

used; but if no other material is proper than that stated, the grant is void. (*p*)

It is by ignorance of the law that inventors fall into this error, for without such a statement the patentee would be protected; for suppose any other matter could be used instead of the one named, if the purpose was carried out in a similar manner, and the process was not cheaper, or produced a more beneficial result than the mode detailed in the specification, it would be an infringement on the patent right, for it would involve the principle of the invention. If the matter used was evidently an evasion, or what the law calls an evasion, (*q*) the party would be punishable by an action for damages, and an injunction might be obtained against a continuance of the process. After what has been written upon novelty, (*r*) it is almost superfluous to say that to support the patent the invention must be new, or the introduction from abroad (*i.e.* from some place not within her Majesty's dominion) of a new trade or manufacture. (*s*)

Colourable difference in the mode of effecting the object of the patent.

LEGAL CONSTRUCTION.

In enforcing a claim, the patent and specification are taken as one instrument, (*t*) and is construed upon the

Construction of the letters patent.

(*p*) *Crompton v. Ibbotson*, supra.

(*q*) Vide infra, Infringement. (*r*) Supra.

(*s*) *Campion v. Benyon*.—"A patent can only be sustained for a new discovery, and the specification must support the patent; if it do not, the king is deceived, and the patent is void."—Burrough, J. (13.)

"The plaintiff must be nonsuited: the patent is taken out for more than he has discovered. If the specification had stated the patentee claimed no merit to the exclusion of the starch, the patent might have been valid."—Richardson, J. (13.)

(*t*) *Crossley v. Beverley*, *Russell v. Cowling*, *Neilson v. Harford*, supra.

principles of good faith. (u) The description of the invention is of course to be taken from the specification, for its very object is to set out the process by which the invention is to be accomplished. (v) The principle of law is, that the patentee does not claim things which he knows to be in use, unless he makes a distinct claim therefor in the specification, in which case the presumption would be rebutted by the fact. (w)

Interpretation to accord with the state of knowledge.

The interpretation of the terms of a specification must be in accordance with the state of knowledge at the time (x) (it is presumed) of the enrolment of the specification, and not at the time of the grant of the patent, for a patentee is bound to record in the specification all improvements; and if between the grant of the patent and its enrolment any discovery was made which would affect his invention, and it could be traced to his knowledge, he would be bound to specify it. If it was not his actual discovery, he would then state his discovery and the after-discovery, stating, that since his invention a certain matter was discovered (describing it) by which the process could be effected more expeditiously, or in a cheaper mode; as if the patent was for a process of smelting iron by the aid of a chemical compound, and a cheaper means was found out of making the particular compound; if the patentee knew it, he would be bound to specify it, but without claiming the invention.

Construction of patents.

The construction of all written instruments is for the Court, (y) within which rule a specification falls, (z) and should be so read as, consistently with the fair import of the language, to make the claim and the actual discovery co-extensive; (a) and if words be used contrary to their

(u) Neilson v. Harford, supra. (v) Rex v. Arkwright, supra.

(w) Haworth v. Hardcastle, supra.

(x) Cropley v. Beverley, supra. (y) Neilson v. Harford, supra.

(z) Hill v. Thompson, supra. (a) Haworth v. Hardcastle, sup.

usual signification, but the meaning the patentee had in view can be gathered from the specification, it shall be sufficient. (b)

If a particular process, or manufacture, or machine is described, and the specification is silent as to a particular part, or a combination of parts, it shall be presumed the claim is not for such parts. (c)

Silence of a specification as to parts of a machine.

Of the letters patent and the specification the construction is for the Court, but the terms of art and the facts are for the jury.

Facts construed by the jury.

ENROLMENT—AMENDMENT, IN WHAT CASES ALLOWED.

By a condition contained in the letters patent, the patentee has to enrol the specification in the High Court of Chancery within the period therein named. The enrolment is a condition, and if not complied with within the time named, the patent is void. In computing the time, the day of the date of the letters patent is not reckoned. (d) The time is calculated by calendar and not lunar months; so that if a patent bears date as of the first of a month, enrolment on the first of the next month (if the time of the enrolment be within a month) satisfies the condition. (e)

Enrolment.

Computation of the time.

Any mere clerical error may be amended, (f) and when amended, though the amendment be one not in accordance with the statute, it is doubtful if it will, on petition, be expunged; as in a case where, under the 5 & 6 of Wm. 4, c. 83, a patentee had, by the authority of the solicitor-

Master of the Rolls' power to amend.

(b) *Derosne v. Fairlie*, supra.

(c) *Carpenter v. Smith*, supra; *Russell v. Cowley*, supra.

(d) *Watson v. Pearse*, 2 Camp. 294. Vide *Russell v. Ledsam*, 9 Jurist, 557, et supra.

(e) *Derosne v. Fairlie*, supra. (f) *In re Edmund*, R. 41.

general, entered a memorandum of alteration of the enrolment of the specification: and it was alleged, in a petition to expunge the amendment, that it was not according to the provisions of the above statute, as being an extension of the patent, to the prejudice of a subsequent patentee,—the Master of the Rolls (Lord Langdale) refused to grant the petition, being of opinion that he had no jurisdiction, and dismissed it with costs. (g) If the parties who have amended are not living within the jurisdiction of the Court, service upon the party who acted as their agent in obtaining the amendment will be esteemed a service upon the principals; but an affidavit of service of the petition upon the party amending residing in Scotland will not be esteemed a good service. (h) In delivering judgment in the above case, the Master of the Rolls (Lord Langdale) said, “In a case before Lord Gifford, the word ‘fire’ was allowed to be substituted for the word ‘wire.’ (i) In re Redmund (j) an erroneous transposition of numbers was amended, by the order of Sir J. Leach, and who in a subsequent case allowed two errors to be amended, by one of which the word *which* was written instead of *wheel*, and the word *increase* had been written *inverse*. “I have had such cases before me, and where it has been plainly intended to amend mere slips or clerical errors, a strict evidence of the error has been required.”

In order to enable a third party to dispute the validity of the amendment and of the order, it has been directed that the order itself shall be indorsed on the enrolment. (k) In Ruberty’s patent, the specification recited that the patent was granted in October instead of November, which was allowed to be corrected, and in Whitehouse’s patent. (l) The petitions stated that in both

Notice of
amendment.

Amendment
when allowed.

Amendment
and order.

(g) Re Sharpe’s Patent, B. 245.

(i) Whitehouse’s Patent.

(k) In re Sharpe.

(h) Ibid.

(j) 5 Russ. 44.

(l) Supra.

cases proceedings by *scire facias* had been commenced, to repeal the grant, and in *Re Nickel's Patent*, (*m*) where a clerical error had been made in the Queen's warrant, which had been copied in the subsequent steps, the Master of the Rolls, on petition, allowed the amendment; the error consisted in the word *recovering* being used instead of the word *covering*. In this case the petitioner had taken proceedings against a party for infringing his patent, and proceedings by *scire facias* had been commenced to annul the patent.

(*m*) 1 T. & P. 36.

CHAPTER VII.

DISCLAIMER—CONFIRMATION.

Disclaimer,
what.

IN treating of the specification, it has been said, that if a person claims as his invention a something which has been before known to the public, or claims as his inventions several matters, for one of which his patent would be bad, on the ground of the want of novelty, such claim would vitiate his patent, and for which cause the profits of many inventions (some of which were very meritorious) have been lost to the inventors. To aid what appeared to be a defect in the patent laws (for such a claim was often innocently made, from a supposition on the part of the patentee that he was the discoverer) the statute of the 5 & 6 of Wm. 4, c. 83, (*a*) was enacted, and also to confirm patents which would otherwise be void, by a petition to her Majesty in council. (*b*)

5 & 6 Wm. 4,
c. 83, sect. 1.

By consulting the digest of the statute (*c*) it will be seen, the first section sets forth consistently its object, which is, that a person, who in a patent has described himself to be the inventor of certain things, part of which he finds are not new, may, by the permission of the law officers of the Crown, disclaim such or any part thereof; but such disclaimer or alteration must not tend to enlarge the right conferred by the grant. The statute states, that a person who may be the grantee or assignee of a patent, may likewise enter a disclaimer.

Grantee, after
assignment,
right to dis-
claim.

It has been held that the grantee, after he has assigned a

(*a*) Vide stat. supra.

(*b*) Infra.

(*c*) Supra, p. 10.

part of his interest, may enter a disclaimer of any part of the patent. (*d*) Where a patent was originally void, but by the disclaimer of a part, that which would have destroyed it is eradicated, such disclaimer has not a retrospective effect, so as to make a person liable for infringements before the entry of the disclaimer; (*e*) but when the disclaimer

Disclaimer,
effect of.

(*d*) *Spilsbury and Abbot v. Clough and Another*, 2 Gale & David. 17.—Patent for improvements in chloride of lime.—The disclaimer was made by the original patentee, when he had not the entire interest in the patent. “I think he had the right to make such disclaimer under the statute.”—Denman, C.J. (21.)

“I think the word ‘obtained,’ in the statute, applies to the person who obtained the letters patent. I do not understand the words ‘assignee, or otherwise,’ in the first section; in the second it is clear, and I do not see why the word should not have the same meaning in the first section. I think if the grantee had parted with all his interest, he might still enter the disclaimer by permission of attorney or solicitor general.”—Patteson, J. (22.)

It must be by permission, and a caveat may be entered against the disclaimer.—Coleridge, J. (23.)

(*e*) *Perry and Others v. Skinner*, 2 Meeson & Welsby, 471.—Disclaimer under 5 & 6 Wm. 4, c. 83.—“The Act is obscurely worded, but it would be unjust if it made a man who was acting consistently with the law at a certain time, subsequently a wrongdoer by relation: such we cannot presume; and that a man would bring an action, after he had disclaimed, for the infringement of a patent, before such disclaimer was thought of. The intention of the Act was, he should not have the benefit of the disclaimer (475) as to infringements gone by before such disclaimer made.”—Lord Abinger, C.B. (476.) “That a disclaimer shall be deemed and taken to be part of the original letters patent, would be a manifest injustice; the only construction which can be put on the act is, that it shall be deemed and be taken as a part of the letters patent from thenceforth.”—Parke, B. (477.)

Stocker v. Waller and Others, 9 Jurist, 136. — Case for infringement.—Declaration set out that plaintiff was the first inventor of certain improvements in pumps—the grant—enrolment of the specification—before committing the grievances complained of, a disclaimer of a part, &c.—breach. Plea: After said grant, and before enrolment of the disclaimer, a patent was granted to W.B. for an improvement in water-closets, &c., and that the grievance alleged in

is made, it becomes a part of the patent. (*f*) And when a disclaimer, or memorandum of alteration, is entered, the Master of the Rolls has no power to remove it from the records of the Court of Chancery. (*g*)

the declaration was making, &c., in accordance with the patent of W. B. Verification. Demurrer: That it was no answer to an infringement by defendants of the letters patent, that the defendants work under a license from another and subsequent patentee. The points intended to be argued for the plaintiff were, that a license from W. B. could not justify an infringement of the plaintiff's rights; that the plea was bad for argumentativeness and uncertainty, and that it amounted to the general issue. For the defendant: The rights of the plaintiff, if any, date from the entry of the disclaimer and memorandum of alteration, and not from the original grant of the letters patent. That no letters patent were ever granted for the invention of which an infringement is alleged in the declaration. That the declaration was insufficient, and did not shew any cause of action or infraction of the privilege granted to the plaintiff, and that until the entry of the disclaimer, the plaintiff's patent was void. "The plea assumes to be in confession and avoidance. The confession, which I will assume to be good, must amount to an admission of so much of plaintiff's right as remains after the disclaimer; but then there is no sufficient avoidance. It should shew that the plaintiff's patent, as described by the disclaimer, is void in law; there is no express allegation that it is void, unless as arising from the disclaimer or grant to W. B. A disclaimer does not necessarily import the original patent was void, for the object of the statute was not only to enable inventors to set themselves right, when from some cause their patent is void, but to remove doubts and difficulties which hang over the heads of parties bringing actions for infringements. W. B.'s patent was void, as being known to the public by the prior enrolment of the plaintiff's specification. Judgment for plaintiff."—Tindal, C.J. "The true meaning to be given to the first section of the 5 & 6 Wm. 4, c. 83, is that suggested by the Court of Exchequer (*Perry v. Skinner*, 2 M. & W. 471). The effect of that construction is, to hold that from the time of the entry of the disclaimer it shall be taken to be incorporated with the letters patent and the specification, so as to affect all acts done after that period, but it shall not have the effect of making parties wrongdoers by relation."—Cresswell, J.

(*f*) *Clarke and Another v. Kendrick and Another*, 12 M. & W. 221.

(*g*) *Re Sharpe's Patent*, supra.

In the statute a proviso is also made, that against such disclaimer a person may enter a caveat, which will entitle him to the same right of notice as in the case of the entry of a caveat against the issue of any patent for any improvement in a particular branch of manufactures. (*h*)

Caveat against
a disclaimer.

CONFIRMATION.

The second section of the act empowers the Privy Council to confirm any patent which may be issued, if, in their discretion, they deem it proper. On the hearing, satisfactory affidavits must be produced that the party did not know of the prior invention, and also that no proceedings are taken under the patent; proof of publication in an English book, or in a specification, would be fatal. (*i*) But

Confirmation.

(*h*) Vide supra, Caveat.

(*i*) *Westrupp and Gibbin's Patent, Webs. Pat. Ca. 554.*—Application by assignee of patent; petition stated assignment, and that since the date of the assignment it was discovered that part of the process was known to certain persons, but not publicly known; and that the petitioner believes that the same had never been practised before the date of the letters patent, and that no legal proceedings had been taken upon the patent. Petition was confirmed by surviving patentee; application was opposed upon the ground that part of the patent was old, being published in a book many years before. Sir F. Pollock opposed, and said the parties should have disclaimed the old patent, and made the patent good as to the remainder, provided it was new, and produced two specifications, which he alleged were of the invention in question. Lord Lyndhurst said, "he could not conceive that the act was intended to allow of the confirmation of a subsequent patent, adversely to the rights of prior parties, and that the power conferred upon the Council was discretionary." Lord Wyndford: "I apprehend the object of the clause is, if there are any very minute portions which have been used, and the patentee swears he did not know it, in that case the Court would confirm it." The petition was dismissed. On application for costs, Lord Lyndhurst

if the publication is alleged to be a French work, though the work is in England, and it is alleged in the affidavit that the invention is not known in England, such publication will be deemed insufficient to render the patent invalid.

Foreign patent
for a similar
object.

If it was shewn that there was a foreign patent for a similar invention, the Council would, in such a case, confirm the patent, though they would direct a notice to be sent to the foreign patentee. (*j*) Where persons oppose applications of this kind before the Privy Council, if they are successful in their opposition, costs will be given, upon the ground of public policy. (*k*) In both these cases, if the Crown officer requires it, advertisement must be inserted in such papers as he shall direct.

said, "If a person entitled to oppose comes and opposes successfully, if we do not give costs, we should discourage persons coming to protect the interests of the public; the costs are given under the general and not under the patent act."—*Dismissed with costs.*

(*j*) Huerteloupe's Patent, Webs. Pat. Ca. 553.—In this case the petitioner stated of what his patent consisted, and that he was not aware that any other person had invented or used the same improvement; but that since the grant of the letters patent, the patentee had discovered that a patent for a similar contrivance had been obtained in France some time before, but which differed in certain particulars from the invention of the petitioner; and that the said invention was known in England only by the means of books printed and published in France, and thence introduced into England. The petition, and that no suit or action had been commenced, was verified, by affidavit, and also by an affidavit of the keeper of the printed books of the British Museum, which stated that twenty volumes of a French work, containing an account of expired patents, had been read at the Museum, in 1832, one volume of which contained the specification. The Council directed a notice to be sent to the French patentee, and an affidavit of sending such notice through the post was held sufficient. The patent was confirmed.

(*k*) In re Westrup and Gibbin's Patent, *supra*.

CHAPTER VIII.

EXTENSION OF LETTERS PATENT.

BEFORE the passing of the act of Parliament of the 5 & 6 Extension of letters patent. of William 4, c. 83, any extension of the monopoly granted by letters patent was by a bill passed through the Houses of Parliament, which was an inconvenient and most expensive mode. To remedy the inconvenience and lessen the expense in obtaining such extension, it is provided by the above statute, that her Majesty shall be empowered, on the recommendation of a committee of her Majesty's Privy Council, to extend the period of the original grant, which recommendation is obtained by petition.

The parties appear before the Council, by themselves or Practice. agents, and prove their rights, and shew they have not benefited to such an extent as will adequately reward them for the ingenuity and cost of the invention.

In hearing and adjudicating upon petitions for an en- Practice adopted by the Privy Council. largement of the term, the Privy Council are guided, in a great measure, by the rules which were adopted by the House of Lords, when the extension of the time was by bill.

Where the specification is clearly bad, the patent will Specification bad. not be recommended to be extended; for it is necessary to make out a *primâ facie* case of the goodness of the patent. (a) For if a patent which was recommended to be extended, was bad, the vice would extend to the subsequent grant; in such case the extension would be made for the mere pur-

(a) Webs. Pat. Ca. 557, note a.

pose of being vacated, and would only be a source of inconvenience and expense to the patentee. (b)

Proceedings instituted to vacate the patent.

In a case where proceedings were pending for the purpose of vacating a patent, which had nearly expired, and application for an extension was made under the 5 & 6 of Wm. 4, their lordships held that such proceedings were no reason why they should not adjudicate upon the matter; (c) if the application was under the 2 & 3 of Vict. c. 67, (d) it is probable their lordships would wait the event of the proceedings, for the patentee's right would be preserved. The reason of their proceeding in the above case, it is presumed, was, that if they suffered the time of the grant to run out, they would have had no power after that time, and so the adjudication was proceeded with, for the purpose of preserving the patentee's right, and allowing him the benefit of the statute.

Unopposed cases.

In all unopposed cases, it is necessary to give the attor-

(b) *Kay's Patent*, 3 Moore, P. C. R. 24.—Improved machine for preparing and spinning flax.—An objection was made, that the patent was disputed, when it was urged that the patent being near its expiration, unless their lordships adjudicate the right would be gone. Their lordships decided that, the patent being near its expiration, they would proceed, as the prolongation would be of no value, if the Court of Chancery decided against its validity. The usage of the House of Lords has been to grant an extension on the party making out a *prima facie* case, leaving the validity of the patent for the determination of the courts of law.

(c) *Webs. Pat. Ca.* 557, note a.

(d) *Vide supra*, p. 17, for Digest of Stat.

In *Bodmer's Patent*, it was objected by the attorney-general, that their lordships could not entertain the application after the expiration of the letters patent; that prosecuting with effect meant something more than the application by presenting the petition, and obtaining a day to be fixed for the hearing must have taken place, to satisfy the provisions in the statute; the 2 & 3 Vict. c. 67, was framed to alleviate the hardships of this case. Their lordships recommended an extension for three years. (2 M. 471.)

ney-general notice of the hearing, that he may attend to protect the interests of the public, though the practice is for him to attend in all cases, whether they are opposed or not.

In order to obtain the recommendation of the Council, it is necessary, in the first place, to prove the utility of the patent, and also to shew that the patentee has not received any benefit at all adequate to the advantage which has been conferred upon commerce, or society, in consequence of his invention ; and that for several years the patent was rendered useless, either by the necessity of testing the invention, (*e*) by reason of undue and improper oppositions, (*f*)

Recommendation of the Council, how obtained.

(*e*) Erard's Patent, Webs. Pat. Ca. 557.—Improvements in pianofortes, &c.—The extension was prayed on the ground of the difficulty of perfecting the invention, five years having been necessary to instruct the workmen, and which period had elapsed before a single instrument was ready for sale ; and that the outlay in working the patent amounted to 15,000*l.* above the returns. Lord Lyndhurst said, "Upon consideration of the circumstances, the Council would recommend an extension for the term of seven years. In cases of this kind, we expect a very strong case of hardship to be made out, as well as a strong case upon the utility of the invention."

Jones's Patent, Webs. Pat. Ca. 577.—Improvement in wheels for carriages.—The invention had not remunerated the patentee ; that it was a matter of great difficulty to perfect the invention, and that was done only within the last five or six years. Extension for seven years recommended.

Wright's Patent, Webs. Pat. Ca. 561.—Improvement in machines, &c., for purposes of bleaching.—The invention took four years to perfect ; and when the patent was obtained, the patentee was prevented, by bankruptcy and other circumstances, from benefiting thereby ; and that his creditors had reconveyed to him the letters patent. The attorney-general said, he was not aware of any objection, unless that as the patent had not been brought into use, it should be considered as ineffectual, unless the circumstance could be accounted for. Extension for seven years recommended.

(*f*) Robert's Patent, Webs. Pat. Ca. 573.—Improvement to machinery for the purposes of spinning wool, cotton, and other fibrous substances.—The invention has been of great advantage ; that the profits realized did not cover the loss of burning the manufactory,

or by circumstances without the control of the inventor: (*g*) where the patent has not been brought into use, unless a sufficient reason is given, it will be an argument, and a great one, against its utility. (*h*)

supposed to be the act of an incendiary; during the first seven years the patentee got nothing, and during the last three years the invention has been making some return. The term was prolonged for seven years, partly on account of the ingenuity of the contrivance, and partly on account of the peculiar opposition which has been offered.

Stafford's Patent (Webs. Pat. Ca. 563) for improvements in carriages.—The utility of the invention was proved and that the patentee had expended, in his endeavour to introduce the invention, all the money he had, and was greatly embarrassed in consequence, and that the invention had not been productive in consequence of the great opposition which had been made by parties from interested motives. Patent extended seven years.

(*g*) Swaine's Patent, Webs. Pat. Ca. 559.—A method for producing and preserving mineral waters, and the machinery to effect the same.—The ground of the petition was the difficulty of sufficiently making the invention known, and obtaining the public confidence; and that it was not until the last three years the patent had been beneficial to the proprietors, and that much more had been expended in carrying out the object of the patent than had been realized. There was some difficulty as to the evidence: the accounts were produced, but the handwriting of all the entries was not verified. Lord Lyndhurst said, "We are satisfied by reasonable evidence that considerable loss has been sustained, and the period should be enlarged."

(*h*) Sumner's Patent, Webs. Pat. Ca.—Improvement in the manufacturing of cloth, and its application to articles of dress.—No profit had been realized for a long time, and that the profit of the last five or six years had not remunerated the patentee, through opposition, by reports concerning the patent, and vexatious law proceedings. The notice of objections stated the petitioner had compromised the legal proceedings referred to, with a view of prejudicing and deterring other parties known to the petitioner to be infringing the patent, and in consequence of patentee not interfering to stop the infringements, the opponents had embarked a large capital in the manufacturing of the article by steam power; and it was not until the manufacture by steam drove out of the market the manufacture by the loom, that the petitioner amended his patent by disclaimer, with a view to the

If a patent be rendered unproductive in consequence of lowering the duty upon certain articles, and by a fluctuation in trade it becomes again productive, such is not a sufficient reason to warrant the interference of the Council, especially if it is proved that there is any difference in the mode used from that recommended by the specification; or if the improvement is introduced from abroad; (*i*) so it is insufficient to state there has been neither profit nor loss; the actual expenses in conducting the patent must be shewn, and the product therefrom. In this case the applicant was an assignee, who had purchased the patent after the death of the patentee, and his only allegation was, that he had purchased the stock of the patentee, and had lost thereby. (*j*)

Causes deemed insufficient by the Council to recommend an extension.

The Privy Council acknowledge in all cases the rights of assignees of patents, (*k*) and regard their petition in the same light as they would that of the original patentee; (*l*)

Rights of assignees, recognition of.

present application. Sir W. Follett, on the part of the opponent, stated there was but little novelty in the invention, and that as the public were not benefited, where was the general utility? The slow progress of the sale shewed that the invention was but of small utility, and was in itself an answer to the application; and that the petitioner had slumbered on his rights, and allowed and permitted them to be infringed with impunity. Held, an insufficient case was shewn to warrant the recommendation.

(*i*) Woodruf's Patent.—Proof that patent was a very valuable property, but in consequence of the reduction of duty on a certain class of articles, it ceased to be profitable; but after some time it was applied to silk, and it again became profitable, with an improvement. Opposed on the ground that the improvement was introduced from France, by other persons than the petitioner. Application refused.

(*j*) Quarell's Patent for Improvement in Lamps.

(*k*) In re Galloway, Webs. 725.

(*l*) Wright's Patent, Webs. Pat. Ca. 651.—Application by the assignees of the patent for certain combinations and improvements in making pins.—The deeds of purchase, assignment, and partnership were put in, when it was objected they should be proved in the usual manner. It was answered that no notice of such intention was given in the objec-

but when it appears the assignees have been sufficiently remunerated, though the right has been productive but for a short period, the extension will not be recommended. (*m*)

Smallness of the invention.

Application of a simple mechanical process.

In recommending the extension of letters patent, if the subject of the patent be a principle adapted to the purposes of a manufacture, the smallness of the step which led to the result will not influence their lordships; but where the subject of the patent is the mere application of a well-known simple process, which might easily suggest itself to anybody, and which has been employed in respect to other substances, the conclusion will be different, and the difficulty of the process will be a matter which their lordships will consider. (*n*)

tions declared in pursuance of the decisions of the Council. Their lordships intimated that the applicants must make out their title. The application was on the ground of the immense cost of the machinery, and delay in carrying it out in consequence of the ill-faith of the patentee. It was prayed, on the part of the opposers, on their lordships intimating an intention of recommending an extension for five years, that they should be remunerated for the expenses they had been occasioned by their connection with Wright, and that they might be declared entitled to the joint use of the new letters patent. Their lordships said they should recommend the extension of the patent in favour of those in whom the legal estate of the patent was vested, leaving to the opposers and the representatives of a deceased partner any claim they might have in law or equity. New letters patent were granted the assignees for five years.

(*m*) Morgan's Patent (Webs. Pat. Ca. 733), which was an application by the patentee in conjunction with the assignees.—The petition was refused, their lordships being of opinion that the assignees had been sufficiently remunerated, and that the patentee was only a nominal applicant, and that though the invention had merit, it seemed of very moderate degree, and that if they granted an extension of the term in this case, they would have to do so in every other. Refused.

(*n*) Soames's Patent (Webs. Pat. Ca. 729) for a new preparation or manufacturing of certain materials produced from a vegetable substance, and the application thereof to the purposes of affording light,

In cases of opposition, where it arises from jealousy, and is needless—the attorney-general attending to protect the interests of the public—costs of the opposition will be allowed, if it is unsuccessful; (o) so where a petition has

Costs of opposition.

and other purposes.—The petition stated the great utility of the invention, and that a large capital was embarked in the manufacturing of the article, and that the return was considerably less than are the ordinary returns on manufacturing capital. In conclusion, the petition stated, as grounds for the extension, the introduction of a new trade and manufacture, the utility and importance of the invention, and the want of remuneration, from the difficulty experienced by the assignees from circumstances over which they had no control. It was objected, the invention was not new, and that only a very small step was necessary to complete the invention. Lord Brougham: “The merit of an importer is less than that of an inventor, and it is an argument against the patent that it was imported and not invented, and that the public benefit is very much reduced if a thing was known before.” Lord Campbell: “It is overcoming certain difficulties in separating the stearine and ealine oils for which the patent is taken out. Sir T. Wilde contended, that however small the step, it made all the difference between a worthless commodity, and one most valuable.” Lord Brougham in saying the patent would be recommended to be extended in a small degree, said, “It was very fit their lordships should guard against the inference being drawn, from the small amount of any step made in an improvement, that they are disposed to undervalue it in importance, when a new process is found out, and applied so as to become the subject of a patent. However small the advance on the previous knowledge, it is no reason for undervaluing the merits of the discoverer, for the history of science, from the greatest discoveries to the most unimportant, is one continued illustration of the slow progress by which the mind makes its advance in discovery. But such is not the case here, for this is only a new application, which might suggest itself to any person.” Patent extended for three years.

(o) Downton's Patent, Webs. Pat. Ca. 565.—Improvement in water-closets.—Petition stated difficulties arising from want of capital: the opposition was on account of the high rate of charge, and that the patentee would not allow the trade any advantage. The invention was very useful for ships. A lord: “The fact of a great number of the articles being sold, when the cost is more than four times that of the ordinary article, is a proof of its utility.” The proof to

been abandoned, their lordships will grant, on application, costs to the opposing parties. (*p*)

Cause which led to the enactment of the 2 & 3 Vict. c. 67.

In Bodmer's Patent, it was objected that, when the letters patent had expired, their lordships could not, under the statute of William, entertain the petition. This was allowed to be a valid objection, and led to the enactment of the 2 & 3 Vict. c. 67, which saves the right of petitions not adjudicated on before the expiration of the grant, if the petition has been presented six months before the time of its expiration; but the Privy Council will require a sufficient reason to be rendered why a petition was not proceeded with if duly presented.

Delay by misfortune.

It will be seen in this, as in every other branch of the law of patent, that strict equity is the principle on which the decisions are based. It will be seen, from the cases cited, that the Privy Council have regard for the misfortunes of the patentees, and those connected with them, if they are urged as a reason for the non-productiveness of the patent; but in all cases, the subject of the patent must be shewn to be an invention of great utility; and if any delay has occurred in making it productive, that such delay has not arisen from carelessness or inactivity, but from misfortune, or unavoidable circumstances, or the necessity to perfect the invention, or from improper opposition or prejudice, or such reasons; otherwise, the want of energy in the grantees would be made a tax upon the public, instead of their ingenuity and industry; for the prolongation of the term is depriving the public of a right, and is of necessity a tax;

warrant the extension is this, that the patentee has made nothing for seven or eight years (uniform small profits spread over the period of the grant would be insufficient). Patent extended for five years; the costs of the opposition were allowed; one of their lordships remarking, the attorney-general is here for the public, at all events.

(*p*) Mackintosh's Patent, Webs. Pat. Ca. 739.

for an article protected is only procurable at a greater cost than one which is open to public competition. Where the petitioner had patronized an ingenious invention, and expended large sums of money to bring it to perfection and introduce it, the amount of profit, not having been greater than in ordinary mercantile speculations, would be taken into consideration, and would be a good ground for an extension.

The Privy Council sometimes annexed a condition, as in the patent of Whitehouse, which was an application for an extension by the assignee. The extension was recommended on condition of the assignee allowing an annuity to the patentee during the period of the new term.^(q)

Condition sometimes annexed to extensions.

In estimating the profits, the expenses of bringing the patent into use, and the litigation consequent upon maintaining the right, are always to be deducted; and also a manufacturer's fair profit is to be deducted and distinguished from the profits accruing through the monopoly.^(r)

Profits, how estimated.

The rules of evidence adopted by the Council are those of the common law. In all cases the right of the petitioners must be proved; and also that they have in all things complied with the regulations of the act (as advertising, &c.); and those imposed by the Privy Council, as the delivery of objections to be relied upon by those in opposition.

Rules of evidence adopted by the Privy Council.

All cases which would have been considered proper cases to carry before the Houses of Parliament, for the purposes of an extension, will receive every consideration by the Privy Council acting under the statute.

Cases formerly proper to be extended by Parliament.

(q) In re Whitehouse, ex parte Russell, 2 Moore, P.V.R. 496.

(r) In re Galloway, supra.

Employment of
the poor.

In the case of the Lustring Patent, which was the introduction of a new manufacture from abroad,^(s) the employment of the poor was one of the grounds urged for an extension. If it had been the only ground, it is doubtful whether the mere employment of the poor would have been considered a sufficient reason for the extension of the time: (it would, it is apprehended, be necessary to shew also an inadequate remuneration, or a case of hardship); for the poor would be equally employed by the invention being thrown open to the public, and, perhaps, to a greater degree; and the absence of the monopoly would create competition, which would have the effect of lessening the price of the protected article, and, by consequence, lead to an increased consumption. But where, as in the case of Lomb's Patent, and in other cases collected in Webster's Patent Cases, it was shewn it required much expense, difficulty, and time to perfect the invention, such matters would be taken into consideration.

(s) Vide Re Morgan, supra.

CHAPTER IX.

THE NATURE OF THE PROPERTY CONFERRED BY THE GRANT OF
LETTERS PATENT—RIGHTS OF THE PATENTEE—MEANS OF CON-
VEYANCE—PARTNERSHIP—BANKRUPTCY—INSOLVENCY.

HAVING, in the previous part of this work, treated upon all the matters necessary to procure or render a patent valid, it becomes our duty to treat of the nature of the property the grantee obtains, and the rights which are incidental to his grant. To arrive at a correct conclusion, we must examine the grant, and its construction, *i. e.* the letters patent. (*a*)

It will be seen, by referring to the form of the grant, that it contains a recital of the motives of the sovereign in making it, and the rights which are thereby vested in the patentee, and also a proviso that it shall be void if it be prejudicial or inconvenient to her Majesty's subjects generally, and also if it be not new; and that the grant shall not create any privilege inconsistent with a prior grant; and also that it shall be void if it becomes vested in, or be held in trust for, more than twelve persons (such proviso does not extend to the granting of licenses). If it be desired that more than twelve persons should be interested in the patent, an act of Parliament for that purpose must be obtained. (*b*)

Formerly there was much speculation as to the intention of this clause in the grant, as to what class of persons it was

(*a*) Vide Appendix for form.

(*b*) In re Head's Patent, *Head v. Carey*, 6 Law Times.

intended to include ; viz. whether it extended to the parties to whom the patent was assigned, and to such persons as they should grant licenses to, or only to the original proprietors of the patent. The case of *Protheroe v. May and Others*(c) (which was an issue directed by the Court of Chancery) has finally settled the matter. The facts of the case were as follows : A patent was granted to one Dunn, who assigned it to twelve persons, who were from thence to become interested in the profit of the said patent ; and they granted licenses to certain persons, amongst others to the said plaintiff, for a particular district, who assigned his license to a company consisting of more than twelve persons ; the question was, whether the clause applied to licensees as well as to trustees. The Court decided that the grant of the licenses, and their becoming vested in more than twelve persons, had no effect to render the patent invalid.

Clause in the patent restricting the grant to twelve persons. Construction.

The clause only extends to voluntary assignments, and not to assignments by the operation of the law;(d) as if one of the partners died, and left two executors, or became bankrupt, and his estate vested in two assignees, the executors or the assignees would be considered as only representing one person, such vesting being wrought by the operation of the law ; but if one of the partners become a partner with others in his share, in such case, though the partnership would only represent one share, the engagement is a voluntary one ; and as it is not necessary that the interests of each person should be equal, to constitute the partnership in the patent, it is apprehended that such person and his partners would be deemed to be partners in the patent. In such case, the patent, being vested in more than twelve persons, would be void : if it were not so, a patent might be divided into any number of shares, and the

(c) 5 M. & W. 675.

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

vesting the shares in twelve persons would be sufficient to satisfy the provision in the patent, though the property was actually vested in a thousand persons. (e) This construction may, at first sight, appear a hardship, as it seems to be giving to any of the associated persons power to defeat, at any time, the object of the partnership, and to make void the patent; but in partnerships it must be recollected that the broad rule of law is, that the act of one of the partners shall bind his fellows. A partnership is not constituted by any construction of law, but by the agreement of the parties themselves, and is entered into with a full knowledge of the consequences, and the powers with which each invests the others. There is no greater risk in the case of a patent than in any other mercantile pursuit; for in all partnerships, an unprincipled associate has power to wreck the scheme and ruin his fellows; besides, the partners, having knowledge of the clause in the patent, could, were they so disposed, bind each other by bond, conditioned in a penalty, not to associate any other person with any member in the scheme. In the case of a partner associating another person with him (in partnership in his share), it perhaps may be urged that, with the others the person associated is not a partner: even so, but it cannot be denied, that to the world he is a partner, and as he participates in the profits, he is liable for the debts of the partnership; if then he, for any purpose, is a partner, he is within the restrictive clause.

Mr. Webster, in a note to *Protheroe v. May and Others*, (f) suggests that "some of these consequences might be avoided by a license instead of an assignment, the rent or license dues being reserved by *way of per-centage upon the gross amount of the sales*, instead of by *way of share in*

(e) *Duvernier v. Fellows*, 5 Bing. 248; in error, 10 B. & C. 826.

(f) *Webs. Pat. Ca.* 417.

the profits, or per-centage on the net returns," and refers to the cases of *Elgie v. Webster*, (g) and *Ridgway v. Philips*. (h) With all deference to the suggestion of the learned reporter, it appears doubtful, whether, if the plan could be carried into effect, it would not, in truth, be a grant of a part of the profits, and have to be so pleaded; the rule being, that instruments shall be pleaded according to their effect. If, then, it be a grant, how is the partnership avoided? for in any case it must be a license to participate in the profits to be gathered from the patent. Calling the grant a license would evidently be a merely colourable deviation, and one of which the intention would be too evident to be mistaken. If the suggestion could be effected in the way proposed, and the *licenses* were good as licenses, the participation in the profits, which would be consequent upon them, would constitute a partnership; if so, it would be a vesting of the patent in more than twelve persons, and the effect to make it void. The reserving of the rent or license dues upon the gross amount of the sales, and reserving them by way of share in the profits, seems to amount to the same thing, for in either case it appears to be a participation in the profit to arise from the patent.

License, intention of.

The appointment of a certain district, with power to under-let licenses, would, it is apprehended, amount to the same thing, and be construed to be a mere colourable deviation; for the intention of the saving proviso is not that numbers of persons shall be interested in licenses, with power to sub-let, but that the licensees interested shall be so with the intention of carrying into effect the patent. *Protheroe v. May* proves that a person may assign his license, but not that he may sub-let, for that would be creating an interest in the profits of the patent itself, and not the grant of a mere power to carry out its object, or a

License, intention of.

(g) 5 M. & W. 518.

(h) 1 Cr. M. & R. 415; 5 Tyr. 131, S. C.

permission of user, which, it is submitted, is the real intention of the power to license.

It is by virtue of the clause contained in the grant that the patentee, or those who represent his rights, have power to grant licenses, and which power is most reasonable; for if the patentee had it not, it might tend to the complete stoppage of the particular trade of which the patent was an improvement, or to create a monopoly in the hands of the patentee, not by prohibiting the sale of all other than the patented article, but it might be that it was made at so much less a cost, as to defy competition, and vest in the hands of the patentee the exclusive trade; and which, if the patent was granted for an article in general use, as for an improvement in the manufacture of iron, by which the cost was lessened one-half, it might tend to the public injury; therefore, it is presumed, the licencing clause was inserted, that by receiving a sum in the shape of royalty, the patentee might be remunerated. If it was shewn that the patentee refused to grant licenses, and that he was unable fully to exercise his privilege, and importations of a similar commodity (not of the patented article, for that would be equally an infringement upon the exclusive right as manufacturing within the kingdom) were procured from abroad; or, it might be, the invention not being protected abroad, that the patented article was manufactured there, and the foreign markets supplied by foreign produce to the injury of the home trade; it is presumed, under such circumstances, that the patent would be construed to be within the sixth section 21 Jac. c. 3, which provides, that it shall not be to the *hurt of trade*, or a prejudice and general inconvenience to her Majesty's subjects. The patentee in such a case would be recompensed out of the public purse by means of a parliamentary grant.

Refusal to license, effect.

Licenses are of various kinds—as a sole license to use

Estoppel, when
it does not ap-
ply.

the invention within the whole extent of the grant, or to use a part thereof, or within a particular district or place; or a common license to use and vend without any restriction against the patentee granting licenses to others in the same place. It is not necessary that the grant of a license should be under seal; (i) but where the license is not under seal, the doctrine of estoppel does not apply, and if the patent is in itself void, a plea putting it in issue would be an answer to an action for the reserved rent. (j)

(i) *Chanter v. Dewhurst*, 12 M. & W. 823.—*Indebitatus assumpsit* to recover 31*l.* 10*s.* for a license to use patent invention.—The license granted was not under seal, but written; patent reciting the licenses granted should be under seal. It was objected, the license not being under seal, was void; and answered, that the defendant having kept and used the license, could not object, and was liable to pay for it. The judge refused to nonsuit, and jury returned a verdict. On motion, “to grant a license not under seal may be a fraud on the Crown, but does not exempt him to whom it is granted, and who derives benefit therefrom, from paying the price of it.”—Alderson, B. (825.) The object of the patent is to prevent another from making the article for sale, not to prevent him from using it.—Ib. “The defendants have got all the plaintiff agreed to give, and must pay the stipulated price.”—Parke, B. (826.) “If defendants intended to avail themselves of this objection, they should have made it earlier, and not have kept the license.”—Alderson, B.

(j) *Hayne and Another v. Maltby*, 3 T. R. 438.—Action of covenant on articles of agreement, which stated a grant by the plaintiff to the defendant to use a patent machine for making stockings in a certain way.—The declaration averred enjoyment, and assigned breaches, using, &c. other machines than those agreed, and also for using engines, &c. resembling the patent; to which were several pleas. Third set forth the patent, and stated, &c., it should be void if specification was not enrolled, &c., and that it was not. Fourth, not a new invention. Fifth, not discovered by patentee, to which plaintiff demurred. Defendant attempted to put in issue matters foreign to the merits of the cause, as by his deed he was estopped from so doing. Held, “the doctrine of estoppel does not apply here, for the very person to be estopped is he who has been imposed upon:” Lord Kenyon, mentioning *Oldham v. Langmead*,

In a case where there were several parties to an agreement, which was for the use of several patent rights, but the subject of the action was for a distinct sum agreed to be paid to one of the parties (the original inventor), who brought the action in his own name: the Court held the non-joinder of the other parties to the agreement, though they had no interest in the particular sum the subject of the action, was a variation between the declaration and the contract. (*k*)

Non-joinder of
the parties.

saying, "The case differed; for there a person assigned his right in the patent, and yet, in violation of his right, infringed the plaintiff's right, and attempted to deny his having any title to convey." (441.)

The plaintiff has not the right he pretended to confer, and therefore the defendant had not the consideration for which he entered into the covenant.—Buller, J. (442.)

(*k*) An information in the nature of a *quo warranto*. (Chanter v. Leese, Cussons, and Diggle, 4 M. & W. 295; confirmed in error, 5 M. & W. 698.)—An agreement, not under seal, was entered into by the plaintiff and others, with the defendants, to use certain patent rights in which they were interested, and that they (the defendants), for certain considerations, were to have within a certain district the sole right to use such patent; one of which considerations was, that the defendants should pay the plaintiff 400*l.* a year, by half-yearly payments. The action was brought for 200*l.* Declaration stated agreement, and alleged as breach non-payment. There was also an account stated. Pleas, *non assumpserunt*, letters patent (setting them out); supposed improvement was not a new invention. Verification. Not invented and found out by the plaintiff. Verification. Plaintiff took issue on first plea, and demurred to second and third, assigning same cause of demurrer to each, viz. that the plea contains matter, which, if true, constituted an answer, or defence, to part only of the cause of action in the first count, in this, to wit, that the promise to the defendant in the first count was made in consideration of the right and liberty to use and vend the whole of the said patentee's inventions in the said agreement in the first count set forth; and the defendant attempts to avoid the agreement upon the allegation of matter, which, if true, tends to invalidate only one of the said patents, &c. Joinder in demurrer. Lord Abinger, C. B., delivering judgment of the Court: "We think judgment

Money paid for
a license under
a void patent.

Though the invalidity of the patent is an answer to the action for the rent, yet the party cannot recover back such moneys as he has paid the supposed patentee for the use of the privilege which the license was intended to confer. (*l*)

Estoppel, when
it applies.

Where the licenses are granted by deed (*i. e.* by agreement in writing under seal), the doctrine of estoppel applies, and a person would not be allowed to disavow so solemn an act. (*m*)

should be for the defendant on demurrer. The declaration is founded on contract; if the person is unable to do what he contracted for, the contract is at an end. The possession of all and each of the said patents being an entire consideration, the plea impeaching that is a good consideration to avoid the whole contract as it appeared on the record. We think that there was a variation between the declaration and the contract in not setting out all the contracting parties." Judgment on demurrer, and rule absolute for a nonsuit.

(*l*) *Taylor v. Hare*, 1 New Rep. 260.—Action for money had and received.—The defendant, supposing himself the inventor of a valuable invention, agreed to let the plaintiff use it, upon consideration of an annual amount, which for several years was paid, and then it was discovered that the defendant was not the inventor. The action was to recover back the money paid. Held: Two persons equally innocent make a bargain, and one agrees to pay the other for the use, and he has it, it is in the nature of a partnership. Plaintiff cannot recover.—Lord Mansfield, C.J.

"We cannot here take an account of the profits."—Heath, J.

(*m*) *Bowman v. Taylor and Others*, 2 Ad. & Ell. 278.—Covenant.—Declaration stated an invention in constructing looms for weaving, termed "power-looms," for which a patent was obtained with power to vend the same, &c. Plaintiff had agreed to permit the defendants to use said invention upon certain considerations set out. Breach, non-payment of consideration, and non-fulfilment of other covenants. Plea, setting out letters patent, &c., and then averred the patent was not a new invention; second, plaintiff was not first and true inventor; third, plaintiff did not specify, &c. To all the pleas there was a demurrer; joinder in the demurrer; there were also issues in fact. Lord Denman, C.J.: "The plaintiff contends these pleas are bad, because the defendant is estopped by his deed from pleading them. As to the doctrine laid down by Lord Coke (Co. Litt. 3526), 'that a recital does not conclude because it is no direct

Where the sufficiency of a license by deed is put in issue, and with it is joined an issue in fact, such issue in fact should be left to the jury: if it is not, it will be a ground for a new trial. (n)

Sufficiency of a license by deed and motion of fact, question for a jury.

Joint owners of a patent are partners, and are therefore amenable to the laws of partnership; and if one induces a person by fraud to purchase a license which turns out of

Joint owners in patents.

affirmation,' the authority is a great one; but still, if a party has by his deed recited a specific fact, though introduced by 'Whereas,' it seems impossible to say he shall not be bound by his own assertion so made under seal" (citing *Lainson, executor of Griffiths, v. Tremere*, 1 Ad. & E. 792). Taunton, J.: "The principle of the law of estoppel is where a man has entered into a solemn engagement, by deed under his hand and seal, as to certain facts, he shall not be permitted to deny any facts he has so asserted. This case is distinguished from *Haynes v. Maltby*. Here, there is an express averment that the plaintiff is the inventor of the improvements; there, the articles of agreement merely averred (nothing as to the origin of the invention), but merely stated plaintiffs were assignees of the patent." Patteson, J.: "The deed recites plaintiff invented and obtained a patent for certain improvements, and proceeds to a demise of the subject-matter for which the patent is so granted. I cannot separate these things. The passage in Lord Coke must be taken with some qualification. *Lainson v. Tremere* is a direct authority to shew there may be an estoppel by way of recital."

(n) *Bowman v. Roshon and Others*, note b, 2 Ad. & E. 295.—Declaration same as *Bowman v. Taylor*. Pleas, *non est factum*, and same pleas as in *Bowman v. Taylor*; and fifth, a further breach of the conditions of the letters patent. On trial before Lord Denman, C.J., plaintiff put in counterpart of indenture which was executed by defendant. The Chief Justice held the recital to be conclusive as to the second and third pleas, so as to preclude evidence being given in support. The defendants then not insisting on the fourth and fifth pleas, a verdict was taken generally for the plaintiff, leave being given to move for a new trial, on the ground that the inference to be drawn from the deed, as to the truth of the allegations in the pleas, should have been left to the jury. On argument of the rule, Lord Denman said, "We are all of opinion there must be a new trial: a specific issue, in fact, having been joined, and evidence offered on it at trial, which was not received. Both had liberty to amend pleadings, without costs."

no value, if the others are made parties to the contract, they will all be liable to refund the purchase-money so obtained. (o)

Agreement conditioned in a penalty.

Where the discoverer of an invention discloses it to another person, who agrees not to avail himself of the secret, under the *penalty* of a sum of money, and he breaks his agreement, such word penalty cannot be read as liquidated damages. (p)

Property conferred by a patent.

By the grant of letters patent, the property conferred on the patentee (supposing his patent to be valid) is of as

(o) Joint owners of a patent are considered as partners; and where a party had been induced by the fraud of one of such joint owners to purchase from him, by an agreement, to which all were parties, the use of a patent right, which turned out to be of no value, it being proved to be a mere, but old, speculation: Held, that each of the parties to the contract, one of whom had no interest in the patent at the time of the contract, was liable to refund the whole of the purchase-money fraudulently obtained.—*Lovell v. Hicks*, 2 Y. & C. 481; on rehearing, see S. C. 2 Y. & C. 58.

Quære, as to effect on right of plaintiff to recover the whole from each, had it proved that he knew that three of the parties to the contract were, by special agreement, entitled in severalty to different proportions of the profits of the patent, and that one of them had no interest in it whatever.—S. C.

(p) *Smith v. Dickenson*, 3 Bos. & Pul. 630.—Assumpsit.—Declaration stated plaintiff had invented certain improvements in a saddle, and confiding in defendant's promise, plaintiff told defendant the secret, but the defendant wrongfully obtained letters patent therefor. It was proved, at the trial, plaintiff had invented the spring apparatus, and that defendant being desirous to know the secret, had bound himself in 1,000*l.* not to avail himself of the knowledge which defendant should communicate. On obtaining the knowledge, defendant entered a caveat against any other person taking out a patent for the same thing, and took out patent himself; and that defendant being unable to make out the specification alone, was assisted by plaintiff on condition of their sharing the invention. Jury found a special verdict, damages, &c. The Court held, the word penalty excluded the notion of liquidated damages. It was held, the subsequent meeting did not vacate the original, but the fraud practised upon the plaintiff was only a continuation of it.

absolute a nature as any other property, and which he may by way of sale assign (*q*) or mortgage, and his transfer will vest in the assignee as absolute a right as he (the patentee) had before the assignment. It may also be made the subject of a trust, which doctrine was formerly doubted, (*r*) but now it is the constant practice to make patents the subject of trusts.

Being a recognized property, it is, of course, amenable to the bankrupt laws, and would pass to the assignees as well as any other property. But if the invention is still in embryo, and not made the subject of a patent until after the bankrupt has obtained his certificate, the assignees would have no right to the invention, for until it becomes patented, the invention cannot be said to be property; (*s*) and so the right and interest an insolvent has in letters patent will pass under the assignment of the effects of the insolvent to the provisional assignee. Future patents will be subjected to those rules which govern any future property an insolvent may acquire, and it follows they may be seized in execution, and sold by the sheriff under a writ of *feri facias*.

Patentee, bankruptcy of, effect.

Insolvency of.

(*q*) Cartwright *v.* Amatt, 2 B. & P. 43.

(*r*) Ex parte O'Reilly, 1 Ves. jun. 129. Lord Thurlow.

(*s*) Hesse *v.* Stevenson, 3 Bos. & Pul. 577.—“The schemes which a man has in his head before he obtains his certificate, or the fruits which he may make of such schemes, do not pass to the assignees, nor could they require him to assign them over, provided he does not carry them into effect until after he obtains his certificate; but if he avails himself of his knowledge and skill, and thereby acquires a beneficial interest which may be the subject of assignment, why should not that interest pass in the same manner as any other property acquired by his personal industry? We are, therefore, of opinion, that the interest in letters patent is an interest of such a nature as to be the subject of assignment by the commissioners”—(Lord Alvanley, C. J., 578 and 579)—“and if the patent be conferred by Act of Parliament, it is the same.”—Ib.

Alien enemy,
trust for.

A doubt has been raised whether a patent can be held in trust for an alien enemy. From the general policy of the law, it would be presumed it could not, and the trustee would not be bound to execute the trust, for the proceeds thereof might be employed against the country. It is clear, no action could be prosecuted with effect by such alien enemy, but an action by the trustee for an infringement of the patented right would be governed by entirely different considerations; but whether an action could, under such circumstances, be maintained by a trustee, is a fair subject for doubt.

Clause to supply govern-
ment.

The patent sometimes contains a clause that the patentee shall supply the government with the invention at reasonable prices; in such case, where the government have been supplied with the invention, a mandamus will not be issued to compel the particular department of the government to which the supply appertains to fix the price; (t) the only remedy would appear to be upon the contract.

(t) *Ex parte Perring*, 4 Ad. & E. 949.—Patent for constructing anchors, which contained a proviso to void the same, unless patentee supplied the dock-yards, at the times and at such prices as should be settled by the Lords Commissioners of the Admiralty for the time being.—Motion was for a mandamus to command the Lords of the Admiralty to settle the price. The affidavit stated the patent; that the Admiralty had anchors so constructed, and refused to give the patentee the proper remuneration. The claim seems to be in the nature of a *quantum meruit* for the use of the patent. Littleton, J. : “The claim, if valid, must be founded upon a contingency. We cannot grant a mandamus to a public board, ordering them to carry a contract into effect.”

CHAPTER X.

PROTECTION OF THE PATENTEE IN THE ENJOYMENT OF HIS RIGHTS
—INFRINGEMENT—INJUNCTION—PROCEEDINGS AT LAW.

THE next subject of consideration will be, to what protection is the patentee entitled, and in what way can he enforce his rights, which may be divided into two heads: the summary jurisdiction of the Lord Chancellor, which is by injunction; and the enforcement of the claim by an action at the common law and the recovery of damages; but, before entering upon these heads, it will, in the first place, be necessary to shew what is an infringement of a patent right.

Remedy for
wrong.

INFRINGEMENT.

The forms in which infringements present themselves are various, and must depend upon the nature of the invention. In a process, it will be by imitation; in a machine, by its manufacture or use; in a vendible article, by making and selling. The mere exposure to sale is not a selling, and would be insufficient to satisfy the word vend in the prohibitory part of the patent. (a)

Infringement.

Vending, what.

(a) *Minter v. Williams*, 4 Ad. & E. 251.—Case for infringing patent by making and vending chairs in imitation of the said invention.—“The prohibitory part of the patent does not mention vending; the word generally used is ‘sell.’ There is a great distinction between vending and exposing to sale.”—Patteson, J. (255.) “The prohibitory part of the patent forbids all persons ‘to make, use, or put into practice the said invention, or to counterfeit, imitate, or resemble the

Similarity of structure.

Similarity of structure to the patented article, until the contrary is shewn, would be presumptive evidence of the two articles being of the same construction, and of the imitation being a piracy. (*b*)

Principle, construction.

In the case of a principle, however great may be the improvement introduced, if the adaptation is in the same mode as that suggested by the specification, the difference being in the form by which the principle is applied, it will be held to be an infringement; (*c*) for identity of purpose and not of name is the criterion by which the infringement is to be judged. (*d*)

Equivalent, use of.

Where a patent specifies for the use of a particular article, the use of some well-known equivalent would be an infringement; but when certain articles are used without intending to infringe the patent, and the party using them does so in ignorance that he is thereby infringing the patent, especially if it is unknown to science that the particular compound would be produced by using the articles which were well known, such use would be no infringement; (*e*) but, after

same, or to make any addition thereunto or subtraction therefrom, &c.' The count alleges, that the defendant, without the plaintiff's license, exposed to sale certain chairs, intending to imitate, &c., and which did, &c., his invention. Do these words necessarily import the vending spoken of in the granting part of the patent? I think it means the habit of selling and offering for sale. A mere exposure to sale with intent, &c. is not equal to a sale; the word vend we ought to read only so as to give the meaning which would effectuate the purpose of the patent, viz. the prevention of acts injurious to the patenee, with as little restraint on the public as possible. I cannot say a mere exposure to sale is injurious to the patentee, it might be beneficial."—Coleridge, J.

(*b*) *Huddart v. Grimshaw*, supra.

(*c*) *Neilson v. Harford*, supra.

(*d*) *Cutler's Pat. infra. Russell v. Cowley*, Webs. Pat. Ca. 462.

(*e*) *Heath v. Unwin*, 9 Jurist, 231.—Case for infringement of patent for improvements in the manufacture of iron and cast-steel, to which, amongst other pleas, defendant pleaded not guilty.—The

an action, it is presumed, the nature of the articles would be a publication to the world, and then user of the same things would be held to be an infringement of the patent. So a

plaintiff obtained a patent for improvements in the manufacture of iron and steel, and in his specification mentions several. The question here arises, upon the claim to use carburet of manganese for the conversion of iron into steel. The specification mentioning the use of the oxide of manganese, describes the part of the process alleged to be infringed, in these terms: "Lastly, I propose to make an improved quality of cast-steel by introducing into a crucible bars of common blistered steel, broken, as usual, into fragments, or a mixture of cast and malleable iron, and its carbonaceous matter, along with one to three per cent. of their weight of carburet of manganese, and exposing the crucible to the proper heat for melting the materials; but I do not claim the use of any such mixture of cast and malleable iron and carbonaceous matter, as any part of my invention, but the use of carburet of manganese in any process for the conversion of iron into cast-steel;" and, in summing up his claims, he states the third to be the employment of oxide of manganese alone in producing of cast-iron; and the one in question, the employment of carburet of manganese in preparing an improved cast-steel (carburet of manganese is formed by the fusion of black oxide of manganese and carbonaceous matter). It was proved the defendant did not put the carburet of manganese, but the oxide of manganese and carbon, into the crucible together with the steel; and evidence was given, that before combining with the steel, the ingredients would form carburet of manganese, which the jury found to be true; and, also, that the quantity of carburet so formed would be less than one per cent. of the weight of the steel in the crucible. The patent was obtained for the use of a peculiar combination of carbon and manganese, called carburet of manganese. The question then is, is this a mere colourable variation? If the defendant substitutes for part of plaintiff's invention some well-known equivalent, whether chemical or mechanical, it would be a mere colourable variation. It is clear, from the evidence, defendant never meant to use carburet of manganese, and we do not consider the defendant can be deemed guilty of an indirect infringement of the patent, for neither he nor any one else, prior to this investigation, knew that carburet of manganese would be found in the crucible in a state of fusion; and even then, it is a mere speculative opinion,—though, after the verdict, we must assume it to be a correct opinion amongst men of science.

Colourable deviation. mere colourable deviation would be an infringement of the patent. (f)

Improvements. Where improvements are claimed, they must also be shewn to be new : an imitation of any part of the invention is suf-

(f) *Walton v. Potten*, 4 Scott, 91.—The jury found on all the issues for the plaintiff. After commenting upon the whole of the issues, his lordship said: “There is only one or material issue, whether sheet cards or top cards were material or not, according to the mode of adaptation described in plaintiff’s specification. The jury found for plaintiff, the evidence being the actual user of sheet and top cards and the trial of experiments (though, perhaps, since the action was brought): on the part of the plaintiff the evidence was positive, opposed by judgment and belief on the part of the defendant.”—Tindal, C. J.

“‘I confine my claim, &c. to the application of India-rubber as the fittest, &c., in which the dents or teeth are to be set together in the manufacture of cards, obtaining thereby a superior elasticity.’ It appears to me to involve not a mere simple claim to the use of caoutchouc, but its adaptation for the reception of the teeth, by putting at the back of it a linen cloth, which is proved to be an essential part of the manufacture, though it be afterwards removed.” (142.) Being more elastic, it facilitates the insertion of the teeth. (143.) *Coltman, J.*

“The plaintiff’s card is formed by the insertion of the dents or teeth in a fillet or sheet composed of a slice of caoutchouc, cut from the block as imported into this country, or as improved by being made more compact by a chemical or mechanical process, cemented to a piece of linen or brown Holland, an additional elasticity being given to the teeth by the India-rubber in which they are imbedded. The defendant’s card is made by inserting the dents or teeth in a mixed fabric that has been previously saturated or impregnated with a solution of India-rubber, and made compact or firm by rolling, after the solvents have been evaporated by exposure to the atmosphere, the object being the attainment of a greater degree of elasticity, through the medium of the India-rubber, than the cloth would possess without. The principle of both methods is the same; they differ only in the manner of applying the India-rubber. I think the verdict of the jury affirming the infringement was right.”—*Erskine, J.* (159.)

“By defendant’s specification, the claim is of a new material for forming the backs of cards, and explains it thus: &c., &c., producing the same result as plaintiff’s by a circuitous mode.”—*Maule, J.* (151.)

sufficient to maintain the action. It need not be shewn that the perfected article imitated in all its parts the original invention; (*g*) for the substance of the invention and its principle, and not the mere form, are to be looked at. (*h*)

The sale of a pirated article is sufficient to constitute an infringement of a patent. (*i*) Sale of a
pirated article.

A licensee, in cases of infringement, is a competent witness to prove the infringement; (*j*) but in all cases the question of infringement is a question of fact for the jury. (*k*) Licensee a
competent wit-
ness.

INJUNCTION.

Proceeding by injunction is the mode which patentees usually select; for in that case the infringement is stayed immediately, or, if allowed to be continued, which it is under special circumstances, an account is directed to be kept. Injunction.
Account.

(*g*) In an action for the infringement of a patent for improvements in a cabriolet, the defendant pleaded—1, not guilty; 2, that the improvements were not new; 3, that the plaintiffs were not the true and first inventors of the improvements:—Held, 1st, that on these pleadings it could not be contended that the patent was illegal as a monopoly; 2nd, that though all the improvements claimed must be shewn to be new, it need not be shewn that the defendant's cabriolet was an imitation of all of them—an imitation of one was sufficient to maintain the action; 3rd, that the validity of the patent might be considered to have come in question, so as to entitle the plaintiff to a certificate to that effect under the 5 & 6 Wm. 4, c. 83, s. 3.—*Gillett v. Wilby*, 9 C. & P. 334; et vide *Jones v. Pearse*, supra.

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

(*i*) *Cornish v. Keene*, supra; *Gibson v. Brand*, supra. S. F.

(*j*) *Derosne v. Fairlie*, 1 M. & Rob. 457.

(*k*) *Boulton v. Bull*, supra; *Hale v. Boot*, Webs. Pat. Ca. 101; *Heath v. Unwin*, supra.

Injunction,
how obtained.

An injunction is obtainable upon *ex parte* evidence. In the bill, the patentee or assignee, as the case may be, must set forth his title and make out a sufficient *prima facie* case; the infringement must be distinctly alleged. In the case of *Stultz v. De la Rue*,^(l) Lord Lyndhurst, Ch., said, "When a party comes for an injunction against the infringer of a patent, he ought to state that he believes at the time he makes the application that the invention is new, or had never been practised in this kingdom at the date of the patent. It is not enough that he believed it to be new at the time when the patent was taken out;" and that he is the true inventor,—mere belief will not be sufficient.

Injunction.

Injunction,
when granted
of course.

An injunction is always granted immediately if the patentee has been in possession of his rights for some time.^(m)

Answer to bill,
when put in.

If the defendant intends to dispute the right the patentee claims, from some informality in the grant, or other reason, he puts in an answer to the bill; on the hearing, if the Court thinks the objection to the patent is one which is sustainable, they will sometimes dissolve the injunction and direct an issue at law; the defendant in the meantime to

(l) 5 Russ. 329.

(m) *Hill v. Thompson and Another*, 3 Meriv. 622.—Injunction.—Where a patent has been granted, and an exclusive possession of some duration has been had under it, the Court will interpose by injunction, without compelling the party previously to establish the validity of his patent by an action at law; but when new, and in opposition it be endeavoured to be shewn that there is no good specification, the Court will not act upon its presumed validity without a previous trial. (624.)

Harmer v. Plane, 14 Ves. 130.—Injunction.—Where the patentee has been a reasonable time in possession of his grant, on infringement, the Court have granted an injunction until the legal question be tried, because there is less inconvenience in granting the injunction than in dissolving it at hazard, because it may prove that the grant of the Crown was valid. (133.)

keep an account of the articles he manufactures by the patented process.

An injunction is obtainable not only during the time of the existence of the patent, but may also be obtained afterwards, to restrain the sale of machines piratically made during the existence of the patent.⁽ⁿ⁾ Where the pirated article is part of the private effects of a person, an injunction will not be granted to restrain the sale of it.^(o) The injunction is intended to protect the patentee in the property of his invention, and prevent its use by other persons during the continuance of the grant for the purposes of sale or manufacture by the patented process. Where a patentee has looked on and allowed the defendant to incur great expenses, by the erection of works for the purposes of carrying on the particular process, an injunction, if it has been obtained, will not be continued, but an account will be directed ;^(p) but if the defendant had entered into a contract with the patentee, and paid the rent reserved under the contract, the injunction would be continued, unless he (the defendant) pays into court the money which became due before he gave the patentee notice that he intended to discontinue the use of the license ; for by ceasing to pay, he exposes himself to the consequent stoppage of his works.^(q)

An injunction may be obtained after the lapse of the patent.

Injunction, when not granted.

Injunction, intention of.

It is usual when the Court grants an injunction, to impose on the plaintiff the terms of bringing an action to try his title ;^(r) sometimes the Court directs a specific time for the delivery of the declaration,^(s) or provides that the cause shall be tried within a certain period.^(t) The fact that an

Imposition of terms.

(n) *Crossley v. Beverley*, supra.

(o) *Universities of Oxford and Cambridge v. Richardson*.

(p) *Neilson v. Thompson*, supra.

(q) *Neilson v. Fothergill*, *Webs. Pat. Ca.* 289.

(r) *Wilson v. Tindal*, supra.

(s) *Russell v. Cowling*, supra.

(t) *Russell v. Barnsley*, supra ; *Hill v. Thompson*, supra.

action is pending against another person is an insufficient reason for the continuance of an *ex parte* injunction, without compelling the plaintiff to bring an action against the new defendant.(u) When the validity of the patent is established at law, the injunction is of course revived.(v)

In a suit to restrain the infringement of a patent, the plaintiff is not precluded from obtaining an injunction at the hearing, because he did not apply for one on motion; but it will not be granted to him on a *prima facie* case, made out by the help of the facts proved in the cause, in order to give him further time to establish his title at law; and *semble*, that he must make out such a case as would entitle him to a perpetual injunction.(w) Where a person is aware of an infringement being made upon his grant, he should proceed immediately, and not lie by, and then come in for the purpose of claiming a share of the profits made by the piratical use of the patent.(x) Where an injunction has been obtained, and the jury finds there has been no infringement, there would be no justice in continuing it (the injunction). The Court has no power to make the plaintiff pay the defendant damages because the injunction has been continued too long.(y) In taking an account in a late case, it was held the proper measure of damages would be the amount for which the engines sold, and the profit derived therefrom.(z) So though a party does not make any direct profit by his infringement, yet if he makes an indirect one, such profit would be the subject of an account.(a)

Proceedings,
when they
should be com-
menced.

Damages sus-
tained in con-
sequence of an
injunction.
Taking an
account.

(u) Russell v. Barnsley, supra. (v) Neilson v. Harford, supra.

(w) Bacon v. Spottiswoode, Bea. 382.

(x) Crossley v. Beverley, supra.

(y) Morgan v. Seaward, Shadwell, V.C.; Beckford v. Skewes; Neilson v. Harford.

(z) Morgan v. Seaward, supra; Neilson v. Thompson, supra.

(a) *Semble*, that a party infringing a patent, though he does not make any direct profit from the sale of the subject of the patent, is liable

Where the bill alleges that the plaintiff is the patentee of an invention, stating its nature generally, but referring for greater certainty to a specification in which it is set forth and described at large; and alleges also, that the plaintiff has been for ten years in the exclusive enjoyment of such patent, and has established his legal title by repeated actions, a general demurrer, on the ground of the invalidity of the patent as stated in the bill, will be overruled; and for the purpose of determining the validity of a plaintiff's title as the patentee of an invention, the Court will not make an order, upon demurrer, directing the bill to be retained, with liberty to the plaintiff to bring an action. (*b*)

Demurrer to
bill.

to account to the patentee for a collateral profit arising to him from the use of the patent article by his customers, as where the result of the invention is to diminish the amount of gas supplied to them.—See *Crossley v. The Derby Gas Light Company*, 4 M. & K. 72; *Bacon v. Spottiswoode*, Bea. 382.

(*b*) *Kay v. Marshall*, 4 M. & G. 193, note a.—The plaintiff filed a bill for an injunction after the time for demurrer had elapsed. Special application was made for leave to demur, which Shadwell, V. C., refused, but was granted by Lyndhurst, Ch. The demurrer was filed; on argument, ordered to stand over twelve months, plaintiff in meantime to be at liberty to bring action. On application to Lord Cottenham, Ch., the order was dismissed, and the demurrer overruled. (1 Mylne & Craig, 373.) Application was then made to the Master of the Rolls (1 Keene, 190) to file a double plea to plaintiff's bill, which was granted—first, by denial of invention of new machinery; secondly, alleged invention was not of public benefit. On the case coming on for argument, plaintiff consented to waive all objections in point of form, if the defendant would consent to the trial at law of the pleas, without first going into evidence in equity, which was agreed to, and a decree made to that effect. The cause was tried before Parke, B., at York, when a verdict for plaintiff was found on both issues. The defendant applied to the Master of the Rolls for a new trial or special case, on the ground that the learned baron had taken an erroneous view of the case. On hearing, at the suggestion of the Master of the Rolls, with acquiescence of both parties, award was made, that a case should be stated for the opinion of the Court. A certificate thereto

Such are the remedies afforded to patentees in a court of equity, where it is best at first to institute proceedings; though at law if an action be determined against an infringer, a court of equity will on application, if the wrongful act be continued, grant an injunction.

Injunction,
effect of.

The practice of the court is, never to grant an injunction without annexing a condition, which is to try the cause some time within a given period. An injunction, when obtained, restrains the parties from proceeding with the infringement, and takes effect immediately, and if not dissolved, is perpetual—*i.e.* to the end of the patented right; a person proceeding in its despite would commit a contempt, which the Court would notice, and punish by fine or imprisonment.

was returned, that the patent was not valid in law. On the question coming on for further directions, it was ordered plaintiff's bill should be dismissed with costs. Plaintiff appealed to the House of Lords, which appeal was dismissed.

Westhead v. Keene, Bea. 287.—Where a bill to restrain the infringement of a patent did not set forth the specification, but contained an extract from it, and alleged that all had been done by the specification which was required by the terms of the patent, and that the drawings, and a full description of them, could not be set out in the bill, and charged that the invention was new: Held, upon the authority of *Kay v. Marshall* (3 M. & C. 373), (but with some doubt expressed by the Court) that the bill was not demurrable.

CHAPTER XI.

PROCEEDINGS AT LAW TO ENFORCE PATENTEE'S RIGHT.

HAVING shewn the nature of an injunction, and the benefits attending such a mode of proceeding, it becomes necessary to treat of that which is often auxiliary to the suit in equity, viz. the action at law. The proceedings are the same whether the action is directed to be brought by the Court of Equity, or are commenced, in the first instance, at law; the same steps have to be gone through, and the same description of evidence (a) has to be produced, excepting when the parties admit certain things, and agree to a case, which is called a special case. Then the particular points to be submitted for the decision of the judges are determined by the parties, and the facts all agreed, such an issue is an issue in law, to be determined by the judges of the court to which it is sent.

Action at law.

Special case, what.

In cases where there is or are a particular fact, or facts, undetermined, and upon the determination of that fact, or the facts, depends the decree in equity, the trial is by jury; for it is a rule that the questions of law are for the Court, but the facts are for the "country."

Facts, when in issue.

The party to bring the action is he in whom the legal interest is vested; if in more than one person, then the action must be brought in their joint names, or it is liable to be abated for the nonjoinder of the parties.

Person to bring the action.

The action to be brought for an infringement of a patent is an action on the case. Parties, whose rights have been

Nature of the action.

(a) Supra, Evidence.

Declaration necessary to.

Venue.

infringed, must shew their title in the declaration. An allegation must be made that the patent was granted under the great seal, and the letters patent must be set out (profert is made, but being of matters of record, oyer is never allowed); (b) and then follow the breaches complained of. (c) The venue is transitory, and may be laid in any county; but if it is laid in Middlesex, it cannot be changed; for the substratum of the action, the letters patent, being tested at Westminster, the necessary affidavit cannot be truly made that the cause of the action arose wholly in another county. (d) In *Beckford v. Skewes*, (e) which was an issue directed by the Vice-Chancellor, it was attempted to be made part of the order, that the cause should be tried in Cornwall, which his Honour refused; the venue was laid in London, and changed, by Mr. Justice Coleridge, at chambers, to Devon, with a condition that the jury was to be summoned from Exeter. So in *Brunton v. White*, (f) on motion, it was refused to allow the venue to be changed from London to Lancaster.

Not guilty.

Before the new rules, (g) by a plea of not guilty, the defendants put in issue the whole of the declaration, and the plaintiff was obliged to support the grant in all its parts; but, since then, the defendant has to plead all his defences, and deliver with his pleas notice of the objections upon which he intends to rely at the trial. (h)

Pleadings, nature of.

If the plaintiff joins issue upon the pleas, the record is taken down to trial; if not, then follows another pleading, called the replication, the reply to which is called

(b) *Rex v. Amery*, 1 T. R. 149. (c) *Infra*, Pleadings.

(d) *Cameron v. Grey*, 3 T. R. 363; vide *Rex v. Huire*, 2 Cox, 235.

(e) *Supra*.

(f) 7 D & R. 103.

(g) H. T. 4 Wm.

(h) *Vide infra*, Objections.

a rejoinder ; so the pleadings continue until one or other of the parties join issue.

For any thing which would afford in law an insufficient rebuttal of the matter alleged, the opposite party may demur. If the insufficiency is such that the statement is wholly insufficient in law, then a general demurrer will hold ; but if of mere form, then the demurrer must be special. Demurrer, when.

It does not follow because a patentee loses one action that he is thereby debarred from bringing another action against another party, or against the same party, for a fresh infringement ; for it may be, the failure of the action was not because of the intrinsic demerits of his patent, but from some insufficiency of pleading, or failure of proof. In such cases of failure, it would be proper for the patentee to persevere ; for, if the failure was on account of his claim being too large, a disclaimer would cure the defect. The patent right continues in force until either the right is gone, by the time having run out, or until it is repealed by a proceeding called a *scire facias*. Loss of an action, right to bring another.

SCIRE FACIAS, PROCEEDINGS BY.

The writ of *scire facias* is an original writ, so called from its commencing words, and proceeds out of the Court of Chancery (because, in patents, the matter for which it issues is filed of record in that court). Scire facias, what.

The writ of *scire facias* must be founded upon some matter of record, (i) and issues when the Crown has unadvisedly granted any thing by letters patent which ought not to have been granted, or where the patentee has done an act (or ab- On what founded, and when it issues.

(i) 4 Inst. 88.

By whom it
may be brought.

stained from doing an act) which amounts to the forfeiture of a grant. It may be brought either on the part of the King, to resume the thing granted; or if the grant be injurious to a subject, by the subject, in which case the King is bound of right to permit him (upon petition) to use his royal name for repealing the patent by *scire facias*.^(j) This applies to cases where there are two patents for the same thing, as two markets, and where individuals are affected.

Scire facias to
repeal letters
patent for an
invention.

Where a patent has been granted for an invention, the only cause for which the writ can be asked, is that the Crown is deceived. In this case the writ is not due *ex debito justitiæ*, but is in the discretion of the Crown. As the Crown is bound to see that the public are not unduly vexed by a monopoly, it is also bound to protect the patentee against unnecessary litigation.^(k) Sir W. Follett stated the practice for the obtainment of a *scire facias* to be as follows: "When a *scire facias* is applied for, the Queen's warrant, directed to the attorney-general, is obtained upon petition, and the attorney-general may or may not grant his fiat, just as it should appear to that law officer whether the Crown should interfere or not. The theory is perfectly clear. The Crown, it is said, has been induced to do a wrong; the remedy provided for a case of that sort is a petition for a process. The Crown refers the matter to its law officer, and if the law officer thinks fit to advise the Crown not to interfere, the subject has no remedy. The proceeding goes upon the notion that it is a complaint against the Crown, except in cases where the controversy lies between two grants of the Crown—that is, when the question is, which of the two grants shall prevail?—and then it is a

Practice.

^(j) 3 Blac. Com. 260, et seq., per Coleridge, J.; 2 Saund. 72, u, ed. 1844.

^(k) Sir Wm. Follett, *arguendo* Regina v. Neilson.

matter exclusively between subject and subject, and in that case only is the writ said to be granted *ex debito justitiæ*. In all other cases it falls under the rule of our law, which does not permit a complaint to be made against the Crown, except with the permission of the Crown. If so, the attorney-general has a right, if he chooses, to refrain from issuing his fiat, without which no proceeding can be taken."

A practice has, of late, been introduced, of entering a caveat against the issue of the writ of *scire facias* at the chambers of the attorney-general, upon which the parties come before him.

Caveat against the issue of a *scire facias*.

It has been said, that in a case where there have been two patents granted for the same thing, the writ issues *ex debito justitiæ*. The application of this rule appears to have been confined to cases where a market or fair has been granted, to the prejudice of an ancient market or fair. (l)

Scire facias, when it issues *ex debito justitiæ*.

Upon this point a question arises: if two patents for inventions are granted for the same thing, has the prior patentee a right to the writ of *scire facias*?

Mr. Webster, (m) in a note, says, "In the case of an invention, how is it to be determined they are the same?— and if the same, the first patent may be equally invalid." It is clear, if the latter specification claims the same rights as the prior one, or if it be proved that the two patents were identical, that the latter could be repealed by a proceeding upon *scire facias*; but the doubt the reporter seems to have, is whether the writ is demandable by the first patentee as of right. The argument in the case of *Regina v. Neilson* was, whether or not the Lord Chancellor (the writ having issued) had power to stop the proceedings or quash the writ; the argument only turned incidentally upon the right the

(l) Saund. Rep. 72, u, ed. 1844.

(m) Webs. Pat. Ca. 667.

patentee had to demand the issue of the writ. His lordship gave no opinion thereon, but directed the proceedings to stay, until after a case, pending between the parties, had been heard in the House of Lords.

It is submitted, that in the case of an invention, the writ is not demandable by the prior patentee as of right, but it is apprehended it would be granted in all cases where sufficient grounds were shewn for its issue. The reasons which appear to determine this subject are as follow: In the case of a market, &c., the after-grant infringes upon the private rights of an individual; and though its allowance may be a convenience to a particular district, yet it is also to the prejudice of that wherein the ancient market existed. But in the case of a patent upon a patent for an invention, a much more extensive infringement arises. In this case it cannot be said to be merely in prejudice of the rights of an individual, but of the community generally; for, by an undue extension of the time for which the monopoly was granted, it is an usurpation or assumption on the part of the Crown in contradiction to the rights conceded to the public by the Statute of Monopolies, and by consequence an infringement of the general rights of the community. In which case, the proceedings must be said to be such as concern the Crown (for its prerogatives are brought into question), and the rule of law mentioned by Sir W. Follett would apply, and the second patent being a wrong wrought to the community generally, one individual more than another would have no right to the writ; therefore, any proceeding which might be allowed, must be considered as a proceeding *ex gratiâ*. In the former case, the infringement is immediately of an individual right, and the party aggrieved would be the person who has a right to institute the inquiry, though mediately the rights of a particular district are concerned. In the latter case, the pa-

tentee and the public are immediately concerned, for the public, after the lapse of the period of the original grant (unless under particular circumstances),⁽ⁿ⁾ have a right to the use of the invention, and the second grant would be a perpetuation of that monopoly to the prejudice of the public. In any other case of infringement than that first mentioned, the writ cannot be demandable by an individual, for no particular, but a general, right is infringed; and it appears necessary that an individual right must have been infringed to make the writ demandable as of right.^(o)

It is said that the last patentee cannot apply for a *scire facias* for the purpose of repealing the prior patent,^(p) but in the case of a patent for inventions, such a proceeding can be had, on the ground of its invalidity, whether for deceit, inaccuracy of specification, or other sufficient reasons. The application is not made as being the application of a subsequent patentee, but as one of the public, any member of which may apply to the attorney-general for the purpose, but cannot demand the writ as a right; and this is a very usual mode of annoyance adopted against patentees; as where a *scire facias* is applied for by the first patentee, on the ground of the second patent being merely colourably different, the after patentee, out of revenge, applies for the abrogation of the prior patent, as for want of novelty, or some such defect, as in the cases of *Rex v. Hadden*, and *Rex v. Lister*, and *Rex v. Daniels*, and *Rex v. Furnell*.^(q)

Application for a *scire facias* by a subsequent patentee.

The proceedings upon a *scire facias* originate in the Petty Bag Office in Chancery. After the permission of the attorney-general has been obtained, instructions are given for the draft of the writ, which, after having been first settled by

Proceedings upon a *scire facias*.

(n) Vide Extension.

(o) Saund. Rep. 72, u.

(p) Saund. 72, u.

(q) Reported in Godson's Pat. Ca. 274.

the counsel for the prosecution, is taken to the attorney-general, who grants his fiat; but before he does so, the prosecutor and two sureties have to enter into a bond for 1,000*l.*,^(r) conditioned to be void upon the payment of the defendant's costs (in event of the patents being confirmed), to be taxed as between attorney and client; and treble costs, if the defendant is entitled thereto, under the statute of 5 & 6 Wm. 4, c. 83, s. 3. This provision was enacted to protect the patentee against vexatious proceedings, the enactment being, if the patent right has before been brought into question, and the judge, whether in Chancery or at common law, certifies that fact, then the patentee shall be entitled to treble costs. ^(s)

Fiat, when granted.

When the fiat is granted, a summons is sent to the defendant, whereby he is informed that the writ is issued against him, and directs him to appear. ^(t) When he has appeared, he may then either plead in bar or abatement. The usual defence is the general issue, which compels the prosecutor to prove all the allegations.

Demurrer.

If the matter be insufficient in law, as in the case of pleading in a common action, the defendant may demur; ^(u) in which case, the whole record is sent to a court of common law, which decides as well the demurrer as the issue in fact.

Default by not appearing.

If the patentee, after having been warned twice, does

^(r) The reason why a security is required for costs is, that in cases where the Crown is concerned, costs are neither given nor received; and unless a bond was exacted, the patentee would bear his own costs, and might, if successful, perhaps from malice of disappointed or envious men, be continually subjected to such proceedings, but which the bond is calculated to stop.

^(s) Vide supra, p. 13, for stat.

^(t) The *scire facias* form recites the patent, and states the grounds upon which it is meant to be impeached.

^(u) Com. Dig. Pat. F. 8.

not appear, judgment to annul the patent may be had by default. If no defence is made, the judgment is by *nil dicet.* (v)

The issue on the *scire facias* is allowed to be tried at bar Trial, when at bar. only upon very particular reasons being given; otherwise, the trial is at *nisi prius*. At the trial, the patentee must be prepared most strongly to rebut every allegation in the writ.

If the verdict is against the patentee, a new trial will be New trial, when granted. granted, if he can shew that his case has not had the fullest investigation; but the matter for which it will be granted must be material—as the admission of improper evidence, going into matters not contained in the objections detailed, or some other weighty reason. An affidavit by the patentee, alleging surprise, on the ground that on a prior trial the sufficiency of the specification was the only matter gone into by the Court, and he therefore did not think that the novelty of the invention would be impeached, and which he did not come prepared to meet, such an objection was held insufficient. (w)

When the judgment is for the Crown, it is that the letters Judgment for the Crown. patent of our lady the Queen be revoked and the enrol-

(v) Com. Dig. Pat. F. 8.

(w) Motion for a new trial on affidavit of Mr. Arkwright, that on the first and second trials the sufficiency of specification was the only motion gone into by the Court, and on the *scire facias* being brought, he supposed it was only to procure in another shape a revision of the same question, and that he did not expect the origin of invention would be attacked, and that he could disprove the weight of the evidence adduced. That the supposed immaterial articles in specification were necessary when the machine was employed on wool, and it was therefore necessary to insert them. New trial refused. There are two questions to be tried, the specification and the origin of the invention, and this proceeding is brought finally to conclude the motion, for it is a *scire facias* to repeal letters patent. The questions to be tried are stated upon record; there is no colour to try the cause again. (144.) Lord Wynford, C.J. Dav. Pat. Ca.

Cancelling in law.

ment cancelled; (c) it is doubtful whether the defendant can be compelled to deliver them up to be cancelled. (y) The entry of a *vacatur* upon the enrolment of the patent is a sufficient cancelling in law.

Scire facias, what a sufficient foundation for.

Any thing which goes to the validity of a patent, and would be a defence in an action at law for an infringement, would be a sufficient matter whereon to found a proceeding by *scire facias*; the failure of an action through insufficiency of evidence, or for matters purely technical, would afford no ground.

Scire facias pending an action.

The issue of a *scire facias* is no ground for preventing the trial of an action for an infringement of a patent; (z) but where a motion is for a nonsuit, (a) or where there

(x) Com. Dig. Pat. F. 8.

(y) In a very late case (*The Queen v. Newton*, reported in *Newton's Repertory*, vol. xxvi. p. 361), where a proceeding was instituted in the Chancery court, to compel the production of the letters patent, in order to their cancellation by erasure and breaking off the great seal, and that the non-production of them by the defendant should be declared a contempt, the Lord Chancellor (Lord Lyndhurst) said he had no power to compel the defendant to produce them; and he (the defendant), by his counsel, denied that the patent was his, and that he had transmitted the letters patent to his client, who resided abroad, and had no power over them. After some further discussion upon the point, it was decided that the enrolment of the patent should be cancelled, that a *vacatur* should be entered upon the roll, and that the defendant should undertake to bring no writ of error, or make any assignment of the patent.

(z) *Muntz v. Foster*, 1 D. & L. 942; 7 Scott, 898, S. C.—Rule *nisi* to shew cause why proceedings in action should not stay until after trial of a *scire facias* to repeal which had been sued out, and which according to the ordinary business in the Queen's Bench, should have been tried before this, but owing to circumstances over which the prosecutors had no control, the matter was postponed. "As a general rule, plaintiff has a right to have his cause go to trial according to the ordinary course of business. This is not a sufficient case for the Court to interfere."—Tindal, C.J. *Haworth v. Hardcastle*, L.B.

(a) *Haworth v. Hardcastle*, supra.

has been a verdict for the Crown, with leave to move, in such case the Court will stay the proceedings until the question upon the *scire facias* is settled. (b) So in proceedings on a *scire facias* where the writ is returnable after the expiration of the patent, and there is an appeal pending in the House of Lords, the Lord Chancellor will stay the proceeding until the decision of the appeal. (c)

The writ of *scire facias* must not in general terms state that the matter of the patent is prejudicial to her Majesty's subjects, it must state positively in what way it is prejudicial; (d) and if there are any suggestions in the writ which are informal and improper, the attorney-general will enter a *nolle prosequi* thereto.

Statement on
a writ of *scire
facias*.

(b) *Smith v. Upton*, 6 Scott, 804; 6 M. & G. 251, S. C.—Action for infringement of a patent; venue in Middlesex; cause carried down by proviso.—A *scire facias* had been brought to repeal letters patent; a verdict was given for the Crown on all the material issues, with leave for the defendant to move to enter verdict for him. Motion had been made, and rule was pending in Queen's Bench. Upon affidavit of these facts, stating defendant on the record was the moving party in the *scire facias*, and that the questions intended to be raised were substantially the same as were involved in the inquiry in the other court, a rule *nisi* was granted for postponement until next sittings after Michaelmas Term. "Rule made absolute on payment by defendant of any costs plaintiff may have been put to in preparing for trial for sittings after this Term."—Vide *Haworth and Hardcastle*, S.P.

(c) *Regina v. Neilson*, Webs. Pat. Ca. 665.—Petition to stay proceedings on a writ of *scire facias* to repeal letters patent.—The petition set forth the letters patent and the invention, and stated suit against infringers, and pressed injunction granted thereon, &c., and that a writ of *scire facias* was issued, &c., and was not returnable until after the extension of the patent. Petition prayed the writ might be set aside, and all proceedings thereon to be stayed. His lordship directed the proceedings to stay until the House of Lords had given judgment in a case then pending before them between the parties.

(d) *Rex v. Arkwright*, supra.

Two persons cannot have a *scire facias* to repeal the same patent.(e)

(e) Sir F. Pollock, *arguendo*, Regina v. Neilson, *supra*.—Every person in the realm is interested in the continuance of the letters patent. The English are interested in the Scotch patents, and the Scotch in the English patents. After one person has sued out a *scire facias*, another cannot do it.

CHAPTER XII.

PLEADINGS—DECLARATIONS: FORMS—PLEAS: FORMS.

IN a prior part of this work, some general remarks were made upon pleadings in actions upon patents, it will therefore be unnecessary to repeat them—this chapter being devoted to the more technical consideration of the matter, and also to set out the various forms of pleading.

It is no bar to an action that the patentee has been defeated in a prior action,^(a) for until the patent has been repealed by *scire facias*, or lapsed by the expiration of the grant, a right is presumed to be in the patentee, and his remedy for an infringement of his right is by an action upon the case. The person to bring the action is he who at the time of the infringement had the right to the property. Mr. Godson says, ^(b) “That when the patentee has assigned, the assignee may sue alone, or the patentee may join in the action” (citing 2 Wilson, 423, 2 Saund. 115-16, a). This appears to be doubtful, for it must be presumed the assignor has parted with the whole of his interest; and the rule seems to be, that a person cannot join in an action for damages (which an action for the infringement of a patent essentially is, though the damages taken are often nominal, the plaintiffs being anxious to have their rights confirmed by the verdict of a jury), unless the damages when recovered would accrue to them jointly, for which reason tenants in common

Defeat of patentee in a prior action.

Remedy for infringement.

Assignee, suit by.

(a) *Arkwright v. Nightingale*, Dav. Pat. Ca. 52.

(b) *Godson on Patents*, 237.

Assignee, suit
by.

cannot join in real and mixed actions. (c) In such an action the assignee should set out the mode by which the assignment was made, and not merely aver that the letters patent became duly assigned, without shewing how, though a declaration containing such an averment would be good

Necessary alle-
gations in the
declaration.

after verdict. (d) The safe way would appear to be, to declare in the name of the assignee only. The patent must be set forth, and that it was made under the great seal, and profert must be made; butoyer is never allowed, being matters of record. Then the breach must be alleged. (e)

Action against
a public officer.

If the defendant be the public officer of a company, an allegation must be made to that effect in the declaration. (f)

(c) *Wilkinson v. Hall*, 1 Bing. N. C. 713.

(d) *Cornish v. Keene*, in error, *supra*.

(e) *Gibson v. Brand*, *supra*. Tindal, C. J.—An allegation in a declaration, that the defendant infringed the patent by making, using, and putting in practice the plaintiff's invention, is supported by proof that an order was given and executed in England for making articles by the same mode for which the plaintiff obtained his patent, and which articles were afterwards received by the defendant, and is sufficient "to satisfy an allegation that he made those articles, for he that causes and procures to be made may be well said to have made them himself."

(f) *Galloway and Routledge v. Bleadem*, public officer, 1 M. & G. 247.—Declaration stated invention of certain paddle-wheels, for which a patent was granted, &c. Breach. Covenant—made paddle-wheels in imitation of said invention, and sold, &c., without, &c. Pleas—not guilty; not first and true inventor; nature of invention and manner of performance not particularly described and ascertained according, &c.; not new invention. Replication joined issue on the three first pleas, and took issue on the fourth, asserting the invention was a new invention, &c., and had not been publicly practised and used, &c.; admissions were made by the defendant's attorney, in the whole of which the company are mentioned as defendants. At the trial, the jury found a verdict for the plaintiff on all the issues, with nominal damages. Application was made to the judge to give a certificate, under 5 & 6 Wm. 4, c. 83, s. 5, and to certify for a special jury. The judge reserved the question as to the certificate, but certified for special jury. In Hilary Term a rule was obtained,

FORMS OF DECLARATION.

DECLARATION FOR THE INFRINGEMENT OF A PATENT.

In the Queen's Bench,

the day of , in the year of
our Lord, 18

Middlesex, } A. B. (the plaintiff in this suit), by E. T., his attorney, complains
to wit. } of C. D. (the defendant in this suit), who has been summoned to answer the said plaintiff in an action upon the case. For that whereas the said A. B., before and at the time of making and obtaining of the letters patent, and of committing the grievances of the defendant, as hereinafter mentioned, was the first and true inventor of a certain [*describe the invention*], and thereupon our lady the Queen, heretofore, to wit, on [*date of letters patent*], by her letters patent, bearing date at Westminster, the day and year aforesaid, under the great seal of England, and which said letters patent the plaintiff now brings into court, reciting that [*set forth the recital—grant of the patent, condition of enrolment of the specification, and the clauses prohibiting the exercise of it by others*], as by the said letters patent, reference being had thereunto, will fully and more at large appear. And the plaintiff further saith, that he did afterwards, to wit, on [*day of enrolment of the specification*], in pursuance of the said proviso and of the said letters patent, by an instrument in writing, under his hand and seal, particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed and executed, and did afterwards, within [*time for specifying*] calendar months, next and immediately after the date of the said letters patent, to wit, on the [*day of enrolment*], cause the said instrument in writing to be enrolled in her Majesty's High Court of Chancery, at Westminster, in the county of Middlesex, as by record of the said instrument in writing, now remaining of record in the said High Court of Chancery, more fully appears. And the plaintiff further says, that he did always from the time of making the said letters patent as aforesaid, by himself, servants, deputies, and agents in that behalf, make, use, exercise, and vend his said invention. Yet the defendant, well knowing the premises, but continuing and wrongfully and injuriously intending to injure the plaintiff, and to deprive him of the profit he

calling on the plaintiff to shew cause why judgment should not be arrested for an insufficiency in the declaration, it not being therein alleged that Bleaden was a registered officer of a company, and a rule also was obtained, calling on the plaintiff to shew cause why the *nisi prius* record should not be amended, by inserting, &c. The Court refused to allow amendment unless plaintiff would pay costs of the rule for arresting judgment, and of the application, and forego the costs of the action. Declaration should state (when action is against public officer) the fact.—7 Wm. 4 & 1 Vict. c. 73, s. 3.

would otherwise acquire by the exercise and use and sale of the said invention in the said letters patent mentioned, and within the said term of years therein mentioned, to wit, on (*some day before the service of the writ after the grant of the letters patent*), and on divers other days and times between that day and the commencement of this suit, and within, &c. [*state the breach*], whereby the plaintiff hath been, and is, greatly injured, and deprived of a great part of the profits and advantages which he might and would otherwise have derived and acquired from the same invention. To the damage of the plaintiff in and thereupon he brings his suit, &c.

ACTION FOR INFRINGEMENT OF A PATENT BY AN ASSIGNEE.

For that whereas X. Y. (*the patentees*), before and at the time, &c. &c. [*as in the form above, immediately after the averment of the filing of record, &c.*] And the plaintiff further says, that the said X. Y. afterwards, and before the committal of the several grievances hereinafter mentioned, to wit, on the [*date of assignment*], by a certain indenture made between the said X. Y., of the one part, and the said A. B., plaintiff herein, of the other part, which said indenture, sealed with the seals of the said parties respectively, the plaintiff now brings into court, the day of the date whereof is the day and year last aforesaid, for the consideration therein mentioned, did, amongst other things, assign and transfer unto the said A. B. [*state the words of the assignment*], as by the said indenture, reference being had thereunto, will more fully and at large appear. And the plaintiff further says, the said X. Y. did always, from the time of the making the said letters patent as aforesaid until the making of the said indenture, by himself, &c. [*as in form above*], and that he, the plaintiff, hath always, from the time of making the said indenture, hitherto, by himself, his deputies, servants, and agents, made, used, exercised, and vended the said invention, to their great advantage and profit; yet the defendant, &c. &c. [*proceed as in the form above*].

ACTION FOR AN INFRINGEMENT WHERE THE PLAINTIFF HAS DISCLAIMED
PART OF THE INVENTION.

For that whereas [*as in the form supra, p. 165*] was the first and true inventor of so much of certain improvements in [*state the invention*] mentioned in the said letters patent hereinafter stated, as is not hereinafter mentioned to have been disclaimed by him [*then proceed as in the first form, after stating the enrolment of the letters patent*]. And further the plaintiff saith, that afterwards, and before committing any of the grievances by the defendant as is hereinafter mentioned, and after passing the statute of the fifth and sixth of Wm. 4, c. 83, to wit, on the 1st day of March, in the year of our Lord 1844, the plaintiff, pursuant to the said statute, and by the leave of the then attorney-general, entered with the clerk of the patents of England a disclaimer of part of the said specification which has been so enrolled as aforesaid, and also a memorandum of alteration of part of the specification, and of the title of the said invention in the said letters patent men-

tioned, which said disclaimer and memorandum of alteration were in writing, under the hand and seal of the plaintiff, and bore date the day and year last aforesaid; and the plaintiff did therein and thereby state the reason of the said disclaimer and alteration, pursuant to the said statute; and that the said disclaimer and memorandum of alteration did not extend the exclusive right granted by the said letters patent; and the plaintiff says, that the said disclaimer and memorandum of alteration were afterwards, to wit, on the 5th day of March, in the year last aforesaid, filed by the said clerk of patents, and enrolled with the said specification, according to the form and by virtue of the said statute, as by the record of the said specification and disclaimer and memorandum of alteration, remaining of record in the said High Court of Chancery, will fully appear; and that the title of the said invention, as altered by the said disclaimer and memorandum of alteration, was and is as follows, that is to say [*state the title*]; and the plaintiff says that, after making the said letters patent, and entering, filing, and enrolling the said disclaimer and memorandum of alteration as aforesaid, and within the term, &c., set out breach, &c. &c. (*f*)

PLEAS.

By the new rules, (*g*) the defendant must specially plead any defence he may have to the declaration; formerly the plea of not guilty put in issue the whole of the declaration, but it now only puts in issue the particular infringement complained of; and with the pleas it is necessary to deliver a list of the objections intended to be relied upon at the trial. (*h*)

Pleading requirement by the new rules.

Requirement by statute.

In several cases, instead of describing the invention in words, after setting out the specification, copies of drawings were annexed to the pleadings, describing the invention. In a late case, on an application to a judge at chambers to strike out the drawings, his lordship refused to make an order, whereon an application was made to the Court and

Annexing drawings to pleadings.

(*f*) Vide Chitty's Forms (vol. ii. p. 577-8) for various counts in declarations, for making imitations, counterfeiting, &c.

(*g*) Hil. Term, 4 Wm. 4.

(*h*) 5 & 6 Wm. 4, c. 83, s. 5. Vide supra, Objections.

Annexing drawings to pleadings.

a rule *nisi* granted, so the matter will possibly be argued in the next Term.⁽ⁱ⁾ Considering the nature and intention of the pleading, and how gradually the system grew, it seems impossible to conceive that drawings can be admitted in the place of words; for if allowed in patent cases, it from analogy would grow into a practice, and must necessarily be allowed in other cases; especially in those where it was necessary to set out boundaries, resort would be had to plans, which would only have the effect of introducing confusion. Words are understandable by every person, and it is easy to discover whether they describe the matter intended to be presented; but if resort were had to plans, it is more than doubtful whether even the truth would be elicited. It is apprehended the plan of introducing drawings into pleading upon patents cannot be supported, being contrary to the very spirit and intention of pleading, which requires the utmost particularity. All matters of objection to a patent must be set forth with the greatest nicety.

Introduction of drawings into pleadings, contrary to the spirit of pleading.

Not a manufacture.

If the objection is, that the patent is granted for a matter

(i) *Lealey v. Browne and Another*, 9 Jurist, 537.—Case for infringing a patent.—The third plea set out the whole of the specification, and annexed to it certain drawings, purporting to be copies of the drawings annexed by the plaintiff to his specification; the sixth plea averred that the plaintiff had enrolled no other plea than that set forth in the third plea; and application had been made to Williams, J., at chambers, to strike out the third and sixth pleas, or the drawings contained or referred to in them, on which application no order was made. Application was now made to Williams, J., in court, to strike out the third and sixth pleas, on the ground that they were insensible, except by reference to certain drawings; or why not strike out the drawings as surplusage, and contrary to the rules of pleading? Williams, J.: “Can the plea be intelligible without the design to aid the eye?” The rule *nisi* was granted on the ground that as the drawings had been before used in pleadings without objection, it would be preferable to have the matter argued in full court.

not within the statute of Jac. 1, it must be expressly set forth, and in the language of the statute, (j) for the plea Not a manufacture within, &c.

(j) *Spilsburry and Abbott v. Clough*, 2 Gale & Dav. 17.—Plea—that the said invention in the said letters patent mentioned was not, at the time of making the said letters patent, a new manufacture within this realm, within the true intent and meaning of the act of Parliament in that case made and provided; to which there was a demurrer: “That it does not appear with certainty whether it is intended to dispute that the invention is new or that it is a manufacture within the meaning of the statute; and although in the plea it is alleged that the said invention was not at the time of making the letters patent a new manufacture, yet it is not stated, nor does it appear thereby, whether the said defendant intends to rely upon the fact, that the invention was at the time of making the said letters patent publicly known, or that the said invention was not new to the inventor, and also that the plea attempts to put in issue matter of law, viz. whether the invention is a manufacture within the meaning of the statute.” Notice was also given that the declaration would be objected to. The declaration was held to be good, *as to the goodness of the plea*. “Suppose the words of the statute had been followed, then I think it would have fallen within that rule of law which allows of a complicated position, though consisting of several facts. But the words of the statute are not followed; which are, ‘the sole working or making of any manner of new manufacture within this realm.’ Therefore, being used in the ordinary sense, it is left doubtful whether the objection is that the invention is not new, or that it is not a manufacture within the statute of James. The plea is bad.”—Lord Denman, C.J. “If the plea had omitted the words ‘within this realm,’ it might have been good; but, as it stands, it applies those words to the invention, whereas the Act applies them to the working or making.”—Wightman, J.

Walton v. Potter and Horsfall, Webs. Pat. Ca. 598.—Plea—that the invention was not, at the time of making the said letters patent, a new invention, as to the public use and exercise thereof within England; setting out specification, and averring that the said invention was unfitted and useless for the construction of sheet-cards and top cards, as therein described. Under these pleas, it was contended, that the objection that the invention was not the subject-matter of letters patent, being the application of a known substance to a purpose, and in a manner well known, was open to the defendant. (On motion in arrest of judgment), the matter was not expressly

Must not be ambiguous.

must set forth the matter of the defence, and not be so framed as to leave the plaintiff in doubt as to the defence intended to be adopted.

Title larger than the specification.

If the objection be that the title is larger than the invention, it must be directly raised; an averment that the specification is insufficient does not raise the question. (*k*)

For a principle.

So where the objection is, that the patent is for a principle, it must be made the ground of a substantive plea, and is not put in issue by a plea that the invention is not new. (*l*)

Denial of utility.

When the objection is, that the invention is not useful, a plea merely denying the utility is insufficient; "it should, as in *Arkwright's* case, positively say it is prejudicial." (*m*) Parke, B., in the case of *Morgan v. Seaward*, (*n*) said, "The grant of a monopoly for an invention which is altogether useless may be well considered as mischievous to the state—to the hurt of trade, and generally inconvenient within the meaning of the statute of James 1, and that it might be the proper form (in such a case) to use the words of the statute, and not to plead the want of utility. So the utility of an invention cannot be put in issue by a plea that the plaintiff is not the first inventor." (*o*)

decided, the Court being of opinion that this objection upon the pleas was not open to the defendants. Third issue only raises the question whether, being a manufacture, it was in public use and exercise at the time the patent was granted or not, and not whether it was a manufacture within the meaning of the stat. of Jac. 1. (661.)

(*k*) *Derosne v. Fairlie*, supra.

Neilson v. Harford, Webs. Pat. Ca. 312.—Pleas—not guilty, not true invention, invention not new; setting out specification, and traversing compliance with the rule, as to the description, enrolment, &c.; not useful. Parke, B., in addressing the jury, held that, under these pleas, the title to the patent was not put in issue.

(*l*) *Househill Company v. Neilson*, Webs. Pat. Ca. 667; *Jupe v. Pratt and Another*, *ibid.* 161.

(*m*) Per Alderson B., *Jupe v. Pratt*, supra.

(*n*) Supra.

(*o*) *Househill Company v. Neilson*, Webs. Pat. Ca. 690.

When the objection is, that the specification does not sufficiently describe the invention, it must be directly put in issue, for many slips in pleading are cured after verdict; for it is a rule of pleading, that if an issue could have been material, the Court, after verdict, ought to intend it so. (p) In the case of *Morgan v. Seaward*, (q) a plea was, "that the said invention was not an improvement in steam-engines." The Court said, "On reference to the specification and by what appears upon the record, it is by no means clear that the patentee does not claim an improvement in steam engines unconnected with machinery, and if he does not, the plea would be probably bad on demurrer, as it is uncertain whether the plea does not deny the invention to be an improvement in steam-engines unconnected with machinery." So under the issues of infringement and denial of the originality of the invention, an objection founded upon the vagueness of the specification is not raised. (r)

When there is a confession of an infringement, the avoidance must be plain and direct, and some matter of law must be shewn whereby the patent is rendered void; an averment in a plea that the defendant was under a license obtained from another and that the patent is insufficient. (s) So where the declaration is for an enrol-

Not sufficiently describe the invention.

Infringement and denial of originality.

Confession and avoidance.

(p) *Kemp v. Crewes*, 1 Ld. Raym. 187.

(r) *Russell v. Crichton*, Veb. Pat. Ca. in notes 77.

(s) *Stocker v. Waller and Others*, 9 Jurist, 136.—Case for infringing patent for certain improvements in pumps.—Declaration set out patent and enrolment, and entry of a disclaimer; and alleged that after making letters patent and entry of disclaimer, the defendant made and sold certain, &c., in imitation of the said invention. Plea—after grant of letters patent, and before declaration, her Majesty did grant to B. letters patent for a certain invention of improvements in water-closets and stuffing-boxes applicable to pumps and cocks, and the defendants say the said patent is still in force, and is not void; and that by license of the said B., use said inven-

Enrolment. ment of a specification, and a plea setting forth the proviso, and averring that no other specification was enrolled, is bad, for it does not traverse the averment in the declaration; and if intended as a traverse, it is circuitous and bad, and amounts to an argumentative denial. (t) A plea denying that the grantee of letters patent ascertained and described the nature of his invention should conclude to the country; if it is concluded with a verification, it is bad upon special demurrer. (u)

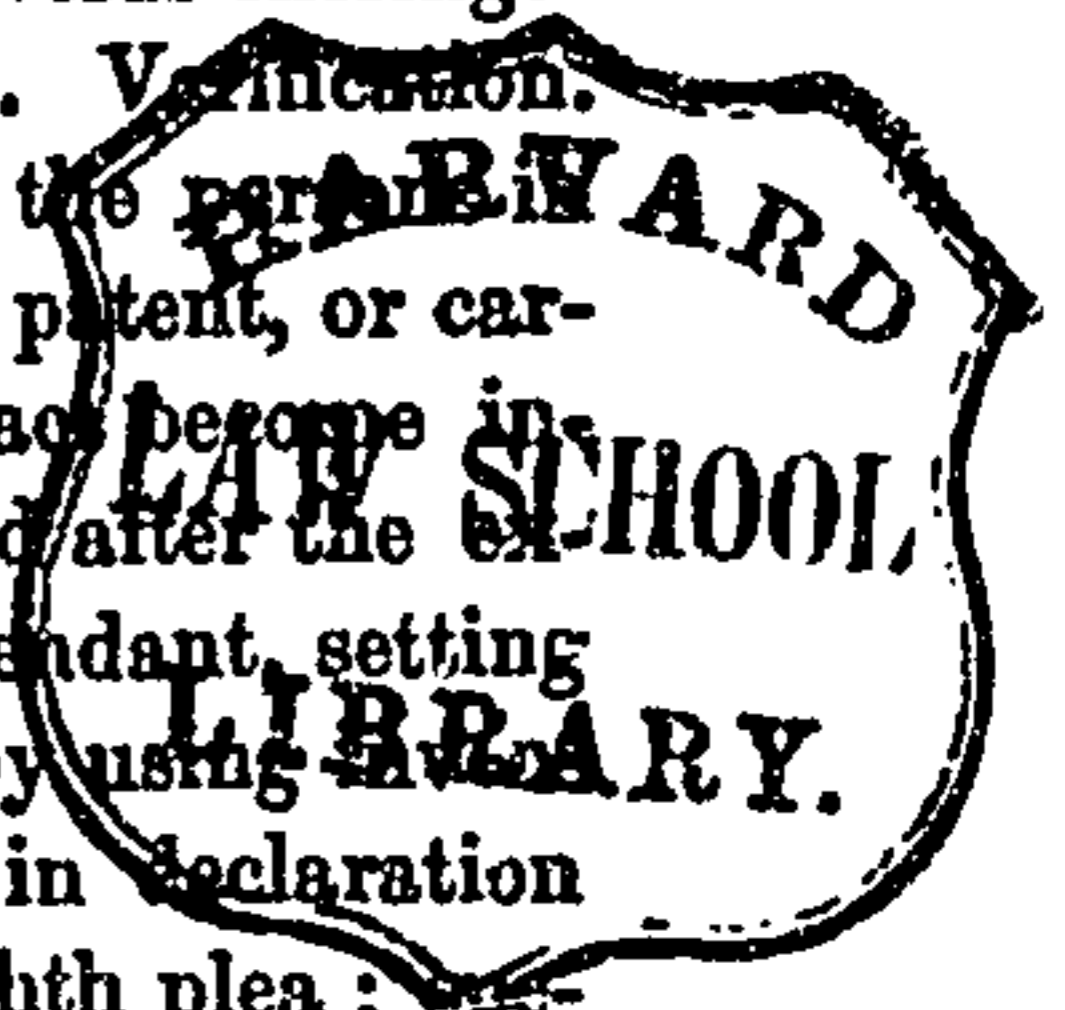
tion, so far as relates to stuffing-boxes applicable to pumps; and that they have used said invention, &c. Verification. Demurrer, for that it is no answer to an infringement, by default of the letters patent, that the defendants work under a license from another and subsequent patentee, and other points. Tindal, C. J.: "I consider the plea to be bad: it assumes to be in confession and avoidance of the cause of action alleged in the declaration; the confession, which I will assume to be good, must amount to an admission of an infringement of that portion of plaintiff's patent which remains after effect is given to the disclaimer. But there is no sufficient avoidance; it ought to shew that the patent of the plaintiff, as diminished by the disclaimer, is void in law. The fact of disclaimer does not necessarily import the original patent was void, for the object of the statute was not only to enable inventors to set themselves right when their patents would have been void, but to remove doubts which otherwise hang over the parties bringing actions for infringements, by enabling them to disclaim a part of the specification.

(t) *Muntz v. Foster*, 7 Scott, N. R. 471; 1 D. & L. 737.

(u) *Bentley v. Gouldthorpe and Another*, 4 Law Times, 414.—Declaration set out letters patent for making cards for carding cotton, and enrolment of specification, and that patentee assigned to A., who assigned to B. Breach—making, using, &c. said invention; making, using, putting in practice said invention; making, using, and putting in practice said invention; making, using, and putting in practice part of said invention; counterfeiting, imitating, and recently making, &c. divers additions, &c. and pretending to be inventors. Plea—patentee did not ascertain, &c., according to meaning, &c. of letters patent. Verification. Demurrer. Plea neither traverses nor confesses any material averment of declaration, and is ambiguous as not averring patentee did particularly describe, &c., and uncertain whether such plea intends to traverse averment in

declaration, or to confess and avoid the same by virtue of some new matter. If former, it should have concluded to the country; if latter, defendant should have set out new matter, by force, &c.: defendant seeks to avoid averments in declaration, and should have concluded to the country. Tindal, C. J., in delivering judgment said, "The question is, whether seventh plea should have concluded to the country, which depends whether averment in declaration, which the plea in terms denies, was a material averment. If so, it should have concluded to the country. We are of opinion the averment was material. The meaning of the condition is (specifying) that if specification be not enrolled within six months, patent is void; if not from date of patent, at all events from the end of six months. It is alleged in the plea, that the grantee of the letters patent did not particularly describe and ascertain the notification of his invention, according to the meaning of the letters patent, referring to the declaration; it alleges filing of specification, so in substance the plea seems to have denied the averment *modo et forma*. We think plea should have concluded to the country."

Stead v. Carey, 5 Law Times, 74.—Declaration stated grant of patent for wood-paving, and that a specification should be enrolled in four months, which was not enrolled until six months, and then averred an act of Parliament was obtained to form a company to carry out patent, and that specification enrolled six months after should be as effectual as if enrolled within time named in letters patent. Declaration then assigned breaches, several infringements of patents. Pleas—seventh, title was too large. ^{Verification.} Eighth, reciting act to establish a company, and that the person by the said act mentioned had not purchased said letters patent, or carried on trade, &c., and no company, &c., and said act became inoperative. Ninth recited, before passing said act, and after the expiration of the four months, a patent was granted defendant, setting out, and justified infringement of plaintiff's patent, by using invention of defendant. To seventh plea, letters patent in declaration stated was granted for, &c. General demurrer to eighth plea; special demurrer to ninth. The objection was, that the word *of* making and paving, &c., and not *for* making, &c., was used, which Tindal, C. J., held, "was got rid of by the allegation, in manner and form as the defendant has above thereof alleged," which we see, on looking at the plea, the traverse is good; it says he did not take out the letters patent by that description. "By the act, Stead's patent was confirmed in substance as well as in words."—Tindal, C. J.



FORMS.

PLEA, NOT GUILTY.

In the Queen's Bench.

The day of , in the year of our Lord 18 .

C. D. } The defendant, by J. B., his attorney, says that he is not, nor was,
 a t s } guilty of the said alleged grievances above laid to his charge, or
 A. B. } any or either, or any part thereof, in manner and form as the
 plaintiff hath above thereof complained against him, and of this he puts himself
 upon the country.

PLEA, THAT THE PLAINTIFF WAS NOT THE FIRST INVENTOR.

And for a further plea in this behalf, the defendant says, that the plaintiff was not at the time of the making of the said letters patent the true and first inventor of the said [*set out the invention*], in manner and form as the plaintiff has in the declaration in that behalf above alleged, and of this the defendant puts himself upon the country.

THAT THE PLAINTIFF IS NOT THE FIRST INVENTOR OF PART OF THE INVENTION CLAIMED.

And for a further plea in that behalf, as to so much of the said alleged invention and improvements in the said letters patent mentioned, and in the said specification firstly described, the defendant says that the plaintiff was not, at the time of the granting of the said letters patent in the said declaration mentioned, the true and first inventor of the said supposed improvements or inventions in manner and form as the plaintiff has in the said declaration in that behalf alleged—country, &c.

THAT PART OF THE INVENTION WAS PUBLICLY USED AND KNOWN.

And for a further plea in this behalf, the defendant says, the said alleged inventions and improvements in the said letters patent mentioned, and in the said specification firstly described and ascertained, were not at the time of making the said letters patent, or of the presenting of the said petition therein mentioned, a new invention or improvement, but part thereof, to wit, so much of the same as is firstly described in the said specification, had been and was long before the said petition and grant of the said letters patent, publicly used and made, and openly exhibited for sale, to wit, by the defendant, in that part of the United Kingdom of Great Britain called England, nor was nor were the said alleged improvements and inventions invented or found out by the plaintiff; by reason whereof the said letters patent were wholly void; and this the defendant is ready to verify.

THAT THE PLAINTIFF DID NOT SPECIFY THE NATURE OF HIS INVENTION.

And for a further plea in that behalf the defendant says, that the plaintiff did not, by any instrument in writing, particularly describe and ascertain the nature of his said invention, and set forth in what manner the same was to be performed, in manner and form as the plaintiff has in that behalf above alleged—country, &c.

THAT THE PLAINTIFF DID NOT ENROL THE SAID SPECIFICATION.

And for a further plea in this behalf, the defendant says the plaintiff did not cause any instrument in writing particularly describing and ascertaining the nature of the said invention, and in what manner the same was to be performed, in manner and form as the plaintiff has in the declaration in that behalf above alleged; and of this, &c.—country.

THAT THE INVENTION IS NOT USEFUL.

And for a further plea in this behalf, as to the said improvements and discoveries in the said declaration mentioned, the defendant says that they were not, at the time of granting the said letters patent, nor have been, nor are, from thence hitherto, of any public or general use, or benefit, or advantage whatsoever, nor were nor are the same, in fact, any improvement whatever, or in any manner beneficial to the public; by reason whereof the said letters patent were, and still are, wholly void and of no effect; and this—verification, &c.

THAT HER MAJESTY DID NOT GRANT THE LETTERS PATENT, &c.

And for a further plea in this behalf, the defendant says that our lady Queen Victoria did not grant in manner and form as in the said declaration alleged; and of this, &c.—country.

THAT THE INVENTION WAS NOT THE PROPER SUBJECT OF A PATENT.

And for a further plea on this behalf, the defendant says that the said supposed inventions, improvements, or discoveries in the said letters patent in the said declaration mentioned, and in the said specification described, were not, at the time of making the said letters patent, or of presenting the said petition, nor are nor ever have been from thence henceforth, a manufacture properly and lawfully the subject of letters patent, according to the form and within the intent and meaning of the statute in such case made and provided—(and this—verification).

THAT THE INVENTION WAS NOT NEW.

And for a further plea in this behalf, the defendant says, that the said alleged invention or discovery in the said letters patent and instrument in writing mentioned, described, and ascertained, was not, at the time of making the said letters patent, a new invention as to the public use and exercise thereof in the United

Kingdom, nor was the same invented or found out by the plaintiff; by reason whereof the said letters patent were and are wholly void; and this, &c.—verification.

THAT THE LETTERS PATENT WERE OBTAINED BY FRAUD.

And for a further plea in this behalf, the defendant says, that the letters patent in the said declaration mentioned were procured through and by reason of the fraud and misrepresentation of the plaintiff, and of others in collusion with him; and this—verification, &c.

LEAVE AND LICENSE.

And for a further plea in this behalf, the defendant says, that he committed the said grievances in the declaration mentioned, at the time in the declaration in that behalf mentioned, by the leave and license of the plaintiff, to him first given and granted for that purpose, as he lawfully might, for the cause aforesaid; and this, &c.—verification, &c.

CHAPTER XIII.

NOTICE OF OBJECTIONS.

BEFORE the statute 5 & 6 of Wm. 4, c. 83, patentees, upon bringing actions against the infringers of their rights, were put to great and often needless expenses, by not knowing upon what particular part of their invention the defendant would ground his defence, or by what particular defect he would endeavour to extenuate, or rather to justify, his infringement. In order to guard the plaintiff against such needless expenses, the above statute was enacted. (a) Before that time, the plaintiff was obliged to be armed with proof at all points to support his patent, but now his attention is directed only to particular points, and on examination, if he finds he cannot rebut, he can abandon the action without incurring the great expense its prosecution would occasion him. Benefit of the
5 & 6 Wm. 4.

Objections, in-
tention of.

By the 5th section of the statute, (b) it is directed the defen-

(a) *Fisher v. Dewick*, 4 Bing. N. C. 716.—The object of the statute was not to limit the defence, but the expense, and more particularly to prevent the patentee from being upset by some unexpected turn of the evidence, it was intended the defendant should give an honest statement of the objections on which he meant to rely. (710.) “The protection of the patentee was the object of the statute, as particulars so general afford no assistance.”—Park, J. (710.) “And let the patentee know what objections he had to meet.”—Vaughan, J. (711.) “The Court should see that the objections are stated in a definite and intelligent form before trial; the defendant may bring forward any number of objections, but he must state with precision what they are.”—Coltman, J. (711.)

(b) *Supra*, p. 15.

dant shall deliver with his pleas a notice of the objections to the patent upon which he intends to rely, (*i. e.*) to shew in what the patent is defective, and if he succeeds in proving his objections, his use of the protected manufacture would be justified, and the verdict would be against the patentee. But even this provision is not in all cases a sufficient guard. Mr. Justice Cresswell proposed to extend the rule farther than the statute directed. In the case of *Walton v. Bateman and Others*, (*c*) his lordship said, "I cannot help thinking that it would be a very good rule to establish, that with the notice of objections the defendant should be compelled to say under which plea he means to bring forward the different objections." No case which the author has met with has gone as far as the observation of his lordship pointed; and it will be found, by a perusal of the cases cited under this heading of the subject, that their lordships are careful, upon the matter being submitted to them, that no vague or indefinite objections are allowed, and which vigilance goes far to obviate the necessity of the step suggested by his lordship above, to cure the evils to which he adverted as prompting his observation. (*d*)

Stringency of the construction of the notice of objections.

Effect of non-delivery of notice of objection.

The objections are demandable by the force of the statute, and their delivery would be compelled, on application, by a rule of court granted for that purpose. If the defendant fails to deliver them, it is apprehended the plaintiff could not treat pleas delivered without them as a nullity, and sign judgment as for want of a plea; though it is said

(*c*) *Webs. Pat. Ca.* 616.

(*d*) "I fear that in this case and in others, objections so drawn, without any specific statement as to the plea under which they are to be given in evidence, instead of serving to help us in the due administration of justice, may serve as traps and pitfalls for judges and juries to be caught in."—*Coltman, J.* And see further observations in note *d*, *Webs. Pat. Ca.* 268.

the objections are a part of the case, (e) and without them the defendant could not proceed with his justification, for the words of the statute are express,—“and no objection shall be allowed to be made in behalf of such defendant, unless he shall prove the objections stated in such notice.” (f) The words of the statute upon a default would appear to point to a judgment of *nil dicet*. It is presumed, on refusal, the Court would act summarily and grant an attachment against the defendant, his attorney, or both, for contempt. One case only appears upon record wherein the pleas were delivered without notice of objections, and which occurred almost immediately after the statute came into operation; in that, the Court directed the objections to be delivered, and the pleas pleaded to stand, on the assumption of the defendant's having pleaded *de novo*. (g)

The objections must be more definite than the pleas (though there may be cases in which the language of the pleas might be sufficient in every respect to satisfy the intention of the statute). (h) They must particularly state the matters which militate against the stability of the patent. (i) Yet, at the same time, they must not go beyond

Objections
must be defi-
nite.

(e) *Neilson v. Harford and Others*, vide *Webs. Pat. Ca.* 309, *in notis*.—The objections being read, do not give the right to a reply; for they are a part of the case, and should be read when the pleadings are read.

(f) 5 & 6 Wm. 4, c. 80, s. 5; *supra*, pp. 15, 16.

(g) *Losh v. Hague*, *Webs. Pat. Ca.* note a, 205.

(h) *Neilson v. Harford*, *supra*.—Case. “But it may be that the plea itself is sufficiently explicit, then the words of the plea would be sufficient.”—Alderson, B. In delivering the judgment of the Court, in the case of *Neilson v. Harford*, Parke, B., said, “The objection may be so fully and completely expanded upon the record, that a mere transcript of the plea itself may be sufficient; in other cases the plea may be so general in its language, as to be insufficient as a notice, if transcribed from the plea merely. Each case must depend upon its peculiar circumstances.”—*Ibid*.

(i) *Jones v. Berger*, 5 M. & G. 208; 6 Scott, 208, S.C.—Case—

the pleas; (*i. e.*) they must not include matters to which

Infringement of a patent for a mode of treating farinaceous matters for the purpose of obtaining starch and other products, and in manufacturing starch. Pleas—Not guilty; not first inventor; did not particularly describe and ascertain nature of said invention; that said invention was in use at and before the time of obtaining the patent. Objections—That Jones was not first and true inventor, the invention having been made public in two prior specifications of patents (naming persons), and also by other persons, and in other books and writings; that said specification does not sufficiently distinguish between what is old and what new; that the process is not beneficially applicable for obtaining starch from all farinaceous matter, and that patentee did not state in said specification the most beneficial manner with which he was acquainted for obtaining the same; that the directions are not such as would enable any ordinary workman to make starch of a quality suitable for the general purposes of commerce, and the specification is in other respects insufficient, and calculated to mislead; that said invention was in use before, particularly as applied to rice and rice-flour, was known and in use, and practised by persons engaged in the manufacture of lace, and such fabrics, and in clear-starching. “The new rules of pleading were promulgated in Hilary Term, 1834; the new Patent Act, 1836 (5 & 6 Wm. 4, c. 83). We are not therefore at liberty to say the legislature were not aware of the new rules under which the plea of not guilty in actions on the case was so materially abridged; and when we find the legislature directed the defendant shall give the plaintiff a notice of the objections on which he intends to rely, it is reasonable to think they must have meant to require something more particular than the pleas. What degree of particularity is required, it may be difficult to define. I think it would be a more fair compliance with the statute, that the objection should disclose the names of the authors, or specify the books upon which the plaintiff means to rely. No hardship is imposed upon the defendant; he can add the names of other publications to his notice, any time before the trial, by applying to a judge at chambers (215); that ‘elsewhere’ be struck out, and if ‘other places’ are found therein, add, &c.; the words ‘and elsewhere,’ are too general, and might mislead” (distinguishing this case from *Fisher v. Dewick*). A particular of objections delivered by the defendant in an action for infringing a patent right must be precise and definite. It is not sufficient to say that the improvements, or some of them, have been used before; the defendant should point out which.—Tindal, C. J.

the pleas do not relate, (*j*) so they must not tend to mislead. (*k*)

The notice of objections is not conclusive upon the defendant at his peril; but the Court, under its general jurisdiction, may order a further and fuller notice; but where the notice sufficiently points to the matter intended to be relied upon as a defence, the Court will not interfere; as where the objection alleged that certain persons have used the invention claimed, and that therefore the invention is not new, the Court will not direct that the names of such persons shall be furnished; (*l*) and so, where it was stated

(*j*) *Macnamara v. Hulse*, 1 C. & M. 471.

(*k*) To a declaration for the infringement of a patent, the defendant pleaded that the nature of the invention, and the manner in which it was performed, were not particularly described in the specification; and also, that the invention was not new; and the objections delivered with the pleas, under 5 & 6 Wm. 4, c. 83, s. 5, stated, first, that the specification did not sufficiently describe the nature of the invention, and the manner in which it was to be performed; and secondly, that the invention was not new, and had been wholly or in part used and made public before the obtaining of the letters patent:—Held, that the first of these objections was sufficient, but that the second was bad, and ought to have pointed out what portions of the alleged invention were previously in use.—*Heath v. Unwin*, 10 M. & W. 684; 2 D. P. C., N. S. 482.

(*l*) *Bulnois v. Mackenzie*, 4 Bing. N. C. 127.—“I think the act of Wm. 4, c. 83, comes within the same construction as the statutes of set-off. It is doubtful whether, under the words ‘notice of objections,’ we can require the names of those persons who are alleged to have used the plaintiff’s invention, and therefore, so much of the order is rescinded, and the judge at N. P. will admit or reject evidence as to those persons, according as he may deem them to fall within the terms of the notice.”—Tindal, C. J. “The act was intended to afford the plaintiff more specific information than was given by the defendant’s plea; and I think the present notice insufficient.”—Vaughan, J. “I think the order goes too far in requiring the names of all the other persons who are alleged to have used the invention.”—Bosanquet, J. “It would be throwing too great a difficulty upon the defendant to require him to disclose

in the objection, that articles similar to those patented were made by the defendant and others several years before the date of the letters patent, and their sale *to divers persons*, and, amongst others, to one A. B., the Court, on application, refused to strike out the words "divers persons," or direct a description of the other persons to be given; *(m)* but in other cases such words have not been allowed. *(n)* When the objection is that the matter has been before specified, or that the description has appeared in a certain book or books, and the patents wherein the specifications have been enrolled were not named, nor the

the name and address of all the persons who are alleged to have been using the plaintiff's invention."—Coltman, J.

Regina v. Walton, 2 Q. B. 969.—Patent for carding wool.—Proceedings on *sci. fa.* were instituted. Supposed invention was not new as to the public use in England, and that before the grant of the letters patent, parts had been used by others in England. Notice of objection was filed, stating another patent of A. claimed part of the invention, but neither declaration nor objections specified the names of any persons supposed to have used parts of such invention. Application was made to the Master of the Rolls to direct the names of such persons to be given, but it was refused. The record was brought into this court, and cause set down. Lord Denman, C. J., refused to make a rule *nisi* absolute for such particulars, saying, "We agree with the Master of the Rolls rather than the Court of Common Pleas, and think the particulars should not be ordered."

Bentley v. Keighley, 1 D. & L. 944.—The notice of particulars of objection, delivered by the defendant in pursuance of the 5 & 6 Wm. 4, c. 83, s. 5, stated, amongst other grounds of objection, that the invention was known "to A. B. and others," who were the true inventors thereof, and had first used and exercised the same in England:—Held, that the defendant was not bound to specify the names of the other parties. Tindal, C. J., said, "I am not prepared to say 'and others' should be struck out; it is not imputed the words are inserted for the purposes of fraud, and defendant may not know the names of the others."

(m) *Carpenter v. Walker*, Webs. Pat. Ca. note 8, 298.

(n) Vide *Fisher v. Dewick*, *Galloway v. Bleadon*, *Heath v. Unwin*.

names of the authors of the books, in both cases the notice of objection will be directed to be amended by such addition. (o) So if the objection is, that the patent, or the extension of the patent, was obtained by fraud, it must be stated wherein the fraud consisted. (p) Stating that the invention is not sufficiently set forth in the specification is sufficient, (q) so that the plaintiff did not state the best mode of effecting the object of the patent with which he was acquainted. (r)

The Court are particular in confining the proofs to the letter of the notice of objections, and their being too large is an error as fatal as if they did not put a matter sufficiently important in issue; for if the notice of objection is, "that the invention was used by many persons, and the proof is that it was only used by one, the objection is not proved." (s)

Proof of objections required.

Provision is made in the statute for the amendment of the notice of objection by the addition of other objections.

Amendment of notice of objection.

(o) Vide *Jones v. Berger*, supra. Tindal, C. J.

(p) *Russell v. Ledsam*, 11 M. & W. 647; 3 D. P. C., N. S. 347.—To an action for the infringement of a patent, the defendant pleaded—1, That the patentee was not the true and first inventor; 2, That the invention was not, when the letters patent were granted, a new invention; 3, That the report of the Judicial Committee of the Privy Council, and the letters patent thereupon, were procured by fraud, covin, and misrepresentation:—Held, first, that the notice of objection delivered under the 5 & 6 Wm. 4, c. 83, s. 5, need not state who the first inventor was, or under what circumstances the invention had been previously used.

Secondly, that if the defendant objects that the patent is not new, he should specify whether he objects to the patent generally on that ground, or to part only; and if so, to what part.

Thirdly, that the notice ought to state the species of fraud, covin, and misrepresentation by which the patent was procured, on which he intends to rely.

(q) *Heath v. Unwin*, supra. (r) *Jones v. Berger*, supra.

(s) Per Erskine, J. *Jones v. Berger*, Webs. Pat. Ca. 547.

tions; (t) and the Court has decided that, in accordance with its practice, it has power to amend particular objections, and which amendments will be made at any time before the trial of the cause, and therefore any plea which the plaintiff may have to urge, as to the generality of the objections of which notice is given, must be proceeded with before trial, for at the trial it would be too late, and his complaint would not be attended to. (u)

Direction of a specimen of the invention to be declared.

The Court will not generally direct a specimen of the invention to be given to the defendant, in order to aid him in the preparation of his defence, the specification being, unless in very particular cases, sufficient. (v) But when there is any intricacy as to which of the patented articles the complaint relates, the patent having been granted for several articles of a similar character, the Court will direct that the plaintiff shall deliver to the defendant such a description of the articles presumed to be pirated as may direct him in his defence. (w)

(t) Section 5.

(u) If the notice of objections, delivered by a defendant with his pleas in an action for the infringement of a patent, pursuant to the stat. 5 & 6 Wm. 4, c. 83, s. 5, be not sufficiently specific, the plaintiff's course is to apply to a judge at chambers for an order for the delivery of a more specific notice; but if he omit to do so, he cannot object to the generality of the notice at the trial: the only question then is, whether the notice is sufficiently large to include the objections relied on by the defendant.—Neilson v. Harford, 8 M. & W. 806; Bulnois v. Mackenzie, supra.

(v) Crofts v. Peach, 2 Hodges, 110.—The Court will not direct a specimen of plaintiff's invention to be delivered to the defendant in order to his ascertaining whether the invention is new; to put the novelty in issue, he can plead the invention is not new, the specification giving every necessary information as to the invention.

(w) Perry v. Mitchel, Webs. Pat. Ca. 269.—Where the patent was granted for a number of articles of the same character (steel pens), on an action being brought for an infringement, the Court (Exchequer) directed that a notice of the particular articles in-

In Scotland the object of the statute is obtained by means of the closed record, therefore the statute does not apply to cases prosecuted in the Scotch courts.

CERTIFICATE OF THE JUDGE.

Another effect of the statute of the 5 & 6 of Wm. 4, c. 83, is to prevent a patentee being needlessly vexed and put to expenses by being continually compelled to defend his rights: the statute enacts, that if any action at law or suit in equity be brought for an alleged infringement of the patent, or *scire facias* to repeal it, it shall be lawful for the judge to certify upon record, under his hand, that the validity of the patent came into question before him, which record being given in evidence in any other suit, and a verdict pass for the patentee, &c., he shall receive treble costs in the suit, to be taxed at three times the taxed costs, unless the judge trying the issue certifies against such treble costs. (a) The certificate should not be directed to the pleas, but to the notice of objections delivered with them, (b) and where the plaintiff recovers a verdict, with nominal damages only, in order to render the certificate

fringed should be given by the plaintiff, which he did, referring to the particular pens by diagrams and numbers.

(a) Vide supra, 5 & 6 Wm. 4, c. 80, s. 3; supra, pp. 13, 14.

(b) *Losh v. Hague*, 5 M. & W. 387; 7 D. P. C. 495.—The certificate given by a judge under the Patents Act, 5 & 6 Wm. 4, c. 83, s. 5, should be as to the determination of each objection of which notice has been given, and not as to the issues.

Where a defendant, in an action for the infringement of a patent, succeeds on the plea which goes to the whole action, he will be entitled to the general costs of the cause, deducting the costs of the objections on which the plaintiff has succeeded, and of the issues found for him.

under 5 & 6 Wm. 4 available, he must also obtain a certificate under 3 & 4 Vict. c. 24, s. 2, that the action was brought to try a right, (c) and the certificate should be applied for before another cause is called on; for Parke, B., in the case of *Gillet v. Green*, (d) expressed a doubt whether the judge had power to grant it then: after the taxation of the costs the Court expressly decided it could not be granted. The statute applies only to causes actually tried. In a late case, where issue had been joined and the cause called on, and the defendant consented to a verdict against him for nominal damages, the judge (Erskine, J.) refused to give the certificate (the pleas were—not guilty, alleged invention not new, specification did not, &c.), because the interests of a third person are concerned, and such consent might have been fraudulent by the collusion of the parties. (e) In order to obtain the certificate it is not necessary that the validity of the patent should be put directly in issue; a plea which puts it partially in issue, as that the invention is not new, is sufficient. (f)

(c) *Gillett v. Green*, 7 M. & W. 347; et vide *Thompson v. Gibson and Another*, 6 Jurist, 390; *Page v. Pearse*, 9 Dowl. P. C. 815.—In cases where the patentee has obtained a verdict and a certificate that the validity of the patent came into question, in a subsequent trial, if the plaintiff recovers only nominal damages, unless the judge certifies that the action was brought to try a right, the plaintiff, by the operation of the 3 & 4 Vict. c. 24, s. 2, will be deprived of his treble costs, under the statute of the 5 & 6 Wm. 4, c. 83, s. 3; and Parke, B., said, “That the words of the act being ‘where damages are under 40s., unless the judge shall immediately certify’ that the action, &c., that it might be a question whether the judge could grant a certificate, even after another cause was called on.”

(d) *Supra*.

(e) *Stocker and Another v. Rodgers and Another*, 1 C. & K. 98.

(f) *Gillett and Another v. Welby*, 9 C. & P. 334.

PLEAS ALLOWED TO BE PLEADED TOGETHER.

When it is desirable for the defendant to plead several pleas, care must be taken that a distinct ground of answer or defence is intended to be established in respect of each one proposed to be pleaded; otherwise, upon application to a judge at chambers, they will be ordered to be struck out: but in all cases a rule (order) must be obtained where the defendant wishes to plead two or more pleas; (a) for if they are pleaded without such rule, the plaintiff may sign judgment; (b) that is, where two or more pleas are pleaded to the same part of the declaration, (c) which in actions for infringement of patents is usually the case.

Where a disclaimer has been entered under a patent, the defendant will not be allowed to plead similar pleas to the whole invention and to the undisclaimed part. (d) In a case where it is doubtful, from the language of the specification (which described six inventions), whether each improvement was described separately as the invention protected by the letters patent; on application, a plea was allowed to be added, which denied that two parts of the invention were not new manufactures within the meaning of the statute of James, there being already a plea upon the record denying that the invention was a new manufacture within the meaning of the statute of Jac. 1. (e) Pleas—that the articles in respect of which the patent was granted were generally known previously to the grant of the patent; that the alleged improvements were not an invention in respect of which a patent could lawfully be granted; and

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- (a) Archbold's Attorney's Guide, vol. i. p. 284.
 (b) *Hockey v. Sutton*, 2 Dowl. 701.
 (c) *Archer v. Garrard*, 2 M. & W. 63.
 (d) *Clarke v. Kendrick*, 3 D. P. C. (N.S.) 392.
 (e) *Bentley v. Knightly*, 1 D. & L. 944.

a similar plea as to part of the alleged invention, in addition to a plea that the invention was not a new manufacture within the meaning of the statute of Jac. 1, were not allowed. Tindal, C. J., in refusing to allow the two preceding pleas, said, "It seems to me the defence which the defendants are desirous of setting up under the fourth and fifth pleas may be well set up in the third (which is the last plea above); that plea involves as well the question of novelty, as whether or not the alleged invention is a manufacture within the statute of James." (f)

CASES OMITTED OR REPORTED AFTER THE PRECEDING MATTER
WENT TO PRESS.

Machine not
useful in some
cases.

Scire facias can-
not be obtained
for declaration.

Mandamus to
enforce rights
of patentee.

Haworth v. Hardcastle and Others, 1 Bingham's N. C. 190.—Patent for machinery, &c. to facilitate the operation of drying calicoes, &c. &c.—Specification stated mode in which the operation was to be performed, &c., and for removing the same, &c. by means of which, &c., and then followed the claim with respect to the novelty. The evidence was in some measure conflicting, and the machine failed to take up certain cloths stiffened with clay for deceptious purposes. The jury found the invention was new and useful; the specification sufficient for a mechanic, properly instructed, to make a machine from; that there had been an infringement upon the patent, and that the machine was not useful in some cases. (187.)

The verdict was entered for plaintiff, with leave for the defendant to move to enter a nonsuit. "If a machine is useful in general, because some cases occur in which it does not answer, we think it would be much too strong a conclusion to hold the patent void; we think we should act with great hazard and precipitation if we were to hold that the plaintiff ought to be nonsuited upon the ground that his machine was altogether useless for one of the purposes described in his specification." (190.)—Tindal, C. J.

(Mandamus to enforce rights of patentee.)—In a patent for an invention, it was stipulated that the patentee should apply for his Majesty's service so much of the invented article as should be re-

(f) Walton v. Bateman and Others, 4 Scott, 397; vide Walton v. Potter, 4 Scott, 91; Webs. Pat. Ca. 598, note h.

quired, at such reasonable prices and terms as should be settled for that purpose by the Admiralty. The patentee allowed the article to be made at the royal dock-yards, and, at the request of the Navy Board, gave instructions for the guidance of the smiths there, without stipulating for any recompense for the use of the patent:—Held, that a mandamus would not lie to the Admiralty to fix a price to be paid to the patentee.—*Ex parte Pering*, 6 N. & M. 472.

Cornish v. Keene, supra.—A new patent, sealed in 1832 and enrolled in May, 1833, is no answer to an action for the infringement of a patent not enrolled until June, 1833, the patentees having, in March and April preceding, publicly sold and supplied the London market. The mere fact of the enrolment of Desgrand's specification after the plaintiff's patent was sealed and his discovery known upon the market, does not of itself alone afford any proof whatever of the want of novelty in the manufacture made under the plaintiff's patent. (589.)—Tindal, C. J.

Hill v. Croll, 9 Jurist, 645.—C., the owner of two patents, agreed, in consideration of 200*l.*, to purchase of the plaintiff (and of another person, with his consent), at stipulated prices, all articles of a particular description which he should require for working his patents, and sell to the plaintiff, at certain stipulated prices, the products of certain processes of the patents, and to no one else, without his consent; plaintiff, on his part, agreed to supply the patentee, and to purchase from him the said products. On filing a bill for the specific performance of the agreement, it was held, that, as the Court had no power to compel the plaintiff to supply the articles in question, it could not decree the specific performance of the agreement, either in whole or in part.

Neckells v. Haslam, 9 Jurist.—In this case, which was for an injunction, objection was made to the allowance of the Master, on the taxation of the costs, of a retainer of 55*l.* and a fee of 30 guineas to the attorney-general. "The objection is to the fee, and not to the counsel. A most serious blow would be aimed at the liberties of the people of this country, as represented by counsel, if I were to interfere in the way this petition asks. Every person has a right to choose his own counsel, and it is for him to determine whom he will have. If the plaintiff having in contemplation, as I have no doubt he had, the trial which would take place, and thought proper to employ the first counsel, in either event he had a right to do so."—Vice-Chancellor of England. Objection overruled with costs.

The King, by letters patent, granted to two persons, their heirs and assigns, the office of king's printers in Scotland for forty-one

A patent obtained before patent which publishes before enrolment.

Agreement to purchase consequent upon a patent.

Counsel's fee.

King's printers in Scotland.

years, to use and enjoy its profits and privileges, so far as the same were consistent with the articles of the Union ; and especially the sole privilege of printing, in Scotland, Bibles, New Testaments, the psalms, prayer-books, confessions of faith, and the greater and lesser catechisms in English. The patent prohibited all other persons from printing in, or importing into, Scotland from any parts beyond the seas, any of the books, without authority from the patentees, under pain of confiscation :—Held, that the patentees had the exclusive right of printing these books in Scotland, and that the English Bible could not be sold in Scotland.—Manners, App., Blair, Resp., Bligh, 391.

Plea of non
concessit.

Bedells and Another v. Massey, 2 D. & L. 322.—Channell, Serjt., shewed cause, citing Morgan v. Leaward, Co. Litt. 260, a ; Baddeley v. Sepangwell ; Hyndi's case ; Eden's case. Case for infringement of patent. Declaration made profert of letters patent, but did not set them out verbatim. Defendant, who was under terms to plead issuably, delivered abstract of pleadings ; amongst others, *non concessit*, invention was of no importance, no use to public.—“The objection to the plea of *non concessit* is, not that it is at variance with the abstract delivered, but that it is no plea at all. It seems to me to be the only one by which a defendant can dispute the effect of letters patent, and shew the plaintiffs claim one thing, whereas the letters patent grant another. No inconvenience can result ; the plaintiff will have to produce at the trial the exemplification of the letters patent, and shew they agree with the declaration, and the plea will be answered.—Tindal, C. J. (325.) *Non concessit* is an issuable plea, and within the terms under which defendant was to plead issuably.—Maule, J.

CHAPTER XIV.

SECURING PROPERTY BY REGISTRATION, (a)

UNDER THE 5 & 6 VICT. c. 100; AND 6 & 7 VICT. c. 65.

THE expense of procuring patents, and the exceeding difficulty under the rigid construction of law adopted, prevented the inventor of many useful improvements in manufactures from exclusively enjoying, for such a period as would recompense him for his trouble, the fruits of his ingenuity; so that it was only in matters of great importance (and of a particular character) that persons could afford to apply for the grant of letters patent.

Registration of designs.

From time to time, commencing from the twenty-seventh year of Geo. 3 (1787), acts have been passed which have afforded manufacturers in particular trades a partial protection. The acts of the 5 & 6 Vict. c. 100, and 6 & 7 Vict.

Statutes affording a partial protection.

(a) The first idea of protecting inventions for a short period by registration seems to have been given by the Designs Act, 2 Vict. c. 17, which, though intended for the protection of ornamental designs and patterns, did not exclude those for articles of utility, and many such were registered under its provisions; but in 1842 it was thought fit to make an alteration in this law, by admitting to protection in the same manner other articles which did not then fall within its scope, for which end the act 5 & 6 Vict. c. 100, was passed, which applies to ornamental designs exclusively, thus shutting out most of those articles which had been registered under the previous act; and so great a deprivation was this felt by many who had availed themselves of its protection, that the author of this work was induced to memorialize the Board of Trade, who, after considering the matter, informed him that they had some idea of ameliorating the law in this respect, and in a short time a bill was brought into Parliament, and passed--the present act. (A. P.)

c. 65, in conjunction, have extended the benefit to every branch of manufacture, whereby an impulse has been given to artistic and mechanical ingenuity; and so important has the subject seemed in the eyes of manufacturers, that a school of design has been established for the encouragement and protection of artistic merit, in connection with manufactures.

5 & 6 VICT. c. 100, DIGEST AND CONSTRUCTION OF THE ACT.

Statute to come into operation 1st Sept. 1842.

Sect. I. This act to come into operation 1st of September, 1842, and the then acts 27 Geo. 3, c. 38, 29 Geo. 3, c. 19, 24 Geo. 3, c. 23, 2 Vict. c. 13, and the 2 Vict. c. 17, from thence are repealed.

Duration of copyright.

II. Any copyright granted by virtue of the said acts, to continue in force until its lawful expiration, and all offences thereunder to be subjected to the remedies therein provided.

Copyright, for what obtainable.

III. New and original designs (except for such things as are contained within the provisions of the statute of 38 Geo. 3, c. 71, and 54 Geo. 3, c. 56, which statutes principally related to works of art), whether applicable to the ornamenting any article of manufacture, or any substance, artificial or natural, or partly so, whether applicable for the pattern, or shape, or ornament, or two or more such purposes, and whether effected by printing, painting, embroidery, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means, manual, mechanical, or chemical, separate, or combined. The PROPRIETOR of such design, it not having been before published in the United Kingdom of Great Britain and Ireland, or *elsewhere*, (*b*) shall have the right solely to apply such design

(*b*) The design must be new: the words here used are restrictive. An introduction from abroad would not, it is apprehended, be protected, as in the case of the introduction of a new invention under the 21 of James 1, c. 21.

to any article of manufacture, or substance aforesaid, provided the same be done (c) in the United Kingdom of Great Britain and Ireland, for the terms hereinafter mentioned, which terms will be computed from the registration of the designs.

In respect of the application of any such design to ornamenting any article of manufacture contained in the first, second, third, fourth, fifth, sixth, eighth, or eleventh of the classes following, for the term of three years :

In respect of the application of any such design to ornamenting any article of manufacture contained in the seventh, ninth, or tenth of the classes following, for the term of nine calendar months :

In respect of the application of any such design to ornamenting any article of manufacture or substance contained in the twelfth or thirteenth of the classes following, for the term of twelve calendar months :

Class 1.—Articles of manufacture composed wholly or chiefly of any metal or mixed metals :

Class 2.—Articles of manufacture composed wholly or chiefly of wood :

Class 3.—Articles of manufacture composed wholly or chiefly of glass :

Class 4.—Articles of manufacture composed wholly or chiefly of earthenware :

Class 5.—Paper hangings :

Class 6.—Carpets, floor and oil cloths : (d)

(c) It is apprehended, if the design is not used, that the certificate would be void—or, at all events, unless the proprietor could shew user, or an intention of user (manifested by some decided steps), he would not be entitled to the penalties imposed by the act for an infringement of the design—for the act being, in many of its enactments, strictly penal, that mode of construction would be adopted which is most in favour of the liberty of the subject, regard being at the same time had to the evident intendment of the legislature.

(d) Vide 6 & 7 Vict. c. 65, s. 5.

Class 7.—Shawls, if the design be applied solely by printing, or by any other process by which colours are or may hereafter be produced upon tissue or textile fabrics :

Class 8.—Shawls not comprised in Class 7 :

Class 9.—Yarn, thread, or warp, if the design be applied by printing, or by any other process by which colours are or may hereafter be produced :

Class 10.—Woven fabrics, composed of linen, cotton, wool, silk, or hair, or of any two or more of such materials, if the design be applied by printing, or by any other process by which colours are or may hereafter be produced upon tissue or textile fabrics ; excepting the articles included in Class 11 :

Class 11.—Woven fabrics, composed of linen, cotton, wool, silk, or hair, or of any two or more of such materials, if the design be applied by printing, or by any other process by which colours are or may hereafter be produced upon tissue or textile fabrics, such woven fabrics being or coming within the description technically called furnitures, and the repeat of the design whereof shall be more than twelve inches by eight inches :

Class 12.—Woven fabrics, not comprised in any preceding class :

Class 13.—Lace, and any article of manufacture or substance, not comprised in any preceding class.

Registration,
necessaries to.

Name of the
person to be
put upon the
registered
article.

IV. The design to be protected must be registered before publication, and, at the time of the registration, applied to some article in the above-mentioned classes,^(d) by specifying the number of the class. The name of the person registering must be registered as the proprietor of the design ; and after publication, the name of the proprietor shall appear upon the article to which his design applies : if the manufacture be a woven fabric, by printing upon one end ; if another substance, at the edge, or upon any convenient parts, the letters R^d, with the number or letter,

(d) Vide Sec. III. supra.

or number and letter, corresponding with the date of the registration. The mark may be put upon the manufacture, by making it on the material itself, or by attaching thereto a label containing the proper marks.

V. The author of the design is to be considered the proprietor thereof, unless he has executed the design for another person, *for a good or valuable consideration*; then such other person shall be considered the proprietor, and shall *alone* be entitled to register it; but his right to the property shall only be co-extensive with the right which he may have acquired; for, it may be, he has not the exclusive right, but a right of application in conjunction with another person.

Who allowed to register.

VI. A person acquiring, by purchase or otherwise, a right to the entire or partial use of a design (*i. e. registered design*), may enter his title in the register provided by the act; and any writing purporting to be a transfer of such design, and signed by the proprietor of the design, shall operate as an effectual transfer; and the registrar, on the production of the writing, or if the right be acquired by any other mode than purchase, by producing evidence thereof to his satisfaction, shall insert the name of the new proprietor.

Assignment of the design.

FORM OF TRANSFER.

I, A. B., author [*or proprietor*] of design No. _____, having transferred my right thereto, [*or, if such transfer be partial,*] so far as regards the ornamenting of _____ [*describe the articles of manufacture or substances, or the locality with respect to which the right is transferred*], to B. C., of _____ do hereby authorize you to insert his name on the register of designs accordingly.

FORM OF REQUEST TO REGISTER.

I, B. C., the person mentioned in the above transfer, do request you to register my name and property in the said design as entitled [*if to the entire use*] to the entire use of such design, [*or, if to the partial use,*] to the partial use of such design, so far as regards the application thereof [*describe the articles of manufacture, or the locality in relation to which the right is transferred*].

FORM OF REQUEST WHEN THE PROPERTY DEVOLVES UPON A PERSON BY
ANY OTHER MODE THAN BY TRANSFER.

I, C. D., in whom is vested by [*state bankruptcy or otherwise*] the design No. [*or if such devolution be of a partial right, so far as regards the application thereof*] to [*describe the articles of manufacture or substance, or the locality in relation to which the right has devolved*].

Infringement
of design.

VII. If during the existence of the right (whether it be of the entire or partial use of such design), any person, without the *license in writing* of the registered proprietor, shall apply such design, or a fraudulent imitation thereof, to the ornamenting of any article of manufacture, &c. for the purposes of sale, or publish, sell, or expose for sale any article of manufacture, &c. to which such design, or fraudulent imitation thereof, shall have been applied, after having received a verbal or written notice from any other person than the proprietor that his (the proprietor's) consent has not been given to such application, or has been served with or had left at his premises, a written notice signed by the proprietor or his agent to that effect, (*d*) shall for every offence forfeit a sum of not less than five pounds and not exceeding thirty pounds, to the proprietor of the design. The penalty may be recovered as follows:—

Summary re-
medy.

England.

In England, by an action of debt, or on the case, against the offender, or by a summary proceeding before two justices, having jurisdiction in the district wherein the offender resides.

Any justice acting for the county, riding, division, city, or borough wherein the offender resides, may act; but he must not be concerned in the sale or manufacture of the article, or in the property of the design.

The appearance of the offender is compelled by a summons, appointing a time and place; which time must not be less than eight days from the date of the summons.

Service to be made on the person or at the residence of the offender.

(*d*) Sec. VIII. in continuation.

On appearance of the party, or on his default, two justices, as above, may hear the complaint, and on proof by the confession of the offender, or by the oath of one or more credible witnesses (to be administered by the justices), they may convict the offender in the penalty aforesaid for each offence—the aggregate amount of the penalties up to the time of the institution of the proceedings not to exceed 100*l.* against one person.

If the amount of the penalty and the costs attending the conviction are not paid, then the amount of the penalty, of the costs, and the costs of the distress and sale, shall be levied by distress upon the goods, &c. of the offender, wherever he may happen to be in England, and the justices before whom the conviction was had, or any two justices acting for any county, &c. wherein the goods of the offender may happen to be, may grant a warrant of distress and sale; any overplus to be delivered to the offender on demand.

FORM OF INFORMATION.

Be it remembered, That on the _____, at _____, in the county of _____, A. B., of _____, in the county of _____ [or C. D., of _____ in the county of _____, at the instance and on behalf of A. B., of _____, in the county of _____] cometh before us _____ and _____, two of her Majesty's justices of the peace in and for the county of _____ and giveth us to understand that the said A. B., before and at the time when the offence hereinafter mentioned was committed, was the proprietor of a new and original design for [*here describe the design*], and that within twelve calendar months last past, to wit, on the _____, at _____, in the county of _____, E. F., of _____, in the county of _____, did [*here describe the offence*], contrary to the form of the act passed in the _____ year of the reign of her present Majesty, intituled, "An Act to consolidate and amend the Laws relating to the Copyright of Designs for ornamenting Articles of Manufacture."

FORM OF CONVICTION.

Be it remembered, That on the _____ day of _____, in the year of our Lord _____, at _____, in the county of _____, E. F., of _____, in the county aforesaid, is convicted before us

and _____, two of her Majesty's justices of the peace for the said county, for that he the said E. F., on the _____ day of _____, in the year _____, at _____, in the county of _____, did [*here describe the offence*], contrary to the form of the statute in that case made and provided; and we the said justices do adjudge that the said E. F., for his offence aforesaid, hath forfeited the sum of _____ to the said A. B.

In Scotland. In Scotland, by action before the Court of Session in the ordinary form, or by summary conviction before sheriff of the county wherein the offence was committed; the proceeding as in England, but according to the Scotch form.

In Ireland. In Ireland, by action in the superior court, or by civil bill in the civil bill court of the county or place wherein offence was committed.

Proprietor may elect between the summary remedy and an action at law.

IX. Or the proprietor, if he so elects, may bring an action for the damages he has sustained by the application or imitation of the design for the purpose of sale, or by the publication and exposure to sale, against any person so offending, he (the offender) knowing that the proprietor of the design had not given his consent to such application.

Wrongfully registering and applying to the courts of equity.

X. If a person wrongfully gets himself registered as the proprietor of a design, the rightful owner may institute a suit in equity against him, and the judge having cognizance of such suit may, if it appears to him that the design has been registered in the name of a wrong person, in his discretion, either direct the registration to be cancelled (in which case it will from thence be wholly void), or direct that the name of the lawful proprietor shall be substituted for the name of the wrongful proprietor in the register, and make such direction as to the costs as he may think fit. The registrar, on the service of the order or decree, and on paying of the proper fee, shall comply with the same.

Continuing the marks after the expiration of the certificate,

XI. The marks denoting a registered design must not be applied to any article not registered, or to any article the

registry of which has expired, or any marks similar thereto. and applying
 A person applying such marks, or selling articles so marked, ^{them to unregis-}
 knowing them to be unlawfully applied, shall forfeit for ^{tered articles.}
 every offence a sum not exceeding 5*l.*, to be recovered in
 the way directed to recover the penalty.^(e)

XII. Proceedings for offences and injuries under this ^{Limitation of}
 act to be brought within twelve months from the commis- ^{proceedings.}
 sion of the offence, and not after. Persons proceeding
 under the act to recover their full costs.

XIII. In cases of summary proceedings, the justices ^{Power to award}
 may award costs to the party prevailing, and grant a war- ^{costs.}
 rant to enforce the payment against the summoning party.

XIV. The appointment of the officers, &c. to be in the ^{Appointment of}
 lords of the Committee of the Privy Council for the con- ^{officers.}
 sideration of all matters of trade, &c.; the appointments to
 be during pleasure; the salary of the officers to be fixed
 by the Commissioners of the Treasury; the lords of the
 Privy Council to make rules, &c.

XV. The registrar is to register no designs, in respect of ^{Mode of regis-}
 any application thereof to the ornamenting manufactures, ^{tering.}
 &c., unless he is furnished, in respect of each application,
 with two copies (drawings or prints) of such design, accom-
 panied with the name of the person who shall claim as
 proprietor, or of the style of the firm under which he may
 be trading, with his place of abode, or place of carrying on
 business, or other place of address, and the number and class
 in respect of which the registration is made; he must
 register all such copies, &c., from time to time successively
 as they are received by him for that purpose, and on every
 such copy, &c. affix a number corresponding to such
 succession. He shall retain and file one copy, &c., and
 return the other to him from whom he receives it, and
 class such copies, &c., and keep an index of them.

(e) *Supra*, Sec. VIII. page 196.

Duty of the registrar.

XVI. On the copy returned to the person registering, the registrar shall notify, under his hand, that the design has been registered, date of registration, name of the registered proprietor or firm, place of abode, &c., with the number of such design, with the number or letter employed by him to denote or correspond with the registration: such evidence of a registration certificate made on any original design, or copy, &c. purporting to be signed by the registrar, or deputy registrar, purporting to have the seal of the office affixed, in the absence of evidence to the contrary, be sufficient proof of the design—of the name of the proprietor—of the registration—of the commencement and period of registry—of the person named as proprietor being proprietor—of the originality of the design, and of compliance with the provisions of the act.

The writing (purporting to be such certificate), in absence of proof to the contrary, shall be received as evidence without proof of the signature or of the office seal.

Inspection of the designs, when allowed.

XVII. Any person, on payment of the appointed fee, to be at liberty to inspect any design whereof the copyright had expired; of such of which the copyright has not expired, no inspection shall be allowed, unless by the proprietor of the design, or by a person appointed by him, in writing, or by the special authority of the registrar, and then only in his presence, or in that of a person holding an appointment under this act; and in no case shall a copy be allowed to be taken. The registrar, on a person producing a design, having thereon the registration mark, or the registration mark only, may give him a certificate stating whether there be existing any copyright of such design, and to what particular manufacture such copyright applies—the term of the copyright—date of registration, and the name and address of the registered proprietor.

Appointment of the office fees.

XVIII. The Commissioners of the Treasury to appoint the fees to be paid for the service of the registrar, &c. &c.

XIX. If the registrar, or any person employed under him, shall demand or receive any fee or gratuity, &c., other than the remuneration authorized by the Commissioners of the Treasury, he shall forfeit for every offence 50*l.*, to be recovered in an action of debt in the Court of Exchequer at Westminster, and be rendered incapable of holding, &c. Excess of duty.

XX. And for the interpretation of this act, be it enacted, that the following terms and expressions, so far as they are not repugnant to the context of this act, shall be construed as follows; (that is to say) the expression "Commissioners of the Treasury" shall mean the Lord High Treasurer for time being, or the Commissioners of her Majesty's Treasury for the time being, or any three or more of them; and the singular number shall include the plural as well as the singular number; and the masculine gender shall include the feminine gender as well as the masculine gender.

XXI. And be it enacted, that this act may be amended or repealed by any act to be passed in the present session of Parliament.

6 & 7 VICT. c. 65.

Sec. I. Reciting 5 & 6 of Vict., and the extension of the benefits by this act to come into operation on the 1st of September, 1843. Extending the benefit.

II. The proprietor of a new and original design for an article of manufacture, having reference to some purpose of utility, so far as it shall extend to its shape and configuration, whether for the whole shape or for only a part, it not having been previously published in Great Britain and Ireland or *elsewhere*, (*f*) shall have the sole right to such design, to be computed from the time of registration according to the act; this act not to extend to the 38 Geo. 3, c. 71, and 54 Geo. 3, c. 56. Shape.

(*f*) *Supra*, p. 192, *in notis*.

Registration of
the design.

III. (*f*) The design must be registered before its publication, in accordance with the provisions of this act, and after such registration, the article to bear the word registered and the date.

Using marks
unlawfully.

IV. (*g*) A person placing the word registered upon an unregistered article, or upon an article the copyright of which has run out, or advertise the same for sale as a registered article, or unlawfully sell, publish, or expose for sale such article, shall forfeit for every offence a sum not less than 1*l.* and not exceeding 5*l.*, to be recovered. (*h*)

V. (*i*) Floor and oil cloths to be included in Class 6.

VI. The provisions of the 5 & 6 Vict., when not repugnant, to extend to this act in certain cases.

VII. Provision as to the appointment of the registrar, &c. (*j*)

Registration.

VIII. The registrars not to receive, &c.; (*k*) and every drawing, &c., together with the title and the description of the design, with the name and address of the proprietor, shall be on a sheet of paper or parchment, and on the same side thereof; the size of the sheet not to exceed 24 in. by 13 in., and on one side of the sheet shall be left, on the side where the drawing is, a blank space of the size 6 in. by 4 in., for the certificate to be written; the prints or drawings to be upon a proper geometric scale, and the parts of the design which are not new to be set forth; such drawings to be registered, as in. (*l*)

Power of registrar to refuse registration.

IX. The registrar empowered to refuse to register such designs as do not appear to him to be within the intention of the act, and of the 5 & 6 Vict. c. 100, as of a thing not

(*f*) Vide 5 & 6 Vict. c. 100, ss. IV., XV.

(*g*) Vide 5 & 6 Vict. c. 100, s. XI.

(*h*) Vide s. VIII., supra, 196.

(*i*) Supra, p. 193.

(*j*) Same as s. 14, 5 & 6 Vict. c. 100, supra, p. 199.

(*k*) Same as s. XV., 5 & 6 Vict. c. 100, supra, p. 199.

(*l*) Ibid.

intended to be applied to an article of manufacture, but only as a wrapper, label, or covering, in which an article might be exposed for sale—or where the design is contrary to public morality or order; with power of revision of his decree by the lords of the Privy Council.

X. Every person to be at liberty to inspect the index of the titles of the designs, not being ornamental designs, and to take copies from the same; the permission not to apply to designs the copyrights of which have not expired.

XI. The interpretation, as in 5 & 6 Vict. c. 100, Sec. XX.

XII. Power to amend, &c., as in Sec. XXI.

OBSERVATIONS UPON THE STATUTE FOR REGISTERING DESIGNS.

By consulting these acts, (*m*) it will be seen that the benefit of protection is extended to matters which formerly were not in any way protected. The first act (5 & 6 Vict. c. 100) applies protection to ornamental designs, the latter (6 & 7 Vict. c. 65), to any useful article of manufacture, as far as its shape and configuration is concerned, no limitation being made in the statute whether such configuration was applicable to the external or internal structure, or both. The words in the act, "*purpose of utility*," would seem to imply that any improvement in a manufacture which was effected by the peculiar shape of any part of it, whether external or internal, was a proper subject for protection.

In the case of *Milligen v. Picken*, (*n*) in which the invention termed the "sylphide parasol" was discussed, it was attempted to raise the question, under the plea of not the inventor or proprietor of the design, &c., whether such a manufacture as the one in dispute was an article of

(*m*) *Supra*, pp. 192, 201.

(*n*) In the C. P. 5 *Law Times*, 216.

manufacture within the meaning of this statute. Their lordships held, that under the plea the issue was not raised, and the question was not decided.

It is apprehended, if the object is effected by the particular configuration of the parts, that it is within the intention of the statute, but only so far as the configuration is concerned: if the same results could be effected by means of another shaped machine, which was *not merely colourably different*, though thereby the same result was produced, it would be no infringement of the prior design.

Expense of registration.

The expense of obtaining registration in most cases does not exceed fifteen pounds, which charge includes the preparation of all the necessary drawings, &c., being to the manufacturing world, for purposes to which the act applies, a great boon; for though the protection extends at most but to a period of three years, yet the right is spread over the whole of her Majesty's dominions, and is obtainable by the proprietor of the design, whether his right is by the invention or by the purchase of the design. (o)

Persons wrongfully obtaining registration.

Persons wrongfully obtaining registration of the design are punishable by being condemned in the costs consequent upon a suit in equity to abrogate the registration. (p)

How obtained.

The registration of the design is obtained by a simple application, (q) which is a great feature in favour of this method, and, on the registration, becomes an available property; whereas a patent, though it is really the property of the patentee, is obliged to stand the test of an action at law before its validity is completely established; but the great advantage of this method is, that a stop may be immediately put to any infringement of the right by the sum-

(o) 5 & 6 Vict. c. 100, s. 5, supra, p. 195; 6 & 7 Vict. c. 65, supra, p. 201.

(p) 5 & 6 Vict. c. 100, s. 10, supra, p. 198.

(q) 5 & 6 Vict. c. 10, s. VI., supra, p. 195.

mary jurisdiction which the statute vests in two justices of the peace; (*r*) and whilst the act allows the jurisdiction of the justices, it does not restrict the proprietor of the design from proceeding at law (at his election), but he cannot adopt both remedies for the same offence. Summary jurisdiction.

It is necessary that the design should be original (an introduction from abroad would be insufficient), and that it has not been before published. (*s*) The articles made under the protection of the statute must be marked in the way directed by the act, (*t*) which mark must be discontinued when the copyright has expired. Design, necessary to.

We have enumerated the principal advantages obtainable under these acts; yet, in order that this mode may not obtain an undue advantage, it will be necessary to point out some of the defects of the mode in question, and to shew the superiority, in some respects, of the patents over the copyrights. Advantages and disadvantages of the act.

The shortness of the time for which the copyright exists may be considered as the greatest defect, and would, in some cases, be an effectual bar to the adoption of the benefits proposed; for it is found that fourteen years, (*u*) in many cases, is too short a period to afford to the inventor a remunerating profit, and applications are frequently made to the Privy Council, under the 5 & 6 Wm. 4, c. 83, and 2 & 3 Vict. c. 67, for an extension of the original period of the grant; (*v*) but then it must, on the other hand, be considered that there are very many articles for which the exclusive right for three years would yield such a return as would well repay the inventor or proprietor for his trouble or the outlay of his capital; and in these cases,

(*r*) 5 & 6 Vict. ss. 7, 8, supra, p. 196. (*s*) Supra, p. 192, note.

(*t*) 5 & 6 Vict. c. 100, sec. XI.; and 6 & 7 Vict. s. 4, supra, pages 198, 202.

(*u*) Supra, p. 119, et infra.

(*v*) Title Extension.

it should be recollected, articles, at comparatively a nominal sum, are protected, which before were liable to be *pirated* immediately upon their publication. The other great objection is, the confined character of the grant, extending as it does only to the form of the article, leaving open the door for its unprincipled adoption by a *material* alteration in the shape; and this is indeed a very weighty objection, since it will be admitted that the essence of many inventions consists in the general idea of working out some abstract principle, or in some mechanical action, independently of the peculiar means represented for effecting the same, and that this may be equally well carried out under various shapes or configurations; but though this is generally true, yet there are many cases in which the peculiar shape or configuration is the essence of the invention, and can receive full protection under these acts; as paddle-wheels, stern-propellers, railway-bars, chairs, sleepers, wood pavements, and many other articles of utility.

APPENDIX OF FORMS.

PATENT.

PETITION FOR A PATENT.

The humble petition of _____, of, &c.,
Sheweth,

That your petitioner hath invented [*here state the title of the invention*].

That he is the first and true inventor thereof; and that the same hath never been practised or used by any other person or persons whomsoever, to his knowledge or belief.

Your petitioner, therefore, humbly prays that your Majesty will be graciously pleased to grant unto him, his executors, administrators, and assigns, your royal letters patent, under the great seal of the United Kingdom of Great Britain and Ireland, for the sole use, benefit, and advantage of the said invention, within that part of your Majesty's United Kingdom of Great Britain and Ireland called England, your dominion of Wales, and town of Berwick-upon-Tweed, [in the Islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all your Majesty's colonies and plantations abroad,] for the term of fourteen years, pursuant to the statute in that case made and provided. And your petitioner shall ever pray, &c.

DECLARATION TO SUPPORT A PATENT.

I, A. B. of _____ in the county of _____ (profession)
do solemnly and sincerely declare that I have invented

That I am the first and true inventor thereof, and that the same hath never been practised by any other person or persons whomsoever, to my knowledge or belief. *And I further declare that it is my intention to solicit letters patent in Scotland and Ireland.* And I make this declaration conscientiously believing the same to be true, and by virtue of the provisions of an act made and passed in the fifth and sixth years of the reign of his late Majesty King William the Fourth, intituled, "An Act to repeal an Act of the present session of Parliament, intituled, 'An Act for the more effectual abolition of oaths and affirmations

the sole use and exercise of the said invention, according to our gracious intention hereinbefore declared : We do, by these presents, for us, our heirs and successors, require and strictly command all and every person and persons, bodies politic and corporate, and all other our subjects whatsoever, of what estate, quality, degree, name, or condition soever they be, within that said part of the United Kingdom of Great Britain and Ireland called England, our dominion of Wales, and town of Berwick-upon-Tweed, [*colonies, &c.*] aforesaid, that neither they, nor any of them, at any time during the continuance of the said term of fourteen years hereby granted, either directly or indirectly, do make, use, or put in practice the said invention, or any part of the same, so attained unto, by the said A. B. as aforesaid, nor in any wise counterfeit, imitate, or resemble the same, nor shall 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 said A. B., 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 can or may be justly inflicted on such offenders for their contempt of this our royal command, and further to be answerable to the said A. B., his executors, administrators, and assigns, according to law, for his and their damages thereby occasioned. And moreover we do by these presents, for us, our heirs and successors, will and command all and singular the justices of the peace, mayors, sheriffs, bailiffs, constables, headboroughs, and all other officers and ministers whatsoever of us, our heirs and successors, for the time being, that they or any of them do not, nor shall at any time hereafter, during the said term hereby granted, in any wise molest, trouble, or hinder the said A. B., 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. Provided always, and these our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted it shall be made to appear to us, our heirs or successors, or any six or more of our or their Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention, as to the public use and exercise thereof, in that said part of our United Kingdom of Great Britain and Ireland called England, our dominion of Wales, and town of Berwick-upon-Tweed, [*colonies*] aforesaid, *or not invented or found out by the said A. B. as aforesaid (if the invention is introduced from abroad then, or not first introduced therein by the said, &c.)*; then upon signification thereof, to be made by us, our heirs or successors, under our or their signet or privy seal, or by the lords and others of our or their Privy Council, or any six or more of them, under their hands, these our letters patent shall forthwith cease, determine, and be utterly void, to all intents and purposes, any thing hereinbefore contained to the contrary thereof in any wise notwithstanding. Provided also that these our letters patent and any thing hereinbefore contained, shall not extend, or be construed to extend, to give privilege

unto the said A. B., his executors, administrators, or assigns, or any of them, to use or imitate any invention or work whatsoever which hath heretofore been invented or found out by any other of our subjects whatsoever, and publicly used or exercised in that said part of our United Kingdom of Great Britain and Ireland called England, the dominion of Wales, and town of Berwick-upon-Tweed [colonies] aforesaid, unto whom our like letters patent or privileges have been already granted, for the sole use, exercise, and benefit thereof; it being our will and pleasure that the said A. B., his executors, administrators, and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practise their several inventions, by them invented or found out, according to the true intent and meaning of the said respective letters patent, and of these presents. Provided likewise, nevertheless, and these our letters patent are upon the express condition, that if at any time hereafter these our letters patent, or the liberties and privileges here by us granted, shall become vested in or in trust for more than the number of twelve persons, or their representatives, at any one time, as partners, dividing, or entitled to divide, the benefit or profit obtained by reason of these our letters patent, reckoning executors or administrators as and for the single person whom they represent, as to such interest as they are or shall be entitled to, in right of their testator or intestate. And also, that if the said A. B. shall not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and cause the same to be enrolled in our High Court of Chancery, within [time for specifying] calendar months next and immediately after the date of these our letters patent. And also, that if the said A. B., his executors, administrators, or assigns, shall not supply, or cause to be supplied for our service, all such articles of the said invention as he or they shall be required to supply, by the officers or commissioners administering the department of our service for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said officers or commissioners so requiring the same, that then these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine, and become void, any thing hereinbefore contained to the contrary thereof in any wise notwithstanding. Provided that nothing herein contained shall prevent the granting of licenses, in such manner, and for such considerations, as they may, by law, be granted. And, lastly, we do by these presents for us, our heirs and successors, grant unto the said A. B., his executors, administrators, and assigns, that these our letters patent, or the enrolment or exemplification thereof, shall be in and by all things good, firm, valid, sufficient, and effectual in the law, according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favourable and beneficial sense, for the best advantage of the said A. B., his executors, administrators, and assigns, as well in all our courts of record as elsewhere, and by all and singular the officers and ministers whatsoever of us, our

heirs and successors, in that part of our said United Kingdom of Great Britain and Ireland called England, our dominion of Wales, and town of Berwick-upon-Tweed [*colonies*] aforesaid, and amongst all and every the subjects of us, our 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.

In witness whereof, we have caused these our letters to be made patent. Witness ourselves at Westminster, this of , in the year of our reign.

By writ of Privy Seal.

FORM OF SPECIFICATION.

To all to whom these presents shall come, I, A. B., of [&c.] send greeting. Whereas her most excellent Majesty Queen Victoria, by her letters patent, under the great seal of the United Kingdom of Great Britain and Ireland, bearing date at Westminster, the day of , in the year of her reign, did for herself, her heirs and successors, give and grant unto me, the said A. B., her especial license, sole privilege and authority, that I, the said A. B., my executors, administrators, and assigns, and such others as I, the said A. B., my executors, administrators, and assigns, should at any time agree with, and no others, from time to time, and at all times during the term of years therein expressed, should and lawfully might make, use, exercise, and vend, within England, Wales, and the town of Berwick-upon-Tweed, [*within the Islands of Jersey, Guernsey, Alderney, Sark, and Man, and also within all her Majesty's colonies and plantations abroad,*] my invention of [*here describe the invention in the words of the patent*]. In which said letters patent there is contained a proviso, obliging me, the said A. B., by an instrument in writing, under my hand and seal, particularly to describe and ascertain the nature of my said invention, and in what manner the same is to be performed; and to cause the same to be enrolled in her Majesty's High Court of Chancery, within calendar months next and immediately after the date of the said in part recited letters patent, as in and by the same, reference being thereunto had, will more fully and at large appear. Now know ye that, in compliance with the said proviso, I, the said A. B., do hereby declare that the nature of my said invention, and the manner in which the same is to be performed, are described and ascertained by the drawing hereunto annexed and forming part hereof, and the words following; that is to say [*here are stated the particulars*]. In witness whereof, I, the said A. B., have hereunto set my hand and seal, the day of , in year of our Lord one thousand eight hundred and forty.

A. B. (L.S.)

Taken and acknowledged by the above-named A. B., at the Public Office, Southampton Buildings, Chancery-lane, this day of one thousand eight hundred and forty, before me,

DISCLAIMER AND ALTERATIONS.

PETITION TO THE ATTORNEY OR SOLICITOR GENERAL.

The petition of A. B., of _____, in the county of _____
profession

Sheweth,

That your petitioner obtained her Majesty's royal letters patent, bearing date at Westminster, the _____ day of _____ in the _____ year of her reign, for [*here is inserted the title of the invention*]. And whereas your petitioner duly enrolled a specification of his said invention. [*Here set forth some of the particulars, sufficient to lead to the nature of the claims of invention, then set forth the disclaimer or alterations, and the reasons for the same.*] Your petitioner therefore prays leave of her Majesty's Attorney or Solicitor General, certified by his fiat and signature, as by the statute in such case made and provided, to enter with the clerk of the patents of England, the said disclaimer and memorandum of alteration, a copy of which, signed by your petitioner, is left herewith, in the form in which your petitioner is desirous the same should be entered as aforesaid.

DISCLAIMER.

[*Recite so much of the Specification as recites the grant of the patent by her Majesty.*].—And whereas I am desirous, for good and sufficient reasons hereinafter mentioned, to enter a disclaimer of that part of the title of my said invention hereinafter next mentioned, and have obtained for that purpose the leave of her Majesty's Attorney-General, certified by his fiat and signature, according to the form of the statute in such cases made and provided: Know ye, therefore, that I do hereby disclaim the following part of the title of my said invention; that is to say. [*State the part disclaimed.*] And I, the said A. B., do further declare that my reasons for making the above disclaimer are as follows; that is to say. [*State them.*] And I, the said A. B., further declare and protest, that the above disclaimer does in no wise extend, or purpose to extend, the exclusive right granted to me by the said letters patent.

In witness whereof, &c.

PROLONGATION OF THE TERM OF A PATENT.

NOTICE.

I, A. B. of [*description*], Gentleman, do hereby give notice that I intend forthwith to apply to her Majesty in Council for a prolongation, for the further term of seven years, or such other term, not exceeding seven years, as her Majesty shall please, of the right of sole using and vending my, the said A. B.'s, invention of [*state invention*], granted to him, the said A. B., by certain letters

patent, bearing date the day of in the [date] year of her reign, within that part of the United Kingdom of Great Britain and Ireland called England, the dominion of Wales, and town of Berwick-upon-Tweed; and I, the said A. B., do hereby give further notice, that I intend to apply on the day of next, to the Right Honourable the Lords, comprising the Judicial Committee of her Majesty's Honourable Privy Council, for a time to be fixed for hearing the matters of the said petition for such prolongation of the said term as hereinbefore mentioned. And all persons desirous of being heard in opposition to this the prayer of the said petitioner are hereby required to enter caveats at the Privy Council Office on or before the said day of next.

Signed by the Patentee.

Witnessed by the Solicitor.

PETITION.

To the Queen's most excellent Majesty in Council.

The humble petition of A. B., of
Sheweth,

That your petitioner, after much labour and considerable expense, invented . That your Majesty, by letters patent, dated the day of in the year of your reign, granted to your said petitioner, his executors, administrators, and assigns, the sole use and exercise of his said invention within that part of the United Kingdom of Great Britain and Ireland called England, the dominion of Wales, and the town of Berwick-upon-Tweed, in the Islands of Jersey, Guernsey, Alderney, Sark, and Man, and also in all your Majesty's colonies and plantations abroad, for the term of fourteen years from the date of the said letters patent, which term has not yet expired. That your petitioner—
[State the special circumstances warranting the application.] That your petitioner hath advertised in the *London Gazette* three times, and three times in the *Times*, the *Morning Herald*, and the *Morning Post*, being three London papers: and three times in the *Manchester Guardian*, being a country paper, published in the town of Manchester, where your said petitioner resides and carries on the manufacture of his said invention; that it his intention to apply to your Majesty in council for a prolongation of his said term of sole using and vending his said invention. Your petitioner therefore humbly prays your Majesty to grant to him new letters patent for the sole use and exercise of his said invention, within that part of your Majesty's United Kingdom of Great Britain and Ireland called England, the dominion of Wales, and town of Berwick-upon-Tweed, for a term of seven years after the expiration of the said term of fourteen years first above mentioned, according to the form of the statute in such case made and provided.

And your petitioner shall ever pray, &c.

PETITION FOR THE CONFIRMATION OF A PATENT.

To the Queen's most excellent Majesty in Council.

The humble petition of A. B., of

Sheweth,

That your petitioner, having after great labour and considerable expense invented [*state invention*], which invention is of general benefit and advantage, your Majesty was graciously pleased in consideration thereof to grant to your petitioner, his executors, administrators, and assigns, your royal letters patent, under the great seal of Great Britain, for the sole use and exercise of his said invention, within that part of your Majesty's United Kingdom of Great Britain and Ireland called England, your dominion of Wales, and town of Berwick-upon-Tweed, which said letters patent bear date upon the day of in the year of your Majesty's reign. That it hath since been proved and specially found by the verdict of the jury, in a certain action brought by your petitioner against C. D., and tried before the Right Honourable Thomas Lord Denman, the Chief Justice of your Majesty's Court of Queen's Bench, at Westminster, on the day of in the year of our Lord , that your petitioner was not the *first* inventor of the said by reason of one B. C. having invented the same before the date of the said letters patent. That the said B. C. never at any time before the date of the said letters patent published or made known the said invention; and that your said petitioner was until, and long after, the date of the said letters patent, wholly ignorant that the said B. C. had invented the said or any part thereof, but verily believed himself to be the *first* and true inventor thereof. Your petitioner therefore humbly prays that your Majesty will be graciously pleased to confirm the said letters patent, and make the same available to give your petitioner the sole right of using, making, and vending the said invention, as against all persons whatsoever, within that part of your Majesty's said United Kingdom of Great Britain and Ireland called England, the dominion of Wales, and town of Berwick-upon-Tweed.

And your petitioner shall ever pray, &c.

CAVEATS.

Caveat against any person taking out Letters Patent for any improvement relating to without notice being first given to A., of, &c.

Under 5 & 6 Will. 4, c. 83, s. 1.—Caveat against any person entering a disclaimer or alteration in a title or specification relating to without notice to

Under Id. s. 4.—Caveat against A. B. having any extension of his patent dated the day of 184 , for certain improvements in without notice to

NOTICE OF OBJECTIONS.

In the

A. B. or C. D.

Take notice that on the trial of this cause the defendant (*or* plaintiff) will insist on the following objections to the validity of the patent mentioned in the declaration :—

1st. That, &c. [*State the objections in order.*] Dated the
day of 184 .

Signed C. D., attorney for the { defendant
or
plaintiff.

To Mr. R. R., the { plaintiff's attorney
or
defendant's

NOTICES ISSUED BY THE REGISTRAR OF DESIGNS.

COPYRIGHT OF DESIGNS.

Office of Registrar of Designs, 35, Lincoln's Inn Fields.

By the Consolidated Designs Copyright Act, 5 & 6 Vict. c. 100, commencing its operation the 1st September, 1842, a copyright or property is given to the authors or proprietors of original designs for ornamenting any article of manufacture or substance, for the various terms specified in the following classes :—

CLASS.	ARTICLE.	COPYRIGHT.
1. Articles in Metal	3 years.
2. Articles in Wood	3 „
3. Articles in Earthenware	3 „
4. Articles in Glass	3 „
5. Paper Hangings	3 „
6. Carpets, Floor Cloths, and Oil Cloths	3 „
7. Shawls (patterns printed)	9 months.
8. Shawls (patterns not printed)	3 years.
9. Yarn, Thread, or Warp (printed)	9 months.
10. Woven Fabrics, not Furnitures (patterns printed)	9 „
11. Woven Fabrics, Furnitures (patterns printed)	3 years.
12. Woven Fabrics (pattern not printed)	12 months.
13. Lace and all other articles	12 „

The rights conferred upon the authors or proprietors of original designs are subjected to the following conditions :—

1st. The design must be registered.

2nd. After registration, every article of manufacture published by the proprietor on which such design is used, must have thereon a particular MARK, which will be exhibited on the certificate of registration.

These conditions being observed, the right of the proprietor is protected from piracy by a penalty of from 5% to 30% for each offence, each individual illegal application or sale of a design constituting a separate offence. This penalty may be recovered by the aggrieved party either by action in the superior courts, or by a summary proceeding before two magistrates.

If a design be executed by the author on behalf of another person, for a valuable consideration, the latter is entitled to be registered as the proprietor thereof; and any person purchasing either the exclusive or partial right to use the design is in the same way equally entitled to be registered, and for the purpose of facilitating such transfers, a short form is given in the Act.

A penalty of 5% is imposed in the case of any person using the registration mark on any design not registered, or the copyright of which has expired, or when the design has not been applied within the United Kingdom.

All designs of which the copyright has expired may be inspected at the Registrar's Office, on the payment of the proper fee; but no design, the copyright of which is existing, is in general permitted to be seen. Any person, however, may by application at the office, and on production of the registration mark of any particular design, be furnished with a certificate of search, stating whether the copyright be in existence, and in respect to which article of manufacture it exists; also the term of such copyright and the date of registration, and the name and address of the registered proprietor. Any party may also, on the production of a piece of the manufactured article with the pattern thereon, together with the registration mark, be informed whether such pattern, supposed to be registered, be really so or not.

DIRECTIONS FOR REGISTERING.

All persons wishing to register a design must bring or send to the Registrar's Office two copies thereof, together with the proper fees. These copies may consist, either of portions of the manufactured articles, when such can conveniently be done (as in the case of *Paper Hangings, Calico Prints, &c.*), or else of prints or drawings, which, whether coloured or not, must be correct representations of the design. These must be accompanied with the name and address of the proprietor or proprietors, or with the title of the firm under which he or they may be trading, and the place of carrying on business, and *also with the number of that one of the above classes*, in respect of which such design is intended to be registered. After the design has been registered, one of the two copies will be filed at the office, and the other returned to the proprietor, with a certificate annexed, on which will appear the mark to be placed on each article of manufacture on which the design is used.

A design may be registered in respect of one or more of the above classes, according as it is intended to be employed in one or more species of manufacture, but separate copies must be furnished, and a separate fee paid on account of each separate class, and all such registrations must be made at the same time.

All communications with the office for the registration of designs may be made either through the general post or any other mode of conveyance, provided the carriage be paid; and if the proper fees, or an order for payment, be inclosed, the designs will be duly registered, and the certified copies returned to the proprietor free of expense.

The Registrar's Office will be open every day on and after the 1st September, 1842, between the hours of ten in the morning and four in the afternoon, and designs and transfers will be registered from eleven until three, and the following are the fees ordered to be paid by the Treasury:—

TABLE OF FEES.

Registering Designs:—

				£.	s.	d.					£.	s.	d.
Class 1	3	0	0	Class 12	0	5	0
Class 2	1	0	0	Class 13	0	5	0
Class 3	1	0	0	Transfer	1	0	0
Class 4	1	0	0	Certifying design same as						
Class 5	0	10	0	registration fee, but for						
Class 6	1	0	0	class 1	1	0	0
Class 7	0	1	0	Cancellation or Substitution				1	0	0
Class 8	1	0	0	Search	0	2	6
Class 9	0	1	0	Inspection of designs of						
Class 10	0	1	0	which the copyright has						
Class 11	0	5	0	expired, each class	...			0	1	0

DESIGNS FOR ARTICLES OF UTILITY.

DESIGNS OFFICE, 35, Lincoln's Inn Fields.

By the act 5 & 6 Vict. c. 100, a copyright is given for such designs for articles of manufacture as are of an ornamental character only; by the new act 6 & 7 Vict. c. 65, commencing its operation on the 1st of September, 1843, a copyright of THREE YEARS is given to the author or proprietor of any new and original design for the shape or configuration either of the whole or of part of any article of manufacture having reference to some purpose of utility, whether such article be made in metal or any other substance.

To obtain this protection, it is necessary—

1st.—That the design should be registered before publication.

2nd.—That after registration, every article of manufacture published by the proprietor, and made according to such design, or on which such design is used, should have upon it the word "REGISTERED," with the date of registration.

In case of Piracy of a design so registered, the same remedies are given, and the same penalties imposed (from 5*l.* to 30*l.* for each offence), as under the act 5 & 6 Vict. c. 100, and all the provisions contained in the latter act relating to the transfer of ornamental designs, in case of purchase or devolution of a copyright, are made applicable to those useful designs registered under this act.

In addition to this, a penalty of not more than 5*l.* nor less than 1*l.* is imposed upon all persons marking, selling, or advertising for sale any article as "registered," unless the design for such article has been registered under one of the above-mentioned acts.

DIRECTIONS FOR REGISTERING AND SEARCHING.

Persons registering a design for purposes of utility must bring or send to the Registrar's Office two exactly similar drawings or prints thereof, made on a proper geometric scale, together with the name and address of the proprietor or proprietors, or the title of the firm under which he or they may be trading; also the title of the design, and such description in writing as may be necessary, either to make it intelligible or to explain which parts may not be new or original. These two drawings or copies must, together with the title, name, &c., be on two separate sheets of paper or parchment, only one side of which must be written or drawn upon. Each of these sheets must not exceed in size 24 inches by 15 inches, and on the same side as the drawings, &c., there must be left a blank space, of the size of 6 inches by 4 inches, upon which the certificate of registration will be placed.

After the design has been registered, one of the drawings will be filed at the office, and the other returned to the proprietor duly stamped and certified.

In case of the transfer of a registered design, a copy, on one sheet of paper, with a blank space left for the certificate, must be transmitted to the registrar, together with the forms of application (which may be procured at the office), properly filled up and signed; the transfer will then be registered, and the certified copy returned.

Certified copies of designs registered under this act will not be delivered before three o'clock the day following that on which they are brought to the office.

Proprietors of designs and agents are expected to examine their certificates previous to leaving the office, as no error can afterwards be rectified.

An Index of the titles and proprietors of all the registered designs for articles of utility is kept at the Registrar's Office, and may be inspected by any person, and extracts made from it.

All such designs, the copyright of which is expired, may be seen and copied at the office.

Any such design, the copyright of which is unexpired, may also be inspected, but copies are not allowed to be taken from them.

All communications for the registration of designs, either for ornamental or useful

purposes, may be made either through the general post, directed to the "Registrar of Designs, Designs Office, London" (and letters or parcels so sent are not restricted in weight to 16 oz.), or by any other mode of conveyance; and provided the carriage be paid, and the proper fees, or a post office order for the amount payable to the Registrar of Designs be inclosed, the designs will be duly registered, and the certified copies returned to the proprietor, free of expense.

The Registrar's Office, 35, Lincoln's Inn Fields, is open every day, between the hours of ten in the morning and four in the afternoon, when inquiries and searches may be made. Designs and transfers are registered from eleven until three.

TABLE OF FEES.

	Stamp.			Fee.			Total.		
	£.	s.	d.	£.	s.	d.	£.	s.	d.
Registering design	5	0	0	5	0	0	10	0	0
Certifying former registration	5	0	0	1	0	0	6	0	0
Registering and certifying transfer	5	0	0	1	0	0	6	0	0
Cancellation or substitution	—			1	0	0	1	0	0
Inspecting index of titles... ..	—			0	1	0	0	1	0
Inspecting designs (expired copyrights) each vol.	—			0	1	0	0	1	0
Taking copies of ditto, each design	—			0	2	0	0	2	0
Inspecting designs (unexpired copyrights), } each design	—			0	5	0	0	5	0

Directions for registering ornamental designs under the act 5 & 6 Vict. c. 100, may also be procured at the office.

NOTICE.

Designs Office, 9th September, 1843.

As the act 6 & 7 Vict. c. 65, applies only to the shape or configuration of articles of utility, and not to any mechanical action, principle, contrivance, or application (except in so far as these may be dependent upon, and inseparable from, the shape or configuration), no design will be registered the description of which shall contain a claim for any such mechanical action, principle, contrivance, or application.

With this exception, all designs, the drawings and descriptions of which are properly prepared and made out, will be registered, without reference to the nature or extent of the copyright sought to be thereby acquired; which consideration must be left entirely to the judgment and discretion of the proprietor of the design.

Parties are strongly recommended to read the act before determining to register their designs, in order that they may be satisfied as to the nature, extent, and comprehensiveness of the protection afforded by it, of which the registration will not constitute any guarantee.

By order of the registrar,

J. H. BOWEN, Clerk.

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