

And in the case of *Stury and Stury*, (u) the Court of Queen's Bench held, that such a writ was good, being in the form warranted by the practice of the Court of Chancery out of which it issued.

If a writ of *venire facias juratores*, issuing out of Chancery and returnable in the Queen's Bench, be not returned in the latter Court according to the exigency of the writ, an *alias venire facias* shall issue out of the Queen's Bench and not out of Chancery. (x)

The practice is for the clerk of the Petty Bag to give notice of trial in the Petty Bag Office, upon the back of the issue (or it may be given separately,) and the practice of the Court as to the length of notice required is the same as in causes in the Court of Queen's Bench.

Proceedings in the Queen's Bench.

The Court of Chancery, it is said, has power to adjourn any Common Law action there pending, and transmit the record into the Court of Queen's Bench at any time, (y) either before or after issue joined, or joinder in demurrer, (z) and in *Sarnfield's* case, (a) that was done even before plea pleaded. But this must of course be understood as applying only to cases in which the Court of Queen's Bench can exercise jurisdiction, not to an action in which the Chancery can alone give judgment.

In cases when the action can be adjourned into the Queen's Bench, the whole record is sent into that Court, together with the record, if any, upon which the action is founded. As in case of a *scire facias* upon a recognizance, not only the record *in the action, but also the recognizance [#405] itself is sent into the Queen's Bench. (b)

By the removal of the record in such cases the whole jurisdiction over the action is transferred to the Court of Queen's Bench, and in that Court alone must all the subsequent proceedings be taken in the action. (c)

But it is otherwise with an action of *scire facias* to revoke a patent, and to cancel the patent and the enrolment; in such an action the Lord Chancellor alone can give judgment to cancel the patent and enrolment, and therefore, when a trial is to be had by a jury, the tenor, or a transcript only of the record, is sent out of Chancery into the Queen's Bench, the original record and the patent roll upon which the *scire facias* is founded being retained in the Court of Chancery.

After notice of trial has been given, and an entry made upon the record in the Court of Chancery, of an award of a writ of *venire facias juratores* to the Sheriff of Middlesex by the Court, a day is to be given to the parties to be in the Queen's Bench, (which is always the return day of the writ,) and the Clerk of the Petty Bag then makes a transcript of the Chancery record upon parchment, and delivers it to the prosecutor's solicitor to be carried into the Queen's Bench in order that the issues may be there tried.

(u) 2 Rol. Rep. 291.

(x) 13 Ed. IV. 8; Staund. Prerog. 77, b.; Jenk. 133, ca. 71.

(y) 1 Ro. Abr. Chan. (F) (G), 372. (z) 2 Saund. 27.

(a) Cited 8 Co. R. 23, a.

(b) Roll. Abr. Court (G) pl. 5; 24 Ed. III. fol. 73, pl. 91; See *Bishop of Bristol v. Procter*, 1 Ro. R. 287.

(c) Vide Al. 14, 17; Sty. 90, 94; 2 Saund. 27; 1 Ro. R. 287; Eq. Cas. Abr. 129.

The action being at the suit of her Majesty, the transcript of the record when it is transmitted belongs to the Crown side of the Queen's Bench, and therefore it is always delivered into the Crown Office of that Court. (*d*)

The transcript of the record must be taken into the Crown Office before the first day of the *nisi prius* sitting at which the trial is intended to take place, so as to enable the prosecutor's attorney to prepare the *nisi prius* record, and take it to the Marshall's Office on or before that day. And the transcript must have annexed to it a copy of the notice of objections filed by the prosecutor in the Petty Bag Office.

The clerk of the Petty Bag will also prepare the writ of *venire facias juratores*, and deliver it to the prosecutor's solicitor with a transcript of [*406] the record. The writ must be taken to the office of the Sheriff of Middlesex, by whom it is to be returned into the Crown office of the Court of Queen's Bench.

It was formerly the practice to require the prosecutor and the defendant to take office copies of the record, and notice of objections as soon as it came into the Crown Office; this practice has however been abolished.

When the transcript of the record comes into the Queen's Bench, a record is made of the bringing of it into that Court, and setting out the whole of it verbatim. (*e*) Upon this Queen's Bench record all the proceedings in that Court are entered, immediately following the transcript of the Chancery record, the proceedings in the Queen's Bench being commenced by the appearance of the respective parties in that Court.

Before the passing of the recent statute of 6 & 7 Vict. c. 20, the parties prosecuting and defending an action of *scire facias* were compelled to employ clerks in Court to prosecute and defend the suit on their behalf, and the clerks in Court were in fact the actual attorneys of the parties on the record. But by the 6 and 7 Vict. c. 20, s. 1, the office of clerk in Court was abolished, and by section 14 of the same act all attorneys entitled to practice in the Queen's Bench, are enabled in like manner to practice on the Crown side of that Court.

The writ of *venire facias*, issued out of Chancery, is to be returned into the Crown Office of the Queen's Bench; and if it be actually returned, the return is recorded immediately after the entry of the appearance of the parties in that Court. But if the writ is not returned, an entry is made accordingly, upon which an *alias venire* may be awarded.

If an *alias venire facias* becomes necessary, it must be sued out of the Court of Queen's Bench, and not out of Chancery. For the *alias* writ issues upon the entry of *victimes non misit bracc*, which can only be in the Queen's Bench. (*f*)

The *alias venire* must be in the same form as that issued out of Chancery, (*g*) with the exception of the additional words—"As before we have [*407] commanded you," and the teste of the writ, which must be in the name of the Chief Justice instead of the name of the Queen herself. This writ must be tested as of the day of the last continuance previous to the award of the *distringas juratores*, and must be made returnable on a day certain, or immediately, according to the form of the prior writ out of Chancery. This writ must be prepared by the prosecutor's attorney, and

(*d*) In actions between private persons, records out of Chancery are delivered to the officers on the Plea side of the Queen's Bench.

(*e*) See the Form in the Appendix, Chap. II. s. 7.

(*f*) *Stand. Prolog.* 77, b; *Jeakins*, 3rd Cent. p. 133, ca. 71.

(*g*) See the Form in the Appendix, Chap. II. s. 5.

signed and sealed at the Crown Office, (*h*) after which the Sheriff's return must be procured in the usual way.

A side bar rule may be obtained at the Crown Office (upon production of a motion paper signed by counsel,) requiring the Sheriff to return the *venire facias*, or any other writ.

The action may be tried either at bar (*i*) or *nisi prius*. (*j*) But it cannot be tried at *nisi prius* without the consent of the Crown; (*k*) and if the consent of the Crown is withheld, the cause must be tried at bar. (*l*) The reason of this is, that the statute of Westminster, the second, which gives the writ of *nisi prius*, is not binding upon the Crown, the Crown not being expressly named in it. (*m*) The Attorney General is not, however, entitled to a *nisi prius* as of right, but the Court may, if it think fit, grant the defendant a trial at bar. (*n*)

The consent of the Crown may be granted either by writ of Privy Seal, (*o*) or by warrant under the hand of the Attorney General. (*p*) It is said in Rolle's Abridgment, (*q*) that if the King be plaintiff in any action, he shall not have a *nisi prius* without a writ directed to the justices for their warrant, and a case in the Year Book 24 Ed. III. 23 B. is cited. (*r*) The case cited, however, was in the Common Pleas, and whatever may have been the practice in that Court, a *nisi prius* may be obtained in the Queen's Bench upon the warrant of the Attorney General, without any writ of Privy Seal. [408] And it is the every-day practice of the Crown Office to grant a *nisi prius* upon such a warrant.

If an action of *scire facias* were to be tried at *nisi prius* without any writ from the Crown, or warrant from the Attorney General, the whole proceeding would be irregular.

Nor can the defendant take the action to trial at *nisi prius* by *proviso* without the consent of the Attorney General, because no *laches* can be attributed to the Queen:—and a trial at *nisi prius* by *proviso*, without such consent, would be irregular, and would be set aside. (*s*)

The writ of *distringas juratores* also issues out of the Queen's Bench, and is directed to the Sheriff of Middlesex. It must be tested as of the day of the return of the *venire facias juratores*, or if there has been an *alias venire*, then as of the day of the return of the *alias* writ. This writ must be framed in accordance with the practice of the Court of Queen's Bench, and must therefore state the substance of the issues which are to be tried. It is of course to be tested in the name of the Chief Justice, and must be made returnable on a day certain in the next ensuing term before the Queen at Westminster. (*t*)

(*h*) By 8 & 9 Vict. c. 31, s. 2, all writs on the Crown side of the Court are, after the 1st of January, 1846, to be sealed at the Crown Office.

(*i*) See *R. v. Haro*, 1 Str. 267; and *R. v. Bewdley*, 1 P. Wins. 207.

(*j*) *Eyre v. Taunton*, 3 Cro. 313.

(*k*) F. N. B. 241, A; Fitz. Abr. Nisi Pri. pl. 16; Bro. Abr. Nisi Pri. pl. 35; Sav. 2; 2 Inst. 424; and see Vin. Ab. (P. b); 2 Ro. Abr. 629 l. 10; Staund. 159.

(*l*) *R. v. Banks*, 6 Mod. 245; 2 Salk. 652, S. C.

(*o*) Hawk. Bk. 2, c. 42; Bro. Abr. Nisi Pri. pl. 35.

(*p*) *Atry's case*, 6 Mod. 123.

(*q*) 2 Inst. 555, 2 Ro. Abr. 629, l. 16-21.

(*r*) *R. v. Banks*, 6 Mod. 245; Staund. 156; and see Sav. 2.

(*s*) 2 Ro. Abr. 629; and see Vin. Ab. Trial, (P. b.)

(*t*) And see Fitz. Abr. Nisi Pri. 18.

(*u*) 2 Hawk. c. 41, s. 10; *R. v. Banks*, 6 Mod. 245; 2 Salk. 652; 2 Ld. Ray. 1,082; 11 Mod. 33, S. C.; *R. v. Dyde*, 7 T. R. 661; *R. v. Madox*, 2 East, 202.

(*v*) See the rules made for the regulation of the practice of the Crown Office, Cor. Pract. App.

The writ is to be prepared by the prosecutor's attorney, (*u*) and taken to the Crown Office to be signed and sealed, (*x*) and then it must be delivered to the Sheriff and returned by him in the usual way.

If the action is to be tried at *nisi prius*, the record must be prepared by the prosecutor's attorney in the ordinary way, (*u*) and if the trial does not take place at the sittings next after the return of the *venire facias juratores* out of Chancery, continuances must be duly entered up to the time when the trial actually takes place. If the cause is to be tried by a common jury, the continuance may be by an entry of *viccomes non misit breve*, (*y*) after the award of the *venire facias*, and an award of an *alias* writ of *venire facias*, returnable immediately before the trial. But if a special jury has been [409] nominated and reduced, and the jury process actually returned, the continuance must be entered in the same way after the award of the *distringas juratores*, (*z*)

The *nisi prius* record is a mere transcript of the Queen's Bench record, the *venire*, "Middlesex to wit," being written in the margin instead of "England to wit," which is always written in the margin of the Chancery record. The *venire* is necessarily in Middlesex, because the record upon which the *scire facias* is founded, remains in the county of Middlesex, and therefore the issues must be tried by a jury of that county, (*a*)

The *nisi prius* record is to be prepared by the prosecutor's attorney, and taken to the Queen's Bench Office to be sealed and passed. The record ought not, however, to be sealed until the Attorney General's warrant for a *nisi prius* has been obtained.

A copy of the notice of objections, and the Attorney General's warrant for the *nisi prius*, must be annexed to the *nisi prius* record, and if the cause is to be tried by a common jury, the writs of *venire facias* and *distringas*, with the Sheriff's returns to those writs, must also be annexed to it, before it is carried into the Marshall's Office.

Either the prosecutor or defendant may obtain a rule to have the action tried by a special jury, (*b*). The rule is drawn up at the Crown Office upon production of a motion paper signed by counsel; (*c*) no affidavit or Judge's order being necessary.

In order to act upon the rule, an appointment (*d*) must be obtained at the Crown Office for the nomination of the jury *thence*, and the rule and appointment must be served upon the Sheriff, and the opposite party. The rule must be produced at the chambers of the Lord Chief Justice, in order to have the cause marked as a special jury cause, on or before the day preceding the adjournment day of the Middlesex sittings after term, (*e*). When the adverse [410] party does not appear upon the first appointment, the party which obtained the appointment must (after waiting half an hour) procure a peremptory appointment. If the adverse party does not appear upon the peremptory appointment, the party who procured it may after waiting an hour proceed with the nomination *ex parte*. The nomination is made at the Crown Office by the clerk or officer there in this manner: (*f*) he will draw forty-eight

(a) See the Form in the Appendix, Chap. II. s. 7.

(b) 8 & 9 Vict. c. 31, s. 2; see note (*h*), last page.

(c) See 1 Str. 267.

(d) See the Form in the Appendix, Chap. II. s. 7; and see also *R. v. Haro*, 1 Str. 267.

(e) See Bro. Abr. s. l. Pa. pl. 189.

(f) See 6 Geo. IV. c. 50, s. 30.

(g) See Cooper's Crown Practice, 137.

(h) See 6 Geo. IV. c. 50, s. 32.

(i) *R. G. Ill* 44 Geo. III., 1805; Peacock, 197. The adjournment day is the second day after the last day of the sittings after term, or the third if a Sunday intervenes.

(j) 6 Geo. IV. c. 50, s. 32.

cards (having numbers written upon them) successively out of a ballot box, and upon drawing each card reference will be made to the name in the Sheriff's book or list of special jurors opposite to the number corresponding with that on the card, and each of the names thus obtained will be placed upon the list of jurors nominated to try the action. It is usual for the parties attending to take a copy of the list so made for the purpose of making inquiries before reducing the list. (g)

An appointment to reduce the number of jurors on this list from forty-eight to twenty-four may be obtained immediately or at any time after the nomination. The appointment to reduce must be served on the opposite party, and if he fail to attend the first appointment a peremptory appointment should be obtained.

If the parties both appear, the list is reduced by the prosecutor and defendant alternately striking out a name until the number of jurors on the list is reduced to twenty-four. If the opposite party fail to appear upon the peremptory appointment to reduce, the party striking the jury must produce an affidavit of the due service upon the proper party of the rule, and of the appointment to nominate and reduce, and then the Master or his clerk will strike out names for the absent party. (h)

The twenty-four names which remain in the reduced list are those of the jurors which must be summoned to try the issues joined in the action. (i) For that purpose the reduced list is to be signed by the Master, and annexed to the *venire facias*, and taken to the Sheriff. When a day for the trial of the cause has been appointed, the Sheriff will summon the *jurors, and copy [*411] the names into a panel, and return the writ, with the panel annexed, into Court on the day appointed. And when a special jury has thus been struck and reduced, the cause cannot be tried by any other jury, (j) unless the rule for the special jury is first discharged.

If the party who obtains a rule for a special jury neglects to proceed to a nomination of the jury, the opposite party may obtain an office copy of the rule, and proceed upon it as if it were his own rule. So if a party after the nomination of the jury fail to proceed to reduce the list, the opposite party may obtain an appointment to reduce upon an office copy of the rule, and proceed upon it in like manner as the other party could have done.

If the defendant procures a rule for a special jury for the purpose of delay, and neglects to proceed to strike and reduce the jury, the prosecutor may move to discharge the rule, (k) or he may obtain a summons calling upon the defendant to show cause why the action should not be tried by a common jury; (l) or the prosecutor may disregard the rule, and proceed to try the action by a common jury. (m)

Writs of *subpœna ad testificandum* and *duces tecum* in this action must be issued out of the Crown Office. In order to obtain such a writ, it must be engrossed on parchment by the attorney of the party suing it out, (n) it must

(g) The Sheriff is entitled to two guineas for attending, and the Master one guinea for the nomination. These fees must be paid by the party striking the jury.

(h) See Corner's Prac. 137, 138; Hand's Crow. Prac. 10; and R. v. Hart, 1 Cowp. 412.

(i) 6 Geo. IV. c. 50, s. 30.

(j) R. v. Perry, 5 T. R. 453; and R. v. Franklin, cited there.

(k) Stanbury v. Gillet, 9 Bing. 319; Phelps v. Kelly, 3 M. & G. 883; Chuck v. Harris, 1 M. & G. 940; *Anon.* 1 Chit. 490, n.

(l) R. v. Smith, Corn. Cr. Prac. 138.

(m) See 1 Stark. R. 31; Gunn v. Honeyman, 2 B. & Ald. 400; Johnson v. Blackwell, 6 C. & P. 236.

(n) See the Form in the Appendix, Chap. II. s. 7.

then be taken to the Crown Office with a *præcipe*, where the writ will be signed and sealed, (o) and the *præcipe* filed. The writ must be tested as of the day it is issued.

The Queen being a party to the action, a *tales* cannot be prayed by either party at the trial without the Attorney General's warrant. (p) Whenever the cause has been made a special jury cause therefore, each party ought to provide [*412] himself with such a warrant which will be granted as of course. (q) *The warrant may be used or not at the discretion of the party who obtained it. (r)

The record must be entered for trial with the Marshall of the Queen's Bench, and the record carried in to the Marshall's office in the same way as in other causes to be tried at the *nisi prius* sittings after term for Middlesex; the record must therefore be taken to the office on or before the first day of the sittings at which it is to be tried.

When the action of *scire facias* is at the suit of the Crown, it is necessary to make a proclamation at the trial as soon as the jury appears, for the prosecutor is not named in the record, and therefore the Court cannot have any judicial knowledge on the subject. (s) Upon the proclamation being made, the counsel for the prosecution appears for the Crown, and then the jury is sworn and the trial proceeds.

The prosecutor's counsel is entitled to begin and give evidence in support of the prosecutor's objections to the patent, or such of them as are admissible under the suggestions contained in the writ. And as he is entitled to begin, so will he be entitled to the reply if the defendant should give any evidence.

The Queen being a party, the defendant cannot demur to the evidence for the Crown, unless the counsel for the Crown consent; but if the consent of the Crown is refused, the Court ought to direct the jury to find the special matter, upon which the law may afterwards be adjudged. (t)

There is considerable doubt whether a bill of exceptions can be allowed in any case where the Queen is a party, for the Crown is not expressly named in the statute of Westminster, the second (u) which gives the bill of exceptions. (x)

It has also been doubted whether a bill of exceptions lies upon proceedings in the Petty Bag in Chancery; but that doubt seems to be set at rest by the opinion of the Judges in a case which occurred before Lord Keeper *Harcourt*. [*413] Copies of the Lord Keeper's letter to the Chief Justice of the King's Bench, and the answer of the Chief Justice, with the opinion of the Judges, have been preserved in the office of the Petty Bag. (y)

(o) 8 & 9 Vict. c. 31, s. 2, and see n. (b), p. 407.

(p) 2 Hawk. c. 21, s. 18.

(q) See the Form in the Appendix, Chap. II. s. 7.

(r) See 6 Geo. IV. c. 50, s. 37.

(s) See 9 Co. R. 101, a.

(t) Baker's case, 5 Co. R. 104, a.; Co. Lit. 72, a.; Doct. plac. 119; Middleton v. Baker, Cro. Eliz. 751, 752.

(u) 13 Ed. I. c. 31.

(x) See 2 Hawk. c. 16, s. 20; R. v. Vane, 1 Sid. 85; Kely. 15; 1 Keb. 32; 1 Lev. 68, S. C.; Willis, 535; and 2 Inst. 427.

(y) The following are copies of the letter and answer:

Lord Keeper's Letter to the Lord Chief Justice.

“MR LORD:—On Thursday last, Mr. Attorney General moved the Court of Chancery to discharge a frivolous plea in abatement to a *scire facias* depending in the Petty Bag. On hearing counsel on both sides, I was of opinion that the plea was frivolous, and ordered it to be discharged. The defendant's counsel, immediately upon my pronouncing the order, produced a Bill of Exceptions, ready engrossed, in ten large skins of parchment, at which

When there are several suggestions in a writ of *scire facias*, [*414] each suggestion, (to be valid,) ought to show sufficient cause for the repealing and cancelling of the patent. If issue be taken upon each of these suggestions, a verdict upon any one of the issues will be sufficient to entitle the Crown to judgment; all the other issues will of course become immaterial, and the Judge it seems has authority, in such a case, to discharge the jury from giving any verdict upon them. (z)

Thus in the case of *The Queen v. Nickels*, (a) an objection was taken by the prosecutor's counsel to the sufficiency of the specification, and as the objection arose upon the face of the specification, and respecting the construction to be put upon the words of the instrument, Lord Denman, C. J., directed the jury to find a verdict for the Crown upon the issue respecting the sufficiency of the specification, and discharged them from giving any verdict upon the other issues in the action. (b)

sired me to seal it. I forbear to trouble your Lordship with any account with respect to the nature of the writ, or of the plea, or the manner of tendering the bill to me.

"The length of the bill made it necessary for me to take time to examine the truth of it; but, on further consideration, I am under some doubt whether a Bill of Exception lyes from a judgment given by the Court of Chancery in a suit depending in the Petty Bag.

"The mischief, in my apprehension, is the same as in the case of an erroneous judgment in any other Court of Record, and yet, since I have not mett with any president of tendering a Bill of Exceptions to the Court of Chancery, and forasmuch as the remedy for obliging the Justices to set their seals, seems very improper to be taken in the case of the Keeper of the Great Seal, I entreat the favor of your Lordship, if your Lordship conceives there is any doubt in this case, to take the opinions of all the Judges, and to give yourself the trouble of certifying their opinions to me.

"I am, my Lord,
"Your Lordship's very
"humble Servant,
"Harcourt."

"17 Nov. 1711."

The Answer of the Lord Chief Justice.

"My Lord:—I have desired the opinions of my Lord Chief Justice of the Common Pleas, my Lord Chief Baron, and the rest of the Judges upon the question proposed by your Lordship in your letter to me of the 17th of November last.

"Whether a Bill of Exceptions lyes upon proceedings in the Court of Chancery in a suit depending in the Petty Bag.

"After having met, and heard council on both sides, and conferred together, we all take the point to be entirely new, for neither any of our own experience, or reading, nor the industry of the parties or their council, have furnished us with any one instance of a Bill of Exceptions in Chancery before this which occasions the present question. But yet, from the nature of the act of Parliament whereby the Bill of Exceptions is given, which is an advancement of justice, the extensive words which are used in it, and the more extensive exposition which from time to time have carry'd it beyond the strict words to cases and courts within the same mischief; and because the mischief is the same in cases of an erroneous judgment in the Court of Chancery as in any other Court, which your Lordship, in proposing this question, is pleased to intimate as of great weight with yourself. We are all of opinion that a Bill of Exceptions doth lye upon proceedings in the Court of Chancery in a suit depending in the Petty Bag. I could not lay this sooner before your Lordship, having not had the final resolution of the Judges till last night, when we all mett together for that purpose."

"23rd Jan. 1712."

(z) *R. v. Johnson*, 5 A. & E. 488; *Cook v. Caldecott*, 4 C. & P. 315; but see *Tolson v. Kaye*, 6 M. & G. 589, and the observations of Parke, B., in *Duckworth v. Harrison*, 4 M. & W. 444.

(a) MS.

(b) See further on the subject of discharging a jury as to immaterial issues, *Powell v. Sematt*, 1 Dow. N. S. 56; 1 Bligh. N. S. 545; 3 Bing. 381; 1 Moore, 330, 8 C.; *Duckworth v. Harrison*, 4 M. & W. 444; *R. v. Johnson*, 5 A. & E. 488, and 6 M. & G. 259, n.

At Common Law, after the issuing of a *distringas*, a new *venire* could not be awarded, (c) and it seems that the statutes 7 & 8 Will. III. c. 32, sec. 1, and 6 Geo. IV. c. 50, s. 16, which give such a writ in other actions, do not extend to a *scire facias* in which the Queen is a party, for the Crown is not particularly named in either enactment. (d) And in the case of *Pretious v. Robinson*, (e) (which was before the passing of either of these statutes,) there was a second *venire* awarded; it was held that the trial was void.

Whether the action has been tried at bar or at *nisi prius*, the Court of Queen's Bench has power to grant a new trial. (f) For the transcript of the record is sent into the Queen's Bench, to the end that the issues may be tried, and until the issues have been *properly* tried, the Queen's Bench cannot certify the [*415] Chancery respecting the result. It has *consequently been the constant practice to move the Court of Queen's Bench for new trials in actions of *scire facias*. (g)

Some question was at one time made respecting the proper Court in which to sign judgment after a verdict for the Crown, but it seems that the judgment can only properly be signed in the Court of Chancery.

It is a general rule that when a record once comes out of any other Court into the Queen's Bench, it is not to be remanded. (h) But to that rule there are several exceptions. Thus in Brooke's Abridgment, (i) it is stated, that "in the King's Bench they have divers precedents, that in writ of error upon a fine the record itself shall be certified, so that no more proclamations be made, and if they are reversed, that makes an end of all, but if they are affirmed, then the record shall be sent into the Common Pleas by *mittimus* to be proclaimed and engrossed."

So if a plea of frank-fee is pleaded of land in ancient demesne, and after the proceedings have been removed into the Queen's Bench, the land is proved to be ancient demesne, the proceedings shall be remanded. (k)

And in Keilway's Reports, (l) it appears that a record was remanded into Chancery, by *certiorari*, to enable a party to have his livery there.

In the great majority of cases in which records are sent out of Chancery into the Queen's Bench for trial, the record is retained in the latter Court, and judgment given there; (m) but in all these cases the Court of Queen's Bench has the same jurisdiction over the subject-matter of the suit as the Court of Chancery; in fact, every thing that is to be done in such actions after verdict, may be done as well by the one Court as the other, and therefore it would be a useless form to send the records in such actions back into Chancery. And in all those actions when the records are taken into the Queen's Bench for a trial, the original record either actually or in contemplation of law is transferred [*416] to that Court. *Thus, in a case stated in the Year Book, 24 Ed. III., (n) Robert Bishop of Chester and another brought a *scire facias* against G. de M. upon a recognizance; after issue joined, the record, and also the record of the recognizance, was sent into the Queen's Bench. The Bishop being nonsuited at the trial, afterwards brought a new *scire facias*

(c) See Tidd's Pract. c. 34, p. 779, 9th ed.

(d) See the case of R. v. Franklin, stated by Buller, J., in R. v. Perry; 5 T. R. 454.

(e) 2 Vent. 173.

(f) See R. v. Bewdley, 1 P. Wms. 207.

(g) See R. v. Arkwright, Dav. P. C. 141; R. v. Wheeler, 2 B. & Ald. 315; R. v. Bynner, not yet reported.

(h) See Jefferson v. Morton, 2 Saund. 23.

(i) Title, Record, pl. 79; see also 3 Shep. Abr. 130.

(k) Bro. Abr. Conusance, pl. 61.

(l) 94, b.

(m) See Bro. Ab. Judg. pl. 135.

(n) Fol. 73, B. pl. 91.

in the Queen's Bench upon the recognizance, (o) and it was held that he might do so, for the whole record including the recognizance itself had been removed out of Chancery into the Queen's Bench.

But in a *scire facias* to repeal and cancel a patent, the original record in the action, as well as the enrolment, which is the record upon which the action is founded, both remain in Chancery, and a transcript of the record in the action only is sent into the Queen's Bench to have the issues tried by a jury. We have already seen, (p) that the very object of the suit is to have the patent recalled back into the same place from whence they issued under the Great Seal, in order that they may be cancelled by having the Great Seal taken off. For this reason the writ of *scire facias* commands the Sheriff to warn the defendant to appear in Chancery to show cause, not only why the patent should not be cancelled and vacated, but also why the patent should not be restored into Chancery there to be cancelled. And for the same reason the prayer of judgment by the Attorney General at the end of the declaration is, that the patent, and the enrolment of it, may be cancelled, vacated and disallowed, and that the patent may be restored into Chancery there to be cancelled.

It is evident from what has been stated, that there is something to be done by the judgment in the action which cannot be done in the Queen's Bench, and can only properly be done in Chancery; and it is, therefore, to be inferred from the nature of the case, and independent of all other authority, that after the issues have been properly tried, and a verdict found for the Crown, the record of the verdict ought to be remanded into Chancery for the judgment to be given there. Whether it would be necessary to send the record of the verdict into Chancery if the verdict be for the defendant, it is unnecessary *for the present purpose to inquire, and a case (if there [*417] be any such) in which judgment has been given for the defendant in the Queen's Bench after verdict will be no authority against sending the record into Chancery after a verdict for the Crown, for if the defendant is entitled to judgment the judgment renders all further proceedings unnecessary, but if the Crown is entitled to judgment, then there is something further to be done, and respecting which the Queen's Bench has no jurisdiction. It is believed, however, that there is no case in which a judgment has been given by the Queen's Bench for the defendant in a *scire facias* to cancel a patent, and upon principle it seems that even when the defendant obtains a verdict upon all the issues in the action, the record of it ought to be sent into Chancery; for in the first place the Queen's Bench has not the record itself but only a transcript, and in the second place, the Crown might possibly be entitled to judgment *non obstante veredicto*, which can only be given in Chancery.

There is, however, ample authority to show that after a verdict in the Queen's Bench in action of *scire facias* to cancel a patent, the record of the verdict must be sent into Chancery for that Court to give judgment.

Sir Edward Coke in the Fourth Institute (q) says, that after the trial has been had in the Queen's Bench, the record is to be remanded into Chancery and judgment given there. If this was intended to apply to all actions in which the records are sent out of Chancery for trial, it is clear that it is a mistake; but it seems also to be clear that there are cases to which this passage in the Fourth Institute is substantially applicable. Thus, if a traverse is taken in Chancery upon an inquisition under a writ *de lunatico enquirendo*, the issue must be sent into the Queen's Bench to be tried, but after trial that Court has

(o) In 2 Saund. 27, it is stated by mistake that the new *scire facias* was issued upon the record of the nonsuit.

(p) *Ante*, p. 380, and 1 Str. 151.

(q) P. 80

no further jurisdiction, and all the ulterior proceedings must be taken in Chancery, into which Court the record must be remanded. And the passage in the Fourth Institute just cited, is also applicable to the remand of the record of a verdict in *scire facias* into Chancery, after a trial in the Queen's Bench.

[*418] In the *Sackvill College* case, (r) in Chancery, Chief Baron *Hale said, that upon an issue tried in a *scire facias*, judgment is not given in the Queen's Bench, but the record is to be returned into Chancery.

In Fitzherbert's Abridgment a case is stated, (s) which seems indeed to be perfectly conclusive to show that a record in *scire facias* may be remanded into Chancery after a trial in the Queen's Bench.

The case cited occurred in the forty-sixth of Edward the Third, and as it is most important with reference to this part of our subject, it is deemed advisable to insert here a literal translation of it, which is as follows:—

“In the time of the Father of our Lord the King a certain manor was seized into the King's hands as forfeited to the King, by cause that one R. H., who was seized of the said manor had adhered to the Scots, and the King by patent gave the said manor to one Randolph de Vuis, in fee, to hold of him and his heirs. And R. died, and the manor descended to one R. as son and heir, who died his heir within age, by which one R. Dacr, of whom the manor was anciently held, seized the ward, and by *diem clausit extremum* returned in Chancery, all this matter is found, and R. Dacr, ousted of ward, upon which he sued petition in Parliament, setting forth all this matter, and that before the forfeiture the manor was held of him and his ancestors, and prayed that the charter of the King be repealed; and it was sent into Chancery, and upon that a *Scire Facias* issued against the heir and his friends, if they knew any thing to say for maintaining the charter of the King. And it was returned that they were warned and did not appear, upon which the Serjeants of the King maintained that it (the manor) was held of the King before the forfeiture, and not of R. Dacre, and the other (R. Dacr) the contrary. And this record was sent into the King's Bench, and found by the Inquest of *Nisi Prius* (by letters of Privy Seal) (t) for the Demandant. And because that the Charter was in the Chancery all was remanded, and he prayed that the charter be repealed; and some of the justices were of opinion by cause that it came to the King by forfeiture, that it shall be held of him immediately, and well debated; and at last it was assented that the charter should be repealed, and that he should have a new charter, to hold of the chief Lord of the fee, and that there should be restitution of the ward, &c., *quod nota bene,*” &c.

Fitzherbert's Abridgment is a book of the highest authority in our law, and the case which has been cited from it seems to be conclusive to show that a record may be remanded into Chancery after a verdict in the Court of Queen's Bench. And when it is considered that upon a verdict for the Crown, there are several things to be done, which the Lord Chancellor only can do, and respecting which the Queen's Bench *has no jurisdiction whatsoever; [*419] namely, to cancel the patent by taking the Great Seal off it,—to cancel the enrolment in the manner described by Coke, (u) and enter a *vacatur* on the roll; it seems to be difficult to come to any other conclusion except this, that the record of the verdict must be sent into Chancery for judgment to be given there. (x) And, indeed, as the Queen's Bench never has before it any

(r) T. Raym. 178.

(s) Title “Petition,” pl. 19.

(t) There could be no *Nisi Prius* in such a case, without the King's writ or Attorney General's warrant, vide

407. (u) 4 Inst. 88.

(x) See the petition of Commons to the King (45 Edw. III.) stated in 1 Rolle's Abr. tit. Chan. (F.) pl. 1, p. 372, “That no plea be thenceforth pleaded in Chancery unless the King be properly a party in the said plea, or that the plea touch the office of the Chancery.”

thing more than a transcript of the Chancery record, and that merely for the purpose of trying the issues, it seems to be impossible to come to the conclusion that any judgment can be given in the Court of Queen's Bench.

And a case is stated in Rolle's Abridgment, (y) which is not only an authority for sending the record of the verdict into Chancery for judgment, but also furnishes us with the form in which the record is to be sent into that Court. The following is the statement of the case, viz:—"That a manor was held of a barony of a common person, and the manor being forfeited to the King, he granted it to another to hold of himself, instead of the capital lord of the fee. That there was a petition that the charter be amended, upon which there was a plea in Chancery, and found by the escheator and by a jury in the King's Bench to be true;"—and an entry appears to have been made to the effect that,—"*because the giving of judgment upon the verdict, and execution of the judgment, belonged to the office of Chancellor, the verdict was sent into Chancery and a day given to the parties there.*"

In accordance with the authorities here stated, the record of the verdict upon a *scire facias* was sent out of the Queen's Bench into Chancery, in the case of *The Queen v. Nickels*, (z) and judgment given there for the Crown to revoke and cancel the patent, and to cancel the enrolment. (a) A writ of error was brought upon that judgment returnable in the House of Lords, but no objection was taken in Chancery, "to the regularity of the proceedings, nor [*420] was the want of authority in the Court of Chancery to give the judgment assigned for cause of error in the House of Lords.

It has however been contended, that judgment after verdict for the Crown may be given in the Court of Queen's Bench; but the cases relied on are not sufficient to show that that Court can give judgment to *cancel* a patent, and the enrolment of it. (b)

In *Digges'* case, (c) the *scire facias* commanded the Sheriff to warn the grantees named in a patent, (d) to appear in Chancery to inform the Queen and her council wherefore the Queen's hands ought to be removed from lands, but nothing is said respecting either the revoking or cancelling the patent. And although judgment was afterwards given for the defendant in the Queen's Bench, (e) yet the case is no authority on this subject, for no question could have been there raised respecting the cancelling of the patent, or the enrolment of it.

In *Mark Steward's* case, (f) it appears that by letters patent the office of Serjeant-at-Arms had been granted to Mark Steward, who was to be attending upon the Lord Chancellor for the time being. An inquisition was afterwards taken for seizing the office into the hands of the Queen, under which it was found that Mark Steward did serve the office according to the patent, but absented himself during the time specified in the inquisition. Mark Steward traversed this inquisition, and pleaded the Queen's leave of absence during the time mentioned in the inquisition, upon which issue was joined and the record was sent into the Queen's Bench for the issue to be tried. A special verdict was given, and upon argument in the Court of Queen's Bench, judgment was given by that Court for Mark Steward, that he be restored to his office, &c.

(y) 1 Ro. Abr. 534, (G.) Courts Bank le Roy.

(z) MS.

(a) It is stated in Corner's Crown Practice, p. 202, that the original Queen's Bench record was removed; but that is a mistake, it was a transcript only, the writer having seen and examined both the original record and the transcript.

(b) See 6 M. & G. 256, n. (a).

(c) 1 Co. R. 157, a.

(d) Ibid. 160, b.

(e) Ibid. 172, b.

(f) 9 Co. R. 99, b.

It will be observed that in this case there was nothing to be done which could not be as well done by the Queen's Bench as the Chancery, no question respecting the cancelling of the patent could have been raised, and therefore the case furnishes no authority in favour of the assertion that the Queen's Bench can give judgment to *cancel* a patent, and the enrolment of it.

[*421] *The only case in which a judgment in *scire facias* to revoke a patent has been signed in the Queen's Bench is *Sarnefield's* case, which is cited in *The Prince's* case, reported in Coke's Reports. (g) It appears that in *Sarnefield's* case a *scire facias* was issued upon the petition of the Prince of Wales as Duke of Cornwall against Sarnefield and his wife, to repeal a *grant* made by King Richard the Second, and confirmed by King Henry the Fourth, of a manor in the county of Cornwall, to Sarnefield and his wife for their lives: and to have the manor seized into the hands of the King, as parcel of the Duchy, &c. Sarnefield being dead, his wife appeared and pleaded the grant of Richard the Second to her for her life, and prayed in aid of the King, and had it, and the Courts gave day, &c. And the Prince at the day brought a *procedendo in loquela*, and thereupon the defendant made default; and the Prince afterwards brought a *procedendo ad iudicium*, upon which the Court of King's Bench gave judgment to revoke the patent, and to seize the manor into the hands of the King, &c.

The object of the suit in *Sarnefield's* case, however, was to have the manor re-seized into the hands of the King; and it was necessary only to *revoke* the *grant*, in order to enable the Court to give judgment. But the Court of King's Bench did not in that case give any judgment for *cancelling* the patent, nor did they deal with the patent in any other way than by revoking it, or more correctly speaking, the *grant* it contained, in order to enable them to give judgment as commanded by the writ of *procedendo*.

It is to be observed, that the judgment in *Sarnefield's* case having been obtained by default, the case cannot be considered as one of great authority. And if the form of judgment given by the King's Bench in that case be compared with the form of a judgment in *scire facias*, in Chancery, as stated by Coke, (h) the great difference between the two cases will be seen at once. In *Sarnefield's* case, the judgment was merely to revoke and annul the patent, nothing being said about cancelling the patent or the enrolment; but the form of a Chancery judgment is not only to revoke the patent, but to cancel it, and [*422] also to cancel and quash the enrolment. The difference *between the two jurisdictions is indeed apparent from the different way in which Coke speaks of the two Courts. He says, (i) that a *scire facias* to repeal a patent may be brought in the King's Bench (k); but speaking of the Court of Chancery, he says, that the highest point of the Lord Chancellor's jurisdiction is "to *cancel* the King's letters patent under the Great Seal, and damning the enrolment thereof by drawing strikes through it like a lettuce."

It appears, therefore, that there is authority for judgment being given by the Court of Chancery in a *scire facias* to *cancel* a patent, but none for giving such a judgment in the Queen's Bench; and as we have seen that the object of an action of *scire facias*, such as those now under consideration, is to cancel a patent, and the enrolment of it, which cannot be done by the Queen's Bench, or by any other authority, except the Lord Chancellor, as the sole Judge of his Court (in Common Law matters;) it seems to be impossible to resist the conclusion that judgment in such an action must be given in Chancery and not elsewhere.

(g) Part 8, p. 23, a.
(i) 4 Inst. 72.

(h) 4 Inst. 88.
(k) See on this subject, *ante*, p. 381.

In order to send the record of the verdict into Chancery, the attorney of the prosecutor or defendant must make up the Queen's Bench record, by entering the *postea* upon it, after which must be entered a day given to the parties to be in Chancery, and a remand of the record into Chancery. (l) A complete transcript of this record is then to be made, and both the record and the transcript are to be taken to the Crown Office to be numbered and stamped. The *nisi prius* record must at the same time be produced with the *postea* upon it, and the clerk at the Crown Office will indorse on that record, "Verdict recorded, and sent into Chancery for judgment," and then make a corresponding entry in his book. The Queen's Bench record is then to be taken into the treasury of that Court, and the transcript to the Office of the Petty Bag.

The *nisi prius* record cannot be obtained until after the fourth day of term, and if a rule *nisi* for a new trial should be obtained, that record cannot be obtained until after the rule has been disposed of. The appearance of the parties on the first day of the term next after the trial is always recorded in the Queen's Bench, and the proper day to give them [*423] to appear in the Court of Chancery, is the day after the motions for new trials have been disposed of, namely, the fifth day of the term; any other day in the term may, however, be given. If a rule for a new trial has been obtained and discharged, proper continuances must, (if necessary) be entered on the Queen's Bench record, prior to the entry of the sending of the record into Chancery.

Proceedings in Chancery after a Trial of the Issues by a Jury.

The King's Bench record of the verdict, and of all things done respecting the trial, is brought into Chancery in the same way as it is taken into the Queen's Bench, that is, in contemplation of law, by the proper hands of the Lord Chief Justice, no writ being necessary for this purpose, both Courts being supposed to be held in one place, that is, before the Queen herself. (m) The record is however, in practice, brought into the Petty Bag in Chancery, by the attorney of the party seeking to obtain the judgment of the Court.

Upon the record of a verdict coming into Chancery, the whole of the proceedings in the Queen's Bench are entered upon the Chancery record; and the party entitled to judgment may then sign it in the Petty Bag Office, no rule being necessary for that purpose.

If the Crown has obtained a verdict upon any issue by which sufficient matter appears to entitle the Crown to judgment, the judgment entered is, "That the said letters patent of our said Lady the Queen, so as aforesaid granted to the said, W. N., be revoked, cancelled, vacated and disallowed, annulled, void and invalid, and be altogether bad and held for nothing, and that those letters patent be restored into the Chancery of our said Lady the Queen, here to be cancelled, and also that the enrolment thereof be cancelled, quashed and annulled." (n)

But if the defendant has obtained a verdict upon every issue he will be entitled to judgment, the form of which will be, "It is [*424] considered and adjudged by the same Court here, that he, the said A. B., do depart hence without day in this behalf."

(l) See the Form in the Appendix, Chap. II. s. 7.

(m) See 10 Edw. III. fol. 59, pl. 62.

(n) 4 Inst. 88.

If the prosecutor has obtained a verdict, the defendant may, however, move the Court (before the Lord Chancellor) in arrest of judgment; and if the defendant has obtained a verdict, the prosecutor may in like manner move for judgment, *non obstante veredicto*; and if it is intended to move, the Court in that way, the party intending to move, ought to apply to the Master of the Rolls to stay the entry of the judgment, until he has had an opportunity to make the motion.

It is usual for the party signing the judgment to furnish the clerk of the Petty Bag with a draught of the intended judgment, which he will examine, and if approved of, he will enter it upon the record. Care ought to be taken to enter proper continuances when necessary.

The effect of a judgment for the Crown in an action of *scire facias* is to render the defendant's patent wholly void, and therefore the judgment may be pleaded in bar of any subsequent proceedings on the patent. (o)

The prosecutor having obtained the judgment of the Court to have the patent and the enrolment cancelled, it only remains to have execution done upon the judgment by actually cancelling those two records.

The defendant is in contemplation of law in Court at the time of giving judgment for the Crown, and must therefore be taken to be perfectly aware of the effect of the judgment. The patent was originally delivered out of Chancery to the patentee as his evidence of a grant made to him by the Crown, but by the judgment the grant is revoked, and the patent is ordered to be restored into Chancery to be cancelled, so that the patentee may not have it in his power to give any evidence of a grant which has been revoked, and has ceased to have any operation.

The defendant being in Court when he is commanded by the judgment to restore the patent into Chancery, no process is necessary, (p) unless he refuses [*425] to bring in the patent. In order to procure the patent and enrolment to be cancelled, the prosecutor must, after the entry of the judgment, make an entry upon the Chancery record, of a day given to the defendant to bring in the patent, (q) and the day ought to be a seal day in term, when the Lord Chancellor hears motions. Care must be taken to fix the day given so that a sufficient notice of it may be given to the defendant. (r) The prosecutor ought to instruct counsel to appear for the Crown on the day appointed, when, if the defendant appears, and produces the patent, the prosecutor's counsel will move to have it and the enrolment cancelled in pursuance of the judgment, and a *vacat* or *vacatur* entered on the roll:—if the defendant appears, but does *not* produce the patent, the motion will be that the defendant stand committed for his contempt in not restoring the patent into Chancery in pursuance of the judgment. (s) The defendant may, however, show cause why the judgment should not be carried into execution, as that a writ of error has been sued out, or is intended to be sued out; or he may ask for further time to answer the application, or to bring in the patent, and any reasonable length of time will be given if the Court thinks it necessary.

If the defendant can show that he has not either the possession of or any control over the patent, the Court will not construe his conduct to be a contempt, for he cannot be required to do that which is impossible. (t)

(o) Bro. Abr. Pat. pl. 23, Sci. fa. pl. 138, 131.

(p) Vide 1 Ventr. 173, and Lawrence v. Martin, 1 Salk. 7.

(q) See the Form of Entry in the Appendix, Chap. II. s. 7.

(r) See the Form of Notice in the Appendix, Chap. II. s. 7.

(s) See R. v. Cary, 1 Vern. 131; 1 Eq. Cas. Ab. 129, S. C.; Clarke's case, 2 Q. B. Rep. 619.

(t) R. v. Newton, not yet reported.

If the defendant fails to appear in pursuance of the notice, upon the day given to him on the record, the counsel for the Crown must move for a rule, or order *nisi*, calling upon the defendant to show cause why an attachment should not be issued against him for contempt.

If the patent belongs to a corporation, it seems that a *distringas* is the proper process to compel them to bring it in to be cancelled. (u)

When the patent is brought in by the defendant, it must be cancelled by the Lord Chancellor, or one of his officers in his presence, for the Master of the Rolls has no jurisdiction *over the patent, and it cannot be properly [*426] cancelled by any less authority than that of the Judge by whom it was made. (u) The cancellation is effected by cutting or tearing the Great Seal from the instrument.

The enrolment of the patent must also be cancelled and vacated in pursuance of the judgment. To do this it is necessary to obtain the order of the Lord Chancellor, that the enrolment be cancelled and a *vacatur* entered on the roll upon which the patent is enrolled, and that the proper officer attend the Master of the Rolls with the roll for that purpose.

Sir *Edward Coke* says, (x) that the cancelling or "damming" the enrolment is done by "drawing strikes through it like a lattice," (y) and this is done under the direction of the Master of the Rolls, as keeper of the records of the Court, and he signs his name in the margin of the roll opposite the enrolment of the patent which is to be cancelled, after which the enrolment is cancelled and the *vacatur* is entered in the margin of the roll, thus:—

"Cancelled this enrolment by order of the Lord Chancellor, dated the day of A. D. 18 , in pursuance of the Judgment,—our Sovereign Lady the Queen against in the Petty Bag. Therefore on the day of A. D. 18 the letters patent and this enrolment thereof are vacated."

It seems also that the patent ought to be cancelled, or something equivalent to the cancelling of it should be done before the enrolment is cancelled. For, at any time before the patent is actually cancelled, the defendant may be enabled to get the judgment vacated or reversed, and therefore it seems to be but proper that the patent should be actually cancelled, or that some proceeding should be taken to compel the defendant to bring in the patent before the enrolment is cancelled.

But a defendant cannot be compelled to do that which is physically impossible, (z) as if he being merely a trustee for another delivered the patent over to his *cestui que trust*, before the action commenced, and is unable to procure the restoration of it into Chancery in pursuance of the judgment; and in such a case if the defendant will undertake to bring no writ of error, or do any thing to vacate the judgment, he will *be excused, until he shall [*427] (if ever) be enabled to restore the patent as commanded by the judgment.

Thus, in the recent case of *The Queen v. Newton*, (a) it appeared upon a motion that the defendant stand committed for not bringing in the patent, that it was in the custody of the defendant's *cestui que trust*, who resided abroad, and that the defendant had in vain endeavored to procure the restoration of it, and was therefore unable to obey the command given to him by the judgment of the Court. The Lord Chancellor held, that under these circumstances, if the defendant would undertake that he would not assign the patent, bring any

(u) 11 Co. R. 74, a.

(u) See 4 Inst. 88, and 10 Co. R. 67, b.

(x) 4 Inst. 88.

(y) Semble, "lattice."

(z) Per Lord Lyndhurst, L. C., in *R. v. Newton*, not yet reported.

(a) Cor. Lord Lyndhurst, L. C., assisted by Lord Langdale, M. R., not yet reported.

writ of error, or do any act to defeat the judgment, he ought to be excused, and having given the required undertaking, he was accordingly excused from *then* restoring the patent into Court.

But a defendant is not, by being thus excused, wholly exempted from the duty of restoring the patent into Chancery, for he may afterwards obtain possession of it, and in that case he ought to bring it into Court in pursuance of the judgment.

In the case of *The Queen v. Newton*, just cited, the defendant being unable to restore the patent, the Lord Chancellor ordered that the enrolment should be cancelled without the previous cancelling of the patent, and that a *vacatur* should be entered on the roll, which was done accordingly, the defendant having further day given him to bring in the patent, until he should be able to do so.

The enrolment of the specification of a patent is not affected by the proceedings in *scire facias*, but will remain of record for the benefit of the public, notwithstanding the repeal and cancelling of the patent.

If the defendant obtains a writ of error to reverse or vacate a judgment for the Crown, all proceedings for the cancelling of the patent and enrolment will be stayed until judgment shall have been given upon the writ of error. When, if the judgment be affirmed, the patent enrolment must be cancelled in the way already stated.

For errors in process, or errors in fact, of this action after judgment in Chancery, the party may have a writ of error, *coram nobis in Cancellaria*, [*428] in the same way as a party can *have a writ of error, *coram nobis*, upon a judgment in the Queen's Bench. (a) But in cases where process issues out of Chancery, *returnable in the Queen's Bench*, as an execution upon a statute merchant, (b) such a writ of error must be made returnable in the Queen's Bench.

For errors in law in the Court of Chancery, a writ of error must be returnable in Parliament. (c) And in addition to the authorities cited below, the M. S. register of the cursitors, which is now in the custody of the Clerk of the Petty Bag, shows that such a writ can only be made returnable in Parliament. (d)

It is said by Sir *Edward Coke*, (e) that upon a judgment given in Chancery, a writ of error lies returnable in the Queen's Bench. There are also several *dicta* to the same effect to be found in other books and cases, (f) but there is no satisfactory authority in favour of such a position, for all the cases cited in support of it are cases in which the errors assigned were errors in fact or in process. (g)

In the case of *Rex v. Cary*, (h) it was moved that the defendant be at liberty to bring a writ of error in the King's Bench, for which was cited *Dyer*, 315, and 4 Inst. 80. But Lord Keeper *North* said, all the books were founded only on the single opinion of Lord *Dyer* and though he thought the jurisdiction of Chancery even on the Latin or Common Law side not subjected unto, or to be controlled by the King's Bench, he would enjoin all such writs of error.

(a) 42 Ass. fol. 262, pl. 22; Bro. Abr. Error, pl. 131.

(b) 18 Edw. III. fol. 25, pi. 17; 17 Ass. 24; 29 Ass. 47.

(c) Bro. Abr. Error, pl. 95-131; Jurisdic. pl. 53; 37 Hen. VI. 13 & 14; 11 Edw. IV. 9, a.; 1 Ro. Abr. 745, l. 4.

(d) See the case of the King v. Butler, 2 Ventr. 344, and 3 Lev. 220, in which the writ was made returnable in Parliament, and all the Judges appear to have attended the argument.

(e) 4 Inst. 80.

(f) 3 Bl. 49; *Dyer*, 315; 1 Ro. R. 287.

(g) 17 Ass. pl. 24; 29 Ass. pl. 47; 18 Edw. III. 25.

(h) 1 Vern. 131; 1 Eq. Cas. 129. S. C.

Speaking of this case *Blackstone* says in a note, (i) the opinion of Lord Keeper *North*, that no such writ of error lay seems not to have been well considered. But the authorities which have been cited, show that Lord Keeper *North* was quite correct in what he stated; and, indeed the form of the writ of error given in the register shows conclusively that the *writ must be returnable in Parliament, and the forms in the register can [*429] only be altered by act of Parliament. (k)

See also the cases and authorities cited in *Macqueen's Practice of the House of Lords*, p. 369 to 371.

In order to obtain a writ of error in this action, the Queen being a party, it is necessary to obtain the Attorney General's warrant for the issuing of the writ, which is always granted as of course.

If the writ of error is to be returnable in Parliament, (as it must be for an error in law,) a warrant must also be procured from the Secretary of State in order to authorize the issuing of the writ. The writ is prepared by the Clerk of the Petty Bag, and the Master of the Rolls being the keeper of the records of the Court, the writ must be directed to and allowed by him.

It is unnecessary to state more here respecting the practice upon such writs of error; it is the same in this action as in other cases. (l)

It is a general rule that the Queen neither pays nor receives costs in any action in which she is a party. There are indeed some exceptions to this rule, but none of them apply to a *scire facias* to repeal a patent. And the statutes 8 & 9 W. III. c. 11, s. 3, and 3 & 4 W. IV. c. 42, s. 34, relating to costs in actions of *scire facias*, do not apply to this action. No costs therefore can by law be recovered either against the Crown, or the defendant *upon the judgment* in this action. (m)

But it has already been stated, (n) that a prosecutor is always required to give security, by bond, to the Chief Clerk of the Petty Bag for payment of the defendant's costs if he obtains a verdict and judgment in the action. (o)

There is no instance however of the bond having been enforced, and it seems that the defendant would not be entitled as of right to the benefit of it, for the law, as we have seen, does not entitle him to costs in the action. If therefore, a defendant obtains a verdict upon every issue, and consequently judgment in the action, it seems (the bond being taken in pursuance of the Attorney General's fiat,) that the *defendant ought to have the Attorney General's [*430] fiat for the payment and taxation of his costs in the action, and for putting the bond in suit, in case they are not paid. And if it should be necessary to sue on the bond, application ought to be made to the Lord Chancellor or Master of the Rolls for leave to sue in the name of the senior Clerk (who is one of the officers of the Court,) for the recovery of the costs, which would only be granted upon condition that the defendant indemnifies the senior Clerk against all costs and expenses of the intended proceedings on the bond.

If the defendant obtains the necessary authority to recover his costs upon the bond, they must in pursuance of the condition be taxed as between attorney and client, and they are to be taxed by the Clerk of the Petty Bag as the officer of the Court.

Although the parties to an action of *scire facias* to cancel a patent are not entitled to recover costs by the judgment in the action, the Court may, and frequently does award costs to be paid upon interlocutory proceedings.

(i) 3 Com. p. 49.

(k) *R. v. Hare*, 1 Str. 158.

(l) See *Macqueen's Practice*, Ho. Lo. 361-372.

(m) *R. v. Miles*, 7 T. R. 367.

(n) *Ante*, p. 386.

(o) See the Form of Bond in the Appendix, Chap. II. s. 7.

Thus upon an application to set aside an irregular plea in the case of *R. v. Nickels*, (a) Lord Langdale, M. R., granted the application with costs. And in the case of *R. v. Craufurd*, (a) Lord Lyndhurst, L. C., refused a motion to rescind an order of the Master of the Rolls, and granted the prosecutor his costs of opposing the motion.

And in the case of *R. v. Bewdley*, (b) the Court of Queen's Bench granted a new trial to the defendants on payment of costs.

It seems that interlocutory orders of the Lord Chancellor, or Master of the Rolls, for the payment of costs, may be enforced under the statute 1 & 2 Vict. c. 110, s. 18. The order of the Lord Chancellor, who is the sole Judge of the Court of Chancery, is in fact a rule of the Court, and the order of the Master of the Rolls may be made a rule of the Court, in the same way as the order of any Common Law Judge may be made a rule of Court. If, therefore, the Lord Chancellor, or Master of the Rolls, orders a party to pay costs, it seems that payment may be enforced under the provisions of the statute just [*431] cited, by making the order (*when necessary) a rule of Court, and by entering the rule of record in the Court.

SECTION VII.

Of the Revocation of a Patent by the Queen or Privy Council.

EVERY patent contains a proviso, (m) which makes the grant it contains revocable by the Queen, or by any six of her Privy Council, for certain causes which are mentioned in the proviso.

The causes for which a patent may be revoked are stated in the proviso to be, if the grant is contrary to law, or prejudicial or inconvenient to her Majesty's subjects; or, if the invention was not new, or not invented by the patentee.

These grounds for revoking a patent are in fact such as would render it void as contrary to law, and they include all the objections which may be taken to a patent, either in an action for an infringement of it, (n) or in a *scire facias* to repeal it, (o) except the non-performance of the proviso requiring the enrolment of a specification.

If a patent is void for any cause, the ordinary remedies for the Crown or the public, are only available by pleading and proving the cause of invalidity in a Court of justice, and that at a very great cost. But by this proviso the Queen or her council may declare the cause of invalidity, and the declaration will of itself have the effect of revoking or avoiding the patent, and of course of rendering all further proof than the declaration itself unnecessary.

The grant of a patent is a matter of grace and favour, and therefore as we have seen, (p) the Crown may annex any conditions it pleases to the grant, and this condition seems to have been inserted with the view of enabling the Crown to determine any illegal grant which may be unadvisedly made, without allowing the public to be put to the trouble or cost of resisting the unlawful patent.

[*432] The revocation may be either by the Queen herself, or by *six or more of her Privy Council; if by the Queen herself, the

(a) Not reported.

(m) Stated in Chap. IV. *ante*, p. 62.

(c) *Vide ante*, p. 339.

(b) 1 P. Wms. 224.

(n) *Vide ante*, p. 266.

(p) *Ante*, p. 61.

signification or declaration must be either under the signet, or the Privy Seal; if by the Privy Council, then the declaration must be under the hands of six or more Privy Councillors.

It is probable that it was under this or a similar proviso, that Queen Elizabeth was enabled to recall the patents for monopolies which were found to be so grievous to the public during her reign. There is no instance in modern times of the determination of a patent under this proviso, but there can be no doubt that the power it confers would be exercised if a case should arise calling for such an extraordinary interference of the Crown for the protection of the public.

*CHAPTER XI.

[*433]

OF THE EVIDENCE TO BE GIVEN IN ACTIONS RESPECTING LETTERS PATENT.

SEC. I.—*In Actions for the Infringement of Letters Patent.*

II.—*In Actions of Scire Facias to Repeal Letters Patent.*

SECTION I.

Of the Evidence in Actions for the Infringement of Letters Patent.

1st. *Of the Burthen of Proof.*

2nd. *Of the Competency and Examination of Witnesses.*

3rd. *Of the Evidence to be given under each of the Issues in an Action for an Infringement.*

1st. *Of the Burthen of Proof.*

1. THE burthen of proof at the trial is upon the plaintiff, as to almost all of the issues generally raised in action for the infringement of a patent.

2. Before the making of the new pleading rules, (a) all the evidence admissible in a patent action, was given upon the issue raised on the plea of not guilty. And that plea always compelled a plaintiff to prove the patent grant alleged in the declaration, that the patentee was a person capable as the inventor or importer of the invention to sustain the grant; that the invention possessed novelty and all the other qualities requisite to make it the valid subject of such a grant; that the patentee had sufficiently complied with the proviso requiring a specification; and lastly that the defendant had infringed the patent privilege. (b)

*3. By the new pleading rules just mentioned, the effect of the plea of not guilty has been narrowed so as to amount only to a [*434] denial of the alleged infringement, and consequently the evidence in support of

(a) R. G. H. T. 3 W. IV. 1834. See Charnock's New Rules, p. 125.

(b) See the cases of *Turner v. Winter*, 1 T. R. 602; *Manton v. Manton*, Dav. P. C. 348; *Minter v. Wells*, 1 Webs. R. 129, 130.

any objection which the defendant intends to take to the patent, must be given under the plea of *non concessit* or some special plea stating the particular cause for invalidating the patent upon which the defendant intends to rely. It was not intended by the new pleading rules, however, to make any alteration respecting the burthen of proof upon any matter in contest between the parties, but merely to confine the evidence at the trial to the particular matters which the defendant shall put in issue by special pleas.

4. If, therefore, the defendant does not plead *non concessit*, the plaintiff need not give the patent in evidence, for it is admitted, or what is the same thing for the purposes of the cause, it is not denied; but if that plea is pleaded the patent grant must be proved in the same way as it would have been formerly, under the plea of not guilty.

5. If the defendant does not plead any plea, putting the patentee's title in issue as inventor or importer, it will be admitted; but if it be put in issue the plaintiff must prove a *prima facie* case in support of his title. The same observation also applies to other questions respecting the validity of the patent; thus, if the novelty or utility of the invention, or the sufficiency of the specification, be put in issue by the defendant, the plaintiff will be compelled to give *prima facie* evidence in support of his patent.

6. Nor does the notice of objections required by the statute 5 & 6 Will. IV. c. 83, s. 5, make any alteration respecting the person upon whom the burthen of proof is cast on any issue to be tried between the parties. The effect of that enactment is indeed merely to entitle a plaintiff to more specific notice of the defendant's objections to the patent than are afforded by the pleas. But if the defendant by his notice takes objections to the patent on the grounds that the patentee was not the inventor, that the invention was not new or useful, or that there was no sufficient specification, the plaintiff must give sufficient *prima facie* evidence in support of each issue (if any) to which the

[*435] defendant's objections are applicable. (c)

2nd. Of the Competency and Examination of Witnesses.

(a) Of the Competency of Witnesses—(b) Of the Examination of Witnesses.

(a) Of the Competency of Witnesses. (d)

1. The statute 6 & 7 Vict. c. 85, has made a most important alteration of the law respecting the competency of witnesses. By sect. 1 of that statute, it is enacted that no person offered as a witness, shall be excluded by reason of incapacity from crime or interest from giving evidence on the trial of any issue, joined in any suit, action or proceeding, civil or criminal, in any Court, &c., but that every person so offered shall be admitted to give evidence, notwithstanding that he may have an interest in the matter in question or the event of the trial, or of the suit, action or proceeding in which he is offered as a witness, and notwithstanding that he may have been convicted of any crime or offence. But it is provided that the act shall not render competent any party to the suit individually named in the record, or any person in whose immediate

(c) See further as to the Notice of Objections, *ante*, Chap. X. s. 2, p. 264.

(d) It is only intended here to state the points relating to this subject which are peculiar to patent actions.

and individual behalf any action may be brought or defended, either wholly or in part, or the husband or wife of such persons respectively.

2. If a patentee has assigned the whole of his interest in his patent, there can be no doubt that he is a competent witness for the assignee in any action he may bring for an infringement of the patent. (f) If the patentee has entered into covenants with the assignee respecting the validity of the patent, he may have an interest in the event of any action in which the validity of the patent comes in question. But in such a case it is conceived that the statute 6 & 7 Vict. c. 85, (g) would prevent the testimony of the patentee from being excluded, although his interest in the event would be a "matter for the jury to take into consideration as tending to effect his credit." [*436]

3. A licensee of a patent invention is also a good witness for the plaintiff in an action for an infringement of the patent.

This was decided in the case of *Derosne v. Fairlie*, (h) but it does not appear from the report of the case what description of license the witness had obtained, it is merely stated that he had purchased a license.

4. If a licensee is empowered by his license to use the invention in consideration of a periodical payment or rent, or a payment of a license duty in proportion to the extent of his user of the invention; he can have no interest to support the patent unless the payments reserved by the license are merely nominal, or not a full consideration for the privilege granted. Such a licensee may, however, have an interest in the destruction of the patent, but not any greater interest than any other of the public, unless indeed he has improvidently covenanted to pay a larger amount of license duty than the license privilege is worth. A licensee who has paid a gross sum of money for an irrevocable license, or has obtained such a license for any other consideration, has an interest in supporting the patent, for if the patent privilege be thrown open to the public, his license can produce him no benefit.

5. These observations are only of importance for the purpose of directing attention to the extent of the interest which a licensee may have in the event of an action for an infringement so as to affect his credit as a witness, for it is clear that the statute 6 & 7 Vict. c. 85, (i) renders a licensee a competent witness in such an action, unless indeed the action be brought or defended for his immediate benefit.

Thus, if a person had an exclusive license for some particular district, and an action was brought by the patentee for his benefit, against a party infringing the patent within the district comprised in the license; the licensee could not be a competent witness, for he would come within the meaning of the exception contained in the first section of the statute as being the person in "whose immediate and individual behalf" the action was brought. (i)

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(*b) *Of the Examination of Witnesses.* (k) [*437]

1. Upon the examination of a witness to prove that an invention was not new, the witness proved that he had long before the date of the patent constructed a machine for the same purposes as the patent machine. A drawing,

(f) Gamble, the patentee, was examined as a witness in *Bloxam v. Elser*, 1 C. & P. 563.

(g) See the Statute in the Appendix, Chap. I. s. 1.

(h) 1 Mo. & Rob. 457.

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

(k) The decisions relating to this subject in patent actions only, are here stated.

said to be a drawing of the witness's machine was produced, but the drawing had not been made by the witness, and it was objected for the patentee that the witness ought not to look at the drawing, but should describe the machine he had constructed. Mr. Justice *Bayley*, however, held that the witness might look at the drawing, and might be asked whether he had such a recollection of the machine he had made as to be able to say that the drawing was a correct representation of it. (l)

2. In the case of *Bloxam v. Elsee*, (m) it was proposed to ask a witness whether he did not learn from a person under whom the plaintiffs claimed title to their patent something respecting the contents of a deed; but Lord *Tenterden*, C. J., overruled the question, and held that no question could be asked as to what had been said of the contents of a written instrument, or an account of its non-production.

3rd. Of the Evidence to be given under each of the Issues in an Action for an Infringement.

1. It must be premised that in the following observations respecting the evidence to be given under each issue, it is supposed that the defendant has given a proper notice, embracing all the objections which may be taken under each issue. It has already been shown that the only question which can arise at *nisi prius* respecting a notice of objections is, whether the terms of the notice are sufficient to include any objection in support of which the defendant may tender evidence, (n) and it seems that the notice of objections is so far to [*438] be considered *as part of the pleadings, that it ought to be stated or read at the same time that the pleadings are opened. (o)

2. There are, however, some objections which a defendant may take at the trial, and of which it seems that he need not give any notice, as that the patent is not properly stamped, (p) or that there is a variance between the patent as proved, and as it is set out in the declaration. So it seems that the defendant need not state in his notice that he will object that the act complained of by the plaintiff is no infringement of the patent.

Under an Issue upon a Plea of Non Concessit.

1. In support of an issue joined upon the plea of *non concessit*, the plaintiff must prove a grant of privilege by the Crown, as stated in the declaration, either by the production of the patent under which he claims, or by an exemplification or *constat* of the enrolment of it under the Great Seal.

2. When the plea of *non concessit* alleges that her Majesty did not by the letters patent mentioned in the declaration make such grant of privilege as in the declaration alleged, the defendant admits that there is a patent, but denies that the purport and effect of it is properly stated by the plaintiff. (q)

3. The plea is sometimes, however, more extensive, and denies generally that the Queen has made such grant of privilege as the plaintiff has stated

(l) *R. v. Hadden*, 2 C. & P. 184.

(m) *Ry. & Mo. N. P. C.* 187; 1 C. & P. 563.

(n) See further respecting the Notice of Objections, *ante*, Chap. X. s. 2, p. 284.

(o) Per Parke, B., *Neilson v. Harford*, 1 Webs. R. 309.

(p) *Nickels v. Ross*, Tindal, C. J.

(q) 3 Burr. 1544; *Baddeley v. Leppingwell*, and 6 Co. R. 15, b. Eden's case.

in the declaration, and the existence of any patent seems then to be put in issue. (r)

4. There is some doubt, however, whether a defendant can, strictly speaking, be allowed by the plea of *non concessit*, or indeed any other plea to deny that there is a patent. At the time of declaring, the patent is in contemplation of law produced and shown to the Court, (s) and it has been seen (t) that a patent under the Great Seal being produced and shown to the Court cannot be denied, for the Great Seal proves itself, and therefore it must be apparent to the Court that the instrument produced is a patent, and it seems that the defendant ought not to be allowed to plead a plea which is so manifestly untrue. (u) [*439]

5. The effect of the plea of *non concessit* must, however, be substantially the same, so far as respects the evidence which it compels the plaintiff to give, in whatever form it may be pleaded; for it does not avail a plaintiff any thing to have it admitted that there is some patent in existence, when the defendant denies that the plaintiff has stated the purport and effect of that patent. The consequence is that the plea of *non concessit* must always compel the plaintiff to give his patent in evidence at the trial, and in this way the defendant will obtain the same benefit as if he had denied that there was any patent in existence. For when the alleged patent is produced, and tendered in evidence by the plaintiff, the Court is bound to inspect the instrument, and see whether it really is a patent under the Great Seal or not, and if it is not sealed with the Great Seal, it cannot be received in evidence.

6. If the patent is produced it is admissible in evidence without further proof, for being under the Great Seal, of which the Courts of Law take judicial notice, the seal is sufficient proof that the instrument is what it purports to be.

7. At the Common Law no grant by the Crown was available unless it could be proved by production of the patent itself under the Great Seal. (x) And this rule frequently operated very much to the prejudice of parties claiming under patentees, who were unable to procure the production of the letters patent.

8. This evil was in some measure removed by the stat. 3 & 4 Edw. VI. c. 4, (y) which, however, related exclusively to patent grants of land; but some question arising as to the construction of that statute, it was amended by the act of 13 Eliz. c. 6. (y)

Section 2 of the latter act in substance provides, that patentees and all persons claiming under them are enabled to make such title to lands, "or other things whatsoever," specified in their letters patent, or any part thereof, by showing forth an exemplification or *constat* under the Great Seal of the enrolment of the letters patent, (z) or so much thereof as [*440] shall be necessary, as if the letters patent were themselves pleaded and shown forth.

This enactment clearly applies to letters patent for inventions, (a) and under its provisions a party claiming under a patent, but unable to produce it, may prove the grant of privilege he claims by an exemplification or *constat* of the enrolment of the patent. The act does not, however, make a copy of the enrolment evidence unless it is exemplified under the Great Seal.

(r) See the Forms in the Appendix, Chap. II. s. 4.

(s) Vide *ante*, p. 254, 264.

(t) *Ante*, p. 264.

(u) Eden's case, 6 Co. R. 15, b; Plowd. 232.

(x) Lane's case, 2 Co. R. 16, b; 2 Rol. Abr. 182.

(y) See the Statute in the Appendix, Chap. I. s. 1.

(z) As to what the enrolment is, vide *ante*, Chap. IV. p. 38.

(a) See 5 Co. R. 53, a, 53, b.

9. An exemplification is so called, because by it the record is exemplified, (b) and it sets out the whole of the enrolment of the patent. The exemplification does not purport to exemplify the patent, but the enrolment only. (c)

10. In whatever manner a patent may be proved it only amounts to evidence of the *purport* of the grant it contains, the effect or operation of the grant being quite a different question. And although a patent purports to grant a sole privilege to the patentee, it may be that the grant is for some reason illegal and void, and if so the patent is of no force, and the grant it purports to make has no operation, and consequently it is in legal language strictly correct to say that the Queen did not make such a grant as the plaintiff alleges in his declaration, for a void grant is the same as no grant at all. (d)

11. It has been shown in a preceding part of this work that the law imposes certain conditions upon the validity of a grant of a sole privilege in an invention, both with respect to the person of the grantee, (e) and also the nature of the invention itself. (f)

And as the plea of *non concessit* puts in issue not only the fact of a grant having in form been made by the Crown, but also all the facts which go to establish the validity of the grant, it is apprehended that (if the notice of objections be sufficient) a plaintiff will be compelled by the plea to give *primâ facie* [*441] evidence in support of his title, in the same manner as he would by pleas alleging, that he or the patentee was not the true and first inventor or importer of the invention, that the invention was not such an art as might be made the subject of a patent privilege, and that it did not possess the requisite qualities of novelty and utility. (g)

12. And the defendant is at liberty under this plea, not only to show that no such grant has in fact been made, but also to prove facts which are sufficient to invalidate the grant. Thus, the defendant may show that there is a variance between the statement in the declaration, and the patent given in evidence by the plaintiff. That the patent contains a false description of the invention, (h) or in other words, that the invention is misdescribed by the title which the patentee has given it. So, he may show that the patent bears date on a day antecedent to the delivery of the Privy Seal bill to the Lord Chancellor, which renders the patent absolutely void. (i) The defendant may also prove that the patent contains a false recital, (k) or that it was obtained upon a false suggestion or representation, (l) either of which will be sufficient to avoid the patent. (m)

13. But in order to take advantage of the invalidity of a patent under this plea, it must be shown that the patent was void, *ab initio*, and therefore the avoidance of the grant by any matter subsequent to the making of the patent, as for instance the want of a proper specification, cannot be taken advantage of under this issue, but must be specially pleaded.

14. For the purpose of merely proving the purport of the patent grant as alleged in the declaration, it will be sufficient to give the patent itself in evidence. But if any question should arise under this issue, which renders it

(b) 5 Co. R. 53, b.

(c) See Hardr. 119.

(d) As to the nature and effect of the plea of *non concessit*, vide *ante*, p. 265, 268.

(e) *Ante*, Chap. III. p. 19.

(f) *Ante*, Chap. V. p. 77.

(g) As to what *primâ facie* evidence such pleas will compel a plaintiff to give, see the subsequent parts of this Chapter.

(h) As to the sufficiency of a title, vide *ante*, Chap. IV. p. 43.

(i) 18 Hen. VI. c. 1. Appendix, Chap. I. s. 1.

(k) Vin. Abr. Prerog. (Q. b); 1 Co. R. 43, a.

(l) 1 Co. R. 43, a; Com. Dig. Grant, (G. 6), (G. 9).

(m) Vide *ante*, Chap. IV. p. 42, as to what false recitals and suggestions are sufficient to avoid a patent.

necessary to show what the invention is, the plaintiff must give his specification in evidence. Thus, if it be objected by the defendant that the patentee was not the true or first inventor, or that the invention was not new, the plaintiff must give his specification in evidence, to prove what the invention is to which the patent applies, and to enable his witnesses to give testimony respecting its novelty at the date of the patent. [*442]

15. Although the specification is an instrument under the hand and seal of the patentee only, yet it derives its efficacy as evidence in such a case from the proviso in the patent itself, in pursuance of which it must have been enrolled; and therefore it may for such a purpose be considered as part of the patent itself.

Thus in the case of *Hornblower v. Boulton*, (n) 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."

So in the case of *Crossley v. Beverley*, (o) 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 as one muniment in enforcing this claim on the part of the patentee, and they only."

Under an Issue upon a Plea alleging that the Patentee was not the true and first Inventor.

1. Under a plea that the patentee was not the true and first inventor, the plaintiff must give *prima facie* evidence (such as the nature of the case admits of) to show not only that he was the true or actual inventor, (p) but also that he was the first inventor who gave or contracted to give the invention to the public.

2. Invention is an act of the mind which is incapable of direct proof except by the evidence of the inventor himself, and his evidence is generally inadmissible in an action upon the patent. But when a patentee has assigned over all his interest in the patent privilege, there seems to be no reason why he should not be a good witness to prove that he did actually make the invention as alleged in the petition recited in the patent. And as it is a rule that a party must produce the best evidence the nature of the case admits of, it may even be questionable whether an assignee plaintiff is not bound in such a case to prove the affirmative of this issue by the evidence of the patentee himself, if his evidence can be procured. [*443]

3. In the absence of direct proof, however, it may be shown in support of this issue, that a patentee was the first to communicate a knowledge of the invention to the world, and if there be no proof that he acquired a knowledge of the invention by other means, it is only fair to presume that he was the inventor of it.

Thus in the case of *Minter v. Wells*, (q) Mr. Baron Alderson held, that the circumstance of the plaintiff being the first to introduce the invention was *prima facie* evidence that he was the true and first inventor.

And accordingly it is the invariable practice at *nisi prius*, to prove the affirmative of this issue, (the patent being admitted,) first by giving the specification

(n) 8 T. R. 98; Dav. P. C. 221.

(o) 9 B. & C. 62.

(p) As to who may, as an actual inventor, be the grantee of a sole right to use an invention, vide *ante*, Chap. III. s. 2, p. 22.

(q) 1 Webs. R. 129.

in evidence, and then showing that the invention was new, and unknown to the public at the date of the patent; and this is sufficient *prima facie* evidence to establish the affirmative of the two propositions which the plaintiff is bound to prove, viz: that the patentee was not only the true or actual inventor, but also the first to give the invention to the public.

4. If the patentee was not an actual inventor, but merely an importer of the invention from abroad, the plaintiff would *under this form of plea* make a *prima facie* case in precisely the same way as has been already mentioned, viz: by putting the patent and specification in evidence, and proving the novelty of the invention at the date of the patent.

5. Under this issue the defendant may show that the patentee was not the true or actual inventor, and also that he was not the first inventor, which means the first person to give the public the benefit of the invention; and proof of either of these circumstances will be sufficient to entitle the defendant to a verdict.

[*444] 6. In order to show that the patentee was not the true or *actual inventor, the defendant must prove that the patentee acquired a knowledge of the invention from a British subject, or some person residing in this country, or from some other source than his own actual invention or discovery.

Thus in the case of *Cornish v. Keene*, (r) the Lord Chief Justice *Tindal* held, that although the invention was new so far as the world was concerned, yet if it could be shown that the party who got the patent was not the man whose ingenuity first discovered it, that he had borrowed it from A. or B., or taken it from a book that was printed in England, and which was open to all the world—then, although the public had the benefit of it, the patentee would not be the true and first inventor.

In *Tennant's* case, (s) a chemist at Glasgow proved, that having frequent conversations with Mr. Tennant on the means of improving bleaching liquor, he had in one of them suggested to Mr. Tennant that he would probably attain his end by keeping the lime water constantly agitated. Mr. Tennant afterwards informed the witness that this method had succeeded. These conversations took place in 1796, and Mr. Tennant obtained his patent in 1798; and in an action which the patentee brought upon the patent, Lord *Ellenborough*, C. J., nonsuited him upon two grounds, one of which was that the chemist had suggested to him the agitation of the lime water, (which was indispensable in the process) and therefore that it was not the invention of the patentee.

So in the case of *Lewis v. Marling*, (t) in which it was proved that a model and specification of a machine similar to the plaintiff's had been brought from America several years before the date of the plaintiff's patent, Lord *Tenterden*, C. J., said, at *nisi prius*, that if it were shown that the plaintiffs had borrowed from some one else, then of course their patent would fail. And upon a motion for a new trial in that case, (u) his Lordship afterwards said, that he told the jury that if it could be shown that the plaintiffs had seen the model or specification that might answer the claim of invention. And in the same case, [*445] Mr. Justice *Bayley* said, if it had been *shown that the plaintiff had seen the model, and had borrowed from it, he would not have been the true inventor.

In the case of *Gibson v. Brand*, (x) Lord Chief Justice *Tindal* held, that proof that the patentee was the first to publish an invention to the world, was

(r) 1 Webs. R. 507.

(t) 4 C. & P. 52; 10 B. & C. 22, S. C.

(x) 1 Webs. R. 628.

(s) 1 Webs. R. 125, n.; Dav. P. C. 429.

(u) 10 B. & C. 22.

not *conclusive* evidence of his being the actual inventor, and that he would not be the inventor if it were shown that he had borrowed it from another person; for the law never intended that a person who has taken all his knowledge from the labours and assiduity, or ingenuity of another, should be the man who was to receive the benefit of another's skill.

And if it be shown, as in *Barker v. Shaw*, (y) that an invention was made by a servant, whilst in the service of his masters, the patentees, the defendant will be entitled to a verdict, for the patentees were not the true inventors. The same law was laid down by Mr. Justice Buller, in the case of *The King v. Arkwright*. (z)

7. But a patentee's title as inventor will not be defeated by proof that he availed himself of the assistance of others in *perfecting* his invention.

Thus, in the case of *Bloxam v. Elsee*, (a) it appeared that the invention consisted of a machine for making paper in continuous sheets of an indefinite length, and that the principle of the invention was the receiving the pulp to be made into paper upon a plane formed by an endless wire web, stretched upon revolving cylinders, so that the paper was moved forward as fast as it was formed. The patentee discovered the principle of this invention, but the mechanical details necessary for carrying the invention into complete effect were numerous and complicated, and therefore he engaged Mr. Donkin, an engineer, to give him his professional assistance, and several parts of the machine were suggested to the patentee by Mr. Donkin. It was objected by the defendant that the patentee under these circumstances could not be the inventor; but it was answered that Mr. Donkin was merely acting as the patentee's servant, and the objection was not sustained.

In the case of *Minter v. Wells*, (b) Mr. Baron Alderson *said [*446] to the jury in commenting upon the evidence, "Mr. Minter and Sutton were together about the time the invention took place; which of the two suggested the invention, and which carried it into effect, is a question for you to decide. If Sutton suggested the principle to Mr. Minter, then he would be the inventor. If, on the other hand, Mr. Minter suggested the principle to Sutton, and Sutton was assisting him, then Mr. Minter would be the first and true inventor, and Sutton would be a machine, so to speak, which Mr. Minter uses for the purpose of enabling him to carry his original conception into effect."

8. If the patentee was an importer of the invention, the defendant may, under this issue, show that the patentee was not the true inventor, within the meaning of the law, by proving that a knowledge of the invention was communicated to the patentee by a British subject, or that the patentee acquired a knowledge of the invention in any way (except by communication from a foreigner residing abroad) which would defeat his title as an actual inventor.

A communication from a Scotchman is not sufficient to support a patent, for in *Tennant's* case, (c) the patent was held to be void on the ground that an essential part of the invention had been communicated to the patentee by a Scotch chemist. The point was not, however, distinctly mentioned in that case.

But the case of *Brown v. Annandale* (d) (decided in the House of Lords) shows that the words "in this realm" in the Statute of Monopolies, (e) must now be understood to mean the whole of the United Kingdom; and as the

(y) Holroyd, 60; 1 Webs. R. 126.

(a) 1 C. & P. 567.

(c) 1 Webs. R. 125, n.; Dav. P. C. 429.

(e) 21 Jac. I. c. 3, s. 6.

(z) Printed case, and Dav. P. C. 61.

(b) 1 Webs. R. 132.

(d) 1 Webs. R. 433.

patentee must be the true inventor within the United Kingdom, a communication of the invention made to him by any person residing within any part of it, would not enable him to support a patent.

9. To show that the patentee was not the first inventor, the defendant must prove that the public had acquired a right to the invention in some shape or other prior to the date of the patent; and proof that a prior patent had been granted for the invention would be sufficient to entitle the defendant to a verdict. (f)

[*147] *In the case of *Forsyth v. Riviere* (g) Lord Tenterden, C. J., held, that if several persons simultaneously discover the same thing, the party *first* communicating it to the public, under the protection of letters patent, is the true and first inventor. So, in the case of *Cornish v. Keene* (h) the Lord Chief Justice Tindal said in his address to the jury.—“There may be many discoveries starting at the same time, many rivals that may be running on the same road at the same time, and the first which comes to the Crown and takes out a patent, it (the invention) not being generally known to the public, is the man who has a right to clothe himself with the authority of the patent and enjoy its benefits.” If, therefore, it be shown that a prior patent has been obtained for an invention, the second patentee cannot be the *first* inventor within the meaning of the law, for the law has regard not to priority of invention, but only to priority in the communication of the invention to the public. (i)

10. In order to defeat a patentee's title as first inventor, on the ground of a prior patent for the same invention, it is not necessary that a defendant should prove that the invention comprised in the prior patent is the same in every particular as that comprised in the second; it is enough to show that the plaintiff's patent extends to something for which the prior patent was obtained, and whether the objection applies to the whole or part of the invention is immaterial, for if the plaintiff fail as to any part, he must fail entirely.

And if a prior patent for the same invention has been specified before the date of the plaintiff's patent, the evidence for the defendant will be still stronger, for in that case it will appear, independent of the prior patent, that there has been a publication to the world sufficient to defeat the plaintiff's patent. (k)

11. Proof that the alleged invention, comprised in a patent, or any part of it, was not new to the public at the date of the patent, will also be sufficient to show that the patentee was not the first inventor. And, therefore, a plea that the patentee was not the true and first inventor, puts in issue the novelty of [*448] the invention at the date of the patent (l) in the same way as a plea alleging that the invention was not new as to the public knowledge and use of it. (m)

And accordingly in the case of *Stead v. Williams*, (n) it was held, that if an invention has already been made public in England by a description contained in a work, whether written or printed, which has been publicly circulated, the patentee is not the first and true inventor.

12. But a patentee's title as the first inventor will not be defeated by proof that a person previously made the same discovery if a knowledge of the prior

(f) *Walton v. Potter*, 1 Webs. R. 591, 592.

(g) *Chit. Prerog. Cr.* 182.

(h) 1 Webs. R. 508.

(i) See the reasons for this explained in Chap. III. s. 4, *ante*, p. 31.

(k) *Walton v. Potter*, 1 Webs. R. 592; and *vide post*, the evidence upon an issue respecting the novelty of an invention.

(l) See *Walton v. Potter*, 1 Webs. R. 592.

(m) For the evidence upon an issue respecting the novelty of an invention, *vide post* in this Chapter.

(n) 8 Jur. 930.

discovery is not given to the public. Thus, in *Dollond's* case, (o) the plaintiff had invented a new method of making object-glasses for telescopes, and it was objected that Dr. Hall had made the same discovery before him. But it was held by *Buller, J.*, that as Dr. Hall had confined it to his closet, and the public were not acquainted with it, Dollond was to be considered the first inventor. The law, as laid down by Mr. Justice *Buller*, in *Dollond's* case, was cited and approved of by Mr. Justice *Dallas*, in delivering the judgment of the Court of Common Pleas in the case of *Hill v. Thompson*. (p) And in the case of *Lewis v. Marling*, (q) Mr. Justice *Bayley* said, "If I make a discovery, and am enabled to produce an effect from my own experiments, judgment, and skill, it is no objection that some one else has made a similar discovery by his mind, unless it has become public."

13. So also it was held by Mr. Justice *Patteson*, in the case of *Jones v. Pearce*, (r) that a prior unsuccessful experiment will not defeat a patentee's title as first inventor, if the invention was really his own. And in the case of *Lewis v. Marling*, (s) it was proved that a model of a machine similar to the plaintiff's was brought from America, in 1811, several years before the date of the plaintiff's patent; that the model was in the same year exhibited to three or four persons, and that workmen were employed by Mr. Thompson, a manufacturer, to make a machine from it. The machine, however, was never finished, and Mr. Thompson afterwards purchased the plaintiff's machine. Lord *Tenterden, C. J.*, held, that as it was not shown [*449] that the plaintiff had seen the model, the evidence was not sufficient to defeat the plaintiff's title as inventor.

And in the case of *Carpenter v. Smith*, (t) Lord *Abinger, C. B.*, said that he was counsel in the cases of *Lewis v. Marling* and *Jones v. Pearce*, and that he recollected that those cases proceeded on the ground of the former machines being in truth mere experiments which altogether failed.

In the subsequent cases of *Cornish v. Keene*, (u) *Galloway v. Bleudon*, (x) and *Gibson v. Brand*, (y) the same law was laid down, that evidence of prior experiments only are not sufficient to show that the patentee was not the first inventor.

Under an Issue taken upon a Plea alleging the falsehood of a Patentee's representation to the Crown, that he obtained a knowledge of the Invention by means of a communication made to him by a foreigner residing abroad.

1. When a patent has been obtained for an imported invention, (z) upon a representation to the Queen, that by means of a communication made to him by a foreigner residing abroad, he was in possession of the invention; we have seen, (a) that the defendant may by a plea allege that the communication was false, and that the patent was consequently void. (b) The plaintiff will by his replication to this plea allege that the representation was true, (c) and therefore,

(o) Dav. P. C. 170; 1 Webs. R. 43.

(q) 10 B. & C. 22.

(s) 4 C. & P. 52.

(u) 1 Webs. 508.

(y) 1 Webs. 628.

(a) *Ante*, Chap. X. s. 2, p. 267.

(b) See the form of plea in the Appendix, Chap. II. s. 4.

(c) *Vide ante*, Chap. X. s. 2, p. 282, and the form of replication in the Appendix, Chap. II. s. 4.

(p) 8 Taunt. 382; 2 B. Mo. 433.

(r) 1 Webs. R. 122.

(t) 9 M. & W. 300.

(x) 1 Webs. 525.

(z) *Vide ante*, Chap. III. s. 3, p. 26.

it is apprehended that he must prove the affirmative of the issue, that a knowledge of the invention was actually communicated to the patentee in the manner alleged. (d)

2. The plaintiff is consequently compelled to prove under this issue that a communication was made to him on some day before the date of his petition for the patent, or at all events before the date of the patent, for a communication after the date of the patent would be inconsistent with the representation [*450] *which the patent shows that the patentee has made to the Crown. So also it must be shown that the communication was made by a foreigner, for if the communication was made by a British subject the patent could not be supported.

And in *Tennant's* case, (e) it was held, that a communication made to the inventor by a Scotchman of an essential part of the invention was sufficient to avoid the patent. It must also be proved that the foreigner was at the time of the communication resident abroad, or that his domicile was abroad, and not in this country.

3. The necessity for proving these facts is brought upon a plaintiff by the form of the representation which a patentee must make to the Crown in order to obtain a patent for an imported invention, and the truth of which he must prove if denied. (f)

4. If it appears that the communication was made by a foreigner residing in this country; it seems that the evidence would not even show the patentee to be the true and first inventor within the meaning of the law. (g) A foreigner who is resident in this country may himself obtain a patent for his invention, and there does not seem to be any better reason for supporting a patent for an invention acquired by communication from a foreigner permanently residing here, than for an invention which has been communicated by a British subject, in which case the law would clearly render a patent void.

5. And if a patent for an invention communicated by a foreigner permanently residing here were to be supported, it would be difficult to avoid extending the law also to a patent for an invention communicated by a foreigner who has been made a denizen.

6. A communication from a foreigner naturalized by act of Parliament would clearly be insufficient, for he has obtained nearly all the privileges of a natural-born subject; and is, therefore, subject to the performance of the same duties.

7. Under this issue the defendant may show that the patentee acquired a [*451] knowledge of the invention in a manner *different from that which he alleged to the Crown in his petition for the patent.

Under an Issue taken upon a Plea alleging the falsehood of any other representation made by the Patentee's Petition to the Queen respecting the nature of his Invention.

1. It has been shown already, (h) that if any material representation made by a patentee in his petition for his patent was untrue, the fraud thus practised upon the Crown has the effect of rendering the patent null and void.

2. An issue of this kind is most frequently raised upon the correctness of a representation respecting the nature of the invention intended to be comprised

(d) Such proof was given in the case of *Bloxam v. Elsee*, 1 C. & P. 558.

(e) *Dav. P. C.* 429; 1 *Webs. R.* 125, n.

(f) See the form in the Appendix, Chap. II. s. 1.

(g) *Vide ante*, Chap. III. s. 3, p. 29. (h) *Ante*, Chap. IV. p. 42.

in the title which the patentee has chosen to give it; as, for instance, a representation that the invention was an improvement or improvements in some particular manufacture, or was applicable in the particular manner mentioned by the patentee in the title which he has given to his invention.

3. The law respecting the titles of inventions has already been stated in a former part of this work, (i) where the cases on the subject of misdescriptions and misrepresentations in the titles of inventions have been digested, and to which the reader is referred.

4. The plaintiff under an issue of this description must prove that the title of the invention is substantially correct in the particulars mentioned in the plea. Thus, if the title states the invention to be an improvement in steam-engines, the plaintiff must show not only that the invention is applicable to steam-engines, but also that it is an improvement upon, or better than something which the invention is intended to supersede. (k)

5. An issue respecting the invention being an improvement must not be confounded with an issue raised upon a plea alleging that the invention is useless to the public; the two issues are perfectly separate and distinct. (l) In the one case *the plaintiff must give evidence respecting the utility [*452] of his invention in comparison with something previously known; but in the other case it is sufficient for him to prove that the invention is itself of some use to the public. (m)

6. It is difficult to lay down any rule with respect to what a plaintiff must prove in order to show that his invention is an improvement. But if the plaintiff can prove that his invention is better or cheaper (n) than what was before known, he will give sufficient *prima facie* evidence in support of an issue respecting the invention being an improvement.

If the invention consists of several distinct things, the plaintiff must prove that every part is an improvement upon what was known before the date of the patent. (o)

In the case of *Cornish v. Keene*, (p) the defendant pleaded that the invention was not an improvement or improvements in the making or manufacturing of elastic goods or fabrics applicable to various useful purposes as alleged by the patentee in the title, upon which issue was joined. The invention consisted of an elastic web which was shown to be useful for surgical purposes, but the Lord Chief Justice *Tindal* held that it was not sufficient to show that the web was useful for surgical purposes alone, but that it must be proved that the web was generally an improvement with respect to the general uses for which the fabric was intended.

7. And if a patent be obtained for an invention which is described in the specification as an improvement upon an invention comprised in a former patent, the specification of the former patent must be given in evidence in order to show what the improvement really is, and whether it is such an improvement as alleged by the patentee. (q)

8. Under an issue respecting the applicability of the invention in the manner alleged in the title, the plaintiff must show that the allegation is substantially true. Thus, if the title allege the invention to be an improvement in lace

(i) *Ante*, Chap. IV. p. 43.

(k) *Cornish v. Keene*, 1 Webs. R. 503.

(l) *Morgan v. Seaward*, 2 M. & W. 544, and *Beddells v. Massey*, 2 Dowl. & Low, 322.

(m) See the evidence to be given upon an issue respecting the utility of an invention, *post*, in this Chapter.

(n) See *Cornish v. Keene*, 1 Webs. R. 506.

(o) *Morgan v. Seaward*, 2 M. & W. 544. (p) 1 Webs. R. 501, 506.

(q) *Lewis v. Davis*, 3 C. & P. 502.

machines, and also applicable to stocking looms, the plaintiff must show that [*453] the invention is applicable not only to lace machines, but also to *stocking looms. And if he fails in proving the applicability of the invention in either respect, he will fail altogether.

Thus, it was held by the Court of Common Pleas, in *Hill v. Thompson*, (r) that if any part of an alleged discovery being a material part, fail (the discovery in its entirety forming one entire consideration,) the patent is altogether void.

9. And if the issue be taken upon the alleged nature of the invention in any other respect, the plaintiff must show that the invention is really of the nature which he has alleged, and a material variance in this respect will be fatal. (s)

10. The defendant under an issue of this description, may show that the representation contained in the patentee's title was false in the particular alleged by his plea. Thus, under an issue respecting the invention being an improvement, he may prove that the invention was no improvement; and if he shows that any part of the invention was not such an improvement as alleged by the patentee, he will be entitled to a verdict. This point was expressly decided by the case of *Morgan v. Seaward*, (t) in which the invention was stated in the title to be improvements in steam-engines, and in machinery for propelling vessels; and it having been proved that one part of the invention was not an improvement, the Court of Exchequer held that the verdict was rightly entered for the defendant, and that the patent was void.

The same law was laid down by Lord Abinger, C. B., in the case of *Losh v. Hague*, (u) and by Mr. Justice Buller, in the case of *The King v. Arkwright*. (x)

11. So, also, under an issue respecting the applicability of the invention to the purposes alleged by the patentee, the defendant may give evidence to show that the invention is incapable of being used or applied in the manner represented by the patentee, or that some material part of the representation is untrue. And if the defendant succeeds in showing that the representation is false in any one particular, the defendant will be entitled to a verdict.

[*454] Thus, in the case of *Felton v. Greaves*, (y) the patent had *been obtained for an invention which the patentee intitled "a machine for sharpening knives, scissors, and razors;" and as it appeared that the machine described in the specification was inapplicable for the purpose of sharpening scissors, the patent was held to be void.

12. And under any other issue respecting the nature of the alleged invention, the defendant may show that the description which the patentee has chosen is inaccurate, either wholly or in part; and if it is shown to be false in any material particular, the defendant will be entitled to a verdict.

Thus, in *The King v. Metcalf*, (z) the patentee had described his invention as a tapering brush; but the patentee's brush only differed from other brushes in the circumstance of having the hairs or bristles made of unequal lengths instead of being made of a uniform length; and it was held that the nature of the invention was inaccurately described, and that the patent was therefore void.

And in the case of *The King v. Wheeler*, (a) the patentee had represented his invention to be "a new or improved method of drying and preparing malt." It appeared, however, that the invention was not applicable in the manufacture

(r) 8 Taunt. 382; 2 B. Mo. 433.

(s) See the cases of *R. v. Metcalf*, and *R. v. Wheeler*, *post*.

(t) 2 M. & W. 544.

(u) 1 Webs. R. 203, 204.

(x) 1 Webs. R. 72; Dav. P. C. 61.

(y) 3 C. & P. 611.

(z) 2 Stark. R. 249.

(a) 2 B. & Ald. 249.

of the article previously known by the name of malt, but was a method of converting malt into a colouring matter, to be used in colouring beer. And it was held that the patent was void on the ground of the misrepresentation contained in the title.

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Under an Issue upon a Plea alleging that the Invention was not an Invention of any manner of Manufacture, or was not of such a nature as could be made the subject of a Patent Privilege.

1. This issue raises a question which is more for the decision of the Judge than of the jury. The plaintiff must, however, give the specification in evidence, in order that the Judge may be enabled to see the nature of the art or invention which is comprised in the privilege granted by the patent.

2. If there are any terms of art contained in the title or *specification, the plaintiff ought to give evidence of the signification of [*455] those terms, and the jury must determine what the signification is, so as to enable the Judge to arrive at a right construction of the patent and specification, which, for this purpose, must be taken as one instrument.

3. The Statute of Monopolies (*b*) requires that, in order to render a patent valid, the subject of the privilege it grants must be the sole working or making of some manner of new manufacture, and the construction to be put upon this enactment in the statute has been considered in a former part of this work. (*c*) When the nature of the art or invention has been proved by means of the specification, and the meaning of terms of art and other facts which may be necessary to the right understanding of the specification have been ascertained by the jury, it is for the Judge to determine whether the invention is an invention of some manner of manufacture within the meaning of the Statute of Monopolies.

4. Under this issue, the defendant may also give any evidence which may be applicable to explain the signification of the terms of art contained in the title of the invention or the specification, so as to show that the nature of the art or invention for which the patent has been obtained was not within the meaning of the exception contained in the 6th section of the Statute of Monopolies.

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Under an Issue respecting the Novelty of an Invention. (d)

1. This issue compels the plaintiff to prove that the invention was new as to the public knowledge and use of it, at the time of the making of the patent. (*e*) The first thing to be attended to, therefore, is the *date* of the patent, for the patent must be presumed to have been made on the day it bears date. (*f*) And the patentee must be able to show *prima facie*, *that the invention [*456] which (*g*) he gave or contracted to give to the public had not before *that day* become public property.

(*b*) 21 Ja. I c. 3, s. 6.

(*c*) Vide *ante*, Chap. V. p. 77.

(*d*) See Chap. V. s. 2, p. 102, respecting the degree of novelty which is requisite in order to make an invention the legal subject of a patent privilege.

(*e*) As to the burthen of proof see *Turner v. Winter*, Dav. P. C. 153; *Manton v. Manton*, Dav. P. C. 348; *Bovill v. Moore*, Dav. P. C. 399.

(*f*) *Ludford v. Gretton*, Plow. 491.

(*g*) *Galloway v. Bleaden*, 1 Webs. 525; *Cornish v. Keene*, 1 Webs. 509.

But this issue does not raise the question whether the invention is a manufacture within the meaning of the Statute of Monopolies. (h)

2. In order to prove that the invention was new, the plaintiff must call witnesses whose avocations were likely to have made them acquainted with the invention if it had been known to the public prior to the date of the patent, and who can testify that it was unknown to them.

If it were possible to obtain the testimony of every member of the community upon the point, the novelty of an invention might be capable of direct and positive proof: but as that is impossible, the law allows of the next best evidence which a plaintiff can give, viz: the testimony of persons residing in this country, who were likely to have known of the invention if it had been public property prior to the date of the patent, and who can testify that the invention was unknown to them until the patentee by his patent contracted to give it to the public in consideration of the temporary privilege granted to him in the patent.

The value of evidence of this description depends entirely upon the means of knowledge possessed by the witnesses, and the degree of probability that they would have known of the art or invention if it had been public property before the date of the patent. The evidence of a person who was not more likely to know any thing respecting the invention than any other of her Majesty's subjects would be of very little value; and hardly any number of such persons would be able by their testimony to make out a *prima facie* case in support of the novelty of the invention.

But if the plaintiff calls witnesses, who, for some time before the date of the patent, were well acquainted with the particular branch of trade or manufacture to which the invention relates, and who can prove that they were ignorant of it until after the date of the patent, that will be sufficient *prima facie* evidence for the plaintiff on this issue.

[457] *The nature of this description of evidence is most clearly explained by the Lord Chief Justice *Tindal*, in the case of *Cornish v. Keene*, (i) in which his Lordship said in his charge to the jury, "On the part of the plaintiffs in this case the evidence is, as it necessarily must be, of a negative character. The assertion of the plaintiff Sever is, 'At the time I took out my patent, the subject of the patent was not generally known; it was a new invention by me, and was not known to the world.' You cannot prove a negative strictly; you can only do so by exhausting the affirmative instances of it by calling persons who never seen it (the invention), and the more those persons are in the way of hearing of it, or seeing it, if it had existed, the stronger is that exhausting evidence, if I may so call it, in its effect and value upon the jury. From the nature of the case, it is very difficult to suppose such circumstances as that a party should distinctly and affirmatively prove that it was a new invention, and it was not known and practised at the time the patent was obtained: therefore the plaintiff calls several witnesses to prove that part of the proposition: namely, persons who had been in this trade several years."

Evidence of this description was also held to be sufficient to make out a *prima facie* case for the plaintiff, by Lord Chief Justice *Gibbs*, in *Manton v. Manton*, (k) and by Lord Chief Justice *Tindal*, in *Galloway v. Bland*, (l)

3. If the invention consists of several distinct parts, the plaintiff must prove that each part of the invention was new at the date of the patent. (m) And

(h) *Walton v. Porter*, 1 Web. R. 601. (i) 1 Web. R. 573.

(j) Dav. P. C. 359, 353.

(k) 1 Web. R. 526.

(l) *Manton v. Manton*, Dav. P. C. 340, 341; *Gibson v. Brand*, 4 M. & G. 172; *Gillet v. Wily*, 9 C. & P. 324; and *Loh v. Bruce*, 1 Web. R. 238.

so, if several inventions have been comprised in the same patent, each invention must be shown to be new, or the whole patent will be void. (n)

4. The defendant must, in answer to a *prima facie* case for the plaintiff, show that the invention was public property at the date of the patent, or in the language of the plea, that it was not then a new invention as to the public knowledge and use of it.

5. If it can be shown that an invention was described in a book published before the date of the patent, or in any public document, such as [*458] a specification entolled in Chancery, that will be sufficient evidence to prove that the invention was not new within the meaning of the law. For the public had already a knowledge of the invention, or what is the same thing, possessed the means of knowledge available to every one of her Majesty's subjects.

Thus, in the case of *The King v. Arkwright*, (o) Emerson's book on Mechanics, published prior to the date of the patent, was held to be sufficient proof that a part of the alleged invention described in that work was not new. So, in the case of *Hill v. Thompson*, (p) it appeared that an essential part of the invention was described in Aikin's "Chemical Dictionary," which was published before the date of the patent, and the Dictionary was held to be sufficient evidence to show that the invention was not new.

And in the case of *Morgan v. Steward* (q) it was mentioned by Mr. Baron Alderson that Dr. Brewster lost the benefit of his invention of the Kaleidoscope, because it had previously been published in a book.

In the case of *Cornish v. Keene* (r) it appeared that the patentee had previously taken out a patent which had been specified before the date of the patent, upon which the action was brought. The defendant gave an office copy of the enrolment of the former specification in evidence, in order to disprove the novelty of the invention, and the Lord Chief Justice Tindal told the jury that if the secret was communicated to the world by the prior specification, the subsequent patent would be rendered void by the want of novelty in the invention.

And the defendant will be entitled to a verdict if he can show such a prior publication as to any part of the plaintiff's invention.

Thus, in the case of *Huddart v. Grimshaw*, (s) Lord Ellenborough, C. J., said, in his charge to the jury, that if prior to the time of the plaintiff obtaining his patent any part of that which was of the substance of the invention had been communicated to the public in the shape of a specification of any other patent, the plaintiff could not claim the benefit [*459] of a patent.

6. But the invention comprised in a patent will not be shown to want novelty by proof that *after* the date of the patent, although *before* the date of the specification, the invention was described or mentioned in the specification of some prior patent. (t)

7. Proof that a foreign work containing a description of the invention had been imported into this country prior to the patent, would not be evidence of a want of novelty, unless it could be shown that the work was also published, or sold to the public here, prior to the date of the patent. (u)

8. The Statute of Monopolies, (x) which, we have seen, was in affirmance of the Common Law in this respect, requires that the art which is made the

(n) *Borden v. Hawks*, 4 B. & All. 541. (o) *Day*, P. C. 129.

(p) 8 Taunt. 382; 1 Webs. R. 247, 248. (q) 2 M. & W. 553.

(r) 1 Webs. R. 510, 511.

(s) *Day*, P. C. 279.

(t) See *Cornish v. Keene*, 3 Bing. N. C. 570.

(u) *Vide ante*, *Chen v. r.* 2, p. 108. (x) *Stat. p.* 106.

subject of a patent grant shall be the sole working or making of some manner of new manufacture, *which others, at the time of the making of the patent, do not use*; and the patent itself contains a condition that the invention comprised in it shall be *new as to the public use and exercise of it.* (y) And, therefore, if it can be shown that the art or invention comprised in the patent was *used* by others in public before the making of the patent, the defendant will be entitled to a verdict upon this issue.

9. But the prior use of an invention must be shown to be a *public use*, in order to enable a defendant to succeed upon this issue, for the use of it in private would not prove that the public had acquired a knowledge of the invention, or a right to use it before the date of the patent.

There is some difficulty, however, in laying down any rule in terms sufficiently definite for the purpose of determining the precise degree of publicity in the prior use of an invention, which will be sufficient to show a want of the novelty which is required by law.

10. It is not necessary, however, for the defendant to show, in support of his case, under this issue, that there had been a *general use* of the invention [*460] before the date of the patent, it is sufficient to prove that there had been a *public use* of the invention.

It was indeed at one time supposed that the case of *Lewis v. Marling* (z) had decided that a defendant was bound to show a general use of the invention prior to the patent, in order to be entitled to a verdict on this issue. It is true that according to the report of that case, at *nisi prius*, Lord *Tenterden* did make use of the words "generally known or generally used;" but his Lordship was speaking of evidence, (a) which went merely to prove that there had been experiments made prior to the patent, which it is quite clear could not have the effect of defeating the plaintiff's claim to his patent.

If the report of the case of *Lewis v. Marling*, at *nisi prius*, be compared with the report of the same case (b) upon a motion *in banc* for a new trial, (b) it will be seen that the former differs from the latter in the statement of facts as to several material particulars. No objection was taken to the ruling of the learned Judge at *nisi prius*; and his Lordship himself says that he left the case to the jury to say whether the invention had been "in *public use* and operation before the granting of the patent."

And in the subsequent case of *Carpenter v. Smith*, (c) Lord *Abinger, C. B.*, said that he had been counsel in the case of *Lewis v. Marling*, and also in *Jones v. Pearce*; (d) and that he recollected that those cases proceeded on the ground of the former machines being in truth mere experiments, which altogether failed. From what has been said, there seems to be strong grounds for believing that some error has crept into the report of the case of *Lewis v. Marling*, at *nisi prius*; but however that may be, it is clear, from the authority of a great number of cases, that it is sufficient for a defendant to prove, in order to obtain a verdict on this issue, that the invention was *publicly known*, or used before the date of the patent.

In the case of *Cornish v. Keece*, (e) it was laid down by the Lord Chief Justice *Tindal*, that if the invention was, at the time the letters patent were [*461] granted, in any degree of "general use, if it was known at all to *the world publicly, or practised openly*, so that any other person might have the means of acquiring it as well as the person who obtained a patent, that would be sufficient to show that the patent was void.

(y) *Ante*, Chap. IV. p. 52, and Chap. V. p. 106.

(z) 4 C. & P. 52.

(b) 10 B. & C. 22.

(d) 1 Webs. R. 122.

(a) Vide 10 B. & C. 22.

(c) 9 M. & W. 300.

(e) 1 Webs. R. 508.

And the same learned Judge, in the case of *Gibson v. Brand*, (f) told the jury that it was quite clear that if, on the evidence they had heard, they were satisfied that that which was alleged to be a discovery by the plaintiffs, had been publicly known and practised in England, there was an end to the validity of the patent.

So, in the case of *Jones v. Pearce*, (g) it was laid down by Mr. Justice Patteson, that if a wheel which had been made before the date of the patent, was on the same principles, and in substance the same as the wheel for which the plaintiff had taken out his patent; (h) and that it had been used openly in public so that every body might see it, and had continued to use the same thing up to the time of the taking out of the patent, the plaintiff's invention was not new and his patent bad.

This ruling was mentioned in the case of *Carpenter v. Smith*, (i) and approved of by Mr. Baron Alderson, except that his Lordship thought it need not appear that the use continued up to the time of taking out the patent. And as it is clear, both from the report of the case in *Jones v. Pearce* and the observation made by Lord Abinger in *Carpenter v. Smith*, (k) that the plaintiff obtained a verdict in *Jones v. Pearce*, on the ground that the alleged prior use of the invention was merely experimental; the probability is, that when Mr. Justice Patteson was speaking of the prior use continuing up to the time of the patent being obtained, his Lordship meant that if the use continued up to the time of taking out the patent, it would show that it was not experimental merely.

11. The meaning of the term public use was much discussed in the recent case of *Carpenter v. Smith*. (l) It was held by Lord Abinger, C. B., at nisi prius, (m) in that case, that "public use" means a use in public, [*462] or in a public manner, and not a user by the public. And upon a motion for a new trial, on the ground of a misdirection, (n) the Court of Exchequer held that the Lord Chief Baron's ruling was right; and a rule nisi for a new trial was refused. In giving judgment in that case, Mr. Baron Alderson said—"Public use means a use in public, so as to come to the knowledge of others than the inventor, as contradistinguished from the use of it by himself in his chamber."

12. It is not necessary to show that the alleged invention was used by several persons before the grant of the patent; for if a prior user by one person is shown to have been sufficiently in public, that is enough to entitle the defendant to a verdict.

Thus, in the case of *Manton v. Manton*, (o) Lord Chief Justice Gibbs held, that proof of the invention having been used or practised (in public) by any one person before the date of the patent, would be sufficient to show that the invention was not new, and avoid the patent. So, in the case of *Carpenter v. Smith*, (p) Lord Abinger, C. B., held, that if it were shown that the invention had been once in public use (that is, used in a public manner, not used by the public,) or had been used by half-a-dozen individuals, or one, in a public manner, that would be sufficient to defeat the patent. In that case a witness proved (q) that he had made a lock five years before the date of the patent, upon the same principle as the plaintiff's, which had been put upon a gate belonging to Mr. Davies, where the witness saw it every day; that he after-

(f) 1 Webs. R. 628.

(h) See *Hasting's case*, cited in *Darcy v. Allen*, Noy, 178.

(i) 1 Webs. R. 542.

(l) 9 M. & W. 300.

(n) 9 M. & W. 300.

(p) 1 Webs. R. 525.

(g) *Ibid.* 122.

(k) 1 Webs. R. 542; vide ante, p. 460.

(m) 1 Webs. R. 530.

(o) Dav. P. C. 333.

(q) *Ibid.* 539.

wards repaired the lock ; and that it continued in use until the time it was taken off to be produced at the trial. Lord *Abinger* held this to be sufficient evidence of a public use of the invention, and told the jury that it was sufficient to justify a verdict for the defendant upon this issue. And upon a motion for a rule for a new trial in that case, (q) on the ground of a misdirection, the Court of Exchequer held that the ruling of Lord *Abinger*, at *nisi prius*, was correct, and refused a rule.

[*463] Sc, also, in the case of *Losh v. Hague*, (r) Lord *Abinger*, *C. B., laid down the same law, that a single instance of public use is sufficient evidence for the defendant, upon this issue.

13. And it is sufficient if the defendant can show that the art or invention has been before used for any purpose whatever, although it has not been used for the object or purpose mentioned in the plaintiff's specification ; and the reason is, that the mere new use of an old art or invention cannot be made the subject of a patent privilege. (s)

Thus, in the case of *Kay v. Marshall*, (t) it was shown that the machinery which the patentee was the first to apply to the spinning of flax, had before been used for spinning wool, cotton, &c. ; and it was held the patent was void in consequence of the want of novelty in the invention.

And in the case of *Losh v. Hague*, (u) in which the patent had been granted for "improvements in the construction of wheels for carriages to be used on railways;" it was proved that the plaintiff's alleged improvement had been applied in the construction of wheels to be used on common roads before the date of the patent, and before any railways had been made ; and Lord *Abinger*, C. B., held the evidence sufficient proof of a want of novelty in the invention, and the defendant accordingly had a verdict. In the course of his charge to the jury, the learned Judge said—"If you are of opinion that this wheel has been constructed, according to the defendant's evidence, by the persons who have been mentioned, long before the plaintiff's patent, although there were no railroads then to apply them to, and no demand for such wheels, yet the application of them to railroads afterwards by Mr. Losh will not give effect to his patent, if part of that which is claimed as a new improvement by him, is in fact an old improvement, invented by other people and used for other purposes ; that is my opinion on the law, and on that I am bound to direct you." And his Lordship added, that if the wheels had been before constructed *on the same principle* as the plaintiff's either wholly or in part, the defendant was entitled to a verdict. (x)

[*461] 14. The want of novelty in an invention may also be shown by evidence that articles produced by the exercise of the art or invention were sold before the date of the patent. The reason of this is, that a sale of such articles is evidence that a prior inventor has published the invention to the world, and given the benefit of it to the public. And accordingly it is the constant practice to give evidence to prove that articles the same as the patent articles were sold before the date of the patent.

In the case of *Wood v. Zimmer*, (y) it appeared that the patentees had, four months previous to the patent, sold an article composed in precisely the same manner as that for which the patent was obtained, although under a name different from that contained in the title in the patent. Lord Chief Justice *Gibbs*

(q) 9 M. & W. 300.

(r) 1 Webs. R. 205.

(s) *Vide ante*, Chap. V. s. 1, p. 91, and s. 2, p. 113.

(t) 5 Bing. N. C. 492; 1 Beavan, 535; and 8 Cl. & Fin. 245.

(u) 1 Webs. R. 202.

(x) See this case, cited more at length, *ante*, p. 95; and see also pp. 112, 113.

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

held, that inasmuch as the patentees sold the article previously, they gave it to the world without a patent, and could not afterwards obtain a (valid) patent for it. And his Lordship said—"some things are obvious as soon as they are made public. Of others the scientific world may possess itself by analysis, some inventions almost baffle discovery. But to entitle a man to a patent, the invention must be new to the world. The public sale of that, which is afterwards made the subject of a patent, though sold by the inventor only, makes the patent void."

So, in the course of delivering the judgment of the Court of Exchequer in the case of *Morgan v. Seaward*, (z) Mr. Baron Parke said—"It must be admitted that if the patentee himself had before his patent constructed machines for sale as an article of commerce for gain to himself, and been in the practice of selling them publicly, that is, to any one of the public who would buy, the invention would not be new at the date of the patent. This was laid down in the case of *Wood v. Zimmer*, (a) and appears to be founded in reason; for if the inventor could sell his invention, keeping the secret to himself, and when it was likely to be discovered by another, take out a patent, he might have practically a monopoly for a much longer period than fourteen years. Nor are we prepared to say, that if such a sale was of articles that were only fit for a foreign market, or to be used abroad, it would make any difference; nor that a single instance of such a sale, as an article of commerce, to any one who chose to buy, might not be deemed the commencement of such a practice and the public use of the invention, so as to defeat [*465] a patent."

In the case of *Minter v. Mower*, (b) proof of the making and sale of a single chair before the date of the plaintiff's patent, was held to be sufficient to render the patent void. And in the case of *Losh v. Hague*, (c) Lord Abinger, C. B., held, that if the patent article had been made and sold to one individual before the date of the patent, that would be sufficient to entitle the defendant to a verdict.

15. Evidence of the public use of the invention comprised in a patent, or the sale of an article made by means of it in this country, by a single individual, at any time before the date of the patent, is sufficient to entitle the defendant to a verdict upon this issue, not only because the invention is not brought within the terms of the exception in the Statute of Monopolies, (d) but also because at the Common Law no one can be deprived of the right to use an invention which he had publicly used prior to the date of the patent. (e)

Thus, in the case of *Minter v. Mower*, (f) in which proof of the prior use of the invention by a person of the name of Brown, in a single instance only, was held to avoid the patent. One reason given by the Court for holding the patent to be void was, that it "would have actually precluded Brown from continuing to make the same chair that he had made before the patentee's discovery."

So, in the case of *Carpenter v. Smith*, (g) in which the sale and public use of a single lock, put upon Mr. Davies' gate, was held to be sufficient evidence of a want of novelty in the plaintiff's invention; one reason given by Mr. Baron Alderson was, that if the patent were to be held good, and Mr. Davies were to change his lock to another gate, he would be liable to an action for an infringement of the plaintiff's patent.

(z) 2 M. & W. 544.

(b) 6 A. & E. 735.

(d) Vide *ante*, p. 106, 108.

(f) 6 A. & E. 735; 1 Webs. R. 142.

(a) Holt, N. P. C. 58, stated above.

(c) 2 Webs. R. 206.

(e) Vide *ante*, Chap. III. s. 4, p. 33.

(g) 9 M. & W. 300, stated *ante*, p. 462.

And in the case of *Cornish v. Keene*, (*h*) the Lord Chief Justice *Tindal* told the jury, that if the defendants had shown that they had practised the [*466] invention, and produced the same *result in their factory before the time the patent was obtained, they could not be prevented by the subsequent patent from going on with that which they had done.

16. It seems to make no difference that the articles sold before the date of the patent, and relied on as a previous publication, were purchased for the purpose of being exported. For, by a public sale, that is a sale to any one who chooses to buy; the vendor acquired a right by means of the publication, which no subsequent patentee could deprive him of.

In the case of *Carpenter v. Smith*, (*i*) it appeared that a trader connected with the American trade, produced to a manufacturer at Birmingham an American model of a lock similar to the plaintiff's; and the manufacturer several years before the date of the patent made a parcel of six dozen locks, and another parcel of a dozen and a half locks, according to the model, and sold them to the trader for the alleged purpose of being sent to America. Lord *Abinger*, C. B., held, that the sale of these locks was destructive of the novelty of the plaintiff's patent, although sold for the purpose of being sent to America; and the Court of Exchequer afterwards refused to grant the plaintiff a rule *nisi* for a new trial. (*j*)

17. If it be shown that any essential part of the invention is deficient in the requisite novelty, the defendant will be entitled to a verdict; for the consideration for the patent privilege being the novelty of the whole invention, if any part of it fail or be not new, the patent is entirely void. (*k*)

Thus, in the case of *Brinton v. Hawkes*, (*l*) in which the invention was for improvements in ships' anchors, windlasses, and chain cables, it was shown that the alleged improvement in the anchor was not new, and it was held that the patent was therefore void.

18. If the defendant can show that the description contained in the specification by reason of its generality or otherwise, has the effect of including in the patent any thing that was publicly known, or used before the date of it, (*m*) [*467] so that a *subsequent use of a thing so included in the patent would be an infringement of it; the defendant will be entitled to a verdict on this issue.

This was in effect laid down by Lord *Eldon* in the case of *Hill v. Thompson*, (*n*) in which his Lordship said, 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."

And in the case of *Losh v. Hague*, (*o*) Lord *Abinger*, C. B., said to the jury, "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 got a patent for."

19. It is therefore important, with reference to the evidence to be given under this issue, to consider what would, or would not be, an infringement of the patent; and then to ascertain whether every thing to which the patent would thus apply, was new at the date of the patent. And if the defendant can prove that there is any art or invention which was public property at the date of the patent, and which would, if used afterwards, render a person liable

(*h*) 1 Webs. R. 501, 511.

(*i*) 1 Webs. R. 530; 9 M. & W. 300.

(*j*) See also *Morgan v. Seaward*, 2 M. & W. 544, cited *ante*, p. 464.

(*k*) See Chap. V. s. 2, pp. 115, 116, and *ante*, pp. 116, 458.

(*l*) 4 B. & Ald. 541; and see the cases, cited *ante*, p. 116.

(*m*) See the judgment of Parke, B., in *Russell v. Cowley*, 1 Webs. R. 469.

(*n*) 3 Mer. 626.

(*o*) 1 Webs. R. 206.

for an infringement of the patent, if it were valid, the plaintiff cannot have a verdict upon this issue, for he cannot show that every part of the invention was new at the date of the patent. (p)

Thus, in the case of *Minter v. Mower*, (q) it appeared that the description contained in the specification, had the effect of including a chair such as had been made and sold by a person called Brown before the date of the patent. And the Court of Queen's Bench for this reason held, that the patent was void.

So, in the case of *Carpenter v. Smith*, (r) it appeared that the invention (remaining after a disclaimer) was alleged to be an improvement in locks consisting of a combination of a sliding bolt and lever latch. The patentees claimed this combination in general terms, not in any particular manner, and Lord Abinger, C. B., held, that as the description contained in the specification was so general in its terms as to *include something which was before known, the patent was bad for want of novelty in the [*468] invention.

In the case of *Williams v. Brodie*, (s) the patent was held to be void, because the specification described without distinction both the old stove, and the addition or improvement invented by the patentee.

In *The King v. Else*, (t) the patent was held to be void, because the patentee claimed, not merely the particular improvement which he had invented in the mode of mixing silk and cotton thread upon the frame in making lace, but the right of making lace of silk and cotton thread generally, lace having in some other way been made by the mixing silk and cotton thread before the date of the patent.

See also in the case of *Bovill v. Moore*, (u) the patentee in his specification described the whole machine to which his invention related, without distinguishing the improvements of which alone the invention consisted, and it was held, that the patent was therefore void.

See also the cases of *Campion v. Benyon*, (v) *Jessop's case*, (x) *Macfarlane v. Price*, (y) *R. v. Nickels*, (z) and *R. v. Cutler*. (a)

20. In order to obtain a verdict upon this issue, the defendant is not bound to prove a public knowledge or use of the invention within England, Wales and Berwick-upon-Tweed; it is sufficient if he proves such a public knowledge or use in any part of the realm, which includes the whole of the United Kingdom and all its colonies.

This was in effect decided by the case of *Brown v. Annandale*, (b) in the House of Lords. That case it is true was an appeal from a decision of the Court of Sessions in Scotland; but it is quite clear that the decision of the House is quite as applicable to an English as to a Scotch patent. The effect of that decision is in fact this, that by the act of the Union between England and Scotland, the Statute of Monopolies (c) was as to patents extended to Scotland, and that from that *time the words, "this realm," in [*469] the statute meant, not merely England, Wales, Berwick-upon-Tweed and the colonies, but Scotland also; and that if an invention is shown not to be new in any other portion of the realm than that to which the grant extends, the patent is void.

(p) Vide *ante*, p. 119.

(r) 1 Webs. R. 538, 539.

(s) Cited in *R. v. Arkwright*, Dav. P. C. 96.

(t) Dav. P. C. 144.

(u) 6. B. Mo. 71, cited *ante*, p. 119.

(y) 1 Stark. R. 199, cited *ante*, p. 185.

(a) 1 Stark. 354.

(c) 21 Jac. I. c. 3, s. 6.

(q) 6 A. & E. 735.

(u) 2 Marsh. 211; Dav. P. C. 361.

(x) Dav. P. C. 203.

(z) Cited *ante*, p. 186.

(b) 1 Webs. R. 433.

By the statute for the union between Great Britain and Ireland, the whole of the United Kingdom is made one realm, and therefore there can be little doubt that an invention must be new throughout that realm, including the whole of the United Kingdom, and also all its colonies, in order to support a patent. If therefore a defendant can show that the invention which forms the subject-matter of the action was publicly known and used before the date of the patent, in any part of the United Kingdom, or any of the colonies, he will be entitled to a verdict upon this issue.

21. Evidence of a mere discovery of the plaintiff's invention by some other person prior to the date of the patent, will not be sufficient to entitle the defendant to a verdict on this issue, (d) unless the discovery was publicly used, or actually published to the world in such a manner that the public had acquired a right to use the invention. (e)

22. Nor will a defendant be entitled to a verdict on this issue, upon proof that a patent had been obtained prior to the plaintiff's patent for an invention for effecting precisely the same object as the plaintiff's invention, provided the plaintiff's invention is for effecting the object by means different from those used by the prior patentee.

Thus, in the case of *Hullett v. Hague*, (f) it appeared that the patentee had, by his specification, described his invention (intituled "improvements in evaporating sugar") as follows—"I do further declare that my said invention and improvement consists in forcing, by means of bellows, or any other blowing apparatus, atmospheric, or any other air, either in a hot or cold state, through the liquid or solution subjected to evaporation; and this I do by means of pipes, whose extremities reach nearly (or within such distance as may be found [*470] suitable under *peculiar circumstances) to the upper or interior area of the bottom of the pan or boiler containing such liquid or solution, the other extremities of such pipes being connected with larger pipes, which communicate with the bellows or other blowing apparatus which forces the air into them." The defendant gave in evidence a prior patent and specification, comprising an invention for the same object. But it appeared that the prior patentee used pipes perforated with holes, and coiled at the bottom of the vessel, or a shallow metallic vessel of the nature of a cullender; and the Court of Queen's Bench held that as the subsequent patentee effected his object by different means, the inventions were perfectly distinct, and that the prior patent and specification were no proof of a want of novelty in his invention, although the object of the two inventions was precisely the same. (g)

And in the case of *Walton v. Potter*, (h) the Lord Chief Justice *Tindal* laid down the law on the subject thus—"There can be no doubt that although one man has obtained a patent for a given object, there are many modes still open for other men of ingenuity to obtain a patent for the same object; there may be many roads leading to one place, and if a man has, by dint of his own genius and discovery, after a patent has been obtained, been able to give to the public, without reference to the former one, or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent for that purpose."

(d) *Gibson v. Brand*, 1 Webs. R. 628; and see *Dolland's case*, Dav. P. C. 170, and *ante*, p. 126.

(e) See further the observations and cases, *ante*, p. 448, as to evidence which would be insufficient to show that a patentee was not the first inventor.

(f) 2 B. & Ad. 370.

(g) See also the case of *Russell v. Cowley*, 1 Webs. R. 463; and *Macintosh v. Everington*, 6 Rep. Arts, N. S. 317-365.

(h) 1 Webs. R. 590-591.

Evidence of a prior use of the invention will not be sufficient to prove a want of novelty, if the invention was used secretly, or in such a manner, as not to amount to a publication.

In the case of *Bentley v. Fleming*, (i) it appeared that the patent had been obtained for a card machine; and there was evidence that about five or six weeks before the patent was obtained, the inventor had lent his patent machine to one N., in order that he might try whether it would set the teeth of the cards, and in order to discover whether it was worth while to take out a patent for it or not. There was also evidence *that N.'s room was in a mill, and that men were constantly going backwards and forwards [*471] to and from the room. It appeared also that for some weeks before the time at which the machine was lent to N., it had been in complete working condition. It was objected on behalf of the defendant, that this was sufficient evidence that the machine had been publicly used in N.'s room before the granting of the patent; but Mr. Justice *Cresswell* held that that was not so, there being no evidence to show that the machine had been given to N. for the purpose of his giving it publicity. And it is quite clear that this evidence was insufficient, because the use of the machine was merely experimental; the knowledge communicated to N. must be deemed to have been confidential, and therefore within the meaning of the principle laid down in *Morgan v. Seaward*, (k) and there was no evidence to show that persons coming into N.'s room either did or could discover the nature of the invention, and it is improbable that the nature of a complicated machine could be discovered merely by a passing sight of it. This case seems to give rise to this observation, that whenever it appears that an act done before the date of the patent, was not intended to be a publication of the invention, it will not be presumed to have amounted to a publication, unless it is clearly shown that the effect of the act was to publish a knowledge of the invention to the world.

In the case of *Bentley v. Fleming*, (l) just cited, it was also proved that the inventor had a machine made according to his invention in complete working order for a long period before he took out the patent, but there being no proof of a public use of the machine, the learned Judge held that the evidence was not sufficient to invalidate the patent.

In the case of *Morgan v. Seaward*, (m) an action was brought by the assignee of a patent for an invention, one part of which was an improved paddle-wheel. It was proved in evidence, that before the date of the patent, (which was the 22nd July, 1829,) Curtis, an engineer, made for Morgan (one of the plaintiffs) two pair of wheels upon the principle mentioned [*472] in the patent at his own factory. Galloway, the patentee, gave the instructions to Curtis under an injunction of secrecy, because he was about to take out a patent. The wheels were completed and put together at Curtis's factory, but not shown or exposed to the view of those who might happen to come there. After remaining a short time, the wheels were taken to pieces, packed up in cases, and shipped in the month of April on board a vessel in the Thames, and sent for the use of the Venice and Trieste Company, of which Morgan (one of the plaintiffs) was managing director, and which carried on its transactions abroad, but had shareholders in England. Curtis deposed that "they were sold to the Company," without saying by whom, which might mean that they were sold by Curtis to Morgan for the Company; and Morgan paid Curtis for them. Morgan and Galloway employed an attor-

(i) 1 C. & K. 587.

(k) 2 M. & W. 544, cited *ante*, p. 127.

(l) 1 Car. & Kirw. 587.

(m) 2 M. & W. 544, cited more fully, *ante*, p. 127.

ney, who entered a *caveat* against any patent on the 2nd of March, and afterwards solicited the patent in question, which was granted to Galloway and assigned to Morgan. Upon these facts, a verdict was entered for the defendant at *nisi prius*, upon a plea alleging that the invention was not new, but leave was reserved for the plaintiff to move the Court of Exchequer to have the verdict entered for him on that issue. The Court afterwards made a rule absolute for entering a verdict for the plaintiff on the ground that the disclosure was private and confidential, and that the sale of wheels was not a public sale, nor a transaction from which the inventor derived any profit. (n)

24. Evidence of prior unsuccessful experiments will also be insufficient to defeat a patent on the ground of a want of novelty in the invention. If the prior experiments failed in producing any effect, the communication of a knowledge of them to the world could not amount to any publication of the art or invention subsequently comprised in the patent. For if the experiments were unsuccessful, the invention would be incomplete, and it would be impossible to give a knowledge of it to the world.

Thus, in the case of *Jones v. Pearce*, (o) for an infringement of a patent for [*473] improvements on wheels for carriages, it appeared that wheels similar to the plaintiff's had been made and used by Mr. Strutt before the date of the patent, but that the wheels being afterwards broken they were laid aside. Mr. Justice *Patteson* told the jury, that if they were of opinion that Mr. Strutt's wheel was an experiment, and that he found it did not answer, and ceased to use it altogether, and abandoned it as useless, and no body else followed it up, there was no reason for saying that the plaintiff's patent was not good.

So, in the case of *Cornish v. Keene*, (p) the Lord Chief Justice *Tindal* held, that if the evidence that is brought in any case, when properly considered, classes itself under the description of experiment only, and unsuccessful experiment, such evidence would not show the patent to be void on the ground that the invention was not new to the public. And in delivering the judgment of the Court of Common Pleas in that case, (q) his Lordship said, "The question raised for the jury was this, whether the various instances brought forward by the defendants amount to proof, that before, or at the time of taking out the patent, the manufacture was in public use in England; or whether it fell short of that point, and proved only that experiments had been made in various quarters, and had been afterwards abandoned. This question is, from its nature, one of considerable delicacy, a slight alteration in the effect of the evidence will establish either the one proposition or the other, and the only proper mode of deciding it is by leaving it to the jury." (r)

And in the case of *Galloway v. Bleaden*, (s) the Lord Chief Justice *Tindal* said, in his charge to the jury, that a mere experiment, or mere course of experiments, for the purpose of producing a result which was not brought to completion, but begun and ended in uncertain experiments,—that was not such an invention as should prevent another person who was more successful, or pursues with greater industry, the chain in the line that has been laid out for [*474] him by the preceding inventor, from availing himself of it, and having the benefit of it. And his Lordship told the jury, "that the question for them to determine was, whether on the evidence the thing itself

(n) See the judgment of the Court, given *ante*, p. 127.

(o) 1 Webs. R. 122.

(p) 1 Webs. R. 508.

(q) 3 Bing. N. C. 570.

(r) See also the charge of Mr. Justice *Cresswell*, in *Walton v. Bateman*, 1 Webs. R. 619.

(s) 1 Webs. R. 525, 526.

was complete so as to be used, or whether only a series of experiments was going on. (s)

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Under an Issue upon a Plea alleging that the Invention was of no Utility. (t)

1. Under this issue the plaintiff must give *prima facie* evidence to prove that the invention which has been made the subject of the patent grant, was useful to the public at the date of the patent. (u) But the degree of utility is quite immaterial under this issue, it is sufficient if the plaintiff can show that the invention was of *any* utility to the public. (x) And it is to be observed that the question of utility must be determined with reference to the date of the patent, for subsequent discoveries may have rendered the invention useless. Upon this issue neither the novelty of the invention nor the sufficiency of the specification is in issue, and therefore the question to be decided is, whether that which is claimed by the specification as the patentee's invention was of public utility at the date of the patent. It is consequently necessary that the plaintiff should give his specification in evidence in support of this issue in order to show what the invention really is.

2. This issue, must not be confounded with an issue, respecting the invention being an improvement, in the particular kind of manufacture to which the invention relates. For upon such an issue, the plaintiff must prove that the invention was some improvement upon what was known before the date of the patent. But under an issue upon a plea alleging the want of utility, in the invention, the plaintiff will make out a *prima facie* case, if he proves the invention to be of *any* utility to the public, wholly irrespective of any thing that was known at the date of the patent. (x)

3. If there are several separate and independent parts of an invention, each part must be shown to be useful, (y) or at all *events to have been of some utility at the date of the patent. And if the plaintiff fails [*475] to prove that any material part of his invention is useful, his patent is entirely void. (z)

4. In order to succeed upon this issue the defendant must show a total want of public utility in the invention, or in the words of the plea, that it was of no use or benefit to the public.

This issue is in fact taken upon a traverse of the consideration which ought to be received by the public for the patent grant, which is, the benefit or utility of the invention to the public; and unless the defendant can show a total want of utility, there will be a sufficient consideration to support the patent upon this issue.

Thus, in the case of *Lewis v. Marling*, (a) it appeared that the object of the invention was the production of a machine which was useful as a whole, but it was proved that a part of it as described in the specification was useless,

(s) See also *Gibson v. Brand*, 1 Webs. R. 628.

(t) See Chap. V. s. 3, p. 132, respecting the utility of an invention which is made the subject of a patent privilege.

(u) *Manton v. Manton*, Dav. P. C. 349; *Bovill v. Moore*, Dav. P. C. 399, cited *ante*, p. 135.

(x) *Morgan v. Seaward*, 1 Webs. R. 172, cited *ante*, p. 137.

(y) *Ibid.* 172, 186.

(z) *Hill v. Thompson*, 8 Taunt. 375; vide *ante*, p. 139.

(a) 10 B. & C. 22; see also *Haworth v. Hardcastle*, 1 Bing. N. C. 182-4; 4 M. & Sc. 720, S. C.

and yet it was held that this was not such a want of utility as would vitiate the patent. (b)

5. If the patentee has represented that his invention is useful in some particular manner, the defendant may defeat the patent by proving that the representation was untrue. (c) The defendant cannot do this, however, under a plea merely, alleging that the invention is of no use to the public, but must offer such evidence either under a plea of *non concessit*, or a special plea alleging that the patent was void in consequence of the false representation. (d)

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Under an Issue upon a Plea alleging that there is no sufficient Specification.(e)

1. Upon this issue the plaintiff must show, (f) that he or the patentee has [*476] in pursuance of the proviso in the patent by *an instrument under his hand and seal, particularly ascertained and described the nature of the invention, and the manner in which it is to be performed. (g)

The plaintiff must therefore produce the specification itself, or account for its non-production, and show that it was made under his hand and seal. And if there is an attesting witness to it, it is apprehended that he must be called as a witness at the trial, or his absence accounted for.

2. So, also, he must show that the instrument was made within the time limited by the proviso in the patent. These formal proofs are, however, rarely required, the contest between the parties generally turning upon the sufficiency of the instrument itself.

The defendant sometimes in his plea sets out the specification itself, and then concludes with a special traverse of the allegation in the declaration that the patentee had sufficiently specified his invention, (h) and in such a case the formal proofs already mentioned are unnecessary, the only question then being whether the specification is sufficient.

3. The question respecting the sufficiency of the specification is a mixed question of law and fact, partly for the determination of the jury and partly for the decision of the Judge.

In the case of *Hill v. Thompson*, (i) Lord Eldon, L. C., said, that the intelligibility of the description of an invention is a matter of fact for the jury, but whether or not the patent is defective in attempting to cover too much is a question of law.

And in the case of *Neilson v. Harford*, (k) it was contended that the jury were to judge of the construction to be put upon the specification, but the Court of Exchequer thought otherwise; and in delivering the judgment of the Court in that case, Mr. Baron Parke said, "The construction of all written evidence belongs to the Court alone; whose duty it is to construe all written instruments, as soon as the true meaning of the words in which they are couched, and the surrounding circumstances, if any, have been ascertained by [*477] *from the Court, either absolutely, if there be no words to be con-

(b). And see further the cases, cited *ante*, Chap. V. s. 3.

(c) *Vide ante*, p. 139.

(d) *Vide ante*, p. 451, as to an issue respecting a false representation.

(e) See the various Forms of Pleas in the Appendix, Chap. II. s. 4.

(f) As to the Burthen of Proof, *vide ante*, p. 433.

(g) See Chap. VII. (*ante*, p. 151) respecting the Form, Requisites and Construction of Specifications.

(h) *Vide ante*, Chap. X. s. 2, p. 276.

(i) 3 Mer. 626.

(k) 8 M. & W. 806; 1 Webs. R. 370.

strued as words of art, or phrases used in commerce, or surrounding circumstances to be ascertained, or conditionally, where those words or circumstances are necessarily referred to them. Unless this were so, there would be no certainty in the law, for a misconstruction by the Court is the proper subject, by means of bill of exceptions, of redress in a Court of Error; but a misconstruction by the jury cannot be set right at all effectually."

The law thus laid down (*l*) by the Court of Exchequer defines most clearly the respective duties of the Court and the jury, in determining an issue respecting the sufficiency of a specification.

4. The form, requisites, and construction of a specification have already been considered in a former part of this work, (*m*) to which the reader is referred; and the only remaining branch of the subject to be considered is, what evidence may or ought to be given by the parties upon the trial of this issue.

5. Upon this issue the plaintiff is bound to prove that the description contained in the specification is sufficient to ascertain the nature of the invention, and the manner in which it is to be performed. That the burthen of proof is upon the plaintiff, was held by Mr. Justice *Buſher*, in the case of *Turner v. Winter*, (*n*) in which his Lordship said, "I do not agree with the counsel who have argued against this rule, in saying that it was not necessary for the plaintiff to give any evidence to show what the invention was, and that the proof that the specification was improper lay on the defendant; for I hold that a plaintiff must give some evidence to show what his invention was, unless the other side admit that it has been tried and succeeds. But whenever the patentee brings an action on his patent, if the novelty or effect of the invention be disputed, he must show in what his invention consists, and that he produced the effect proposed by the patent in the manner specified. Slight evidence of this on his part is sufficient; and it is then incumbent on the defendant to falsify the specification."

*And this was cited and approved of by Mr. Baron *Bolland*, in the case of *De Rosne v. Fairie*, (*o*) in which the Court of Exche- [*478] quer made a rule absolute for a new trial on the ground that the plaintiff had not given sufficient evidence to explain the specification.

So, also, in the case of *Manton v. Manton*, (*p*) the Lord Chief Justice *Gibbs* held that it is necessary that a patentee should show that he has accurately explained the nature of his invention in his specification. (*q*)

6. Under this issue the plaintiff must prove—that the specification describes the same invention as that mentioned in the patent;—that it sufficiently describes every part of the invention;—that the description it contains is sufficiently intelligible to persons of competent knowledge;—and that the invention is capable of producing all the effects specified.

7. And firstly, plaintiff must show that he has in his specification described the same invention as that which is comprised in the patent. In the case of *The King v. Wheeler*, (*r*) it was held that a patent was void because the specification described a process for converting malt into colouring matter by exposing it to a high temperature, whereas the title in the specification was "a new or improved method of drying and preparing malt," and it was held that the variance rendered the patent void. But if it had been shown that an article, such as that produced by means of the patent process, was known by the

(*l*) See also the case of *R. v. Wheeler*, 2 B. & Ald. 349.

(*m*) *Ante*, Chap. VII. p. 151.

(*n*) Dav. P. C. 153; 1 T. R. 602.

(*o*) 5 Tyr. 393.

(*p*) Dav. P. C. 333.

(*q*) See further as to the Burthen of Proof, *ante*, p. 433.

(*r*) 2 B. & Ald. 349.

name of malt, then it is conceived that the objection on the ground of variance would have been removed. Thus in the case of *The King v. Metcalf*, (*) in which it was held that a patent obtained for a tapering brush was void by reason of a misdescription of the invention, Lord *Ellenborough*, C. J., seemed to be of opinion that if the term tapering brush had by the usage of trade acquired a perverted sense, evidence of the fact might have been given for the purpose of removing the objection, but in the absence of such evidence the patent was held void.

8. The plaintiff must also show that the specification sufficiently describes [*479] every part of the invention comprised in the patent, and every thing which is necessary to put it into successful use and practice. (i) For the consideration to be given to the public is the knowledge of the whole invention; and if any part of the invention is insufficiently specified, the public has not had all the consideration which was bargained for; and if the consideration fail in part, it fails altogether, and renders the patent entirely void. (ii)

Thus in the case of *Morgan v. Scaward*, (x) Mr. Baron *Hudson* told the jury, that the specification described two inventions, and if either of those inventions was insufficiently specified, the patent failed. And in the case of *De Rozne v. Fairie*, (y) the Court of Exchequer made a rule absolute for a new trial on the ground that the plaintiff had not shown that the object or purpose of the invention could be effected by the means which were stated in the declaration. The patent in that case had been obtained for an invention intitled "improvements in extracting sugar or syrup from cane juice, and other substances containing sugar, and in refining sugar and syrup." The patentee's invention, as described in the specification, consisted in the use of the charcoal of bituminous schistus and animal charcoal combined, or either of them separately, to form a filter, through which syrup was to be passed for the purpose of separating the colouring matter from it. The patentee stated that the carbonization of bituminous schistus had nothing peculiar:—that it was produced in closed vessels as was done for producing animal charcoal, only that it was convenient before the carbonization to separate from the bituminous schistus the sulphurets of iron which are mixed with it. It was proved by Mr. Faraday, and other chemists, that there were many kinds of bituminous schistus known in England; that they varied very much in the quantity of the sulphuret of iron which they contained, and that they did not know any process by which the sulphuret of iron could be completely expelled. It was admitted that the presence of the sulphuret of iron was injurious, but the plaintiff did not state, in his specification, any mode by which it could be separated from the bituminous [*480] schistus. The jury having upon this state of facts found a verdict for the patentee, the Court of Exchequer set aside the verdict, and ordered a new trial, on the ground that it was the duty of the plaintiff either to have shown that bituminous schistus with the admixture of sulphate of iron, as it was known to exist in England, would answer the purpose beneficially, or that the sulphuret of iron could be removed by any process known to ordinary chemists of skill.

9. The plaintiff must also prove that the specification is intelligible to persons having a competent degree of knowledge of the subject to which the invention relates. It has already been stated, (z) that the intelligibility of the specification is a question for the determination of the jury, but the plaintiff is

(i) 2 Park. R. 249.

(ii) See the cases on this subject collected *ante*, Chap. VII. p. 162.

(x) *Vide ante*, pp. 47, 165-170.

(z) 1 Weob. R. 172.

(y) 5 Tyr. 223.

(z) *Ibid.*, p. 470.

only bound to satisfy the jury that the specification is intelligible to a person of ordinary and competent skill; (a) for, as observed by Lord *Ellenborough*, C. J., in *Harmar v. Playne*, (b) “no sort of specification would probably enable a ploughman utterly ignorant of the whole art, to make a watch.”

In the case of *Gibson v. Brand*, (c) the Lord Chief Justice *Tindal* said, in his address to the jury respecting the issue upon the sufficiency of the specification, “All that I mean to leave to you is the question of fact that is raised for your determination, namely, whether it is so worded, and such explanations are given in it, that a person of a sufficient degree of understanding on the particular subject, could carry the provisions of the specification into effect, and obtain the proposed result.”

And in the case of *Galloway v. Bleaden*, (d) the same learned Judge, after making some observations upon the specification, said to the jury, “But the main question on this point is for you, and that is, whether it is such a fair and clear statement, that a person with a competent degree of knowledge upon the subject-matter to which the patent relates, would be able to make that which the plaintiff now enjoys the exclusive privilege of.”

To prove the sufficiency of the specification in this respect, [*481] the plaintiff must call as witnesses at the trial, persons of competent skill or knowledge in the particular branch of manufacture to which the invention belongs, and who can testify that the specification conveys to their minds sufficient information to enable them to understand what the invention really is, and also how to put it in practice, or carry the object of it into complete effect. (e)

In the case of *Walton v. Potter*, (f) the Lord Chief Justice *Tindal* said, in his address to the jury, “Generally speaking, the rule which is laid down upon occasions when the sufficiency of the specification is called in question, is this,—that as these specifications are drawn by men who are more conversant with the particular article than juries, who are selected indiscriminately from the public, and certainly much more than Judges, whose knowledge is confined to one particular department; credit is given to witnesses, if they are conversant with the subject-matter of the invention, and are able to tell you, and you believe it, that they see enough on the face of the specification to enable them to make the article without difficulty.”

10. The plaintiff may also call witnesses to prove that they have been enabled to put the invention in practice merely by means of the instructions contained in the specification.

Thus, in the case of *Cornish v. Keene*, (g) the plaintiffs called workmen as witnesses, who proved that by means of the information contained in the specification, and without further instruction, they had been enabled to make the patent article. Evidence of this description seems to be by far the most conclusive, with respect to the intelligibility of the specification; for the evidence of persons who have not tested the specification by actual experiment in this way, is only matter of opinion, the value of which depends very much upon the skill of the witness, and the knowledge which he possesses of the language and terms of the particular art to which the invention relates. And there is the difficulty with respect to such evidence of opinion, that the jury has no certain means of knowing the degree of skill which a [*482] witness possesses, and upon that circumstance in a great measure

(a) See the cases on this subject, stated *ante*, Chap. VII. p. 173 to p. 176.

(b) Day. P. C. 319.

(c) 1 Web. R. 629.

(d) 1 Web. R. 224.

(e) See *Mason v. Seaward*, 1 Web. R. 110, *Ellis v. Aron*, 1 Web. R. 224.

(f) 1 Web. R. 115.

(g) *Ibid.* 502.

depends the value of his testimony on this subject. The specification must be sufficiently intelligible to persons of ordinary and competent skill, and it is not sufficient if it can only be understood by persons of great knowledge and science. The persons who are called to prove the sufficiency of a specification, are generally persons of the latter class; and they may be perfectly able to understand a specification, which would be wholly insufficient to instruct any ordinary workman of competent skill. The evidence of such witnesses, in fact, merely amounts to an opinion respecting the sufficiency of the specification as instructions to an entirely different class of persons.

11. So if there are any technical terms, or terms of art necessary to be explained, in order to enable the jury to understand the description contained in the specification, the plaintiff must give evidence to show what is the meaning of such terms. (*h*)

12. It seems, however, that the plaintiff cannot be allowed to give evidence to explain or correct any mistake or mis-statement in the specification, or to show that the error could not mislead. (*i*)

13. The plaintiff must show that the invention is capable of producing all the effects stated in the title or specification, for if it does not, the public will be misled, (*k*) and will not receive a portion of the intended consideration. Thus in the case of *Felton v. Givarts*, (*l*) it appeared that the patent had been obtained for a machine to sharpen knives and scissors, but the machine as described in the specification, although useful for sharpening knives, was inapplicable to the sharpening of scissors, and it was held that the specification was not sufficient.

14. And if the invention is described as an improvement upon an invention [*483] comprised in some prior patent, the specification of the prior patent must be put in evidence, in order to enable the jury to see what the improvements are which are comprised in the subsequent patent. (*m*)

15. In answer to a *prima facie* case made by a plaintiff, the defendant may give evidence to prove that the specification is insufficient, and that the plaintiff has therefore failed to comply with the condition upon which he obtained his patent.

16. Thus the defendant may show that the invention described in the specification is not the same as that comprised in the patent, for if so, the specification cannot be a performance of the condition contained in the patent. (*n*)

17. So also the defendant may show that the patentee has failed sufficiently to describe an essential part of his invention, for he was bound to describe every part of it according to the condition contained in the patent. (*o*)

18. The defendant may also give evidence to prove that the specification, or some essential part of it, is not sufficiently intelligible to enable a workman of ordinary and competent skill to use the invention and put it into successful practice. Evidence of the insufficiency of the specification in this respect, may either consist of the testimony of persons of competent skill, that they have read the instrument and do not understand it, or think it insufficient, or of persons of competent skill who have subjected the specification to the test of actual experiment, and following the instructions it contains, have been unable to succeed in producing the result described in the specification. (*p*)

(*h*) *Derosne v. Fzirie*, 1 Webs. R. 157, and see the case of *Neilson v. Harford*, 1 Webs. R. 331.

(*i*) See *Neilson v. Harford*, 1 Webs. R. 325; 8 M. & W. 806, S. C.

(*k*) *Bickford v. Skewes*, 1 Q. B. 938. (*l*) 3 C. & P. 611.

(*m*) *Lewis v. Davis*, 3 C. & P. 502.

(*n*) See the cases, *ante*, Chap. VII. p. 159, 160.

(*o*) *Vide ante*, Chap. VII. pp. 162, 167. (*p*) *Vide ante*, p. 481, 482.

19. The defendant may also prove that the invention will not produce all or some of the effects mentioned in the specification, (*g*) or that the specification is in some respect deficient, false, or fraudulent. Thus if he can prove that any thing necessary to enable a person to put the invention into successful practice has been omitted, or that the invention *as described* is of no use, the specification will be bad, and the defendant will be entitled to a verdict on this issue. (*r*) *So if he can show that the invention cannot be prac- [*481]
tised without some further invention or addition to the machinery or process described by the specification, or necessarily implied by the description. (*c*)

20. If the defendant can prove that there is any thing material stated in the specification, which is false, the mis-statement will avoid the patent (*d*) So if he can show that any statement in the specification is calculated to mislead or puzzle a person who might attempt to follow its directions. (*e*)

21. And if the defendant can show that the patentee has omitted or concealed any thing relating to the invention which would have been beneficial to the public, or has not described the invention according to the best of his knowledge at the time he enrolled his specification, the patent will void, and the defendant will be entitled to a verdict on this issue. (*f*)

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Under an Issue on a Plea alleging that the Patentee did not cause any sufficient Specification to be enrolled within due time.

1. This issue raises all the same questions as the last, and also this additional question, viz: whether the specification was enrolled within due time after the date of the patent.

2. The plaintiff must, therefore, under this issue, not only prove the sufficiency of his specification, (*g*) but also that it was enrolled in Chancery within the time limited by the patent. (*h*) There are three offices in Chancery in which such enrolments may be made, viz: the Enrolment Office, the Petty Bag Office, and the Rolls Chapel, and a due enrolment in any one of them will be a sufficient performance of the condition contained in the patent.

*3. The enrolment of the specification is a record of the Court of Chancery, (*i*) and if it is in the Enrolment Office, or the Petty Bag [*485] Office, it must be proved in the usual way, that is, by means of an examined copy of it. But if the enrolment be in the Rolls Chapel, which is now a branch of the public Record Office, established by the statute 1 & 2 Viet. c. 94, a copy of it, certified by the deputy keeper of the records, or one of the assistant record keepers, (*k*) and purporting to be sealed or stamped with the seal

(*g*) *Turner v. Winter*, Dav. P. C. 152.

(*r*) *Per Parke, B., Nelson v. Harford*, 1 Webs. R. 317.

(*c*) See the cases of *R. v. Arkwright*, Dav. P. C. 106; *Morgan v. Seaward*, 1 Webs. R. 170; and *Nelson v. Harford*, 1 Webs. R. 295, cited *ante*, Chap. VII. p. 576.

(*d*) *Bickford v. Skewes*, 1 Q. B. R. 938; *Lewis v. Marling*, 10 B. & C. 22, and *vide ante*, Chap. VII. p. 178.

(*e*) *Savery v. Price*, 1 Ry. & Mo. 1; *Crompton v. Riddison*, Dan. & Lloyd, 33; *Turner v. Winter*, Dav. P. C. 145, and *ante*, Chap. VII. p. 179.

(*f*) *Lambert v. Johnson*, Bull. N. P. 76; *Bovill v. Moore*, Dav. P. C. 400; *Wood v. Zimmer*, Holt, N. P. C. 50; and see *Crossley v. Beverley*, 9 B. & C. 62, and the cases cited *ante*, Chap. VII. p. 167-172.

(*g*) For proofs of the sufficiency of the specification *vide ante*, p. 475

(*h*) *Vide ante*, p. 433, respecting the Burthen of Proof.

(*i*) *Vide ante*, Chap. VIII. s. 3, p. 212.

(*k*) *Quære*, whether it is necessary to prove the signature to the certificate

of the Record Office, is by section *thirteen* of that act made evidence without further or other proof.

4. The record will itself show when the specification was enrolled. (*l*) According to the proviso in the patent, it ought to be enrolled within a certain number of months "next and immediately after the date" of the patent. In the case of *Watson v. Pears*, (*m*) Lord *Ellenborough*, C. J., held, that according to the proper construction of this proviso, the time within which the specification is to be enrolled must be computed exclusive of the day of the date of the patent. The patent in that case bore date the 10th day of May, 1808, and contained a *proviso* requiring a specification to be enrolled "within one calendar month next and immediately after the date" thereof. The specification was not enrolled until the tenth of June following. It was contended for the defendant that the patent was void, the specification not having been enrolled on or before the 9th day of June, when one calendar month from the date of the patent expired. It was also contended that the month must begin to run from the 10th of May, and included the whole of that day, and that it therefore could not extend to the tenth of June, there being a clear impossibility of two days of the same number being comprehended in one calendar month. For the plaintiff the case of *Thomas v. Popham*, (*n*) was relied on. The question arose there upon the Statute of Enrolments, 27 H. VIII. c. 16, which enacts "that the enrolment shall be made *within six months from the date of the deed*." The indenture in issue bore date the 9th October, 1557, [*486] and it was enrolled "in Chancery on the 21st of March, 1558," which was the last day of the six months, reckoning twenty-eight days to each month, and exclusive of the day of the date of the instrument, and the Court there held that the indenture was well enrolled, and that the words "next after the day of the date of the deed," excluded the day of the date. In reply, it was urged for the defence that the King's grants were liable to a different rule of construction, and that it had often been decided that where a period was to be reckoned from the date, the day of the date was inclusive. Lord *Ellenborough*, C. J., however, over-ruled the objection, and said, "It used to be held 'that from the date' includes the day, and 'from the day of the date' excludes it. But since the case of *Pugh v. The Duke of Leeds*, (*o*) these formal distinctions have been done away; and the rule of good sense has been established, that such words shall be construed according to the meaning of the parties who use them. The case cited upon the statute of enrolments, I think is expressly in point. That shows that *the day on which the patent bears date is not to be reckoned*. The month, therefore, only began on the 11th of May, and included the tenth of June, the day on which the specification was enrolled."

5. The defendant will be at liberty under this issue to give evidence of the same objections that he could prove under a plea denying the sufficiency of the specification. (*p*)

Under an Issue on the Plea of Not Guilty.

1. It has already been stated (*q*) that the only question under this issue is whether the defendant has committed the alleged grievances, or, in other words,

(*l*) See the Form of Enrolment in the Appendix, Chap. II. s. 1.

(*m*) 2 Camp. 294.

(*o*) Cowp. 714.

(*q*) *Ante*, p. 263, 278, 431.

(*n*) Dyer, 218, b., and F. Mo. 40, S. C.

(*p*) *Vide ante*, p. 483.

whether he has invaded the plaintiff's patent privilege in the manner alleged in the declaration.

2. The patent grant stated in the declaration, and the validity of it, are therefore admitted for the purposes of this issue; but as the title of the invention in the patent does not afford sufficient information upon the subject, it is necessary to put the enrolment of the specification in evidence, in [*487] order that the jury may know to what the patent privilege applies, and be enabled to judge whether any act proved to be done by the defendant amounts to a violation of the plaintiff's exclusive privilege. (r) It would not be sufficient to put the specification itself in evidence, because no one is bound to take notice of the contents of it until it is enrolled. But when it has been enrolled in pursuance of the proviso contained in the patent, the enrolment becomes a record of which every one is bound to take notice at his peril, and therefore the plaintiff is entitled to use this record in evidence to show the nature of the invention, which is comprised in the patent privilege. For this purpose the patent and the specification may be considered as one instrument, (s) and if a plaintiff should happen to set out his specification in his declaration, he would not be compelled to give any evidence of it under the plea of not guilty. In order to give the enrolment of the specification in evidence, the plaintiff must prove it by an office copy or an examined copy of the record in the usual way. (t)

3. In support of his case under this issue, the plaintiff must prove that the defendant used the art invented by the patentee, or violated his patent privilege in the manner alleged in the declaration.

4. A patent privilege may be infringed in several ways:—by making or manufacturing articles for use or sale by means of the art which has been invented by the patentee, or by using, exercising, or putting the art in practice, to the prejudice of the patentee in any other way;—by vending or selling articles made in violation of the patent privilege;—by making for use or sale, or vending articles which counterfeit, imitate, or resemble articles made in pursuance of the invention, or by counterfeiting or imitating the invention in any other way. And the breaches in the declaration must of course be framed according to the nature of the infringement complained of. (u)

It will be convenient to consider the evidence to be given under this issue, as to each class of breaches separately.



(a) *Upon a Breach alleging that the Defendant has injuriously made Articles, or used the Invention in Violation of the Patent.*

1. It seems that a bare making of articles according to the patentee's invention is sufficient evidence of an infringement, unless it [*488] be shown that the making was merely for experiment or amusement. Thus in the case of *Jones v. Pearce*, (x) Mr. Justice Patteson told the jury that the mere making by the defendant, of wheels such as invented by the plaintiff, would be a sufficient infringement of the patent, unless he merely made them for his own amusement or models.

(r) See *Hill v. Thompson*, 8 Taunt. 382; 2 B. Mo. 433; *Morgan v. Seaward*, 1 Webs. R. 178, 182; *Walton v. Potter*, 1 Webs. R. 587.

(s) See *Hornblower v. Boulton*, Dav. P. C. 229, 235; the judgment of Bayley, J., in *Crossley v. Beverley*, 9 B. & C. 62.

(t) *Vide ante*, p. 485.

(u) *Vide ante*, Chap. X. s. 2, p. 258; and the Forms of Declarations, in the Appendix, Chap. II. s. 4.

(x) 1 Webs. R. 125.

2. So, if it be proved that the patent art has been used, exercised, or put in practice by the defendant in any other way, that will be sufficient evidence of an infringement unless it appears that the use was such as could not injure the plaintiff.

3. And any of these acts being clearly within the meaning of the prohibition contained in the patent, they must, *prima facie*, be deemed to be injurious to the plaintiff; and, therefore, when proved in evidence, they will be sufficient to make out the plaintiff's case, unless the defendant proves that they were innocent acts which could not prejudice the plaintiff in any way whatsoever.

4. If the plaintiff can show that articles have been made in England according to the patentee's invention, and *in pursuance of the defendant's order*, or directions, that will be sufficient to entitle him to a verdict against the defendant upon this breach.

Thus, in the case of *Gibson v. Brand*, (y) the Lord Chief Justice *Tindal* said, in delivering his judgment, "The breach alleged in the declaration is, that the defendant infringed the patent by making, using, and putting in practice the plaintiff's invention; and the evidence is, that an order was given in England, which order was executed in England, for making articles by the same mode for which the plaintiffs had obtained their patent, which articles were afterwards received by the defendant. This is quite sufficient to satisfy an allegation that he made those articles, for he that causes and procures them to be made, may be well said to have made them himself."

[*489] *5. And it seems that the act of sale of an article made according to the plaintiff's invention is not only a direct violation of the patent, (z) but is also evidence of an infringement under this breach. Thus in the case of *Gibson v. Brand*, (a) the Lord Chief Justice *Tindal*, at *Nisi Prius*, told the jury that if the defendants had themselves sold an article of exactly the same fabric, made in the same manner as that for which the patent was taken out, such sale *might be considered as a using of the invention* within the terms of the declaration. (b)

6. In order to make out his case, it is not necessary that the plaintiff should show that the defendant has used or exercised the whole of the art or invention comprised in the patent, it is sufficient if he can show that the defendant has used any part of it. Thus in the case of *Cornish v. Keene*, (c) the patent comprised an invention which was composed of three distinct parts, and the plaintiffs proved that the defendants had used so much only of the invention as related to one of the three parts, yet the evidence was held to be sufficient to entitle the plaintiff to a verdict upon this issue. (d) And even if the object of the invention is only the production of one particular kind of article, yet if the plaintiff proves that the defendant has used any essential part of the art or invention, that will be sufficient to entitle him to a verdict. Thus, in the case of *Jones v. Pearce*, (e) Mr. Justice *Patteson* told the jury that the want of two or three circumstances in the defendant's wheel which were contained in the plaintiff's specification would not prevent the plaintiff's recovering for an infringement of his patent. And in the case of *Crane v. Price*, (f) it was held by the Court of Common Pleas that as it clearly appeared on the evidence that the defendants had used the invention "either in part or in whole," the plaintiffs were entitled to a verdict on the plea of not guilty to this breach.

(y) 1 Webs. R. 631.

(z) Vide *post*, p. 491.

(a) 1 Webs. R. 630.

(b) There was no breach in the declaration in this case, alleging a sale or vending.

(c) 1 Webs. R. 501.

(d) See also *Morgan v. Scaward*, Webs. R. 170.

(e) 1 Webs. R. 124.

(f) 4 M. & G. 580.

7. It is clear, however, that the plaintiff cannot sustain this issue merely upon proof that the defendant has done something which is mentioned or described in the specification, unless it also appears that it is *actually claimed by the patentee *as part of the invention comprised in the patent.* [*490] For an art or invention may merely amount to a combination of several arts or inventions known prior to the plaintiff's patent, and a defendant will not infringe the patent merely by using one or more of these component parts, if he do not use any part of the art which is of the essence of the invention, or if he do not, in any respect, avail himself of the art invented by the plaintiff. (g)

8. The plaintiff cannot always procure direct evidence of an infringement, and is therefore obliged to have recourse to evidence of a circumstantial character. Thus, in the case of *Huddart v. Grimshaw*, (h) the plaintiff was unable to give direct proof of the mode in which the defendant had made the rope, which was alleged to be an infringement of the patent, but it was proved that the defendant carried on his business secretly, and denied the plaintiff and his witnesses access to his manufactory, and that the rope made and sold by the defendant could not be produced by any other mode known to the witnesses, except the invention of the plaintiff. Lord *Ellenborough*, C. J., held this to be sufficient *prima facie* evidence of an infringement, to call upon the defendant if he could, to show that the rope was made by some other means, and not by the use of the plaintiff's invention. (i)

9. The defendant may in his defence show, that what he has done did not amount to a user of the art comprised in the patent.

He may therefore prove that the articles which he has made are substantially different from those described in the specification, or that they were manufactured in a mode different in principle from that of the patentee. And if the defendant can show that what he has done is in principle and in substance different from the plaintiff's invention, and not in form merely, he will be entitled to a verdict. (k)

10. And it seems that if a defendant can show that the article which he has made according to the plaintiff's invention, was made for amusement merely, and not with any view to a sale or a beneficial use of it, he will not be guilty of an infringement. Thus in the case of *Jones v. Pearce*, (l) Mr. Justice *Patteson* said to the jury, that the making of the patent [*491] wheels would be an infringement, *unless the defendant merely made them for his own amusement, or as a model.* And the reason seems to be that such a making would not necessarily be injurious to the patentee.

11. But it is no answer for the defendant to show that what he has done is an improvement upon the plaintiff's invention, if the improvement is not available without a use of the plaintiff's invention. Thus in the case of *Neilson v. Harford*, (m) it appeared that the apparatus which had been made by the defendant was unquestionably a great improvement upon the plaintiff's invention, but Mr. Baron *Parke* held that it was nevertheless an infringement of the plaintiff's patent. Nor will it avail a defendant any thing in such a case, that he has himself obtained a patent for his improved invention; for the subsequent patent cannot oust the plaintiff of any part of his privilege, (n) and therefore

(g) Vide *Hill v. Thompson*, 8 Taunt. 382; 2 B. Moore, 433, S. C.

(h) Dav. P. C. 265.

(i) See also *Hall v. Jervis*, 1 Webs. R. 100.

(k) See *Morgan v. Seaward*, 1 Webs. R. 171; *Walton v. Potter*, 1 Webs. R. 585-589.

(l) 1 Webs. R. 125.

(m) *Ibid.* 310-328.

(n) See a proviso in the patent that it shall not have the effect of defeating any prior patent. Vide *ante*, Chap. IV. p. 64, 65, and Appendix, Chap. II. s. 1.

the defendant must wait until the expiration of the plaintiff's patent, before he can exercise any part of his invention, which requires the aid of the plaintiff's (o)

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(b) *Upon a Breach alleging the vending or selling of Articles made according to the Invention. (p).*

1. Proof of a sale by the defendant of an article which has been made according to the invention, is alone sufficient to entitle the plaintiff to a verdict upon this breach. For a sale must necessarily be injurious to a patentee to some extent, because it is chiefly by the profits arising from the sale of articles made in pursuance of his invention, that a patentee can obtain the reward which the law intends him to receive, as a consideration for the benefit which he has conferred upon the community by a publication of his invention.

[*492] *2. It is not necessary for the plaintiff to prove that the articles which the defendant has sold were made in breach of the patent privilege, for it will be presumed that they had been made by some person in violation of the plaintiff's rights, until the contrary appears. And the defendant cannot complain of this presumption, for he must know where he obtained the articles which he sold, and if they were made by the patentee or any of his licensees, the defendant can easily show that fact in his defence to the action.

3. Although it is usual to allege that the articles vended or sold by the defendant had been made or manufactured in violation of the plaintiff's privilege, yet a patent may be infringed by a sale of articles made according to the invention, although not made in violation of the patent. Thus, if articles precisely the same as the plaintiff's be made in a foreign country, or in any part of the United Kingdom to which the patent privilege does not extend, it is clear that the making of them could be no infringement of the patent; and if such articles are brought into this country for any other purpose than a sale or user of them, as for instance in order to be re-exported, it is apprehended that the importation would be no violation of the plaintiff's privilege. But if such foreign articles are actually sold in this country, then there can be no doubt that the sale of them would be an invasion of the privilege granted by the patent.

4. But in order to amount to an infringement of the patent, the articles sold by the defendant must have been articles actually produced by the exercise of the art or invention comprised in the plaintiff's patent, or in other words, the articles must be of such a description that the making of them by any other person than the patentee, or his licensees in England, would be a violation of the patent. Thus if the patentee has invented an improved lace machine, and obtained a patent for it, the sale of a machine made according to the patentee's invention would be an infringement; but the sale of *lace*, or any other article made by means of the patent machine, would be no infringement of the patent, for the patentee's invention is the art of making the improved lace machine, and that art is not used within the meaning of the patent by a person who merely uses the machine to produce a piece of lace.

[*493] *5. In answer to a plaintiff's *prir i facie* case, the defendant may show that the articles which he sold were manufactured either by the patentee himself, or by some other person with his license, and had been sold either to the defendant or to some other person. For when a paten-

(o) Vide *ex parte Fox*, 1 V. and B. 67; *Harmar v. Playne*, 11 East, 101; 14 Ves. 130; *Crane v. Price*, 4 M. & G. 580.

(p) See the *Forms of Breaches*, in the Appendix, Chap. II. s. 4.

tee, or any other person by his authority, makes an article according to the invention, and sells it to the public, it must be understood that the purchaser acquires an absolute dominion over it, with a right to sell it or dispose of it in any manner he pleases. Indeed, when an article has once been sold by the patentee, or his licensee, the object of the law has been attained; the patentee has obtained (or had the means of obtaining) the profit which it was intended he should receive, and any subsequent sale of the article is not within the meaning of the prohibition contained in the patent.

(c) *Upon a Breach which alleges the making for use or sale, or the vending of Articles, which counterfeit, imitate, or resemble Articles made in pursuance of the Invention; or the counterfeiting, imitating, or resembling the Invention in any other way.*

1. Under an issue upon a breach of this description, the plaintiff must prove that the articles which the defendant has made or sold, are substantially the same as those produced by the invention comprised in the patent, or that the art or invention which the defendant has used or exercised for his own profit or benefit, is in substance the same as the plaintiff's.

2. In order to see whether an act which has been done by the defendant was an infringement of the patent, it is most important to attend to what is usually called the principle of the invention. The word principle, when thus used, is not however intended to signify any of those first principles, or laws of nature, which all inventors must call into requisition, more or less, and which cannot be made the subject of a patent. By principle, in this sense, is meant a practical application of some one or more of these first principles, which is properly denominated an art, by means of which articles of commerce *may be manufactured, and an art of this description is that [*494] which must necessarily be the subject of every valid patent privilege. (g) Thus in the case of *Watt's* steam-engine, Mr. Watt had invented the art of making a steam-engine with a condenser separate from the cylinder, and in common parlance, it is said that the principle of that invention is the construction of a steam-engine so that the steam shall be condensed in a vessel separate from the cylinder. And whenever it can be shown that an act done by the defendant comes, in this sense of the word, within the principle of the plaintiff's invention, the act is a violation of the patent privilege, for the defendant has used the art invented by the plaintiff contrary to the prohibition in the patent. The law intends a patent to reward the patentee for his invention, by means of the profit to be derived from the exercise of the sole privilege granted by the patent; and if other parties could evade the patent privilege, by making some immaterial variation from the mode of applying the invention, or the articles to be produced by means of it, as described in the specification, the object of the patent would be entirely frustrated; for no one would pay the patentee a profit price for the patent article if he could obtain an article substantially the same at a cheaper rate.

3. The prohibitory clause contained in every patent commands all persons, except the patentee, and those he may agree with, to abstain from counterfeiting, imitating, or resembling the invention, or making any addition unto, or subtraction from, the invention, and it is conceived that this command is only an expression of what the law is on the subject of an evasion of an exclusive privilege granted to an inventor by patent. (r)

(g) *Vide ante*, Chap. V. s. 1, p. 92.

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

4. What has been said respecting the proof of infringements upon breaches of this description will be best understood by a reference to the law, which has been so clearly laid down on the subject by several eminent Judges.

5. In the case of *Hill v. Thompson*, (s) Mr. Justice *Dallas* (afterwards Lord Chief Justice) said, in delivering the judgment of the Court of Common [*495] Pleas respecting the question of *infringement in that case, "A slight departure from the specification for the purpose of evasion only, would of course be a fraud upon the patent; and, therefore, the question will be, whether the mode of working by the defendant has, or has not, been essentially or substantially different."

6. In the case of *Jones v. Pearce*, (t) it appeared that the plaintiff's invention was of a method of making wheels for carriages on the principle of suspension, and Mr. Justice *Patteson* directed the jury that if they thought that in the wheel made by the defendant the suspension principle was applied in the same way as according to the plaintiff's invention it was applied, the plaintiff would be entitled to recover.

7. In the case of *Walton v. Potter*, (u) the law on this subject was laid down by the Lord Chief Justice *Tindal*, in his address to the jury, thus, "Where a party has obtained a patent for a new invention, or a discovery he has made by his own ingenuity, it is not in the power of any other person, simply by varying in form or in immaterial circumstances the nature or subject-matter of that discovery, to obtain either a patent for it himself, or to use it without the leave of the patentee, because that would be in effect and in substance an invasion of the right; and, therefore, what you have to look at upon the present occasion, is not simply whether in form or in circumstances, that may be more or less immaterial, that which has been done by the defendant varies from the specification of the plaintiff's patent; but to see whether in reality, in substance, and in effect, the defendants have availed themselves of the plaintiff's invention, in order to make that fabric, or to make that article, which they have sold in the way of their trade; whether, in order to make that, they have availed themselves of the invention of the plaintiff."

8. In the case of *Morgan v. Seaward*, (x) Mr. Baron *Alderson* told the jury that on the subject of the infringement, the question was, "whether the defendant's machine was only colourably different, that is, whether it differed merely in the substitution of mechanical equivalents for the contrivances resorted [*496] to by the patentee," and that they were to look to *the substance of the defendant's machine, and not to the mere form, and if it was *in substance* an infringement, they ought to find it so.

9. In the case of *Russell v. Cowley*, (y) the invention consisted of a mode of making iron tubes by passing narrow strips of iron turned up at the edges through dies or conical holes in a piece of iron. The defendant made his tubes by passing similar strips of iron between two rollers, each roller having a semi-circular groove round it, so that the conjunction of the two grooves formed a round hole through which the strip of iron passed. It was proved by scientific witnesses that the defendant's mode of making tubes was similar in principle to that which had been invented by the patentee, and the plaintiff obtained a verdict on this issue. (z)

(s) 8 Taunt. 382; 2 B. Mo. 433, S. C. (t) 1 Webs. R. 121.

(u) Ibid. 586.

(x) 1 Webs. R. 171.

(y) 1 Webs. R. 459.

(z) The defendant obtained a rule nisi to set aside the verdict for the plaintiff in this case, and enter a non-suit, but it appears that all objection to the proof of infringement was abandoned, and the rule was discharged; see the case reported, 1 C. M. & R. 864.

10. In the case of *Crossley v. Beverley*, (a) tried before Lord Tenterden, C. J., it appeared that the patentee had obtained a patent for an improved gas apparatus, and the infringement complained of was a close imitation of the patent machine, the principles applied in the plaintiff's patent machine and in the defendant's being the same, and the plaintiff accordingly obtained a verdict. A motion was afterwards made in the Court of King's Bench for a new trial in this case, (b) when the Court refused to grant a rule nisi, but there was no objection taken to the sufficiency of the evidence of the infringement.

And in the subsequent case of *Jupe v. Pratt*, (c) Mr. Baron Alderson said, speaking of the case of *Crossley v. Beverley*, "There never was a more instructive case than that; I remember very well the argument put by the Lord Chief Baron who led that case for the plaintiff, and succeeded. There never were two things to the eye more different than the plaintiff's invention and what the defendant had done in contravention of his patent right. The plaintiff's invention was different in form—different in construction; it agreed with it only in one thing, and that was, by moving in the water, a certain point was made to open, either before *or after, so as to shut up another, and [*497] the gas was made to pass through this opening: passing through it, it was made to revolve; the scientific men, all of them, said, the moment a practical scientific man has got that principle in his head, he can multiply without end the forms in which that principle can be made to operate." And his Lordship then proceeded to say with reference to the case of *Jupe v. Pratt*, "The difficulty which will press on you, (the plaintiff's counsel) and to which your attention will be called in the present case, is this: you cannot take out a patent for a principle; you may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle, but invented some mode of carrying it into effect. But then you must start with having invented some mode of carrying the principle into effect; if you have done that, then you are entitled to protect yourself from all other modes of carrying the same principle into effect, that being treated by the jury as piracy of your original invention."

11. The defendant may, in answer to the plaintiff's case upon such a breach, give evidence to prove that what he has done was not an imitation of the plaintiff's invention, but was substantially different from it; (d) or that the article which he has sold was not produced by any use or application of the art which is described in the specification.

12. When a breach alleges that the defendant has done several acts in violation of the patent: as,—that he has made several articles according to the invention; or, that he has sold several of such articles, it is not necessary, in order to entitle the plaintiff to a verdict that he should prove that the defendant has committed the precise number of infringements alleged in the breach, for the allegation contained in a breach being divisible, it is sufficient if it be proved that the defendant has done any one act which amounts to a complete infringement of the patent, or any part of it.

In the case of *Gillet v. Wilby*, (e) the plaintiff's patent was for an invention of improvements in a cabriolet. The breach in the declaration alleged that the defendant used *and put in practice a cabriolet with the plaintiff's [*498] improvements, and that the cabriolet used by the defendant did imitate and resemble the plaintiff's improvements, and it was urged for the

(a) 1 Webs. R. 106.

(b) 9 B. & C. 63.

(c) 1 Webs. R. 146.

(d) See the case of *Heath v. Unwin*, in the Exchequer, not yet reported.

(e) 9 C. & P. 334.

defendant that the plaintiff must show that the defendant's cabriolet imitated and resembled all the improvements. But Mr. Justice *Coltman* held that the allegation in the breach was divisible, and that it would be sufficient if the cabriolet resembled any one of the plaintiff's improvements.

SECTION II.

Of the Evidence in Actions of scire facias to Repeal Letters Patent.

- 1.—*Of the Burthen of Proof.*
- 2.—*Of the Competency of Witnesses.*
- 3.—*Of the Evidence to be given under each of the Issues in the Action of scire facias.*

1. *Of the Burthen of Proof.*

1. In an action of *scire facias*, the burthen of proof is upon the prosecutor as to the greater number of the issues which are generally raised in such an action.

2. When the patentee is seeking to enforce his privilege against one of the public in a Court of Law, the defendant is entitled to put the plaintiff to the *primâ facie* proof of all the conditions which the law requires to render the patent available. But when one of the public puts the law in motion by *scire facias* against the patentee, the position of the parties is reversed, and the prosecutor must give *primâ facie* evidence of the grounds upon which he alleges that the patent ought to be avoided and repealed. Thus under the suggestions, that the patentee was not the true and first inventor, that the invention was not new, or not useful, the prosecutor must give *primâ facie* evidence in support of the suggestions, or the defendant will be entitled to a verdict.

3. But there are some issues on the trial of which the burthen of proof is [*499] upon the defendant, as where issue is taken upon *a suggestion alleging the falsehood of some material representation made to the Crown by the patentee in order to obtain the patent, the defendant must, by his plea, allege that the representation was true, and he must prove the affirmative of the issue, or the prosecutor will be entitled to a verdict. So if it is suggested that the patentee has not sufficiently complied with the condition which required him to enrol a specification, the burthen of proof is upon the defendant, and he must show that he has enrolled a sufficient specification as required by the patent.

4. If there is any one issue on which the burthen of proof is upon the prosecutor, his counsel has the right to begin at the trial, and this right is generally esteemed to be a great advantage. The prosecutor in this way acquiring the right to begin, it is generally deemed most convenient to go into his whole case, not only as to those issues on which the burthen of proof is upon him, but also as to the other issues.

2. *Of the Competency of Witnesses.*

If the patentee is the defendant in the action, it is clear that he is not a competent witness. But if the action be brought against the assignee of the patent,

then it seems that the patentee would be a good witness either for the Crown or the defendant. (*f*) So a licensee would be a competent witness either for the prosecutor or the defendant, subject however to any objection affecting his credit by reason of any interest he may have in the continuance of the privilege granted by the patent. (*g*) But the assignee of the patent, or of any portion of it, or a person having an exclusive license, *and on whose behalf the action was defended*, would not be a competent witness for the defendant. (*h*)

3. *Of the Evidence to be given under each of the Issues in an Action of scire facias.*

It has been shown (*i*) that the prosecutor must file a *notice of [*500] his objections with the declaration in the Petty Bag Office. A copy of this notice must be annexed to the *nisi prius* record, and for the purposes of *the trial* must be considered as part of the pleadings. The only question however which can arise at the trial respecting the notice, is, whether the terms of it are sufficient to include any objection which the prosecutor may take, under any of the issues, to the validity of the letters patent. (*k*)

2. With the exception of the difference caused by the burthen of proof being thrown upon the prosecutor on many of the issues, the evidence will be substantially the same upon any issue in this action, as upon a similar issue in an action for an infringement of the patent.

3. Thus under an issue upon a suggestion that the patentee was not the true and first inventor, the prosecutor must prove the affirmative of the suggestion in the same way as a defendant in an action for an infringement must give evidence in support of a plea containing a similar allegation. (*l*) And the defendant in *scire facias* may answer the prosecutor's *prima facie* case by the same evidence as he might give as plaintiff upon a similar issue in an action for an infringement of the patent. (*m*)

4. If the patent was obtained for an imported invention upon a representation that the patentee had obtained a knowledge of the invention from a foreigner residing abroad, and issue be taken upon a suggestion that that representation was false, (*n*) the defendant must prove the affirmative of the issue, and show that the representation was true. (*o*)

5. The same observation applies also to an issue taken upon a suggestion of the falsity of any other representation made to the Crown by the patentee; as, a suggestion that the invention was not such an improvement or not an invention of such a nature as represented by the patentee. (*p*)

6. Under an issue upon a suggestion that the invention was not of such a nature as could legally be made the subject of a patent grant, the prosecutor must give the enrolment *of the specification in evidence in order to [*501] show the nature of the invention as described by that instrument, and if it contains any terms of art which require explanation, the prosecutor must give evidence to show the signification of them. When the meaning of

(*f*) See further on the competency of a patentee as witness, *ante*, p. 435.

(*g*) See further on this subject, *ante*, p. 436.

(*h*) *Vide ante*, p. 436.

(*i*) *Ante*, Chap. X. s. 6, p. 395.

(*k*) *Neilson v. Harford*, 8 M. & W. 806; 1 Webs. R. 370, S. C.

(*l*) *Vide ante*, p. 443.

(*m*) *Vide ante*, p. 442.

(*n*) See the Form of the Suggestion in the Appendix, Chap. II. s. 7.

(*o*) See the Evidence, *ante*, p. 449.

(*p*) See the Evidence, *ante*, p. 451.

the specification has thus been ascertained, it is for the Judge to determine whether invention can legally be made the subject of a patent grant or not. (q)

7. Upon an issue respecting the want of novelty in the invention, the prosecutor must prove that the invention was not new to the public at the date of the patent. The evidence to be given upon this issue is precisely the same as that to be given upon a similar issue in an action for an infringement of the patent, (r) with this difference, that the burthen of proof is upon the prosecutor, and he must give evidence to show that the public had acquired a right to the invention before the date of the patent. (s)

8. Upon an issue respecting the want of utility in the invention, it must be proved on behalf of the Crown that the invention was of *no* utility whatsoever to the public. (t) And in answer to a *prima facie* case for the prosecution, the defendant must show that the invention was of *some* public utility, and if he can satisfy the jury that it is of *any* utility, however small, he will be entitled to a verdict. (v)

9. Upon an issue taken on a suggestion that the patentee has not performed the condition requiring a specification, the burthen of proof is upon the defendant. (w) But the prosecutor cannot make out a *prima facie* case upon any of the issues which he is bound to prove, without giving the enrolment of the specification in evidence, and that of course is sufficient proof for the defendant that a specification has in fact been enrolled. It frequently happens also that the prosecutor finds it advantageous to set out the specification in one of the suggestions in the writ of *scire facias*, so as to be able to make use of it in a Court of Error. The question upon an issue of this description, therefore, generally is, whether the specification which the patentee [*502] has enrolled is a sufficient compliance with the condition in the patent. The evidence to be given on the one side, or on the other, has already been shown in the first Section of this Chapter, to which it is therefore sufficient to refer. (u)

(q) Vide *ante*, p. 454.

(r) Vide *ante*, p. 456.

(s) Vide *ante*, p. 454.

(t) Vide *ante*, p. 455 and 454, respecting the Proof of a Specification, and the enrolment of it.

(u) Vide *ante*, p. 471.

(v) Vide *ante*, p. 455.

(w) Vide *ante*, p. 455.

*CHAPTER XII.

[*503]

OF THE PRACTICE RESPECTING LETTERS PATENT FOR INVENTIONS.

- SEC. I.—*Of the Practice respecting the obtaining of Patents, enrolling Specifications, and altering Patents and Enrolments.*
- II.—*Of the Practice respecting Disclaimers and Memorandums of Alteration.*
- III.—*Of the Practice of obtaining the Confirmation and Prolongation of Patents.*

SECTION I.

Of the Practice respecting the obtaining Patents for Inventions, enrolling Specifications, and altering Patents and Enrolments.

- 1.—*Of the Practice respecting the obtaining Patents for Inventions.*
- 2.—*Of the Practice respecting the Enrolment of Specifications.*
- 3.—*Of the Practice respecting the Alteration and Amendment of Patents, Enrolments, &c.*

THE mode in which letters patent are to be obtained, is regulated partly by statute and partly by long established practice.

Patents for inventions are usually procured through the agency of a class of gentlemen who practice as “patent agents,” and inventors generally find it better to have recourse to the assistance of those gentlemen, than to attempt to obtain their patents themselves. Indeed there can be no doubt that it is really more economical for an inventor to employ a patent agent, than to act for himself. There are several gentlemen of talent and experience who devote themselves to this practice, and every person intending to *apply [*504] for a patent, will do well to retain one of them to assist him in procuring his patent.

According to the existing law, it appears that any person may act as a patent agent, and it is much to be regretted that there are no means of excluding unqualified persons from practising.

Several solicitors have recently added the soliciting of patents to their other professional avocations, and it is probable that the profession will do so much more extensively, when the practice of obtaining patents becomes better known than it is at present.

It frequently happens that several inventions relating to the same branch of manufactures are contemporaneously made by different persons, and if an inventor thinks it probable that application will be made for a patent for any invention similar to his own, it will be better, in the first instance, to communicate to his agent merely the title of his invention and no more.

It is sometimes deemed advisable for an inventor, in the first place, to enter caveats at the chambers of the Attorney and Solicitor General, against a patent being granted to any other person.

A caveat against a patent is in substance a request in writing, filed in some office, and desiring that a patent may not be granted without notice to the party who enters it.

Caveats against patents may be entered at the chambers of the Attorney and Solicitor General, at the Patent Bill Office (generally called the Patent Office,) the Signet Office, the office of the Lord Privy Seal, and at the Patent Office.

A caveat to be entered at the chambers of the Attorney or Solicitor General, is usually in the form or to the effect following, viz :

“Caveat against her Majesty’s letters patent for [*improvements in steam-engines*] being granted to any person without notice, to me the undersigned [*Andrew Pritchard, of No. 162, Fleet Street, London, Patent Agent.*] Dated this [*first*] day of [*January*] 1846.” “*A. Pritchard.*”

A caveat of this description is called a general caveat, because it is intended to apply, not merely to a specific application for a patent, but to all applications [*505] for patents *for inventions such as described in the caveat. But a caveat entered for the purpose of opposing a patent at the bill, or any later stage of the proceedings, is called a specific caveat, because it is intended to apply only to that specific application for a patent.

The object of the entering caveats at the chambers of the Attorney and Solicitor General is, that no application for a patent, either for the same or any similar invention, may be granted without notice of the application being given to the party entering the caveat, so that he may be enabled to oppose the grant of the patent if he thinks that it would be prejudicial to his own claim for a patent, or in any other way affect his interests. And in pursuance of such caveats, the parties entering them will obtain notices of all applications for patents for inventions which come within the meaning of the description contained in their caveats.

A caveat may either be entered by an inventor, or other person in his own name, or in the name of his patent agent, as may be most convenient. If entered in his own name, the clerks of the Attorney and Solicitor General will send notices of applications for patents direct to him, but if in the name of his patent agent, the notices will go to the patent agent, and he will send a similar notice to the party employing him. (x)

Caveats are not necessary in every case, but there are many cases in which inventors intending to apply for patents, ought always to enter them; as where they unavoidably run the risk of their inventions being pirated by others before they can apply for patents for them.

In the experiments which inventors must sometimes make in order to complete their inventions, they are exposed to the risk of having the fruits of their labour purloined by workmen, and others in whom they may be obliged to confide. To guard against such persons surreptitiously obtaining a patent for the stolen invention, the inventor ought to enter a caveat; but it ought always to be borne in mind that a caveat only enables the person entering it to oppose a patent being granted to any other person, it is no security against a publica- [*506] tion of a knowledge of the invention to the world by *any person in whom the inventor may confide, or who may surreptitiously obtain a knowledge of the invention. And such a publication would of course defeat any patent subsequently obtained even by the real inventor. (y)

As it is the practice to refer petitions for patents to the Attorney or Solicitor General, (to either of whom they may be taken at the will of the applicant,) an inventor must, in order to be effectually protected, enter a caveat at the chambers of each of those officers.

Although the form of caveat already given (z) is that now usually adopted, there is no particular form necessary. The chief thing to be attended to is,

(x) See the Forms in the Appendix, Chap. II. s. 1.

(y) Vide ante, Chap. V. s. 2, p. 102. (z) Ante, p. 504.

the description of the kind of invention to which the caveat is intended to apply. The party who enters a caveat is not obliged to describe an invention with much particularity, and it is unnecessary that the description should be even as precise as the title of an invention in a patent.

It is therefore the practice in preparing a caveat, to describe in very general terms the kind of invention to which the party entering it wishes it to apply, so that he may the better insure notice of an application for a patent for any invention which may *in any degree* affect him. And a party entering a caveat having thus secured notice of all applications which can affect his interests, he can in every case in which he receives notice exercise his discretion according to the title of the applicant's invention, whether a patent for such an invention is likely to be prejudicial to him, and whether he will oppose the application or not.

An inventor must however be careful to make the description inserted in his caveat sufficiently clear and distinct, to enable the Attorney or Solicitor General's clerk to understand clearly the kind of invention to which it is intended to apply. And if the description in a caveat is obscure, or not sufficiently distinct, the person entering it will run some risk of not receiving notice of some of the applications to which he intended it to apply. It will be better, therefore, in every case, rather to incur the cost of entering two or more caveats, than to run the risk of failing to obtain the notice which is desired.

*Caveats are entered not only by actual inventors, but also by [*507] many other persons who are occupied in making experiments with the view to discoveries in the useful arts, and also by many who are interested as patentees, or otherwise, in any particular branch of manufactures. Such persons always describe the inventions which are intended to be comprised in their caveats in the largest and most general terms.

The object of a patentee in entering such a caveat, is to prevent any other person from obtaining a patent for a more colourable variation of his invention. And with respect to other persons entering such caveats, their object is to prevent patents being granted for any art or manufacture already known and used by them. For although a public knowledge or use of an art or manufacture will render a subsequent patent for it void, yet persons who have acquired the right to use such an art are interested, and entitled to oppose the grant of any patent, which however illegal might bring their rights in question, and put them to the cost and trouble of establishing them against the illegal grant made to the patentee.

Such general caveats as those just mentioned are beneficial so far as they enable the parties entering them to protect their interests, by preventing any one from surreptitiously or improperly obtaining a patent to which he is not entitled.

The notices of applications for patents which are given by the Attorney and Solicitor General in pursuance of a caveat, are always sent by post to the person named in the caveat, and therefore *care ought to be taken to insert the correct address to which such notices are to be sent.*

In order to enter a caveat at the chambers of the Attorney and Solicitor General, two copies of the document must be prepared, and a copy taken to the chambers of each of those officers. The fee of five shillings must be paid with each copy of the caveat, to the clerk, who will enter it in a book kept for that purpose.

A caveat at the chambers of the Attorney or Solicitor General continues in force for one year only from the time it is entered, but it may be renewed from year to year as long as the party pleases.

Whenever a petition is referred to the Attorney or Solicitor [*508] General, the clerk of the officer to whom it is taken examines the

list of unexpired caveats, and if he finds that the general descriptions contained in any of them have reference to the invention mentioned in the petition, he sends notices to each of the parties who have entered such caveats.

The notice of an application for a patent, (*a*) which a person receives in pursuance of his caveat, states the name and address of the applicant, and the title of the invention for which the patent is sought to be obtained, and informs the person who entered the caveat that if he considers that the application will interfere with his caveat, he must return an answer within seven days from the date of the notice, otherwise the patent will be allowed to proceed.

The time allowed for returning an answer to the notice or entering an opposition, is seven days from the date of the notice, exclusive of the day of the date.

Upon receiving notice of an application for a patent, in pursuance of a caveat, the first thing to be decided is whether the title of the invention claimed by the applicant can affect the invention or interest of the person who receives the notice. If it be clear that a patent for such an invention cannot operate to his prejudice, it is unnecessary to pay any attention to the notice; but if it is apprehended that such a patent will be prejudicial to his interests, he may proceed to oppose the grant of it. (*b*)

When a person has made any discovery in the useful arts for which he desires to obtain a patent, he must, in the first place, choose a title for his invention, and it is of the utmost importance that he should make a proper selection.

The title of an invention is a short description or definition of it, which the inventor must state in his petition to the Crown for a patent, in order to convey some idea respecting the nature of the invention. The title which a patentee gives to his invention is always adopted in the patent, which shortly recites the material allegations of the petition upon which it is founded, (*c*) the title being recited in the very words used by the inventor. (*d*)

[509] The requisites of a title have already been stated, (*e*) and an inventor must bear in mind that he gives a title to his invention *at his own peril*; the privilege granted by the patent will apply to whatsoever may be comprised within the meaning of the title, and no more.

There is, sometimes, much difficulty in selecting a proper title for an invention, and many instances have occurred in which inventors have lost the benefit of their patents in consequence of having given erroneous titles to their inventions. In every case of doubt or difficulty, therefore, an inventor ought to obtain advice and assistance, in order to prevent the evil consequences which might follow if he were to select an improper title.

In choosing a title, an inventor should attend to the following general rules:—

A title ought to be sufficiently extensive in its signification to include every part of the invention for which the patent is to be obtained:—it must not be so extensive as necessarily to include any thing which the applicant has not invented. It must describe the same art or manufacture as the petitioner has invented, and not another; it must not contain any misrepresentation. (*f*) It need not be very definite, but it must give *some* idea of the nature of the invention, and as far as it goes it must be correct. (*g*) And if it be not incorrect, the generality of the description it contains will be no objection. (*h*)

(*a*) See the Form in the Appendix, Chap. II. s. 1.

(*b*) The mode of opposing is stated, *post*, in this section.

(*c*) Vide *ante*, Chap. IV. p. 40. (*d*) *Ibid.* 43.

(*e*) *Ante*, Chap. IV. p. 43–47.

(*f*) See the cases cited, *ante*, Chap. IV. p. 43–47.

(*g*) *Sturz v. De la Rue*, 5 Russ. 324. (*h*) Vide *ante*, p. 46.

It has already been shown, (*i*) that an inventor is not entitled as of right to a patent for his invention, but only by the grace and favour of the Crown, acting on behalf of the public. It has also been shown that in order to obtain a patent for an invention, the inventor must apply by petition to the Queen. (*k*)

In his petition, the inventor must insert his name and addition, and also state the circumstances on which he founds his claim to a patent privilege. If the petitioner is an actual inventor, (*l*) he states (*m*) that he has invented the art or manufacture for which he seeks to obtain a patent; that he is the [*510] true and first inventor of it, and that it is new, and has not been used in this kingdom to the best of his knowledge and belief. If the petitioner has imported a knowledge of the invention from a foreign country, he states that, in consequence of a communication from a foreigner residing abroad, he is in possession of the invention; that it is new, and has not been used in this country, to the best of his knowledge and belief.

Until recently, it was supposed that an invention would possess sufficient novelty to support a patent, if it were new in England and Wales, although known in Scotland or any other part of the United Kingdom, and therefore it has been customary in a petition for a patent merely to allege that the invention is new in England, Wales, and Berwick-upon-Tweed. But the case of *Brown v. Amundale*, (*n*) in the House of Lords, has decided that an invention must be new in every part of the United Kingdom, and therefore a petition for a patent ought now to state that the invention is new within this realm, (*o*) or within the United Kingdom.

The prayer of a petition for a patent is, that her Majesty will be pleased to grant unto the petitioner, his executors, administrators, and assigns, letters patent for the sole use of his invention within England, Wales, and Berwick-upon-Tweed, pursuant to the statute. If the inventor desires to have his patent extended to the Colonies or Channel Islands, they must be mentioned in the prayer of the petition.

If a patent grant is made to an alleged inventor when he cannot give the consideration required to support it, the patent, although void, may be used to the prejudice of her Majesty's subjects. The law therefore requires that when an inventor petitions for a patent, he must correctly inform the Crown respecting the invention which is to be made the subject of the patent privilege which he seeks to obtain. (*p*) And if any material statement he makes be false, the law as a penalty deprives him of his patent.

As it is not proper that the Queen should be advised to make any grant of privilege which cannot be supported, it is necessary that the alle- [*511] gations of the petition should be supported by some proof that the grant for which the petitioner asks is one that may be legally made.

It was formerly necessary that the allegations of a petition for a patent should be verified by the affidavit of the petitioner, sworn before a Master in Chancery, but the law in this respect was altered by the statute 5 & 6 W. IV. c. 62, s. 11, (*q*) in pursuance of which the petition is now to be verified by the solemn declaration instead of the affidavit of the petitioner.

(*i*) *Ante*, Chap. I. p. 4.

(*k*) *Ante*, Chap. IV. p. 41.

(*l*) *Vide* Chap. III. s. 2, p. 22.

(*m*) See the Forms in the Appendix, Chap. II. s. 1.

(*n*) 1 Weob. R. 433.

(*o*) The words, "this realm," in the Statute of Monopolies, 21 Jac. I. c. 3, s. 6, since the Union extends to the whole of the United Kingdom.

(*p*) *Vide ante*, p. 41.

(*q*) See the material parts of the statute stated in the Appendix, Chap. I. s. 1.

The solemn declaration which the petitioner makes, in support of his petition, must contain precisely the same allegations as those which are contained in the petition. And if it is the petitioner's intention also to apply for Scotch and Irish patents, that fact ought to be stated in the declaration, in order to enable the petitioner to obtain *six* months instead of *four* months, to specify his invention.

The declaration, if made in town, must be made before a Master in Chancery, but if made in the country, before a Master extraordinary.

The petition for a patent, and the declaration in support of it, are to be taken to the office of the Secretary of State for the Home Department, (r) and left there for her Majesty's answer to the petition. It is the practice for the Secretary of State to answer the petition on behalf of the Crown, by referring it to the Attorney or Solicitor General to consider and report thereon, in order that the Crown may be advised respecting the legality of the grant which the petitioner seeks to obtain, and the expediency of granting the prayer of the petition, after which it is stated in the reference that her Majesty's further pleasure will be declared.

The reference of the petition to the law officers of the Crown is always written under or endorsed upon the petition itself, and is to be signed by the Secretary of State. (s) According to the usual course of business, this is generally done within *three* or *four* days after the petition and declaration have been left at the Secretary of State's Office. As the reference is always made [512] in the same form, it is usual to take the petition to the Home Office with the reference written under it ready for the Secretary of State's signature.

The petitioner or his agent must apply at the Secretary of State's Office for the answer to the petition, and so soon as it is ready, the petition, with the answer signed by the Secretary of State, and the declaration, will be delivered to the applicant, and they must then be taken to the chambers either of the Attorney or Solicitor General, at the election of the party.

Upon a petition being left at the chambers of the Attorney or Solicitor General, his clerk will compare the title of the invention inserted in the petition with the descriptions which are contained in all the subsisting caveats in his office. If he thinks that none of the caveats apply to the invention, the patent will be allowed to proceed as of course; but if he is of opinion that the title relates to an invention which comes within the general description contained in any of the caveats, he sends notice (by post) of the application to each party who has entered such a caveat. (t)

The parties to whom notice has been sent, in pursuance of their caveats, have allowed them *seven* days after the date of the notice (exclusive of the day of the date,) within which they must enter their opposition at the chambers of the Attorney or Solicitor General, if they intend to oppose the patent. If no opposition is entered within the seven days, the proceedings for obtaining the patent will then be permitted to proceed, as of course.

Every person who has entered a caveat is at liberty to oppose the grant of a patent before the Attorney or Solicitor General. For all persons are interested in such a grant which is really made on behalf of the public, and therefore any one of the public is at liberty, upon entering a caveat and opposition, to go before the Attorney or Solicitor General to show that the petitioner has no

(r) Whitehall, Westminster.

(s) The fee payable at the Home Office for the reference is £2 2s. 6d.

(t) The contents of the Notice are stated, *ante*, p. 508, and see the Form in the Appendix, Chap. II. s. 1.

claim to a patent, or that the grant cannot legally be made. And a caveat may be entered in order to oppose a patent at any time before the report is actually signed.

In order to oppose a patent, it was formerly necessary merely to give notice of the opposition, or enter the opposition *at the chambers of the Attorney or Solicitor General, to whom the petition for the patent [513] had been referred. But oppositions were frequently entered solely for the purpose of delaying a petitioner, and in order to check that practice, it has been made a rule that every person who opposes a patent must deposit the fees payable for the hearing of his opposition, and the amount (3*l.* 5*s.*) must be paid to the Attorney or Solicitor General's clerk before the opposition can be entered.

The usual and most convenient mode of entering an opposition, is to prepare a note of the opposition, stating the name and address of the opposing party, and that he will oppose the grant of the patent to the person applying, (*u*) and then take it to the Attorney or Solicitor General's chambers, and pay the 3*l.* 5*s.* for the hearing of the opposition, to the clerk, who will file the note and enter the opposition.

When any person has duly entered an opposition at the chambers of the Attorney or Solicitor General, and made the required deposit, the further progress of the proceedings for obtaining the patent will be arrested until the hearing before the Attorney or Solicitor General, which then becomes necessary.

In order to dispose of an opposition, the applicant for the patent must obtain an appointment for a hearing, (*v*) and a summons to be served upon the party opposing the patent to attend on the day appointed. The summons (*w*) must be served upon the opposing party seven clear days before the day appointed for the hearing, but sending the summons by post, addressed to the opposing party by the address contained in his caveat, will be deemed sufficient service.

At the time appointed for the hearing, the applicant must attend at the chambers of the Attorney or Solicitor General, with whom the petition has been lodged, and if no one appears to oppose, a report will be made in favour of the applicant as of course. (*x*)

It frequently happens that the Attorney or Solicitor General is [514] prevented by his other engagements from attending at his chambers at the time appointed, and in such cases the hearing will be postponed, from time to time, by the clerk until the matters of the petition and opposition can be heard; and an opposing party must attend the further appointments, from time to time made for that purpose without any fresh summons.

If the opposing party attends at the time ultimately appointed for the hearing, the applicant is first heard in support of his petition for the patent, and then his opponent is heard to state his objections to the grant of the patent.

It is the practice to hear each of the parties separately, in private, the object of which is, that no party may be prejudiced by what they may disclose to the officer of the Crown.

The applicant for a patent proposes to give the public the benefit of his invention in consideration of a privilege to be granted him by the patent, and he discloses his invention to the Attorney or Solicitor General, only for the

(*v*) See the Form in the Appendix, Chap. II. s. 1.

(*w*) The fees to the Attorney or Solicitor General and clerk, for a hearing, amount to 3*l.* 5*s.*, for each party.

(*x*) See the Form in the Appendix, Chap. II. s. 1; the fee for a summons is 5*s.*

(*y*) In order to entitle a petitioner to a report in his favour as of course, for default of the appearance of a party opposing: the due service of the summons, or the sending it by post to the proper address, ought to be proved by solemn declaration made in the form given by the statute 5 & 6 Will. IV. c. 62. See a Form in the Appendix, Chap. II. s. 1.

purpose of enabling him to determine whether the Crown ought on behalf of the public to accept of the offer made by the inventor. The disclosure which an inventor thus makes to the officer of the Crown, is not therefore intended to be a publication of the invention to the world, but is made upon condition that his application for a patent privilege be granted, or if refused he shall not be prejudiced by the communication. The publication of a knowledge of an invention at any time before the date of a patent obtained for it, renders the patent void, as has been shown in a former part of this work; (z) and to require an inventor to state the nature of his invention in detail before his opponents, would enable them to defeat his patent by publishing it to the world before the patent could be sealed. For the reasons which have been stated, the disclosure which the inventor makes to the officer of the Crown is always strictly in private, and must be deemed to be a confidential communication, unless and until the patent is granted.

[*515] The ground upon which an application for a patent is *generally opposed, is, that the opposing party claims to have a better right than the applicant to the invention, which he supposes to be described by the title contained in the petition.

The opposing party therefore discloses his invention to the Attorney or Solicitor General, merely for the purpose of enabling that officer to determine whether his invention, and that of the applicant for a patent, are the same, or whether a patent for the one would in any respect interfere with a patent for the other. Such a disclosure must clearly be deemed to be confidential, and therefore must be made in private.

After hearing the parties, the Attorney or Solicitor General will determine whether the Queen ought to be advised to grant the prayer of the petition. If he thinks that the petitioner's invention, and that of his opponent, are the same, he will not report in favour of the applicant to the prejudice of his opponent, and in such a case it is usual for the parties to join in obtaining the patent, or enter into some compromise. But if the Attorney or Solicitor General is of opinion that the inventions are perfectly distinct, he will report in favour of the petitioner.

There are, however, other grounds upon which an application for a patent may be opposed; as, that the invention is already publicly known in this country, that it is not such an invention as comes within the meaning of the exception contained in the sixth section of the Statute of Monopolies, (a) or that the petitioner is seeking to obtain a patent with too large a title for some improper purpose.

If it appears that the alleged invention of the petitioner is not such as can legally be made the subject of a patent privilege, no report will be made in his favour; but it rarely becomes necessary to refuse an application for a patent on that ground.

It is now a rule that in every opposed case, the applicant for a patent shall, if he succeed at the hearing, deposit in the chambers of the Attorney or Solicitor General, a description of his invention, as stated by him upon the hearing, together with such drawings (if any) as may be necessary to show the general nature of it.

[*516] *Every applicant for a patent ought, therefore, before the hearing, to prepare a proper statement, (with drawings, if necessary,) to be laid before the Attorney or Solicitor General, and to be deposited in pursuance of the rule just stated, if the opposition should fail to prevent the grant of the patent. If the statement is not sufficiently definite, the petitioner will

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

(a) 21 Jac. I c. 3.

be ordered to amend it, and the Attorney or Solicitor General's clerk will not receive any description as a compliance with the rule, unless it has been examined and approved of, and every sheet and drawing signed by the Attorney or Solicitor General himself. The statement ought to be signed by the petitioner, or if that cannot conveniently be done, then by his solicitor or agent, who attends the hearing on his behalf.

The practice of compelling an applicant for a patent to deposit a description of his invention, would be most useful if it were extended to all cases, for there can be no doubt that there are quite as many unopposed as opposed cases, in which the deposit of such descriptions would be a great protection to the public. There seems to be no reason why the inventor should not, in every case, be required to file such a description in general terms, of the nature and object of his invention, as would effectually prevent him from appropriating to himself by his specification, any thing to which his original application for a patent did not extend. The document so filed ought, of course, to be kept secret until after the patent has been sealed and the specification enrolled, after which it should be open to the inspection of the public.

When the Attorney General is of opinion that the title of the invention is incorrect, or that it is unnecessarily large, and may be used for a fraudulent purpose, he will compel the applicant to alter it in such manner as he thinks fit. If the Attorney or Solicitor General orders an alteration to be made in the title, the petition must be altered accordingly; and if the alteration is material the declaration must be altered so as to correspond with the petition, and redeclared before a Master (ordinary or extraordinary) in Chancery.

If the determination of the Attorney or Solicitor General be against the applicant, no report is drawn up, for the decision is, practically speaking, final, and therefore it would be useless *to incur the expense of preparing [*517] any report upon the matters of the petition.

When there is no opposition to an application for a patent, or if there is an opposition, and a decision is given in favour of the petitioner, a report is made to her Majesty in favour of the grant of the prayer of the petitioner. This report is prepared by the clerk of the Attorney or Solicitor General, (b) and it states (c) the reference by virtue of which it is made, the substance of the petition and declaration made in support of it, that as it is entirely at the hazard of the petitioner whether the invention is new or will have the desired success, and that, as it may be reasonable to encourage arts and inventions for the public good, it is the opinion of the Attorney (or Solicitor) General that her Majesty may, by her letters patent, grant unto the petitioner the sole use of his invention, if her Majesty shall be pleased so to do, with a proviso requiring a specification of the invention within a certain time after the date of the patent.

When the petitioner has declared that he intends to apply for patents for Ireland and Scotland, the time recommended to be allowed for specification of the invention is *six* calendar months; if for Ireland or Scotland only *four* calendar months will be recommended, and in other cases two calendar months only will be allowed for that purpose. The reason for allowing a longer time for specification when the party intends to apply for Scotch and Irish patents is, that those patents require a much longer time for their preparation than English patents; and if the English specification were to be enrolled before the sealing of the Scotch and Irish patents, those patents would be void, on the ground of the invention not being new, a knowledge of the invention having been previously given to the public by the enrolment of the specification. (d)

(b) The fee payable for the report is 4*l.* 4*s.*

(c) See the Form in the Appendix, Chap. II. s. 1.

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

Under very special circumstances, the Attorney and Solicitor General have, in some cases, recommended a longer time than six months to be allowed to the patentee. (d) But there is no recent instance of more than the usual time [*518] being granted, and it would be necessary to make out a very strong case to induce the Attorney or Solicitor General to recommend more than six months for specifying the invention.

In order to obtain more than the usual time for the enrolment of the specification, application ought to be made to the Attorney or Solicitor General before he makes his report to the Crown, to recommend a longer time to be allowed. It is entirely in the discretion of the Attorney or Solicitor General whether he will recommend any additional time for completing the specification, but his recommendation is not final, for the Lord Chancellor may refuse to seal the patent if he thinks the time allowed is too long. Thus, in the case of *ex parte Heathcoat in re Lacy*, (e) fifteen months having been allowed for enrolling the specification, Lord Eldon, L. C., refused to affix the Great Seal to the patent.

When the report has been completed and signed by the Attorney or Solicitor General, it will be delivered, together with the petition and declaration, to the petitioner or his agent, and all the three documents must be taken to the office of the Secretary of State for the Home Department, and left there in order to obtain the Queen's warrant.

It is scarcely necessary to observe, that notwithstanding a favourable report by the Attorney or Solicitor General, it is entirely discretionary with the Crown whether the desired grant shall be made or not; (f) in practice, however, a patent is rarely refused for an invention, if the officer of the Crown advises that it should be granted.

The Queen's warrant (g) is directed to the Attorney or Solicitor General, and contains her Majesty's authority to prepare a bill for the intended patent. The warrant recites the petition and the Queen's willingness to encourage all arts and inventions, which may be for the public good, and directs a bill to be prepared for her Majesty's signature to pass the Great Seal containing a grant to the petitioner of the sole use of the invention within England, Wales, and Berwick-upon-Tweed, and also, if desired, within the Channel Islands and Colonies, for the term of fourteen years, provided the petitioner, within the [*519] space of time recommended by the Attorney General, cause a particular description of the invention to be enrolled in Chancery, and the warrant also directs the Attorney or Solicitor General to insert in the bill all such clauses, prohibitions, and provisoes as are usual and necessary.

The warrant is prepared by a clerk in the Home Office, (h) after which it is to be signed by her Majesty, and countersigned by one of the principal Secretaries of State, and it is usually signed by the Secretary for the Home Department, in whose office it is prepared.

The warrant may usually be obtained in about a week after the report has been left at the Home Office, but the completion of it may be delayed by holidays, the absence of her Majesty from town, and many other causes.

When the warrant has been completed, it will be delivered to the petitioner or his agent, upon his calling at the Home Office, and he must take it to the

(d) See Parl. Rep. Pat. pp. 6 and 26.

(e) 29 Rep. Arts, 251.

(f) Vide *ante*, Chap. I. p. 4.

(g) See the Form in the Appendix, Chap. II. s. 1.

(h) The fees payable at the Home Office for a warrant in ordinary cases amount to 7*l.* 13*s.* 6*d.*; if there be more than one patentee there will also be a further fee of 1*l.* 7*s.* 6*d.* for each additional name; and if the patent is to extend to the Colonies and Channel Islands there will be an additional fee of 1*l.* 7*s.* 6*d.* The warrant is liable to a stamp duty of 1*l.* 10*s.*; but it is not stamped until after it is signed, and the practice is for the Clerk of the Patent Bill Office to get the instrument stamped.

Patent Bill Office of the Attorney and Solicitor General, which is usually but incorrectly called the Patent Office. (*h*) The warrant will be entered by the clerk of the office or his deputy, and then delivered to the engrossing clerk to prepare the bill, after which the warrant is filed and kept in that office.

The Patent Bill Office is an office of the Attorney and Solicitor General for the preparation of bills for patents which are to pass the Great Seal. The clerks of the Patent Bill Office (*i*) are in fact the deputies of the Attorney and Solicitor General, and as their deputies, they prepare all bills for patents, which those officers are, by warrant from the Crown, directed to prepare. And upon receiving a warrant for a bill, the engrossing clerk will prepare it as of course, if no caveat has been entered against it.

The grant of a patent may now again be opposed at this stage of the proceedings, and such an opposition is usually called an opposition at the bill. Any person may oppose a patent at this stage whether he [*520] has opposed it at the previous stage or not, and for that purpose he must enter a caveat at the Patent Bill Office, which may be done at any time before the bill has received the signature of the Attorney or Solicitor General.

The object of entering a caveat is twofold: *firstly*, that the bill may not be signed without the knowledge of the party who enters it; and *secondly*, to prevent the preparation of the transcripts of the bill until the opposition is disposed of, so that the party who opposes shall not have to pay the cost of the transcripts, if it be decided that the patent cannot be granted.

The caveat (*k*) is in substance a request that a bill for a patent to the petitioner for the particular invention, may not be granted without notice to the person who enters it, and the caveat being against the grant of a specific thing to a particular person named, it is called a specific caveat.—a caveat at the previous stage (the Attorney or Solicitor General's chambers) being on the contrary a general caveat.

The caveat is to be entered with the clerk of the Patent Bill Office, or his deputy, and he will send a copy or notice of the caveat to the chambers of the Attorney and Solicitor General. (*l*)

The warrant from the Crown for the preparation of a bill for a patent, is directed to the Attorney or Solicitor General, and it is the duty of the officer to whom the warrant is delivered to see that the bill is prepared in accordance with the directions which are contained in the warrant. The Attorney or Solicitor General does not, however, in ordinary cases, personally superintend the preparing or settling of the bill for a patent, the duty being performed by the clerks of the Patent Bill Office, as his deputies. (*m*)

The bill is prepared by the engrossing clerk of the Patent Bill Office, who adheres strictly to the established form in which the [*521] Crown has been accustomed to grant the sole use of inventions, and inserts, as directed by the warrant, "all such clauses, prohibitions, and provisoes, as are

(*h*) This office (which is in Serle Street, Lincoln's Inn,) must not be confounded with the office which is properly called the Patent Office, or Letters Patent Office, (Quality Court, Chancery Lane,) in which patents are engrossed and prepared for passing the Great Seal.

(*i*) The offices are in the gift of the Attorney General for the time being.

(*k*) See the Form in the Appendix, Chap. II. s. 1.

(*l*) The fee for entering the caveat is 1*l.* 1*s.*

(*m*) The fees payable at the Patent Bill Office for the bill including stamps amount to 15*l.* 16*s.* in ordinary cases; if there are two or more inventors there is a further fee of 2*s.* 6*d.* to be paid for every additional name; and if the patent is to extend to the Channel Islands and Colonies or any of them, there will be an additional fee of 2*s.* 6*d.* The stamps amount to 6*l.*, which includes 1*l.*, 10*s.* for the stamp to be impressed upon the warrant.

usual and necessary," (*n*) varying them indeed in some particulars when, according to the circumstances of the case, the patent grant is to be made to an actual inventor, or to a person who is an importer of a foreign invention;—or where the grant is to extend only to England, Wales, and Berwick-upon-Tweed; or where it is also to extend to the Channel Islands and Colonies.

In preparing the bill, the clerk first copies the address or direction, (*o*) and then the recital from the Queen's warrant, after which follows the grant, and other clauses in the usual form, as already mentioned.

The officers of several departments of the public service sometimes require the insertion of a reservation of a right to use the invention, and in such a case the special clause or clauses to be inserted in the patent are settled by the officers of the Crown requiring the reservation, and furnished to the engrossing clerk at the Patent Office, who will submit the clause to the Attorney or Solicitor General, and if approved of by him, insert it in the patent.

When it becomes necessary to make any alteration in any part of the ordinary form of bill for a patent, the alteration must be specially approved of and ordered by the Attorney or Solicitor General before it can be made.

The bill for the intended patent (*p*) contains the whole of the instrument precisely as it is intended to be made, with the exception of the formal conclusion, instead of which the words, "In witness, &c. Witness, &c.," are written at the end of it.

The bill is always written upon parchment, (*q*) and at the foot of it is written the word "Examined," opposite to which the Attorney or Solicitor General is [*522] to sign his name, in order to *testify that the bill has been prepared under his authority, and in the form which he approves of.

Underneath the bill is also to be written a docket, or statement, certifying her Majesty of the nature, form and effect of the intended grant, that all such clauses, prohibitions, and provisoes, are inserted in the bill, as are usual and necessary in grants of the like nature, and that the bill has been prepared by warrant under her Majesty's sign manual, and countersigned by the Secretary of State. (*r*) This docket or statement is also to be signed by the Attorney or Solicitor General before the bill is taken to the Home Office.

The bill having been thus prepared at the Patent Bill Office, it will be taken by the engrossing clerk to the chambers of the Attorney or Solicitor General for his signature to the bill and to the docket, and it is immaterial which of them signs it. If the bill is not opposed, the clerk to the Attorney or Solicitor General will get the bill and docket signed by that officer, and return it to the engrossing clerk, who will take it back to the Patent Bill Office.

But when the patent is opposed at the bill, the bill, when prepared as already stated, will be marked "OPPOSED" by the engrossing clerk, and will be left at the chambers of the Attorney or Solicitor General, in order to have the opposition disposed of, and it is the practice to take it to the chambers of the officer who reported in favour of the grant of the patent. The Attorney and Solicitor General, however, frequently hear cases and sign bills for each other.

As soon as a bill against which a caveat has been entered is received from the engrossing clerk at the chambers of the Attorney or Solicitor General, his clerk sends notice to the clerk of the Patent Bill Office, who immediately sends

(*n*) As to the Form and Construction of a Patent, and its several clauses, see Chap. IV. p. 36.

(*o*) *Vide ante*, p. 40.

(*p*) See the Form in the Appendix, Chap. II. s. 1.

(*q*) A stamp duty of 1*l.* 10*s.* must be impressed upon the bill, and upon each of the transcripts prepared for the signet and privy seal.

(*r*) See the Form in the Appendix, Chapter II. s. 1.

notice, by post, to each person who has entered a caveat against the patent, informing him that the bill has been lodged for signature, and also informing him of the time within which an opposition must be entered and a deposit made.

If a person who has entered a caveat at the Patent Bill *Office [*523] intends to oppose the grant of the patent, he must enter his opposition at that office within three days after the date of the notice which he receives from that office, or the patent will be allowed to proceed. And a person entering a caveat after the warrant has been lodged, must, if he receives notice at the time of the warrant having been received, immediately enter his opposition, or the proceedings for obtaining the patent will not be stayed.

A person who has entered a caveat, may, however, enter an opposition to a patent at the Patent Bill Office, at any time before the bill has actually been signed by the Attorney or Solicitor General, but an opposition will not be entertained afterwards, although the signed bill has not been delivered to the petitioner or his agent.

A person who intends to oppose at this stage, must also, when he enters his opposition, deposit the sum of 30*l.* as a security for costs; and if he fails to do so, he cannot be heard in opposition to the grant of the patent to the petitioner, and the bill will be prepared as of course.

The reason why this deposit is required is, that if a person intends to oppose the grant of a patent for any particular invention, he ought to be sufficiently vigilant, and make his opposition in the first instance at the report, as it is called, (s) that is, when the applicant comes to the Attorney or Solicitor General for a report upon his petition. And if a person who has good ground for opposing the grant of a patent is guilty of *laches*, and by his negligence causes the applicant for a patent to incur costs which would be unnecessary if he had opposed at an earlier stage, it is but just that he should pay the unnecessary costs which he has in fact caused, if he succeeds in his opposition. And if a person opposing fails to make out a sufficient case against the applicant upon the hearing of the opposition, it is but fair that he should pay the applicant the costs of the hearing which the opposition has made necessary.

By compelling a person who seeks to oppose at this stage, first to deposit a sufficient sum as a security for costs, the Attorney or Solicitor General acquires the means of awarding *such amount of costs as he may think [*524] just, to the party whose petition is opposed.

In order to enter an opposition to a patent at the bill, the party opposing, his solicitor or agent, should prepare a note of the opposition stating the name and address of the opposing party, and that he opposes the grant of a bill for the patent. This note should be taken to the Patent Bill Office, and the required amount (30*l.*) deposited with the clerk of that office, or his deputy, as a security for costs, who will then file the note and enter the opposition of which he will send notice to the chambers of the Attorney or Solicitor General.

If the grant of a patent is opposed at this stage, and the party opposing has made the necessary deposit, and entered his opposition, the patent will not be allowed to pass until the opposition has been disposed of, and the petitioner must, in order to proceed with the patent, procure from the clerk of the Attorney or Solicitor General an appointment for a hearing before that officer, taking care that sufficient time is allowed for serving the summons upon the opposing party to attend the hearing. The Attorney or Solicitor General's clerk will prepare a summons for the opposing party to attend the hearing, and transmit it to the Patent Bill Office, where it will be delivered to the petitioner or his agent, by whom a copy of it must be served upon the opposing party.

(s) Vide *ante*, p. 512.

The summons must be served upon the opposing party, or sent to him by post, so that it may be received three clear days before the day appointed for the hearing.

The hearing at this stage is conducted in precisely the same manner as the hearing of an opposition at the report which has already been described. (*t*)

If the opposition is successful, all further proceedings for obtaining the patent will be stayed, but if not the bill will be signed and passed as of course.

If the patent is to be granted, the applicant must deposit a description of his invention if he has not previously done so upon an opposition at the report, (*u*) and if the previous description is found to be insufficient, it will be ordered to be amended.

[*525] *Although a party opposing a patent at this stage has been compelled to make a deposit as a security for costs, yet the Attorney or Solicitor General may in his discretion either give or refuse costs as he may think fit. The general rule, however, is, that when an opposition succeeds, the petitioner for the patent is allowed the amount which he has paid for the report, the Queen's warrant, the bill, the summons and hearing, and his agency fees. (*x*) And when the determination upon the hearing of an opposition is in favour of the applicant for a patent, then the opposing party must pay the petitioner's fees payable for the hearing, (*y*) as well as his own costs of the opposition.

When the opposition has been disposed of, the clerk of the Patent Bill Office will (unless otherwise directed by the Attorney or Solicitor General) pay the petitioner the amount he is entitled to under the general rule just mentioned, and, after also deducting the fees payable by the party who opposed the patent, return the residue of the 30*l.* to him.

The amount of the costs to be allowed to an applicant for a patent after disposing of an opposition at the bill, will be determined by the clerk of the Patent Bill Office, according to the result of the hearing, and the rules already mentioned, but if either party is dissatisfied with the determination of the clerk, he may appeal to the Attorney or Solicitor General before whom the matter of the opposition was heard.

The bill is now ready for delivery, and may be obtained at the office upon application by the petitioner, his solicitor or agent, by whom it must be taken to the office of the Secretary of State for the Home Department. (*z*)

The bill will then be laid before her Majesty by the Secretary of State for the sign manual, which is always affixed at the commencement of the instrument.

[*526] *The bill when thus completed by the sign manual is called "The Queen's bill," and it is returned to the Secretary of State's Office, where an entry of it will be made in a book kept for that purpose, and then the instrument will be delivered to the petitioner, his solicitor, or agent, upon application at the Home Office.

(*t*) *Ante*, p. 513, 514.

(*u*) *Vide ante*, p. 515.

(*x*) The amount allowed the petitioner in ordinary cases is 18*l.* 10*s.* 6*d.*—being 4*l.* 4*s.* for the report; 7*l.* 13*s.* 6*d.* for the warrant; 1*l.* 1*s.* for the bill; 3*l.* 10*s.* for the warrant and hearing; and 2*l.* 2*s.* for agency fees.

(*y*) The amount usually allowed is 3*l.* 10*s.* for the petitioner's hearing and summons; the opposing party must also pay 3*l.* 5*s.*, the fees for the hearing of his opposition, which will also be deducted from the 30*l.*

(*z*) The fees upon the bill at the Home Office amount to 7*l.* 13*s.* 6*d.* in ordinary cases; if the patent is to be granted to more than one person there will be a further fee of 1*l.* 7*s.* 6*d.* for each additional name; and if the patent is to extend to the Channel Islands and Colonies, or any of them, there will be an additional fee of 1*l.* 7*s.* 6*d.*

After the clerk of the Patent Bill Office has prepared the bill in the manner already described, he also prepares two transcripts of it on parchment, (a) one of which he sends to the Signet Office, and which is intended to become the signet bill, and the other he sends to the Privy Seal Office to be afterwards made the Privy Seal bill, or writ of Privy Seal.

When the Queen's bill has been obtained from the Home Office, it must be taken to the Signet Office (b) to be passed. (c) The signet is a royal seal which is always in the custody of the Secretary of State, and he has clerks under him called Clerks of the Signet, (d) to whom are assigned the office of passing the Queen's bills to the Privy Seal, (e) and which by the statute of 27 Hen. VIII. c. 11, s. 1, (f) they are directed to do within eight days after the Queen's bill is received at the Signet Office.

The Queen's bill is filed at the Signet Office as the warrant to the clerk of the signet in attendance, (g) for preparing and issuing the signet bill to the Lord Privy Seal. (h)

In order to prepare the signet bill, (i) the clerk of the signet takes the transcript of the bill prepared and transmitted to him from the Patent Bill Office, as already mentioned, *and after examining it with the Queen's bill, [*527] and thus ascertaining that the transcript is a correct copy of the bill, he writes above it a command in the Queen's name to the Lord Privy Seal, to issue the Privy Seal bill to the Lord Chancellor commanding him to make the intended patent.

Below the bill the clerk writes some words to testify that the command given is made under her Majesty's signet and the date of the bill, and then in pursuance of the statute, (k) he subscribes his name to the bill. On the outside of the bill is also written a direction to the Lord Privy Seal. (l)

A docket of the bill having been entered in the docket book of the Signet Office, stating the name of the intended patentee, and the substance of the grant, the bill is taken by one of the clerks in that office to the office of the Secretary of State for the Home Department, where it is to be sealed with the signet, and then it is to be taken back to the Signet Office.

An opposition to a patent is now never made at the signet bill, but the writer has been informed at the Signet Office that caveats were formerly entered in that office; and there can be no doubt that any person may oppose the grant of a patent at that as well as at every other stage of the proceedings for obtaining it. The opposition would however be referred by the Secretary of State to the Attorney or Solicitor General, and therefore, if the patent has been pre-

(a) Each transcript must be impressed with a stamp duty of 1*l.* 10*s.*

(b) No. 28, Abingdon street, Westminster.

(c) Stat. 27 Hen. VIII. c. 11, s. 1. See the statute in the Appendix, Chap. I. s. 1.

(d) 2 Inst. 556.

(e) See the statutes 57 Geo. III. c. 63, and 2 & 3 Will. IV. c. 49, respecting the offices of the clerks of the signet.

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

(g) There were formerly four clerks of the signet who attend in person or by deputy in rotation for three months at a time; but the office of one of them has been abolished, and there are now only three clerks, each of whom attends in person, or by deputy, for four months during the year. The business of the office is, however, chiefly transacted by the record clerk.

(h) See 8 Co. R. 18 b.

(i) The fees payable for a signet bill for a patent to be granted to one person amount to 4*l.* 7*s.*; if to more than one person 5*l.* 18*s.* 6*d.* extra is payable for every additional name, and if the patent is to extend to the Colonies and Channel Islands, the additional fees amount to 13*s.* 6*d.* The expedition fee is 1*l.* 11*s.* 6*d.* for which the signet bill may be passed the same day the Queen's bill is taken to the office.

(k) 27 Hen. VIII. c. 11, s. 1. Appendix, Chap. I. s. 1.

(l) See the Form of the Bill in the Appendix, Chap. II. s. 1.

viously opposed, the opposition at this stage would only produce a rehearing before the same officer. And as a party would gain no advantage by such a rehearing, or by an opposition at the signet bill instead of any preceding stage, oppositions at this stage have fallen into disuse.

When the signet bill has been completed in the manner already described, it is to be taken to the Privy Seal Office, in order to procure the Privy Seal bill or writ of Privy Seal, and as the Signet Office and the Privy Seal Office are at present both in the same building, (*l*) it is usual for a clerk in the Signet Office to take the signet bill to the Privy Seal Office, when it has been completed.

[*528] The signet bill being received in the Privy Seal Office, the clerk of the Privy Seal is, in pursuance of the statute 27 Hen. VIII. c. 11, s. 2, to prepare the Privy Seal bill within eight days afterwards, unless he is otherwise commanded by the Lord Privy Seal. (*m*)

The grant of a patent may again be opposed when the bill comes to the Lord Privy Seal. (*n*) For although the signet bill commands the Lord Privy Seal to issue her Majesty's warrant or writ to the Lord Chancellor to make the letters patent, yet the command is to be understood as a qualified command; that is, that his Lordship is to issue the warrant or writ if it be legal or just so to do.

In order to oppose the proceedings for a patent before the Lord Privy Seal, the party opposing it must enter a caveat (*o*) and opposition at the Privy Seal Office, in the same manner as at the Patent Bill Office. (*p*)

An opposition at this stage has sometimes been heard before the Lord Privy Seal himself, and at other times he has referred the matter to a committee, or officer, to consider and report to his Lordship. (*q*)

The Privy Seal is now seldom delivered to a lawyer, and therefore oppositions to patents at this stage have become of very rare occurrence; but the power remains, and if the Lord Privy Seal were a lawyer, it is probable that oppositions would frequently be made before him instead of the Lord Chancellor, as being less expensive and likely to be more expeditiously disposed of.

In the absence of any caveat, or opposition, the clerk of the Privy Seal, in order to prepare the writ of Privy Seal, or Privy Seal bill, having examined the transcript of the bill sent from the Patent Bill Office and compared it with the signet bill, writes above the former her Majesty's command to the Lord Chancellor, that under the Great Seal in his custody, he cause her Majesty's letters to be made patent in the form which follows. (*r*) And underneath the bill he writes, "Given under our Privy Seal at our Palace at Westminster," and also the date when the Privy Seal is affixed to the instrument. (*r*)

[*529] To the Privy Seal bill thus prepared, the clerk of the Privy Seal subscribes his name in pursuance of the statute 27 Hen. VIII. c. 11, s. 2, and an entry or docket of it is then to be made in the docket book of the office, stating the name of the grantor, the substance of the grant, and the date of the Privy Seal bill.

Documents to be sealed with the Privy Seal, which are addressed to particular officers or persons, are always folded, so that when sealed the contents may be completely concealed. (*s*) The Privy Seal bill is therefore folded in

(*l*) No. 28, Abingdon street, Westminster.

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

(*n*) *Ex parte* Daly, Vern. & Scriv. 492.

(*o*) See the Form in the Appendix, Chap. II. s. 1.

(*p*) *Vide ante*, p. 524.

(*q*) *Ex parte* Daly, Vern. & Scriv. 522.

(*r*) See the Form in the Appendix, Chap. II. s. 1.

(*s*) Grants which pass under the Privy Seal only, are called letters of Privy Seal, and are not folded as mentioned above, but are left open like a patent.

this manner by the clerk, with a label attached to it and exposed to view, directed to the Lord Chancellor, to whom the bill or writ is to be delivered.

There is a public seal day on Friday in every week, at which Privy Seal bills may be sealed, but a bill may be sealed at a Private Seal, on any other day on payment of an additional fee. (*s*)

In order to procure a Privy Seal bill to be sealed on the public seal day, the signet bill must be taken into the Privy Seal Office on the day before the seal day; but a Privy Seal bill will be prepared and sealed the same day that the signet bill is delivered at the Privy Seal Office, upon payment of an expedition fee. (*t*)

The Privy Seal being in the custody of the Lord Keeper of it, all bills and other instruments which are to be sealed with the seal, must be taken to his Lordship, and when he is out of town, the instruments are forwarded to him by post to be sealed by one of his officers.

The Privy Seal bill having been sealed is taken back to the Privy Seal Office, where the signet bill is filed, as the Lord Privy Seal's warrant for what he has done in pursuance of it. (*u*)

When the Privy Seal bill, or writ of Privy Seal, has thus been completed, it will be delivered to the petitioner, his solicitor, or agent, upon application at the Privy Seal Office,—to be taken into Chancery. (*v*)

The Privy Seal bill is to be taken to the Patent or Letters Patent Office, (*t*) and left with the clerk of that office, or his [*530] deputy, by whom the letters patent are to be prepared, and he will take off the Privy Seal (which he must do to open the instrument) and endorse upon it the day of the month when he receives it.

After the delivery of the Privy Seal bill to the clerk of the patents, the whole of the proceedings for obtaining a patent take place on the Common Law side of the Court of Chancery, (*u*) of which the Lord Chancellor is sole Judge. (*x*) And there are several officers of this Common Law side of the Court whose duty it is to prepare, seal, and enrol letters patent and other instruments which pass the Great Seal; as, the clerk of the patents, (*y*) the sealer or sigillator, (*z*) the chafe-wax, (*a*) and the clerk of the enrolments, (*b*)

It is the delivery of the Great Seal which constitutes the Lord Chancellor sole Judge of the Court of Chancery, and the making of a patent by affixing the Great Seal, is a judicial act by which the Lord Chancellor, as Judge of the Queen's Court of Chancery, makes a record of the Queen's grant in pursuance of her command. (*c*)

The grant of a patent may be again opposed when the petitioner comes to the Lord Chancellor to have it made under the Great Seal, in pursuance of the writ of Privy Seal,—for, as it has already been shown, (*d*) the command contained in the writ of Privy Seal must be understood as being conditional, and that the Lord Chancellor is only to make the patent if he shall be of opinion that the proposed grant will not be illegal or unjust.

(*v*) Vide 2 Inst. 556; 8 Co. R. 19, b. (*t*) *Id.*

(*u*) *Id.* 11a. 6d.

(*z*) The fees payable at the Privy Seal Office upon a patent to a single person for England and Wales amount to 4*l.* 2*s.*; if to more than one person 5*l.* 1*s.* 6*d.* extra is payable for each additional name, and a further fee of 13*s.* 6*d.* is to be paid if the patent is to extend to the Colonies and Channel Islands, or any of them.

(*t*) In Quality Court, Chancery Lane. (*u*) See 1 Shep. Abr. tit. Court, p. 464.

(*x*) 4 Inst. 80, 84.

(*y*) 1 Shep. Abr. tit. Court, pl. 14, p. 467; 4 Inst. 82.

(*z*) 2 Inst. 554; 4 Inst. 82; 1 Shep. Abr. p. 467.

(*a*) 4 Inst. 82; 1 Shep. Abr. p. 467.

(*b*) 1 Shep. Abr. p. 467.

(*c*) Vide *ante*, Chap. IV. p. 37.

(*d*) *Ante*, Chap. IV. p. 38.

When a person intends to oppose a patent at the Great Seal, he must enter a caveat (c) at the Patent Office, against affixing the Great Seal to the patent. (f) If such a caveat be entered before the Privy Seal bill comes into the Patent Office, the person who enters the caveat will be entitled to *receive [*531] notice by post from the Patent Office of the Privy Seal bill having been lodged at that office.

A caveat may however be entered at the Patent Office against a patent, at any time before the Great Seal has actually been affixed to the patent, and if it be entered after the Privy Seal bill has come into the office, notice of that fact will be given to the person who enters the caveat at the time of entering it.

The caveat which is thus to be entered at the Patent Office, is a specific caveat against a particular grant; and although it was formerly the practice to receive and enter general caveats at that office, in precisely the same way that such caveats are now entered at the chambers of the Attorney and Solicitor General, that practice was abolished by order of Lord *Brougham*, L. C., and no general caveat can now be entered at the Patent Office against a patent for an invention.

A caveat has the effect of staying all proceedings respecting the patent during the three days allowed to the party for entering an opposition.

When notice is sent to a person who has entered a caveat, he is (in effect) allowed three days to determine whether he will oppose the patent or not, and if he intends to oppose the preparation and sealing of the patent in pursuance of the Privy Seal bill, he must enter an opposition on or before the expiration of the third day after the date of the notice, or the patent will be allowed to pass as of course. But when a person who enters a caveat, receives notice at the time of entering it, that the Privy Seal bill has already been lodged at the Patent Office, he must then enter an opposition, or the patent will be passed as of course.

An opposition to a patent may, however, be entered at any time before the patent has actually been sealed with the Great Seal.

The opposition to a patent at this stage must be entered at the Patent Office with the clerk of the patents, and it will have the effect of preventing any proceedings from being taken upon the Privy Seal bill, if none have been taken at the time it is entered; or if the opposition is not entered until after the preparation of the patent has been commenced, the entry will have [*532] the effect of staying all further proceedings, until the opposition is disposed of and the Lord Chancellor orders the patent to be prepared and sealed.

In order to discharge the caveat and remove the stop (as it is called) to the preparation and sealing of the patent, the applicant for the patent must prepare a petition stating all the facts and proceedings, and praying that letters patent may be made and sealed in pursuance of the writ of Privy Seal. The facts to be stated in the petition respecting the invention, will be the same as those stated in the petition to the Crown, and it must also be shown, that the petitioner applied by petition to the Queen, that all the necessary proceedings have been taken, that the writ of Privy Seal has been lodged at the Patent Office, and that the preparation or sealing of the patent has been prevented, by a caveat and opposition entered at the same office.

The material allegations of this petition must be supported by affidavit, to be sworn before a Master (ordinary or extraordinary) in Chancery. (g)

(c) See the Form in the Appendix, Chap. II. s. 1.

(f) The fee for entering a caveat is 10*s*.

(g) An affidavit to be used on the Common Law side of the Court of Chancery, ought not to be sworn before the clerk of the Affidavit Office, for he is an officer of the Equity side of the Court only.

The petition together with the affidavits, must be lodged at the Patent Office, and the clerk of the patents will procure the petition to be answered by the Lord Chancellor, (*h*) directing it to be put in the paper for the next petition day, and the petitioner or his solicitor must immediately afterwards serve his opponent with a copy of the petition and answer.

If the party opposing wishes to bring any additional facts before the Lord Chancellor, he must do so by affidavit, sworn before a Master in Chancery, and filed at the Patent Office.

Each party may obtain office copies of his opponent's affidavits, or any other documents filed at the Patent Office, in the ordinary way. (*i*)

Parties soliciting an opposed patent at this stage, and the party opposing must conduct their proceedings in person, or employ a solicitor of the Court, for patent agents who are not solicitors cannot legally conduct any proceeding in Chancery.

It is usual to apply to the Lord Chancellor to have the petition advanced, and to have a day appointed for hearing the matters [*533] of the petition and opposition, and his Lordship will generally appoint an early day for that purpose.

The hearing sometimes takes place in the Lord Chancellor's private room, and his Lordship will, *if necessary*, hear each party separately and in private. (*h*) In one case, (*i*) there was a hearing in public; his Lordship then saw the parties and their models, and afterwards gave his judgment in open Court.

But the parties will be heard in the presence of each other, or in public, if such a hearing will not prejudice either of them. Thus, in *Cutler's case*, (*k*) the opposing party did not intend to obtain a patent for his invention, and he was therefore desirous that each party should be heard in the presence of the other, in order that he (the opposing party) might have the advantage of knowing what the petitioner's invention was, and judging whether it was such an invention as might be legally made the subject of a patent privilege. And as the petitioner had of course previously delivered the Privy Seal bill into Chancery, the Lord Chancellor was able to make a patent bearing date prior to the day of the hearing, and therefore the petitioner could not be materially prejudiced if his application for a patent was granted. For these reasons, each party was heard in the presence of the other, upon the reference by the Lord Chancellor to the Attorney General, and afterwards before the Lord Chancellor himself.

The Lord Chancellor will generally refer the matters of the petition and opposition to the Attorney or Solicitor General to report specially to his Lordship respecting the facts, and the propriety of granting the prayer of the petition. (*l*) and direct the petition to stand over until after the report has been made.

Upon such a reference the Attorney or Solicitor General must have copies of the petition and affidavits laid before him, and he will appoint a day for hearing the parties, when he will hear the parties and their counsel separately, or in the presence of each other, according to the [*534] circumstances of the case.

If the parties are satisfied with the Attorney or Solicitor General's report, the Lord Chancellor will, as of course, make an order in accordance with the recommendation contained in the report.

(*h*) The fees for this amount to 13s. 6d. being the same as upon Chancery petitions.

(*i*) The cost of office copies is the same as for other office copies in Chancery, which at present is four pence for every Chancery folio of ninety words.

(*h*) See the reasons given, *ante*, p. 514, for a hearing in private before the Attorney or Solicitor General.

(*i*) *Ex parte Fox*, 1 V. & B. 67.

(*k*) 1 Webs. R. 418.

(*l*) *Ex parte Hensen, in re Alcock*, 1 Webs. R. 432; *in re Cutler*, 1 Webs. R. 418.

But if either party is dissatisfied with the Attorney or Solicitor General's decision, he must prepare a petition to the Lord Chancellor, stating his exceptions to the report, and lodge it at the Patent Office to be answered and put in the paper in the manner already mentioned, and upon application to the Lord Chancellor, his Lordship will appoint a day when he will hear the parties and their counsel, and dispose of the petitions as he may think just.

In *Cutler's case* (m) there had been no opposition at any prior stage of the proceedings, and upon a petition to discharge a caveat at the Patent Office, and to seal the patent, Lord *Cottenham*, L. C., ordered the matters of the petition to be referred to the Attorney General to inquire and report to the Lord Chancellor whether the patent ought to issue, that all parties should be restrained from doing any act respecting the invention until after the report, and that if the Attorney General should report that the patent ought to issue, it should be sealed as of the 12th March, being the day the patent would have been sealed if there had been no caveat. The Attorney General reported to the Lord Chancellor that he was of opinion that the patent ought not to issue, and the petitioner being dissatisfied with the Attorney General's determination, presented another petition to the Lord Chancellor to seal the patent, stating the grounds upon which he excepted to the Attorney General's report, and the petition was also supported by further affidavits. This petition was heard before the Lord *Cottenham*, L. C., and his Lordship ordered the patent to be sealed as prayed.

In two recent cases, *in re Samuda*, and *in re Griffiths*, each party was applying for a patent for an invention which had previously been made the [*535] subject of a *specified* patent granted to Mr. Samuda for Scotland, (n) and each party had gone through all the preliminary proceedings for obtaining a patent without opposition, but when they came to the Patent Office, each party was opposed by a caveat entered by the other. Each party then petitioned the Lord Chancellor to seal his patent, and his Lordship referred both petitions to the Solicitor General to inquire and report whether the patents, or either of them, ought to issue. The Solicitor General, after hearing counsel for each of the parties, reported that the invention had already been published in the United Kingdom, (in Scotland,) and therefore, according to the decision in *Brown v. Annandale*, (o) it could not legally be made the subject of a patent, and that no patent ought to be granted to either of the petitioners. The petitioner *Griffiths* being dissatisfied with the Solicitor General's report presented a second petition stating his exceptions to the report, and praying that his patent might be sealed. The matters of these petitions were heard before Lord *Lyndhurst*, L. C., when his Lordship held, that the invention having been published in another part of the realm, it could not be made the subject of a patent privilege in England, and that neither of the patents could be sealed.

In *ex parte Dyer*, (p) it appeared that a person had applied for a patent, and another person had subsequently applied for a patent for the same object. In consequence, however, of the progress of the first application having been delayed, the second applicant was in advance of the other, and in a position to seal his patent first, and Lord *Eldon*, L. C., held, that in concurrent applications for a patent, for the same object, that which obtains the Great Seal first, will have the sole right at law, and his Lordship said, "I can see no other

(m) 1 Webs. R. 418.

(n) See *Brown v. Annandale*, 1 Webs. R. 432.

(o) 1 Webs. R. 433.

(p) Parl. Rep. on Pat. 1829, p. 197, and *Holroyd on Pat.* 59, S. C.

mode of deciding, than by awarding the patent to him who runs the quickest through the process."

The Lord Chancellor has jurisdiction (as Judge of the Court of Chancery) to give costs to parties who appear before him upon petitions to seal patents.

In the case of *ex parte Fox*, (q) Lord Eldon, L. C., refused [*536] to give the petitioner his costs, on the ground that his Lordship did not think that the opposition was unreasonable. But in *re Alcock*, (r) Lord Brougham, L. C., granted the petitioner his costs, and Lord Cottenham, L. C., ordered the opposing party to pay the petitioner's costs in *Cutler's* case. (s) So also in *Nickel's* case, (t) Lord Cottenham, L. C., ordered a party petitioning to have an altered patent resealed, to pay the costs of a party who had entered a caveat, and successfully opposed the petition.

In *Cutler's* case, (u) the costs of Cutler, the petitioner, were taxed in the ordinary manner as between party and party, and the petitioner being dissatisfied with the taxation, presented a petition to the Lord Chancellor, stating that by the taxation, the travelling expenses of the petitioner and his solicitor, incurred in procuring evidence, certain fees to counsel, scientific men, &c., &c. were disallowed, and praying that it might be referred back to the Master to review his taxation, and to allow the petitioner all costs, charges, and expenses reasonably incurred in consequence of the opposition to the patent. The petition was heard before Lord Cottenham, L. C., who dismissed it with costs.

If the Lord Chancellor decides that a patent ought not to be sealed in pursuance of the Privy Seal bill, it is unnecessary to draw up any order unless the petitioner is directed to pay the opposing party his costs. But the clerk of the patents records the Lord Chancellor's judgment by an indorsement on the Privy Seal bill, which is filed of record in the Patent Office.

When the Lord Chancellor grants the prayer of a petition to have a patent sealed, or refuses it, and orders the petitioner to pay his opponent's costs, an order must be drawn up for giving effect to the Lord Chancellor's judgment. The order will be drawn up by the clerk of the patents, who will also procure the Lord Chancellor's signature to it. (v) The order is filed in the Patent Office.

If no caveat or opposition has been entered at the Patent Office [*537] against the sealing of a patent, it will be prepared and sealed, as of course, in pursuance of the Privy Seal bill, or writ of Privy Seal. If the patent has been opposed, and the Lord Chancellor upon petition has decided that the patent must be granted, it will be prepared and sealed as soon as his Lordship's order for that purpose has been drawn up and signed.

When the patent is to be prepared, the clerk of the patents in the first place writes the *recepti* in the margin of the Privy Seal bill, stating the day when the Lord Chancellor received the bill, being the same day that the patent is to bear date. The *recepti* is to be signed by the Lord Chancellor, and it is usually in the following form:

"Received the [eighteenth] day of [September,] 1845."

(Signed)

"LYNDHURST, C."

(q) 1 V. & B. 67.

(r) Cit. 4 My. & Cr. 511, and Webs. on Pat. p. 134 (101).

(s) 1 Webs. R. 418.

(t) Turn. & Phil. 36; 1 Webs. R. 656; but not reported in the point above stated, vide ante, p. 218.

(u) 4 M. & Cr. 510.

(v) The cost of the order varies according to the length of it.

This is done in pursuance of the stat. 18 Hen. VI. c. 1, (x) which requires the date of the delivery of the bill to the Lord Chancellor to be entered of record in Chancery, and prohibits a patent being made in pursuance of the bill bearing date on any prior day.

The delivery of a Privy Seal bill to the clerk of the patents, who is the officer of the Lord Chancellor, is in effect a delivery of it to the Lord Chancellor himself, and therefore his Lordship may direct the date of the delivery to be recorded in the *recepti* as of any day after the Privy Seal bill is lodged at the Patent Office.

The sealing of a patent is sometimes very considerably delayed by an opposition, and in order to prevent the petitioner being prejudiced in such a case, the Lord Chancellor will generally direct the delivery of the Privy Seal bill to be recorded in the *recepti* as of the earliest day upon which the patent might have been sealed if there had been no opposition, so that the patent when made may bear date as of that day. (y) But in other cases it is the practice to record the delivery of the Privy Seal bill as of the day when the *recepti* is signed by the Lord Chancellor, and the patent sealed. And as a party may at all times [538] procure an unopposed patent to be prepared with expedition, and sealed *at a private seal, it is his own fault if he is prejudiced by any delay in the preparation and sealing of it.

The clerk of the patents also engrosses the patent upon parchment, copying it verbatim from the Privy Seal bill, only instead of the abbreviated conclusion, "In witness, &c., witness, &c.," he adds the proper conclusion, with the date in words at length. (z)

According to the statute of 18 Hen. VI. c. 1, (a) a patent is to be made in pursuance of a warrant or writ from the Crown, bearing date the day mentioned in the *recepti*, and not before. And the act declares that if any letters patent be made to the contrary they shall be void.

A patent is always dated as of the current year of the Queen's reign, not as of the year of our Lord.

Patents for inventions are always made in pursuance of a command to the Lord Chancellor, contained in a bill or writ under the Privy Seal, and therefore every patent of that description is subscribed, "By writ of Privy Seal," in order to show upon the face of it by what authority the patent has been made. (b)

A patent is also to be subscribed with the name of the clerk of the patents as the officer by whom the instrument has been prepared.

The clerk of the patents also prepares a docket (c) for the Lord Chancellor's signature containing the name of the party to whom the patent is to be granted, the title of the invention, the extent and duration of the grant, the time allowed for specification, and the date of the patent. The words, "By writ of Privy Seal," and the name of the clerk of the patents, are also to be subscribed to be docket.

The documents having been prepared in manner already described, the Privy Seal bill is laid before the Lord Chancellor to obtain his Lordship's signature to the *recepti*. The docket is also to be signed by his Lordship to authorize the sealing of the patent, and he usually signs it with his initials only.

(x) See the Statute in the Appendix, Chap. I. s. 1.

(y) See Cutler's case, 1 Webs. R. 418, 430.

(z) See the Form in the Appendix, Chap. II. s. 1.

(a) See the Statute in the Appendix, Chap. I. s. 1.

(b) Vide 8 Co. R. 18, b.

(c) See the Form in the Appendix, Chap. II. s. 1

*The sealing of a patent, as well as any other instrument, may [*539] take place either on a public seal day, or at a private seal. (d) And in order to have a patent prepared and sealed on a public seal day, the Privy Seal bill must be taken to the Patent Office two clear days before the seal day.

The patent is sealed by the sigillator, or sealer, to whom must be produced the docket bearing the Lord Chancellor's signature as his warrant, and the engrossment of the patent, and upon seeing that they correspond with each other, he will affix the Great Seal to the patent. (e)

The patent having been sealed, all the documents are taken back to the Patent Office, where the Great Seal and patent will be put into a case, and then delivered to the patentee or his agent. (f)

The docket is then entered into the docket book of the Patent Office, to which the public has access, and from that book the public derive their information respecting patents which have been sealed.

The Privy Seal bills and dockets upon which patents have been made, are kept in the Patent Office until they are sent to the Enrolment Office, which is done annually in the month of October, in order that the clerk of records and enrolments may prepare the enrolments of the patents, which have been made in pursuance of those Privy Seal bills.

Patents are always enrolled or entered of record, upon rolls called patent rolls. (g) and as a Privy Seal bill contains the whole of the patent made in pursuance of it, the patent itself is always delivered to the patentee, in order that he may have evidence of his title and immediate possession of his privilege, and the enrolment is made from the Privy Seal bill. Although copied from the Privy Seal bill for the sake of convenience, the enrolment is, however, the enrolment of the patent and not of the Privy Seal bill. (h)

In enrolling a patent, it is the practice to abbreviate the direction or address at the commencement of the enrolment of a patent, [*540] thus, "Victoria, by the grace of God, &c. To all to whom these presents shall come greeting, Whereas," &c., and after copying the whole of the body of the patent verbatim, then to abbreviate the conclusion thus, "In witness, &c., witness, &c., the [eighteenth] day (i) of [September]," and these abbreviations seem to be made for the purpose of avoiding unnecessary repetitions upon the rolls.

The patent rolls are composed of long narrow strips of parchment called membranes, fastened together, and rolled up. The patents of each year of the Queen's reign are entered upon a distinct set of rolls, although perhaps, in contemplation of law, all the patent rolls are to be considered as but one roll or record. The patents of every year are copied upon membranes, such as have been mentioned, nearly in the order of their dates, (but that is not requisite.) the commencements and conclusions of the patents being abbreviated in the manner which has been described.

Each membrane of parchment is numbered, and also indorsed in this manner:—"Patents of the [ninth] year of the reign of Queen Victoria," and the

(d) Vide *ante*, p. 390. If an applicant opens the Great Seal in order to procure his patent to be sealed he must pay an extra or opening fee of 2*l*.

(e) The fees payable at the Patent Office for a patent to one person for England and Wales only, when sealed at a public seal, amount to 4*l*. 17*s*.; and if there are two or more patentees an additional fee of 2*l*. 13*s*. 4*d*. is to be paid; but there is no further fee when the patent extends to the Channel Islands and Colonies.

(f) Vide *ante*, p. 38.

(g) Vide *ante*, pp. 38 and 219; and 2 Blac. Com. 347.

(h) See Nickel's case, 1 Webs. R. 660.

(i) See the Form in the Appendix, Chap. II. s. 1.

enrolments having been written or engrossed upon them, they are fastened together in proper order so as to form rolls, called parts, of a convenient size, and these parts are numbered in arithmetical order, "first part," "second part," and so on. There are about thirty of these parts or rolls for each year of the Queen's reign, and there are about fifty membranes in each part.

The patent rolls are kept about two years in the Enrolment Office, after which they are sent to the Petty Bag Office, together with the Privy Seal bills and dockets; and the reason for adopting this practice seems to have been, that the clerks of the Petty Bag might examine the rolls and see that they were correct. (*h*) It has, however, long ceased to be the practice to examine the enrolments after they are transferred to the Petty Bag Office.

The patent rolls remain in the Petty Bag Office until they are about fifteen [*541] years old, and then they are finally sent *into the Office of the Rolls Chapel, together with the Privy Seal bills.

Office copies of the enrolment of a patent may be had at any of the offices in which the enrolment is deposited. (*a*)

2. *Of the Practice respecting the Preparation and Enrolment of Specifications for Patent Inventions.*

After a patent has been sealed, the patentee ought to examine the list of patents granted during the preceding six months, in order to ascertain whether there is any patent for an invention with such a title as would be large enough to include his invention. If he finds that the title contained in any prior unspecified patent would be sufficient to describe or include his invention, he ought to be very circumspect, and ought not to communicate his invention to any but persons in whom he can place reliance, until the prior patent has been specified. The reason is, that a prior patentee having a patent with a title sufficiently large to include the subsequent invention, might, if it came to his knowledge, introduce into his specification a description not only of his own invention, but also of that of which he has subsequently obtained a knowledge, and thus the subsequent patentee might be totally deprived of the fruits of his labour and ingenuity.

And it is the more necessary for a patentee to be cautious in this respect, because persons have frequently been known to obtain patents containing titles couched in the most general and indefinite terms, for the purpose of afterwards including in their specifications any novelty of which they may obtain a knowledge during the time allowed for the enrolment of that instrument, and which would be covered by the title.

The patentee has now to perform the condition upon which he has obtained his patent, in pursuance of which he must, within the time limited by the pro- [*542] viso, ascertain and describe *the nature of his invention, and the manner in which it is to be performed, by an instrument in writing under his hand and seal, which is usually called a specification; and he must also cause that instrument to be enrolled in Chancery.

(*h*) See Collier on Patents, p. 196.

(*a*) At the Enrolment Office the cost of an office copy is 8*d.* for every folio of ninety words, 2*d.* per sheet for the paper, 2*s.* for the certificate of examination, and 1*s.* for the seal;—at the Petty Bag Office the charge is also 8*d.* per folio, and 2*d.* per sheet for the paper; but the certificate fee is 3*s.* 4*d.*, and the search and inspection 3*s.* 6*d.*;—and at the Office of the Rolls Chapel, 6*d.* per folio is charged for a plain copy, and 1*s.* per folio for an authenticated copy;—the stamps are to be paid for in addition to these fees at each of the offices.

The specification is a most important instrument, with reference to the patentee's title to the privilege granted by the patent, and the utmost care ought to be taken to prepare it correctly.

Few instruments require greater skill to be exercised in their preparation than specifications, and more patents have been lost in consequence of the insufficiency of specifications than for any other cause. Specifications are, indeed, now prepared in a much less objectionable manner than formerly, but there is still room for very great improvement.

In consequence of the great cost of a patent, the patentee is generally anxious to have his specification completed at as small a cost as possible, and therefore he either prepares the instrument himself, or has recourse to the assistance of some person who is willing to render his services for a small remuneration, and such persons are generally wholly incompetent to discharge the duty of settling this most important instrument.

If an invention is really of value, the patentee will always find it cheaper to have his specification prepared or settled by a competent person, for although by so doing he will enhance the cost in some degree, yet he will render his patent more secure, and probably save the cost of proving the sufficiency of the instrument in a Court of Law.

The form and requisites of a specification have already been examined in a former part of this work, (*h*) to which the reader is referred. And it ought always to be borne in mind by those who settle specifications, that *the law requires the specification to be prepared with the utmost good faith on the part of the patentee*, and that too great care cannot be taken to ensure the accuracy of the instrument. The object of the specification being that the public should have information of what the prohibition in the patent extends to, during the term it grants, and what the public are to acquire the right of doing after the patent has expired; the specification should distinctly point out what the invention is, so that every one may [*543] clearly understand what he is prohibited from doing; and the manner of using or practising the invention should be described with such accuracy, that any competent person will after the expiration of the term be enabled to practice the invention without difficulty or further instruction.

The specification is usually written upon parchment, and although it might be put upon paper, it is always better to have it written upon a more durable article. (*i*)

It must be signed and sealed by the patentee himself, or if there be two patentees, it will be sufficient if it be signed and sealed by either of them.

If the specification is intended to be enrolled in the Enrolment Office, it must be acknowledged before a Master (ordinary or extraordinary) in Chancery, (*k*) for without such an acknowledgment, it cannot be enrolled in that office. (*l*) But in the Petty Bag and Rolls Chapel Offices no acknowledgment is required.

There are three offices in Chancery in which specifications may be enrolled; they are the Enrolment Office, (*m*) the Petty Bag Office, (*n*) and the Rolls

(*h*) *Ante*, Chap. VII. p. 151; and see the Form in the Appendix, Chap II. s. 1.

(*i*) It must be stamped with the duty of 5*l.*, and a progressive duty of 1*l.* must be paid for every entire quantity of fifteen folios (of seventy-two words each) over and above the first fifteen folios.

(*k*) See the Form of Acknowledgment in the Appendix, Chap. II. s. 1.

(*l*) In Co. Lit. 225, b, it is said that no deed, &c. can be enrolled unless it be duly and lawfully acknowledged.

(*m*) Chancery Lane.

(*n*) In the Rolls Yard, Chancery Lane.

Chapel Office, (*n*) and a patentee is at liberty to enrol his specification in whichever of those offices he thinks fit. (*o*)

When a specification is enrolled in the office of the Rolls Chapel, the patentee and the public acquire the advantage of *being enabled to prove [*544] the enrolment by an authenticated copy, (*p*) for that office is now a branch of the public Record Office within the provisions of the statute 1 & 2 Vict. c. 94. In consequence, however, of the facility afforded at the Rolls Chapel Office to persons examining enrolments and other records, some patentees will not enrol their specifications at that office notwithstanding the advantages of enrolling there. (*q*)

It has already been shown within what time a specification must be enrolled, and it only need be added, that the enrolment will be in time, if the specification be left at the office for enrolment at any time before twelve o'clock at night of the last day allowed for that purpose, for the instrument is always enrolled as of the day it is left at the office for that purpose.

In the Enrolment Office, specifications are entered (*r*) upon the "Close Rolls," being so called because upon those rolls writs close are enrolled. In each of the other offices, viz: the Rolls Chapel and Petty Bag, there is a roll called the Roll of Specifications and Surrenders, and upon that roll a specification is entered at either of those offices.

These rolls are prepared in a similar manner to the patent rolls, which have already been described; but they are indorsed "Close Rolls," or "Roll of Specifications and Surrenders," as the case may be.

If the specification has been acknowledged, the acknowledgment will be entered of record upon the roll (*s*) as well as the specification itself, and the date of the enrolment.

When the enrolment has been completed, a certificate will be indorsed upon the specification stating that it was enrolled on the day it was left at the office for that purpose.

[*545] *The close rolls are taken from the Enrolment Office to the Rolls Chapel Office, when they are about fifteen years old. The roll of specifications and surrenders is not removed either from the Rolls Chapel or Petty Bag Office.

(*n*) In the Rolls Yard, Chancery Lane.

(*o*) The cost of enrolment in the Rolls Chapel Office is much less than in either of the other offices. In the Rolls Chapel Office it is sixpence for every Chancery folio of ninety words;—at the Enrolment Office the charge is 10s. for every membrane or skin entirely occupied by the enrolment, (a membrane usually containing about ten Chancery folios) and for any portion of a membrane less than the whole a charge is made at the rate of 6*d.* for every five lines;—the cost of enrolment at the Petty Bag Office is 10s. 6*d.* for every skin; any portion of a skin less than half a skin is charged as half a skin, and a portion of a skin more than half is charged as a whole skin; and the patentee is at each of those offices allowed to prepare the drawing for the roll himself, at any time within fourteen days after the specification has been left for enrolment. When the patentee does not supply the drawing for the roll, it will be prepared in the office; and of course an extra charge will be made for it.

(*p*) Vide *ante*, p. 485.

(*q*) It is very much to be regretted that all specifications are not enrolled in one office. It is extremely inconvenient for the public to have three offices to search for enrolments; and it frequently happens that a person searches each of the offices before he finds the specification he wants—and he must pay a fee for each office he searches whether he finds the enrolment there or not. The Attorney General might frame the condition in the form of patent, so as to compel patentees to enrol their specifications in the Rolls Chapel Office, in which the greatest facilities are afforded to the public, and the Master of the Rolls has power to order all the existing enrolments in the Petty Bag or Enrolment Office to be transferred to the Rolls Chapel.

(*r*) See the Form of Enrolment in the Appendix, Chap. II. s. 1.

(*s*) See the Form in the Appendix, Chap. II. s. 1.

Each of the enrolment offices which have been mentioned may be searched for the enrolments of specifications, by any person within the usual office hours, (t) the fee being one shilling for each search. (u)

For the same fee which is paid for a search at the Rolls Chapel Office, the party searching is entitled to peruse the whole of the enrolment of the specification, and to inspect the drawing (if any) annexed to the roll, and he may *in pencil* take extracts from or copy any part of the enrolment of a specification, or a drawing annexed to the roll. A copy of the whole, or of any part of a specification may be had at a moderate charge; (x) and if a copy of a drawing is required, the charge is equally moderate, the party requiring it being only charged the actual cost of preparing it. These facilities have been given to the public by the Master of the Rolls, (y) under the statute of 1 & 2 Vict. c. 94, (z) the Rolls Chapel Office being now a branch office of the public Record Office of the kingdom.

The copies which are furnished to applicants at the Rolls Chapel Office may, in pursuance of the statute 1 & 2 Vict. c. 94, s. 12, to be examined and certified as true and authentic copies, by the deputy keeper of the records, or one of the assistant record keepers, and sealed or stamped with the seal of the Record Office, and by sect. 13, copies so sealed are to be received [546] in evidence in every case in which the original record would be received. (y)

At the Petty Bag or Enrolment Office, a person inspecting the enrolment of a specification is not allowed to take any extract, or to copy any part of the record, nor can he obtain a copy of any part of the enrolment without taking or at all events paying for the whole. The cost of an office copy is greater at either of these offices (z) than at the Rolls Chapel Office, and it is not admissible in evidence unless proved to be correct by a person who has examined it with the original record. (a)



3. *Of the Practice respecting the Alteration and Amendment of Patents, Enrolments, &c.*

When any error is sought to be amended, or alteration made in a patent, (b) all the prior proceedings must be altered before the Lord Chancellor can alter or amend the patent in the manner desired by the patentee.

(t) The office hours at the Rolls Chapel Office, and Petty Bag Office, are from 10 o'clock a. m. to 4 o'clock p. m. during the whole year; at the Enrolment Office, during each term and until the Second Seal after Hilary term, and Last Seal after Michaelmas term, the hours are from 10 a. m. to 2 p. m., and from 6 a. m. to 8 p. m.; at other times from 10 a. m. to 3 p. m., holidays excepted.

(u) At the Petty Bag Office a fee of 2s. 6d. is charged for an inspection in addition to the fee for a search; but the fee for a search at the Enrolment Office includes an inspection.

(x) Sixpence for every Chancery folio of ninety words.

(y) The public are greatly indebted to Lord Langdale, the present Master of the Rolls, for the great facilities which he has given to parties desiring to have access to specifications. It is greatly to be regretted, however, that the privileges intended for the benefit of the public have been much diminished in value, in consequence of the small number of specifications now enrolled at the Rolls Chapel Office.

(z) See the Statute in the Appendix, Chap. I. s. 1.

(y) Vide *ante*, p. 485. The cost of authenticating a copy is 6d. per folio, which makes the total cost 1s. per folio besides stamps.

(z) See the cost of office copies, stated *ante*, p. 543, and there will be an additional charge for copying any drawing annexed to the specification.

(a) Vide *ante*, p. 485.

(b) Vide Chap. VIII. s. 3, *ante*, p. 211.

In order to obtain an alteration, or amendment, or alteration of the Queen's warrant and bill, and subsequent proceedings, the patentee must present a petition to the Crown, praying for the amendment or alteration which is desired, this petition must be left at the office of the Secretary of State for the Home Department, and it will be answered by the Secretary of State by a reference to the Attorney or Solicitor General, in the same way as a petition for a patent.

When the petition with the reference has been obtained, it must be taken to the chambers of the Attorney or Solicitor General, and an appointment must be obtained for a hearing, when the petitioner, his solicitor, or agent, must attend and support the prayer of the petition.

There is no definite practice with respect to the mode of entering caveats [*547] against amendments or alterations being *allowed, such proceedings being of rare occurrence, but it seems that they ought to be entered in the same way as other caveats, and if any one has entered a caveat with the Attorney or Solicitor General, he will be heard in opposition to the prayer of the petition in the same way as a person is heard upon an opposition to an application for a patent. And if there have been any proceedings taken upon the patent, the Attorney or Solicitor General will sometimes direct the petitioner to give notice of the application to the parties.

If the Attorney or Solicitor General reports in favour of the application, the petition and report must be taken to the office of the Home Secretary.

Upon a favourable report being made to the Crown by the Attorney or Solicitor General, the application for the alteration or amendment will be granted, and for that purpose the Secretary of State for the Home Department will send for the Queen's warrant and the Queen's bill, which he will take with him to an audience of her Majesty, and in her presence the alteration will be made in each of those documents. In the margin of each document will be written a memorandum signed by the Secretary of State, certifying that the alteration was made in the presence and by command of her Majesty, and stating the date when it was done, after which the documents are restored to their former custody.

The next step is to procure the signet bill to be altered to make it correspond with the Queen's bill, for which purpose the clerk of the signet will obtain the signet bill at the Privy Seal Office, and having made the necessary alteration of it, of the entry in the docket-book, (when necessary) in accordance with the altered Queen's bill, he will take it to the office of the Secretary of State for the Home Department, and get it resealed, and then return it to the Privy Seal Office.

In order to procure the Privy Seal bill to be altered or amended, it is necessary to present a petition to the Master of the Rolls, stating all the facts, and praying for leave to have the Privy Seal bill taken to the Privy Seal Office to be altered or amended and resealed. Before this petition is presented, it is necessary to obtain the signature of the Attorney or Solicitor General to a con- [*548] sent on the part of the *Crown, that the prayer of it may be granted. This petition must be taken to the secretary of the Master of the Rolls, and his Lordship will grant the application if he thinks the case one in which an amendment or alteration ought to be allowed. If there be any proceedings at Law or in Equity pending upon the patent, it is usual to require notice of the application, to be given to the parties in order that they may, if necessary, be heard against the prayer of the petition. (c)

If the Master of the Rolls grants the requisite leave for the Privy Seal bill to be amended, it is taken to the Privy Seal Office, and there altered so as to

(c) See Nickel's case, 4 Beavan, 563; 1 Webs. R. 650.

make it accord with the signet bill, and it is then to be folded up and taken to the Lord Privy Seal and resealed. If the alteration affects the entry of the bill in the docket-book of the office, the entry must also be altered so as to make it correspond with the bill.

The Privy Seal bill, or writ of Privy Seal, together with the patent, must then be taken to the Patent Office, and the Privy Seal bill must be re-delivered to the Lord Chancellor in precisely the same way as it was delivered in the first instance; and his Lordship again signs a *recepti* stating such re-delivery, and the object of it. (*d*)

If no caveat has been entered against sealing the amended or altered patent, it will be done as a matter of course, but caveats and oppositions may be entered in precisely the same way as caveats and oppositions against the sealing of any other patent, (*e*) and if there be any caveat against altering or sealing the patent, the applicant must petition in the same way as already stated, (*f*) respecting an opposition to the sealing of a patent originally.

The hearing and proceedings upon a petition to alter or amend and reseal a patent are precisely the same as upon a petition for the sealing of a patent, except that the hearing is not in private.

In order to alter and reseal a patent, the Great Seal is first to be cut off, and the required alteration having been made, "the patent is to be sealed [*549] in precisely the same way as before. (*g*)

The patent having been altered and resealed, the Privy Seal bill will be restored to its former custody, and then the Master of the Rolls will upon petition or application order the enrolment to be altered so as to make it correspond with the altered patent.

The jurisdiction of the Lord Chancellor and Master of the Rolls to alter or amend enrolments of specifications, &c., has been considered in a former part of this work (*h*) to which the reader is referred.

In order to procure any alteration or amendment of the enrolment of a patent or specification, the patentee must present a petition to the Master of the Rolls, stating the facts, and praying that the alteration or amendment may be made. This petition must be left with his Lordship's Secretary, and the facts stated in it must be verified by affidavit.

If there be any proceedings pending upon the patent, the parties must have notice in order that they may oppose the alteration in case it should be to their prejudice.

The petitioner's counsel will be heard in support of the application, and if the application is opposed, the counsel of the party opposing will be heard in opposition to the prayer of the petition.

If the Master of the Rolls grants the prayer of the petition, an order must be drawn up directing the alteration or amendment to be made, and the order must then be taken to the officer by whom it is to be executed.

Either party may appeal to the Lord Chancellor. (*i*)

(*d*) See Nickel's case, Turn. & Phil. 47; 1 Webs. R. 663, S. C.

(*e*) Vide *ante*, p. 530.

(*f*) Vide *ante*, p. 532, and see Nickel's case, Turn. & Ph. 46; 1 Webs. R. 661.

(*g*) Vide *ante*, p. 539.

(*h*) Chapter VIII. s. 3, p. 211.

(*i*) Vide *ante*, p. 220.

SECTION II.

Of the Practice respecting Disclaimers and Memorandums of Alteration, under the Statute 5 & 6 Will. IV. c. 83, s. 1.

THE enactment under which a patentee or assignee of a patent may obtain
 [*550] leave to alter or disclaim any part of the *title or specification of the invention comprised in a patent, has already been stated in a former part of this work. (i)

Shortly after the passing of the statute, the Attorney and Solicitor General laid down certain rules of practice, (k) respecting the mode of proceeding by parties applying for leave to enter disclaimers or memorandums of alteration under its provisions, and those rules still remain in force.

A person desiring to disclaim or alter any part of his title or specification must apply by petition (l) to the Attorney General or Solicitor General for leave to enter the proposed disclaimer or memorandum of alteration.

The petition must state the nature of the patent, and the nature of the grant it makes, the title of the invention being stated *verbatim* as contained in the patent. The petition must also state when the specification was enrolled, and also so much of the instrument itself (if any) as may be necessary to make the petition intelligible. If the applicant is an assignee of the patent, he must state how and when he became the assignee. (m) And the applicant must also state what the proposed disclaimer or alteration is, and the reasons why it is sought to be made.

When a party is desirous of disclaiming some parts of his title or specification, and of altering some other part, the petition must, of course, be framed accordingly.

The petition may in general be addressed either to the Attorney or Solicitor General at the election of the applicant. But if either of those officers has acted as counsel in any cause respecting the patent, it is the practice to address the petition to the other of them, and if they have both been engaged in a similar manner, then the petition may be addressed to either of them, and he will desire some gentleman who has filled the office of Attorney or Solicitor General, to advise him respecting the disposal of the matters of the petition.

[*551] *The petition must be lodged at the chambers of the Attorney or Solicitor General, to whom it is addressed, and it must be accompanied by a copy of the specification and of the proposed disclaimer or memorandum of alteration.

The statute (n) expressly authorizes the Attorney and Solicitor General to require the party applying to advertise his disclaimer or alteration in such manner as that officer may think fit, and whenever legal proceedings have been taken upon the patent, or the Attorney or Solicitor General is of opinion that

(i) Chap. VIII. s. 2, p. 203, 205.

(k) See the Rules in the Appendix, Chap. I. s. 2.

(l) See the Form of Petition in the Appendix, Chap. II. s. 2.

(m) When any part of a title or specification is disclaimed or altered by an assignee, it seems to be desirable that the assignment, under which he claims, should be enrolled in Chancery, in order that his title to enrol the disclaimer or memorandum of alteration may appear upon the records of the Court. The Attorney or Solicitor General might require an enrolment of the deed before granting his *fiat*.

(n) 5 & 6 W. IV. c. 83, s. 1.

the disclaimer or alteration may prejudice third parties, he will direct the applicant to publish such advertisements as he thinks necessary, and will delay granting his *fiat* until about ten days after the advertisements have been duly published. (o)

A caveat (p) may be entered by any person against granting a *fiat* for the entering and enrolling of a disclaimer or memorandum of alteration. (q) Such a caveat is to be entered in the same way as a caveat against the grant of a patent, the practice respecting which has already been stated, (r) and may be entered at any time before the actual issuing of the *fiat*. (s)

A caveat against a particular disclaimer or alteration which has been advertised, is a specific caveat, which is only to be entered at the chambers of the Attorney or Solicitor General, to whom the application has been made; but parties may also enter general caveats against any disclaimer or alteration of a patent or specification, and in such cases caveats must be entered at the chambers both of the Attorney and Solicitor General. A caveat will only be in force for one year, but it may be renewed as often as the party entering it pleases.

When a patentee applies for leave to enter a disclaimer or alteration and the advertisements (if required) have been duly published, the Attorney or Solicitor General's clerk sends notice of the application to every person who has entered a caveat, that if he intends to oppose the application, he must [*552] within four days send notice or enter his opposition at the chambers of the Attorney or Solicitor General to whom the application has been made, and if no opposition be entered within the four days the petition will be treated as unopposed.

A party who intends to oppose an application for leave to enter a disclaimer or memorandum of alteration, ought to enter his opposition at the chambers of the Attorney or Solicitor General within four days after the date of the notice which he receives; an opposition may however be entered at any time before the *fiat* is granted. The effect of an opposition being entered is to stay all proceedings upon the petition until the party opposing has been heard, or had an opportunity of being heard against the granting of the prayer of the petition, and he is entitled to have a week's notice of the time appointed for a hearing of the matter of the petition.

There must in every case be an actual hearing of the matters of the petition before the Attorney or Solicitor General, at which every person who has entered an opposition is entitled to attend.

If the grant of a *fiat* is not opposed the Attorney or Solicitor General will peruse the petition and other documents, and if it appears to him that the proposed disclaimer or alteration will not be prejudicial to the public he will grant his *fiat* for the entry and enrolment of it. But if he is not satisfied respecting the propriety of allowing the disclaimer or alteration, he may require the applicant to furnish him with further information, or to vary the form of the instrument to be entered and enrolled.

In order to obtain a hearing, the petitioner must procure an appointment from the clerk of the Attorney or Solicitor General, and in an opposed case also a summons for the parties to attend on the day appointed for the hearing. A copy of the summons must be served upon every opposing party.

(o) The advertisements when required are usually ordered to be inserted three times in *The Times*, *The Morning Chronicle*, and *London Gazette*, and if the patentee carries on business in the country, then also in a newspaper published in the neighborhood.

(p) See the Form of Caveat in the Appendix, Chap. II. s. 2.

(q) See the statute 5 & 6 Will. IV. c. 83, s. 1, which entitles parties to enter caveats, and to have notice of hearings.

(r) *Ante*, s. 1, p. 507.

(s) The fee for entering a caveat is 5s.

At the time appointed for the hearing the application will be heard in support of his petition, and if any opposing parties attend they will also be heard before the Attorney or Solicitor General; and this hearing is not private like the hearing upon an opposition to the grant of a patent, but each party is [*553] *heard in the presence of the other, first the applicant for a *fiat*, then each of his opponents.

Each party must produce such evidence of any material facts as may be satisfactory to the Attorney or Solicitor General, but those officers are not bound to adhere strictly to the rules respecting legal evidence. Affidavits or solemn declarations made before a Master (ordinary or extraordinary) in Chancery, of the insertion of advertisements, &c., may be read at the hearing. And, in order to dispense with advertisements, the applicant must satisfy the Attorney or Solicitor General that no legal proceedings have been taken upon the patent.

The parties may, and in opposed cases usually do, appear by counsel at the hearing.

The Attorney or Solicitor General having heard the applicant, and all his opponents, if any, will grant or refuse the application as he thinks fit. The granting of leave is entirely discretionary with the officer to whom the application is made, and his decision is final.

If the Attorney or Solicitor General decides that the prayer of the petition ought to be granted, the intended disclaimer or memorandum of alteration ought to be completed, and the *fiat* obtained without delay, for a caveat and an opposition may, as has already been stated, be entered at any time before the *fiat* has actually been granted. (*r*)

The instrument ought to be written on parchment, and that is to be done by the party himself, his solicitor, or agent.

The statute (*s*) provides that a patentee may *enter* with the clerk of the patents a disclaimer or memorandum of alteration, "and such disclaimer or memorandum of alteration, being *filed* by the said clerk of the patents, and enrolled with the specification," shall be deemed to be part of the patent or specification. Three things are, therefore, to be done in order to comply with the provisions of this statement, viz: to enter the instrument with the clerk of the patents;—to file it with that officer;—and to enrol it in the office in which the specification was enrolled. The order in which these three [*554] things are done does not seem to be material, but they must *all be done before the instrument can have complete effect given to it.

The most generally prevailing mode which has been adopted for the purpose of complying with the provisions of this act seems to be very loose and unsatisfactory.

It has become the practice to prepare what is called an entry paper, stating the whole of the intended disclaimer or alteration as it is proposed to be made, and if the Attorney or Solicitor General determines to grant his *fiat*, the disclaimer or memorandum of alteration is also engrossed on parchment, and each document is signed by the patentee. The *fiat* is written under or endorsed upon the disclaimer or memorandum of alteration, and signed by the Attorney or Solicitor General, and under the entry paper is written a certificate directed to the clerk of the patents, stating that a *fiat* has been granted, which certificate is signed in like manner. The entry paper is then taken to the clerk of the patents to be entered and filed, and the disclaimer or memorandum of alter-

(*r*) The fees payable at the chambers of the Attorney or Solicitor General amount to about 7*l.* 14*s.*

(*s*) 5 & 6 Will. IV. c. 83, s. 1.

ation to the office where it is to be enrolled, after which it is returned to the patentee.

It is to be observed that a party seeking to disclaim or alter his patent or specification must at his own peril comply with the provisions of the statute, and if he fails to do so, the instrument will be unavailing.

It seems that the best course to be adopted in case of a disclaimer or memorandum of alteration, is to take the instrument, after it has been signed and (if necessary) acknowledged by the party, and the *fiat* signed by the attorney or solicitor, to the office where it is to be enrolled, and the enrolment having been completed (which it generally will in the course of a few days,) the document ought to be taken to the Patent Office, and there left to be entered and filed by the clerk of the patents.

The statute (s) speaks of an enrolment of the disclaimer or memorandum of alteration with the specification, but that has been construed to mean an enrolment at the office in which the specification was enrolled. As all the parts of a roll are to be deemed in law but as one roll, and as there is only one roll at any office upon which such an instrument can be enrolled, "an enrolment in this manner appears to be a literal compliance with the ['555] statute. The object of the legislature seems to have been that any one searching the records of any of the offices for the enrolment of a specification, should find the disclaimer or memorandum of alteration in the same office as the specification. The disclaimer or memorandum is entered upon the roll in the same way as the specification, and upon a part of the roll for the year in which it is enrolled. (t) A reference is always made opposite the enrolment of the specification to that of the disclaimer or memorandum of alteration, and also opposite the enrolment of the disclaimer or memorandum of alteration, to that of the specification, thus, "See Disclaimer [memorandum of alteration or specification,] 24th part, 1844."

If a disclaimer or memorandum of alteration is to be enrolled in the enrolment office, (as it must be if the specification was enrolled in that office,) it is necessary that the instrument should first be duly acknowledged before a Master (ordinary or extraordinary) in Chancery, (u) without which that office will not receive it, or enter it upon the roll.

In order to enter a disclaimer or memorandum with the clerk of the patents, the document must be taken to the Patent Office, (v) where a book is kept for the purpose of making such entries. The entry is made by copying the whole of the instrument in the book; and if there are any drawings, they are also inserted in the book, and the party making the entry is at liberty to furnish the necessary drawings, (y) The object of the legislature in requiring this entry seems to have been that when the title of an invention has been altered, or any part of it disclaimed, the books of the Patent Office shall give information of the fact to the public. And in order to carry out this intention, whenever a disclaimer or memorandum of alteration is entered and filed, a reference is made opposite the entry of the patent in the docket book, to the folio ['556] of the entry book in which the disclaimer or alteration is to be

(s) 5 & 6 Will. IV. c. 83, s. 1.

(t) *See ante*, p. 544. The fees payable for enrolling a disclaimer or memorandum of alteration, are the same as the fees for enrolling a specification.

(u) See the Form of Acknowledgment in the Appendix, Chap. II. s. 1.

(v) In Quality Court, Chancery Lane.

(y) The fee for making and entering is 10s. if the instrument is short, but if long the fee for the same is 1s. and for entering it 4d. per folio; but of course an extra charge is made for drawing, if a copy of it is not furnished by the party making the entry.

found, so that any person searching the docket, will have the means of ascertaining how far the effect of the patent has been varied.

The disclaimer or alteration having been entered and enrolled, it must be filed with the clerk of the patents at the Patent Office, and the instrument will thenceforth become part of the patent and specification. (*a*)

When a disclaimer or memorandum of alteration has been enrolled, and also entered and filed in pursuance of the Attorney or Solicitor General's *fiat*, the Master of the Rolls has no jurisdiction to order it to be removed from the rolls of the Court. (*b*)

SECTION III.

Of the Practice of the Judicial Committee of the Privy Council respecting the Confirmation and Prolongation of Patent Privileges.

THE power of the Crown with the advice of the Privy Council to confirm a patent privilege has been stated in a former part of this work, (*c*) to which the reader is referred for an explanation of the scope and object of the enactment, (*d*) by which the Crown was invested with that power.

Before the statute 5 & 6 Will. IV. c. 83, (*e*) was passed, the term of a patent privilege in an invention could only be extended by Act of Parliament. Applications to Parliament for such extensions were of frequent occurrence notwithstanding the great expense of obtaining a private Act of Parliament.

By the act just mentioned (the provisions of which have since been amended and enlarged, (*f*)) the Queen in Council is invested with the power of prolonging such patent privileges.

Section *four* of the statute enacts, "That if any person who now hath or [557] shall hereafter obtain any letters patent as aforesaid, (*g*) shall advertise in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carried on any manufacture of any thing made according to his specification, or near to or in which he resides in case he carried on no such manufacture, or published in the county where he carries on such manufacture, or where he lives in case there shall not be any paper published in such town, that he intends to apply to his Majesty in Council for a prolongation of his term of sole using and vending his invention, and shall petition his Majesty in Council to that effect, it shall be lawful for any person to enter caveat at the Council Office; and if his Majesty shall refer the consideration of such petition to the Judicial Committee of the Privy Council, and notice shall first be by him given to any person or persons who shall have entered such caveats, the petitioner shall be heard by his counsel and witnesses to prove his case, and

(*a*) See the statute 5 & 6 Will. IV. c. 83, s. 1; and *Perry v. Skinner*, 2 M. & W. 471.

(*b*) *Sharpe's case*, 1 Web. R. 611; vide *ante*, p. 226.

(*c*) Chap. VIII. s. 1. p. 199.

(*d*) 5 & 6 Will. IV. c. 83, s. 2; see the Statute in the Appendix, Chap. I. s. 1.

(*e*) See the Statute in the Appendix, Chap. I. s. 1.

(*f*) By 2 & 3 Vict. c. 67, and 7 & 8 Vict. c. 69.

(*g*) In section one of the act the phrase used (and to which the reference seems to be here made) is, "any person who as grantee, assignee, or otherwise, hath obtained or shall hereafter obtain letters patent for the sole making, exercising, vending, or using of any invention."

the person entering caveats shall likewise be heard by their counsel and witnesses: whereupon, and upon hearing and inquiry upon the whole matter, the Judicial Committee may report to his Majesty that a further extension of the term in the said letters patent should be granted, not exceeding seven years; (*h*) and his Majesty is hereby authorized and empowered, if he shall think fit, to grant new letters patent for the said invention for a term not exceeding seven years after the expiration of the first term, any law, custom or usage to the contrary in anywise notwithstanding. Provided (*i*) that no such extension shall be granted if the application by petition shall not be made and prosecuted with effect before the expiration of the term originally granted in such letters patent."

The power which this enactment and the statute 7 & 8 Vict. c. 62, (*j*) vest in the Crown being confined within definite limits as to the length of the additional terms which may be granted, application must be made to the legislature as heretofore, (*k*) whenever the extension which the Crown is thus authorized to grant shall happen to be insufficient. [*558]

By the statute 3 & 4 Will. IV. c. 41, s. 1, a committee of the Privy Council was formed, with the style of "the Judicial Committee of the Privy Council," and by subsequent sections of the act, all the judicial powers of the Privy Council were transferred to the Judicial Committee. (*l*)

By section eighteen it is enacted, "That it shall be lawful for his Majesty, under his Sign Manual, to appoint any person to be Registrar of the said Privy Council, as regards the purposes of this act, and to direct what duties shall be performed by the said Registrar."

By section four it was enacted, that it should be lawful for his Majesty to refer to the Judicial Committee for hearing or consideration any such matters as his Majesty should think fit, and that such committee should thereupon hear or consider the same and advise his Majesty thereon. It is under the power thus conferred upon the Crown that a petition to the Crown for the confirmation or prolongation of a patent privilege is referred to the Judicial Committee.

A patentee may apply for a confirmation of his patent at any time during the continuance of the term it grants, and he will of course do so with as little delay as possible after he has discovered the defect in his title which he seeks to remedy.

But a patentee must not apply for a prolongation of his patent until the term has nearly expired, for the amount of profit made by a patentee is generally greatest during the last two or three years of his term, and it may be sufficient to remunerate him. Thus, *in re Mackintosh's* patent, (*m*) the petitioner lodged his petition and applied to the Council to have a day fixed for the hearing about eighteen months before the expiration of the patent, but their Lordships were of opinion that the profits accruing during that period might materially affect the question of extension, and therefore directed the application to stand over. [*559]

The 5 & 6 Will. IV. c. 83, s. 4, provided (*n*) that no extension should be granted if the application by petition should not be made and prosecuted with effect before the expiration of the term originally granted by the patent.

(*h*) Extended to fourteen years by stat. 7 & 8 Vict. c. 69, s. 2.

(*i*) This proviso has been repealed by the 2 & 3 Vict. c. 67, sec. 1. Vide *post* and *in re Bolmer's* patent, 2 Moore, P. C. C. 471; 1 Webs. R. 740.

(*j*) See sec. 2 of the statute, stated *post*, pp. 575, 576.

(*k*) As an application to Parliament for the prolongation of a patent will rarely, if ever, become necessary, it is not deemed necessary in this work to say anything as to the practice of Parliament respecting bills for that purpose.

(*l*) See Macqueen's Practice, pp. 687-724. (*m*) 1 Webs. R. 739.

(*n*) Vide *ante*, p. 557.

In re Bodmer's patent, the petitioner duly presented his petition, and obtained an appointment for a hearing on a day before the expiration of his patent; but a sufficient number of the members of the Court did not assemble on the day appointed, and consequently the patent expired before the hearing. Upon the hearing which subsequently was obtained, (after the expiration of the patent,) it was objected by the Attorney General on behalf of the Crown that their Lordships had no power to entertain the application, which had not been prosecuted with effect before the expiration of the patent. The Judicial Committee held that the objection was fatal, and that the words "prosecuted with effect" in the proviso required that something more than the application by presenting the petition and obtaining a day to be fixed for the hearing must have been done to satisfy the proviso in the statute, and the application was consequently refused. (o) This decision led to the repeal of the proviso in the 5 & 6 Will. IV. c. 83, s. 4, by the statute now to be noticed.

By stat. 2 & 3 Vict. c. 67, s. 1, after reciting the act 5 & 6 Will. IV. c. 83, s. 4, and reciting that it had happened since the passing of the said act, and might happen again, that parties desirous of obtaining an extension of the term granted in letters patent of which they were possessed, and who might have presented a petition for such purposes in manner by the said recited act directed, before the expiration of the said term, might nevertheless be prevented by causes over which they had no control from prosecuting with effect their application before the Judicial Committee of the Privy Council; and it was expedient therefore that the said Judicial Committee should have power, when under the circumstances of the case they should see fit, to entertain such application, and to report thereon according to the provisions of the [560] said recited act, notwithstanding that before the hearing of the case before them the terms of the letters patent sought to be renewed or extended might have expired: it is enacted, "that so much of the said recited act as provides that no extension of the term of letters patent shall be granted as therein mentioned if the application by petition for such extension be not prosecuted with effect before the expiration of the term originally granted in such letters patent, shall be and the same is hereby repealed."

By section 2 it was enacted, "that it shall be lawful for the Judicial Committee of the Privy Council, in all cases where it shall appear to them that any application for an extension of the term granted by any letters patent, the petition for which extension shall have been referred to them for their consideration, has not been prosecuted with effect before the expiration of the said term from any other causes than the neglect or default of the petitioner; to entertain such application, and to report thereon as by the said recited act provided, notwithstanding the term originally granted in such letters patent may have expired before the hearing of such application; and it shall be lawful for her Majesty, if she shall think fit, on the report of the said Judicial Committee, recommending an extension of the term of such letters patent, to grant such extension, or to grant new letters patent for the invention or inventions specified in such original letters patent, for a term not exceeding seven years after the expiration of the term mentioned in the said original letters patent: Provided always, that no such extension or new letters patent shall be granted if a petition for the same shall not have been presented as by the said recited act directed, before the expiration of the term sought to be extended, nor in case of petitions presented after the thirtieth day of November, one thousand eight hundred and thirty-nine, unless such petition shall be presented six calendar months at the least before the expiration of such term, nor in any case, unless

(o) The petitioner afterwards obtained a prolongation under the statute 2 & 3 Vict. c. 67.

sufficient reason shall be shown to the satisfaction of the said Judicial Committee for the omission to prosecute with effect the said application by petition before the expiration of the said term."

"The proper time for applying for a prolongation is from twelve [561] to six calendar months before the expiration of the patent term. But it seems that the omission to present a petition at least six months before the expiration of the patent, will only prevent the grant of a prolongation when a hearing cannot be obtained during the continuance of the original term, for the proviso only appears to extend to "any such extension or new letters patent" as mentioned in the previous part of the section, that is, extensions and new patents granted at hearings after the expiration of the original terms.

Whether application is intended to be made for the confirmation or prolongation of a patent, the patentee must, in the first place, give public notice by advertisement of the application which he intends to make. The necessity for giving notice by advertisement is imposed on a petitioner for the prolongation of a patent by the provisions of the act (*k*) under which the application must be made, and upon a petition for a confirmation by one of the rules of practice published by the Privy Council, (*l*) the provisions of the act, and of the rule being the same in effect.

The notice which an applicant is thus required to give must state the nature of the intended petition or application, and the day on which he intends to apply to the Judicial Committee for a time to be fixed for bringing the matter of the petition. (*m*) The day for which such notice is given must not be less than four weeks after the date of the publication of the last of the advertisements to be inserted in the *London Gazette*. (*n*)

If the intention is to petition for a confirmation, the advertisement must state that on or before the day mentioned, notice must be given of any opposition intended to be made to the petition. But if the petition is to be for the prolongation of a patent, the notice to be advertised must state that caveats are to be entered on or before the day for which the notice is given.

The notice of application must in every case be advertised three times in the *London Gazette*, three times in a London newspaper, and three times in a country newspaper. The insertion of the advertisements once [562] in each of three several London newspapers will be sufficient. The country newspaper must be a paper published in the town where or near to which the applicant carries on any manufacture of any thing made according to his specification, or near to or in which he resides if he carries on no such manufacture; or a paper published in the county where he carries on such manufacture or where he lives, if there be no paper published in the town in or near to which he carries on his manufacture or resides. When a patentee resides abroad and does not carry on any manufacture in this country, it will be sufficient if the notice is advertised in a newspaper published in or near to the place where licensees under the patent carry on business. (*o*) But in one case, (*p*) which was an application for a confirmation, the Privy Council required notice to be sent by post to a party interested who resided abroad.

The petition for a confirmation (*p*) must be directed to her Majesty in Council, and it must state the patent, the specification, and if the applicant is an assignee, the assignment under which he derives his title. It must also state the particular defect which renders it necessary for the applicant to petition for a confirma-

(*k*) 5 & 6 Will. IV. c. 83, s. 4.

(*l*) Reg. P. C. r. 1.

(*m*) Reg. P. C. r. 1, and 2, Appendix, Chap. I. s. 2.

(*n*) De Rosne's case, 20 May, 1844.

(*o*) Baron Heurteloup's case, 1 Webs. R. 553.

(*p*) See the Form of Petition in the Appendix, Chap. II. s. 3.

tion, that the invention had not been publicly and generally used before the date of the patent, that the petitioner has published all the necessary advertisements required by the rules of the Privy Council, and concluding with a prayer that her Majesty will be pleased to confirm the patent.

The petition for the prolongation of a patent must also be addressed to the Queen in Council, and state the patent, and specification, and the assignment, if any, to the applicant. It must then set forth the circumstances which have prevented the petitioner from obtaining a proper amount of recompense by means of the exercise of his invention; and if the petitioner intends to apply under the 7 & 8 Vict. c. 69, s. 2, (q) for an extension for fourteen years, it must be stated that a further term of seven years will not suffice for his remuneration. (r)

[*563] *A petition, whether for a confirmation or prolongation, must be presented within one week after the insertion of the last of the advertisements required to be published in the *London Gazette*. (q) And it must be accompanied with affidavits that advertisements have been duly inserted in the *London Gazette* and other papers in the manner already mentioned. (r)

The petition, together with the affidavits of the due publication of the advertisements, must be taken to the Council Office and filed there, and her Majesty's reference of the petition to the Judicial Committee will be obtained by the Clerk of the Council.

Any person may oppose an application for the confirmation of a patent provided he lodges notice of his intention so to do at the Council Office on or before the day named in the applicant's notice. (s) And a petition for the prolongation of a patent may also be opposed by any one who shall enter a caveat (s) against the prolongation at the Council Office, before the day mentioned in the advertisement. And parties who intend to oppose the confirmation or prolongation of a patent, may lodge caveats or notices of opposition at the Council Office, although no petition has been lodged and no advertisement published.

The Judicial Committee will in some cases give parties leave to enter caveats after the day mentioned in the advertisements. (t) And under special circumstances, probably notice of opposition would also be allowed to be given after the day appointed.

The Judicial Committee of the Privy Council does not always sit on the day mentioned in the advertisements, but when the Council does not sit on that day, the application to fix a hearing is made on the first day the Council sits afterwards.

Before applying for a time to be fixed for hearing the matter of a petition for a confirmation, the petitioner's solicitor must serve all parties to any former [*564] suit or action respecting the patent mentioned in the petition, and all *persons who have lodged notices of opposition to the application, with copies of the petition. (u) And previous to an application to fix a time for hearing a petition for a prolongation, the solicitor must serve all persons who have entered caveats against the application with copies of the petition. (u)

As parties can lodge notices of opposition and caveats, even on the day of application for a hearing, it will be necessary for the petitioner's solicitor to

(q) See the Statute in the Appendix, Chap. I. s. 1.

(r) See the Form of Petition in the Appendix, Chap. II. s. 3.

(q) Reg. P. C. r. 3, Appendix, Chap. I. s. 2. (r) Ibid. r. 4.

(s) See the Form in the Appendix, Chap. II. s. 3.

(t) Such leave was granted in *Macintosh's case*.

(u) Reg. P. C. r. 5.

search the Council Office for notices and caveats up to the close of the day prior to the application, in order that he may be enabled to comply with the rules of the Privy Council, by serving the copies of petitions as already mentioned.

The service of parties with copies of the petitions must be verified by affidavit, without which the Privy Council will not entertain an application to fix the hearing.

On the day mentioned in the advertisements, the petitioner must apply by counsel to the Judicial Committee of the Privy Council, to fix a time for hearing the matter of his petition. If the petition is opposed, the day to be fixed for the hearing must be more than four weeks from the time of the application, because the petitioner must give at least four weeks' notice of the time appointed for the hearing.

Every person who has been served with a copy of a petition, whether for a confirmation or a prolongation, must, within a fortnight after such service, lodge at the Council Office notice of the grounds of his objections to the granting of the prayer of the petition. (*w*) If a party neglects to lodge such a notice he cannot be heard in opposition to the prayer of the petition; and a person who has lodged a notice, will be confined to what is contained in his notice, and will not be allowed to oppose the petition upon any ground which is not mentioned in the notice.

Upon a petition for a confirmation, the solicitor of the applicant must give notice of the time appointed for the hearing to every person who has lodged a notice of opposition at the Council Office. (*x*) And upon a petition for a prolongation a similar notice must be given to every person who has entered a caveat at the Privy Council Office. (*y*)

The notice of a hearing must be served at least four weeks [565] before the day for which it has been appointed. (*z*)

All affidavits, notices, &c., relating to the matter of any petition which has been referred to the Judicial Committee must be intitled, "In the Judicial Committee of the Privy Council," and also in the matter of the petition to which they relate.

Parties may obtain office copies of all papers lodged at the Council Office, respecting the matter of a petition. (*a*)

The petitioner may either appear in person, or by counsel, at the hearing of the matter of the petition. And as he is bound to make out a good *prima facie* case, independent of any objections to be raised by his opponents, he must begin at the hearing, and of course he will be entitled to the reply.

The practice of the Privy Council respecting the number of counsel to be heard is the same as in the House of Lords, viz: two only for each party, and two counsel only will be heard on behalf of several opposing parties, unless they have independent and distinct grounds of opposition founded on separate and independent interests. (*b*)

The Attorney General always attends the hearing in order to watch the case on behalf of the Crown and the public.

The petitioner must in the first place show at the hearing that he has duly advertised notice of his application, and also served copies of his petition upon all persons who are required to be served by the rules of the Judicial Committee.

(*w*) Ibid. r. 6.

(*x*) Ibid. r. 1.

(*y*) Ibid. r. 2.

(*z*) Reg. P. C. r. 1 and 2.

(*a*) Reg. P. C. r. 7, Appendix, Chap. I. s. 2. The cost of an office copy is 5s. for every side or page of the copy.

(*b*) Woodcroft's patent, 3 Moore's P. C. C. 172.

The petitioner must also give in evidence his patent and an office copy of the enrolment of his specification. And if he is an assignee of the patent, his title deed or title deeds must be given in evidence, the execution of them being proved by the attesting witnesses. (c)

Any of these formal proofs may be made either by affidavit or by the examination of witnesses at the hearing.

The petitioner for a confirmation must show whether there have been any proceedings taken upon the patent, and the result of them. And if there have been any actions or suits respecting the patent, he must prove that the parties [*566] have *been served with copies of the petition. The petitioner must himself, by affidavit, state that he was ignorant of the defect in his title at the time of his application for the patent; and it would be prudent to have the patentee in attendance, as the Judicial Committee might desire to examine him respecting his want of knowledge of a discovery or use of the invention by any other person prior to the grant of his patent. (e)

The petitioner must also show the particular defect in his title, occasioned by a prior discovery or use of the invention which he is seeking to cure by a confirmation; and the Privy Council will require the fullest possible information respecting this part of the case, and the way in which the defect was discovered.

To make out the petitioner's case, evidence must also be given to show that the invention had not been publicly known or used at any time before the date of the patent.

In order to obtain the report of the Judicial Committee in favour of a confirmation, the petitioner must make out a strong case for the interposition of the Crown in his favour, and if he has any other remedy, as by a disclaimer or a memorandum of alteration, the confirmation will not be granted. (f)

In support of a petition for a prolongation, a patentee must make out a *prima facie* title to his patent privilege, by giving in evidence his patent and an office or examined copy of the enrolment of his specification as already mentioned; (g) and if he is an assignee, he must complete the proof of his title by giving in evidence the assignment or assignments under which he claims a right to the privilege granted by the patent. (h) So, if any disclaimer or memorandum of alteration has been filed and enrolled, an office or examined copy of the enrolment must be given in evidence. (i)

The petitioner must also, in support of his petition for an extension, make out a *prima facie* case respecting the validity of the patent. (k) He must [*567] therefore show that *the invention was new at the date of the patent, which will be sufficient (the specification being in evidence) not only to prove the novelty of the invention, but also that the patentee was the inventor. (l) The utility of the invention must also be proved, and (as it will be shown presently) in the most satisfactory manner. And general evidence must be given respecting the sufficiency of the specification.

The petitioner must also make out a strong case for the continuance of his patent privilege, (m) the granting of the prayer of the petition being any thing

(c) Wright's patent, 1 Webs. R. 561; Galloway's patent, Ibid. 725.

(e) Vide *in re Jones's patent*, 1 Webs. R. 578.

(f) See Baron Heurteloup's case, 1 Webs. R. 553; and Well's case *re Westrupp and Gibbin's patent*, 1 Webs. R. 554, stated *ante*, pp. 201 and 202.

(g) *Ante*, p. 567.

(k) *In re Wright's patent*, 1 Webs. R. 561; and *in re Galloway's patent*, 1 Webs. R. 724.

(l) See *in re Galloway's patent*, 1 Webs. R. 724.

(h) See *in re Erard's patent*, 1 Webs. R. 557, n. (a); *in re Wright's patent*, Ibid. 561.

(i) See the reason of this explained, *ante*, p. 443.

(m) *In re Erard's patent*, 1 Webs. R. 557.

but a matter of course in any case, (l) and the jurisdiction of the Judicial Committee is only to be exercised on special grounds to be alleged and proved in each particular case. (m)

In order to make out a sufficient case for the prolongation of a patent, the petitioner must show, *firstly*, great, or at least some very considerable merit on the part of the patentee and party applying,—*secondly*, that the public has derived or will derive some material benefit from the invention, and, *thirdly*, that the patentee, or his assignee, has not been sufficiently rewarded by means of the first grant, for the benefit which he has conferred upon the public. The length of the additional term which the Privy Council may recommend the Crown to grant, will in every instance depend upon the strength of the case which the petitioner makes out as to each of the three particulars which have been mentioned.

(1) *Merit of the Patentee or Assignee.*

Merit in the patentee is required, because the consideration for the grant of privilege contained in the patent must move from the grantee; (n) and the object of the patent law is, that patent privileges should be granted to reward those who first give useful inventions to the public, and to encourage others, by the hope of obtaining similar rewards, to confer similar benefits upon the public. (o)

And in order to determine the amount or extent of reward which ought to be given in any particular case, it is essential to consider the [*568] degree of merit belonging to the patentee. (p)

In order to ascertain the personal merits of the patentee, it is necessary to consider whether he was an actual inventor, or only imported a knowledge of the invention from abroad, an actual inventor being of course a much more meritorious person than an importer. Thus in *re Soame's* patent (q) in the Privy Council, Lord Brougham said, "The merit of an importer is less than of an inventor. We are now sitting judicially, and it is an argument against the patent, that it (the invention) was imported, and not invented. I do not say it takes away the merit, but it makes it much smaller." And in the same case, Lord Campbell said, "I should say, sitting here, if it (the invention) had been published in a foreign journal, considering whether the patent should be prolonged, I should be influenced by what I saw published in a foreign journal, without inquiring whether it was known in England; though when sitting in a court of justice, and considering the validity of the patent, I should require that it should be known in England."

If the patentee is an actual inventor, his personal merit will depend upon the skill and ingenuity which he has shown in making his invention, and the labour and expense which he has bestowed in bringing it to perfection, and rendering it useful and valuable to the public.

In the case of *Whitehouse's* patent, (r) Lord Brougham, in delivering the judgment of the Privy Council in favour of a prolongation of the patent, relied much upon the great merit of the inventor. So also in *re Downton's* patent (s)

(l) *Li re Morgan's* patent, 1 Weba. R. 737.

(m) Per Lord Brougham, in *re Jones's* patent, 1 Weba. R. 579.

(n) Vide *ante*, p. 23.

(o) Vide Chap. III. *ante*, p. 19.

(p) See in *re Whitehouse's* patent, 1 Weba. R. 473; *re Russell's* patent, 3 Moore, P. C. C. 496; in *re Downton's* patent, 1 Weba. R. 565; and in *re Morgan's* patent, 1 Weba. R. 737.

(q) 1 Weba. R. 739.

(r) *Ibid.* 477.

(s) *Ibid.* 565.

in the Privy Council, the great ingenuity of the patentee was considered by their Lordships as one great reason for a prolongation.

The utility of the invention to the public, is of course one great criterion in judging of the merit of a patentee, and if his merit is not very considerable, the Privy Council will not recommend a prolongation of the patent. Thus [*569] *in re Morgan's patent*, (s) Lord Brougham said, in delivering the judgment of the Privy Council, "Their Lordships do not consider that this invention is entirely without merit, but it seems of a very moderate degree, being the substitution of the chemical process of washing with sulphuric acid for the scaling process by fire, making a cheaper and somewhat better article. It is not without merit, at the same time it cannot be said to be of great merit—merit which would lead their Lordships to strain much in favour of the inventor." And a prolongation was refused. (t)

There were doubts in the profession respecting the power to grant a prolongation to an assignee, (u) but notwithstanding such doubts, the Privy Council, in several instances, recommended the grant of extensions to assignees, (x) and, in one case, (y) a prolongation was granted to an administratrix. All doubt on this subject has, however, been obviated by the statute 7 & 8 Vict. c. 69, s. 4. (z)

Upon a petition by the assignee of a patent, the Privy Council will consider the assignee as representing the merit of the patentee and inventor, and will recommend the grant of an extension to an assignee although Parliament would not have granted such an extension. (a)

Thus *in re Galloway's patent*, (b) Lord Brougham stated that the Judicial Committee thought it for the benefit of patentees that the assignee should represent the whole merit of the inventor. And *in re Morgan's patent*, (c) his Lordship said, in delivering the judgment of the Privy Council, "When application is made to their Lordships for the extension of a patent term, (that is to say, of a monopoly under letters patent,) by assignees to whom the interest of the patentee has been parted with, and in whom it is vested, their Lordships have always been used to consider that by taking into their [*570] view, and favourably listening to the application of an assignee, they are, though not directly, yet mediately, and consequentially, as it were, giving a benefit to the inventor, because if the assignee is not remunerated at all, it might be said that the chance of the patentee of making an advantageous conveyance to the assignee, would be materially diminished, and consequently, his interest damnified. For this reason, consideration has been given to the claims of the assignee who has an interest in the patent."

And the Privy Council will not only consider an assignee as representing the patentee, but will also take into consideration the personal merit of the assignee himself, and his claim to be further rewarded. Thus *in re Whitehouse's patent*, (d) in which Mr. Russell, the assignee, was applying for a prolongation of a patent, Lord Brougham said, in delivering the judgment of the Privy

(s) 1 Webs. R. 737.

(t) See *in re Woodcroft's patent*, 3 Mo. P. C. C. 171.

(u) See the observations of Lord Brougham, *in re Galloway's patent*, 1 Webs. R. 725; *case of Spilsbury v. Clough*, 2 Q. B. 466, and *ante*, pp. 149 and 205.

(x) *Whitehouse's patent*, 1 Webs. R. 473; *S. C. nom. re Russell's patent*, 2 Moore, Cases, 496; *Southworth's patent*, 1 Webs. R. 486; *Wright's patent*, *ibid.* 561; *his patent*, *ibid.* 577; *Galloway's patent*, *ibid.* 724; and *Soames's patent*, *ibid.* 729.

(y) *Downton's patent*, 1 Webs. R. 565.

(z) *Vide ante*, p. 149, and see the Statute in the Appendix, Chap. I. s. 1.

(a) *In re Soames's patent*, 1 Webs. R. 729.

(b) 1 Webs. R. 724.

(c) *Ibid.* 737.

(d) 1 Webs. R. 473.

Council in favour of the application, "Their Lordships have taken into account Mr. Russell's merit in patronizing the ingenious and deserving author of this invention, in expending money till he was enabled to complete this invention, and in liberally supplying the funds which were requisite for the purpose of carrying the invention into execution."

If the patentee himself has no great merit or claim to be rewarded, the Privy Council will investigate the claims of the assignee, and if the assignee has not some very considerable merit or claim to be rewarded by the public, their Lordships will, of course, refuse to recommend any extension of the patent. (e)

(2) *Utility of the Invention.*

It has been shown in former parts of this work, (f) that it is sufficient if an invention possesses some degree of utility in order to make it the subject of a valid patent privilege, and that a patent is not void on the ground of a deficiency of public utility in the invention, unless there is a total absence of it. (g)

*At the time when a patent is granted it would be difficult, and [*571] in many cases it would be impossible, to ascertain the degree of benefit which an invention will confer upon the public; and, therefore it is that patents are granted without much, if any inquiry into the utility of the inventions for which they are obtained; and because (according to the language of the Attorney General's Report) it is entirely at the hazard of the patentee whether the invention is new, or will have the desired success; and because it is reasonable for her Majesty "to encourage all arts and inventions which may be for the public good." (h)

A patentee, therefore, takes a grant, knowing it to be entirely at his own risk; and if the merit of his invention is so small that the patent produces him little or no profit, he has no claim upon the public; he has had all that he bargained for, all that he had any right to expect, and the public ought not to be inconvenienced by the continuance of a monopoly of an invention, which, although itself of small utility, yet may be of some importance as a component part of some other art or invention.

It has been shown that the object of the patent law is by the grant of patent privileges to encourage ingenious persons to benefit the public by new and useful inventions; and it is the policy of the excellent statute (which the public owe to Lord *Brougham*) to hold out further encouragement, by additional rewards to the patentees of useful inventions, who have not already been sufficiently recompensed by their patents; the reward in every case being an extension of the patent term in proportion to the merit of the applicant, the utility of the invention, and the want of prior remuneration.

The grant of a patent privilege is made by the Crown on behalf of the public, (i) the consideration for which is the public utility of the invention comprised in it, (k) and this applies to a patent for a prolongation as well as to an original patent.

It is very fit and proper to grant patents in the first instance *at [*572] the risk of the public receiving very small consideration for some

(e) Vide *in re Morgan's patent*, 1 *Webs. R.* 737.

(f) Vide *ante*, pp. 3 and 133.

(g) *Ibid.* pp. 3 and 137.

(h) The recital in a patent also shows the intent of the Crown in making the grant to be "to encourage all arts and inventions which may be for the public good." Vide *ante*, pp. 47, 48, 517, and the *Forms of Report and Patent*, in the *Appendix*, Chap. II. s. 1.

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

(k) *Ibid.* p. 132, 133.

of the grants; for, if a contrary course were adopted, the community would run some risk of losing the benefit of really useful inventions, or what would be nearly as bad, delaying the publication of them to the world.

But when an invention has once been published, and by the inventor's own act dedicated to the public, after the expiration of a patent, there is no reason for prolonging the patent privilege, if it is not shown that the inventor confers some substantial benefit upon the public; for, if such an invention really does benefit the public, the patentee can have no difficulty in proving the fact after he has had the advantage of a fourteen years' monopoly, and the opportunity of ascertaining whether he has produced any thing the public requires.

In order to obtain the prolongation of a patent, therefore, it is necessary that the petitioner should prove to the satisfaction of the Privy Council, that the invention comprised in the patent has given some considerable benefit to the public as consideration for the new grant, as an equivalent for the inconvenience which must result from the continuance of the patent privilege. And in all the cases of applications for prolongations which have been made, the Judicial Committee has required the utility of the invention to be satisfactorily proved, and has refused to grant extensions in those cases in which the public have not received some considerable benefit.

In *Erard's* case, (l) Lord *Lyndhurst* said, in delivering the judgment of the Privy Council, upon an application for the prolongation of a patent, "In cases of this kind we expect a very strong case of hardship, as well as a strong case upon the utility of the invention." So in *re Downton's* patent, (m) upon an application to extend a patent, it was laid down by the Privy Council that the questions were, "is it a useful invention; is it beneficial to the public; is it an invention of that character which would lead us to interpose; is there ingenuity in the invention, and has the party been remunerated." (n)

[*573] It is no objection to the claim of a patentee for a prolongation that improvements have been made upon his invention, if the invention itself, which is comprised in the patent, was itself at the date of the patent really useful and meritorious.

Thus in *re Galloway's* patent, (o) which was an application for the prolongation of a patent for an invention of improvements in machinery for propelling vessels, Lord *Brougham* said, in delivering the judgment of the Privy Council, "Now it appears that improvements were made in the float, such manifest improvements, that no person would after these ever think of persisting in using the invention as it originally stood, but would have recourse to the improvements. That, however, is no reason against the claim of the original inventor; it is only saying that his invention, though useful, has been capable of improvement, and its having been improved, affords no reason for denying him an extension of the patent, if upon other grounds he has merit, and if upon other grounds he is shown not to have reaped a due benefit in proportion to that merit. If such an argument were to prevail, any improvement made by him upon the patent would at once take away the patentee's right to obtain, under whatever circumstances he may come before this Court, a recommendation to have, under the Act of Parliament, an enlargement of the term."

And in *re Soame's* patent, (p) the same law was laid down by Lord *Brougham*.

(l) 1 Webs. R. 557.

(m) Ibid. 565.

(n) See also in *re Wright's* patent, 1 Webs. R. 575; in *re Jones's* patent, 1 Webs. R. 577; in *re Galloway's* patent, *ibid.* 724.

(o) 1 Webs. R. 734.

(p) Ibid. 734.

It is evident, indeed, that it is rather to the advantage of the public to hold out inducements to patentees to improve their inventions, and to grant more liberal extensions in cases where inventors have, by improvements, made their inventions of greater utility and value to the public.

And no argument can or ought to prevail against the utility of an invention, by reason of the small step which the patentee made in advance of the previous state of public knowledge respecting the particular art or branch of manufactures to which the invention relates. This was laid down and most lucidly explained by Lord *Brougham*, in delivering the judgment of the Privy Council upon an application for a *prolongation of *Soame's* [*574] patent, (q) in which his Lordship said, "It is very fit their Lordships should guard against the inference being drawn, from the small amount of any step made in improvement, that they are disposed to undervalue that in importance; if a new process is invented, if new machinery is invented, if a new principle is found out and applied so as to become the subject of a patent right, embodied in a manufacture, then, however small it may be in advance of the state of science, or of art previous to the period of that step being made, that is no reason whatever for undervaluing the merits of the person who makes a discovery in science or an invention in art, because the whole history of science, from the greatest discoveries down to the most unimportant—from the discovery of the system of gravitation itself, and the fractional calculus itself, down to the most trifling step that ever has been made, is one continued illustration of the slow progress by which the human mind makes its advance in discovery; it is hardly perceptible, so little has been made by any one step in advance of the former state of things, because generally you find that just before there was something very nearly the same thing discovered or invented. Therefore it is no argument whatever in general, if there is a new principle, or a novel invention, a new process for instance."

(3) *No sufficient reward.*

A patent is granted for the purpose of rewarding an inventor for the benefit which his invention confers upon the public. From many causes over which patentees have no control, they very frequently suffer great loss, or fail to acquire such an amount of remuneration as it is just and expedient that they should receive; even when their inventions are very meritorious and most valuable to the public. (r)

The object of the statute 5 & 6 Will. IV. c. 83, s. 4, was to enable the Crown, with the advice of the Privy Council, to prolong patent rights, as rewards to patentees, in cases where they possess great merit, and have not been sufficiently recompensed by means of the grant contained in the first patent.

*The want of a sufficient amount of recompense or reward [*575] arising from the exercise of the privilege granted by the first patent, is therefore in every case essentially necessary, in order to bring an applicant for a prolongation within the meaning of the statute, (s) and a petitioner must prove, to the satisfaction of the Privy Council, that he has not been sufficiently remunerated.

(q) 1 Webs. R. 735.

(r) *Vide ante*, pp. 145, 146.

(s) *In re Soame's patent*, 1 Webs. R. 733; *in re Kay's patent*, *ibid.* 571.

Every case laid before the Privy Council will be thoroughly investigated, (f) and if a meritorious petitioner is able to satisfy their Lordships that he has not received any sufficient recompense, such an extension of the patent will be recommended—as in the judgment of their Lordships will meet the justice of the case. (u)

In cases in which it has been shown that meritorious patentees have received no remuneration, or have suffered a loss, extensions have generally been recommended for the full period of seven years, authorized to be granted under the 5 & 6 Will. IV. c. 83, s. 4. (x)

In other cases their Lordships have recommended extensions for various additional terms, according to the particular degree of merit of each petitioner, and the extent to which he has already been remunerated. (y)

But when it appears that a patentee, or his assignee, has received as much remuneration as he deserves, (z) or that the patent has not been productive of remuneration, in consequence of the gross negligence on the part of the patentee, (a) the Privy Council will not report in favour of a prolongation.

The power of prolonging a patent privilege was enlarged by the statute 7 & 8 Vict. c. 69, s. 2, which recites that, "It is expedient for the further encouragement of inventions *in the useful arts, to enable the time of monopoly [*576] in patents to be extended in cases in which it can satisfactorily be shown that the expense of the invention hath been greater than the time now limited by law will suffice to reimburse:" and enacts, "That if any person having obtained a patent for any invention, shall before the expiration thereof present a petition to her Majesty in Council, setting forth that he has been unable to obtain a due remuneration for his expense and labour in perfecting such invention, and that an exclusive right of using and vending the same for the further period of seven years, in addition to the term in such patent mentioned, will not suffice for his reimbursement and remuneration, then if the matter of such petition shall be by her Majesty referred to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same after the manner and in the usual course of its proceedings touching patents, and if the said Committee shall be of opinion and shall so report to her Majesty, that a further period greater than seven years' extension of the said patent term ought to be granted to the petitioner, it shall be lawful for her Majesty, if she shall so think fit, to grant an extension thereof for any time not exceeding fourteen years, in like manner and subject to the same rules as the extension for a term not exceeding seven years, is now granted under the powers of the said act of the sixth year of the reign of his late Majesty." (b)

And by section 4 of the act it is enacted, that nothing therein contained, shall prevent the Judicial Committee from reporting that an extension for any period not exceeding seven years should be granted, or prevent her Majesty from granting an extension for such lesser term than the petition shall have prayed. The object of this statute as shown by the recital, is to provide the means

(f) See *in re Swaine's patent*, 1 Webs. R. 559.

(u) See the various cases reported in the first vol. of Mr. Webster's Reports.

(x) See *in re Stafford's patent*, 1 Webs. R. 563; *in re Kollman's patent*, *ibid.* 564; *in re Robert's patent*, *ibid.* 573; *in re Wright's patent*, *ibid.* 575; *in re Jones's patent*, *ibid.* 577; and *in re Wright's patent*, *ibid.* 736.

(y) See *in re Southworth's patent*, 1 Webs. R. 486; *in re Downton's patent*, 1 Webs. R. 565; *in re Kay's patent*, *ibid.* 668; S. C. 3. Moore's P. C. C. 24; *in re Galloway's patent*, 1 Webs. R. 724; and *in re Soame's patent*, *ibid.* 729.

(z) See *in re Morgan's patent*, 1 Webs. R. 737; *in re Quarrill's patent*, *ibid.* 740.

(a) See *in re Minister's patent*, 1 Webs. R. 721.

(b) The stat. 5 & 6 Will. IV. c. 83, which is previously recited.

of rewarding meritorious inventors in cases where prolongations for seven years would be sufficient for that purpose.

In order to obtain a prolongation under this statute, the petition must allege that an extension for seven years would *be insufficient to remunerate him, and pray for the grant of an additional term of fourteen [*577] years.

The petitioner must also show to the satisfaction of their Lordships, that a prolongation would not be sufficient to remunerate him for his expenses and labour in perfecting his invention.

Although the proceeding before the Judicial Committee to obtain the prolongation of a patent, is substituted for an application to Parliament for an act, yet the provisions of the statutes 5 & 6 Will. IV. c. 83, and 7 & 8 Vict. c. 69, s. 2, were intended to apply to some cases in which acts of prolongation could not have been obtained.

This is clearly explained by Lord *Brougham* in giving the judgment of the Judicial Committee upon a petition for the prolongation of *Soames'* patent, (c) in which his Lordship said, "their Lordships have always considered that it was with the view of affording a better remedy, not only cheaper and easier, but better in this respect, that there might be cases which never would have prevailed on the legislature to make a new personal law prolonging a monopoly, which, nevertheless might seem meritorious enough in respect of the individual, beneficial enough in respect of the public, and deficient enough in remuneration to justify interference; which, nevertheless, had they been presented in the form of a petition to Parliament would have failed to procure an act."

A person who has entered a caveat against the prolongation of a patent, is entitled (if he gives a sufficient notice of his objections) to dispute the petitioner's claim, and to disprove any part of the case which is laid before the Privy Council in support of the petition.

Thus an opposing party may give evidence to show that the patentee was destitute of merit, that the invention was of no use to the public, or that the patentee has been sufficiently rewarded, or failed to obtain a sufficient recompense only in consequence of his own gross negligence.

So also it may be shown in opposition to such an application that the patent is clearly void, either for want of novelty or utility in the invention, or for any other cause.

*But the Privy Council will assume a patent to be good until the contrary be shown, either by the judgment of a Court of Law or [*578] Equity, or by some other proof which can leave no doubt on the subject. If a patent is clearly void, the Privy Council will not recommend Her Majesty to make another void grant, but their Lordships will not take upon themselves the office of a Court of Law or Equity to investigate the legality of a patent, and in all doubtful cases they will leave the legal objections to a patent to be determined by those Courts. (d)

The Privy Council will in some cases where an assignee is applying for an extension, grant the prayer of a petition upon the terms that some further reward be given to the patentee.

Thus, in *re Whitehouse's* patent, (e) the Privy Council granted an extension to Mr. Russell, the assignee of the patent, upon condition that he secured to Mr. Whitehouse the payment of 500*l.* per annum, during the further term which was granted.

(c) 1 Webs. R. 734.

(d) See in *re Kay's* patent, 1 Webs. 568; S. C. 3 Moore, P. C. Cases, 24.

(e) 1 Webs. R. 568; S. C. *nom. re Russell's* patent, 2 Moore, P. C. Cases, 496.

So also the Privy Council will take care that licensees are not unfairly prejudiced by a prolongation, (f) and if a petitioner has not made terms with a licensee, the licensee may oppose the grant of an extension.

The Judicial Committee adopts rules of evidence as nearly as possible resembling those which prevail in our Courts of Law, (g) and a petitioner must prove all facts necessary to support his petition to the satisfaction of their Lordships. No admission made by a party opposing the petition will dispense with any necessary proof, for their Lordships are bound to protect the interests of the public. (h)

For the purpose of proving the insufficiency or want of remuneration, the petitioner's original account books must be produced, and an accountant must be called who has examined them, and can state the actual amount of profit and loss arising from the exercise of the patent. And a balance sheet ought to [*579] be produced showing the actual receipts and expenditure *of the patentee as well as the balance of profit or loss. The Privy Council will require the most satisfactory evidence upon this part of a petitioner's case which is so essential to entitle him to the extension he is seeking to obtain. (i)

By section 7 of the statute 3 & 4 Will. IV. c. 41, it is enacted, "That it shall be lawful for the said Judicial Committee in any matter which shall be referred to such committee to examine witnesses by word of mouth, (and either before or after examination by deposition) or to direct that the depositions of any witness shall be taken in writing by the Registrar of the said Privy Council to be appointed by his Majesty as hereinafter-mentioned, or by such other person or persons, and in such manner, order, and course as his Majesty in Council, or the said Judicial Committee shall appoint and direct; and that the said Registrar, and such other person or persons so to be appointed, shall have the same powers as are now possessed by an examiner of the High Court of Chancery, or of any Court Ecclesiastical."

By section 9 it is enacted, "That every witness who shall be examined in pursuance of this act, shall give his or her evidence upon oath, or if a Quaker or Moravian, upon solemn affirmation, which oath and affirmation respectively shall be administered by the said Judicial Committee and Registrar, and by such other person or persons as his Majesty in Council, or the said Judicial Committee shall appoint; and that every such witness who shall wilfully swear or affirm falsely shall be deemed guilty of perjury, and shall be punished accordingly."

By section 19 it is enacted, "That it shall be lawful for the President for the time being of the said Privy Council to require the attendance of any witnesses, and the production of any deeds, evidences, or writings, by writ to be issued by such President in such and the same form, or as nearly as may be, as that in which a writ of *subpoena ad testificandum*, or of *subpoena duces tecum*, is now issued by his Majesty's Court of King's Bench, at Westminster; and that every person disobeying any such writ so to be issued by the said [*580] President, shall be considered as in contempt of the said Judicial Committee, *and shall also be liable to such and the same penalties and consequences as if such writ had issued out of the said Court of King's Bench, and may be sued for such penalties in the said Court."

(f) Upon this subject, vide *ante*, p. 148.

(g) See *in re Erard's patent*, 1 Webs. R. 557, n. (a).

(h) See *in re Soame's patent*, 1 Webs. R. 732.

(i) Vide *in re Quattrill's patent*, 1 Webs. R. 740; and *in re Swaine's patent*, *ibid.* 560, n. (a).

By section 11, after reciting that by the statutes of 13 Geo. III. c. 63, and 1 Will. IV. c. 22, certain powers are given to certain courts therein mentioned to enforce, and provisions are made for the examination of witnesses upon interrogatories and otherwise; it is enacted, "That all the powers and provisions contained in the two last-mentioned acts, or either of them, shall extend to and be exercised by the said Judicial Committee, in all respects as if such committee had been therein named as one of His Majesty's Courts of Law at Westminster."

Under this section of the act, the Judicial Committee may order witnesses to be examined before the Registrar, or issue commissions for the examination of witnesses, and such examinations may be upon interrogatories or otherwise. (k)

By section 15 it is enacted that the costs incurred in the prosecution of any appeal or matter referred to the said Judicial Committee, and of such issues as the same committee shall under this act direct, shall be paid by such party or parties, person or persons, and be taxed by the aforesaid Registrar, or such other person or persons to be appointed by his Majesty in Council, or the said Judicial Committee, and in such manner as the said committee shall direct."

Under this enactment the Judicial Committee has power to compel a party petitioning or opposing a petition to pay costs to his opponent. Thus *in re Mackintosh's patent*, (l) the petitioner having abandoned his application for a prolongation, the Privy Council ordered him to pay the opposing parties their costs. *In re Downton's patent*, (m) an opposing party was ordered to pay the petitioner the extra costs occasioned by the opposition. And *in re Westrupp and Gibbon's patent*, (n) a petition for the confirmation of a patent being opposed, was dismissed with costs. And in the case just cited, Lord Lyndhurst said, "My opinion on the subject of costs is this: if a party entitled to oppose does come and oppose, and opposes successfully, if we do not give costs, we shall discourage persons coming to protect the interests of the public. We have the power to give costs in any matter referred to us, and sitting here as a Judicial Committee, we can give costs under the general act, (o) not under the patent act." (p) And in the same case their Lordships refused to allow evidence to be given as to costs after the close of the case.

The costs to be paid in pursuance of an order of the Privy Council are generally taxed by the clerk of appeals; but the Council may direct the costs to be taxed by any other officer.

By section 17, it is enacted, "That it shall be lawful for the said committee to refer any matters to be examined and reported on to the aforesaid Registrar, or to such other person or persons as shall be appointed by his Majesty in Council, or by the said Judicial Committee, in the same manner and for the like purposes as matters are referred by the Court of Chancery to a Master of the said Court; and that for the purposes of this act, the said Registrar and the said person or persons so to be appointed, shall have the same powers and authorities as are now possessed by a Master in Chancery."

If the Privy Council refuses to report in favour of the prayer of a petition, whether for a confirmation or prolongation, a report is unnecessary, and none will be prepared.

When the Privy Council has determined to report to the Crown in favour of a confirmation or prolongation, a report is accordingly drawn up by the clerk

(k) See the provisions of the act, 1 Will. IV. c. 22.

(l) 1 Webs. R. 739, n.

(m) 1 Webs. R. 567.

(n) Ibid. 556.

(o) 3 & 4 Will. IV. c. 41, s. 15.

(p) 5 & 6 Will. IV. c. 83.

of appeals, stating that the Judicial Committee recommend the prayer of the petition to be granted; and if the petition be for a prolongation, also stating the additional term which her Majesty is advised to grant to the petitioner, and the conditions (if any) upon which the new grant is to be made. (*q*)

The report when prepared will be approved of by the Queen in Council, at the first meeting of the Privy Council after the matter of the petition has been [*582] heard; and the order in Council *made thereupon (*r*) will then be delivered to the petitioner's solicitor to be taken to the Office of the Secretary of State for the Home Department, to procure the Queen's warrant for a patent in pursuance of the recommendation of the Privy Council.

Upon a report of the Privy Council in favour of a confirmation (if by a new patent) or prolongation, a warrant will be prepared reciting the facts stated in the report, and commanding the Attorney or Solicitor General to prepare a bill for the intended patent by which the confirmation or prolongation is to be granted. This warrant is prepared at the Home Office, and is signed by her Majesty, and countersigned by the Secretary of State, in the same way as a warrant for an ordinary patent. (*s*)

The warrant will be delivered to the petitioner, his solicitor, or agent, at the Home Office, and it must then be taken to the Patent Bill Office, in order that the bill and two transcripts may be prepared.

It is unnecessary here to describe the subsequent proceedings for obtaining the patent, they are the same as the proceeding in ordinary cases which have already been detailed. (*t*)

(*q*) The cost of the report is 1*l.* 10*s.*

(*r*) The cost of the order in Council is 3*l.* 2*s.* 6*d.*

(*s*) The cost of the warrant is the same as in other cases.

(*t*) Vide Section 1 of this Chapter, *ante*, p. 519.

APPENDIX.

CHAPTER II.

[655]

FORMS AND ENTRIES.

[Chapter I. and Sections 1, 2 and 3 of Chapter II., not being applicable to the practice in the United States, are omitted.]

SECT. IV.—*Forms of Entries and Proceedings in Actions for Infringements of Patents.*

V.—*Forms of Proceedings in suits in Chancery to restrain Infringements of Patents.*

VI.—*Forms of Entries and Proceedings in qui tam Actions for Penalties under 5 & 6 Will. IV. c. 83, s. 7.*

VII.—*Forms of Entries and Proceedings in Actions of Scire Facias for Cancelling and Repealing Letters Patents.*

VIII.—*Forms of Assignments of Patents and Licenses to use Patent Inventions.*

SECTION IV.

Forms of Entries and Proceedings in Actions for Infringements of Patents.

In the Queen's Bench [Common Pleas, or Exchequer of Pleas.]

The [*first*] day of [*November,*] in the year of our Lord [*one thousand eight hundred and forty-five.*] (g)

No. 1. MIDDLESEX (h) to wit [*John Moore,*] (the plaintiff in this suit,) by [*Anthony Boucher,*] his attorney, complains of [*John Smith,*] (the defendant in this suit,) who has been summoned to answer the plaintiff in an action on the case.

For that whereas, heretofore, and before, and at the time of making of the letters patent hereinafter [in this count] mentioned, and before the time of the committing of the several grievances hereinafter mentioned, to wit, on the [*first*] day of [*January,*] in the year of our Lord [1844,] the plaintiff [or one Richard Thompson,] was the true and first inventor (i) of [*a certain*

(g) Vide ante, Chap. X. s. 2, p. 253.

(h) The venue is transitory and the plaintiff may lay it in any county he pleases, and the defendant cannot change it. See Cameron v. Gray, 6 T. R. 363; Dav. P. C. 230, 8. C. Brunton v. White, 7 D. & R. 103.

(i) If the patentee was an importer of the invention this allegation must be varied accordingly.

improvement or certain improvements in the mechanism of time-keepers,] and therefore our Lady the now Queen, [or his late Majesty King William the Fourth,] heretofore and before the commencement of this suit, and before the committing of the several grievances hereafter mentioned, to wit, on the said [first] day of [January,] in the year of our Lord [1844,] [or on the day and year last aforesaid,] by her [or his] letters patent under the Great Seal of the United Kingdom of Great Britain and Ireland, (k) bearing date at Westminster a certain day and year therein mentioned, to wit, the [first] day of [*656] [January,] in the [seventh] year of the reign of our said Lady the now *Queen, [or of his said late Majesty,] (and which said letters patent sealed with the Great Seal of the said United Kingdom, the plaintiff now brings into Court and shows to the Court here, the date whereof is a certain day and year therein mentioned, to wit, the day and year last aforesaid,) reciting (l) that the plaintiff [or the said R. T.] had by his petition humbly represented unto her said Majesty, [or his said late Majesty,] that he had invented [“a certain improvement or certain improvements in the mechanism of time-keepers,”] which the petitioner conceived would be of great public utility, that he was the first and true inventor thereof, and that the same had not been practised or used before in this kingdom by any other person or persons to the best of his knowledge and belief, the petitioner therefore most humbly prayed that her said Majesty, [or his said late Majesty,] would be graciously pleased to grant unto him, his executors, administrators, and assigns, her said Majesty's [or his said late Majesty's] royal letters patent under her [or his] Great Seal of the United Kingdom of Great Britain and Ireland, for the sole use, benefit, and advantage of his said invention, within that part of the said United Kingdom called England, her dominion of Wales, and town of Berwick-upon-Tweed, [and in the islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all her said Majesty's colonies and plantations abroad,] for the term of fourteen years, pursuant to the statute in that case made and provided. And that her said Majesty, [or his said late Majesty,] being willing to give encouragement to all arts and inventions which might be for the public good, was graciously pleased to condescend to the petitioner's request, her said Majesty, [or his said late Majesty,] of her [or his] special grace, certain knowledge and mere motion, thereby gave and granted, and by the said letters patent for herself [or himself,] her [or his] heirs and successors, did give and grant unto the plaintiff, [or the said R. T.,] his executors, administrators, and assigns, her said Majesty's [or his said late Majesty's] license, full power, sole privilege, and authority, that he the plaintiff, [or the said R. T.] his executors, administrators, and assigns, and every of them by himself and themselves, or by his and their deputy, or deputies, servants, or agents, or such others as he the plaintiff [or the said R. T.] his executors, administrators, or 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 expressed, should and lawfully might make, use, exercise, and vend his said invention within that part of her said Majesty's [or his late Majesty's] United Kingdom of Great Britain and Ireland, called England, her Majesty's [or his said late Majesty's] dominion of Wales, and town of Berwick-upon-Tweed, [and in the islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all her said Majesty's, [or his said late Majesty's] plantations and colonies abroad,] [*657] in such manner as to him the plaintiff, [or the said R. T.] his executors, administrators, *and assigns, or any of them should in

(k) Vide ante, p. 258; and see R. v. Yandell, 4 T. R. 521.

(l) This recital must, of course, be made to agree with that contained in the patent.

his or their discretions seem meet, and that he the plaintiff, [or the said R. T.,] his executors, administrators, and assigns, should and lawfully might have and enjoy the whole profit, benefit, commodity, and advantage from time to time coming, growing, accruing, and arising, by reason of the said invention, for and during the term of years therein mentioned, to have, hold, exercise, and enjoy the said license, powers, privileges, and advantages thereinbefore granted, or mentioned to be granted unto the plaintiff, [or the said R. T.,] his executors, administrators, and assigns, for and during, and unto the full end and term of fourteen years from the date of the said letters patent next and immediately ensuing, and fully to be complete and ended according to the statute in such case made and provided, and to the end that he the plaintiff, [or the said R. T.,] his executors, administrators, and assigns, and every of them, might have and enjoy the full benefit and the sole use and exercise of the said invention according to her said Majesty's [or his said late Majesty's] gracious intention thereinbefore declared, her said Majesty, [or his said late Majesty] did by the said letters patent for herself [or himself,] her [or his] heirs and successors, require and strictly command all and every person and persons, bodies politic and corporate, and all other her said Majesty's [or his said late Majesty's] subjects whatsoever of what estate, quality, degree, manner, or condition soever they were, within that said part of her said Majesty's [or his said late Majesty's] United Kingdom of Great Britain and Ireland, called England, her said Majesty's [or his said late Majesty's] dominion of Wales, and town of Berwick-upon-Tweed, [and in the said islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all her said Majesty's [or his said late Majesty's] colonies and plantations abroad aforesaid,] that neither they nor any of them at any time during the continuation of the said term of fourteen years thereby granted, either directly or indirectly, should make, use, or put in practice the said invention, or any part of the same so attained unto by the plaintiff [or the said R. T.] as aforesaid, nor in anywise counterfeit, imitate, or resemble the same, nor should make, or cause to be made, any addition thereunto, or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, deviser or devisors thereof, without the license, consent, or agreement of the plaintiff, [or the said R. T.,] his executors, administrators, or assigns, in writing under his or their hands and seals, first had and obtained in that behalf upon such pains and penalties as could or might be justly inflicted on such offenders for their contempt of that her said Majesty's [or his said late Majesty's] royal command, and further to be answerable to the plaintiff, [or the said R. T.,] his executors, administrators, and assigns, according to law, for his and their damages thereby occasioned. And moreover, her said Majesty, [or his said late Majesty,] by the said letters patent for herself [or himself,] her [or his] heirs and successors, willed and commanded all and singular the justices of the peace, mayors, sheriffs, bailiffs, constables, headboroughs, and all other officers and ministers whatsoever, of herself [or himself,] her [or his] heirs and successors for the [*658] time being, that they or any of them did not, nor should at any time thereafter during the said term thereby granted, in anywise molest, trouble, or hinder the plaintiff, [or the said R. T.,] his executors, administrators, or assigns, or any of them, or his or their deputies, servants, or agents, in or about the due and lawful use or exercise of the aforesaid invention, or any thing relating thereto. And in which said letters patent (amongst other things) was and is contained a certain proviso whereby it was declared that in case the plaintiff [or the said R. T.,] should not particularly describe and ascertain the nature of his 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 her said Majesty's [or his said late Majesty's] High Court of

Chancery within [six] calendar months next and immediately after the date of those letters patent, that then and in that case the said letters patent, and all liberties and advantages whatsoever thereby granted, should utterly cease, determine, and become void, any thing thereinbefore contained to the contrary thereof in anywise notwithstanding. And lastly, her said Majesty, [or his said late Majesty,] did by the said letters patent, for herself [or himself,] her [or his] heirs and successors, grant unto the plaintiff, [or the said R. T.,] his executors, administrators, and assigns, that the said letters patent, or the enrolment or exemplification thereof should be in and by all things good, firm, valid, sufficient, and effectual in the law according to the true intent and meaning thereof, and should be taken, construed, and adjudged in the most favourable and beneficial sense, for the best advantage of the plaintiff, [or the said R. T.,] his executors, administrators, and assigns, as well in all her said Majesty's [or his said late Majesty's] Courts of record as elsewhere, and by all and singular the officers and ministers whatsoever of her said Majesty, [or of his said late Majesty,] her [or his] heirs and successors, in that part of her said Majesty's [or his said late Majesty's] United Kingdom of Great Britain and Ireland, called England, her said Majesty's [or his said late Majesty's] dominion of Wales and town of Berwick-upon-Tweed, [and in the islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all her said Majesty's [or his said late Majesty's] colonies and plantations abroad aforesaid,] and amongst all and every the subjects of her said Majesty, [or his said late Majesty,] her [or his] heirs and successors whatsoever and wheresoever, notwithstanding the not full and certain describing the nature or quality of the said invention, or of the materials thereto conducing and belonging: as by the said letters patent now produced and shown forth to the Court here under the said Great Seal of the said United Kingdom, reference being thereunto had, will (amongst other things) more fully and at large appear. And the plaintiff further saith, that he, the plaintiff, [or the said R. T.,] afterwards to wit, on the [first] day of [July,] in the year of our Lord [1844,] in pursuance of the said proviso in that behalf in the said letters patent expressed and contained, by an instrument in writing, to wit, a specification under his hand and seal, did [*659] particularly describe and ascertain *the nature of his said invention, and in what manner the same was to be performed, and did afterwards and within [six] calendar months next and immediately after the date of the said letters patent, (to wit,) on the [first] day of [July] in the year of our Lord [1844,] cause the said instrument in writing, to wit, the said specification, to be enrolled in her said Majesty's, [or in his said late Majesty's] High Court of Chancery, as by the enrolment of the said instrument in writing, to wit, the said specification, now remaining of record in the said High Court of Chancery more fully and at large appears.

[And the plaintiff further saith, that the said [R. T.] after the making of the said letters patent, and before the committing of the several grievances by the defendants hereinafter mentioned, and before the commencement of this suit, to wit, on the [first] day of [August,] in the year of our Lord [1844,] by an indenture then made between the said [R. T.] of the one part, and the plaintiff, [or X. Y.] of the other part, (which said indenture, sealed with the seal of the said [R. T.] he, the plaintiff now brings here into Court, the date whereof is the day and year last aforesaid,) for the considerations therein mentioned, he, the said [R. T.,] did assign [(m) one moiety, or one-third part (as the case may be) of and in] the said letters patent, and the liberties and

(m) These words are to be inserted when the assignment comprises only a portion of the patent privilege.

privileges thereby granted unto the plaintiff [or the said X. Y.] his executors, administrators, and assigns, for the residue of the said term of fourteen years, as and for his and their own sole and absolute property, as by the said indenture reference being thereunto had, will amongst other things more fully and at large appear.]

(n) [And the plaintiff further says, that after the making of the said indenture, and before the committing of the several grievances by the defendant hereinafter mentioned, and before the commencement of this suit, to wit, on the [tenth] day of [October,] in the year of our Lord [1844,] by a certain other indenture then made between the said [X. Y.] of the one part, and the plaintiff [or A. Z.] of the other part, &c. (Here state the second assignment in the same way as the first.)]

And the plaintiff further says, that [(o) the said [R. T.] always from the time of the making of the said letters patent until the time of the making of the said indenture of assignment [firstly, hereinbefore mentioned] by himself, his servants, or agents in that behalf, and by virtue, and in exercise of the said sole privilege so granted by the said letters patent as aforesaid, worked, used, exercised, and put in practice the said invention, *and made divers [*660] large quantities and numbers of articles and things according to and [*660] by means of the said invention, and sold and vended such articles and things to his great benefit, advantage, and profit; and the said [X. Y.] always from the time of the making of the said indenture, [firstly, hereinbefore mentioned] until the time of the making of the said indenture [secondly, hereinbefore mentioned,] by himself, his servants, or agents, in that behalf, and by virtue, and in exercise of the said sole privilege so granted by the said letters patent as aforesaid, worked, used, and put in practice the said invention, and made divers large quantities and numbers of articles and things according and by means of the said invention, and sold and vended such articles and things to his great benefit, advantage, and profit; and that] he the plaintiff, (p) hath always, from the time of the making of the said letters patent [or of the said indenture of assignment lastly hereinbefore mentioned] hitherto and to the time of the commencement of this suit, by himself, his servants, or agents in that behalf, and by virtue and in exercise of the said sole privilege so granted by the said letters patent, as aforesaid, worked, used, exercised, and put in practice the said invention, and made divers large quantities and numbers of articles and things according to and by means of the said invention, and sold and vended such articles and things to his great benefit, advantage, and profit. YET the defendant, well knowing the premises, but contriving and wrongfully and injuriously intending to injure the plaintiff, and to deprive him of the profits, benefits, and advantages which he might and otherwise would have derived, and acquired from the working, using, exercising, and putting in practice the said invention, and from the making, selling, and vending of such articles and things as aforesaid, after the making of the said letters patent [and of the said (last-mentioned) indenture of assignment] and within the said term of years in the said letters patent mentioned, and before the commencement of this suit, to wit, on the

(n) If there be any other assignments under which the plaintiff or any one of the plaintiffs claims, they must be stated here.

(o) When the action is brought by an assignee it is usual to allege that the former possessors of the patent exercised the exclusive privilege to their benefit and advantage; but it seems to be sufficient to allege that the plaintiff has exercised the privilege for his own profit.

(p) The object of this allegation is to show that the plaintiff has been injured by the invasion of his privilege, and that the patent does not merely confer a bare right of no utility or benefit to the plaintiff.

[*first*] day of [*January,*] in the year of our Lord [1845,] and on divers other days and times between that day and the commencement of this suit, within that part of the United Kingdom of Great Britain and Ireland, called England, unlawfully, unjustly, and injuriously, and without the leave, license, consent, or agreement of the plaintiff [*or of the plaintiff or of the said R. T.,*](*q*) and against the will of the plaintiff, did work, use, exercise, and put in practice the said invention and divers, to wit, [*fifty*] parts of the said invention, in breach of the said letters patent, and against the said sole privilege thereby granted unto the plaintiff [*or the said R. T.*] his executors, administrators, and assigns, as aforesaid, whereby the plaintiff hath been and is greatly injured, [**861*] and hath lost and been deprived of divers great *gains, profits, and advantages which he might and otherwise would have derived and acquired from the said invention and privilege.

And the plaintiff further says, that the defendant well knowing the several premises aforesaid, but farther contriving and intending as aforesaid after the making of the said letters patent, [and of the said last-mentioned indenture,] and within the said term of years in the said letters patent mentioned, and before the commencement of this suit, to wit, on the [*first*] day of [*January,*] in the year of our Lord [1845] aforesaid, [*or on the day and year last aforesaid,*] and on divers other days and times between that day and the commencement of this suit in England aforesaid, unlawfully, unjustly, and injuriously, and without the leave, license, consent, or agreement of the plaintiff, [*or of the plaintiff or the said R. T.,*](*r*) and against the will of the plaintiff* made, manufactured, and fabricated divers, to wit, [*one thousand Clocks, one thousand parts of Clocks, one thousand Watches, one thousand parts of Watches, one thousand Chronometers, one thousand parts of Chronometers, one thousand Time-keepers, and one thousand parts of Time-keepers:—or, one thousand Steam Engines, one thousand Stocking Looms, one thousand Braiding Machines, ten thousand yards of Cloth, ten thousand pairs of Gloves, &c., according to the nature of the invention,*] according to and by means of the said invention, and in breach of the said letters patent, and against the said sole privilege thereby granted to the plaintiff, [*or the said R. T.*] his executors, administrators, and assigns as aforesaid, whereby the plaintiff has been and is greatly injured, and hath lost and been deprived of divers great gains, profits, and advantages which he might and otherwise would have derived and acquired from the said invention and privilege.

And the plaintiff further says, that the defendant well knowing, &c. [*commencement as in the second breach down to the**] sold, vended, and put off divers, to wit, [*one thousand Clocks, &c.:—describe the articles in the same manner as in the second breach, ante,*] in breach of the said letters patent, and against the said sole privilege, &c. [*Conclude as in the second breach.*]

And the plaintiff further says, &c., [*commencement as in the second breach down to the**] did counterfeit, imitate, and resemble the said invention, and divers, to wit, [*fifty*] parts thereof, in breach of the said letters patent, &c. [*Conclude as in second breach.*]

And the plaintiff further says, &c., [*Commencement as in the second breach to the**] did make, and also cause and procure to be made, divers, to wit, [*one hundred*] additions to, and divers, to wit, [*fifty*] subtractions from the said invention, and from divers, to wit, [*one hundred and fifty*] parts thereof, whereby to pretend, and whereby the defendant did in fact pretend himself to

(*q*) The declaration ought to negative a license by any person in whom the patent right appears by the declaration to have been vested.

(*r*) Negative a license by any former proprietor of the patent right as well as the plaintiff.

be the inventor and devisor thereof, in breach of the said letters patent, &c. [Conclusion as in the second breach, ante.]

And the plaintiff further says, &c., [commencement as in the second breach to the] did make, manufacture, and fabricate, sell, [*662] and vend, and did cause, and procure to be made, manufactured, and fabricated, sold and vended divers, to wit, [one thousand Clocks, &c.:—describe the articles in the same way as in the second breach, ante,] and divers, to wit, [one thousand parts of Clocks, &c.:—describe the articles as before,] which were intended to counterfeit, imitate, and resemble and which did in fact counterfeit, imitate, and resemble the said invention, and divers, to wit, [fifty] parts thereof, in breach of the said letters patent, &c. [Conclusion as in the second breach.]

And the plaintiff further says, &c., [commencement as before.] did make, manufacture, and fabricate, sell, and vend, and did cause and procure to be made, manufactured, and fabricated, sold, and vended divers, to wit, [one thousand Clocks, &c.] and divers, to wit, [one thousand parts of Clocks, &c.] which were intended to counterfeit, imitate, and resemble, and which did in fact counterfeit, imitate, and resemble divers, to wit, [one thousand Clocks, &c.,] and divers, to wit, [one thousand parts of Clocks, &c.,] made, manufactured, and fabricated, according to, and by means of the said invention, and divers, to wit, [one thousand] parts thereof in breach of the said letters patent, &c. [Conclude as in the second breach.]

To the damage of the plaintiff of [£10,000,] and thereupon he brings his suit, &c.

IN THE QUEEN'S BENCH.

The [ninth] day of [December,] &c.
No. 2. DURHAM, (s) (to wit,) [Anthony Barber,] the plaintiff in this suit, &c. [Commencement as in the last form, ante, p. 655.]

For that whereas our Lady the now Queen, before the commencement of this suit, and before the committing of the grievances by the defendant hereinafter mentioned, to wit, on the [first] day of [September,] in the [fourth] year of her reign, (being in the year of our Lord 1840,) by her letters patent under her Great Seal of the United Kingdom of Great Britain and Ireland, (and which said letters patent sealed with the said Great Seal, the plaintiff now brings into Court, and shows to the Court, here, the date whereof is a certain day and year therein mentioned, to wit, the day and year last aforesaid,) did give and grant unto the plaintiff her said Majesty's especial license, full power sole privilege and authority, that he the plaintiff, his executors, administrators and assigns, or such others as he or they should at any time agree with, and no others, from time to time, and at all times during the term of years therein expressed, to wit, the term of fourteen years, should and lawfully might make, use, exercise, and vend within England, Wales, and the town of Berwick-upon-Tweed, [the islands of Jersey, Guernsey, Alderney, Sark, and Man, and *also all her said Majesty's colonies and plantations abroad,] [*663] an invention of [improvements in machinery for manufacturing Elastic Fabrics,] provided that the said plaintiff should cause a particular description of the nature of the said invention, and in what manner the same was to be performed, 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 letters patent. And her said Majesty did by the said letters patent require and strictly command all and every person and persons, bodies politic and cor-

(s) The venue is transitory. Vide ante, p. 655, n. (h).

porate, and all her subjects whatsoever within that part of the United Kingdom of Great Britain and Ireland, called England, her dominion of Wales, and town of Berwick-upon-Tweed, [the said islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all her said Majesty's said colonies and plantations abroad,] that neither they nor any of them at any time during the continuance of the term thereby granted, either directly or indirectly, should make, use, or put in practice the said invention, or any part of the same, nor in anywise counterfeit, imitate, or resemble the same, nor make, or cause to be made, any addition thereto or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, deviser or devisors thereof, without the license, consent, or agreement of the plaintiff, his executors, administrators, or assigns, in writing under his or their hands and seals first had and obtained in that behalf as by the said letters patent under the said Great Seal now shown to the Court here, reference being thereunto had, will among other things more fully and at large appear. And the plaintiff further saith, that he did afterwards, to wit, on the [first] day of [March,] in the year of our Lord [1841,] and within [six] calendar months next and immediately after the date of the said letters patent, in pursuance of the said proviso, and of the said letters patent, by an instrument in writing under his hand and seal, particularly describe the nature of the said invention, and in what manner the same was to be performed, and did also on the day and year last aforesaid, and within [six] calendar months next and immediately after the date of the said letters patent, cause the same instrument in writing under his hand and seal to be enrolled in her said Majesty's High Court of Chancery at Westminster, in the county of Middlesex, as by the said enrolment of the said instrument in writing, now remaining of record in the said High Court of Chancery, will amongst other things more fully and at large appear. AND the plaintiff saith that he hath always from the time of the granting of the said letters patent, and in exercise of the said privilege so thereby granted as aforesaid, worked, used, exercised, and put in practice the said invention, and made and manufactured articles and things by means of the same invention, and vended and sold such articles and things as he the plaintiff by means of the said letters patent was so entitled to do as aforesaid. YET the defendants well knowing the premises, but contriving, and wrongfully, and injuriously intending to injure the plaintiff, and to deprive him of the profits, benefits, and advantages which he might and otherwise would have derived and acquired from the working, *using, [*664] exercising, and putting in practice of the said invention, and from the making and vending of such articles and things as aforesaid, after the making of the said letters patent, and within the said term of years in the said letters patent mentioned, to wit, on the [twentieth] day of [June,] in the year of our Lord [1842,] and on divers other days and times between that day and the commencement of this suit, and within that part of the said United Kingdom called England, wrongfully and unjustly without the leave or license, and against the will of the plaintiff, did work, use, exercise, and put in practice the said invention, and divers, to wit, [one hundred] parts thereof, in breach of the said letters patent, and of the said privilege thereby granted as aforesaid.

And the plaintiff further says, that the defendant, well knowing the several premises aforesaid, but further contriving and intending, as aforesaid, after the making of the said letters patent, and within the said term of years therein mentioned, to wit, on the day and year last aforesaid, and on divers other days and times between that day and the commencement of this suit in England aforesaid, wrongfully and unjustly, and without the leave or license of the plaintiff, and against his will, * did make, manufacture, and fabricate divers, to wit, [500 Machines,] and divers, to wit, [500 parts of Machines,] according to

and by means of the said invention, and in breach of the said letters patent, and of the said privilege thereby granted as aforesaid.

And the plaintiff further says, &c., [*commencement as in the second breach to the **] did sell and vend divers, to wit, [500 Machines,] and divers, to wit, [500 parts of Machines,] in breach of the said letters patent, and of the said privilege thereby granted as aforesaid.

And the plaintiff further says, &c., [*commencement as before,*] did make, manufacture, and fabricate, sell, and vend divers, to wit, [500 Machines,] and divers, to wit, [500 parts of Machines,] which were intended to imitate, counterfeit, and resemble, and which did in fact imitate, counterfeit, and resemble the said invention, and divers, to wit, [fifty] parts thereof, in breach of the said letters patent, and of the said privilege thereby granted as aforesaid.

And whereas also heretofore, and before, and at the time, &c. [*The residue of the count will be the same as in the preceding forms describing the patent as, certain other letters patent, &c.*]

To the damage of the plaintiff of [£10,000,] and therefore he brings his suit, &c.

*IN THE QUEEN'S BENCH [OR COMMON PLEAS, OR EXCHEQUER [*665] OF PLEAS.]

THE [first] day of [November] in the year of our Lord, [one thousand eight hundred and forty-five.]

[Smith] } No. 3. AND the defendant, by [Richard Roe] his attorney,
ats. } [craves oyer of the said Indenture in the declaration mentioned,
[Jones.] } which is read to the defendant in these words, "This Indenture,
&c." (the deed, or so much of it as may be necessary for the defendant's
purpose must be stated,) which being read and heard, the defendant,] says
that, &c. [*Here state the defence intended to be made by the plea.*] (t)

No. 4. AND for a further plea in this behalf the defendant says that, &c. [*Here state the matter of defence intended to be made by the plea.*]

No. 5. AND, &c., [*commencement as in form No. 3 or No. 4,*] says that her said Majesty [or his said late Majesty] did not [*by the said supposed letters patent in the declaration (or the said first count) mentioned*] give and grant unto the plaintiff, [or unto the said John Harris,] her [or his] said Majesty's especial license, full power, sole privilege, and authority that he, the plaintiff, [or the said R. T.,] his executors, administrators, and assigns, or such others as he or they should at any time agree with, and no others, from time to time and at all times thereafter, during the said term of years in the declaration [or the said first count] mentioned, should, and lawfully might, make, use, exercise and vend the said supposed invention in the declaration [or the said first count] mentioned, [and not disclaimed as in the declaration (or that count) mentioned,] in manner and form as in the declaration in that behalf alleged. And of this the defendant puts himself upon the country, &c.

No. 6. AND, &c. [*commencement as in form No. 3 or No. 4,*] says, that her said Majesty [or his said late Majesty] did not by her [or his] said supposed letters patent in the declaration [or the said first count] mentioned, make such gift and grant of license, power, sole privilege and authority as in the declara-

(t) Vide ante, p. 262, respecting oyer of a patent.

tion [or the said *first count*] mentioned, unto the plaintiff, [or the said *John Harris,*] his executors, administrators, and assigns, in manner and form as in the declaration [or the said *first count*] in that behalf above alleged. And of this the defendant puts himself upon the country, &c.

No. 7. AND, &c. [commencement as in form No. 3 or No. 4,] says, that [*666] the said supposed letters patent in the declaration mentioned were and are *certain letters patent in the words and of the tenor following, (that is to say,) Victoria, by the grace of God, of the United Kingdom, &c. [Here set out the whole of the patent.] Without this that her said Majesty [or his said late Majesty] did, by the said letters patent, give and grant unto the plaintiff, [or the said *John Harris,*] his executors, administrators, and assigns, &c. [The remainder of the plea may be the same as in either of the last two forms.]

No. 8. AND for a further plea in this behalf the defendant says, that the said [John Harris] did not assign [transfer and set over] the said supposed letters patent in the declaration [or in the said *first count*] mentioned, [and all the liberties, privileges, profits, benefits, and advantages thereby granted,] unto him the plaintiff, his executors, administrators, and assigns, in manner and form as the plaintiff hath thereof above in the declaration [or the said *first count*] in that behalf alleged. And of this the defendant puts himself upon the country, &c.

No. 9. AND for a further plea in this behalf the defendant says, that the plaintiff [or the said *John Harris*] was not the true and first inventor of the said supposed invention in the [*first count* of the] declaration mentioned [and not disclaimed as in the declaration (or the said *first count*) mentioned,] in manner and form as the plaintiff hath above in the declaration [or the said *first count*] in that behalf alleged. And of this the defendant puts himself upon the country, &c. (a)

No. 10. AND for a further plea in this behalf the defendant says, that the plaintiff [or the said *John Harris*] was not the true and first inventor of the said supposed invention in the [*first count* of the] declaration mentioned, [and not disclaimed as in the declaration (or the said *first count*) mentioned,] whereby, and by reason, and means whereof, the said supposed letters patent in the declaration [or the said *first count*] mentioned, and the said supposed gift and grant of privilege in the declaration [or the said *first count*] alleged to be thereby made, were and are null and void and of none effect. And this the defendant is ready to verify, &c. (b)

No. 11. AND for a further plea in this behalf the defendant says, that the [*667] said supposed invention in the declaration [or the said *first count*] mentioned *[and not disclaimed as in the declaration (or that count,)]

(a) This is the proper form of plea to adopt, when it is alleged in the declaration that the patentee was the true and first inventor. But when the declaration contains no such allegation, the next form of plea must be adopted.

(b) When the declaration does not contain any averment that the patentee was the true and first inventor, the proper form of plea is (as here given) to allege that he was not the true and first inventor, and that by reason thereof, the patent is void, concluding with a verification.

mentioned,] was not an invention of an improvement [in the construction of steam-engines] in manner and form as the plaintiff hath above thereof in the declaration [or in the said first count] in that behalf alleged. And of this the defendant puts himself upon the country, &c. (c)

No. 12. AND for a further plea in this behalf the defendant says, that before the making of the said supposed letters patent in the declaration [or the said first count] mentioned, to wit, on the [third] day of [May] in the year of our Lord, [1844] the plaintiff [or the said John Harris] by his petition in writing [mentioned in the declaration (or the said first count) and] recited in the said supposed letters patent, did represent and suggest unto her said Majesty, that the said supposed invention in the declaration [or the said first count] mentioned [and not disclaimed as in the declaration (or that count) mentioned] was an invention of [“improvements in,” &c.] And the defendant further says, that her said Majesty, believing and confiding in, and also acting and proceeding upon the said representation and suggestion of the plaintiff, [or the said John Harris,] and in pursuance and in consideration thereof, did make the said supposed letters patent, and also the said supposed gift and grant of privilege in the declaration [or the said first count] alleged to have been made by the same supposed letters patent. And the defendant further says, that the said representation and suggestion so made by the plaintiff [or the said John Harris] to her said Majesty, as aforesaid, was false and untrue, and her said Majesty was thereby misinformed and deceived; and that the said supposed invention [in the declaration (or first count) mentioned and not disclaimed as in the declaration (or that count) mentioned] was not an invention of [“improvements in,” &c.] in manner and form as by the plaintiff [or the said John Harris] so falsely and untruly represented and suggested unto her said Majesty, as aforesaid, whereby, and by reason and means whereof the said supposed letters patent, and gift and grant of privilege, in the declaration [or the said first count] mentioned, were and are null, void and of none effect. And this the defendant is ready to verify, &c. (d)

*No. 13. AND for a further plea in this behalf the defendant [*668] says, that the said supposed invention in the declaration [or in the said first count] mentioned [and not disclaimed as in the declaration (or that count) mentioned] was not [and is not] of great use, benefit, and advantage to the public in manner and form as in the declaration [or the said first count] in that behalf alleged. And of this the defendant puts himself upon the country, &c. (e)

(c) When the plaintiff inserts in his declaration any allegation that he had invented improvements of a particular description for which he afterwards obtained a patent, so much of the allegation as relates to the invention being improvements of the description stated may be traversed by a plea in this form.

(d) If the declaration does not set out the recital contained in the patent, and if the patent is not set out upon oyer, the suggestion made to the Crown will not appear upon the record, unless the defendant alleges it in his plea, and therefore the plea must be substantially in the form here given. In the case of *Morgan v. Seaward*, 2 M. & W. 544, the Court of Exchequer intimated an opinion that the ordinary form of plea (see the last form) would be held bad upon special demurrer, and it seems that the ordinary form ought not to be adopted, unless it happens to be a traverse of something actually alleged in the declaration.

(e) This form has sometimes been adopted when the declaration contained an allegation respecting the great utility of the invention. It is, however, very doubtful whether the plea in this form is not bad, unless indeed it appears upon the face of the declaration, that

No. 14. AND for a further plea in this behalf the defendant says, that the said supposed invention in the declaration [or in the said *first* count] mentioned [and not disclaimed as in the declaration (or in that count) mentioned] (f) was not at the time of the making of the said supposed letters patent in the declaration [or the said *first* count] mentioned, of any use, benefit, or advantage whatsoever to the public, whereby, and by reason and means whereof (g) the said supposed letters patent, and the said supposed gift and grant of privilege in the declaration [or the said *first* count] alleged to be made by the same supposed letters patent, were and are null and void and of none effect. And this the defendant is ready to verify, &c. (h)

No. 15. AND for a further plea in this behalf the defendant says that the said supposed invention in the declaration [or in the said *first* count] mentioned [and not disclaimed as in the declaration (or that count) mentioned] was not, at the time of the making of the said supposed letters patent in the declaration [or in the said *first* count] mentioned, a new invention as to the public knowledge, use, and exercise thereof, in manner and form as in the declaration [or in the said *first* count] in that behalf alleged. And of this the defendant puts himself upon the country, &c. (i)

[*669] *No. 16. AND for a further plea in this behalf the defendant says, that the said supposed invention in the declaration [or the said *first* count] mentioned [and not disclaimed as in the declaration (or that count) mentioned] was not, at the time of the making of the said supposed letters patent in the declaration [or the said *first* count] mentioned, a new invention as to the public knowledge, use, and exercise thereof, whereby, and by reason, and means whereof the said supposed letters patent, and the said supposed gift and grant of privileges in the declaration [or the said *first* count] alleged to have been made by the same supposed letters patent, were and are null and void and of none effect. And this the defendant is ready to verify, &c. (j) (k)

No. 17. AND for a further plea in this behalf the defendant says, that the said supposed invention in the declaration [or the said *first* count] mentioned [and not disclaimed as in the declaration (or in that count) mentioned] was not an invention of any manner of manufacture whereby, and by reason and means whereof the said supposed letters patent in the declaration [or the said *first* count] mentioned, and the said supposed gift and grant of privilege in the declaration [or

the patentee made a suggestion to the Crown of which the plea would amount to a traverse. And the reason is, that any degree of utility is sufficient at law, to make an invention the proper subject of a patent privilege, but if it appears that there was any false suggestion made to the Crown respecting the utility, the deceit which has been practised upon the Crown will avoid the patent. See Chap. V. s. 3. *ante*, p. 132.

(f) This seems to be the proper form of plea in every case in which it is intended to make a defence on the ground that the invention is not of any use to the public; and, therefore, not the legal subject of a patent privilege.

(g) This allegation is frequently but improperly omitted, and when omitted it is implied.

(h) The express or implied allegation of the plea that the patent is void, renders a verification necessary.

(i) This form of plea is only proper when it is expressly alleged in the declaration that the invention was new at the date of the patent. If the declaration does not contain such an allegation, the next form of plea ought to be adopted.

(j) This is the proper form of plea when the declaration does not contain any allegation that the invention was new at the date or making of the patent.

(k) Vide *ante*, p. 668. (g) & (h).

the said *first count*] alleged to have been made by the same supposed letters patent, were and are null and void and of none effect. And this the defendant is ready to verify, &c. (*l*)

No. 18. AND for a further plea in this behalf the defendant says, that the said supposed privilege in the declaration [*or the said first count*] mentioned [and not disclaimed as in the declaration (*or in that count*) mentioned] was not and is not a privilege of the sole working or making of any manner of manufacture whereby, and by reason and means whereof the said supposed letters patent, and the said supposed gift and grant of privilege in the declaration [*or the said first count*] alleged to have been made by the same supposed letters patent, were and are null and void and of none effect. And this the defendant is ready to verify, &c. (*m*)

No. 19. AND for a further plea in this behalf the defendant [*670] says, that the *plaintiff [*or the said John Harris*] did not, by the said instrument in writing under his hand and seal, commonly called a specification, and in the declaration [*or the said first count*] mentioned, particularly describe and ascertain the nature of the said supposed invention in the declaration [*or the said first count*] mentioned, [and not disclaimed as in the declaration (*or in that count*) mentioned,] and in what manner the same invention is to be performed in manner and form as in the declaration [*or the said first count*] in that behalf alleged. And of this the defendant puts himself upon the country, &c. (*n*)

No. 20. AND for a further plea in this behalf the defendant says that (*p*) the plaintiff [*or the said John Harris*] did not by any instrument in writing under his hand and seal, particularly describe and ascertain the nature of the said supposed invention in the declaration [*or the said first count*] mentioned [and not disclaimed as in the declaration (*or in that count*) mentioned,] and in what manner the same supposed invention is to be performed, whereby and by reason and means whereof, heretofore and before the commencement of this suit, and also before the committing of the said several supposed grievances in the declaration, [*or the said first count*] mentioned and after the expiration of [*six*] calendar months next and immediately after the date of the said supposed letters patent in the declaration [*or in the said first count*] mentioned, to wit, on the [*second*] day of [*April*] in the year of our Lord [1841,] the said supposed letters patent, and all rights, liberties, privileges, and advantages thereby granted utterly ceased, determined, and became void. And this the defendant is ready to verify, &c. (*o*)

(*l*) It is usual to raise the question whether an invention is of such a description as can legally be made the subject of a patent privilege, by a plea in the form here given. The next form of plea, however, seems to be more correct.

(*m*) This seems to be the proper form of plea for raising the defence that the privilege comprised in the patent is not such a privilege as can be granted within the meaning of the exception contained in the stat. 21 Ja. I. c. 3. s. 6. Vide *ante*, c. 5. s. 1. p. 77.

(*n*) This is the proper form of plea for merely traversing the sufficiency of the specification as alleged in the declaration.

(*o*) If the declaration should happen to contain no allegation respecting the specification which the defendant can traverse, so as to raise such an issue as desired, he ought to adopt this form, unless he intends to set out the specification in the plea.

(*p*) The declaration generally states (more or less fully) the proviso requiring the specification, but if it is not sufficiently stated in the declaration, and the patent is not set out on oyer, the defendant ought to set it out in this plea.

No. 21. AND for a further plea in this behalf the defendant says that the said supposed instrument in writing, under the hand and seal of the plaintiff, [or of the said *John Harris*,] commonly called a specification in the declaration [or in the said *first count*] mentioned, was, and is an instrument in writing [with certain drawings thereunto annexed, and which same instrument in writing was and is (r)] in the words, letters, and figures following, (that is to say,) "TO ALL TO WHOM THESE PRESENTS shall come," &c. [Here set out [*671] *the whole of the specification.*] And a "true copy of which said drawings are hereunto annexed. (s) WITHOUT THIS THAT the plaintiff [or the said *John Harris*] did by the said instrument in writing, under his hand and seal, commonly called a specification, and in the declaration [or the said *first count*] mentioned, particularly describe and ascertain the nature of the said supposed invention in the declaration [or in the said *first count*] mentioned [and not disclaimed as in the declaration (or in the said *first count*) mentioned,] and in what manner the same invention is to be performed in manner and form as the plaintiff hath above in the declaration [or the said *first count*] alleged. And of this the defendant puts himself upon the country, &c. (q)

No. 22. AND for the further plea in this behalf the defendant says that the plaintiff [or the said *John Harris*] did not within [six] calendar months next and immediately after the date of the said supposed letters patent in the declaration [or the said *first count*] mentioned, cause the said supposed instrument in writing, under hand and seal of plaintiff, [or the said *John Harris*] commonly called a specification in the declaration [or the said *first count*] mentioned, to be enrolled in her said Majesty's High Court of Chancery, in manner and form as the plaintiff hath above in the declaration [or the said *first count*] in that behalf alleged. And of this the defendant puts himself upon the country, &c. (t)

No. 23. AND for a further plea in this behalf the defendant says that the plaintiff [or the said *John Harris*] did not within [six] calendar months next and immediately after the date of the said supposed letters patent in the declaration [or the said *first count*] mentioned, cause any instrument in writing, under the hand and seal of the plaintiff [or the said *John Harris*] particularly describing and ascertaining the nature of the said supposed invention in the declaration [or the said *first count*] mentioned, [and not disclaimed as in the declaration (or in the said *first count*) mentioned,] and in what manner the same supposed invention is to be performed, to be enrolled in her said Majesty's High Court of Chancery, whereby and by reason and means whereof, heretofore, and before the commencement of this suit, and also before the committing of the said several supposed grievances in the declaration [or the said *first count*] mentioned, and after the expiration of [six] calendar months next and immediately after the date of the supposed letters patent, to wit, on the [second] [*672] day *of [November] in the year of our Lord [1842.] the said supposed letters patent, and the said supposed license, power,

(q) This is the proper form of plea where it is intended to set out the specification, vide ante, p. 276.

(r) The words between brackets here must be omitted if there are no drawings.

(s) Leave out these words if there are no drawings. But if there is a drawing, a copy must be annexed to the plea.

(t) This is a proper form of plea for traversing the enrolment of the patentee's specification in the manner alleged in the declaration. The next form is, however, that which is most beneficial for the defendant, and that which is most generally adopted.

privilege, and authority in the declaration [or the said *first* count] mentioned, and all other rights, liberties, privileges, and advantages whatsoever granted by the same supposed letters patent, utterly ceased, determined, and became void. And this the defendant is ready to verify, &c. (u)

No. 24. AND for a further plea in this behalf the defendant says, that he is not guilty of the said supposed grievances in the declaration [or the said *first* count] above laid to his charge, or any, or either of them, or any part thereof, in manner and form as the plaintiff hath thereof above in the declaration [or the said *first* count] complained against him, this defendant. And of this the defendant puts himself upon the country, &c.

IN THE QUEEN'S BENCH, [COMMON PLEAS, OR EXCHEQUER OF PLEAS.]

The [*tenth*] day of [*April*,] in the year of our Lord, [1844.]

[*Jones*] } No. 25. AND the plaintiff as to the plea of the defendant by
v. } him [*firstly*] above pleaded;—and whereof he hath put himself
[*Smith*.] } upon the country, doth the like, [or saith that, *here state the mat-
ter of the replication.*]

Sec. 26. AND as to the plea of the defendant by him [*secondly*] above pleaded;—and whereof he hath put himself upon the country, the plaintiff doth the like, [or says that, *here state the matter of the replication.*]

No. 27. AND as to the plea of the defendant by him [*secondly*] above pleaded, the plaintiff says that he the plaintiff, [or the said *John Harris*,] was at the time of the making of the said letters patent in the declaration [or the said *first* count] mentioned, the true and first inventor of the said invention in the declaration [or the said *first* count] mentioned, [and not disclaimed as in the declaration (or in the said *first* count) mentioned.] And this the plaintiff prays may be inquired of by the country, &c. (x)

No. 28. AND as to the plea of the defendant by him [*fourthly*] above pleaded, the plaintiff says that the said representation and suggestion so made to her said Majesty by the plaintiff, [or the said *John Harris*,] as in the said [*fourth*] plea mentioned, was not false and untrue, and her said Majesty was not thereby misinformed and deceived in manner and form as in the said [*fourth*] plea alleged. And this the plaintiff prays may be inquired of by the country, &c. (y)

*No. 29. AND as to the plea of the defendant by him [*secondly*] [*673] above pleaded, the plaintiff says, that the said invention in the declaration, [or in the said *first* count] mentioned, [and not disclaimed as in the declaration (or the said *first* count) mentioned,] was, at the time of the making of the said letters patent in the declaration [or the said *first* count] mentioned,

(u) The effect of this plea is to show that the patent has become void because the patentee has not enrolled any sufficient specification. This is the form of plea usually adopted for traversing the enrolment of a specification.

(x) See the Form of Plea, *ante*, p. 666, No. 10.

(y) See the Form of Plea, *ante*, p. 667, No. 12.

of use, benefit, and advantage to the public. And this the plaintiff prays may be inquired of by the country, &c. (z)

No. 30. AND as to the plea of the defendant by him [*thirdly*] above pleaded, the plaintiff says, that the said invention in the declaration [*or the said first count*] mentioned, [and not disclaimed as in the declaration (*or the said first count*) mentioned,] was, at the time of the making of the said letters patent in the declaration [*or in the said first count*] mentioned, a new invention as to the public knowledge, use, and exercise thereof. And this the plaintiff prays may be inquired of by the country, &c. (a)

No. 31. AND as to the plea of the defendant by him [*thirdly*] above pleaded, the plaintiff says, that the said invention in the declaration [*or in the said second count*] mentioned, [and not disclaimed as in the declaration (*or that count*) mentioned,] was an invention of a certain manner of manufacture, to wit, of the manufacture in the declaration [*or in the said second count*] mentioned. And this the plaintiff prays may be inquired of by the country, &c. (b)

No. 32. AND as to the plea of the defendant by him [*secondly*] above pleaded, the plaintiff says, that the said invention in the declaration [*or in the said first count*] mentioned, [and not disclaimed as in the declaration (*or the said first count*) mentioned,] was an invention of a certain manner of manufacture, to wit, of the manufacture mentioned in the declaration, [*or in the said first count,*] and described by the said instrument in writing, under the hand and seal of the plaintiff, [*or the said John Harris,*] as in the declaration [*or the said first count*] also mentioned. WITHOUT THIS THAT the said invention was not an invention of any manner of manufacture whereby, and by reason and means whereof the said letters patent in the declaration [*or the said first count*] mentioned, were and are null, void, and of none effect in manner and form as in the said [*second*] plea in that behalf above alleged. And this the plaintiff prays may be inquired of by the country, &c. (c)

[*674] No. 33. AND as to the plea of the defendant by him [*fourthly*] above pleaded, the plaintiff says, that the said privilege in the declaration [*or first count*] mentioned, [and not disclaimed as in the declaration (*or first count*) mentioned,] was and is a privilege of the sole working or making of a certain manner of manufacture, to wit, of the manufacture in the declaration [*or in the said first count*] mentioned. And the plaintiff prays may be inquired of by the country, &c. (d)

No. 34. AND as to the plea of the defendant by him [*eighthly*] above pleaded, the plaintiff says, that he the plaintiff [*or the said John Harris,*] did, by a certain instrument in writing, under his hand and seal, to wit, the said instrument in writing under his hand and seal in the declaration mentioned, particularly describe and ascertain the nature of the said invention in the decla-

(z) See the Form of Plea, *ante*, p. 668, No. 14.

(a) See the Form of Plea, *ante*, p. 669, No. 16.

(b) *Ibid.* No. 17.

(c) See the Form of Plea, *ante*, p. 669, No. 17. This form has occasionally been used, but it is doubtful whether a special traverse is applicable. See the last form.

(d) See the Form of Plea, *ante*, p. 669, No. 18.

ration [or in the said *third* count] mentioned, [and not disclaimed as in the declaration [or that count] mentioned,] and in what manner the same invention is to be performed. And this the plaintiff prays may be inquired of by the country, &c. (e)

No. 35. AND as to the plea of the defendant by him [*seventhly*] above pleaded, the plaintiff says that he the plaintiff [or the said *John Harris*,] did within [*six*] calendar months next and immediately after the date of the said letters patent in the declaration [or the said *first* count] mentioned, to wit, on the [*eighth*] day of [*October*,] in the year of our Lord [1844,] by the said instrument in writing under his hand and seal in the declaration [or the said *first* count] mentioned, particularly describe and ascertain the nature of his said invention in the declaration [or the said *first* count] mentioned, [and not disclaimed as in the declaration (or in that count) mentioned,] and in what manner the same invention is to be performed. And did also afterwards and within [*six*] calendar months next and immediately after the date of the said letters patent, (to wit,) on the [*ninth*] day of [*October*,] in the year of our Lord [1844,] [or on the day and year last aforesaid,] cause the said instrument, in writing, to be duly enrolled in her Majesty's High Court of Chancery at Westminster, in manner and form as in the declaration in that behalf above alleged. And this the plaintiff is ready to verify, &c. (f)

The [*first*] day of [*May*,] in the year of our Lord [1844.]
 [Smith] } No. 36. AND the defendant as to the replication of the plaintiff
 ats. } to the plea of the defendant by him [*fourthly*] above pleaded, and
 [Jones.] } which the plaintiff hath prayed may be inquired of by the country,
 doth the like.

*No. 37. AND as to the replication of the plaintiff to the plea [*675] of the defendant by him [*sixthly*] above pleaded, and which the plaintiff hath prayed may be inquired of by the country, the defendant doth the like.

IN THE QUEEN'S BENCH, [COMMON PLEAS, OR EXCHEQUER OF PLEAS.]

Between [*Bryan Donkin*,] plaintiff,

and

[*Robert Anderson*,] defendant.

No. 38. IN pursuance of the statute in such case made and provided, I hereby give you notice of certain objections upon which the defendant means to rely at the trial of this action. And that at the same trial the defendant, besides denying that her Majesty made any such letters patent, gift, grant, or privilege as in the declaration mentioned, and also denying that he has infringed the said supposed letters patent, or committed any of the supposed grievances in the declaration mentioned; will make and insist upon the several objections, matters, and things hereinafter respectively stated or mentioned:—And will object, contend, and insist,

That, &c. [*Here the several objections must be stated according to the circumstances of the case, after which add the following conclusion.*]

(e) See the Form of Plea, *ante*, p. 669, No. 19.

(f) See the Form of Plea, *ante*, p. 671, No. 23.

And that the defendant will also make and insist upon such other defences, and matters of defences, (other than objections to the said letters patent,) as respectively are, or shall, or may be mentioned or referred to in, or as, are, or shall, or may be admissible under all, or any one or more of the several pleas of the defendant in this action. Dated this [*first*] day of [*November,*] one thousand eight hundred and [*forty-four.*]

To

Mr. [*W. H.*]
The plaintiff's attorney.

Yours, &c.,

[*A. B.*]

Defendant's attorney.

[*Commencement and conclusion as in the last form.*]

No. 39. That the writ of Privy Seal, or warrant of our Lady the Queen, upon, or by virtue of which, the Lord High Chancellor caused to be made the said supposed letters patent, was delivered to the said Lord High Chancellor in Chancery on the [*nineteenth*] day of [*January,*] in the year of our Lord [*one thousand eight hundred and forty-four,*] and was entered of record in Chancery of the said day of the said delivery thereof to the said Chancellor. That the said Chancellor caused letters patent to be made upon the said writ or warrant, dated the [*twenty-first*] day of [*April,*] which was in the [*first*] year of the reign of her said Majesty, and long before the day of the said delivery of the said writ or warrant as aforesaid, contrary to the form of the statute in such case made and provided. By reason whereof the said supposed letters patent are void.

[*676] *That the said supposed letters patent are void by reason of the petition of the plaintiff, [*or of A. B.,*] recited in the same letters patent, or by reason of the recital of the said petition in the same letters patent being false in the several particulars respectively mentioned in this notice, or some of them.

That the plaintiff, [*or the said A. B.,*] did not invent the said supposed invention in the said supposed letters patent mentioned.

That the said supposed invention was not communicated to the plaintiff, [*or the said A. B.,*] by a foreigner resident abroad.

That the plaintiff, [*or the said A. B.,*] was not at the time of the making of the said supposed letters patent the true and first inventor of the said supposed invention.

That the said supposed invention was not invented or found out by the plaintiff, [*or the said A. B.*]

That the said supposed invention was not an invention of improvements in, &c. [*Here use the other words of the title or such of them as with the word improvements form the false representation.*]

That the said supposed invention was not applicable, &c. [*Here use such of the words of the title as may be necessary to show the false representation, as "in the manufacture of ribbons."*]

That the said privilege was not a privilege of working or making any manner of manufacture.

That the said supposed invention was not an invention of any manner of manufacture.

That the said supposed invention was not at the time of the making of the said supposed letters patent an invention of a new manufacture.

That the said supposed invention was not at the time of the making of the said supposed letters patent a new invention as to the public knowledge, use, and exercise thereof.

That the said supposed invention at the time of the making of the said supposed letters patent was of no use, benefit, or advantage to the public.

That the said supposed invention was and is so trifling, worthless, or immaterial, that it was not, and is not proper or sufficient to be made the subject of such a gift or grant of privilege as in the declaration mentioned.

That the plaintiff, [or the said *A. B.*,] did not by the said specification or instrument in writing under his hand and seal in the declaration mentioned, particularly and sufficiently describe and ascertain the nature of the said supposed invention, and in what manner the same supposed invention was and is to be performed.

That the plaintiff, [or the said *A. B.*,] did not by the said specification sufficiently distinguish and point out which of the [machinery parts and things] therein mentioned, he claimed to have invented, and which of the said [machinery parts and things,] he did not claim to have invented or admitted to be old.

That the plaintiff, [or the said *A. B.*,] has not, in pursuance of the proviso or condition in that behalf contained in the said supposed letters patent, caused any specification or instrument in writing under the hand *and seal [*677] of the plaintiff, [or the said *A. B.*,] particularly and sufficiently describing and ascertaining the nature of the said supposed invention, and in what manner the same was and is to be performed, to be duly enrolled in Chancery.

CERTIFICATES.

No. 40. I hereby certify, that this action was really brought to try a right besides the mere right to recover damages for the grievances for which the action has been brought. Dated this [fifth] day of [December, 1845.] (g)
(Signed) [Denman.]

No. 41. I hereby certify, that the validity of the within-mentioned letters patent came in question before me at the trial of this action. Dated this [nineteenth] day of [December, 1845.] (h)
(Signed) [N. C. Tindal.]

No. 42. I hereby certify, that this action was really brought to try a right, besides the mere right to recover damages for the grievances for which the action has been brought. And that the validity of the within-mentioned letters patent came in question before me at the trial of this action. Dated this [eleventh] day of [July, 1845.] (i)
(Signed) [F. Pollock.]

No. 43. I hereby certify, that the record in a certain action wherein [*A. B.*] was plaintiff and [*C. D.*] was defendant, and also the certificate of the Right Honorable [*Lord Denman*,] Chief Justice of our Lady the Queen, thereon indorsed and bearing date the [first] day of [July, 1842] was this

(g) This certificate must, under the stat. 3 & 4 Vict. c. 24, s. 1, be applied for immediately after the conclusion of the trial, for unless then obtained, the judge has no power to grant it afterwards. It must be endorsed on the back of the *nisi prius* record. Vide *ante*, p. 298.

(h) This certificate must be endorsed on the *nisi prius* record. Vide *ante*, p. 300.

(i) This will be found to be the form of certificate most generally useful, for a judge will rarely grant a certificate under one of the statutes and refuse it under the other.

day given in evidence at the trial of this action, between the within-named parties before me. Dated this [twentieth] day of [May, 1845.] (k)
 (Signed) [J. Parke.]

No. 44. I hereby certify, that the plaintiff in this action ought not to have [treble costs, or] any more or other costs than the usual costs taxed as between party and party. Dated this [third] day of [December, 1845.] (l)
 (Signed) [Denman.]

[*678] *No. 45. I hereby certify, that the defendant proved at the trial of this action before the (second, fourth, seventh, and eighth,) objections mentioned in his notice, and that he failed in proving the other objections mentioned in the said notice. Dated this [eighth] day of [December, 1845.] (m)
 (Signed) [J. Patterson.]

SECTION V.

Forms of proceedings in Suits in Chancery, to restrain Infringements of Patents, and for Accounts of Profits lost by means of such Infringements.

IN CHANCERY.

Master of the Rolls,
 [or Vice Chancellor of England,
 _____ Knight Bruce,
 or _____ Wigram.]

To the Right Honorable [John Singleton, Baron Lyndhurst, of Lyndhurst, in the County of Southampton,] Lord High Chancellor of Great Britain. (n)

No. 1. Humbly complaining, sheweth unto your Lordship, your orators [John Brown, of Nottingham, Lace Manufacturer, and Thomas Black, of the same place, Lace Manufacturer.] That before the making of the letters patent hereinafter mentioned, your orators [or A. B. of, &c., and C. D. of &c.] had invented [improvements in the manufacture of Lace,] which your orators [or the said A. B. and C. D.] then believed, and still believe to be, of great public utility. That your orators [or the said A. B. and C. D.] were the true and first inventors thereof, and the same invention had not before

(k) The statute 5 & 6 W. IV. c. 83, s. 3, does not expressly require such a certificate as this, but without such a certificate there would be nothing to show that the record and certificate in the former action had been given in evidence so as to entitle the plaintiff to full costs. Vide ante, p. 300.

(l) This form of certificate is framed under the 5 & 6 W. IV. c. 83, sec. 3, as altered by the 5 & 6 Vict. c. 97, s. 1. By the first-mentioned enactment, a judge trying a second action respecting a patent is enabled to certify that the plaintiff ought not to have treble costs. But the act secondly mentioned takes away treble costs, and gives instead "full and reasonable indemnity as to all costs, charges, and expenses, incurred in or about any action, suit," &c. Vide ante, 300, 304.

(m) Under 5 & 6 W. IV. c. 83, s. 6. (n) Vide ante, p. 309.

or at the time of the making of the said letters patent been publicly known, made, or used, by any other person or persons whomsoever, within this realm, [or was at the time of the making of the said letters patent a new invention, as to the public knowledge and use thereof within this realm.] That by letters patent under the Great Seal of the United Kingdom of Great Britain and Ireland, bearing date at Westminster, the [twenty-first] day of [June,] in the [third] year of the reign of her present Majesty. After reciting that your orators [or the said *A. B. and C. D.*] had, by their petition, humbly represented unto her said Majesty, (as the fact was,) that they had invented (o) [“improvements in the manufacture of Lace”] which *they [*670] believed to be of great public utility, that they were the first and true inventors thereof, and that the same invention had not been made or used by any other person or persons whomsoever, to their knowledge or belief, and that the petitioners therefore most humbly prayed that her said Majesty would be graciously pleased to grant unto them, their executors, administrators, and assigns, her said Majesty’s letters patent, under the Great Seal of the said United Kingdom, for the sole use, benefit, and advantage, of their said invention, within that part of the said United Kingdom called England, the dominion of Wales, and the town of Berwick-upon-Tweed, [and the Islands of Jersey, Guernsey, Alderney, Sark, and Man, and also all her said Majesty’s Colonies and Plantations abroad] for the term of fourteen years, pursuant to the statute in such case made and provided, and that her said Majesty being willing to give encouragement to all arts and inventions which might be for the public good, was graciously pleased to condescend to the petitioner’s request,] her said Majesty did by her said letters patent [of her especial grace, certain knowledge, and mere motion,] for herself, her heirs, and successors, give and grant unto your orators, their executors, administrators, and assigns, her said Majesty’s especial license, sole privilege, and authority, that your orators, [or the said *A. B. and C. D.*] their executors, administrators, and assigns, and every of them, by themselves or by their deputy or deputies, servants, or agents, or such others as your orators, [or the said *A. B. and C. D.*] their executors, administrators, or 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 expressed, should, and lawfully might make, use, exercise, and vend, their said invention within England, Wales, and Berwick-upon-Tweed, [and the islands of Jersey, Guernsey, Alderney, Sark, and Man, and also all her said Majesty’s Colonies and Plantations abroad] in such manner as to your orators, [or the said *A. B. and C. D.*,] their executors, administrators, and assigns, or any of them, should in their or any of their discretions seem meet. And that your orators should and lawfully might have and enjoy the whole profit, benefit, commodity, and advantage from time to time, coming, growing, accruing, and arising by reason of the said invention, for and during the term of years therein mentioned. To have, hold, exercise and enjoy the said license, powers, privileges and advantages, therein-before granted or mentioned to be granted unto your orators, [or the said *A. B. and C. D.*] their executors, administrators, and assigns for and during, and unto the full end and term of fourteen years from the date of the said letters patent, then next and immediately ensuing, and fully to be complete and ended according to the statute in such case made and provided. And to the end that your orators, [or the said *A. B. and C. D.*,] their executors, administrators, and assigns, and every of them might have and enjoy the full benefit, and the sole use and exercise of the said invention, according to her said Majesty’s gracious intention therein-

(o) This allegation must state the recital as it is contained in the patent.