as a defence to any action he might bring upon the patent. If a patentee should commence an action for an infringement of his patent, after it had been assigned over to another, or after he had become bankrupt, or taken the benefit of the Insolvent Act, the assignment, bankruptcy, or insolvency might be pleaded as a defence to the action. And if he surrenders his patent to the Crown by a deed enrolled in Chancery, the surrender might be pleaded as a defence to any subsequent action he might bring for an alleged infringement of the patent.

In an action for infringing a patent the defendant is allowed to plead several pleas, so as to raise every objection which can be taken to the validity of the patent, and the Court will always grant a rule permitting him to plead a *sufficient* number of pleas for that purpose. A patent action is, indeed, almost always brought for the purpose of trying the validity of a patent, and frequently in pursuance of an order of the Court of Chancery; and if the defendant was not permitted fairly Rule to plead several matters.

(z) Vide *post*, tit. Evidence, Chap. XI. Sci. fa. pl. 138, 131.

(a) Bro. Abr. title Pat. pl. 23; and (b) Vide *ante*, Chap. IV. p. 64.

to raise every legal objection to it, the object with which the action is brought would be frustrated.

Defendant will not be permitted to plead pleas which are not necessary or issuable.

But a defendant will not be permitted to plead more pleas than necessary, or to plead them in such a form that the plaintiff cannot take issue upon them. A defendant can rarely plead to a declaration in a patent action without obtaining an order for more time to plead than is allowed in the first instance, and he cannot obtain the order except upon the terms of pleading issuably. The defendant is, therefore, under the terms of this order bound to plead such pleas as the plaintiff can raise issues upon (either in Law or in fact), which will fairly decide the questions between the parties to the cause.

Beddells v. Massey, and Nickels v. Ross.

In each of the recent cases of *Beddells v. Massey* (c), and *Nichels v. Ross* (d), the defendant pleaded the following pleas: 1st, *Non concessit*. 2nd, That the patentee was not the true and first inventor. 3dly, That the invention was not an invention of such improvements as represented by the patentee, and therefore that the patent was void. 4thly, That the invention was not an invention of any manner of manufacture. 5thly, That the invention was not new. 6thly, That the invention was of no utility to the public. 7thly, That the specification mentioned in the declaration did not sufficiently describe the invention. 8thly, That the patentee did not enrol any sufficient specification; and, 9thly, Not guilty. The plaintiff in each of those cases obtained a rule to show cause why two of the pleas should not be struck out, (the first and third,) but the Court of Common Pleas, after argument, discharged the rules with costs.

Bunnett v. Smith.

In the case of *Bunnett and Corpe v. Smith* (e), which was an action by a patentee and the assignee of a moiety of a patent, the defendant applied to a Judge at Chambers for leave to plead similar pleas to those pleaded in *Beddells v. Massey*, with an additional plea traversing the allegation of assignment of a moiety of the patent. The learned Judge refused to allow the defendant leave to plead either *non concessit*, or the plea traversing the assignment. But the Court of Exchequer held that those two pleas were proper pleas, and gave the defendant leave to plead the whole of the Pleas.

(c) 2 Dowl. & Low. 322.
(d) Not yet reported.

(e) 13 M. & W. 552.

The pleas just mentioned to have been pleaded in the cases cited are indeed now the usual pleas to a declaration in a patent action; and although they do not raise every possible ground of defence, they are amply sufficient in a great majority of cases.

The pleas just mentioned are the usual pleas.

In the recent case of *Bentley v. Keighley* (f), the Court of Common Pleas allowed the defendant to plead a plea that a part of the invention was not a manufacture, in addition to a plea that the whole invention was not a manufacture within the meaning of the statute. And the Court granted leave to plead the additional plea in this case, on the ground that there might be a doubt whether a plea that the whole invention was not a manufacture within the statute, would enable the defendant to raise the objection that a part of it was not such a manufacture.

Bentley v. Keighley.
Plea will be allowed in a doubtful case.

But in the case of *Clark v. Kenrick* (g), in which a part of the invention had been disclaimed, under the statute 5 & 6 Will. IV. c. 83, s. 1, the Court of Exchequer refused to allow the defendant to plead pleas applicable to the whole invention, and also similar pleas to that part which was undisclaimed.

Clark v. Kenrick.
Pleas to the whole, and also to undisclaimed part, not allowed.

Several of the pleas which have been noticed, merely traverse some allegation contained in the declaration, and therefore conclude by the defendant putting himself upon the country, (as it is called,) so as to tender an issue in fact for trial by a jury. To such pleas the only replication necessary is a common joinder, by which the issue in fact is actually raised for trial.

Replications.

If a plea that the patentee was not the true and first inventor be merely a traverse of an allegation contained in the declaration, it must of course conclude to the country, and the replication to such a plea will therefore be a mere joinder of issue (h). But if the plea is not a traverse of any thing alleged in the declaration, it must show that the patent is void by reason of the patentee not being the true and first inventor, and conclude with a verification. The replication to such a plea must therefore allege affirmatively that the patentee was the true and first inventor of the invention, with a conclusion to the country (h). When the plea sets out the representa-

Replication to plea that patentee not the inventor.

(f) 1 Dowl. & Low. 944.

(g) 1 Dowl. & Low. 392.

(h) See a Form in the Appendix, Chap. II. s. 4.

tion made by the patentee that he was the true and first inventor, and then concludes by an averment that the representation was untrue, and that the patentee was not the true and first inventor, and the patent therefore void, the plaintiff is put to his election which part of the plea he will traverse. If the plea does not state correctly the representation which the patentee actually made to the Crown, it will be sufficient for the plaintiff to deny that part of the plea which alleges that he made the representation; but if the defendant sets out the representation correctly, then the only course for the plaintiff to adopt is to deny the latter part of the plea, and allege that the representation was correct (i).

Replication to a plea denying that invention is an improvement, or applicable in the way alleged.

So with respect to a plea denying that the invention is such an improvement as described in the title, or that it is applicable in manner mentioned in the title. In such a case if the declaration contain any express allegation of which the plea is a mere traverse, the plea will conclude to the country, and the replication will be only the common joindre of issue. But if the plea sets out the representation made to the Crown that the invention was an improvement of the description, or was applicable in the way mentioned in the title, alleging that the representation was false, and that the patent was therefore void, the plaintiff must, in his replication, either deny that such a representation was made, or allege that the representation was true,—of course concluding to the country (k).

Replication to a plea denying the utility of the invention.

The replication to a plea merely traversing an allegation contained in the declaration respecting the utility of the invention, will, of course, be only the common joinder. But if the plea alleges that the invention was of no use to the public, and that by reason thereof the patent was void, such a plea must conclude with a verification, and the replication to it must allege affirmatively that the invention was of use to the public.

Replication to a plea denying the novelty of the invention.

The same observations apply to a plea putting in issue the novelty of the invention: the replication to such a plea will either be a common joinder, or a traverse of the allegations of the plea as to the want of novelty.

Replication to a plea alleging

A plea alleging that the invention is not such an invention as

(i) See the Forms in the Appendix, Chap. II. s. 4.

(k) See the Forms in the Appendix, Chap. II. s. 4.

may be made the subject of a patent privilege, is generally framed in the terms of the sixth section of the Statute of Monopolies (1), and will seldom be a traverse of any allegation in the declaration. The replication to such a plea must therefore allege that the invention is such an invention as may be legally made the subject of a privilege, with a conclusion to the country.

that the invention cannot be the subject of a patent privilege.

A plea merely denying the sufficiency of the specification as alleged in the declaration, or the enrolment of it, will only require the common joinder by way of replication. But when the plea alleges that for want of a specification, or for want of a specification having been enrolled within six months, the patent has become void, the plaintiff must show a sufficient specification or enrolment in his replication.

Replication to plea denying the sufficiency of the specification.

The pleadings in a patent action very rarely extend beyond a rejoinder, for the replication is almost always either a joinder of issue, or a mere traverse of the defendant's plea. Therefore when a rejoinder becomes necessary, it is generally a mere similitur for the purpose of joining issue.

Rejoinder.

The plaintiff or defendant in a patent action may, of course, demur at any stage of the pleadings in precisely the same way as in other actions.

Demurrer.

It is rarely expedient for a plaintiff to demur in such an action, for a plaintiff's object is generally to establish his legal title to his patent privilege with as little delay as possible; and a demurrer is almost certain to postpone the final determination of a cause.

Rarely expedient for plaintiff to demur.

A defendant in such an action can rarely plead without having obtained an order for time, by which he is laid under terms to plead issuably: and in order to comply with these terms, the defendant must plead pleas upon which the plaintiff can join issue, and go to trial upon the merits.

If a defendant plead any plea in violation of these terms in such an order, the plaintiff may sign judgment against him as for want of a plea. The plaintiff therefore has sufficient security that a defendant in such an action will not plead a frivolous plea; and if a plea is good in substance, it can seldom be beneficial for a plaintiff to demur to it on account of

(1) See the Forms in the Appendix, Chap. II. s. 4.

any defect in form merely. And indeed he ought never to demur to any pleading of the defendant on the ground of informality only, or in any case, unless he will be prejudiced by pleading over instead of demurring.

Seldom for the benefit of a defendant to demur.

And it is seldom for the benefit of a defendant in such an action to demur, for during the time the action is pending, he must generally be uncertain respecting his right to manufacture the article which is complained of as an infringement of the patent; and if it should ultimately turn out that he has been violating a valid patent right belonging to the plaintiff, he will have been employing his time and capital for the benefit of the plaintiff, who will be entitled to the whole of the profits.

It must always require some considerable time to bring a patent action to a determination; and for the reasons already given, it is not often to the interest of either party to cause more delay by any unnecessary demurrer. Demurrers, therefore, are rarely seen in such an action, each party preferring to take issue in fact upon the pleading of the opposite party when he can do so safely and without prejudice to his case.

Notice of objections.

Before the making of the new pleading rules, the defendant in a patent action was permitted to raise every possible objection to the patent by way of defence, under the plea of not guilty (*m*). This operated very much to the prejudice of patentees, who were frequently taken by surprise at the trial by some objection which was quite unexpected. The new pleading rules operated very beneficially by limiting the effect of the plea of not guilty to a denial of the alleged wrongful act or acts stated in the declaration, and by compelling the defendant to raise the objections which he intends to take to the patent by some plea showing the ground upon which he alleges that the patent is void.

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

Defendant on pleading to give plaintiff notice of objections.

By the 5th section of the statute 5 & 6 Will. IV. c. 83, it was enacted, "That in any action brought against any person for infringing any letters patent, the defendant on pleading thereto shall give to the plaintiff [and in any *scire facias* to repeal such letters patent, the plaintiff shall file with his de-

(*m*) Vide *ante*, p. 278.

claration] a notice of any objections on which he means to rely at the trial of such action; and no objection shall be allowed to be made on behalf of such defendant [or plaintiff respectively] at such trial, unless he prove the objections stated in such notice: Provided always, that it shall be lawful for any Judge at Chambers, on summons, served by such defendant [or plaintiff] on such plaintiff [or defendant respectively], to show cause why he should not be allowed to offer other objections whereof notice shall have been given as aforesaid, to give leave to offer such objections on such terms as to such Judge shall seem fit."

No objection to be allowed unless defendant prove the objections in the notice.

Judge may give leave to offer other objections.

It is probable that, at the time this Act was drawn, the beneficial operation of the new pleading rules, in favour of patentees in patent actions, was unknown, or not considered; but be that as it may, the statute was passed *after* the new pleading rules came into operation, and therefore the enactment in question must be deemed to have been made for the purpose of giving the plaintiff in a patent action some benefit other than that which he derived from the new pleading rules.

Act passed after new pleading rules, and therefore intended to give plaintiffs additional benefits.

For this reason it has been decided that it is not sufficient, in a notice given under the statute, to specify every objection in as general terms as in a plea. In some cases indeed a plea states an objection with as much particularity as can be required in a notice: thus, the objection that the patentee was not the true and first inventor, is stated with as much particularity in a plea as can possibly be required in a notice of objections, for the nature of the subject does not admit of anything more being stated, unless the defendant was to mention the evidence by which he would establish his objection; and it is clear that the statute was not intended to compel a defendant to state his evidence in the notice. But whenever a plea will enable a defendant at the trial to raise several different and distinct objections to the patent, the patentee is entitled under the statute to notice of the objections upon which the defendant intends to rely in a form more specific and particular than the plea.

Notice must not be as general as the pleas.

Except in cases where nothing more can be given without stating the evidence.

If a plea enables a defendant to offer several distinct objections, they must be particularized.

It has been decided that the Courts of Common Law have jurisdiction over the notices to be given in pursuance of this statute; and that whenever such a notice is not sufficient, the defendant may be ordered to amend it in the several re-

Courts have jurisdiction over notices, and may order better notices to be delivered.

spects in which it is insufficient, or to deliver a fuller and more particular notice (n).

Power of Courts to order better notices derived from their general jurisdiction over proceedings before them.

The power of the Courts to order further and better notices of objections, is derived from their general jurisdiction over all proceedings in actions before them, precisely in the same way as they derive their power over particulars of a set-off, pleaded by a defendant in pursuance of the statute of set-off, from their general jurisdiction.

Differences in opinions respecting the particularity of notices.

There has been some difference in opinion amongst the Judges respecting the particularity necessary to be observed in framing notices under this statute; but almost all the reported cases on the subject have arisen upon applications for further and more particular notices of objections, and there are very few reported cases of decisions respecting the sufficiency of such notices to let in any particular objection at *Nisi Prius*.

Only question at *Nisi Prius* is, whether notice sufficiently extensive.

Indeed it has been decided, that the only question which can arise at *Nisi Prius* respecting such a notice is, whether the language of the notice is sufficient to include any particular objection made by the defendant (o).

Fisher v. Dewick.

In the case of *Fisher v. Dewick* (p), it was decided, that a notice of objections which is vague, and calculated to mislead the plaintiff, is not a sufficient compliance with the statute, and a further and better notice was ordered. And it was held in that case, that an objection, "That if any part be new the same is useless and unnecessary," was insufficient; and that the defendant should have pointed out what part. And an objection, "That the improvements, or some of them, have been used long before," was also held insufficient, because the defendant ought to have pointed out which of the improvements had been used before.

Notice which is vague and calculated to mislead insufficient.

Bulnois v. Mackenzie. Order that defendant should give names, &c. of persons who used the inven-

In the case of *Bulnois v. Mackenzie* (q), it appeared that one of the objections stated that the invention had been used by *J. H. M.*, and others, before the grant of the patent. *Vaughan, J.*, at Chambers, ordered (amongst other things) that the defendant should furnish the plaintiff with the names,

(n) *Bulnois v. Mackenzie*, 4 Bing. N. C. 127; *Losh v. Hague*, Gods. 2nd ed. 239.

370; 8 M. & W. 822.

(p) 1 Webs. R. 264; 4 Bing. N. C. 706.

(o) *Neilson v. Harford*, 1 Webs. R.

(q) 4 Bing. N. C. 127.

addresses, &c., of the persons referred to in this objection; but the Court of Common Pleas afterwards set aside so much of the order as related to the names, addresses, &c. of these persons.

In the case of *Galloway v. Bleden* (r), the defendant had delivered a notice stating that the invention was old, and had been used by persons named, and divers other persons, before the date of the patent. Upon a summons at Chambers in this case, *Coltman, J.*, ordered that the names, addresses, and descriptions of the persons who had used the invention to be given, and the words "and divers other persons" to be struck out.

In the case of *Jones v. Berger* (s), one of the defendant's objections was, that the patentee was not the true and first inventor, the same having been published by certain persons named in the specifications of their patents (which were sufficiently referred to), "and also by other persons in other books and writings" before the date of the patent. The Court of Common Pleas held this objection was insufficient, and ordered the defendant to specify the books he intended to rely upon. Another objection was, that the invention had been known and practised by persons at Nottingham and elsewhere, before the patent. The Court held this objection also to be insufficient, and ordered the words "and elsewhere" to be struck out, and the names of the other places inserted.

In the case of *Heath v. Unwin* (t), the defendant gave notice of the following objections: *first*, that the patentee was not the inventor of the improvements, in respect of which the patent was alleged to be in force; *secondly*, that the specification and disclaimer in the declaration mentioned did not sufficiently describe the nature of the invention, and the manner in which it was to be performed; *thirdly*, that the invention did not produce the effect stated in the specification, nor was such effect produced by the plaintiff in the manner therein stated; *fourthly*, that the invention was not new, and was either wholly or in part used and made public before the

(r) 2 Chit. Arch. Prac. 1031; 1 S. C. Webs. R. 522.

(t) 2 Dowl. & Dowl. 482; 10 M. & W. 681, S. C.

(s) 5 M. & G. 208; 1 Webs. R. 544,

tion before the date of the patent set aside.

Galloway v. Bleden.
Names, &c. ordered to be given.

Jones v. Berger.
Books ordered to be specified.

Names of places to be given.

Heath v. Unwin.

All the objections except the fourth sufficiently stated.

obtaining the letters patent; *fifthly*, that the invention did not essentially differ from other similar inventions, which were in public use at or before the granting of the said letters patent; *sixthly*, that the defendant had the plaintiff's leave and licence to make use of the improvements for which the letters patent were granted. The plaintiff obtained a rule to show cause why the defendant should not deliver a further and better particular of the objections intended to be relied on. The Court of Exchequer held, upon the authority of the case of *Fisher v. Dewick* (u), that the fourth objection was insufficiently stated; and that it was not sufficient to say that an alleged invention was *wholly or in part* made public before the obtaining the letters patent, but that it should be shown what part was so used. The Court therefore ordered the fourth objection to be amended, but held that all the other objections were sufficiently stated. In giving judgment in this case, Lord Abinger, C. B., (after expressing an opinion that the fourth objection was not sufficient,) said, that "With respect to the second (objection), surely it is enough for the defendant to say that the specification does not properly set forth the invention. *The legislature never intended that the defendant should argue his case in the statement of objections, which he delivers in compliance with the Act.*"

R. v. Walton.
Order for names, &c. of persons who had used the invention refused by Master of the Rolls.

In the case of the *Queen v. Walton* (x), which was a *scire facias* to repeal a patent, the notice of objections stated, that before the granting of the defendant's patent, a patent, comprehending part of the invention claimed by him, had been granted to one Thomas Hanccock, and that part of the invention used, but neither the declaration nor the notice of objections specified the name of any person supposed to have used such part of the invention. The defendant applied to the Master of the Rolls for an order upon the prosecutors to deliver a particular of such names, but the order was refused. After the record had been brought into the Court of Queen's Bench, the defendant obtained a rule in the latter Court calling upon the prosecutor to show cause "why he should not deliver to the attorney or agent for the defendant a state-

(u) 4 Bing. N. C. 706.

(x) 2 Q. B. 969.

ment in writing containing the names and places of abode of the persons whom he intended, upon the trial of the cause, to prove had manufactured or used the invention; or why, in default thereof, the prosecutor should not be precluded from giving evidence of such prior manufacture or use." The rule was obtained on an affidavit, stating that the defendant had no other means of gaining the information required, and was in danger of being taken by surprise at the trial, unless the particulars were ordered. The Court after argument and taking time to consider, discharged the rule, and Lord *Denman*, C. J., said, in delivering the judgment of the Court, "We agree with the Master of the Rolls, rather than with the Court of Common Pleas (y), and think that the particulars should not be ordered."

And the Queen's Bench discharged a rule nisi for such names, &c.

In the case of *Russell v. Ledsam* (z), which was an action for the infringement of a patent, for an additional term granted to the assignee of the original patent, the defendant gave notice of objections:—*first*, That the original patentee was not the true and first inventor; *secondly*, That the invention was not new; *thirdly*, That the new letters patent and the report of the Judicial Committee of the Privy Council, whereon the new letters patent were founded, were obtained by fraud and misrepresentation. The plaintiff obtained a rule nisi for further and better particulars of the objections, which the Court made absolute as to the second and third objections, but discharged it as to the other. In delivering the judgment of the Court of Exchequer, *Parke*, B., said, "The principal point discussed was, whether or no it was necessary in an objection on the ground that the patentee was not the first inventor, or that the invention was not new, that the defendant should state who was the first inventor, or when and in what place, and under what circumstances, it was used before. This point is not new, for it has been already before this Court, and also before the Court of Common Pleas, in the case of *Bulnois v. Mackenzie* (a). In that case the Court of Common Pleas would not require those particulars to be given,

Russell v. Ledsam.

Defendant will not be compelled to state who was the first inventor, or under what circumstances the invention was used before the date of the patent.

(y) In *Jones v. Berger*, 1 Webs. R. 544, cited *ante*, p. 287.

(z) 11 M. & W. 647; 1 D. & L. 347.
(a) 4 Bing. N. C. 127.

and their example has been followed by this Court, in the case of *Heath v. Unwin* (b). In the subsequent case, however, of *Jones v. Berger* (c), the Court of Common Pleas deviated from their former decision in *Bulnois v. Mackenzie*, and compelled the defendant to give the name of the first inventor. On consideration of the matter, however, we think that we ought to abide by the cases of *Heath v. Unwin*, and *Bulnois v. Mackenzie*, and that no particulars of the circumstances under which this invention may have been previously used, should be required from the defendant; and we are fortified in this view by the decision of the Court of Queen's Bench, in the case of *Regina v. Walton* (d), in which they adopted the same view. That was originally an application to the Master of the Rolls, which afterwards came before the Court of Queen's Bench, which we find, on enquiry, to have determined this point the same way. On the authorities, therefore, we are bound to say that no such particulars ought to be required as are here asked for; and the argument is very strong to confirm the propriety of that course, viz., that to require the defendant to afford this information, would be throwing the burden of proof on the wrong party. This rule must, therefore, be discharged as to this part of it, and can only be made absolute so far as it requires the defendant to point out whether he means to object to the patent altogether, as being granted for what was in reality an old invention; and if he only proposes to object to part, then he must state what part. If he means to object to the entire patent, he may state that he objects to it generally as not new; if he means to object to a particular part, he must designate that part. Then with respect to another objection which has been made, relative to the part of the notice which reiterates the terms of the plea that the patent was obtained by fraud, covin, and misrepresentation, we certainly think that the defendant ought to state in what that fraud consisted, and what was the species of misrepresentation by which he means to allege that the patent was obtained from the Privy Council. This rule will therefore be made absolute so far as it requires the defendant to furnish better particulars

To require defendant to give the information would throw the burthen of proof on the wrong party.

Defendant must state whether the whole or part of invention not new.

Particulars of fraud must be stated.

(b) 2 Dowl. & Dowl. 482; 10 M. & W. 684, S. C.

(c) 5 M. & G. 208; 1 Webs. R. 544.
(d) 2 Q. B. 969.

of the fraud, covin, and misrepresentation mentioned in the plea, and also so far as requiring the defendant to state either that he objects to the patent generally as not being a new invention, or that he only objects to part of it on that account, in which case he must specify what part. In all other respects the rule must be discharged."

And in the recent case of *Bentley v. Keighley* (e), in the Court of Common Pleas, the notice of objections stated that the invention was known to M. R. "and others," before the date of the patent; and that from them, or one of them, the patentee acquired a knowledge of the invention: that M. R., J. W., "and others," were respectively the first and true inventors:—and that the invention before the date of the patent was used by M. R., the patentee, "and others." The plaintiff obtained a rule nisi for a better notice of objections, and it was objected that the words "and others" made the notice too general, and that they ought to be expunged, but the Court discharged the rule.

Bentley v. Keighley.
Common Pleas refused to strike out the words "and others."

Although plaintiffs always profess to apply for further and better particulars of objections, on the ground that the notice does not furnish them with sufficient information; the real motive generally is to get rid of some of the objections, or to restrict the defence as much as possible. The object of the statute, however, was not to limit the defence, but to diminish the expense at the trial, and prevent the patentee from being taken by surprise (f).

Object of the statute was not to limit the defence.

But as a defendant in a patent action always takes care to state every possible objection which can be taken to the patent, the plaintiff does not really derive any advantage from the notice; and it is not improbable that section five of the statute 5 & 6 Will. IV. c. 83, which gives the plaintiff a right to the notice, will be repealed as useless, and productive of much unnecessary cost and vexation.

Notice of little benefit.

Patent actions are always tried at *Nisi Prius*, and not at the bar of the Court, although the Court might, if it pleased, order a trial at bar. Few causes require so much care and industry in preparing for trial as patent actions, in which very nice points of law, and difficult questions of fact, must often

(e) 1 Dowl. & Low. 946.

Dewick, 1 Webs. R. 267; 4 Bing. N.

(f) Per *Tindal*, C. J., *Fisher v.* C. 706.

be decided between the parties; and it will frequently happen that a party will succeed or fail in obtaining a verdict, according to the industry with which he has got up his case for trial. Properly to understand the questions raised in such actions, and prepare the necessary proofs, a competent knowledge not only of law, but also of science in general, and the useful arts, are essentially requisite.

Plaintiff entitled to have his action tried although a *scire facias* is pending.

The plaintiff is entitled to have his action tried notwithstanding the pendency of an action of *scire facias* to repeal the patent. For the plaintiff has no means of compelling a prosecutor to proceed to trial with a *scire facias*, and even if he had the means, the result must be deemed to be uncertain; and if the patentee obtains a verdict in the *scire facias*, he will have been prejudiced by the trial of his action for an infringement having been delayed.

Muntz v. Foster.

In the case of *Muntz v. Foster* (g), in the Common Pleas, which was an action for damages for the infringement of the plaintiff's patent, it appeared that the defendants (who were under an injunction) had brought an action of *scire facias* to repeal the plaintiff's patent, and that according to the ordinary practice of the Queen's Bench it would have been tried before the action in the Common Pleas; but that in consequence of special circumstances the trial of the *scire facias* had been delayed. The questions respecting the validity of the patent were the same in each case, and the defendants in the Common Pleas having obtained a rule *nisi* to postpone the trial of the action in that Court, it was contended for them, that as the right of the plaintiff to maintain the action might be altogether destroyed by the proceeding in *scire facias*, they ought not to be compelled to go to trial in the action for an infringement, but that the proceedings ought to be staid; that the defendants being under an injunction, the plaintiffs could not be prejudiced by the delay, the delay being rather to the prejudice of the defendants, who were willing to submit to the injunction in the mean time. But the Court discharged the rule, and the Lord Chief Justice *Tindal* said, in giving judgment, "As a general rule, a plaintiff has a right to have his cause go on to trial according to the ordinary course of

Court will not stay a trial because a *scire facias* is pending.

(g) 1 Dowl. & Low. 942.

business. Special circumstances may exist, upon which the Court may see fit to interpose; but the present does not appear to us to be a case in which we ought to interfere, by staying the proceedings in the action." Trial will only be stayed under special circumstances.

But in the case of *Patteson v. Holland* (*h*), in the Common Pleas, where one action for the infringement of a patent had been tried, and a rule *nisi* for a new trial had been obtained and argued; and it appeared that another action was pending in that Court for another infringement of the same patent, and that a *scire facias* had been sued out to repeal the patent, the Court suspended their judgment upon the rule for a new trial, and ordered the trial of the other action to be postponed until after the trial of the *scire facias*. Patteson v. Holland. Trial of a second action postponed where *scire facias* pending.

And in the case of *Smith v. Upton* (*i*), in the Common Pleas, it appeared that the defendant had sued out a *scire facias* to repeal the plaintiff's patent, and a verdict had been obtained for the Crown, but a rule *nisi* for a new trial was pending in the Queen's Bench. Whilst the rule for a new trial was pending in the Queen's Bench, the defendant in the action in the Common Pleas gave notice of trial by proviso, but the Court, upon the application of the plaintiff, made a rule absolute for postponing the trial. Smith v. Upton. Trial postponed where *scire facias* pending and notice of trial by proviso given.

The defendant in a patent action almost always pleads not guilty, or some other plea, raising an issue upon which the burthen of proof rests with the plaintiff. The plaintiff's counsel in such an action, therefore, generally obtains the right to begin, and also to reply, at the trial of the cause, if the defendant calls witnesses. As the determination of the issues; in fact, in an action respecting a patent frequently turns upon nice distinctions and the credit to be given to the respective witnesses, the right to reply is generally esteemed to be of the greatest value; and a defendant will sometimes have recourse to an action of *scire facias*, in order to obtain this advantage. Right to begin and to reply.

The reading of the notice of objections will not give the plaintiff's counsel a right to reply; and it seems that the proper course is, that the notice should be read at the time the pleadings are opened (*k*).

(*h*) T. T. 1845, not yet reported.
(*i*) 6 M. & G. 251.

(*k*) *Neilson v. Harford*, 1 Webs. R. 309, n. (*h*),

Objections at the trial.

It is provided by the 5 & 6 Will. IV. c. 83, s. 5, already noticed (*l*), that no objection shall be allowed to be made on behalf of a defendant at the trial, unless he prove the objections stated in his notice. The language of this enactment is very extraordinary; and it seems that according to the letter of this law, if a defendant were to prove the objections stated in his notice, he would not be prevented from taking other objections (*m*). This, however, could hardly be the intention of the legislature; and although there has been no decision upon the point, yet it is apprehended that a defendant cannot be permitted to take any objection which is not actually stated in the notice. For in a subsequent part of the same section of the Act, it is provided that a Judge at Chambers may give leave to a defendant to offer other objections beside those included in his notice, which would have been unnecessary if the proof of the objections stated in the notice would enable the defendant to take others also.

The only question at the trial respecting a notice is, whether the language of it is sufficiently extensive.

There are very few, if any, reported decisions respecting the sufficiency of notices to let in the defendant's objections at *Nisi Prius*. It has, however, been held, that the only question which can arise at *Nisi Prius* respecting such a notice is, whether the language of it is sufficiently extensive to include any particular objections sought to be raised by the defendant (*n*).

The statute only extends to objections to the validity of the patent.

It seems that the provision of the statute respecting notices must be construed to extend only to objections *to the validity of the patent*; and that it is unnecessary (although usual) to state in the notice of objections that the defendant will deny the alleged infringement of the patent. And if a defence to the action should be a denial under the plea of *non concessit*, that there is in fact any such patent as the plaintiff alleges, it does not appear to be necessary to state the defence in the notice of objections; for if the defence can be sustained, it is not an objection to a patent, no such patent as alleged being in existence. So if the defendant objects to the patent being received in evidence for want of a stamp, the objection does not seem to be one of which notice need be given to the plaintiff.

(*l*) Vide *ante*, p. 284.

(*n*) *Neilson v. Harford*, 1 Webs. R.

(*m*) Vide per *Rolfe*, B., in *Neilson v. Harford*, 1 Webs. R. 332.

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The defendant cannot at the trial be allowed to take any objection to the validity of the patent, unless he has raised the objection by a proper plea (*o*), even if proper notice has been given of the objection (*p*); for the notice of objections was not intended to supersede the necessity of the pleas required by the rules of pleading.

Defendant cannot take any objection without a proper plea.

But although a defendant is at liberty to take any objection to a patent which comes fairly within the meaning of the language in his notice, yet he must make the objection clear at the trial, so that the plaintiff's attention may be called to it, or the defendant will not afterwards be allowed the benefit of his objection upon a rule *nisi* to enter a nonsuit or verdict for him (*q*).

Defendant must state his objections clearly at the trial.

It is the province of the jury at the trial to determine each issue in fact which is developed by the pleadings; but they have nothing to do with the notice of objections further than to decide whether the several objections raised by the defendant are founded in fact, the sufficiency of the notice to let in the objections being a question for the Judge.

Sufficiency of notice of objections to be determined by judge.

Although the maintenance of patent rights is in some measure an infringement of the rights of the public (*r*), yet the interest which the public has in the encouragement held out to inventors by the grant of such exclusive rights is quite as great.

Interest of the public in having questions respecting patents fairly decided.

In the trial of a patent action, therefore, the public is only interested to have the questions as to the validity or invalidity of the patent fairly decided between the parties. But even if it were to the interest of the public to have a particular patent destroyed, yet at the trial of an action upon such a patent the consideration of the benefit or convenience which would accrue to the public by having the patent destroyed must be entirely disregarded.

The benefit to the public by destruction of a patent not to be considered.

Thus in the case of *Arkwright v. Nightingale* (*s*), it was urged by the defendant's counsel, that it was highly for the public benefit that a verdict should be given against Mr. Arkwright the patentee; but Lord *Loughborough*, before whom

Arkwright v. Nightingale.

(*o*) *Walton v. Potter*, 1 Webs. R. 601.

(*p*) *Gillet v. Wilby*, 1 Webs. R. 270; 9 C. & P. 334.

(*q*) *Beckford v. Skewes*, 1 Webs. R. 219.

(*r*) *Vide ante*, Chap. I. p. 2.

(*s*) *Dav. P. C.* 51, 52, 55.

the cause was tried said, "We must never decide private rights upon any idea of public benefit. I must tell the jury, that they must shut out that part of the argument. I cannot let a cause between *A.* and *B.* be determined upon consequential reasons, that it is beneficial to the public that *A.* should prevail." And although it was urged for the defendant, that by the statute against monopolies (*t*), no patent is to prevail that is generally inconvenient or against public trade, yet his Lordship held that the question of public benefit must be excluded; and said, that "Nothing could be more essentially mischievous than that questions of property between *A.* and *B.*, should ever be permitted to be decided upon considerations of public convenience or expediency. The only question that can be agitated in Westminster Hall, is which of the two parties in law or justice ought to recover."

Damages.

The plaintiff in a patent action is, strictly speaking, entitled to recover such an amount of damages as will fairly compensate him for the injury which he has sustained by reason of the wrongful Acts of the defendant proved at the trial. Patent actions, however, are generally brought merely to try the validity of the letters patent, and not for the recovery of substantial damages from the defendants. It is usual, therefore, to ask and obtain a verdict for nominal damages only, for a patent being once established at Law, the Court of Chancery will afterwards support, and effectually protect, the rights of the patentee.

Usual to give a verdict for nominal damages only.

What must be proved to obtain substantial damages.

In order to recover substantial damages in a patent action, it would be necessary for the plaintiff to give such evidence as would enable the jury to estimate the extent of the loss and injury which he has sustained; and in the absence of such evidence, the plaintiff is not entitled to more than nominal damages. And even in a second action upon a patent which has been held to be valid, the plaintiff is not entitled, in the absence of such evidence, to more than nominal damages (*u*): The infringement of a patent is usually carried on in secrecy and even when that is not so, a patentee would find much difficulty in procuring the evidence necessary to show the

Difficulty of procuring evidence of infringements.

(*t*) 21 Jac. I. c. 3, s. 6.

(*u*) *Minter v. Mower*, 1 Webs. R. 138; see the observations of Lord

Loughborough, in *Arkwright v. Nightingale*, Dav. P. C. 55.

actual extent to which a defendant has carried the infringement so as to enable a jury to award him an adequate remuneration for the injury he has sustained.

In a Court of Equity, however, where a defendant is obliged to make full discovery on oath of all the particulars in any way relating to the infringement of the patent, and the amount of profit he has thereby made, as well as to produce all his books, accounts, &c., the plaintiff may recover some adequate recompence for the amount of his losses (x).

There have been cases, however, in which plaintiffs have recovered substantial damages for the infringement of their patent rights (y); and where a plaintiff is able to give evidence of any considerable amount of infringement, it may be better in some cases at once to seek for substantial damages at the hands of a jury rather than have recourse to dilatory and expensive proceedings in the Court of Chancery.

If a suit in Equity is pending or intended to be commenced against the defendant in a patent action, the plaintiff ought not to ask for more than nominal damages at the trial of the action; for he cannot claim to be recompensed twice, and if he has once asked a jury to assess them, he cannot afterwards, it is apprehended, go into a Court of Equity, and say that the jury have not sufficiently recompensed him for the injury which he has sustained.

But it is usual for a plaintiff to endeavour to procure a verdict for forty shillings at least, because a verdict for a smaller amount of damages will not, since the passing of a recent statute (z), enable him to recover his costs in the action.

New and important points of law frequently arise at the trial of patent causes, and a verdict for the plaintiff or defendant in such a cause is generally followed by an application by the unsuccessful party for a new trial, for a nonsuit, or for judgment, notwithstanding the verdict. There is, however, nothing particular respecting such applications which need to be noticed in a work of this description.

(x) Vide sec. 3, *post*, in this Chap.

(y) See *Lewis v. Mc King*, 4 C. & P. 52, in which the plaintiff obtained a verdict for 200*l.* damages. There is, how-

ever, no subsequently reported case in which more than nominal damages was recovered.

(z) 3 & 4 Vict. c. 24.

Costs.
Nominal
damages for-
merly carried
costs.

Before the passing of a recent statute, (3 & 4 Vict. c. 24,) nominal damages in a patent action were sufficient to entitle the plaintiff to recover his full costs against the defendant; but the Judge before whom the action was tried might have certified, under the 43 Eliz. c. 6, s. 2, to deprive the plaintiff of costs.

Stat. 3 & 4
Vict. c. 24, s. 1.

If plaintiff
recover less
damages than
40s. he is not
to be entitled
to any costs.

By the statute 3 & 4 Vict. c. 24, s. 1, so much of the 43 Eliz. c. 6, as relates to costs in actions of trespass on the case, (which includes patent actions) is repealed; and by section 2, it is enacted, "That if the plaintiff in any action of trespass, or trespass on the case brought in any of the Courts at Westminster, or the Courts of Common Pleas at Lancaster or Durham, shall recover by the verdict of a jury less damages than forty shillings, such plaintiff shall not be entitled to recover or obtain from the defendant, in respect of such verdict, any costs whatever, whether it shall be given upon any issue or issues tried, or judgment shall have passed by default, unless the Judge or presiding officer before whom such verdict shall be obtained, shall *immediately afterwards* certify on the back of the record, or on the writ of trial or writ of inquiry, that the action was really brought to try a right, besides the mere right to recover damages for the trespass or grievance for which the action shall have been brought, or that the trespass or grievance in respect of which the action was brought, was wilful and malicious."

Unless the
Judge certify
that the action
was brought to
try a right.

Statute
deprives
plaintiff of costs
unless he ob-
tains a certi-
ficate.

The effect of this enactment is to deprive the plaintiff in a patent action of any costs whatever, unless he procures a certificate by the Judge who tries the cause that the action was really brought to try a right, besides the mere right to recover damages (a).

Gillet v. Green.

In the case of *Gillet v. Green* (b), which was tried immediately after the stat. (3 & 4 Vict. c. 24,) came into operation, the effect of the statute upon patent actions was not adverted to. The plaintiff in that case obtained a verdict for nominal damages, but did not apply for a certificate under the Act; and it was held by the Court of Exchequer, that the statute clearly applied to the action, and deprived the plaintiff of all right to costs. And in the same case it was held, that the

Certificate can
only be granted.

(a) See the Forms of Certificates in the Appendix, Chap. II. s. 4.

(b) 7 M. & W. 347.

Judge had not power afterwards (several months had elapsed) to grant the plaintiff a certificate, and the Court intimated that it might even be a question whether the Judge could grant the certificate after another cause had been called on. immediately after trial.

By the statute 5 & 6 Will. IV. c. 83, s. 6, it is enacted, "That in any action brought for infringing the right granted by any letters patent, in taxing the costs thereof, regard shall be had to the part of such case which has been proved at the trial, which shall be certified by the Judge before whom the same shall be had, and the costs of each part of the case shall be given according as either party has succeeded or failed therein, regard being had to the notice of objections, as well as the counts in the declaration, and *without regard to the general result of the trial.*" Stat. 5 & 6 Will. IV. c. 83, s. 6. In taxing costs, regard to be had to part of case proved and certified by judge.

It was decided in the case of *Losh v. Hague (c)*, that this enactment does not repeal sect. 74 of the general rules of Hilary Term, 2 Will. IV. (*d*), as to patent actions. By that rule, it is ordered that "No costs shall be allowed on taxation to a plaintiff upon any counts or issues upon which he has not succeeded; and the costs of all issues found for the defendant shall be deducted from the plaintiff's costs." The statute does not repeal R. G. H. T. 2. Will. IV. s. 74. Costs to be allowed to each party upon the issues upon which he has succeeded.

In *Losh v. Hague (c)*, there were four issues raised by the pleadings, and the defendant had given notice of seven objections to the patent. At the trial the defendant succeeded in establishing one of his objections, which was applicable under the third issue, but failed as to his other objections, and the plaintiff had a verdict upon the other three issues. The issue upon which the defendant succeeded being a bar to the whole cause of action, the Master in taxing the costs allowed the defendant *the general costs* of the cause, as well as those on the third issue, from which he deducted the plaintiff's costs of the three issues upon which he had succeeded. It was contended for the plaintiff, that the above section of the general rules was rendered inoperative by the 6th section of the stat. 5 & 6 Will. IV. c. 83; and that the plaintiff was therefore entitled to three fourths of the *general costs* of the cause. The Court of Exchequer, however, held that the statute had not the effect contended for, and that the defendant was entitled to the general costs of the cause. Losh v. Hague.

(c) 7 Dowl. 495.

(d) Charn. New Rules, p. 64.

Treble costs.
Stat. 5 & 6
Will. IV. c. 83,
s. 3.
Judge may
certify that the
validity of a
patent came in
question before
him.

Certificate
being given in
evidence in any
other suit if
patentee obtain
a verdict, he is
to receive treble
costs unless
judge certifies
to the con-
trary.

Object of the
statute to pro-
tect established
patents.
Great cost of
establishing
patents.

There are some
costs which a
defendant can-
not be called

By the stat. 5 & 6 Will. IV. c. 83, s. 3, it is enacted, that
“ If any action at Law [or any suit in Equity] for an account
shall be brought in respect of any alleged infringement of such
letters patent heretofore or hereafter granted [or any *scire*
facias to repeal such letters patent], and if a verdict shall
pass for the patentee or his assigns, [or if a final decree or
decretal order shall be made for him or them upon the merits
of the suit,] it shall be lawful for the Judge, before whom
such action shall be tried, to certify on the record (*d*), [or the
Judge who shall make such decree or order, to give a certificate
under his hand,] that the validity of the patent came in ques-
tion before him; which record or certificate being given in
evidence in any other suit or action whatever touching such
patent, if a verdict shall pass, or decree or decretal order be
made in favour of such patentee, or his assigns, he or they
shall receive treble costs in such suit or action, *to be taxed at*
three times the taxed costs, unless the Judge making such
second or other decree or order, or trying such second or other
action, shall certify that he ought not to have such treble
costs (*e*).

The object of this enactment was doubtless to protect a
patentee who has fairly once established the validity of his patent
in a Court of Law or Equity. A patentee can rarely estab-
lish the validity of his patent without incurring a very large
amount of costs both at Law and in Equity; and when he
does at last succeed in his object, he finds that he is not allowed
on taxation as against his opponent much more than half the
amount of the costs he has incurred.

This is a most serious grievance to patentees, but it is diffi-
cult to provide a remedy. The subject of a patent must be
new to every one to whom the patentee may apply for assist-
ance; and he almost always finds that he must remunerate
men of science and skill for their loss of time in making them-
selves sufficiently acquainted with the subject of his invention
to enable them to give evidence in his favour.

The amount of costs which a patentee must incur in this
manner is sometimes very great; but when the validity of a
patent has not been previously established in a Court of Law,

(*d*) See the Forms of Certificate in
the Appendix, Chap. II. s. 4.

(*e*) See the Forms of Certificate in
the Appendix, Chap. II. s. 4.

it is difficult to say that a defendant should be compelled to pay upon to pay if the amount of costs which the plaintiff may have so incurred. patent not previously established. Our law reports show that patent actions have raised points of law most difficult to determine, and respecting which Judges of the greatest eminence have differed in opinion. The plaintiff's right on the one hand to a patent privilege, and the defendant's right on the other hand, as one of the public, to the use and exercise of the alleged invention, may, and frequently does, depend upon questions of science or fact the most difficult to solve. It would hardly be fair, therefore, to saddle a defendant with the payment of the costs of determining questions of so much doubt and difficulty. And it has been held (*f*) that a plaintiff is not entitled to the costs of experiments necessarily made for the purposes of procuring evidence in the cause.

It seems to be a fair rule to lay down, that a party who succeeds in a cause (whether plaintiff or defendant) should be allowed upon taxation all the costs which he has necessarily or fairly incurred in order to procure success; but this or any other general rule which could be laid down, would be most difficult of application in practice. Rules respecting the taxation of costs difficult of application.

The rules of taxation which prevail in our Courts might, however, be very advantageously relaxed in favour of parties trying such causes as patent actions. The very strict manner in which our Courts have at all times taxed costs as between party and party seems to have had its origin in a desire to repress frivolous and vindictive litigation; and there can be no doubt that the effect has been to diminish such litigation very much. But the application of the existing strict rules of taxation to patent actions frequently operates very unfairly to the prejudice of successful parties in such actions, by depriving them of a large amount of their costs, although such costs are such as every prudent man would have incurred in order to insure success. A more liberal mode of taxing costs in such actions would be a great boon to the parties, and remove many of the difficulties under which they labour. Rules of taxation might be beneficially relaxed in patent actions.

Before a patentee has established his claim to a patent privilege by legal proceedings, he has no proof of his title except his patent, and that has been obtained upon his own unsupported A patentee who has established his patent at law is fairly

(*f*) *Severn v. Olive*, 3 B. & B. 72.

entitled to be better protected.

Protection cannot be extended so far as to prevent others from disputing the patent.

But patentee ought to recover full costs if he succeeds in other actions.

Object of the statute to indemnify patentees, and prevent vexatious infringements.

To obtain the protection of the statute a certificate is necessary.

Stocker v. Rodgers.

Where a verdict is obtained by consent, a certificate will not be granted.

representation. But when a patentee's title to a patent privilege has been once fairly established in a Court of Law or Equity, he stands in a very different position; and he may very fairly claim to be better protected by the law than a patentee, who has no verdict, judgment, or decree, evidencing his title to such a privilege. It would not be fair to extend the protection to a patentee who has established his patent right in an action at Law, so far as to prevent any person from afterwards contesting the validity of the patent; for the defendant in an action might, through ignorance or collusion with the plaintiff, suffer him to obtain a verdict, and other persons may afterwards be able to show that the patent is void. But when the patentee has the evidence of a verdict or judgment in his favour, it is only proper that he should be so far protected; that if he is again compelled to try the validity of his patent, he should be enabled to recover the full amount of his costs if he again succeeds in establishing his title. The object of the enactment already stated (g) was to indemnify patentees against their costs in actions which they may be compelled to bring after they have established their patent, and also to deter persons from committing vexatious infringements of such patents by the penalty of treble costs.

In order to obtain the protection of this enactment, however, it is not sufficient for a patentee merely to obtain a verdict or decree, but he must also obtain the certificate of the Judge before whom the cause was tried or heard, that the validity of the patent came in question before him. And this is made necessary because the pleadings in a cause might, upon the face of them, appear to raise almost every possible question respecting the validity of the patent; and yet the defendant may not at the trial or hearing raise any such question.

Thus in the case of *Stocker v. Rodgers* (h), the defendant pleaded pleas putting the validity of the patent in issue (i); but he offered no defence at the trial, and consented to a verdict for forty shillings damages. The learned Judge (*Erskine, J.*) who tried the cause, refused to give the plaintiff a certificate that the validity of the patent came in question; and

(g) *Ante*, p. 300.

(h) 1 C. & K. 99.

(i) The pleas denied the novelty of

the invention and the sufficiency of the specification.

his Lordship said, "I think that as this is a verdict by consent, and as no evidence has been adduced before me, I ought not to grant a certificate. My certificate would affect third parties; and it would be possible, in a case like the present, for two parties, by collusion, to consent to a verdict in favour of a patent; and if they could obtain a certificate under the third section of the statute, to use it afterwards to the injury of another party who was really contesting the validity of the patent."

But in a case where the validity of the patent did partly come in question, a certificate was granted although the defendant did not call any witnesses (*l*).

It is sufficient if validity of patent comes partly in question.

The costs which this statute enabled the plaintiff in a second or subsequent action to recover, were treble costs, *to be taxed at three times the taxed costs*. The term treble costs in our Courts does not mean three times the amount of the parties' taxed costs; being in fact less than twice the amount of such costs. The amount of treble costs is made up thus: to the sum allowed to the party for costs taxed in the ordinary way is added one half of that sum, and also one fourth of the same sum, and these three sums being added together form what is technically termed treble costs (*m*). But this statute provided, that the treble costs to be allowed to patentee plaintiffs should be not the ordinary treble costs, but treble costs "taxed at three times the taxed costs."

Treble costs how taxed.

The amount awarded to a plaintiff for costs in pursuance of this statute, might be more than the amount which he actually incurred in the action; but the intention no doubt was, that he should receive the sum (if any) which he recovered from the defendant above the actual amount of his costs, by way of a penalty, and to indemnify him against losses, the amount of which could hardly be ascertained.

Extra amount of costs intended as a penalty.

The amount of costs to be allowed to a plaintiff in pursuance of this statute, has, however, been materially varied by the recent statute of 5 & 6 Vict. c. 97, which, in fact, takes away treble costs altogether, except under private or local Acts, and substitutes what may be termed *full costs* instead.

Treble costs taken away by stat. 5 & 6 Vict. c. 97, and full costs given.

By the first section of that Act it is enacted, that "so

Stat. 5 & 6 Vict. c. 97. s. 1.

(*l*) *Gillet v. Wilby*, 9 C. & P. 334; 1 Webs. R. 270.

(*m*) See Tidd's Practice, and Chit. Arch. prac. tit. Treble Costs.

All enactments giving treble costs or more than usual costs repealed.

Parties to be entitled to full costs instead of treble costs, &c.

Costs under 5 & 6 Will. IV. c. 83, s. 3, must now be full costs.

Judge may certify to deprive plaintiff of full costs in a second action.

Intent of the statute.

much of any clause, enactment, or provision in any public Act or Acts, not local or personal, whereby it is enacted or provided that either double or treble costs, or any other than the usual costs between party and party, shall or may be recovered, shall be, and the same are hereby repealed: Provided always, that instead of such costs the party or parties heretofore entitled under such last-mentioned Acts to such double, treble, or other costs, shall receive such full and reasonable indemnity as to all costs, charges, and expenses incurred in and about any action, suit, or other legal proceeding, as shall be taxed by the proper officer in that behalf, subject to be reviewed in like manner and by the same authority as any other taxation of costs by such officer."

The costs, therefore, to be allowed to a plaintiff in a second or subsequent action upon a patent, under the 5 & 6 Will. IV. c. 83, s. 3, as altered by the 5 & 6 Vict. c. 97, s. 1, must be taxed in such a way as to be a "full and reasonable indemnity as to all costs, charges, and expenses incurred in and about" the action (*n*). It is difficult to say what construction will be put upon this statute, but there can be little doubt that it will be construed liberally, and that a plaintiff will under these statutes be allowed the amount of his costs taxed as between attorney and client.

The right of a patentee to have full costs under these two statutes, in a second or other subsequent action, is, however, dependent upon the discretion of the Judge before whom the cause is tried, who may certify so as to deprive him of such costs. By the 5 & 6 Will. IV. c. 83, s. 3, already stated (*o*), it is provided that a patentee shall recover treble costs in a second or other subsequent action, unless the Judge trying such second or other action shall certify that he ought not to have such costs. That provision of course extends to the full costs by the stat. 5 & 6 Vict. c. 97, s. 1, substituted for treble costs, and enables the Judge to certify that a plaintiff ought not to have such costs.

It seems to have been intended by this provision, that although, as a general rule, a patentee in a second or other action, should have treble (now full) costs; yet, that if it should

(*n*) See the Form of Certificate, under these two statutes, in the Appendix.

(*o*) *Ante*, p. 300.

appear to the Judge trying the second or other action, that the patentee ought not to have such costs, the Judge might certify so as to prevent him from obtaining them.

Such a provision was necessary in order to enable a Judge to prevent a patentee from availing himself of a certificate obtained in an action tried by collusion for the purpose of obtaining it. And there may be many other cases in which a Judge would not allow a patentee to have full costs under the statutes; as, if it should appear to him that an action was a harsh or unnecessary proceeding; or that the defendant did not question the validity of the patent, but defended the action *bonâ fide* for the purpose of trying a doubtful question of infringement; in such cases it is to be apprehended that a Judge would certify in order to prevent a plaintiff from obtaining more than ordinary costs from a defendant.

Power of certifying to deprive plaintiff of full costs necessary to prevent collusion.

The form of certificate in such a case would be under the first statute, as altered by the second, that the plaintiff ought not to have full and reasonable indemnity as to all his costs, charges, and expenses, in pursuance of the statutes (*p*).

Form of certificate.

SECTION III.

Of a Suit in Equity.

It is a general rule, that a person is entitled to maintain a suit in Equity only when he can have no adequate or sufficient remedy in a Court of Law. The objects which a patentee has in view when he has recourse to legal proceedings against any person who infringes his patent, are: *firstly*, To put a stop to the further invasion of his rights; and, *secondly*, To recover a recompence for the injury which he may have sustained by the violation of his patent privilege.

Remedy in equity when none at law. Objects of a patent suit.

In order to restrain the further infringement of a patent, it is absolutely necessary to have recourse to a suit in Equity; for a Court of Law has power only to give a patentee damages for any injury he may have sustained by the actual violation of his right, after it has been committed; and such a Court has no means or power to interfere, so as to protect a patentee against the future invasion of his rights.

Court of law has no power to prevent future infringements.

(*p*) See the Form of Certificate in the Appendix, Chap. II. s. 4.

Court of equity, by injunction, can restrain parties from infringing.

No sufficient means of recovering recompence for infringement at law.

Court of equity can compel defendant to account and make discovery.

Patentee has no adequate remedy at law.

Equity will only protect a clear legal right.

If patentee's title is denied it must be tried at law.

But a Court of Equity by means of its process of injunction, has power to command a person who has once violated a patent right, to refrain from committing any repetition of the offence, or again violating the patent in any manner whatsoever. And if such a person afterwards violates the patent, he makes himself liable to be punished by attachment, and imprisonment for contempt, at the discretion of the Court.

Nor has a Court of Common Law the means of enabling a patentee to recover an adequate recompence for the violation of his privilege. The infringement of a patent is generally committed in secret, or, at all events, under such circumstances as to preclude the possibility of procuring sufficient legal evidence of the extent of the infringement. There is, in consequence, frequently very much difficulty in the way of procuring evidence of a violation of the patent by a suspected person, and it would be almost impossible in any case to show by legal evidence in a Court of Law the full extent of the injury which the patentee has sustained by the infringement of his patent. But a Court of Equity has a power, not possessed by a Court of Law, of compelling a defendant to answer on oath the complaint made against him by the plaintiff's bill, and to make a full discovery of every thing which is necessary to enable the Court to do justice between the parties.

It is evident from what has been stated, that a patentee cannot have any adequate remedy in a Court of Law against parties who may infringe his patent; and therefore it has been held that he is entitled to the aid and protection of a Court of Equity, whenever his patent privilege has been invaded.

But the privilege conferred by a patent is a legal right (*q*), which, according to the declaration contained in the Statute of Monopolies (*r*), ought only to be tried by the Common Law of the realm. It is a maxim that equity follows the law, and therefore a Court of Equity will only protect the clear and undoubted legal right of a patentee.

And if this title of a patentee is denied by a defendant in Equity, the Court cannot dispense with the necessity which the plaintiff is under to prove a clear and undisputed *legal*

(*q*) As to the Nature of the Right, see Chap. IX. s. 1.

(*r*) 21 Jac. 1. c. 3, s. 2.