

right to the patent privilege which he seeks to protect. Before a patent privilege has been established by a verdict, the title of the patentee depends entirely upon his patent, *which he has obtained by means of his own ex parte and unsupported representations to the Crown*; and that circumstance alone would induce a Court of Equity to give a defendant a proper opportunity of contesting the validity of the patent in a Court of Law. And even if a patentee has succeeded in obtaining a verdict against one person for infringing his patent, another person who is defendant in a subsequent suit, will still be allowed to contest the validity of the patent in a Court of Law (s). For he ought not to be prejudiced by any proceeding to which he was no party, and he may be in possession of evidence which was unknown to a former defendant; or the defendant in a former case may, either through design or ignorance, have neglected to take any available objection to the validity of the patent.

Defendant has a right to dispute the validity of a patent, even if tried before.

Defendant ought not to be prejudiced by previous proceedings, and may possess further evidence.

The usual mode of trying the validity of a patent is by an action brought by the patentee for an infringement of his exclusive privilege, in which the defendant pleads pleas, and delivers a notice, raising objections against the validity of the patent (t). The same object may, however, be attained by an issue directed by the Court of Chancery, or by an action of *scire facias* to repeal the patent (u). And a defendant in Equity, or any other person aggrieved, is always at liberty to try the validity of a patent by suing out a *scire facias* to repeal it (u).

Mode of trying the validity of a patent at law.

From what has been stated it follows, that although a patentee is entitled to the interposition of the Court of Chancery in his favour, yet the proceedings in that Court can only be sustained for the purpose of protecting a patent right to which he can show, by the judgment of a Court of Law, that he has a legal title. But when that right has been established by such a judgment, between the patentee and the party against whom he is proceeding, the Court of Chancery will not only restrain the defendant from committing any further violation

Suit can only be sustained to protect a patent established at law.

If patent established by a judgment at law, patentee is entitled to an injunction and an account.

(s) See the observations of the Vice-Chancellor in *Russell v. Barnsley*, 1 Webs. R. 472.

s. 2, p. 251.

(u) As to a *scire facias*, see sec. 6 in this Chapter.

(t) As to such an action, vide *ante*,

of the patent privilege, but will compel him to recompense the patentee for all the profits which he has lost by means of the infringement (x).

Parties to the suit.

The rules of the Court of Chancery with respect to the parties to a patent suit, are somewhat different from the rules of our Courts at Law, respecting the parties to a patent action. Thus, an action at Law for the infringement of a patent, no one can be a plaintiff unless he is either a patentee, or can show a legal title by assignment to the whole or a part of the patent privilege. But in the Court of Chancery a person may be made a plaintiff or co-plaintiff, when he has any equitable interest in the patent privilege, although such equitable interest does not amount to a legal title.

Plaintiffs.

Unless a patentee has parted with his patent right or some portion of it, he alone will of course be the plaintiff in any suit respecting his patent. So also an assignee of the whole of a patent privilege must be the sole plaintiff, for the patentee has parted with his interest in the subject-matter of the suit. If a patent is granted to several persons, they may all be joined as plaintiffs in a suit; and so also if a patent has been assigned to several persons, they may all be made plaintiffs.

When a portion of a patent has been assigned, the patentee and the assignee may be made co-plaintiffs. And although different portions of a patent right are vested in several persons by different titles, they may all be joined as plaintiffs in a suit. Although it is usual when a patent privilege is vested in several persons to make them all plaintiffs in a suit, there does not seem to be any reason why any one of such parties might not alone maintain a suit for the protection of his own share in the patent, although it would in such a case be necessary to make his co-patentees defendants in the suit.

Defendants.

The person who has committed the infringement complained of, must of course be made a defendant in the suit; and if the infringement was committed by several persons jointly, they ought all to be made defendants. But if several persons separately commit acts of infringement of the same patent, they cannot all be made defendants in one suit; but must be proceeded against by separate suits (y).

(x) See further as to an Account of Profits, *post*, in this Chapter.

(y) See *Dilly v. Doig*, 2 Ves. Jun. 486.

If there happens to be any person interested in a patent privilege who will not consent to be made a co-plaintiff in a suit, he must of course be made a defendant (z).

In a patent suit the bill sometimes commences with a short bill. statement of the facts upon which a petition for the patent must have been grounded; such a statement is not, however, absolutely necessary, and where brevity is desirable it ought to be omitted. The bill then states the grant of the exclusive privilege of using the invention as made by the patent. It is not necessary to set out the patent at length, but merely to state the substance or effect of it, and the proviso requiring the specification; and the statement ought always to conclude by craving leave to refer to the patent itself (a).

After stating the grant made by the patent, the bill proceeds to show that the patentee has performed the condition upon which he obtained his privilege by enrolling a specification within the time limited by the patent. It is not requisite that the specification should be set out at length in the bill, unless perhaps in case of a disclaimer or memorandum of alteration having been filed under the stat. 5 & 6 Will. IV. c. 83, when it may be necessary to set out both documents, so as to show the effect of the disclaimer or alteration. But in other cases if the bill sufficiently alleges the performance of the condition in the patent, it is unnecessary to set out the specification.

In the case of *Kay v. Marshall* (b), the plaintiff in his bill set forth a patent granting to him the sole use of an invention of a new and improved machinery for spinning flax, &c., with the ordinary proviso requiring the enrolment of a specification. The bill then stated, that by an instrument in writing or specification under his hand and seal, dated, &c., and duly enrolled, the plaintiff, in pursuance of the proviso contained in the patent, particularly set forth, described, and ascertained the nature of his invention, and its several parts, and in what manner the same was to be performed; and that he thereby declared that what he claimed as his invention, &c., setting out the claim of invention made in the specification. The

(z) See *Westhead v. Keene*, 1 Beavan, 287. Chap. II. s. 5. ly. & Cr. 373.

(a) See the Forms in the Appendix,

It is sufficient if defendant alleges that he did by his specification all that was required by the patent.

defendants put in a general demurrer to the bill; and amongst other objections it was urged for the defendants, that the plaintiff's claim of invention was vague and uncertain, and that he did not state his title with sufficient certainty, and that he was bound to set out the specification fully, instead of contenting himself with a mere allegation that it sufficiently described the nature of his invention, and referring to it for greater certainty. But Lord *Cottenham*, L. C., overruled the demurrer, and said, in giving judgment (*inter alia*), "The bill states that the plaintiff has obtained a patent for a new and improved machinery for preparing and spinning flax, hemp, and other fibrous substances; and that in his specification duly enrolled he set forth, described, and ascertained the nature of his said invention, and the several parts thereof, and by what means the same was to be performed. This is all that the bill states of the specification. Upon the face of the bill, therefore, he alleges that he did by his specification do all that his patent required him to do, namely, describe and ascertain the nature of the invention, and in what manner the same was to be performed; what follows is merely the claim, not intended to be any description of the means by which the invention is to be performed, but introduced for the security of the patentee, that he may not be supposed to claim more than what he can support as an invention. It is introduced, lest in describing and ascertaining the nature of his invention, and by what means the same is to be performed (particularly in the case of a patent for an improvement), the patentee should have inadvertently described something which is not new in order to render his description of the improvement intelligible. The claim is not intended to aid the description, but to ascertain the extent of what is claimed as new. It is not to be looked to as the means of making a machine according to the patentee's improvements. If, therefore, the specification as containing the description be sufficiently precise, it cannot be of any consequence that expressions are used in the claim, which would be too general if they professed to be part of the description."

Westhead v. Keene.

In the subsequent case of *Westhead v. Keene* (c), it ap-

peared that the plaintiff's patent had been obtained for an invention of an improved method of cutting caoutchouc or India rubber, &c.; the bill alleged that in compliance with the proviso in the patent, the plaintiff did particularly describe and ascertain the nature of the invention, and in what manner it was to be performed, by an instrument in writing under his hand and seal, explaining therein the aforesaid particulars by drawings, and a description thereof, which (it was alleged) could not be set out in the plaintiff's bill; and that he did enrol the said instrument or specification within the six months in the patent mentioned. To this bill the defendants demurred, and contended that the plaintiff ought to have set out the specification at full length in order to enable the Court to judge of its validity. But Lord *Langdale*, M. R., held, that he was bound by the case of *King v. Marshall (d)*, on the authority of which he overruled the demurrer.

When any part of the title of the invention or of the specification has been disclaimed or altered, the bill must at least show the nature of the disclaimer, or memorandum of alteration which has been filed under the statute. And it is very questionable whether the whole of the disclaimer or memorandum of alteration should not be set out in the bill. Disclaimer must be stated.

If a plaintiff, or of one of several plaintiffs, sues as assignee, his title must be stated in the bill. Assignee must state his title.

It has already been stated (e), that the relief afforded to a patentee by the Court of Chancery, is only in aid of his legal title, and that the Court will not dispense with a trial at Law if required by a defendant. But it has become the established practice of the Court, that when a patentee can show that he has possession of a patent privilege, under colour of a title, not evidenced merely by his patent, but also supported by the verdict of a jury, or by long and undisputed enjoyment, and can also show that the defendant against whom he is proceeding has violated the privilege, he shall have immediate relief, and the protection of an interlocutory injunction; that is to say, an injunction granted before the hearing, by which the defendant will be commanded to refrain from infringing the patent until he answers the bill, or until Interlocutory injunction.
If patentee has a colourable title, he is entitled to an interlocutory injunction.

(d) 1 My. & Cr. 373, cited *ante*, p. 309. (e) *Ante*, p. 306, 307.

But only on the terms of trying the right at law.

Principle upon which the Court acts.

Court will act upon a *prima facie* title even if doubtful.

Jurisdiction clearly defined in several cases.

Boulton v. Bull.

Twenty-seven years' possession a sufficient *prima facie* title.

the hearing or the further order of the Court. But the plaintiff will in such a case be put under terms to commence an action, so that the defendant may have an opportunity of trying the validity of the patent; and if it should be found to be invalid, the injunction will be dissolved as of course.

The principle upon which the Court acts in such cases appears to be this, that although a defendant has a right to dispute the plaintiff's legal title from which he derives his claim for relief in Equity, yet when a patentee plaintiff in Equity can show a *prima facie* title at Law to his patent privilege, the Court will give credit to such a title, and grant him the protection of an injunction until the defendant has had the opportunity of contesting the sufficiency of the title in a Court of Law. And even if such a *prima facie* title appears to the Court to be doubtful, still the relief prayed for will not on that ground be refused.

This part of the jurisdiction of the Court is very clearly defined and explained by several eminent Judges who have presided in this Court.

If the case of *Boulton v. Bull* (g), a bill was filed for an injunction to restrain the defendants from infringing a patent for an invention of a new fire-engine, which had been prolonged by Act of Parliament for twenty-five years. The plaintiffs had been in possession of their patent privilege twenty-seven years, and obtained an interlocutory injunction; the question of the validity of the patent, to be tried in an action at Law. The plaintiffs brought their action in the Court of Common Pleas, and obtained a verdict at *Nisi Prius*, subject to the opinion of the Court upon a case stated. Upon argument of that case the Court was equally divided in opinion, and consequently no judgment was given (h). The defendant moved to dissolve the injunction, but Lord *Loughborough*, L. C., refused the motion; and in giving judgment said, "I cannot put the patentees upon the acceptance of terms that, upon collateral reasons, they think may be disadvantageous to the exercise of the right of which they are in full possession: neither can I put them out of possession upon the difference of opinion of the Court. That is not the fault

(g) 3 Ves. 140.

(h) 2 H. Bl. 453; and see *Hornblower v. Boulton*, 8 T. R. 95.

of the plaintiffs. What has passed in the Court of Common Pleas does not shake their right, but strongly supports it. The verdict, though it has failed of effect, is not to be disregarded. The opinions of the Judges on both sides are deserving of great respect. If nothing can be done upon this, there must be another action. *In the mean time the injunction must be continued.* I will not put them to compensation. I will not disturb the possession of their specific right. It is of notoriety that this fire-engine has been erected in many parts of the country with great advantage."

In the case of *The Universities of Oxford and Cambridge v. Richardson*, Lord Eldon observed, in giving judgment upon a motion to dissolve an injunction (k), "It is then said, in cases of this sort, the universal rule is, that if the title is not clear at Law, the Court will not grant or sustain an injunction until it is made clear at Law. With all deference to Lord Mansfield, I cannot accede to that proposition so unqualified. There are many instances in my own memory in which this Court has granted or continued an injunction to the hearing, under such circumstances. In the case of patent rights, if the party gets his patent, and puts his invention in execution, and has proceeded to a sale, that may be called possession under it, however doubtful it may be whether the patent can be sustained; this Court has lately said, possession under a colour of title is ground enough to enjoin and to continue the injunction till it shall be proved at Law that it is only colour and not real title. There have been several instances of late. Can it be said that the patent in the case of *Boulton and Watt* (l) was not doubtful? The Court of Common Pleas were divided upon the validity of it. Upon the first argument in the Court of King's Bench they were inclined to hold it bad; but they altered their opinion, and decided in favour of it. This Court enjoined them all the time during the pendency of the proceedings at Law, upon the ground that they had had possession of the invention under colour of the title which a patent, questionable in that degree, gave. That declaration, therefore, is not to be understood in that unqualified manner."

Universities of
Oxford and
Cambridge v.
Richardson.

Possession
under colour
of title a suffi-
cient ground
for an injunc-
tion until trial.

In the case of *Harmer v. Playne* (m), upon a motion to dis-

Harmer v.
Playne.

(k) 6 Ves. 707.

(m) 14 Ves. 130.

(l) *Boulton v. Bull*, 2 H. Bl. 453.

Ground upon which an injunction is granted until a trial.

solve an injunction, an objection was taken to the plaintiff's specification; and although Lord Eldon, L. C., expressed great doubts respecting the sufficiency of the specification, yet upon the ground of the length of enjoyment of the patent right which the plaintiff had had, he refused to dissolve the injunction; but his Lordship directed a case to be sent to the Court of Common Pleas for their opinion. His Lordship said, in giving judgment, "The ground upon which, where doubt is excited in the mind of the Court, an injunction is granted until the legal question can be tried, a ground that was acted upon in the case of *Boulton and Watt* (n), in some cases preceding that, and some that have occurred since, is this; where the Crown on behalf of the public grants letters patent, the grantee, entering into a contract with the Crown, the benefit of which contract the public are to have, and the public have permitted a reasonably long and undisputed possession under colour of the patent, the Court has thought, upon the fact of that possession proved against the public, that there is less inconvenience in granting the injunction, until the legal question can be tried, than in dissolving it at the hazard that the grant of the Crown may in the result prove to have been valid. The question is not really between the parties upon the record; for, unless the injunction is granted, any person might violate the patent; and the consequence would be, that the patentee must be ruined by litigation. In the case of *Boulton and Watt*, therefore, though a case of great doubt, upon which some of the ablest Judges in Westminster Hall disagreed, yet upon the ground of the possession by the patentees against all mankind, the injunction was granted until the question could be tried; and the result of the trial being in favour of the patent, proved that the conduct of the Court in that instance was at least fortunate."

Injunction will be granted notwithstanding doubts, if plaintiff has a *prima facie* title.

His Lordship, then, after making some observations respecting an apparent defect in the specification said, "*I feel very considerable doubt whether that can be made good; but there has been possession sufficient under this patent to make it fit that it should be tried; taking care that it shall be tried speedily.* It may be put in the shape of a case, stating the

(n) *Boulton v. Bull*, 3 Ves. 140.

specification under the first patent, the second patent, and specification; then stating facts sufficient to introduce the question, as a question of law, whether the condition for enrolling a specification had been duly complied with."

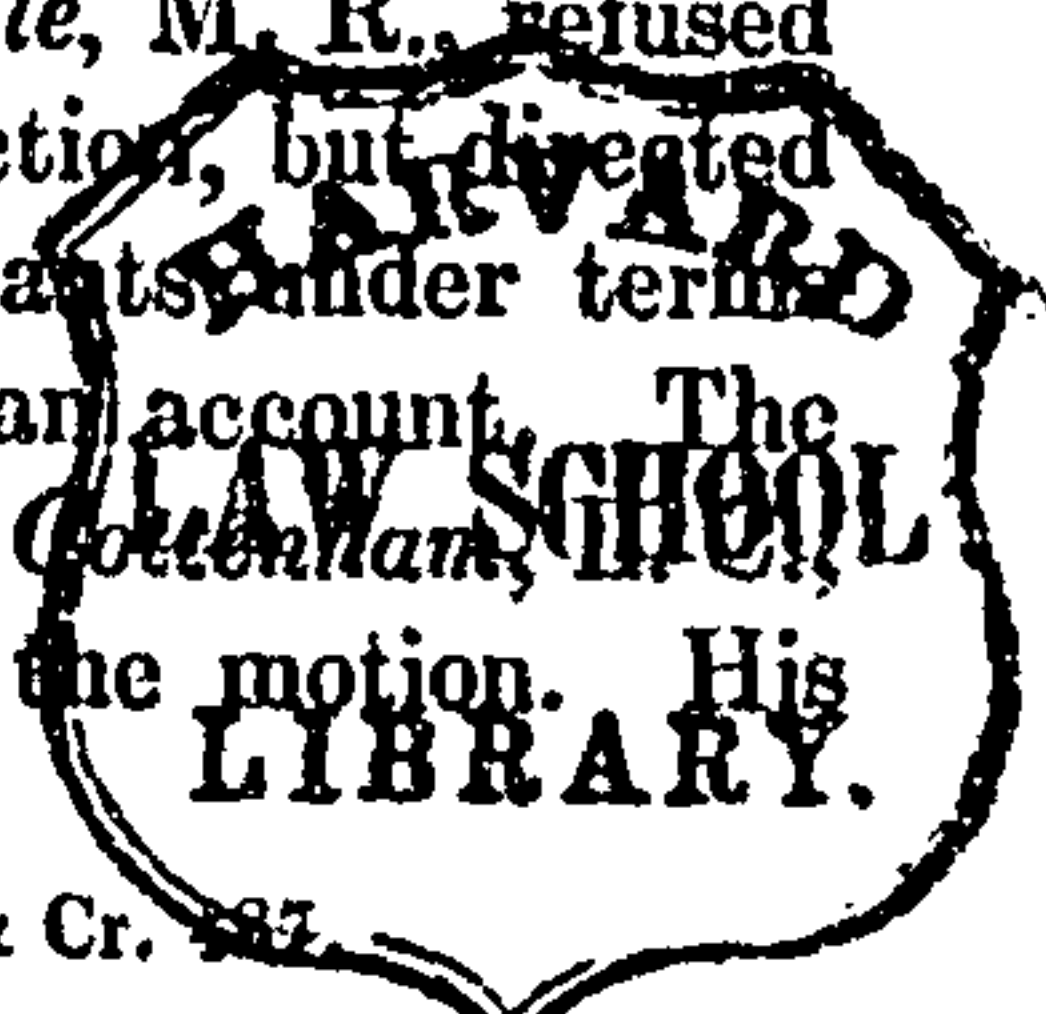
In the case of *Hill v. Thompson* (o), the same learned Judge Hill v. Thomp-
said, "The principle upon which the Court acts in cases of son.
this description is the following:— Where a patent has been If possession
granted, and an exclusive possession of some duration under it, of some dura-
the Court will interpose its injunction, without putting the party tion, injunction
previously to establish the validity of his patent by an action will be granted
at Law. But where the patent is but of yesterday, and, upon without a
an application being made for an injunction, it is endeavoured previous trial.
to be shown in opposition to it that there is no good specifi- If patent
cation, or otherwise that the patent ought not to have been recent, it must
granted, the Court will not, from its own notions respecting first be estab-
the matter in dispute, act upon the presumed validity or inva- lished at law.
lidity of the patent without the right having been ascertained
by a previous trial, but will send the patentee to law, and
oblige him to establish the validity of his patent in a Court of
Law before it will grant him the benefit of an injunction."

The case of *Hill v. Thompson* is in fact the leading case Hill v. Thomp-
on this subject, and has been adopted and constantly acted son, the leading
on by all subsequent Judges in this Court. case.

In the case of *Collard v. Allison* (p), the patent had been Collard v.
granted twelve years before, for an improvement in the ma- Collard.
nufacture of grand square pianofortes. The plaintiffs filed Length of time
affidavits in support of a motion for an injunction in the usual will not entitle
way. The defendants by their answer, and by affidavits in plaintiff to an
opposition to the motion, admitted that if the patent was injunction
valid, they had infringed it; but they denied the validity of the before trial, if
patent, and stated facts to show that the plaintiffs had not possession not
been in the exclusive and undisturbed enjoyment of the patent exclusive.
right as alleged in their bill. Lord Langdale, M. R., refused
to grant the plaintiffs an interlocutory injunction, but directed
an action to be brought, putting the defendants under terms
to accept of short notice of trial and keep an account. The
motion was afterwards renewed before Lord Cottonham, M. R.,
by way of appeal, but his Lordship refused the motion. His

(o) 3 Mer. 622.

(p) 4 My. & Cr. 187.



Lordship said, in delivering judgment in this case, “ It is not my intention to express any opinion upon the validity of the patent, namely, as to whether the peculiarity of construction here claimed constitutes such an improvement as would be the subject of a patent; because I have always thought the decision of that question should devolve upon that jurisdiction in which questions of law are more properly decided. It is not my intention, therefore, to express any opinion on the point, *further than to say this, that it is by no means so clear that that is a ground on which a patent could be maintained.* Independently of that circumstance, however, there is very contradictory evidence as to whether it is a novelty or not. Persons whose opinions must in their profession be held in great esteem, give conflicting testimony on this point. [His Lordship here stated the substance of the affidavits respecting the novelty of the invention, and proceeded:]—The effect of these contradictory statements, therefore, as the matter now stands, leaves considerable doubt upon the question, whether that which is now claimed is a novelty or not; and that circumstance would make it my duty to send the question to Law and prevent me from granting an injunction in the mean time. But then it is said there is possession of the patent, and that possession of a patent for a certain length of time gives such a title as the Court will protect until a trial at Law can be had. And certainly if I found that manufacturers of pianofortes had acquiesced, and that there was no doubt upon that point to which I have before referred (s), I should have adopted the course which Lord *Eldon* adopted, and which I have followed, of protecting the right until the trial should have been had. *For that purpose, however, I ought to have very satisfactory evidence of exclusive possession.* Now, I find here that certain manufacturers state that they abstained from making pianofortes in this manner out of respect for the plaintiffs as having a patent; while other manufacturers again say that they have always made them in this manner. Which of these statements is true I am not called upon to decide; but the discrepancy does throw sufficient doubt on the case to prevent my interfering by injunction. The result is, that this

If there is no doubt that others have acquiesced, for some time, the patent will be protected.

But there ought to be very satisfactory evidence of exclusive possession.

(s) Whether the invention could be the subject of a patent.

case, in my opinion, wants that evidence of exclusive possession upon which Lord *Eldon* acted in the case that has been referred to ; and that there is so much doubt as to the novelty of what is claimed, and as to the validity of a patent for such a manufacture, that I do not feel that I ought to interfere."

If a defendant has acknowledged the validity of the patent in any way, that will be deemed sufficient *primâ facie* evidence upon which to grant an interlocutory injunction, until a trial at Law.

If defendant has acknowledged plaintiff's title, an injunction will be granted.

Thus, in the case of *Muntz v. Grenfell* (*t*), it appeared that in articles of agreement between the plaintiff and the defendant, respecting the patent (which had expired), the patent had been dealt with as a valid patent, and Vice-Chancellor *K. Bruce* granted an injunction until the trial of an action at Law.

So also if bill be filed by an assignee of the patent against the patentee, the patent will be deemed valid as against the patentee (*u*). And if the defendant has previously used the invention under a licence (since expired), the plaintiff will be deemed as against him to have a sufficient *primâ facie* title (*x*).

Primâ facie title against a patentee or licensee.

Although an injunction merely commands a party to do that which it is his duty to do, namely, abstain from infringing the patentee's privilege ; yet it cannot be had as a matter of course. For it is to be presumed that every one will obey the law which is declared in the prohibitory part of the patent, commanding all persons within the limits of the privilege, that they shall not use, exercise, or put in practice the patentee's invention ; and, therefore, the Court cannot be called upon to interfere until the defendant has evinced an intention to do that which will be a violation of the patent privilege.

Injunction does not issue as a matter of course, or until a party has evinced an intent to infringe.

Parties who are about to infringe a patent, seldom give notice of their intention ; and, therefore, it has been laid down that the Court will not interfere until a party has shown by violating the patentee's privilege, that he disregards the command contained in the patent, and that he will therefore probably again infringe the patent privilege.

Court will not interfere until the patent has been violated.

Thus, in the case of *Hill v. Thompson* (*y*), it was laid

Hill v. Thompson.

(*t*) 7 Jur. 121.

(*x*) *Vide ante*, Chap. IX. s. 3, p. 244.

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

(*y*) 3 Mer. 622.

Injunction will not be granted until defendant has actually infringed.

If the infringement is doubtful, an injunction will not be granted.

Morgan v. Seaward.

The question of infringement being doubtful injunction will not be granted, for the defendant might be injured by an injunction, and could recover no recompence.

Negligence will disentitle a patentee to an interlocutory injunction.

down by Lord *Eldon*, L. C., that before an injunction is granted against a defendant, it should be clearly shown that he has actually infringed the plaintiff's patent (z).

If it should appear to the Court that it is doubtful whether the alleged infringement is really a violation of the plaintiff's patent right, an injunction will not be granted; or, if an injunction has been granted upon an *ex parte* application, it will be dissolved, but the defendant will be compelled to keep an account of all the alleged pirated articles which he may make or sell until the question is determined at Law.

Thus, in the case of *Morgan v. Seaward* (a), which was a suit to restrain the infringement of a patent for improvements in machinery for propelling vessels, it was doubtful whether the propeller made by the defendants was an infringement of the plaintiffs' patent, and Sir *L. Shadwell*, V. C., dissolved the injunction. His Honor, after comparing the alleged infringement with the invention as specified, said, "The alteration is therefore not merely colourable, but, *primâ facie*, a decided improvement, by the introduction into a combination of three things of that which is not noticed at all in the specification. That is, however, the proper question for a jury to consider; the Court has merely to decide what is to be done in the mean time. Now it is possible a jury may find there had been no invasion of the patent. If that were so, and the injunction should be continued, where is the justice? There is no power in the Court to make the plaintiffs pay the defendants' damages on the ground that the injunction has been continued too long. On the other hand, if the jury shall declare that there has been an infringement of the patent, the Court has a power over the defendants; and the proper measure of damages will be the amount of the engines sold, and the profit derived therefrom."

A patentee may by his own negligence disentitle himself to the benefit of an interlocutory injunction, however good his *primâ facie* title may be. Thus, if a defendant has, with the full knowledge of the plaintiff, erected large works for the manufacture of an article which it is alleged is an infringement of the patent, the plaintiff cannot afterwards have the

(z) See in a subsequent part of this Chapter what must be proved by affi-

davit in order to obtain an injunction. (a) 1 Webs. R. 167.

benefit of an interlocutory injunction, but must first establish his title at Law as against the defendant, the defendant being put upon terms to keep an account of the articles which he shall in the mean time manufacture.

In the case of *Neilson v. Thompson* (b), it appeared that the defendants had, with the full knowledge of the plaintiffs, and at considerable expense, erected apparatus for the use of hot-blast in the manufacture of iron, and continued to use their apparatus for some time, but refused to accept a licence, or to pay the plaintiffs a shilling a ton, which was demanded for licence duty. The plaintiffs filed their bill in Chancery for an injunction, and alleged that they had allowed the defendants to go on in the expectation that after a trial of the process they would have taken a licence, and paid the required duty of a shilling a ton. In support of an application for an interlocutory injunction, the plaintiffs' affidavits stated that between fifty and sixty persons had taken licences to use the invention upon payment of a shilling a ton, that various infringements had been committed by parties (about four years after the date of the patent) who submitted upon proceedings being commenced against them. The defendants disputed the validity of the patent, but the plaintiffs relied upon a twelve years' possession of the patent privilege as a sufficient *prima facie* title upon which to found their claim for an injunction, and Sir L. Shadwell, V. C., being satisfied that the patent had been infringed, granted the injunction. The defendants then appealed to the Lord Chancellor (Lord Cottenham), who allowed the appeal, and his Lordship, in giving judgment, said, "If you (the defendants) are willing to deal with the shilling a ton as the Court may direct, and to do that upon grounds quite unconnected with the merits of the case, I think I ought to deal with this question of the injunction; because this is not like the case referred to where the party had been in possession of a patent, and somebody else had done that which was an infringement, provided the patent be good;—because here the plaintiff's own statement is, without raising any doubt as to how far that may be correct, assuming the whole statement

Neilson v.
Thompson.

Plaintiff having knowingly permitted the defendants to erect their works, cannot have an injunction before a trial at law.

(b) 1 Webs. R. 275.

to be true;—that in the year 1839, he was aware that these defendants were at some considerable expense in preparing the apparatus for the purpose of using this hot-blast, and he never interfered to stop them, but permitted them to go on, as he says, under the expectation that they would pay him a shilling a ton after a certain time. That is the position in which he has by his own act placed the defendants. Nothing that took place could preclude the defendants from the right of disputing the plaintiff's right as a patentee; but they have at very considerable expense erected this machinery, and from that time to the present have been using it, the plaintiff being aware of it, at least from some time in 1839 (the precise day is not stated), and stood by and permitted them to do this. If he is entitled as patentee, it would be extremely hard for the Court to do anything to prevent his receiving that which he is entitled to receive, and in expectation of which he permitted the defendants to go on with their works. But, on the other hand, it would be extremely hard, indeed, to tell the defendants that they shall not use the works, which, with the plaintiff's knowledge, they have prepared at a very considerable expense; and as to telling them they may go on with the cold-blast instead of the hot-blast, I am told that the difference between the use of the one and of the other is an expense of nearly double, even if it were possible; at all events, they may sustain that loss in the interval until the right is tried. *It seems to me that stopping the works by injunction under these circumstances is just inverting the purpose for which an injunction is used. An injunction is used for the purpose of preventing mischief; this would be using the injunction for the purpose of creating mischief, because the plaintiff cannot possibly be injured.* All that he asks, all that he demands, all that he ever expects from these defendants is one shilling per ton. He has not a right to say to them, you shall not use this apparatus; he cannot do so after the course of conduct he has adopted; he may no doubt say with success, if he is right, you shall pay me that rent which the others pay, and in the expectation of which I permitted you to erect this machinery. Therefore in no possible way can the plaintiff be prejudiced; but the prejudice to the defendants must be very great, indeed, if they are for a short period prevented

An injunction is used to prevent mischief, and if stopping a defendant's works which have been carried on with the plaintiff's connivance, will cause great loss, an injunction will not be granted before a trial at law.

from using at their furnaces that apparatus, which, with the consent of the plaintiff they have erected. The object, therefore, is, pending the question, which I do not mean to prejudice one way or the other by anything I now say, to preserve to the parties the opportunity of trying the question with the least possible injury to the one party or the other; and, I think, the injunction would be extremely prejudicial to the defendants, and do no possible good to the plaintiff, for the purpose for which it may be used. It may, by operating as a pressure upon the defendants, produce a benefit; but that is not the object of the Court: the object of the Court is to preserve to each party the benefit he is entitled to, until the question of right is tried; and that may be entirely secured by the defendants undertaking to keep an account not only for the time to come, but from the time when the connexion first commenced, and undertaking to deal with that account in such a way as the Court may direct; and if the plaintiff is entitled, the Court will have an opportunity of putting the plaintiff precisely in the situation in which he would have stood if this question had not arisen. If it shall turn out that the patent is not valid, the Court will deal with it accordingly; and that will, I think, most effectually prevent all prejudice."

If a defendant has actually infringed a patent, the patentee has a right to the protection of an injunction, although the defendant promises not to repeat the offence. Thus, in the case of *Losh v. Hague* (c), Sir *L. Shadwell*, V. C., said, "I do not think it enough on a question of injunction, for the defendant to say, why he has done the thing complained of, but will not do it again. If a threat had been used, and the defendant revoked the threat,—that I can understand as making the plaintiff satisfied; but if once the thing complained of has been done, I apprehend this Court interferes, notwithstanding any promise the defendant may make, not to do the same thing again."

If a defendant has infringed, plaintiff is entitled to an injunction, although defendant promises not to repeat the offence.

Losh v. Hague.

The protection which the Court of Chancery gives to a patentee by injunction, extends to the prevention not only of the manufacture and sale of the patent article during the

Chancery will protect a patentee by injunction against the sale,

(c) 1 Webs. R. 200.

after the expiration of the patent, of articles made during its continuance.

Crossley v. Beverley, and Crossley v. Derby Gas-light Company.

term of the patent, but also of the sale of articles, after the expiration of the patent term, which have been made during its continuance.

Thus, in the case of *Crossley v. Beverley, and Crossley v. The Derby Gas Light Company* (d), it appeared, upon a motion for an injunction (4th Dec. 1829), that the plaintiff was the assignee of a patent, granted in 1815, for the manufacture of gas meters of a peculiar construction; and had recently succeeded in establishing his right by recovering a verdict at Law. The patent was to expire in the course of a few days. The plaintiff moved *ex parte* on the bill, which was verified by affidavits proving the infringement, that the defendant might be restrained from selling or disposing of any of the gas meters in question which had been piratically made during the continuance of the patent. The defendant, it was suggested, had a large stock of the pirated articles on hand ready to be thrown into the market as soon as the monopoly was at an end; which they had no right to do to the detriment of the plaintiff, who had the exclusive privilege of *manufacturing* them during the fourteen years. And Lord *Lyndhurst*, L. C., granted the injunction.

Plaintiff may move for an interlocutory injunction *ex parte*, or upon notice. Benefit of moving for injunction.

In order to obtain an interlocutory injunction before a trial, the plaintiff may at his election either move for it *ex parte*, or after notice of motion given to the defendant. A plaintiff generally does move for such an injunction, because, even if the Court should refuse to grant the injunction as prayed, the defendant will be put upon the terms of keeping an account of all the patent articles which he may afterwards make or sell during the pendency of proceedings at Law (e); and the plaintiff will not be guilty of *laches* by delaying to bring his cause to a hearing in the mean time.

Motion for injunction *ex parte*.

When a plaintiff's title to his patent has been established by some previous proceedings in a Court of Law, or after long and undisputed possession and exercise of the patent privilege, it is usual to move *ex parte* for an interlocutory injunction. Such motions are indeed frequently made immediately after the bill has been filed, and before the defendant has been served with the *subpœna*; and it is the usual course in such cases to serve

(d) 1 Russ. & Mylne, 166.

(e) Vide *post*, in this section, as to

the terms imposed upon the parties on a motion for an injunction.

the defendant with a copy of the *subpœna*, and of the injunction, or a notice of the order for it, at the same time.

The requisite proofs in support of a motion for an interlocutory injunction will be stated presently ; and a plaintiff ought not to make such an application *ex parte*, unless he is certain that he will be able to sustain his right to the injunction : for if the Court, upon such a motion being made, should have any doubt respecting the plaintiff's title, or any other part of his case, the motion will be directed to stand over until notice has been given to the defendant.

Ought not to be made unless plaintiff is certain that he can sustain the injunction.

If a plaintiff obtains an *ex parte* injunction in a case where his right to it is doubtful, he places himself in a disadvantageous position ; because in such a case he is not allowed any time beyond the two-day notice of motion to answer the affidavits upon which the defendant may move to dissolve the injunction. And if a plaintiff is not entitled to an interlocutory injunction, he increases the costs very unnecessarily by moving for it *ex parte*, instead of making the motion after notice to the defendant.

Disadvantage of moving *ex parte*.

When a patent is recent, and the validity of it has not been previously tried in a Court of Law, it is generally better to move for an interlocutory injunction after giving the defendant notice of the plaintiff's intention to make the motion ; for in such a case the Court seldom grants an interlocutory injunction against a defendant, who can throw any suspicion upon the plaintiff's title, or the validity of his patent ; and the chief object of the motion in such a case, therefore, is to have the defendant put under the terms of keeping an account of all the patent articles he may manufacture and sell. According to the old practice the plaintiff could not without the special leave of the Court, give the defendant notice of a motion until he had entered an appearance ; but the practice has been altered, so that the plaintiff may give such a notice at any time after the appearance is due, but not before, without obtaining leave for the purpose.

Motion for injunction after notice.

The advantages of moving for an interlocutory injunction after notice are : first, a saving in expence, (the motion to dissolve being rendered unnecessary ;) and in the next place, sufficient time being upon such a motion allowed to both parties

Advantage of moving for injunction after notice.

to answer the affidavits of each other, there is much less probability of either party being taken by surprise.

Plaintiff may move for injunction any time before the hearing.

Ought to move before answer.

The plaintiff may in fact move for an interlocutory injunction at any time before the hearing of the cause, but it is seldom that such a motion is made after answer to the bill, unless the answer contains admissions which are sufficient to entitle the plaintiff to the injunction. If a plaintiff intends to move for an interlocutory injunction, he always endeavours to do so before the defendant has put in his answer to the bill; for after the answer is once put in, the plaintiff cannot, for the purpose of any subsequent motion, by affidavit contradict any of the statements contained in the answer. And if he delays to make an application until some time after the suit has been commenced, the Court will not be disposed to grant his application unless he can give a satisfactory reason for the delay.

Application for injunction after a trial.

After a patentee plaintiff has succeeded in establishing his patent right against the defendant in a Court of Law, he may move upon affidavit of the fact (*f*), for an interlocutory injunction; or, if such an injunction has been before granted and dissolved, then to revive it, for the purpose of restraining the defendant from committing any further infringement of the patent before the hearing of the cause.

Court will not generally grant an injunction immediately after verdict for the plaintiff, if defendant intends to move for a new trial.

The Court will not generally grant an injunction immediately after the plaintiff has obtained a verdict at *Nisi Prius*, or before the defendant has had an opportunity of moving for a new trial. In many patent cases a verdict is obtained subject to the opinion of the Court *in banc*, upon a point of law; and it seldom happens that a plaintiff obtains a verdict so free from doubt either as to law or fact, that a defendant has not a fair pretext for an application for a nonsuit or a new trial. Indeed grave questions of law, such as frequently arise in patent actions, cannot conveniently be decided or even discussed before a Judge at *Nisi Prius*; and it is the constant practice to reserve them for the decision of the Court sitting *in banc*.

It would be unfair under such circumstances to grant an injunction against a defendant until he has had a full oppor-

(*f*) See the Form of Affidavit in the Appendix, Chap. II. s. 5.

tunity of having the determination of the Court of Common Law, in which the action is pending, upon any point of law, which is at all material for his defence; and the Court of Chancery would be very unwilling to grant an injunction until the defendant had an opportunity of applying to the Court of Common Law for that purpose.

In the case of *Hill v. Thompson* (g), the Court of Chancery had dissolved an injunction obtained *ex parte*; and immediately after the plaintiff had obtained a verdict at *Nisi Prius*, (which was in the vacation,) he applied to the Court to revive the injunction. The defendant stated in answer to the application that he intended to move for a new trial, and mentioned the ground upon which he intended to move; and Lord *Eldon*, L. C., refused to grant the injunction. His Lordship said, in giving judgment, "And when I see that this question clearly arises, the only other question which remains is, whether I can be so well satisfied with respect to it, as to take it for granted that no argument can prevail upon a Court of Law to let that first question be reconsidered, by granting the motion for a new trial. If this be a question of law I can have no right whatever to take its decision out of the jurisdiction of a Court of Law, unless I am convinced that a Court of Law must and will consider the verdict of the jury as final and conclusive. But this only brings it back to the original question; and I see enough of difficulty and uncertainty in the specification, and enough of apparent repugnance between the specification and the patent itself, to say, that it is impossible I can arrive at such a conclusion respecting it, as *to be satisfied that there is no ground for granting a new trial.*" In the order I formerly pronounced, was contained a direction that the defendants should keep an account of iron produced by their working in the manner described in the injunction. If the injunction is to be now revived, the whole of their establishment must be discharged between this and the fourth day of next term, when it is intended to move for a new trial: the result of which may be that the defendants have a right to continue the works, to do which they will then be under the necessity of recommencing all their operations, and

Hill v. Thompson.

Injunction will not be granted unless it clearly appears that there is no ground for granting a new trial.

Mischief of granting an injunction if defendant succeeds in obtaining a new trial.

making all their preparations and arrangements *de novo* (*h*). It appears to me that this would be a much greater inconvenience than any that can result from my refusal in the present instance to revive the injunction (*i*). My opinion, therefore, is, that this matter must stand over until the fifth day of next term, when I may be informed of the result of the intended application for a new trial; the account to be taken, in the mean time, as before."

Collard v.
Allison.

Where it is shown that defendant intends to move for a new trial, the application for an injunction will be directed to stand over.

If defendant has obtained a rule nisi for a new trial, an application for an injunction will be refused.

Renewal of application for injunction after a trial and judgment.

In the case of *Collard v. Allison* (*h*), the plaintiffs renewed a motion for an interlocutory injunction on the first day of the term after they had obtained a verdict; but it appeared on affidavit that a bill of exceptions had been tendered at the trial, and that the defendants were about to move for a new trial; the Lord Chancellor directed the application to stand over until the result of the motion for a new trial should be known. The defendants accordingly moved for, and obtained, a rule nisi for a new trial; and the motion for an injunction coming on again before the Lord Chancellor, his Lordship said, that under the circumstances in which the case then stood at Law,—a rule to show cause why a new trial should not be had, having been granted,—he must consider the legal title of the parties as still undecided, and he therefore refused the application.

After the plaintiff has obtained a verdict in an action at Law against the defendant, and the defendant failing to obtain a new trial, or get the verdict set aside, the plaintiff has also obtained judgment in the action; it is almost a matter of course to revive or grant an injunction (*l*). And such an injunction will not be refused, merely because the defendant has brought a writ of error against the judgment in the action; or, because he wishes to have the opinion of another Court of Law.

Cornish v.
Keene.

An injunction will be granted after plaintiff has obtained a

Thus in the case of *Cornish and Sievier v. Keene and another* (*m*), the plaintiffs (one of whom was an assignee of a moiety of the patent,) obtained a verdict in an action against the defendants; and after a rule nisi for a new trial was dis-

(*h*) See the observations of Lord Cottenham, L. C., in *Neilson v. Thompson*, 1 Webs. R. 286.

(*i*) See the judgment of Shadwell, V. C. E., in *Morgan v. Seaward*, 1 Webs. R. 168.

(*k*) 4 My. & Cr. 487.

(*l*) *Russell v. Cowley*, 1 Webs. R. 471; *Neilson v. Harford*, 1 Webs. R. 373.

(*m*) M.S.

charged, final judgment was signed, and then the plaintiffs judgment, applied to the Court of Chancery for an injunction against although the defendants. The application was opposed by the defend- defendant has ants on two grounds: first, because the defendants had brought brought a writ of error, and a writ of error to reverse the judgment in the action; and, notwithstanding any defect secondly, because the bill in Chancery did not sufficiently in the bill in allege the assignment of a moiety of the patent to one of the point of form. plaintiffs. In answer to these objections, it was stated by the plaintiffs, that the only ground of error assigned by the defendants was, that the declaration in the action did not allege the assignment to one of the plaintiffs to have been made by deed, and that no ground of error was alleged as to any of the issues respecting the validity of the patent; all of which had been determined in favour of the plaintiffs, the object of the defendants being merely to take advantage of an alleged formal defect in the declaration, for the purpose of reversing the judgment in the action. And it was also contended, that even if the judgment were to be reversed (*m*), yet the purpose for which the action was commenced had been answered by the determination of all the questions between the parties respecting the validity of the patent. To the second objection, it was answered for the plaintiffs, that such an objection could not be taken upon a motion for an injunction; and that even if the bill was defective, as alleged, it might afterwards be amended. Lord *Langdale*, M. R., said, that it was clear that the writ of error did not affect the merits of the case; and that whatever might be the effect of it if successful, the plaintiffs had sufficiently established their title against the defendants, to entitle them to the protection of an injunction. And with respect to the other objection, his Lordship said, that if the bill was defective in the respect alleged by the defendant, the Court would most probably allow it to be amended; but whether the bill was defective or not, still the plaintiffs were entitled to an injunction.

In the case of *Neilson v. Harford* (*n*), the plaintiffs moved Neilson v. Harford. to revive an injunction after they had obtained a verdict and judgment against the defendants, in an action at Law, for the infringement of the plaintiffs' patent. The motion was op- If the Court is satisfied respecting the result of a trial,

(*m*) The judgment was afterwards affirmed in the Exchequer Chamber.

(*n*) 1 Webs. R. 373.

an injunction will not be refused because the defendant desires to have the judgment of another Court of Law.

posed by the defendants, upon the ground that there was a difference in opinion amongst the Judges in the Court of Law, on giving judgment upon a rule for a new trial; that the defendants had been deprived of the means of bringing a writ of error, and were desirous of having the advantage of the judgment of another Court of Law. In giving judgment in this case, Lord *Lyndhurst*, L. C., said, "This was a motion to revive an injunction. The injunction had been dissolved by the late Chancellor, the defendants undertaking to keep an account, and the plaintiffs either to bring or to proceed in an action at Law for the purpose of trying the validity of the patent. The action has since been tried, and judgment has been entered up in the Court of Exchequer. It is under these circumstances, almost a matter of course that the injunction should be allowed. On the part of the defendants, it has been stated, that the learned Judge who tried the case, and who was one of the Judges of the Court where the question was finally decided, dissented from the opinion of the rest of the Court; and it is also stated, on the part of the defendants, that from the course which the proceedings took, they were deprived of their right of bringing a writ of error. I have, in consequence of these objections, thought it my duty to read the report of the trial and of the proceedings in the Court of Exchequer. I do not find that the learned Judge, to whom reference was made, did dissent from the opinion of the rest of the Court. He said, undoubtedly, that it was a question of nicety, and he entertained great doubts with respect to the question; but he himself delivered the judgment of the Court, and said, in the course of delivering that judgment, that he could not say that the construction put by the Court upon the specification was wrong. With respect to the other objection that was made, namely, that the defendants were deprived by the course of proceeding, of bringing a writ of error, the facts of the case appear to be these. Towards the conclusion of the trial, the learned Judge suggested, as the proper course to be pursued, that the facts should be stated in the shape of a special case; or that they should be put upon the record, in order that the case might go, if necessary, to the last resort. The counsel for the plaintiffs assented to this; at least he assented to leave the

facts stated in the shape of a special case, with a view to its being afterwards turned into a special verdict, in order that the question might be upon the record. The counsel, however, for the defendants, the late Attorney-general, finding the opinion of the learned Judge with him, thought that a different course would be most advantageous for his clients, and he adopted it. He insisted that the verdict should be entered on the issues;—and I think, in pursuing that course, he waived any further right to a writ of error, and made his election to abide by the decision of the Court of Exchequer. Under such circumstances, I do not think it reasonable, the decision of the Court being against him, that he should now turn round and say, that I ought to have the advantage of the other course of proceeding at the expense of the plaintiffs. I am the less disposed to depart from the usual course in cases of this kind, after having attentively considered the judgment of the Court, as compared with the specification. I think the construction put upon the specification is a reasonable construction. The whole question turns upon the meaning of the word ‘effect’ in the specification, as to the sense in which that word was used by the patentee, and, I think, adverting to the other parts of the specification, that the construction put upon it by the Court of Exchequer is a reasonable and proper construction; and, I think, adverting to the last clause of the specification, that that must be the meaning of the word effect in that clause; and that, therefore, it would be difficult, consistently with the rules of law, by which an instrument must be construed, taking it altogether, to have put another construction on the instrument. An objection was taken arising out of the form of pleading, by Mr. Roupel; but it does not appear to me that there is any validity in that objection. The case is of this description. The plaintiffs allowed the defendants to use the patent, by way of trial, for a certain period. They did use it for that period, and kept an account, and rendered that account. They were allowed to make this trial with a view afterwards of taking a licence, and paying, if they thought proper, a certain allowance for using the patent. They did not take the licence. They afterwards continued to use it. They refused to render any further account, in consequence of which notice was given to them to discontinue using the patent; and after

that notice was served upon them, it was clear, if they continued the use of the patent, and they did, they would be liable to an action, and liable also to a proceeding in this Court, and an injunction. For these reasons, I am of opinion that the injunction ought to be allowed."

Motion to dissolve an injunction.

When an injunction has been granted upon an application, *ex parte*, the defendant may, and generally does move upon affidavits (*o*) to dissolve it. If he can show that the plaintiff's title to his patent privilege is bad, or that he has not such a *prima facie* title as entitles him to an interlocutory injunction, the Court will dissolve it. So also if it shall appear that the defendant has not actually infringed the patent, or did so with the connivance of the plaintiff, or that the question of infringement is doubtful, the injunction will not be continued. And if the plaintiff has obtained an injunction, *ex parte*, upon affidavits which were insufficient, the injunction will be dissolved with costs (*p*); and it seems properly so, for the plaintiff has induced the Court to grant an injunction upon defective affidavits, upon which it could not have been obtained if the attention of the Court had been called to them.

Defendant may move before or after answer.

The defendant may move to dissolve an interlocutory injunction either upon affidavits alone before answer put in, or he may move upon the coming in of the answer, either with or without affidavits.

Advantages of moving after answer.

In some cases it is of the utmost importance to have the determination of the Court as to the continuance of the injunction decided with as little delay as possible, and in such cases it would be impossible to wait until the answer could be put in. When the answer can be put in before moving to dissolve, it is better to do so, as the defendant will thus obtain some advantages which he would not otherwise possess. Thus the plaintiff cannot after answer contradict anything contained in the answer (*q*).

If defendant disputes the validity of the patent, he must move to dissolve an *ex parte* injunction.

A defendant against whom an injunction has been obtained upon motion, *ex parte*, will (if he disputes the validity of the patent) move to dissolve the injunction, even when he knows that the plaintiff has a sufficient *prima facie* title to sustain the injunction, because he has no other means of compelling

(*o*) As to the Affidavits, vide *post*, in this section.

(*p*) *Sturtz v. De la Rue*, 5 Russ.322.
(*q*) Vide *ante*, p. 324.

the plaintiff to bring an action to try the validity of his patent, and the motion will only be refused upon the terms of the plaintiff undertaking to bring such an action.

If a plaintiff neglects to bring his action to trial within reasonable time, the defendant may move to dissolve an interlocutory injunction. For the plaintiff is bound to use all reasonable diligence in bringing the cause to trial for the purpose of ascertaining his rights, even when the order under which the action is brought is silent on the subject (r). And the reason of this is, that the patent may, notwithstanding the plaintiff's *prima facie* title, turn out to be void, and the defendant ought not, therefore, to be kept under the restraint of an interlocutory injunction any longer than is really necessary for the purpose of enabling the plaintiff to establish his title if he have any. And if the rule of the Court were otherwise, a plaintiff would have the means of very greatly oppressing an innocent defendant. So long as the injunction is allowed to continue, the plaintiff is in possession of all he seeks to obtain, the exclusive enjoyment of the privilege; and therefore he is seldom anxious to expedite the proceedings more than is absolutely necessary. But if the patent is void, the injunction whilst it continues is restraining the defendant from doing that which he has a right to do, and is doing him an injury for which he cannot obtain any recompence.

Motion to dissolve in consequence of plaintiff's delay in his action at law.

Plaintiff bound to use diligence in his action.

If the patent is void, the defendant is injured and cannot obtain a recompence.

For, as observed by Sir *L. Shadwell*, V. C. E., in *Morgan v. Seaward* (s), "There is no power in the Court to make the plaintiff pay the defendant damages, on the ground that the injunction has been continued too long." And it must be borne in mind that the defendant is not the only person interested, for the public at large has also an interest in having a speedy determination of a question which affects their rights, and there may be many persons acting under the restraint which the knowledge of an injunction having been granted in one case is certain to produce.

Morgan v. Seaward.

When a plaintiff has obtained an interlocutory injunction against the defendant, and the defendant afterwards obtains a verdict and judgment in an action brought by the plaintiff to try the validity of the patent, the defendant may immedi-

Motion to dissolve after verdict for the defendant.

(r) Vide *post*, in this section, as to the terms upon which injunctions are granted.

(s) 1 Webs. R. 168.

ately apply to the Court to dissolve the injunction, and the motion will be granted almost as of course. But it is probable that the Court would not grant such a motion merely after verdict, or until the plaintiff had had an opportunity of moving for a new trial (*t*).

Affidavits in support of a motion for an injunction.

In support of an application for an interlocutory injunction, a plaintiff must procure all the material allegations contained in his bill (*u*), to be verified by affidavit (*x*). And if any additional facts are necessary to be proved in order to entitle the plaintiff to the immediate interposition of the Court, they must be brought before the Court in the same way.

In whatever form the question respecting a plaintiff's right to an injunction may arise, it must be determined in the same way.

In whatever form the question may come before the Court respecting a patentee plaintiff's right to have the protection of an interlocutory injunction before a trial at Law between the parties, whether upon an application *ex parte*, or after notice, or upon a motion to dissolve, it must be determined in the same way; and, therefore, the facts which a plaintiff must prove upon affidavit, in order to procure an injunction, will be the same in whatever form he may make his application.

What must be proved by affidavit in support of a motion for an injunction.

And in order to obtain the protection of an interlocutory injunction, all the material allegations in the bill, and all facts material to support the plaintiff's title, must be proved by affidavit to the satisfaction of the Court.

Affidavit of grant of patent and enrolment of specification.

If the patentee is himself a plaintiff, he ought in his affidavit to state the grant of the patent; that he properly described his invention in a specification under his hand and seal, and caused it be duly enrolled in Chancery within the time limited for that purpose by the patent. If the specification is set out in the bill, it will be sufficient for the affidavit to state that the specification is there correctly set forth.

If specification not set out in the bill, a copy must be verified.

But when the specification is not stated in the bill, a copy of it ought to be brought before the Court verified by affidavit, in order to show not only the performance of the condition in the patent which requires the specification but also the nature of the invention, so that it may be seen whether it was a proper subject for a patent privilege, and whether the defendant has actually violated the patent.

(*t*) See *Boulton v. Bull*, 3 Ves. 140; and *Collard v. Allison*, 4 My. & Cr. 487.

(*u*) See the Form of a Bill in the

Appendix, Chap. II. s. 5.

(*x*) See the Forms of Affidavits in the Appendix, Chap. II. s. 5.

If there has been any disclaimer, or alteration of the title, or of the specification, the plaintiff must by affidavit show that the disclaimer or memorandum of alteration have been duly made, entered, and enrolled; and a copy of it must be verified by affidavit in the same way as the specification.

Disclaimer and alteration must be brought before the Court in the same way.

If the plaintiff should happen to be an assignee of a patent, and cannot procure the patentee's affidavit in support of his application, the matters already stated as necessary to be proved may be sworn to by the plaintiff, or any other person who may take the trouble to inform himself properly on the subject.

Affidavit may be made by a person having competent knowledge.

Any assignment of the patent right, under which a plaintiff claims, must be proved by the affidavit of the attesting witness; or if his affidavit cannot be obtained, then in the best way the plaintiff is able, the absence of the attesting witness's affidavit being properly accounted for. If the attesting witnesses are all dead, the proper mode of proving the deed will be by an affidavit of the handwriting of the attesting witness or witnesses, and also of the assignor who executed it.

Assignment of a patent must be proved by the affidavit of the attesting witness.

If the plaintiff, or one of the plaintiffs, was himself the patentee, he must in his affidavit state that he invented or imported the invention comprised in his patent, and that he believes that he was not only the true, but also the first inventor or importer of it in this country. And a patentee plaintiff should in his affidavit state his belief, not only at the time of his application for his patent, but also at the time of the swearing his affidavit, that he was the true and first inventor of the invention. This was laid down very clearly by Lord *Eldon* in the case of *Hill v. Thompson* (y), in which his Lordship said, "That when in future an injunction is applied for *ex parte*, on the ground of the violation of a right to an invention secured by patent, it must be understood that it is incumbent on the party making the application to swear, *at the time of making it*, as to his belief that he is the original inventor; for although when he obtained his patent he might very honestly have sworn as to his belief of such being the fact, yet circumstances may have subsequently intervened, or information been communicated, sufficient to convince him

A patentee plaintiff must, in his affidavit, state that he was the true and first inventor.

Hill v. Thompson.

Plaintiff must state his belief at the time of making his affidavit.

that it was not his own original invention, and that he was under a mistake when he made his previous declaration to that effect."

Neilson v.
Thompson.

Whether the
rule laid down
by Lord Eldon
in Hill v.
Thompson, is
applicable to
motions not
made *ex parte*,
quære?

In the case of *Neilson v. Thompson* (z), in answer to an objection that the patentee's affidavit did not state his belief at the time of swearing it, that he was the true and first inventor, it was stated by counsel in argument, that the doctrine of Lord Eldon in *Hill v. Thompson* (a), already stated (b), only applied to cases of *ex parte* applications for injunctions, and that it was unnecessary, upon an application for an injunction after notice, that the patentee should state his belief, at the time of the swearing of his affidavit, that he was the true and first inventor. It does not appear, from the report of the case of *Neilson v. Thompson* (c), that the Vice-Chancellor noticed the objection to the patentee's affidavit, or whether the objection was pressed by the counsel for the defendant. The application for an injunction in that case was, however, made after notice, and as his Honor granted the injunction, it may be contended that he virtually overruled the objection. But the plaintiff's claim for an injunction in the case of *Neilson v. Thompson*, as it appeared before his Honor, was very strong; for it appeared that there had been an enjoyment of the patent right for upwards of twelve years, and that about four years after the patent had been granted, proceedings had been taken against several parties for infringements, and that they had all submitted and taken licences from the patentee (d). Under such circumstances, any formal objection to the plaintiff's affidavits would only have induced the Court to postpone the hearing of the application until the defect was cured.

The rule laid
down in Hill v.
Thompson in-
tended to apply
to all cases.

If the language of Lord Eldon, in *Hill v. Thompson* (already cited) (e), is examined, it will be found that the reason for the rule which he laid down in that case, is quite as much applicable to the case of an application after notice as a motion for an injunction *ex parte*. His Lordship was laying down a

(z) 1 Webs. R. 276, n. (a).

(a) 3 Mer. 622.

(b) *Ante*, p. 325.

(c) 1 Webs. R. 275.

(d) The facts here stated are as they appeared before the Vice-Chancellor;

they afterwards appeared somewhat differently upon appeal to the Lord Chancellor, who dissolved the injunction, 1 Webs. R. 278.

(e) *Ante*, p. 325.

rule which was to apply to all future cases, and although he only mentions applications *ex parte*, that was probably because interlocutory applications (that is applications before the hearing) were then almost always made *ex parte*; and an examination of the subsequent passages, in his Lordship's judgment, will show that there can be little doubt that the rule was intended to apply to *all* interlocutory applications for injunctions which must be supported by the patentee's affidavit. It seems but reasonable that this should be so, for a patentee may have ascertained since the grant of his patent, that he was not the first inventor; and he ought to put the Court in possession of all the knowledge he has on the subject, and state (if the fact be so) that the then state of his knowledge on the subject enables him to swear that he believes that he was the true and first inventor at the date of his patent. What has been said respecting the construction of the rule laid down in *Hill v. Thompson*, is strongly confirmed by the subsequent case of *Sturtz v. De la Rue*.

In *Sturtz v. De la Rue* (*f*), the plaintiff had filed his bill for an injunction to restrain the infringement of a patent granted to J. G. Christ. The affidavit of the plaintiff (upon which an *ex parte* injunction had been obtained) stated, that by certain letters patent the patentee Christ was authorized to exercise and make use of, within England, &c. "a certain invention in the said letters patent recited to have been, as it had in fact been, as deponent verily believes, communicated to the said John George Christ by a certain foreigner residing abroad." There was not in the bill, or in the affidavits on which the injunction was obtained, any other allegation as to the originality of the invention, or as to its not having been previously known or used in this country.

Upon a motion to dissolve the injunction, Lord *Lyndhurst*, L. C., held, that it could not be sustained in consequence of a defect in the specification. It was then contended for the defendant that the injunction ought to be dissolved with costs; because the plaintiff had not stated in the affidavits on which he obtained it, nor alleged in his bill, that to the best of his knowledge and belief, at the time

(*f*) 5 Russ. 322-328, 329.

Plaintiff must state that he believes at the time he makes the application that invention was new.

If patentee not the plaintiff, application ought to be made to him to make an affidavit.

Bickford v. Skewes.

If patentee be dead, an injunction will be granted on an affidavit that the invention was new.

Affidavit as to novelty of invention by competent person.

No person can speak positively respecting the novelty of an invention on any particular day.

when he applied for the injunction, the invention mentioned in the patent was new, or newly introduced into this country, and Lord *Eldon's* dictum in *Hill v. Thompson (g)*, was relied on. Lord *Lyndhurst*, L. C., said, "There can be no doubt that when a party comes for an injunction against the infringement of a patent, he ought to state that he believes *at the time when he makes the application*, that the invention was new, or had never been practised in this kingdom at the date of the patent. It is not enough that it was believed to be new, at the time when the patent was taken out." And his Lordship accordingly dissolved the injunction *with costs*.

If the patentee is not a plaintiff in the suit, application ought to be made to him to make such an affidavit, with respect to his belief that he was the true and first inventor in the manner already mentioned. If such an affidavit cannot be procured, the reason why it cannot be obtained should be stated on oath in order to induce the Court to dispense with it.

In the case of *Bickford v. Skewes (h)*, the patentee being dead, such an affidavit could not be procured, but nevertheless Lord *Cottenham*, L. C., granted an interlocutory injunction. And if such an affidavit is dispensed with, then proof of the novelty of the invention at the date of the patent, and that the patentee gave a knowledge of it to the public by his specification, must be taken to be *primâ facie*, evidence that he was the true and first inventor.

The plaintiff's affidavits ought also to show that the invention was new to the public at the date of the patent. This is a matter of fact respecting which others may have as much information as the patentee, and therefore a plaintiff ought always in support of his title to procure the evidence of some competent person, on affidavit, that the invention was new to the public at the date of the patent. No person can speak positively with reference to the question of the novelty of an invention on any particular day; and if he had not known it prior to that day, he can only state that fact, and that he believes that the invention was then new and unknown to the public. The value of a person's testimony in favour of the novelty of an

(g) 3 Mer. 624, cited *ante*, p. 325.

(h) 1 Webs. R. 211.

invention must, therefore, materially depend upon his means of knowledge; and his affidavit in support of an application for an interlocutory injunction, ought to show what degree of probability there was of his being acquainted with the invention if it had been known to the public. The testimony of a person whose pursuits were not likely to lead him to a knowledge of a novelty in the particular article of manufacture, which formed the subject of the patent invention, would be of no value; for the object of such testimony is to prove, that it is improbable that the particular manufacture was known to the public at the date of the patent, the degree of improbability of course depending upon the means of knowledge possessed by those who say that they believe it was new.

Affidavit must state the witnesses means of knowledge, &c.

Thus, if a patent invention relates to lace machinery, a plaintiff in support of an application for an injunction, ought to procure the affidavit of a lace manufacturer, and also of a lace machine maker, stating their ignorance of the invention at the date of the patent, and that they verily believe it to be new to the public. So with respect to a patent for an improvement in watches, a plaintiff ought to apply to a watchmaker for testimony in favour of the novelty of his invention; and the belief of a person in no way connected with the manufacture of watches, and therefore, not likely to obtain early intelligence of such an invention, would be of no value.

Affidavit ought to be made by a person conversant with the particular subject.

It must also appear by the affidavits in support of the application that the invention is useful to the public, for we have seen (i), that utility to the public in some degree, is a necessary quality in an invention, to render it a legal subject of grant by patent. But the degree of utility is not material in support of the patentee's legal title; it is sufficient if the invention is of some use or benefit to the public. The degree of utility is, however, of some importance with reference to a plaintiff's claim to an interlocutory injunction; for the Court would more readily interfere for the purpose of protecting a patentee, who by his invention confers some considerable benefit upon the public, than one whose invention is so trifling and frivolous that it is almost worthless.

Affidavit as to utility.

A plaintiff must therefore procure the evidence of some

(i) *Ante*, Chap. V. s. 3. p. 132.

competent person upon affidavit, respecting the utility of the invention; and it is always advisable to show the extent to which the public has been benefited by the invention.

Previous trial or other proceedings.

If the validity of the patent which is made the subject of the suit, has been established by the verdict of a jury against some other party, that fact ought to be brought before the Court, on affidavit, in support of the application for an injunction. So, if there have been any other proceedings taken upon the patent in which the patentee has been successful.

Licences taken, acquiescence by the public, &c.

And if persons have taken licences for the use of the invention, or if the patentee has enjoyed the undisputed exercise of his patent privilege for several years, these facts, or any other which tend to show an acquiescence on the part of the public to the patentee's title, ought to be brought before the Court.

Length of undisputed possession necessary to support an application for an injunction.

It would be difficult to fix any particular length of undisputed enjoyment which would be sufficient to entitle a patentee to an injunction before a trial at Law. In the case of *Boulton v. Bull* (k), in which the plaintiffs obtained such an injunction, there had been twenty-seven years' possession of the patent right. In *Harmer v. Playne* (l), there had been a possession of thirteen years; and in *Neilson v. Thompson* (m), the Vice-Chancellor granted an injunction after twelve years' possession.

In the case of *Losh v. Hague* (n), Sir L. Shadwell, V. C., held that an uninterrupted enjoyment of seven years was sufficient to entitle the plaintiff to an interlocutory injunction. And in the case of *Bickford v. Shewes* (o), a possession of six years was held to be sufficient.

But so short a period as twelve months was held by Lord Eldon, L. C., in the case of *Hill v. Thompson* (p), to be insufficient. In that case his Lordship, after laying down the principle upon which such injunctions are granted, said, "But it is enough in the present case to resort to the principle already laid down, and which is the same that governed the cases (which have been cited) of *Harmer v. Playne* (q), and

(k) 3 Ves. 140.

(l) 14 Ves. 136.

(m) 1 Webs. R. 277.

(n) *Ibid.* 200.

(o) *Ibid.* 211.

(p) 3 Mer. 622.

(q) 14 Ves. 136; decided in April, 1817.

Boulton v. Bull (r); because it cannot be said, that there has been, in this case, such a possession or enjoyment under the patent, as would induce the Court to continue the injunction upon such evidence as is here afforded, until its validity has been tried at Law. Here the patent bears date, July 1814, and the specification, January 1815; and it appears by the affidavits, that the works were not completed so as to carry on the operations under the patent until July 1816,"

In order to obtain an injunction, the affidavits in support of the application must show clearly, and to the satisfaction of the Court, that the act done by the defendant, and which the plaintiff complains of as an infringement, was actually a violation of the plaintiff's patent privilege. Affidavits as to infringement.

Whenever the invention is of such a nature as to permit the exhibition of specimens of the plaintiff's patent article, they ought to be verified on affidavit, so that the Court may have the opportunity of inspecting them, and of comparing them with any similar article of the defendants which is complained of as an infringement. Specimen of patent article ought to be produced.

So, whenever a specimen of the alleged infringement can, without inconvenience, be brought before the Court for inspection, it ought to be made an exhibit to the affidavit of the person who proves the committing of the infringement, so that the Court may be able to compare it with the plaintiff's patent article, or the description in the specification. Specimen of infringement.

And when it is impracticable to bring specimens into Court for inspection, it is very desirable (if practicable) to produce models, in order to show more clearly both the nature of the invention and the alleged infringement. Models.

In the case of *Hill v. Thompson* (s), it was laid down by Lord Eldon, L. C., that the affidavits in support of a motion ought to state particularly in what the alleged infringement consists; and that it is not enough merely to represent that the defendant has made an article in the way described in the specification, but that it should be shown before any injunction is granted, that the patent was actually infringed by doing that which forms the essence of the invention. Hill v. Thompson. Affidavits must state in what the infringement consists.

The plaintiff must also show that he has used due expe- Plaintiff must show that he

(r) 3 Ves. 140.

(s) 3 Mer. 622.

has used due diligence.

dition in applying to the Court after he has obtained a knowledge of the infringement having been committed by the defendant; for if he knowingly allows a person to go on for some time doing that which he says is an infringement of his patent, he cannot afterwards claim the protection of an interlocutory injunction, but must first establish his title against the defendant in a Court of Law (t). But a patentee may have such information as convinces him that a person is infringing his patent, and yet be unable to procure sufficient legal evidence to prove an actual infringement to the satisfaction of the Court. In such a case a patentee cannot be guilty of *laches* in not applying to the Court until he is really in a position to prove the infringement, provided he makes proper exertion to obtain the requisite proof.

Losh v. Hague.

In the case of *Losh v. Hague* (u), in which an application for an injunction was opposed by the defendant on the ground of delay, Sir *L. Shadwell*, V. C., said, "As to the length of time that has elapsed, I do not think there is much in that. On the 23rd of March, the plaintiff received some information that there was an invasion of his patent, and some portion of time it appears was spent in making inquiries; there was notice distinctly given on the 8th of May. Then some further correspondence takes place, and letters between the parties; and then a bill is filed on the 7th of July, and the application is virtually made. I cannot but think, therefore, that the plaintiff has come in sufficient time."

Affidavits to obtain an injunction after verdict in an action against the defendant.

When a plaintiff moves for an injunction, or to revive an injunction, after obtaining a verdict and judgment in an action at Law against the defendant, the statements contained in his bill must be verified by affidavit; but as the verdict which has been obtained will support the plaintiff's allegations respecting the validity of the patent, and the infringement of it, it will be unnecessary to procure the affidavit of any person in support of the plaintiff's allegation as to the novelty or utility of the invention, or the sufficiency of the specification.

If the plaintiff has, upon the occasion of a previous motion in the suit, sufficiently verified all the allegations contained in his bill, it will only be necessary, upon the subsequent motion,

(t) See the case of *Neilson v. Thompson*, before the Lord Chancellor, on Ap-

peal, 1 Webs. R. 278.

(u) 1 Webs. R. 200.

to show by affidavit the nature and result of the legal proceedings which have taken place. For the purposes of this motion, the plaintiff's affidavits ought to show who were the parties to the action at Law, the form and cause of action, the substance of the several issues raised by the defendant respecting the validity and infringement of the patent, the verdict of the jury, and the judgment thereon which the plaintiff has obtained (*x*).

Affidavits must show the nature of the proceedings at law and the result.

The defendant may either in opposition to the plaintiff's application for an interlocutory injunction, or in support of a motion to dissolve such an injunction, file affidavits in answer to those of the plaintiff, and also for the purpose of proving any objection which he intends to take to the plaintiff's patent. Thus, the defendant may by affidavit show that the plaintiff was not the true and first inventor, that the invention was not new, that the specification was insufficient, or any other fact that would show that the plaintiff's patent is void. He may also show that the plaintiff has not sufficient *primâ facie* proof of a legal title to his privilege to induce the Court to grant him an interlocutory injunction, or that the defendant has not committed any infringement of the patent.

Defendant's affidavits in opposition to an injunction, or to dissolve an injunction.

In answer to the affidavits, filed by the plaintiff in support of his application, the defendant is frequently compelled to show by his affidavits the whole of his case against the plaintiff, in order to prevent the granting of the injunction as prayed. This exposure of the defendant's case is frequently a great disadvantage to him, upon the subsequent trial of an action against him in a Court of Law; and cases have sometimes occurred in which it has been deemed better for a defendant to submit to an injunction, than to run the risk of exposing the whole of his case upon the affidavits in opposition to the plaintiff's application.

Disadvantage to a defendant in showing his case before a trial.

In order to show that the patentee was not the true and first inventor, the defendant must prove by affidavit either that a knowledge of the invention was communicated to the patentee by some other person (not being a foreigner resident abroad), before the date of the patent; or that the invention was not new at the time the patent bears date (*y*).

How to show that the patentee was not the inventor.

(*x*) See the Forms of Affidavits in the Appendix, Chap. II. s. 5. and *post*, Chap. XI.; and Index, tit. Evidence.

(*y*) Vide *ante*, Chap. III. s. 4, p. 31;

How to show that invention was not new.

To show that the invention was not new, the defendant's affidavits must prove that the invention was known to the public, or had been used in public, at the date of the patent (*z*).

Affidavits in support of objections to specification.

The material part of the specification ought to be set out by the plaintiff, either in his affidavits, or in his bill verified by affidavit; and the defendant may take any objection to its sufficiency which is apparent upon the face of it. But if any part of it is untrue, or if it is insufficient for any reason not appearing upon the face of the instrument, the defendant must bring the necessary proofs in support of his objections before the Court upon affidavit (*a*).

That defendant has not infringed.

In order to show that he has not been guilty of an infringement, the defendant may prove either that the plaintiff's affidavits are untrue, or that what he has done or made is no violation of the plaintiff's patent right (*b*).

Affidavits upon an appeal motion.

Upon an appeal motion to the Lord Chancellor to dissolve an injunction, the defendant may not only use the affidavits previously filed, but may also file such additional affidavits as may be necessary in support of his case (*c*).

Affidavits to dissolve an injunction after verdict for defendant.

In order to dissolve an injunction against a defendant after he has succeeded in obtaining a verdict against the plaintiff upon a trial at Law, he must show by affidavit the nature of the proceedings which have taken place, the verdict of the jury upon some issue which was taken respecting the validity or infringement of the patent, and the judgment thereon of the Court of Law (*d*).

Upon disposing of a motion for or against an injunction, the Court usually imposes terms upon the parties.

Upon disposing of an opposed application for an interlocutory injunction, or upon a motion to dissolve an interlocutory injunction, it is usual for the Court to impose upon one or both of the parties (if there has been no previous trial at Law between them) such terms as may be deemed equitable and necessary, in order to enable the Court to do justice effectually between them. The Court may, however, grant or refuse an injunction *simpliciter*; but it is not very probable that such a case will arise as will induce the Court to take such a course.

(*z*) Vide *ante*, Chap. V. s. 2, p. 102; and *post*, Chap. XI.; and Index, tit. Evidence.

(*a*) Vide *ante*, Chap. VII. p. 151; and Index, tit. Specification.

(*b*) Vide Index, titles, Evidence and

Infringement.

(*c*) See *Neilson v. Thompson*, 1 Webs. R. 278.

(*d*) See the Forms of Affidavits in the Appendix, Chap. II. s. 5.

In the case of *Hill v. Thompson* (e), upon a motion to revive an injunction, Lord Eldon, L. C., in giving judgment thus explains the mode in which the Court disposes of an application for an interlocutory injunction: "Upon an application to this Court for what may be called the extra relief which it affords on a clear *primâ facie* case, the Court will use its discretion; and if it sees sufficient ground of doubt will either dissolve the injunction absolutely, or direct an issue, or direct the party applying to bring his action; after the trial of which either he may apply to revive if successful, or else the other party may come before the Court, and say I have displaced all his pretensions, and am entitled to have my costs and the expences I have sustained, by being brought here, upon an allegation of right which cannot be supported. And as in this instance the Court will sometimes add to its more general directions, that the party against whom the application is made, shall keep an account pending the discontinuance of the injunction, in order that, if it shall finally turn out that the plaintiff has a right to the protection he seeks, amends may be made for the injury occasioned by the resistance to his just demands."

Hill v. Thompson.

Mode of disposing of an application for an interlocutory injunction.

And in the subsequent case of *Bacon v. Jones* (f), the various modes in which applications for interlocutory injunctions may be disposed of, are stated by Lord Cottenham, L. C., in his judgment, thus: "The jurisdiction of this Court is founded upon legal rights; the plaintiff coming into this Court on the assumption that he has the legal right, and the Court granting its assistance upon that ground. When a party applies for the aid of the Court, the application for an injunction is made either during the progress of the suit, or at the hearing; and in both cases, I apprehend, great latitude and discretion are allowed to the Court in dealing with the application. When the application is for an interlocutory injunction, several courses are open; the Court may at once grant the injunction, *simpliciter*, without more; a course which though perfectly competent to the Court, is not very likely to be taken where the defendant raises a question as to the validity of the plaintiff's title; or it may follow the more

Bacon v. Jones.

Jurisdiction founded on legal right.

Upon application, the Court may grant an injunction *simpliciter*.

(e) 3 Mer. 622.

(f) 4 My. & Cr. 433.

Usual practice either to grant the injunction directing the plaintiff to proceed at law, or to suspend the grant of it until a trial directing the defendant to keep an account.

Terms imposed on the grant of an injunction.

Court will sometimes order plaintiff to proceed within a specified time.

Plaintiff must proceed to trial with reasonable expedition.

Bickford v. Skewes.

If plaintiff does not proceed to trial he will be deprived of injunction.

Defendant guilty of *laches*, cannot compel plaintiff to proceed with so much expedition.

Plaintiff is left to proceed with

usual, and, as I apprehend more wholesome practice in such a case, of either granting an injunction, and at the same time directing the plaintiff to proceed to establish his legal title, or of requiring him first to establish his title at Law, and suspending the grant of the injunction until the result of the legal investigation has been ascertained, the defendant in the mean time keeping an account. Which of these several courses ought to be taken, must depend entirely upon the discretion of the Court, according to the case made."

It is now the almost invariable practice when an interlocutory injunction is granted (before a trial at Law between the parties), to order that the plaintiff shall bring such action as he may be advised against the defendant for an infringement, in order to try the validity of the patent, and whether the defendant has actually violated the plaintiff's patent privilege.

The Court will also in some cases order the plaintiff to proceed within a specified time; and even if the order is silent on the subject, the plaintiff must proceed to trial with all practicable expedition, or the Court will dissolve the injunction. For the defendant being under the restraint imposed upon him by an injunction, has a right (unless he has himself been guilty of *laches*) to insist that the plaintiff shall proceed with his action to try the validity of the patent, with as little delay as practicable.

Thus, in the case of *Bickford v. Skewes (g)*, Lord *Cottenham*, L. C., said, "The mode in which the Court will deal with the plaintiff if he does not proceed to trial, is to deprive him of that *prima facie* right which the injunction gives him." And his Lordship also said, that if there had been in that case promptness on the part of the defendant, he should have thought it very reasonable to compel the plaintiff to go to trial at the assizes next after issue joined.

If the defendant has been guilty of *laches*, as where he has submitted to an interlocutory injunction for a long period before he brings a motion to dissolve it before the Court, he is not entitled to put the plaintiff upon terms to use so much expedition in bringing the action to a trial.

It is not usual to impose any other terms than these upon

the plaintiff, and the object being to test the validity of the plaintiff's title to his patent privilege, he is left to proceed by action in the best way he can for the purpose of establishing his right. Thus in the case of *Boulton v. Bull* (h), the first action having failed to produce any result, in consequence of the Court of Common Pleas being equally divided in opinion, a second action became necessary; and Lord Rosslyn, L. C., in dismissing a motion to dissolve an *ex parte* injunction, refused to impose any terms upon the plaintiff as to the Court in which the second action should be tried.

his action in the best way he can.

Boulton v. Bull.

Before the new pleading rules (i), it was sometimes desirable to put the questions at issue between the plaintiff and defendant into the shape of an issue to be tried in a Court of Law, in order that the precise questions for determination might be more distinctly brought before the Court and jury at the trial. But since the making of the pleading rules, already mentioned, the same reason for adopting an issue instead of an action no longer exists; for the defendant in an action is, by the now pleading rules, compelled to raise every objection which he takes to the validity of the patent by a proper plea, and under the 5 & 6 Will. IV. c. 83, s. 5., is bound to give the plaintiff notice of every objection which he intends to take at the trial. The practice of sending issues to be tried in a Court of Law respecting the validity of patents, has, therefore, been discontinued; and indeed it is more for a plaintiff's interest to have his patent right tried in an action than by an issue, for in an issue he would not be entitled to a notice of objections under 5 & 6 Will. IV. c. 83, s. 5.

Before the new pleading rules, questions respecting patents were sometimes determined by issue.

Practice of sending such issues to be tried at law has been discontinued.

And if the plaintiff is desirous of having his right tried by an action at Law, the Court will permit such an action to be brought, although the defendant does not ask to have such terms imposed upon the plaintiff; or even if the defendant, having already sued out a *scire facias* to repeal the patent, opposes any order being made for the plaintiff to bring an action (k).

If plaintiff is desirous of trying his right by an action, the Court will give him permission, although the defendant has sued out a *scire facias*.

When the Court refuses an interlocutory injunction, or dissolves it upon motion, and sends the plaintiff into a Court of

Upon refusing or dissolving an

(h) 3 Ves. 140.

(k) *Beddells v. Massey*, cor. Sir L.

(i) Reg. Gen. II. T. 4 Will. IV. 1834; Charn. New Rules, p. 125.

Shadwell, V. C. B., E. T. 1844.

Injunction, defendant is put upon terms to keep an account.

Formerly a defendant was sometimes ordered to admit an infringement.

No reason now for ordering such an admission to be made.

Usual upon an injunction being refused to order plaintiff to bring an action.

Case for the opinion of a Court of Law.

Admission of title as assignee. *Morgan v. Seaward.*

Law to establish his right; it is the almost invariable practice to lay the defendant under terms to keep an account of all the profits which he may make, by means of the manufacture and sale of the patent article; so that if the plaintiff shall succeed in establishing his right, the Court may be enabled to recompense him for his loss in the mean time, by ordering the defendant to pay him the amount of the profit, which he the defendant has made by means of the infringement.

Formerly when the plea of not guilty put in issue not only the infringement, but also the validity of the patent, if the Court saw *no ground whatsoever* for disputing the fact of infringement, the defendant would be ordered to admit at the trial that he had infringed the patent. And that was done because it was deemed desirable to ensure a trial of the questions between the parties respecting the validity of the patent, and the accidental failure to prove an infringement would have caused the plaintiff to be nonsuited, and the chief object of the trial would thus be frustrated. This reason, however, for ordering such an admission to be made, now no longer exists, for even if a plaintiff should fail to prove an infringement in support of the issue on the plea of not guilty, yet he may succeed in obtaining a verdict upon all the other pleas denying the validity of the patent.

And upon an injunction being refused or dissolved, it is also usual to order the plaintiff to bring an action precisely in the same way as if the injunction was granted or continued (l).

In a case where there is no question of fact in issue between the parties, as in *Harmer v. Playne* (m), the Court has deemed it better to put any mere question of law between them, into the shape of a case for the opinion of a Court of Law.

The Court has sometimes ordered the defendant to admit the title of the plaintiff as assignee of the patent, *Morgan v. Seaward* (n). But such an order is now rarely made, because it might tend very much to the prejudice of the defendant. For if the declaration alleges title in a sole plaintiff, or in one

(l) Vide *ante*, p. 344.

(m) 14 Ves. 136.

(n) 1 Webs. R. 167.

of several plaintiffs under an assignment, the defendant will be compelled either to traverse the title so stated, or (by not traversing it) to admit it; and if he admits it, he will ever afterwards be estopped from denying the title which is alleged in the declaration.

Thus, in the case of *Bunnett and Corpe v. Smith* (o), the declaration alleged an assignment of one moiety of the patent by the patentee to his co-plaintiff, and the defendant traversed that allegation in the declaration (p). The plaintiffs then applied to the Vice-Chancellor for an order to compel the defendant to admit the assignment, but his Honor refused to make such an order, but ordered that such an action should be tried as would decide the legal rights of the parties. The propriety of leaving a plaintiff to pursue his legal right in such a case cannot be doubted, for any other course might prejudice the defendant; and if the plaintiff has no legal right, he has no title to the interposition of a Court of Equity, which is only to be granted in support of the plaintiff's legal right.

Bunnett v. Smith.

If it be deemed necessary the Court will direct that each party shall produce all documents, &c., in his custody or power relating to the matters in question (q).

When the plaintiff has procured strong presumptive evidence that the defendant is infringing his patent, and is unable to obtain clear or satisfactory proof without an inspection of the defendant's machinery or premises, the Court will order the defendant to permit an inspection, on behalf of the plaintiff, by proper persons to be named in the order (r). And in cases where it appears to be necessary for the ends of justice, the Court will also order the plaintiff to permit a similar inspection by persons on behalf of the defendant (s).

Inspection will be ordered if necessary.

The object of the Court in imposing terms upon the parties

Object of the Court in imposing terms.

(o) Mich. Vac. 1844, V. C. E.

(p) See *Bunnett and Corpe v. Smith*, 13 M. & W. 552.

(q) See the orders made in *Morgan v. Seaward*, 1 Webs. R. 169; and in *Russell v. Cowley*, *Ibid.* 458.

(r) See *Morgan v. Seaward*, 1 Webs. R. 169; *Russell v. Cowley*, 1 Webs. R.

458; *Brown v. Moore*, *cit.* 3 Swan. 264; *Kynaston v. East India Company*, 3 Swan. 248; *East India Company v. Kynaston*, 3 Bl. Ap. Ca. 153; and the cases cited in the notes to the last case.

(s) See *Russell v. Cowley*, 1 Webs. R. 459.

Not imperative upon Court to impose terms.

in this way, is that the real and substantial questions at issue between them may be tried with as little delay as compatible with the attainment of justice; with as little injury as possible to either party, (it being uncertain until after the trial at Law which of the parties is in the wrong,) and so that when the legal rights of the parties have been ascertained, the Court may be enabled to do substantial justice between them. But it is not imperative upon the Court, either upon granting, refusing, or dissolving an interlocutory injunction, to put the parties under any terms whatsoever (r). For a plaintiff may, at any time, obtain leave of the Court to bring an action at Law against the defendant for the purpose of establishing his patent right. And a defendant in Chancery may without any such leave bring a *scire facias* to repeal the patent (s), and so procure the determination of any questions respecting the validity of the patent.

Wilson v. Tindal.

In the case of *Wilson v. Tindal* (t), before Lord Langdale, M. R., his Lordship did, in fact, impose upon the plaintiff the usual terms of bringing an action to try his right, but expressed himself strongly of opinion that the Court might grant an injunction without imposing such terms. His Lordship said in giving judgment, "Having regard to the arguments on the validity of the patent to the enjoyment of it by the plaintiffs, and to the evidence which appears upon the affidavits which have been made in this case, I am of opinion that the injunction which is applied for ought to be granted. The question for consideration is, whether any terms ought to be imposed upon the plaintiffs, or whether any other mode of investigating the facts than that which is adopted in the usual course of proceeding in this Court ought to be adopted. It is to be observed, that all orders made on applications of this kind are merely interlocutory orders; they do not bind the right between the parties. The injunction which I have stated it to be my intention to grant will be an injunction of course only till further order. It will not be a perpetual injunction, not an injunction to continue during the continuance

Order for an injunction is merely an interlocutory order, and does not bind the right.

(r) See *Bacon v. Jones*, 4 M. & C. 433, cited *ante*, p. 343; and *Wilson v. Tindal*, cited, *infra*.

(s) See the 6th Section of this Chap.
(t) 1 Webs. R. 730.

of the patent. Notwithstanding this order the defendant may put in his answer; he may displace all the affidavits which have been filed on both sides. The plaintiff and the defendant may respectively proceed to evidence; they may bring this cause on for a hearing, and upon the hearing of the cause, the whole case, the law regarding the patent, and the facts which will appear upon the depositions, will have to be reconsidered; and that reconsideration may for anything that can be known to the contrary, justly end in a result different from that which I have come to upon the present occasion. The defendant having his option to adopt this course of proceeding, has at the bar expressed his desire to have this matter tried at Law. If he were left merely to prosecute a *scire facias* for the repeal of the patent, there would be one part of the question which he might in that way try. But there are other questions subsisting between the parties regarding matters of fact which could not be tried in that way. Now it has been stated by Lord *Cottenham*, that he recollected no instance in which the Court has not adopted the course of directing the trial of an action; he has stated that to be the result of his experience. I certainly am very reluctant to try my own memory against that, but I should have supposed that there were instances in which that had been done. It is not the right of parties in every case to have an action tried in a Court of Law; it is a question of convenience, and the Court is to exercise a fair discretion. I have no doubt whatever of the competency of this Court to grant an injunction *simpliciter*. Neither had Lord *Cottenham* any doubt of it (u). But the question is, whether, when there is an opportunity for carrying the matter further, it is not on the whole a convenient course of proceeding to have it tried before the tribunal which is most proper for the determination of the legal question, and by which the facts can be better investigated than they can here. It is not, therefore, upon the ground of any doubt as to the validity of the patent that I make the order which I am about to make; but it is because the nature of the case entitles the defendant to a further investigation in

The cause may proceed notwithstanding.

Defendant might bring his *scire facias*.

A trial at law is not of right.

Court may grant an injunction *simpliciter*.

Question respecting proceedings at law is, what is the most convenient course.

Court will give defendant the benefit of a trial at law even when it does not doubt the validity of the patent.

(u) This clearly appears from Lord *Cottenham's* judgment in *Bacon v. Jones*, 4 M. & Cr. 436, cited *ante*, p. 343.

one form or other, and the most convenient and most effective mode appears to me to be that which has been mentioned; namely, by bringing an action in a Court of Law. Notwithstanding, therefore, the very forcible arguments I have heard upon this subject, I think I must in this case, as has been done in so many other cases, direct the plaintiff to bring an action to try this right, the injunction being granted in the terms of the notice of motion."

Demurrer to bill.

If a plaintiff's bill does not show sufficient title to the relief which he seeks to obtain, the defendant may demur to the bill; and if the demurrer be allowed, it will of course put an end to the suit. Upon a demurrer to a bill for an injunction to restrain the infringement of a patent, it is contrary to the practice of the Court to order the demurrer to stand over with liberty to the plaintiff to bring an action to try the validity of the patent.

Kay v. Marshall.

The practice of the Court upon a demurrer to such a bill was laid down so very clearly by Lord Cottenham, L. C., in his judgment in the case of *Kay v. Marshall* (x), upon an appeal from an order of Sir L. Shadwell, V. C., that it will be sufficient here to give an extract from the judgment. His Lordship said, "To this bill the defendant put in a general demurrer; and upon the argument in the Court below, the Vice-Chancellor ordered the demurrer to stand over with liberty to the plaintiff to bring an action to try the validity of the patent. No instance has been produced of such a course having been ever taken upon a demurrer; and I am of opinion that, however beneficial it might be in the result, by bringing the question in issue to a speedy determination, it is too great a departure from the practice of the Court, and too inconsistent with the nature of the question before the Court upon a demurrer, to be supported. Upon a demurrer no question of fact can be in issue; the question being, not whether the plaintiff be entitled, but whether, if all he say be true, he is entitled. Every allegation, therefore, however false in fact, must be taken to be true; but in the action, the question will not be what legal consequences will follow a state of circumstances such as the

Upon a demurrer to a bill, it is contrary to the practice to order the demurrer to stand over until after a trial.

Upon a demurrer, no question of fact in issue.

(x) 1 My. & Cr. 373.

bill alleges, but what are the rights of the parties upon a state of circumstances proved to exist, and which may be totally at variance with the allegations in the bill. The question being, what is the law upon an admitted state of facts, it would not be according to the course of the Court to send such a question to a jury; but there is in this case the additional objection, that the facts before the jury will not necessarily be the same as are stated in the bill. It is no answer to the objection to say, that by the modern course of proceeding at Law, the grounds upon which the verdict of the jury has proceeded will appear upon the record. This circumstance may no doubt render the verdict more useful in ascertaining the rights of the parties; but it may still leave the question quite open as to what is the result in law of the facts stated in the bill. I am, therefore, of opinion that the order appealed from cannot stand. It remains to be considered whether the demurrer ought to have been allowed or overruled; and upon this view of the case, I must assume that the Vice-Chancellor thought that he could not allow the demurrer, and in that opinion I think he was right. The plaintiff alleges that he has been in possession of his patent right for ten years, and that he has within that time established his right at Law. *The equitable relief flows from the legal title*, and the question is, whether upon the statements in the bill the Court can take upon itself to decide that the plaintiff has no legal title. If the plaintiff asking the equitable relief upon the ground of a legal title, states upon his bill a title which cannot be supported at Law, the defendant may take advantage of it by demurrer; but if the plaintiff states himself to stand in the position of having so far established his title at Law as to give him at least a *prima facie* title, this Court will so far give credit to such circumstances, as to afford him the aid of its jurisdiction until the suit shall be in such a state as to call upon the Court for a decision, or to direct such proceedings as may be necessary to complete the investigation of the right at Law. Many cases were cited to show that upon demurrer the Court enquires, not whether the plaintiff may have a title from the facts stated, but whether he has stated a good title. But the cases which stand upon legal titles differ from those in which the title is alto-

The question is, what is the law upon an admitted state of facts.

The question raised by a demurrer cannot be submitted to a jury.

The question is, whether the bill states a sufficient *prima facie* legal title.

Cases upon legal titles different from

those upon equitable titles. If plaintiff has established his title at law against defendant, the Court will not refuse him assistance because it disapproves of the decision at law.

gether equitable. If, for instance, a plaintiff comes here for equitable relief after he has established his right at Law against the defendant, the Court will not withhold its assistance because it may doubt or disapprove the decision at Law. What then is the state of the plaintiff's legal right as he states it in his bill? That he has been in the enjoyment of it for ten years, and that he has in actions against others established it at Law. There is, therefore, possession of a considerable duration strengthened by the verdict obtained, *though not thereby conclusively established against the defendants*. To refuse to entertain the suit, would be to deprive the plaintiff of the benefit of his possession. In *Boulton v. Bull* (y), Lord *Rosslyn* refused to dissolve an injunction, although the Court of Common Pleas had been equally divided upon the validity of the patent. There had indeed been long possession in that case, but the right was at that time very doubtful; and Lord *Rosslyn* proceeded upon the ground that he would not disturb the possession. In *Harmer v. Playne* (z), Lord *Eldon* acted upon the same principle, and said that where the public had permitted enjoyment under a patent for a reasonably long time, the Court would give credit to the patent until the legal question could be tried; and he therefore granted an injunction, although he expressed great doubt as to the validity of the patent. In that case the patent was of thirteen years' standing. In *Hill v. Thompson* (a), Lord *Eldon* again laid down the same rule, observing, that where a patent had been granted, and an exclusive enjoyment of some duration had existed under it, the Court would interfere by injunction without putting the party previously to establish his title at Law; but that where the patent was but of yesterday, and its legality was disputed, the Court would not act upon its own notions of the validity or invalidity of the patent without the right having been first established at Law. In that case the motion was made in the year 1817. The patent was taken out in the year 1814, and the specification bore date in January 1815; but the invention had not been used until July 1816. These, indeed, are all cases of injunction; but the principle applies

(y) 3 Ves. 140.
(z) 14 Ves. 133.

(a) 3 Mer. 622.

equally to cases of demurrer. The Court may refuse an injunction in many cases in which the facts, if stated upon the bill, would preclude a demurrer; but it could not grant an injunction upon facts which, if stated upon the bill, would make the bill demurrable. If the facts do not give the Court jurisdiction, no injunction could issue; and for the same reason a demurrer would hold if facts of that description constitute the bill. If the plaintiff in this cause should ever apply for an injunction, the truth of the statement upon the bill to which I have adverted will then come in question. Upon the demurrer the truth of it cannot be questioned; and this bill represents such an enjoyment of possession under the patent, not by acquiescence merely, but by force of the assertion of title at Law, as within the authority of cases I have referred to, entitles the plaintiff to have his legal title recognized in this Court, until a proper occasion shall arise for having its validity ascertained. That I have already said cannot be done upon demurrer. Upon these grounds I am of opinion that this bill states such a case as precludes the Court from saying, upon demurrer, that the legal title under which the plaintiff claims is bad; the order of the Vice-Chancellor must therefore be discharged, and the demurrer overruled."

Upon demurrer the truth of the bill cannot be questioned.

In the case of *Hicks v. Raincock* (b), the defendant demurred to the plaintiff's bill on the ground that he had not established his right at Law to his patent, but the demurrer was overruled.

Hicks v. Raincock.

If the defendant wishes to avoid the necessity of answering the bill, and making a discovery which would compel him to set out accounts of great length, he must put in a plea; and if a single plea will not be sufficient to enable him to make his defence, he must apply for leave to plead double.

Defendant may plead to the bill.

In *Kay v. Marshall* (c), after a demurrer to the bill had been overruled, the defendant applied for leave to plead double, which was granted accordingly.

Kay v. Marshall.
Leave to plead double.

If a defendant does not demur or plead to the bill, he must within due time after appearance put in his answer to it. By his answer he ought to show what objections (if any) he makes

Defendant's answer to the bill.

(b) 2 Dick. 647.

(c) 1 Keen. 190.

to the validity of the patent, and also whether he admits or denies the alleged infringement (*d*).

Defendant's objections to the patent ought to be stated.

The various objections which may be taken to a patent have already been adverted to (*e*), and each objection ought to be stated as clearly and distinctly as practicable, without going into the evidence by which the objections are intended to be sustained. The objects for stating the objections in this way are, that the plaintiff may be prevented from using any affidavits in contradiction to matters which are stated in the answer, and also from using the answer as evidence against the defendant at the trial at an action at Law. It is usual indeed for a plaintiff to press for the answer, in order that he may be able to give any admissions it may contain in evidence against the defendant upon a trial at Law; but the answer rarely becomes available for that purpose, for a defendant generally has objections to take to the patent, which is put in suit against him, and if he takes care to state those objections distinctly on the face of the answer, the plaintiff will not give in evidence a document which would destroy his title.

Answer ought to be put in immediately.

The plaintiff generally moves for an interlocutory injunction before the defendant has put in his answer; but if plaintiff does not move immediately, the defendant ought to put in his answer with all possible dispatch, so as to prevent the plaintiff from afterwards using any affidavits which contradict the statements it contains. And as already stated (*f*), if the plaintiff has obtained an injunction *ex parte*, the defendant ought if he can to put in his answer before he moves to dissolve it.

Further proceedings in a suit.

It is not often that a patent suit proceeds further than a motion for or to dissolve an injunction after the legal rights of the parties have been determined by a trial at Law.

If the plaintiff succeeds at law he is entitled to the relief prayed by his bill.

If the patent has been established in a Court of Law against all the objections taken to it by the defendant, and it has been shown that the defendant has actually committed an infringement of the patent privilege, the plaintiff is clearly entitled to the relief sought for in his bill, *viz.*—an injunction to restrain the further violation of his patent right, and a

(*d*) See the Form of an Answer in the Appendix, Chap. II. s. 5.

ante, p. 266.

(*f*) *Ante*, p. 330.

(*e*) In the 2nd section of this Chap.

account of the profits which he has lost by means of the infringements already committed by the defendant. In such a case it would be useless for a defendant further to resist the plaintiff's claim to equitable relief, for the determination of the legal rights of the parties respectively by a Court of Common Law, is that upon which the Court of Chancery will act, unless it can be shown that the determination was fraudulently or unfairly obtained.

If on the other hand the defendant has fairly obtained a verdict upon any issue in an action brought to try the validity of plaintiff's patent, by which it is shown either that the patent is void, or that the defendant has not infringed it, there is an end to the plaintiff's title to the relief prayed for by his bill. For a patentee can only have relief in Equity in support of a good and legal patent privilege, and the jurisdiction of the Court is only exercised in favour of a plaintiff, when it can be shown that the defendant has actually violated the patent, or at all events threatened to do so.

If the defendant succeeds, the plaintiff has no title to relief.

For these reasons the unsuccessful party in proceedings at Law generally submits, and the further progress of the suit is rendered unnecessary by a compromise.

Parties generally compromise after a trial at law.

But if the party defeated in the proceedings at Law does not think fit to submit, or thinks that he can succeed in Equity, notwithstanding the adverse judgment of a Court of Law, the suit must proceed to a hearing in the ordinary manner (g).

But if the defeated party will not submit, the suit must proceed.

So also if the plaintiff having obtained a legal decision in his favour, and in consequence of a compromise being refused, or any other cause, he is desirous of recovering a remuneration for his loss, he must proceed with his suit to a hearing in order to obtain a decree for an account of the profits which he has lost by means of the defendant's infringements.

To obtain a decree for an account plaintiff must proceed to a hearing.

When the cause proceeds to a hearing, the plaintiff must support all the allegations contained in his bill by the examination of witnesses, or other evidence, in the usual way; and set down the cause for a hearing so as to obtain a decree for a perpetual injunction, and the taking of an account of the profits lost by the plaintiff.

When cause proceeds, witnesses must be examined and cause set down in the usual way.

When a cause comes on for hearing, the Court will deem Verdict and judgment at

(g) See the observations of Lord Langdale, M. R., in *Wilson v. Tindal*, cited ante, p. 348.

law will be deemed conclusive, unless they can be impeached.

the verdict of a jury, and the judgment of a Court of Law in an action tried between the parties, to be conclusive as to their legal rights, unless the verdict or judgment can be impeached. If the plaintiff has succeeded, he will be entitled to a decree, and if the defendant, the bill will be dismissed with costs.

Court may direct further proceedings at law.

If the Court, however, should see any good reason for doubting the correctness or sufficiency of a verdict or judgment at Law, it may direct such further legal proceedings as it shall deem necessary for determining the rights of the parties in a Court of Law, the bill being retained until the decision has been obtained.

If no action has been tried between the parties, the Court may either itself determine any question raised respecting the validity of the patent, or may send the question to a Court of Law to be determined, retaining the bill until the question is determined (*h*).

Plaintiff may obtain an injunction at the hearing, although he has not moved for an interlocutory injunction.

Bacon v. Spottiswoode.

If a plaintiff neglects to move for an interlocutory injunction, that will not deprive him of the right to an injunction at the hearing if he can show sufficient merits. This was laid down by Lord Langdale, M. R., in the case of *Bacon v. Spottiswoode* (*i*), who in giving judgment in that case, said: "I think that if a plaintiff be entitled to an injunction on the merits, and on the evidence produced at the hearing, he is not to be deprived of that right, because he has not moved for an injunction at a previous stage of the cause. The answer may be so speedily put in, and so framed, that it would be perfectly absurd for the plaintiff to move for an injunction (*h*), although he might be entitled to an injunction upon the merits at the hearing."

Not necessary for plaintiff to try an action before the hearing, but it is rarely expedient not to do so.

Bacon v. Jones.

Nor is it absolutely necessary that a plaintiff should proceed to try the validity of his patent at Law, before the hearing of his cause in Equity, so as to entitle him to an injunction; although it can be very rarely advisable to bring a cause to a hearing before he has established his title in a Court of Law.

In the case of *Bacon v. Jones* (*l*), Lord Cottenham, L. C.

(*h*) See *Few v. Guppy*, 1 M. & Cr. 487.

(*i*) 1 Beavan, 382.

(*k*) Vide *ante*, p. 324, respecting the rule, that a plaintiff cannot, for the

purpose of obtaining an interlocutory injunction after answer, contradict the answer in any respect as to the plaintiff's want of title, &c.

(*l*) 4 My. & Cr. 433.

after stating the various modes in which applications for interlocutory injunctions might be disposed of, said: "When the cause comes to a hearing the Court has also a large latitude left to it; and I am far from saying that a case may not arise in which, even at that stage, the Court will be of opinion that the injunction may properly be granted without having recourse to a trial at Law. The conduct and dealing of the parties, the frame of the pleadings, the nature of the patent right, and of the evidence by which it is established, these and other circumstances may combine to produce such a result; although this is certainly not very likely to happen, and I am not aware of any case in which it has happened. Nevertheless, it is a course unquestionably competent to the Court, provided a case be presented which satisfies the mind of the Judge, that such a course, if adopted, will do justice between the parties. Again the Court may at the hearing do that which is the more ordinary course; it may retain the bill, giving the plaintiff the opportunity of first establishing his right at Law. There still remains a third course, the propriety of which must also depend upon the circumstances of the case; that of at once dismissing the bill."

A case may arise in which an injunction would be granted at the hearing without a previous trial.

Bill may be retained to give plaintiff an opportunity of establishing his right at law.

Or may be at once dismissed.

If plaintiff does not establish his right at law before hearing, it will not be sufficient merely to make out a *prima facie* case.

Bacon v. Spottiswoode, and Bacon v. Jones.

If plaintiff neglects to proceed to a trial, and fails to make out a clear title, his bill will be dismissed.

But if a plaintiff does not proceed to establish his right at Law before the hearing, it will not be sufficient for him merely to make out a *prima facie* case; he must establish an unexceptionable title, or he must show to the Court some good reason why he has not taken proceedings for establishing his right in a Court of Law. This was decided in the cases of *Bacon v. Spottiswoode* (m) and *Bacon v. Jones* (n), in which the plaintiff having neglected to proceed to a trial, failed to make out a clear title at the hearing, and the Master of the Rolls made decrees dismissing the plaintiff's bills with costs; and an appeal to the Lord Chancellor, in *Bacon v. Jones* (o), was also dismissed with costs. The principle upon which the Court acts in such cases is most clearly explained in the judgments of the Master of the Rolls and the Lord Chancellor in the two cases just cited. The Master of the Rolls (Lord Langdale) said (p), "These two bills were filed to obtain an injunction to restrain an alleged infringement on the plaintiff's

(m) 1 Beavan, 382.

(n) *Ibid.*

(o) 4 M. & Cr. 433.

(p) 1 Beavan, 388.

patent, and for consequential accounts. When a cause of this kind is brought to a hearing (an occurrence which does not frequently happen), it is for the purpose of having an injunction made perpetual, or continued during the legal right of the plaintiff under his patent; and it appears to me, that however unusual the circumstance may be, the plaintiff is not precluded from asking for an injunction by the fact of his not having applied for it on interlocutory motion: but the usual course being to ask for the injunction as an immediate protection on interlocutory motion, and the Court having then an opportunity of directing such proceedings, if any, as may be required to determine the validity of the patent; it seems, that the plaintiff, if he omits to move for the injunction at an early period in the cause, first shows that he does not consider the injunction as immediately necessary for the protection of his interest, and next *imposes upon himself the obligation of making out a clear and unexceptionable title at the hearing.* It would be very inconvenient if the plaintiff, having neglected to employ the means in his own power, or which the Court would have afforded him, to establish the validity of his patent, should be permitted to avail himself of doubts which he has himself left, for the purpose of obtaining further time to do the same thing which he ought to have done before. I think, that, at the hearing of the cause, the Court has to look at the facts produced in evidence, for the purpose of considering whether a perpetual injunction should then be granted. On an interlocutory order, it has to look at the facts produced in evidence, for the purpose of considering whether an injunction should be granted till the right can be tried, or further investigated. It is truly said, that where a patent has been granted, and there has been an exclusive possession of some duration under it, the Court may interpose its injunction, without putting the party previously to establish the validity of his patent by an action at Law; but this interposition must nevertheless depend, to a considerable extent, on the circumstances of the case, and the nature of the defence. The Court is not bound to grant the injunction merely because a patent has been granted and exclusively enjoyed for some time; and when the cause is brought to hearing, I apprehend that the plaintiff ought to show his title clearly: and that, if he fails

If plaintiff omits to try before the hearing, he must make out a clear title.

Inconvenience produced by plaintiff delaying to proceed to a trial.

At the hearing Court not bound to grant an injunction upon a *prima*

in that, and has not previously obtained an injunction; he will not be allowed to use the facts proved in the cause as evidence of a *prima facie* case, giving him a right to further delay, for the purpose of enabling him to establish more satisfactorily the legal title upon which alone his equity is founded. In this particular case, having regard to the nature of the patent and the specification, and to the defence, the nature of the alleged infringement, and all the facts which have been now proved, I think that the Court would not upon the same facts have granted or continued an injunction previously to the validity of the patent being established by an action at Law; and, therefore, that the plaintiff has not done that which it appears to me he must be deemed to have undertaken to do before he set down his cause for hearing; he has not made out a clear and unexceptionable title; and having failed to do so, the question which I have had to consider in his favour is, whether the bills should be retained for a year, in order to give him an opportunity of now bringing actions; but, for the reasons which I have stated, I think that this ought not to be done; and having regard to the nature of the suit, and the sort of jurisdiction which the Court exercises in such cases, I am of opinion that the bills must be dismissed with costs.”

And upon the appeal, Lord *Cottenham*, L. C., in giving judgment said, “Generally speaking, a plaintiff who brings his cause to a hearing is expected to bring it on in such a state as will enable the Court to adjudicate upon it, and not in a state in which the only course open is to suspend any adjudication until the party has had an opportunity of establishing his title by proceedings before another tribunal. And I think the Court would take a very improper course if it were to listen to a plaintiff who comes forward at the hearing, and asks to have his title put in a train for investigation without stating any satisfactory reason why he did not make the application at an earlier stage. When he comes forward upon an interlocutory motion, the Court puts the parties in the way of having their legal title investigated and ascertained; but when a plaintiff has neglected to avail himself of the oppor-

facie case, or unless plaintiff shows a clear title.

If plaintiff neglects to proceed to a trial before the hearing, and fails to make out a clear title, his bill will be dismissed with costs.

Plaintiff is expected to bring his cause to a hearing in such a state as will enable the Court to adjudicate.

If plaintiff asks at the hearing for a trial at law, he must explain his delay.

If plaintiff neglects to avail himself of the

opportunity of proceeding to a trial before the hearing, it is a question of discretion whether Court will then assist him.

Plaintiff may have liberty to bring an action at any time before the hearing.

When plaintiff has been guilty of great delay, the Court will not give him further time to establish his right.

No case in which the Court has retained a bill to enable the plaintiff to do that which he has had ample opportunity of doing previously.

tunity thus afforded, it becomes a mere question of discretion how far the Court will assist him at the hearing, or whether it will then assist him at all. If, indeed, any circumstances had occurred to deprive him of that opportunity in the progress of the cause, the question might have been different. But in this case I have not heard any reason suggested why the plain and ordinary course was not taken by the plaintiffs of previously establishing their right at law. They might have brought their action before filing the bill, or they might, after the bill was on the file, have had their right put in a train for trial. Instead of that, *they have allowed the suit to remain perfectly useless to them for the last four years.* They knew of the alleged infringement in the month of August 1835; and from that time till the hearing there was no moment at which they might not, by applying to the Court, have had liberty to bring an action to establish their title at Law. It is obvious that such a line of proceeding exposes a defendant to inconveniences which are by no means necessary for the protection of the plaintiff. It is no trifling grievance to a defendant to have a Chancery suit hanging over him for four years, in which, if the Court shall so determine at the hearing, he will have to account for all the profits he has been making during the intermediate period. Is a defendant to be subject to this annoyance without any absolute necessity, or even any proportionate advantage to his adversary, and without that adversary being able to show any reason why he did not apply at an earlier time? It appears to me that it would be very injurious to sanction such a practice, more especially when I can find no case in which the Court has thought it right to retain a bill simply for the purpose of enabling a plaintiff to do that which these plaintiffs might have done at any time within the last four years. It was much more regular and proper that the plaintiffs should have taken steps for putting the legal right in a course of trial. Those steps they have not chosen to take; and it is now impossible to put the defendants in the same position in which they would have stood if such a course had been originally adopted. For these reasons, I am of opinion, that the Master of the Rolls, finding that the evidence in the cause was not

such as he could act upon with safety, came, in the exercise of his discretion, to a sound conclusion, when he refused to grant the injunction or retain this bill."

Whenever a plaintiff in a patent suit has made out a good and legal title to the privilege granted to him by his patent, and has proved that his privilege has been violated by the defendant, he is entitled to the relief prayed by his bill, and a decree that the defendant be restrained by injunction from committing any further infringement, and that he render an account of all the profits which he has made by invasion of the plaintiff's privilege.

When plaintiff has proved his title and an infringement, he is entitled to a decree.

The injunction which a plaintiff obtains by decree, is not merely temporary, or until further order, like an interlocutory injunction, but extends to the whole duration of the patent privilege; and not only applies to the particular mode of infringement proved against the defendant, but to all other modes in which the patent privilege may be violated.

Injunction granted at the hearing perpetual.

The plaintiff is also entitled to an account of profits in a patent suit, whenever he has made out a title to the interposition of the Court by injunction in his favour; and the Court gives him an account, in order that his remedy may be complete. But if the plaintiff fails to make out his claim to an injunction, he cannot have a decree for an account (q).

Plaintiff's right to an account depends upon his title to an injunction.

In consequence of the difficulty of working out a decree for taking an account of profit, such an account is rarely taken (r).

Difficulty of taking an account.

It is difficult to define the extent to which the Court can

(q) *Balley v. Taylor*, 1 Russ. & My. 73.

(r) The practical difficulties in the way of the working out such a decree are clearly shown by the judgment of the Lord Chancellor in the case of *Crossley v. The Derby Gas Light Company*, 3 M. & Cr. 428. The bill in that cause, after stating the plaintiff's title to a patent for making gas-meters, and alleging that the defendants had made gas-meters, which were infringements on the patent, and had used them in carrying on their works or had sold and disposed of them for profit, prayed that the defendants might account for all such meters so sold or disposed of or used, and for the full value thereof, or

other profit of the sales, or other disposition or use thereof. By the decree an account was directed of what profit had been received, and what benefit derived from the use of such gas-meters as were made and manufactured during the existence of the letters patent, from six years previous to filing the bill and down to the date of the decree, and it was ordered that the defendants should pay to the plaintiff what should be found due upon taking such account. The Master, by his report, "Found and certified that a benefit had been obtained by the defendants by the use of meters in saving gas equal to 2s. 6d. for every 1000 cubic feet of gas, equivalent to profit, and thereby enabling the Com-

go in compelling the defendant to account to the plaintiff for profits. It is clear that the Court will give to the plaintiff all

pany to sell at 10s., and that 25 per cent. had been saved by the use of meters; and it appeared by the books of the Company that the defendants, by hand-bills printed and delivered to customers in July, 1821, determined that meters should be furnished free of expense; and that the Company hoped to be able to furnish gas permanently to those who used meters at 7s. 6d. per 1000 cubic feet. And it also appeared that the Company, on the 8th of May, 1822, made an order, that all persons having more than one light, or having but one light, which was not publicly exposed, should give notice of their intention to receive a gas-meter ten days before Midsummer-day then next; and in case of their omitting to give such notice the pipe of communication would be cut off. And upon the whole consideration of the several states of facts and the evidence so laid before him, the Master allowed and found that the benefit, including profit received, derived by the defendants from the use of such gas-meters as were made and manufactured during the existence of the letters patent, from six years previous to filing the plaintiff's bill down to the date of the decree, amounted to the sum of 6,000l." To this report the defendants took several exceptions, which came on for argument before the Master of the Rolls on the 6th of May, 1837, when his Lordship made an order referring it back to the Master to review his report, with a direction that he should state to the Court the grounds upon which he came to the conclusion which he might arrive at.

The plaintiff appealed against that order, but the Lord Chancellor (Lord Cottenham) dismissed the appeal with costs.

His Lordship, after stating the objects of the bill and the substance of the decree, said, in delivering judgment:—

"This decree was pronounced by the Vice-Chancellor, in March, 1834, and was, upon appeal, affirmed by Lord Brougham; and the only duty of the Court upon the exceptions to the Master's report, now before me upon appeal from the order of the Master of the Rolls, is to put a construction upon

the decree, and decide whether the Master has properly taken the account referred to him by the decree. The Master of the Rolls appears to have stated that he was unable to ascertain the grounds upon which the Master had reported the sum of 6,000l. as the result of the account, and referred it back to the Master to review his report, and to state the grounds upon which he came to the conclusion he might arrive at, not to state the grounds of the report already made. There is not, therefore, the difficulty urged at the bar in support of the appeal, that, as the reference cannot be made to the same Master, some variation in the order of the Master of the Rolls was, at all events, necessary. If the Master of the Rolls is to be taken to mean that he did not understand how the evidence stated in the report could have led the Master to the conclusion to which he came, I entirely concur in that opinion; but it appears to me that the grounds upon which the Master proceeded do appear upon the report, and that they do not support the conclusion. He states, that he found from the evidence that benefit, equivalent to profit, and equal to 2s. 6d. upon every 1,000 cubic feet, had been obtained by the use of the meters, and that 25 per cent. had been saved by the use of the meters. He then states the particular grounds of this conclusion, which are, hand-bills circulated by the Company in 1821, intimating the Company's intention of furnishing meters free of expense, and that the Company hoped to be able to furnish gas permanently, to those who used meters, at 7s. 6d. per 1,000 cubic feet, the price to those who did not use meters being 10s. Also an order of 1822, by which certain persons were not to be served with gas unless they used meters; and he then reports 6,000l. to be the result of the account, a sum which appears to have been produced by calculating 2s. 6d. upon each 1,000 cubic feet of gas supplied, rejecting, however, some hundreds of pounds, which, if the principle were correct, ought to have been added to the 6,000l.

the profits which the defendant has actually made by infringing the plaintiff's patent privilege, but in the absence of

"It is obvious that a suggestion never acted upon, that the Company might at some future time supply gas to those who used meters at 2*s.* 6*d.* per 1,000 cubic feet less than to those who did not, can be no ground for estimating the profit actually derived from the use of them. But there was another statement of the Company in evidence which was much relied upon, namely, that not more than three-fifths of the gas made was paid for. This was a vague statement, not to be relied upon in executing a decree directing an account of profit to be taken.

"The grounds, however, upon which the Master proceeded, and upon which it was attempted to support his report, were these: the Company charge 10*s.* per 1,000 cubic feet; the quantity supplied is calculated by the ascertained consumption of a certain number of burners in a given time; and if the burners were always in a proper state, and the time were never exceeded, all the gas supplied would be paid for. But that is not the case; frauds are practised by altering the burners and exceeding the stipulated time, so that it is found that, instead of 1,000 cubic feet being consumed in the given time, a much larger consumption takes place, equal to one-fourth more; that is, 1,250 cubic feet are consumed instead of 1,000; but as the Company charge 10*s.* per 1,000 feet, that is 2*s.* 6*d.* for every 250 cubic feet, the loss of the 250, that is of the difference between the 1,250 and the 1,000 is worth 2*s.* 6*d.*, and as by the use of the meter these frauds are prevented, the Company save 250 cubic feet upon every 1,000 cubic feet, which is equivalent to 2*s.* 6*d.* for every 1,000 cubic feet.

"Now assuming these figures to be correct—and if the principle followed be not just, there is no necessity for enquiring whether they are so or not—the calculation proceeds upon the supposition that 2*s.* 6*d.* is the value to the Company of 250 cubic feet of gas; whereas it appears that the Company have been supplying, not 1,000 cubic feet, as calculated, but 1,250 cubic feet for 10*s.*; nay, much more, for it is ad-

mitted that 10 per cent. is lost under either system before the gas comes to the consumer's premises, so that 1375 must be made for every 1,000 paid for; and if their proposal of charging 7*s.* 6*d.* only be used as evidence against them, it would show the value of the 1,000, or rather 1,100, cubic feet to be 7*s.* 6*d.* and not 10*s.* The whole principle of the calculation appears to me to be founded in error. The supposed profit is in fact a protection against a loss. The sum charged for any quantity of gas supplied, must not only cover all the expenses of the establishment, machinery, materials, labour, and interest of capital, but also the profit of the Company. The actual loss sustained in making 250 cubic feet over and above the 1,000, cannot, however, be measured by a proportional part of these charges and outgoings. By far the greater part of these would be the same, though 1,000 only were produced. After printing 1,000 copies of a newspaper, the expense to the proprietor, of printing 250 more will very little exceed the value of the paper and labour employed; and if we suppose some defect in the machinery for printing, in consequence of which 250 copies out of every 1250 are rendered unfit for use, would not the loss consist in the paper and other materials, and the labour employed in printing the 250 useless copies?—would it be reasonable to calculate the loss at one-fourth part of the price for which the 1,000 good copies were sold? By the same rule, if the Company were repaid the value of the materials actually consumed in producing the additional 250 cubic feet, and of the additional labour paid for, with a due allowance for the additional wear of the machinery employed, their loss would be repaid to them. The Master, by the course he has adopted, has not only charged upon these 250 cubic feet a proportion of all the cost and expense of the establishment, machinery, and interest of capital, but of the profit of the Company. It is clear that the Company have not, in making the additional 250 cubic feet, sustained this loss. The amount, therefore, would be

all authority on the subject, it is impossible to say whether the Court can also compel the defendant to pay the plaintiff

the measure of the profit or benefit derived from the use of meters. The Master has not even carried out his own principle, for he has not allowed for the cost of the meters, or for any expenses by which a saving has been effected.

“That the Master has not adopted a correct mode of estimating the profits derived from the use of meters, seems to me quite clear. It is therefore impossible to confirm his report; but it is also, I think, impossible to allow the exceptions, all of which assert the proposition that no benefit or profit has arisen from the use of the meters, within the meaning of the decree. Of this I felt no difficulty at the hearing of this appeal; but I felt the same anxiety which the Master of the Rolls has expressed, to make, if possible, such a declaration of the opinion of the Court upon the construction of the decree, as might guard the parties against the chance of a second failure before the Master. Upon carefully considering all the circumstances of the case, however, I am satisfied that I cannot do so consistently with the usual practice of the Court, or with any certainty in the present state of the inquiry, of not promoting instead of preventing the chance of error. There is nothing doubtful or ambiguous in the terms of the decree, nothing therefore to be explained by any explanatory Order, and I have no authority to depart from, or in any respect to vary the directions it contains.

“I am quite aware of the difficulty which may, indeed must, arise in doing with accuracy what the decree directs. To ascertain the profits created by the application of particular means, and, for that purpose, to refer a just proportion of the profits made to some only of the agents employed, may involve questions of the greatest nicety; but such is the duty which the decree has imposed upon the Master. A similar duty was imposed and similar difficulties were experienced in *Brown v. De Tastet* (*). There the object was to ascertain the profits made by the use of a particular portion of the capital em-

ployed; here, by the application of a particular part of the machinery used. In that case the plaintiff had, I believe, ultimately to lament, that in attempting to give to her what abstractedly she was thought to be entitled to, the means by which that object was to be attained were not sufficiently considered. It is easy to foresee many of the difficulties which may arise in taking the accounts directed by the decree, but impossible by anticipation to prescribe to the Master the means of solving them. Some considerations, indeed, though essentially affecting the profits in question, seem to be beyond the reach of calculation. It is obvious, for instance, that the use of the meters, by preventing fraud and the effects of negligence, would enable the Company to supply the gas at a lower rate, and so either cause an abatement, or prevent an increase in the charge; the necessary consequence of which would be to increase the consumption, and add to the profits. But to what extent this effect was thereby produced, and what profits were thereby created, it is impossible to appreciate. In any business in which much money is lost by bad debts, those consumers who pay may be supposed generally to indemnify the tradesman against the dishonesty of others, by the additional price they are compelled to pay; but, if all paid, the same profit would result from selling at lower prices, and the additional profits from the increased consumption would be great, but incapable of being reached by previous calculation.

“So long as it shall be the course of this Court to direct such accounts of profits,—and there are many precedents to support them,—(whether those precedents justify the decree in this case, it forms no part of my duty to enquire,) such among other difficulties will arise, which must be in some manner surmounted. This can only be attempted, when they actually occur, in pursuing the investigation directed. It is impossible, by any declaration or direction, to provide for them by anticipation.

* Jac. 234. See also Lord Brougham's observations in *Docker v. Somes*, 2 My. & K. 665-8.

the amount of any other loss which he has sustained, in consequence of the defendant violating the patent.

The amount of profits which the defendant has actually obtained by means of the infringement of the patent, is properly the subject of an account, and may be ascertained by an inquiry before the Master, although there are many difficulties in the way which prevent such an account from being satisfactory. But if the plaintiff should be held to be also entitled to recover in Equity, the amount of all the loss which he has sustained by reason of the violation of his right, it is quite clear that it would not be practicable to ascertain the amount by an account in the Master's office; and, therefore, it seems that the only course would be to send an issue into a Court of Law, to have the amount of the damages sustained by the plaintiff assessed by a jury.

In consequence of the difficulties in the way of taking an account of profits under a decree, and the vexatious nature of the proceeding, it is usual for the parties to determine the amount of profit for which the defendant is to account by agreement, and it is clearly to the interest of both parties to do so.

If the amount of profit for which the defendant would have to account is very small, the plaintiff may waive the account (r), and after having obtained an injunction, if the defendant submits it would be useless to proceed with such a suit to a hearing.

Usual to compromise the claim for an account.

Account may be waived.

I regret the difficulties to which the plaintiff is exposed in prosecuting the right which the decree gives him; and that I have not the means, in this state of the proceedings, to assist him. But I would seriously submit to the consideration of both parties the expediency of terminating this contest by some compromise and arrangement. The plaintiff has very large rights under the decree, but is met by very serious difficulties in obtaining the fruits of it. The defendants, on the other hand, have this difficulty hanging over them; and although they may trust to the difficulties in the way of the plaintiff, they may be assured that the decree has in it that, which must, if prosecuted, subject them to great vexation and expense, independently of what they may have ultimately to pay from the result

of the account. It is a case, therefore, in which it would seem that a reasonable compromise must be for the benefit of both the parties litigant; and it was for the purpose of informing them of what, in my view of the case, constitutes the real situation of each, in the hope of leading both to think seriously of the evils of further litigation, that I have been induced to go more into detail, than the duty I have at present to perform seemed to require. Upon the whole, I am of opinion that the Master of the Rolls made the proper order, and that if the contest is to continue, the present Master must renew the attempt to take the account directed by the decree."

(r) See *Fradella v. Weller*, 2 Russ. & M. 247.

If a plaintiff intends to waive his right to an account, he ought to give the defendant notice of his intention, and if the defendant submits and pays all the plaintiff's costs, further proceedings will be unnecessary. But if the defendant refuses to submit or to pay the plaintiff's costs, the cause must proceed to a hearing, and the plaintiff will then obtain a decree for a perpetual injunction, and for the payment of his costs of suit (s).

If the defendant submits, a decretal order ought to be made to give effect to the agreement between the parties.

If patent previously tried, certificate should be given in evidence to obtain full costs.

If the validity of the patent upon which the plaintiff is proceeding has been previously established by any judgment or decree, and a certificate obtained, the certificate ought to be given in evidence so as to entitle the plaintiff to full costs, under the statute 5 & 6 Will. IV. c. 83, s. 3 (t), as altered by the 5 & 6 Vict. c. 97, s. 1 (u). But the Judge making a decree or decretal order may certify to prevent the plaintiff from obtaining any more than ordinary costs (x).

Judge may certify that validity of patent has come in question.

When the validity of the patent actually comes in question at the hearing upon the making of a decretal order, the Judge is authorized by the statute 5 & 6 Will. IV. c. 83, s. 3 (y), to certify that fact, so as to enable the patentee to obtain full costs in any future proceedings upon the patent. And if the plaintiff has not already procured such a certificate (z), he ought to apply to have one granted to him (a).

SECTION IV.

Of an Action for Penalties for Counterfeiting the Name or Device of a Patentee.

Offence of counterfeiting patentee's name or mark.

THE statute 5 & 6 Will. IV. c. 83, has provided an additional protection to patentees against persons who may be guilty of counterfeiting or imitating their names, marks, or devices, upon articles made according to or in imitation of their inventions,—

(s) *Fradella v. Weller*, 2 Russ. & M. 247.

(t) Stated *ante*, p. 300.

(u) *Ibid.* p. 303.

(x) *Vide ante*, pp. 300, 304.

(y) Stated *ante*, p. 300.

(z) See the form of certificate in the Appendix, Chap. II. s. 5.

(a) See the observations respecting costs in section 2, *ante*, p. 301.

By sect. 7, of that statute, it is enacted, "That if any person shall write, paint, or print, or mould, cast, or carve, or engrave or stamp, upon any thing made, used, or sold by him, for the sole making or selling of which he hath not or shall not have obtained letters patent, the name or any imitation of the name of any other person, who hath or shall have obtained letters patent for the sole making and vending of such thing without leave in writing of such patentee or his assigns:—or if any person shall upon such thing, not having been purchased from the patentee, or some person who purchased it from or under such patentee, or not having had the licence or consent in writing of such patentee or his assigns, write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word 'patent,' the words 'letters patent,' or the words 'by the King's patent,' or any words of the like kind, meaning, or import, with a view of imitating or counterfeiting the stamp mark or other device of the patentee; or shall in any other manner imitate or counterfeit the stamp, or mark, or other device of the patentee; he shall for every such offence be liable to a penalty of 50*l.*, to be recovered by action of debt, bill, plaint, process, or information, in any of his Majesty's Courts of Record at Westminster, or in Ireland, or in the Court of Sessions in Scotland,—one half to his Majesty, his heirs and successors, and the other to any person who shall sue for the same: Provided always, that nothing herein contained shall be construed to extend to subject any person to any penalty in respect of stamping, or in any way marking, the word 'patent' upon any thing made, for the sole making or vending of which a patent before obtained shall have expired."

5 & 6 Will. IV. c. 83, s. 7.

If any person shall write, paint, &c. upon any thing made, used, or sold by him, the name, or any imitation of the name of a patentee;

or shall upon any such thing, write, paint, &c. the words 'patent,' 'letters patent,' &c., for the purpose of counterfeiting a patentee's stamp, mark, &c.

or in any other way counterfeit the stamp, &c. of a patentee; the offender shall be liable to a penalty of 5*l.*, to be recovered by action of debt; one half for the king, the other half for the informer.

Before the passing of this statute, the only remedy which a patentee had against any person for imitating his name or device was, by a bill in Chancery for an injunction, or an action at Law for the damages which he might have sustained (c).

Remedies before the statute.

There are two offences mentioned in this section of the statute:—*firstly*, The counterfeiting or imitating the name of any patentee; and, *secondly*, The counterfeiting or imitating of any stamp, mark, or device of a patentee.

Two offences mentioned in the statute.

(c) Vide *post*, sec. 5, in this Chapter.

Offence of imitating or counterfeiting a patentee's name.

Must be committed upon something for which a patent has been obtained.

And upon something made, sold, or used by the offender for which he himself has not a patent.

Whether the Act applies to any thing done after the expiration of the patent.

Selling an article with a counterfeit name, no offence.

If a patentee on his own

Under the first clause of the section, the offence of imitating or counterfeiting a patentee's name may be committed in eight different ways; *viz.*—by writing, painting, printing, moulding, casting, carving, engraving, stamping the name, or any imitation of it, without the leave in writing of the patentee or his assigns. The offence must be committed upon something for the sole making and vending of which the patentee has obtained his letters patent; and it would seem, therefore, that the article or thing upon which such an offence is committed must be a thing the making or vending of which would be an infringement of the patent.

And the offence may be committed upon any such pirated article or thing which is *made, used, or sold* by the offender. But the penalty is only imposed with reference to something *made, used, or sold* by the offender, *for the sole making or selling of which he has not himself obtained letters patent.*

It may be doubted whether this protection given to a patentee against the use and imitation of his name, is intended only to apply to acts done during the continuance of his patent term; or whether it is also to apply to the use and imitation of a patentee's name, after the expiration of his privilege. The Act makes it an offence in any person to copy or imitate the name of "any other person, who hath or shall have obtained letters patent," &c.; and these words seem to be large enough to include the copying or imitating of the name of a patentee, whose patent has expired. But the preamble of the Act shows (*d*), that the objects of the legislature in altering the Law touching letters patent were "*as well for the better protecting of patentees in the rights intended to be secured by such letters patent, as for the more ample benefit of the public from the same;*" and it will most probably be held, that the intention was that the seventh section should only apply to acts done during the existence of a patent.

It will be observed that a person who may use or sell any article or thing having a patentee's name counterfeited or imitated upon it, will be guilty of no offence under this statute; if he did not himself counterfeit or imitate the name in the manner mentioned in section 7.

And according to the strict interpretation of the words

(*d*) See the Act in the Appendix, Chap. I. s. 1.

used in the Act, if a patentee were, upon articles made by himself, according to his own patent invention, to counterfeit or imitate the name of another patentee, he would be guilty of no offence within the meaning of this statute. For the words are, "if any person shall write, paint, &c., upon anything made, used, or sold by him, *for the sole making or selling of which he hath not, or shall not have obtained letters patent,*" &c. Therefore every thing made, used, or sold by a person according to his own patent invention, is excepted from the things upon which the offence of counterfeiting or imitating may be committed by writing, painting, &c., as mentioned in the Act. And if the thing upon which the writing, painting, &c., is done, has been made according to an invention comprised in a patent granted to the person himself who counterfeits another patentee's name by so writing, painting, &c., it follows that such writing, painting, &c., is not such a writing, painting, &c., as according to the strict meaning of the words of the statute is made any offence.

patent articles counterfeits the name of another patentee, *quare*, whether any offence?

And it may even be questionable whether the exception would not extend to things made by a person according to an invention comprised in an expired patent.

The *second* kind of offence within this section of the statute, is the counterfeiting or imitating any stamp, mark, or other device of a patentee.

Offence of counterfeiting stamp, &c.

It is necessary carefully to examine the words of the *second* clause of this section of the statute with reference to this offence. The clause commences, "or if any person shall upon *such thing,*" &c. and that of course means a thing made, used, or sold by the offender, and for which he himself has no patent, but which is comprised in a patent granted to another person.

Must be committed upon something for which the offender has no patent, but for which some other person has a patent.

It is also further provided, that the thing upon which the offence is committed must also be a thing which has not been "purchased from such patentee, or some person who purchased it from or under such patentee;" the words "such patentee," meaning "a patentee who hath or shall have obtained letters patent for the sole making or vending of such thing," as expressed in the first branch of the section; and it is no offence unless the act is done by a person "not having had the licence or consent in writing of such patentee." The of-

And upon something not purchased of the patentee.

Must be done with intent to counterfeit patentee's stamp, &c.

An offence to counterfeit any stamp, mark, &c.

Same difficulty in construing the second branch of the section as the first.

Whether counterfeiting a name or mark upon a wrapper is any offence.

Who may sue for penalties.

How to be recovered.

fence may be committed not only by writing, painting, printing, &c., as mentioned in the first clause of the section, but also by otherwise marking the word "patent," the words "letters patent," or the words "by the King's patent," or any words of the like kind, meaning or import. And the act must be done with a view of imitating or counterfeiting the *stamp mark*, or other device of the patentee.

A general provision is then added, which makes it equally an offence if a person (that is such a person as before described) shall, in any other manner, imitate or counterfeit the stamp, or mark, or other device of the patentee.

The same difficulties arise in construing the second clause of the section as in construing the first, and to which allusion has already been made. Thus it is uncertain whether it would be an offence under this statute, if a person were to imitate a patentee's stamp or mark after his patent had expired; or, whether, if a person upon any thing made, according to his own patent invention, were to imitate or counterfeit the stamp mark or device of another patentee, he would be guilty of an offence within the meaning of the second clause of the section. And the difficulty is not at all diminished by the proviso at the end of the section, by which it is declared, that nothing therein contained shall be construed to extend to subject any person to any penalty in respect of stamping, or in any way marking, the word "patent" upon anything for the sole making or vending of which a patent has expired.

And a question may arise upon the construction of either clause of the section; *viz.* whether, if a person imitates or counterfeits a patentee's name or mark upon a wrapper, or anything containing a pirated article, he will be guilty of an offence within the meaning of the statute.

The penalty of 50*l.* imposed on an offender for *every* offence he commits, may be recovered not only by the patentee himself, but by any person who shall sue; one-half for the use of her Majesty, the other half for the use of the plaintiff himself.

Penalties may be recovered by action of debt, bill, plaint, process, or information in any of her Majesty's Courts of Record at Westminster. The description in the Act does not, strictly speaking, apply to the Court of Queen's Bench, for

that Court is in contemplation of law held before the Queen herself, wheresoever she shall be in England; but the Courts of Common Pleas, and Exchequer of Pleas, are, in fact, located at Westminster. It seems that no penalty under this section could be recovered in a County Palatine Court, or in any inferior Court of Record.

The declaration in an action of debt for penalties under this Declaration. statute must show the grant of a patent to a patentee, against whom the offence has been committed, and the due enrolment of a specification—precisely as in an action for an infringement of the patent. It must also state that the defendant had not obtained any patent for the article upon which he committed the offence, and then, (in such of the words of the statute as are applicable to the case,) allege the committing of the offence for which a penalty has become payable.

It has not been decided whether a defendant can make a Defence. good defence to such an action on the ground of the patent Patent void. granted to the patentee being void. But a void patent may properly be considered as no patent at all, and could not have the effect of granting to the patentee the sole making or vending of the article upon which the alleged offence has been committed. It seems therefore that a defendant ought to be allowed to show as a defence that the patent was void and inoperative, for in that case the article upon which the imitating or counterfeiting has been committed would not be an article upon which an offence could be committed within the meaning of the statute.

By the statute 21 Ja. I. c. 4, s. 4 (e), the defendant in a final Plea. action is enabled to plead not guilty, or that he owes nothing, and to give the special matter in evidence; under that statute, therefore, the defendant is enabled to plead *nil debet* to an action of debt for penalties under the 5 & 6 Will. IV. c. 83, s. 7. But according to a general rule made by the Judges (f), he must in the margin of the plea write the words "By statute."

It seems also that if the defendant is entitled to set up the invalidity of the patentee's patent as a defence to the action,

(e) See this section of the statute in the Appendix, Chap. I. s. 1.

(f) Reg. Gen. T. T., 1 Vict. 1838; 8 A. & E. 279; 4 Bing. N. C. 816.

he may do so under the plea of *nil debet*, and need not give any notice of the objections which he intends to take to the patent, the fifth section of the statute being inapplicable.

Statute of
Limitations.

An action against a person for a penalty under this statute comes within the meaning of the stat. 31 Eliz. c. 5, s. 5 (g), and therefore must be commenced within one year after the fact committed, if the action is brought by the patentee or an informer, and within two years if the Crown sues for the penalty (h).

SECTION V.

Of other Remedies available for Patentees.

Patentees have
other remedies
in common
with other
persons.

PATENTEEs have no peculiar remedies except those already mentioned, but there are others which they (in common with other persons) may avail themselves of.

Deceitfully
selling articles
as of the manu-
facture of some
other person.

Thus, if a person deceitfully sells articles as of the manufacture of a patentee or of any other person, such an act is a fraud upon the patentee, or other person by whom the offender pretends that the articles were manufactured, and the law provides the person injured with a remedy against the offender.

Mode of
practising the
deceit imma-
terial.

It does not signify in what manner the offender compasses his purpose; whether by counterfeiting a name, word, mark or device, upon the spurious articles themselves, or upon the envelopes in which they may be wrapped, or by using any other means so as to deceive the public, and induce them to purchase goods as the goods of another, when they really are not so.

Remedies,
action at law,
and suit in
equity.

The remedies available against such offenders are, an action to recover damages for the loss or prejudice sustained by the person injured in consequence of the offender's fraudulent act; and a suit in Chancery for an injunction to restrain the offender from continuing the fraud.

Action for
damages sus-
tained by the
fraud.

The form of action for such an injury is trespass on the case, and the plaintiff is entitled to recover nominal damages upon proof of his cause of action, although he does not show

(g) See this section of the statute in the Appendix, Chap. I. s. 1.

(h) See a Form of Plea of the stat. 31 Eliz. c. 5, s. 5, in the Appendix.

that he has been deprived of any particular amount of profit by means of the defendant's fraud.

Thus, in the case of *Blofield v. Payne* (i), which was an action on the case against a person for wrapping hones in envelopes resembling those of the plaintiff, it was held by the Court of King's Bench, that although the plaintiff did not prove that he had sustained any actual damage by means of the deceit, and the jury found that the defendant's hones were not inferior to the plaintiff's, yet the plaintiff was entitled to recover nominal damages, for the defendant's act was a fraud against the defendant, and was to some extent an injury to the plaintiff.

Blofield v. Payne.

Plaintiff entitled to recover damages.

Nor does it signify that the spurious articles made or sold by an offender are of as good a quality as those of the person injured, for the purchasers of such spurious articles are induced to purchase by means of false representations or appearances which lead them to believe that the goods are the goods of the injured person, and the offender has no right to avail himself of the good name or reputation of another, or to deprive him of any portion of the profit which his manufacturing or commercial fame may enable him to acquire.

It does not signify that defendant's articles are as good as the plaintiff's.

And therefore in the case of *Blofield v. Payne* (k), it was held by the Court, that although the jury had found that the defendant's hones were not inferior to those of the plaintiff, the plaintiff was nevertheless entitled to recover damages against the defendant for the fraudulent imitation of the plaintiff's articles.

Blofield v. Payne.

And a person who manufactures goods deceitfully marked, so as to resemble the goods of another person, and for the purpose of being sold to the public by retailers as the goods of another person, is liable to such an action, although he does not himself actually make any misrepresentation respecting the manufacture of the goods.

If goods are deceitfully marked so as to resemble the goods of another, the maker is liable although he does not actually make any misrepresentation.

Thus, in the case of *Sykes v. Sykes* (l), it appeared that the plaintiff made and sold goods, which he was accustomed to mark with the words "Sykes' patent;" and that the defendant (being of the same name as the plaintiff) made and sold goods to retailers, which he also marked with the words "Sykes'

Sykes v. Sykes.

(i) 4 B. & Adol. 410.

(l) 3 B. & C. 541.

(k) *Ibid.*

patent." The declaration charged the defendant with deceitfully selling goods so marked, as and for goods of the manufacture of the plaintiff. The defendant did not himself represent the goods to be of the plaintiff's manufacture, but he sold them to retailers for the express purpose of being resold as goods of the plaintiff's manufacture. And upon a motion for a new trial, it was held by the Court of King's Bench, that the declaration was substantially proved, and a rule nisi for a new trial was refused (*m*).

Suit in Chancery to restrain the continuance of the fraud.

But although a patentee, or other person thus injured can maintain an action at Law against the offender, he can seldom prove the actual extent of the injury which he has sustained, so as to enable a jury to award him any recompence in the shape of damages. Nor can he in a Court of Law obtain any remedy for preventing the continuance of such fraudulent acts. There being, therefore, no adequate remedy at Law for a person thus injured, he is entitled to the extraordinary aid of a Court of Equity, and he may accordingly maintain a suit for an injunction to restrain the offender from committing any repetition of his fraudulent acts.

Ransome v. Bentall.

Thus, in the case of *Ransome v. Bentall* (*n*), the plaintiffs had obtained a patent for the manufacture of case-hardened ploughshares, which they were accustomed to mark with the words "Ransome's patent," and with the letters "H. H." to denote the shares being case-hardened, and also with certain numbers, as No. 6, to denote their size. The defendant had marked ploughshares, "Ransome's and Co. H. H. 6," and the plaintiff's bill prayed that the defendant might be restrained from selling ploughshares marked with any of those words, letters, or figures, or any words, letters, or figures, which purported to represent that they were made by the plaintiffs. The defendant admitted that he had used the words "Ransome and Co." under belief, as he stated, that the patent had expired; but he claimed the right of using the letters and figure "H. H. 6." The Vice-Chancellor, however, granted the injunction, and said, "The defendant is, in fact, asking me to sanction the commission of a fraud. If he had been in the habit of marking his ploughs with only "H. H. 6," and

Defendant restrained from using any words, &c. to represent that his goods were made by the plaintiffs.

(*m*) See the cases of *Southerne v. Bolton*, 3 Doug. 293.
Howe, 2 Rol. R. 26; *Singleton v.* (n) 3 Law J. N. S. 161.

if I could see the marks so placed, that no person could be deceived in purchasing the ploughs, then I might refuse the injunction as to that part of the prayer. But here the defendant wants me to decide, *ab ante*, that no possible use of "H. H. 6" may not have the effect of misleading persons; and, therefore, the whole prayer must be granted."

In the case of *Knott v. Morgan* (s), an injunction was obtained upon an *ex parte* application, restraining the defendant from running or using for the conveyance of passengers his omnibus in the bill mentioned with the names "London Conveyance," or "Original Conveyance Company," thereon or affixed thereto; and also from running or using for the conveyance of passengers any omnibus, &c., having the names "Conveyance Company," "London Conveyance Company," or any colourable imitation of such names thereon or affixed thereto. The bill was filed by four of the proprietors of the London Conveyance Company on behalf of themselves and the other proprietors, who were numerous. It was urged for the defendant, upon a motion to dissolve the injunction: first, that the plaintiffs were the only persons named in their licence, and that pursuant to the stat. 2 & 3 W. IV. c. 120, ss. 9 & 11, the licence ought to have contained the name of every proprietor; and, secondly, that the plaintiffs had no right to appropriate to themselves the title of "London Conveyance Company" or to claim a monopoly in the words "Conveyance Company," &c. Lord *Langdale*, M. R., however refused the motion with costs, and said in giving judgment, "The first question is, whether the plaintiffs are entitled to sue; and I think that, in the absence of any evidence to the contrary, I must presume that the Commissioners of Stamps, in whom the Act of Parliament has vested the power of licensing the proprietors of stage carriages, have granted to the plaintiffs a proper licence, and that the plaintiffs have consequently a right to sue. The only other question is, whether the defendant fraudulently imitated the title and insignia used by the plaintiffs for the purpose of injuring them in their trade; and, upon the affidavits and evidence before me, I have not the least doubt that the defendant did intend to induce the

*Knott v.
Morgan.*

Defendant restrained from using any words, &c. in imitation of those used by the plaintiffs.

(s) 2 Keen, 213.

public to believe that the omnibus which he painted and appointed, so as to resemble the carriages of the plaintiffs, was, in fact, an omnibus belonging to the plaintiffs and the other proprietors of the London Conveyance Company. It is not to be said that the plaintiffs have any exclusive right to the words 'Conveyance Company,' 'or 'London Conveyance Company,' or any other words; but they have a right to call upon this Court to restrain the defendant from fraudulently using precisely the same words and devices which they have taken for the purpose of distinguishing their property, and thereby depriving them of the fair profits of their business by attracting custom on the false representation, that carriages, really the defendant's, belong to, and are under the management of the plaintiffs. I am not satisfied that the injunction has been drawn up exactly in the words in which it ought to have been framed. Let the orders dated the 27th day of July last, be varied, therefore, so that the injunction may be awarded to restrain the defendant, Robert Morgan, his servants and agents, from running, or in any manner using, or causing to be used, for the conveyance of passengers, his omnibus in the bill mentioned, or any other omnibus, having painted, stamped, printed, or written thereon the words or names 'London Conveyance,' or 'Original Conveyance Company,' or any other names, words, or devices painted, stamped, printed, or written thereon, in such manner as to form, or be a colourable imitation of the names, words, and devices painted, stamped, printed, or written on the omnibuses of the plaintiffs; and let the defendant pay to the plaintiffs their costs of this application."

An appeal motion to discharge this order was afterwards heard before the Lord Chancellor, and discharged with costs.

SECTION VI.

Of the Remedies for the Crown and the Public, by scire facias, to repeal void or illegal Patents.

Patent rarely refused.

ALTHOUGH patents for inventions are not demandable as of right, yet they are in practice rarely refused, the reason being,

as stated in the Attorney-general's report, that the grant is entirely at the risk of the petitioner for the patent.

The Attorney-general, or officer who advises the Crown, must in every case in which the grant of a patent is not opposed, rely solely on the statements of the person petitioning for the patent, and no one can be present on behalf of the public to controvert any of the statements he may make in support of his claim for a patent (u). Even in opposed cases the party opposing can obtain no information respecting the nature of the invention for which a patent is sought, except what he may acquire from the title of the invention inserted in the petition, which we have seen is always couched in the most general and indefinite terms, and quite insufficient to enable any person to understand precisely what the invention really is. And an opposing party is not allowed to be present to hear the statements of a petitioner in support of his claims for a patent, because the opposing party would thus acquire a knowledge of the invention, and would be enabled to defeat the inventor's claim to a patent; for he might publish it to the world, before the inventor could obtain his patent, and so render the patent absolutely void.

Attorney-general relies solely on petitioner's statement.

Party opposing can obtain no information except the title.

No person allowed to hear the statements of petitioner.

Patents for inventions must always, therefore, be obtained by means of proceedings substantially *ex parte*, and in the absence of any person competent to guard the rights of the public, so far as respects the truth of the representations upon which the patents are obtained.

Proceeding to obtain a patent is *ex parte*.

Crown grants are indeed almost always obtained by means of representations made by, or on the behalf of the grantees, and as the sovereign is so much occupied with the affairs of the state, it would be impossible always to ascertain with certainty whether the representations of a petition for a grant by patent were true or not. The law, therefore, takes especial care to protect the Crown against false petitions and representations (v). It is accordingly laid down that it is the duty of every one obtaining a grant from the Queen, to see that she is correctly informed respecting the grant (x). And if it appears that the Queen has been deceived in any material particular, by a false representation or suggestion of the

Crown grants always obtained by petition.

Crown specially protected against false petitions.

If Crown deceived, patent void.

(u) A patent is granted, as of course, if not opposed.

(v) See 10 Co. R. 113, b.
(x) 1 Co. R. 52, a.

granted, the patent will be wholly void (*y*). And when facts are recited in a patent respecting the subject-matter of the grant, it will be presumed that the statements contained in the recital were represented or suggested to the Queen by the patentee (*z*).

Particulars respecting the invention stated in petition and recited in the patent.

The material particulars respecting an alleged invention for which a party seeks to obtain a patent, must, as has already been observed (*a*), be stated in the petition for the patent. The petition must therefore state, that the petitioner is the inventor or importer of the invention, and that the invention possesses the qualities of novelty, utility, &c., so as to be the proper subject of a grant by patent (*b*). The substance of the petition for a patent is always recited in the patent itself, and therefore the patent itself shows upon what representations of the patentee it has been granted (*c*); and if the patentee has represented any thing which was untrue in any material particular, or has induced the Crown to make an illegal grant, the patent is entirely void.

Remedy for the public by *scire facias*.

The various objections which can be taken to a patent for an invention, by a person against whom the patentee may institute legal proceedings, have already been considered (*d*); and the law provides a remedy for the public by action of *scire facias*, in which similar objections may be taken, and if any valid objection is sustained, the result is, that the patent is repealed or annulled, and ordered to be cancelled.

Queen may proceed by *scire facias* to cancel a patent.

The Queen has by the Common Law an undoubted right to proceed by *scire facias* to repeal and cancel a patent respecting which she has been deceived, or by which her subjects are prejudiced. This was laid down by the Judges in the House of Lords in the case of *The King v. Butler* (*e*), and there are several old authorities to the same effect (*f*). In the *Magdalen College* case (*g*), it was said, that "The law has given the King a great prerogative above any of his subjects, that

R. v. Butler.

Magdalen College case.

(*y*) Vin. Abr. Prerog. (O. b.); and vide Chap. IV. *ante*, p. 39, 42.

(*z*) 5 Co. R. 55, b.; 10 Co. R. 112, a.; and vide Chap. IV. *ante*, p. 42.

(*a*) *Ante*, Chap. IV. p. 41.

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

(*c*) Vide *ante*, Chap. IV. p. 41.

(*d*) Section 2 in this Chapter, *ante*, p. 266.

(*e*) 3 Lev. 220, 221.

(*f*) See Staund. Prerog. 84, a.; Brook, Abr. Pat. 14, Petit. 11, and Sci. Fa; Rol. Abr. Prerog. (S.) p. 191; 21 Ed. III. 47 B. & 10 Co. 113, b.

(*g*) 11 Co. R. 74, b.

where by fraud or false suggestion he is deceived, that he himself in such cases shall avoid his own grant *jure regio*." And in *Legat's case* (h), it was said, that "When upon false insinuations or pretences the King makes any grant, as of any monopoly, &c., which, in truth, is to the prejudice of the King and commonwealth, the King *jure regio* shall avoid such grants, and such letters patent by judgment of law shall be cancelled."

The proceeding for avoiding and cancelling a patent by *scire facias* is taken in the Common Law side of the Court of Chancery, being the Court in which the patent was made. *Scire facias* is in Chancery.

It has already been shown (i), that a patent is a record made by the Lord Chancellor, as Judge of the Court of Chancery; and that an enrolment of every patent remains of record in that Court, although the patent itself is always delivered out of Chancery to the grantees. Patent is a record.

In the fourth Institute (k), Sir *Edward Coke* says, that in Chancery there are two Courts:—"one ordinary, *coram domino rege in Cancellaria*, wherein the Lord Chancellor or Lord Keeper of the Great Seal proceeds according to the right line of the Laws and Statutes of the Realm, *secundum legum et consuetudinem Angliæ*; another extraordinary, according to the rule of Equity, *secundum æquum et bonum*." And that of the former, or Common Law Court, the Lord Chancellor or Lord Keeper is the sole Judge; but in cases of difficulty he may call to his assistance any of the Judges of the Common Law Courts (l). Lord Chancellor judge of the Common Law Court.

It seems, however, that in all matters of practice the Master of the Rolls, as chief officer of the Court (m), may act in the absence of the Lord Chancellor; and it has been the constant practice for the Master of the Rolls to attend to such matters, and to transact all such business of the Court as may be done by a Judge at Chambers. Master of the Rolls decides matters of practice.

In this Common Law Court the Lord Chancellor has power to hold plea of *scire facias* to repeal letters patent under the Great Seal, and to cancel the patent, and also the enrolment. Chancellor has power to hold plea of *scire facias* to cancel patents.

(h) 10 Co. R. 113, b.

(i) *Ante*, Chap. IV. p. 36.

(k) P. 79.

(l) 4 Inst. 84; and see *Ross v. Pope*, Plow. 72.

(m) See 4 Inst. 82-97; the Master of the Rolls is also keeper of the records of the Court, see Chap. VIII. s. 3, p. 211.

of it (n); and Sir *Edward Coke* says (o), "Our Lord Chancellor of England is called *Cancellarius a Cancellando*, i. d. *digniori parte*, being the highest point of his jurisdiction to cancel the King's letter patents under the Great Seal, and damning the enrolment thereof by drawing strikes through it like a 'lettico.' "

Jurisdiction to cancel patents is necessarily incident to Chancery.

Mayor, &c. of Liverpool v. Chancellor of Lancaster.

It seems that this jurisdiction, which the Court of Chancery possesses, is necessarily incident to the office of Chancellor, or to the Great Seal which he holds.

Thus, in the case of *The Mayor and Burgesses of Liverpool v. the Chancellor of the County Palatine of Lancaster* (p), in the Queen's Bench, it appeared that there was a *scire facias* (in the Chancery of Lancaster) to repeal a charter granted to that Corporation, under the Great Seal of the County Palatine. To this suit a prohibition was moved for, for want of jurisdiction in the Court. But it was resolved that that Court had jurisdiction of the cause, and amongst other reasons which were given for that judgment, it was declared that this authority was incident to the Seal of the County Palatine; that the complaint of the writ being that the Chancellor had wrongfully put the Seal to it, it was proper to be examined in that Court where the Seal was kept.

Jurisdiction flows from the Great Seal.

The object of the suit is to have the patent restored into Chancery to be cancelled.

And it is evident that this jurisdiction of the Lord Chancellor's flows from the Great Seal, for the very object of the suit and of the judgment is, that the letters patent be recalled back into the same place from whence they went forth under the Great Seal, that they may be cancelled; that is, that the Great Seal may be taken off (q). This indeed is shown by the form of the writ itself, which commands the sheriff to give notice to the patentee to appear in Chancery, and show why the letters patent and enrolment should not be cancelled, *and the letters patent restored into Chancery, there to be cancelled* (r). And the prayer of judgment by the Attorney-general at the end of the declaration is to the same effect (s).

Great Seal of Great Britain.

After the Act of Union with Scotland (t), the Great Seal became the Great Seal of Great Britain, but that did not

(n) 4 Inst. 79-88.

(o) 4 Inst. 88.

(p) 1 Str. 151.

(q) Vide 1 Str. 151-158.

(r) Lilly, Entr. 419.

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

(t) 5 Ann. c. 8, Art. 24.

alter the jurisdiction of the Court of Chancery respecting patents for inventions (u).

So after the Union with Ireland, the Great Seal of Great Britain was destroyed, and the Great Seal which has since been used, is the Great Seal of the United Kingdom (x). But the jurisdiction of the Court of Chancery respecting patents for inventions is still confined to England, Wales, and the colonies.

Great Seal of the United Kingdom.

In the fourth Institute (y), Sir *Edward Coke* says, that a *scire facias* to repeal a patent may be brought in the Queen's Bench, and he cites a case in the Year Books, 3 Hen. IV. fol. 6 (z), pl. 29. In that case it appears that a *scire facias* was sued in the King's Bench by one J. Knightly against one L. to repeal a patent, granted by the King to L. who alleged that Knightly had in Chancery sued out another *scire facias* to repeal the same patent which was then pending, and demanded judgment of the writ. But the only point upon which judgment was given, was that the plaintiff might have as many writs of *scire facias* as he pleased, and the reason seems to have been, that the effect of all the writs could only be to repeal the patent. The same case is also stated in Brook's Abridgment (tit. *Briefe*, pl. 104), to the same effect as here given, but with a "*quod quære*," added to it.

4 Inst. c. 7.

Whether a *scire facias* may be brought in the Queen's Bench, *quære?*

In the Year Book, 21 Ed. III. fol. 47, pl. 68, there is an authority, however, to the effect that a *scire facias* to repeal a patent *can only be in Chancery*, and this case is stated as law by Brook in his Abridgment (a).

21 Ed. III. f. 47.

Scire facias can only be in Chancery.

It seems to be clear indeed that such a *scire facias* could not issue out of the Court of Queen's Bench, for the writ must be founded upon some matter of record, and that Court has no enrolment of the patent or other record upon which the writ could be founded. Thus, in Jenkins's Reports (b), it is laid down that the King's Bench cannot award a *scire facias* against a patentee, for that Court has not the record.

Scire facias cannot issue out of Queen's Bench.

In the case of *The King v. Butler* (c), upon a demurrer to a *scire facias* to repeal a patent, the Lord Chancellor gave judgment for the Crown to repeal the patent, and a writ of

R. v. Butler.

Scire facias founded on a record in Chancery.

(u) *R. v. Hare*, 1 Str. 146-158.

(x) See the cases of *R. v. Bullock*, 1 Taunt. 71; and *R. v. Yandall*, 4 T. R. 521.

(y) P. 72.

(z) Misprinted, fol. 7.

(a) Title, Petit. pl. 11.

(b) P. 134—3rd Century, case 74.

(c) 3 Lev. 220-223.

error was brought in the House of Lords to reverse the judgment. In answer to an objection taken to the writ, it was conceded that a *scire facias* ought to be founded on a record; but it was resolved by the Judges, that the writ in that case was founded on a record, for the patent was enrolled in the Court of Chancery.

The record is the enrolment of the patent.

It has already been stated (*d*), that every patent is enrolled in the Court of Chancery, and the enrolment is the record upon which the writ of *scire facias* issues. This is shown indeed by the form of the writ itself, which, after stating the patent, always concludes with these or similar words, "As by the said letters patent enrolled before us in Chancery is more fully manifest and appears" (*e*).

Scire facias may, in some cases, be made returnable in the Queen's Bench.

Although a *scire facias* must therefore issue out of Chancery, yet it seems that it may in some cases be made returnable in the Queen's Bench.

Thus, in the case in Jenkins just cited (*f*), it appears that an office found for the King for certain land was traversed in Chancery, the land being first granted over by the King by patent; issue was joined in Chancery, and that issue sent into the Queen's Bench to be tried. And it was resolved, that, notwithstanding the transcript of the record had been sent into the Queen's Bench, a *scire facias* might be awarded out of Chancery returnable in the King's Bench.

Such a *scire facias* only ancillary to another suit.

In this case it will be observed, that the *scire facias* was necessary to warn the patentee, and to enable the King's Bench to determine the right to the land; it became necessary incidentally to determine a question respecting the validity of the patent, but the writ was merely ancillary to another suit, and the object of it could not be to *cancel* the patent, although the effect of the suit might be to declare the patent to be void.

Brewster v. Weld.

Court of Queen's Bench doubted whether a *scire facias* to repeal a patent could be returnable in that Court.

In the case of *Brewster v. Weld* (*g*), a *scire facias* was sued out of Chancery, returnable in the Queen's Bench, to repeal letters patent of the Rectory of Aldgate; but it seems, from the report of the case, that the Court of Queen's Bench doubted whether the writ being founded upon a record of the Court of Chancery was returnable in the Queen's Bench, but

(*d*) *Ante*, Chap. IV. p. 38.
 (*e*) Lilly, Entr. 411-415; and see the Form in the Appendix, Chap. II. s. 7.

(*f*) P. 134, pl. 74.
 (*g*) 6 Mod. 229.

the point was not decided. That Court, however, compelled the Sheriff to return the writ, although it was alleged that the Court of Chancery had superseded it, and the writ was returned accordingly.

It is not stated upon what ground the plaintiff sued out the *scire facias*, but it is to be inferred that it was because the patent was to his prejudice in some way; for it is stated, that "it was resolved that if letters patent be to the prejudice of another, he may have a *scire facias* upon the enrolment thereof in Chancery to have them repealed as well as the Queen may" (h).

It will be found, however, upon a careful consideration of all the reported cases of *scire facias*, that although the Court of Queen's Bench may hold plea in some cases where the validity of letters patent come in question; yet, where an action of *scire facias* is brought, not only to repeal the grant, but also to cancel the patent and the enrolment of it, (and this is always so in a *scire facias* to repeal a patent for the sole use of an invention,) then the action must be in Chancery, for the Court of Queen's Bench has no power to cancel the records of the Court of Chancery.

Scire facias to cancel a patent must be in Chancery.

Queen's Bench no power to cancel Chancery records.

The office called "the Petty Bag" is the office of the Court of Chancery, in which all the Common Law proceedings of the Court are carried on; and all pleadings and other Common Law proceedings are intituled "In the Petty Bag Office in Chancery." The legal proceedings of this Court, as stated by Sir Edward Coke (i), "remain in *filaciis*, being filed up in the office of the Petty Bag." And it appears from the same authority (h), that "the process in this Court is under the Great Seal, according to the course of the Common Law."

Chancery Common Law actions are in Petty Bag office.

The principal officer of this branch of the Court is the Master of the Rolls, under whom are the Clerks of the Petty Bag, who have the exclusive privilege of acting as the attorneys of the suitors of the Court.

Master of the Rolls principal officer.

The business was formerly carried on by the Clerks of the Petty Bag, in the names of the Six Clerks, but they are now enabled to conduct the proceedings in their own names.

Clerks of Petty Bag the only attorneys.

(h) There does not appear to have been any further proceedings taken in this case, at least no further report of

it appears in any of our books of reports.

(i) 4 Inst. 80.

(k) *Ibid.* 82.

Stat. 5 & 6
Vict. c. 103, s. 1.
Clerks of Petty
Bag to be
nominal attor-
nies.

By the statute 5 & 6 Vict. c. 103, s. 1, the offices of the Six Clerks were abolished; but it is by section 3, of the same Act, provided that the clerks in the Petty Bag shall be nominal attornies in all causes in the Petty Bag in which Six Clerks might have been such attornies if that Act had not passed; and that the entry of any clerk of the Petty Bag of rules in causes in the Petty Bag, shall have all the effect such entry could have had if that Act had not passed, and a similar entry had been made by a Six Clerk.

Scire facias
issues out of
Petty Bag
office.

It is out of this office that the writ of *scire facias* issues, and in this office all the proceedings in the action must be taken, until the record is carried into the Court of Queen's Bench, for the purpose of a trial, and that is only done when there are issues in fact to be tried by a jury.

Scire facias
lies in three
cases.

It is laid down in the fourth Institute (*l*), that a *scire facias* lies to repeal letters patent in three cases:—“*firstly*, When the King by his letters patent doth grant by several letters patent one and the self-same thing to several persons, the former patentee shall have a *scire facias* to repeal second patent; *secondly*, When the King granteth any thing that is grantable upon a false suggestion, the King by his prerogative *jure regio* may have a *scire facias* to repeal his own grant; *thirdly*, When the King doth grant any thing which by law he cannot grant, he *jure regio* (for the advancement of justice and right) may have a *scire facias* to repeal his own letters patents.”

Scire facias is
a remedy both
for the Crown
and the public.

The action of *scire facias* is a remedy provided by the law not only for the Crown on behalf of the public, but also for any of her Majesty's subjects who can show that a void or illegal patent operates to his prejudice.

Butler's Case.

The Queen is of
right to permit
a subject to sue
by *scire facias*.

Thus, in *Sir Oliver Butler's* case (*m*), Lord Chancellor *Finch* (who was assisted by two of the Judges) said, that “Where a patent is granted to the prejudice of the subject, the King of right is to permit him, upon his petition, to use his name for the repeal of it, in a *scire facias* at the King's suit, and to hinder multiplicity of actions upon the case, for such action will lie notwithstanding such void patent” (*n*). So, in

(*l*) 4 Inst. 88.

(*m*) 2 Ventr. 344.

(*n*) That means that the patentee may proceed by action upon the patent,

and put the defendant to the cost and vexation of having to plead and prove the invalidity of it.

the Court of Queen's Bench, in the case of *The Queen v. Acres* (o), it was also said, that the Crown *de jure* ought to permit subjects in such cases to sue in the name of the Queen (p).

A void or illegal patent for an invention is actually in law prejudicial to every one of her Majesty's subjects, for it commands them to abstain from the use of the art or invention comprised in it; and indeed, as we have already shown (q), a patent for an invention deprives every person (except the patentee) of the right or liberty which he had before of inventing and using the particular art which is made the subject of the patent grant. For this reason every person is presumed to have such an interest in a patent for an invention, that if he alleges that it is illegal or void, he is entitled as of right to a *scire facias* in the name of the Queen in order to repeal it.

Illegal patent prejudicial to every one.

The action is commenced by a writ called a *scire facias*, from two Latin words used in the writ in former times, when our legal proceedings were written in that language; and the action derives its name from the same source. The writ is an original writ (r), founded upon the record or enrolment of the patent, and matters suggested to the Court as a ground for repealing the patent (s).

Action commenced by an original writ of *scire facias*.

It was formerly the practice to present a petition to the Crown, praying for leave to sue out a *scire facias* to repeal a patent containing a grant of land, or of a market, or any similar grant; but that practice never prevailed with respect to actions of *scire facias* to repeal patents for inventions (t).

No petition for writ necessary.

In order to sue out a *scire facias*, the prosecutor's solicitor must prepare a short statement of facts containing the date of the patent, the title of the invention, the prosecutor's name and address, and mentioning whether the validity of the patent has been tried, and the result of any proceedings which may have been taken. This statement must be delivered to the clerk of the Petty Bag (u).

Statement of facts must be furnished.

(o) 10 Mod. 354.

(p) See also 1 P. Williams, 217; Vin. Abr. Prerog. (M. b, 9) pl. 10, (U. b) pl. 8, and the authorities there cited.

(q) *Ante*, Chap. II. pp. 11 and 12.

(r) 1 Str. 43.

(s) Bro. Ab. Sci. Fa. pl. 8.

(t) The late Mr. Abbott (who was upwards of fifty years in the Petty

Bag Office, and during forty-eight years acted as the officer of the Court,) informed the writer that he had never known any petition presented in a *scire facias* to repeal a patent, and that according to the practice of the Court no petition was necessary.

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

Copy enrolment of patent must be procured.

The prosecutor's solicitor ought also to procure a copy of the enrolment of the patent, to repeal which the *scire facias* is to be brought, to enable the clerk of the Petty Bag to set it out correctly in the writ; and it is always best to procure an office copy of the enrolment.

Duty of clerk to draw the writ.

It is the duty of the clerk of the Petty Bag, who acts for the prosecution, to draw and prepare the writ of *scire facias*, for which he is entitled to be paid as the prosecutor's attorney in the action (x).

Generally drawn by counsel.

It very frequently happens, however, that nice and difficult questions are intended to be raised by the suggestions in the writ, and therefore it has become a common practice for the prosecutor's solicitor to get a draught of the intended writ drawn or settled by counsel, and take it to the Petty Bag Office as instructions for the writ. If that course is not adopted, the prosecutor's solicitor must prepare a statement in writing of the several grounds upon which he seeks to repeal the patent, and deliver the statement to the clerk of the Petty Bag, as his instructions for the preparation of the writ.

Draught writ and statement submitted to Attorney-general.

When the draught writ has been prepared, a fair copy of it is laid before the Attorney-general, by the clerk of the Petty Bag, together with the statement of facts already mentioned, in order to obtain his *fiat*, which is necessary to authorize the issuing of the writ. The *fiat* is indorsed upon the back of the copy of the writ, and is always obtained as a matter of course. This *fiat* gives the requisite permission for the prosecutor to sue in the name of the Queen to revoke and cancel the patent, but it is only granted upon condition that the prosecutor gives security by bond to the chief clerk of the Petty Bag.

Fiat.

Bond.

Reason for requiring security.

The reason for requiring this security is, that patentees may not be vexatiously harassed by actions of *scire facias*, in which they could not recover costs against the prosecutor, and the condition of the bond is, that if the defendant obtains a verdict and judgment in the action, the prosecutor shall pay him the amount of his costs taxed as between attorney and client.

(x) The whole of the business of the office is however transacted by a gentleman (Mr. Abbott), who acts as the deputy of each of the three clerks. The business is however nominally distributed amongst the clerks of the Petty

Bag, according to an old rule of practice; and the clerks divide amongst them the profits which arise from their *nominally* acting as attorneys for parties in the Court, according to the same rule.

This security was first required to be given by Sir *Archibald Macdonald* (y), when he was Attorney-general about the year 1790, the amount of the bond then required being 500*l.* But since the year 1836, when Sir *John* (now Lord) *Campbell* was Attorney-general, the amount has been 1000*l.* in ordinary cases. The amount of the bond in other cases is entirely discretionary in the Attorney-general, who will, in extraordinary cases, order security to be given to a sufficient amount to cover the probable extent of defendant's costs in defending the action.

When security first required.

The bond is prepared by the clerk of the Petty Bag, and must be entered into by the prosecutor with two sufficient sureties according to the amount required (z).

Two sureties required.

The clerk of the Petty Bag will furnish the prosecutor's solicitor with a copy of the intended bond for perusal, in order that he may introduce the names of the prosecutor's sureties; which being done, the copy must be returned into the office of the Petty Bag to have the bond engrossed.

The prosecutor's solicitor is required to certify that the proposed sureties are sufficient for the amount of the intended bond. The object of this is, that the solicitor may be rendered responsible for the sufficiency of the sureties which he proposes, and there can be no doubt that *knowingly* misrepresenting the sufficiency of sureties would be deemed a contempt of the Court.

Prosecutor's solicitor must certify that sureties are sufficient.

In town cases the bond is required to be executed in the presence of one of the clerks at the office of the Petty Bag, for which purpose the prosecutor and his sureties usually attend at the office. But one of the clerks will be sent to witness the execution of the bond by any person in London who cannot conveniently attend at the office, for which a small fee is payable. The execution of the bond in country cases, or in town cases by any party who resides in the country, must be attested by a Master extraordinary in Chancery.

Bond to be executed at Petty Bag Office, or before a Master extraordinary.

The person to be made defendant in an action of *scire facias*, to cancel a patent, ought to be he who is entitled to the privilege granted by the patent, and therefore is interested in

Who ought to be made defendant.

(y) Afterwards Lord Chief Baron. Appendix, Chap. II. s. 7.
 (z) See the Form of Bond in the

the continuation or destruction of it; and who having the custody of the patent itself, may be compelled to restore it into Chancery to be cancelled, if the Court gives judgment for the Crown.

Patentee.

The patentee must be made defendant in the action, if he has not parted with the whole of his interest in the patent by assignment, bankruptcy, or otherwise. If the patentee has assigned a part of his patent right, the assignee ought to be made defendant jointly with the patentee.

When patent has been assigned.

When the patentee has assigned the whole of his patent privilege, the assignee should be made defendant; but if the prosecutor does not possess certain knowledge respecting the assignment, it will be better to make the patentee and assignee joint defendants in the action, leaving the patentee to plead the assignment in abatement, or in bar of the further prosecution of the suit against him.

When patentee has died, become bankrupt, &c.

If a patentee or assignee, possessed of a patent privilege or of any part of it, dies, or becomes bankrupt, or insolvent, his executors, administrators, or assignees, must be made defendants, for his interest in the privilege would vest in them by operation of law (z). And if a *scire facias* were to be issued against a deceased patentee, it would seem that a judgment in such an action would be erroneous, for there would be no person who could be summoned, or who could answer the suggestions contained in the writ, and the parties actually entitled to the patent privilege might have a good defence to the action. So, it is conceived, that if a *scire facias* were to be sued out against a patentee *after* he has parted with the whole of his interest, a judgment in the action could not be allowed to prevail against the party actually entitled to the patent privilege.

First writ into Middlesex.

The first writ of *scire facias* is always directed to the sheriff of Middlesex, because the record upon which the writ is founded remains at Westminster, in that county.

Form of the writ.

The writ states the effect of the patent more or less fully, according to circumstances, and then refers to the enrolment of the patent in verification of the statement. The writ then proceeds to set out the suggestions upon which the prosecutor seeks to repeal the patent, commencing with the words—

Suggestion.

“Whereas we are given to understand that, &c.”

(z) Vide *ante*, Chap. IX. s. 2, p. 237.

And in the case of *The King v. Butler (a)*, in the House of Lords, it was resolved by the Judges, that an allegation in a *scire facias* commencing with these words was sufficient to put the defendant to answer the allegation.

The first suggestion in a *scire facias* is usually—"That our said grant was and is contrary to law, and was and is prejudicial and inconvenient to our subjects in general." But the suggestion is useless in this form, because too general.

And in the case of *The King v. Arwright (b)*, Mr. Justice Buller would not allow evidence to be given under an issue taken upon this suggestion.

The prosecutor is at liberty to introduce into the writ any suggestions which show that the patent was originally void, or that it has become void since it was made. The objections which may thus be suggested in a *scire facias* to repeal a patent are substantially the same as the objections which may be raised by pleas in an action for infringing the patent, and which have already been stated (c).

Suggestions which may be introduced.

The suggestions contained in the writ are followed by an allegation stating the effect of the various matters contained in the suggestions in these words—"By reason and means of which said several premises the said letters patent, so, as aforesaid, granted to the said *A. B.* are and ought to be void, and of no force or effect in law."

Allegation that patent void.

The writ then proceeds to recite, that the Queen being willing that what is just should be done, commands the sheriff to summon the defendant to appear in Chancery on a certain day to show if he has any thing to say why the patent and the enrolment of it should not for the reason stated in the writ be cancelled and vacated, and the letters patent restored into Chancery there to be cancelled.

Command to summon defendant.

This writ must be tested in the name of the sovereign on some day in term, and must be made returnable in term. There ought to be fifteen days at least between the teste and return of the writ.

Teste.

Return.

Although the public sittings of the Court of Chancery are always held within the city of Westminster, and almost all the offices of the Court are within that city; yet the Court is

Chancery being moveable, writ is returnable wheresoever it shall be.

(a) 3 Lev. R. 222.

(b) Dav. P. C. 79.

(c) *Ante*, sec. 2, p. 266, in this Chapter.

in fact a moveable Court, that is, a Court which may be hold any where in England. For this reason a *scire facias* and all other writs to be returned into Chancery, are, in point of form, made returnable in Chancery, wheresoever it shall be, on the return day.

R. v. Hare.

Scire facias
returnable
wheresoever
Chancery shall
be, is good.

In the case of *The King v. Hare (d)*, a *scire facias* was made returnable before the King in Chancery, on a day named, wheresoever it (the Chancery) should then be. The defendants pleaded in abatement to the writ, and objected that it ought to have been made returnable wheresoever the Chancery should then be in *England*. It was alleged that the Great Seal, after the union with Scotland, became the Great Seal of Great Britain; that the words wheresoever it shall then be, meant wheresoever the Chancery shall then be in Great Britain, and that if the Lord Chancellor should have the Great Seal in Scotland at the return of the writ, the Chancery would be then in Scotland, and that as no English subject would be compelled to appear to answer process at any place out of England, the writ was void. It was shown, however, that the form of the writ was warranted by the Register and numerous precedents, and the Lord Chancellor *Parher*, assisted by Sir *Joseph Jekyll*, Master of the Rolls, held that the writ was good.

But when the writ was made returnable wheresoever the Chancery should be in *Great Britain*, it was held that it was bad, and it was for that reason abated (e).

Seal.

The writ must be sealed with the Great Seal, for which purpose it will be taken by a clerk in the Petty Bag Office to the Great Seal. General Seal days in term time are every Tuesday, Thursday, and Saturday, and the first and last days of term; and in vacation, four days appointed for that purpose by the Lord Chancellor.

Fees.

The writ is usually sealed on one of these General Seal days, when the fee is sixpence only. But if expedition is necessary, a Special Seal may be obtained at any time, the cost of which will be 3*l.* 1*s.* This is generally called an opening Seal, on account of a fee being paid for opening the Seal

(d) 1 Str. 146.

(e) Vide the judgment of the Lord Chancellor in *R. v. Hare*, 1 Str. 158;

and *Sir C. Moore's case*, cited 1 Str. 153.

for the particular occasion. The writ may also be sealed at a private Seal, that is, the writ may be left at the Great Seal to be sealed before the next General Seal, if the Great Seal should happen to be opened for any other purpose. The cost of this last Seal is nine shillings.

When the writ has been sealed, and the proper bond given, the former will be delivered by the clerk of the Petty Bag to the prosecutor's solicitor, by whom it must be taken to the sheriff to be executed.

When the defendant does not reside in the county of Middlesex, it is only necessary to get the writ returned *nihil*, which the sheriff will do as of course upon application at his office. But if the writ is to be executed in Middlesex, the prosecutor's solicitor should deliver a copy of the writ to the sheriff, along with the original, and the sheriff will make out his warrant to two of his officers (*f*), who will summon the defendant. Return of *nihil*.
Execution of
the writ.

The defendant may be summoned anywhere within the county, (whether he resides or has a place of business within it or not,) by delivering to him a copy of the writ and summons. And if he resides or has a place of business in the county, he may be summoned by leaving the copy writ and summons at his dwelling-house or place of business, for personal service is not necessary. When the defendant has been summoned, the sheriff will return the writ accordingly (*g*). Defendant how
summoned.
Return of
scire feci.

Upon a return of *nihil* the prosecutor will be entitled to sue out a second *scire facias*, which may be either an *alias*, or a *testatum*, according to circumstances. If the defendant cannot be summoned in England, the second writ will be an *alias*, and like the first writ directed to the sheriff of Middlesex. Second writ,
alias, or *tes-*
tatum.

If the defendant can be summoned in any other county in England besides Middlesex, the second writ *may* be a *testatum*, directed to the sheriff of the county in which the defendant resides (*h*). Although it is the usual and proper course to sue out a *testatum* in such a case, it seems that the prosecutor is not bound to do so, but may have an *alias* into Middlesex,

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

Chap. II. s. 7.

(*g*) See the Form in the Appendix,

(*h*) See the Form of the Writ in the Appendix, Chap. II. s. 7.

even when the defendant is known to reside or could be summoned elsewhere in England.

Not necessary that defendant should be summoned.

It is not necessary that the defendant should be actually summoned upon either of the writs in order to enable the prosecutor to proceed, for if the defendant does not appear upon a second return of *nihil*, and within eight days after the entry of the usual rule to answer, judgment may be signed against him by default (i). But in order to enable the prosecutor to sign judgment by default, the first writ must be lodged in the sheriff's office, two days at least before the return day, and the second writ must lie four clear days in the sheriff's office, exclusive of the day of lodging it, the day of the return, and any intervening Sunday.

If the defendant in such a case could show that he had no notice of the proceedings, a judgment by default would most probably be set aside, and the defendant let in to plead and defend the action.

Notice to defendant if not summoned.

Therefore, if the defendant should not be summoned upon either of the writs, it would be prudent for the prosecutor to endeavour to give the defendant notice of the writ before he proceeds to sign judgment, and if the defendant were to neglect to enter an appearance and plead within a reasonable time after notice of the proceedings, the Court would not be inclined to render him any assistance.

Rule to return the writ.

If the sheriff should neglect to make a return to a writ of *scire facias*, he may be compelled by a rule of the Court to do so, and the rule may be had upon application at the office of the Petty Bag.

Rule to answer.

Upon the return of the sheriff to the first or second writ that the defendant has been summoned, or to the second writ *nihil*, the prosecutor may enter a rule for the defendant to answer the matters in the writ, for the writ is in the nature of a declaration (k), and if the rule be entered on any rule day except the last day of term the defendant must appear and answer within eight days, or in default the Crown will be entitled to judgment. The eight days are to be reckoned exclusive of the day of entering the rule, and exclusive of the last day, if it be a Sunday. If the rule is entered on the last

Defendant must appear and answer within eight days.

(i) *R. v. Eston, Dyer, 198, a.*

(k) *Vide Vaughan v. Floud, 1 Sid. 406.*

day of term, the defendant must appear and answer within the first four days of the following term.

In the Petty Bag rules can only be entered in term time, and only on certain days in the term, called rule days. According to the practice of the Court, the second day of the term, the same day in every subsequent week in the term, and the last day of the term, are the days for entering rules.

Rule days in the Petty Bag Office.

The effect of a judgment by default will be to avoid the patent (*l*). Thus, in the case of *The King v. Toly* (*m*), the defendant having been summoned, made default, and judgment was given, that the letters patent and enrolment should be vacated, and it was done accordingly.

Effect of judgment by default.

Judgment was signed in the same manner in the case of *The King v. Blage* (*n*), after the defendant had been returned as summoned and made default.

In order to appear, the defendant's solicitor must instruct the clerk of the office of the Petty Bag to enter an appearance for him, which he will accordingly do in the name of one of the clerks of the Petty Bag (*o*), (according to a rotation established by the practice of the Court,) and the clerk in whose name the appearance is entered will be the defendant's nominal attorney throughout the action, so far as relates to the proceedings in the Court of Chancery, and will accordingly be entitled to all the fees. Although the clerks of the Petty Bag are, amongst them, entitled to all the emoluments arising from their offices as the nominal attorneys of parties in actions there, they never personally interfere in the business of the office, the whole of which is transacted by a deputy (*p*) and his assistants.

Appearance.

The defendant ought to appear immediately after the return of the writ, for the rule to answer only allows him eight days both to appear and answer; and if the prosecutor is ready with his declaration, the defendant obtains no more time by delaying to enter his appearance. But by delaying to

Defendant ought to appear immediately after the return of the writ.

(*l*) H. T. 4 Hen. VI. 12, B.; Bro. pat. pl. 20; Sci. fa. pl. 131, 138.

(*m*) Dy. 197, b.

(*n*) *Ibid.*

(*o*) The present clerks are: John Benthall, Esq., Senior clerk; Thomas Hall Plumer, Esq., Second clerk; and Lancelot Baugh Allen, Esq., Junior

clerk.

(*p*) Mr. Abbott, a most efficient and obliging officer, who is thoroughly conversant with the practice of the Court; and to whom the author is under great obligations for much valuable information respecting the practice of the Court.

enter his appearance, the defendant may be prejudiced, for he cannot obtain an office copy of the declaration until he has appeared; and if he does not appear soon after the entry of the rule, he will not be able to obtain an office copy of the declaration until the time has nearly expired.

Declaration when necessary. A declaration only becomes necessary when the defendant appears to defend the action, and then it is to be prepared and filed by the clerk of the Petty Bag. The prosecutor is at liberty to declare immediately after the defendant has appeared; and it is always advisable to have the declaration and notice of objections ready to file immediately the appearance is entered, in order to prevent delay, for if the declaration is not filed on the same day that the defendant enters his appearance, the defendant will be entitled to eight days to plead after the filing of the declaration.

Declaration when to be filed. The declaration may be filed at any time after the entry of the rule to answer, and after the defendant has actually appeared; whether it be in the term in which the rule is entered, or in the following vacation. But a declaration cannot be filed in vacation, whether the defendant has appeared or not, unless a rule to answer has been entered—and that can only be done in term time. The new pleading rules of H. T. 4 Will. IV. 1834 (*q*), do not affect the practice of the Court in this respect, for they do not apply to actions at the suit of the Crown, nor, it seems, to actions pending in the Court of Chancery.

Title. The declaration must be intituled of the term in which it is filed, or if it be filed in vacation, then as of the preceding term.

Form of declaration. The declaration (*r*) sets out the writ of *scire facias* upon which the defendant has been summoned, or if the defendant has not been summoned, then the *alias* or *testatum* writ, the return of the sheriff, the appearance of the defendant; and then concludes with a prayer of judgment by the Attorney-general, that the patent and enrolment may be cancelled, vacated, and disallowed, and the patent restored into Chancery there to be cancelled.

No rule to plead necessary. No rule to plead becomes necessary upon filing the declaration, for the defendant answers upon the writ, and the rule to

(*q*) Chanc. N. R. 125.

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

answer is the only rule which is necessary for compelling the defendant to plead.

The prosecutor must also, in pursuance of the statute 5 & 6 Will. IV. c. 83, s. 5 (s), file with the declaration a notice of the objections on which he means to rely at the trial of the action. The notice (t) will be substantially the same as a notice given by a defendant in an action for the infringement of a patent, the form and requisites of which have already been considered (u). In order to do this, the prosecutor's solicitor procures a draught of the notice to be settled by counsel, and takes a copy of it to the Petty Bag Office, where a fair copy will be prepared by the officer, and filed with the declaration.

The Court of Chancery has the same jurisdiction over this notice as the other superior Courts have over notices of objections delivered in actions for infringements of patents pending before them. And if the notice filed by the prosecutor is insufficient, the Master of the Rolls will, upon the application of the defendant, order the prosecutor to amend his notice, or file a further and better notice.

An office copy of the declaration and notice of objections is made at the Petty Bag Office for the defendant's solicitor in order to enable him to prepare instructions for the pleas, and his client's defence to the action.

The defendant is, according to the practice of the Court, allowed eight days to plead after the entry of a rule to answer, which is entered on any rule day except the last day of the term, and if entered on the last day of the term, then he need not plead until the fourth day of the following term.

But although a rule calls upon the defendant to answer or plead within eight days, he cannot be compelled to plead within that time after entry of the rule, unless the declaration is filed on the same day that he enters his appearance. If the declaration is filed on any day subsequent to the day on which the defendant appears, he has eight days to plead after the filing of the declaration, within which time he must plead without any fresh rule being entered. If the rule orders

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

the Appendix, Chap. II. s. 7.

(u) *Ante*, s. 2, p. 284.

(t) See the Form of the Notice in

the defendant to answer within the first four days of the following term, he need not plead within that time unless the declaration has been filed at least eight days before the fourth day of the term. And if the declaration is not filed in due time, the defendant is allowed eight days to plead after the filing of it.

Judgment by default.

If the defendant fails to plead before the closing of the office on the last day of his time to plead, judgment may be signed against him by default on the opening of the office on the following morning.

Further time to plead.

The defendant may, if necessary, obtain further time to plead by application to the Master of the Rolls. The secretary of the Master of the Rolls will, for this purpose, grant the defendant's solicitor a summons calling upon the prosecutor or his solicitor to show cause why the defendant should not have further time to plead, and on the hearing of the summons, his Lordship will grant further time if he thinks it necessary, but not so as to delay the prosecutor in going to trial. And if the additional time required by the defendant will prevent the plaintiff from giving the usual notice of trial, the defendant will be laid under terms to accept of short notice of trial, or such notice of trial as the prosecutor can give.

In a case (*x*), in which the defendant had previously obtained an order for time to plead, Lord *Langdale*, Master of the Rolls, laid the defendant under terms to plead issuably. But in the first order for time, his Lordship refused to impose any terms. There is no certain rule, however, on the subject, and his Lordship will in every instance exercise his discretion according to the particular circumstances of the case.

M. R. no jurisdiction to strike out any of the suggestions.

The defendant must plead or demur to all the suggestions contained in the writ, and within the time allowed by the practice of the Court, or the order of the Master of the Rolls. And the Master of the Rolls has no jurisdiction to strike out any of the suggestions contained in the declaration (*y*), for the declaration would then vary from the writ, the tenor of which it purports to set out. Nor can the Master of the Rolls order a *nolle prosequi* to be entered as to any of the suggestions (*y*).

Attorney-general may

But the Attorney-general has power to control the pro-

(*x*) *R. v. Nickels*, MS.

(*y*) *R. v. Newall*, MS.

prosecutor's proceedings in the action, and he may at any time enter a *nolle prosequi* as to the whole or any part of the suggestions contained in the writ, subject of course to an application to the Lord Chancellor, who would have jurisdiction to order a *nolle prosequi* to be struck out in the same way as the other Courts of Law may set aside a plea of a release of a *chose in action* executed by a nominal plaintiff after he has assigned it over for a valuable consideration. If the prosecutor should insert any suggestion upon which the defendant could not take any material issue either in law or in fact, the Attorney General will direct a *nolle prosequi* as to so much of the writ.

And if the prosecutor should be desirous of getting rid of any of the suggestions in the writ, he may do so by *nolle prosequi*, at the time of declaring, or at any time afterwards (z).

If the defendant does not plead to the declaration in due time, judgment by *nil dicit* may be signed against him, and the patent will be repealed.

Thus, in the case of *Hunt v. Coffin* (a), judgment by *nil dicit* was given against the defendant by Cardinal *Wolsey*, Lord Chancellor, assisted by the Judges, that the patent should be revoked (b).

If the matters alleged in the writ are not sufficient to repeal the patent, the defendant may demur to the whole writ and declaration (c). But if only part of the suggestions are insufficient, the defendant must not demur to the whole writ, but to those suggestions only which are insufficient, and plead to the others (d). The demurrer alleges that the matters contained in the writ, or some particular suggestions, are insufficient in law to cause the patent to be cancelled or vacated, and the prosecutor may join in demurrer, alleging that the matters are good and sufficient to cause the patent to be cancelled and vacated (e).

The defendant may either plead in abatement (f), or in bar

(z) See the forms in the Appendix, Chap. II. s. 7.

(a) Dy. 197, b.

(b) See also 37 Hen. VI. 14 A.; Bro. Abr. tit. Sci. Fa. pl. 131-138.

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

(d) See the Form of Demurrer to a

Suggestion in the Appendix, Chap. II. s. 7.

(e) See the case of *R. v. Butler*, 3 Lev. 220, and the Forms in the Appendix, Chap. II. s. 7.

(f) See *R. v. Hare*, 1 Str. 146, in which the defendant pleaded in abatement.

Defendant may plead in

abatement or
in bar.

Patentee who
has assigned,
ought not to
be compelled
to answer.

Assignment
pleadable in
abatement or
in bar.

Reason why
patentee sued.

to the declaration (*g*). But if a *scire facias* has sufficient matter it will not abate for surplusage not material (*h*).

If a patentee has assigned the whole of his interest in the patent before the commencement of the action, there seems to be no reason why he should be compelled to answer the suggestions contained in the writ. For he has no interest in the privilege, and ought not, therefore, to be compelled to defend the grant made by the patent; nor will he be able to deliver up the patent to be cancelled if judgment be given against him.

The assignments of patents, however, are not registered either in Chancery or elsewhere, and therefore a prosecutor will presume, *prima facie*, (unless he has certain information to the contrary,) that the patentee continues to be possessed of the patent right, and issue the writ against him accordingly. But it seems to be reasonable that the patentee should in such a case be allowed to disclaim all interest in the patent, and to plead the assignment either in abatement or in bar of all further proceedings against him. There is no reported case in which such a plea has been decided to be good in a *scire facias* to repeal a patent; but there are authorities which in principle seem to warrant what has been stated (*i*). Thus, in a real action (*k*), the object of which was to recover land, the defendant might plead *non-tenure* generally in abatement (*l*). The defendant in such a plea alleged that he was not tenant of the land at the time of suing out the writ, and it was unnecessary for him to show who was tenant (*m*).

The proper form of plea for a patentee to adopt in such a case seems to be a plea alleging that the defendant by a deed made between himself and the assignee, before the commencement of the suit assigned the patent privilege to the assignee, and delivered to him the patent, and that he the defendant has ceased to have any interest in the patent privilege, or any control over the patent (*n*).

A *scire facias* to repeal and cancel a patent is sued out

(*g*) See Tidd's Practice (9th Edit.) c. xliii. p. 1095.

(*h*) 8 Co. R. 26, b.

(*i*) Vide Co. Ent. 624; Vin. Abr. Abat. (O).

(*k*) Real actions have been abolished.

(*l*) Lutw. 37, 851, b; Cro. Eliz. 559; Com. Dig. Abat. (F. 14.) 1. 3.

(*m*) Com. Dig. Abat. (F. 14.) 4.

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

against the patentee, because he is the person who is entitled to the privilege granted by the patent, and who has the custody of the patent itself as the evidence of his title. And (unless he has assigned his interest) he is therefore the person who is interested to defend the legality of the grant against the suggestions made in the writ; and he is the person who must be called upon to restore the patent into Chancery, if judgment should be given to cancel it.

But after an assignment, the assignee becomes the party interested to defend the patent privilege; and he obtains the custody of the patent, over which the patentee ceases to have any power or control, and in fact he becomes as it were an entire stranger. After assignment patentee has no interest.

If the action were to proceed against the patentee to trial and judgment, it seems that such a judgment ought not to prevail against the assignee, for he would be no party to it; and it might be carried on by collusion with the patentee, and he might have no notice of the proceeding. The assignee would most probably, in such a case, succeed in reversing or vacating such a judgment, either by writ of error or by *audita querela*. Judgment against patentee ought not to prevail against assignee.

It is difficult, however, to say whether such a plea must be pleaded in abatement of the writ, or whether the defendant might not plead it either in abatement, or in bar. Thus, it has been held, that in replevin for goods, the defendant may plead property in a stranger, either in abatement, or in bar of the action (o). The safest course, therefore, is to plead the plea in abatement, for after a judgment of *respondeas ouster*, the plea might be pleaded in bar. Whether plea would be in abatement or in bar.

Such a plea, if pleaded in abatement, would enable the prosecutor to proceed against the assignee, and therefore it would give him a better writ. And the patentee would for ever be estopped from alleging that he had any interest in the patent. Plea would give a better writ.

It may in some cases be very expedient for a patentee to plead the assignment of his patent to another; for if he has assigned his patent with a covenant respecting the validity of it, or the sufficiency of his title to it, it might be to his disadvantage to allow the prosecutor to obtain a judgment by de- Expediency of pleading an assignment.

(o) Com. Dig. tit. Abat. (B. 1.)

fault. And if he is not bound to defend the patent right, he will be desirous to avoid the costs of defending the action upon the merits (*p*). If the defendant pleads in abatement, it seems that the plea ought to be verified by affidavit, as required by the statute 4 Ann. c. 16, s. 11.

Defendant cannot plead double.

If the defendant pleads in bar to the action, he cannot plead double to any part of the writ, for the Crown not being named in sect. 4 of the statute 4 Ann. c. 16, is not bound by it.

Attorney-general v. Allgood.

Thus, in the case of *The Attorney General v. Allgood* (*q*), which was an information of intrusion, it was held by the Court of Exchequer, that the defendant was not entitled to plead several matters.

R. v. Archbishop of York.

In the case of *The King against the Archbishop of York* (*r*), in *quare impedit*, the Court of Common Pleas held, that the defendant was not enabled by the statute to plead two pleas (*s*).

How to proceed if defendant pleads double.

Dendy v. Chitty.

If the defendant were to plead several matters in distinct pleas to the declaration, it seems that the prosecutor might take the course adopted in *Dendy v. Chitty*, and *Luxford v. Chitty* (*t*). In each of these cases the defendant Chitty, in the County Court, pleaded two pleas, the general issue and set-off. The plaintiff replied to the first plea only in each case, paying no attention to the second plea, and upon a trial he had a verdict. The defendant afterwards brought a writ of false judgment in each case, and assigned for error the want of a replication to the plea of set-off, but the Court of Queen's Bench held that the plaintiffs in the Court below had a right to treat the second plea as surplusage, and the judgment was affirmed. In the case of *The Queen v. Nickels* (*u*), in *scire facias*, where the defendant pleaded several matters, the prosecutor obtained a summons calling upon the defendant to show cause why the pleas should not be set aside for irregularity, and Lord *Lungdale*, M. R., after consulting some of the Judges, made an order for setting aside the pleas for irregularity *with costs*.

R. v. Nickels.

Defendant ought to plead

(*p*) See further as to matters which may be pleaded in abatement, under the title Abatement, in Com. Dig.

(*q*) Parker, p. 1 and 15.

(*r*) Willes, 533; Barnes, 353, S. C.

(*s*) See also *R. v. Caldwell*, Forrest, 57; and *Glemham's case*, Poph. 144.

(*t*) 3 A. & E. 319.

(*u*) *R. v. Nickels*, MS.

in bar to the several suggestions contained in the writ, and it is the usual and better course to plead to each suggestion separately, and the pleas are generally mere traverses of the various suggestions (x).

separately to each suggestion.

If prosecutor does not set out the specification in the writ, it may be advisable for the defendant to set it out in his pleas, in which case it is generally best to do so in the plea to the suggestion that the patentee has not enrolled any sufficient specification.

Setting out specification in plea.

The defendant's pleas or demurrers are to be prepared and filed by the clerk of the Petty Bag, but it is usual to procure a draught of them to be drawn or settled by counsel, and deliver a copy to the officer of the Court as his instructions for the pleas.

Defendant's pleas prepared by clerk of Petty Bag.

Special pleas and demurrers require to be signed by counsel in the same way as in other actions.

Signature of counsel.

If any of the defendant's pleas are insufficient, the prosecutor may of course demur, and as the provisions of the statutes 27 Eliz. c. 5. and 4 Ann. c. 16, s. 1, respecting demurrers, do not apply to actions at the suit of her Majesty, it seems that a demurrer by the Crown need not be special, except perhaps for duplicity.

Demurrer to a plea.

It is seldom that any other replication than the common joinder becomes necessary in this action, for the pleas in general are simple traverses of the various suggestions in the writ.

Replication.

The prosecutor's demurrer or replication is to be prepared and filed by the clerk of the Petty Bag, in the same way as the declaration.

The issue (y) is also prepared by the prosecutor's nominal attorney or clerk of the Petty Bag, and delivered to the defendant's attorney or clerk.

Issue.

The clerk of the Petty Bag will also engross the record, and if there are issues to be tried by a jury, will make a transcript of it to be taken into the Queen's Bench, in order to have the issues tried there.

Record and transcript.

When there are any issues to be tried, except those which

Where a trial may be had.

(x) See the Forms of Pleas in the Appendix, Chap. II. s. 7.

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

must be tried by a jury, the trial may take place in the Court of Chancery (*y*). Thus, an issue in law raised by a demurrer may be decided by the Lord Chancellor, who is the sole Judge of this Court (*z*); and this having been done by Lord Chancellor *Finch* in *Sir Oliver Butler's* case (*a*), the judgment was afterwards affirmed in the House of Lords (*b*). So if an issue is to be tried by the certificate of the Bishop, as an issue *no unque accouple in loyal matrimonie*, the certificate may be made returnable in the Court of Chancery, and judgment given there (*c*). Or if an issue be taken upon the custom of London, which is to be tried by the mouth of the Recorder, judgment may be given thereon in the Court of Chancery (*d*). And if there be demurrer as to part and issue to the country as to the residue, the demurrer may be determined in Chancery before the record is delivered into the Queen's Bench (*e*).

It seems that the record may in some cases be delivered into the Queen's Bench, and judgment given on the demurrer there (*e*). But that of course only applies to cases in which the Court of Queen's Bench has jurisdiction, not to actions of *scire facias* in which it is sought to *cancel* as well as repeal letters patent, for the Queen's Bench has no authority to cancel any of the records of the Court of Chancery, much less letters patent under the Great Seal, which no Judge except the Lord Chancellor has any jurisdiction over (*f*).

Issue cannot be tried by a jury in Chancery.

An issue cannot be tried by a jury in Chancery, for that Court has no authority to call a jury to its bar (*g*). But when there is any issue joined in an action in that Court, which must be tried by a jury, the Court awards a *venire facias* to the sheriff returnable in the Queen's Bench (*h*), upon a day certain in term, and the same day is given to the parties, that is, to the Attorney-general, and the defendant, to be in the Queen's Bench (*i*). The record is then to be taken into

(*y*) *Blakeston's* case, W. Jon. 83.

(*z*) 4 Inst. 80.

(*a*) 2 Ventr. 344.

(*b*) 3 Lev. 220.

(*c*) *Blakeston's* case, W. Jon. 83; Latch, 3.

(*d*) W. Jon. 83.

(*e*) *Jefferson v. Dawson*, 1 Sid. 437; 1 Lev. 283, S. C.

(*f*) Vide *ante*, Chap. VIII. s. 3, p. 214.

(*g*) 4 Inst. 80; 2 Ro. R. 291; Br. Abr. Jurisdic. pl. 48; Latch, 3, *Blakeston's* case.

(*h*) Al. 14; 1 Ro. Abr. 372, 1, 31; Br. Abr. Jurisdic. pl. 48.

(*i*) See the Forms in the Appendix, Chap. II. s. 7.

the Queen's Bench in order that the issues may be there tried (*k*).

No writ of *mittimus* is necessary for this purpose, because both the Courts are in contemplation of law held in the same place (*l*), that is, before the Queen herself, wheresoever she shall be in England. The record is therefore taken, and delivered into the Queen's Bench by the Lord Chancellor as the sole Judge of his own Court, without any other than his own authority, and, as it is stated in the record, by his own proper hands (*m*). But although the record always states the delivery of the record to be by the proper hands of the Lord Chancellor, it is sufficient if it be done by the hand of any officer of the Court.

No *mittimus* necessary.

Thus, in the case of *The King v. the Warden of the Fleet* (*n*), after issue joined the record was carried into the Queen's Bench by the clerks of the Petty Bag without any order of the Court, in order to have the issue tried, and it was held that the record was well removed, for what is done by the hand of the proper officer of the Chancellor may be well enough said to be done by him *propria manu*. And the record is, according to the present practice, delivered by the clerk of the Petty Bag to the prosecutor's solicitor, who (being an officer of the court) carries it into the Queen's Bench.

R. v. Warden of the Fleet.

In an action of *scire facias* to repeal and cancel a patent, the record thus delivered into the Queen's Bench is merely a transcript, or the tenor of the Chancery record, the original record being retained in the Petty Bag Office (*o*).

Record sent into Queen's Bench is a transcript.

The record must be transmitted into the Queen's Bench to try the issues in fact (*p*), and cannot be sent to the Common Pleas, or to any other Court (*q*). And the *venire facias* which is issued out of Chancery must be made returnable in the Queen's Bench (*r*).

Record must be sent into Queen's Bench.

The *venire facias* must be directed to the sheriff of Middlesex, and returnable into the Court of Queen's Bench, M. 24 Ed. III. 73, pl. 9.

Venire facias directed to sheriff of Middlesex.

(*k*) See 4 Inst. 80.

(*l*) 10 Ed. III. 59, pl. 62.

(*m*) See also 4 Inst. 80.

(*n*) 1 Eq. Cas. Abr. 128.

(*o*) It is otherwise, however, in an action of *scire facias*, upon a recognizance in which the whole record, including the recognizance itself, is transmitted

into the Court of Queen's Bench, M. 24 Ed. III. 73, pl. 9.

(*p*) Bro. Abr. Sci. Fa. pl. 154.

(*q*) Latch, 3; Al. 14; W. Jon. 82; Jenk. 133, ca. 71.

(*r*) Jenk. 133, ca. 71; Brook. Abr. Jurisdic. pl. 48.

close, the record upon which the action is founded being in that county (s).

Does not state the issues.

The *venire facias* issued out of Chancery does not state the issues to be tried by the jury, but merely that the jury are to take cognizance upon their oaths in a plea of *scire facias* between the Queen and the defendant (t).

Stury and Stury.

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

Alias *venire* issues out of Queen's Bench.

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

Notice of trial.

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

Proceedings in the Queen's Bench.

If Queen's Bench has jurisdiction, action may be adjourned into Queen's Bench.

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

If action adjourned, the record and jurisdiction transferred to Queen's Bench.

In cases when the action can be adjourned into the Queen's Bench, the whole record is sent into that Court, together with the record, if any, upon which the action is founded. As in case of a *scire facias* upon a recognizance, not only the record

(s) Br. Abr. Sci. Fa. pl. 189.

77, b.; Jenk. 133, ca. 71.

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

(y) 1 Ro. Abr. Chan. (F) (G), 372.

(z) 2 Saund. 27.

(u) 2 Rol. Rep. 291.

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

(x) 13 Ed. IV. 8; Staund. Prerog.

in the action, but also the recognizance itself, is sent into the Queen's Bench (b).

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

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

In scire facias to cancel a patent, a transcript only of record sent into Queen's Bench.

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

Transcript of record, when to be sent into Queen's Bench.

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

Transcript to be taken to the Crown Office.

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

When to be taken.

The clerk of the Petty Bag will also prepare the writ of *venire facias juratores*, and deliver it to the prosecutor's

Venire facias.

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

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

Abr. 129.

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

solicitor with a transcript of the record. The writ must be taken to the office of the sheriff of Middlesex, by whom it is to be returned into the Crown office of the Court of Queen's Bench.

Not necessary to take office copies.

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

Queen's Bench record.

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

Attornies now entitled to practise on the Crown side of Queen's Bench.

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

Return of *venire facias*.

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

Alias venire.

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

The *alias venire* must be in the same form as that issued out of Chancery (g), with the exception of the additional words—"As before we have commanded you," and the teste of the

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

3rd Cent. p. 133, ca. 71.

(f) Staund. Prerog. 77, b. ; Jenkins,

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

writ, which must be in the name of the Chief Justice instead of the name of the Queen herself. This writ must be tested as of the day of the last continuance previous to the award of the *distringas juratores*, and must be made returnable on a day certain, or immediately, according to the form of the prior writ out of Chancery. This writ must be prepared by the prosecutor's attorney, and signed and sealed at the Crown Office (*h*), after which the sheriff's return must be procured in the usual way.

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

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

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

(*h*) By 8 & 9 Vict. c. 34, s. 2, all writs on the Crown side of the Court are, after the 1st of January, 1846, to be sealed at the Crown Office.

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

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

(*k*) F. N. B. 241, A; Fitz. Abr. Ni. Pri. pl. 16; Bro. Abr. Nisi Pri. pl. 35; Sav. 2; 2 Inst. 424; and see Vin. Ab. (P. b); 2 Ro. Abr. 629 l. 10; Staund. 156.

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

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

(*n*) *Astry's case*, 6 Mod. 123.

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

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

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

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

the every-day practice of the Crown Office to grant a *nisi prius* upon such a warrant.

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

Trial by *provisio*.

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

Distringas juratores.

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

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

Nisi prius record.

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

Continuances.

(s) 2 Hawk. c. 41, s. 10; *R. v. Banks*, 6 Mod. 245; 2 Salk. 652; 2 Ld. Ray. 1082; 11 Mod. 33, S. C.; *R. v. Dyde*, 7 T. R. 661; *R. v. Macleod*, 3 East, 202.

(t) See the rules made for the regulation of the practice of the Crown

Office, Cor. Pract. Apx.

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

(x) 8 & 9 Vict. c. 34, s. 2; see note (h), last page.

(y) See 1 Str. 267.

nominated and reduced, and the jury process actually returned, the continuance must be entered in the same way after the award of the *distringas juratores* (z).

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

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

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

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

In order to act upon the rule, an appointment (d) must be obtained at the Crown Office for the nomination of the jury there, and the rule and appointment must be served upon the sheriff, and the opposite party. The rule must be produced at the chambers of the Lord Chief Justice, in order to have the cause marked as a special jury cause, on or before the day preceding the adjournment day of the Middlesex sittings after term (e). When the adverse party does not appear upon the

(z) See the Forms in the Appendix, Chap. II. s. 7; and see also *R. v. Hare*, 1 Str. 267.

(a) See Bro. Abr. Sci. Fa. pl. 189.

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

(c) See Corner's Crown Practice, 137.

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

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

Nomination. first appointment, the party which obtained the appointment must (after waiting half an hour) procure a peremptory appointment. If the adverse party does not appear upon the peremptory appointment, the party who procured it may after waiting an hour proceed with the nomination *ex parte*. The nomination is made at the Crown Office by the clerk or officer there in this manner (*f*): he will draw forty-eight cards (having numbers written upon them) successively out of a ballot box, and upon drawing each card reference will be made to the name in the sheriff's book or list of special jurors opposite to the number corresponding with that on the card, and each of the names thus obtained will be placed upon the list of jurors nominated to try the action. It is usual for the parties attending to take a copy of the list so made for the purpose of making inquiries before reducing the list (*g*).

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

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

Reduced list. The twenty-four names which remain in the reduced list are those of the jurors which must be summoned to try the issues joined in the action (*i*). For that purpose the reduced list is to be signed by the Master, and annexed to the *venire facias*, and taken to the sheriff. When a day for the trial of the cause has been appointed, the sheriff will summon the

(*f*) 6 Geo. IV. c. 50, s. 32.

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

the jury.

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

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

jurors, and copy the names into a panel, and return the writ, with the panel annexed, into Court on the day appointed. And when a special jury has thus been struck and reduced, the cause cannot be tried by any other jury (*j*), unless the rule for the special jury is first discharged.

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

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

Writs of *subpœna ad testificandum* and *duces tecum* in this action must be issued out of the Crown Office. In order to obtain such a writ, it must be engrossed on parchment by the attorney of the party suing it out (*n*), it must then be taken to the Crown Office with a *præcipe*, where the writ will be signed and sealed (*o*), and the *præcipe* filed. The writ must be tested as of the day it is issued.

The Queen being a party to the action, a *tales* cannot be prayed by either party at the trial without the Attorney-general's warrant (*p*). Whenever the cause has been made a special jury cause therefore, each party ought to provide himself with such a warrant which will be granted as of course (*q*).

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

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

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

(*m*) See 1 Stark. R. 31; *Gunn v. Honeyman*, 2 B. & Ald. 400; *Johnson*

v. Blackwell, 6 C. & P. 236.

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

(*o*) 8 & 9 Vict. c. 34, s. 2, and see n. (*h*), p. 407.

(*p*) 2 Hawk. c. 41, s. 18.

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

The warrant may be used or not at the discretion of the party who obtained it (r).

Entry of the cause for trial.

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

Proclamation at trial.

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

Prosecutor entitled to begin.

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

Demurrer to evidence.

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

Bill of exceptions.

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

It has also been doubted whether a bill of exceptions lies upon proceedings in the Petty Bag in Chancery; but that doubt seems to be set at rest by the opinion of the Judges in a case which occurred before Lord Keeper *Harcourt*. Copies of the Lord Keeper's letter to the Chief Justice of the King's

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

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

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

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

(x) See 2 Hawk. c. 46, s. 20; *R. v. Vane*, 1 Sid. 85; *Kely*, 15; 1 Keb. 32; 1 Lev. 68, S. C.; *Willis*, 535; and 2 Inst. 427.

Bench, and the answer of the Chief Justice, with the opinion of the Judges, have been preserved in the office of the Petty Bag (y).

When there are several suggestions in a writ of *scire facias*, Discharge of the jury as to some of the issues.

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

Lord Keeper's Letter to the Lord Chief Justice.

" My Lord,

" On Thursday last, Mr. Attorney-general moved the Court of Chancery to discharge a frivolous plea in abatement to a *scire facias* depending in the Petty Bag. On hearing counsel on both sides, I was of opinion that the plea was frivolous, and ordered it to be discharged. The defendant's counsel, immediately upon my pronouncing the order, produced a Bill of Exceptions, ready engrossed, in ten large skins of parchment, and desired me to seal it. I forbear to trouble your Lordship with any account with respect to the nature of the writ, or of the plea, or the manner of tendering the Bill to me.

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

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

" I am, my Lord,

" Your Lordship's very

" humble Servant,

" HARCOURT."

" 17 Nov. 1711."

The Answer of the Lord Chief Justice.

" My Lord,

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

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

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

" 23rd Jan. 1712."

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

R. v. Nickels.

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

Venire de novo.

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

New trial.

Whether the action has been tried at bar or at *nisi prius*, the Court of Queen's Bench has power to grant a new trial (f). For the transcript of the record is sent into the Queen's Bench, to the end that the issues may be tried, and until the issues have been *properly* tried, the Queen's Bench cannot certify the Chancery respecting the result. It has

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

(a) MS.

(b) See further on the subject of discharging a jury as to immaterial issues, *Powell v. Sonnett*, 1 Dow. N. S. 56; 1 Bligh, N. S. 545; 3 Bing. 381; 11 Moore, 330, S. C.; *Duckworth v. Har-*

ison, 4 M. & W. 444; *R. v. Johnson*, 5 A. & E. 488, and 6 M. & G. 259, n.

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

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

(e) 2 Vent. 173.

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

consequently been the constant practice to move the Court of Queen's Bench for new trials in actions of *scire facias* (g).

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

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

Several exceptions to the rule that Queen's Bench never parts with a record.

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

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

In the great majority of cases in which records are sent out of Chancery into the Queen's Bench for trial, the record is retained in the latter Court, and judgment given there (m); but in all these cases the Court of Queen's Bench has the same jurisdiction over the subject-matter of the suit as the Court of Chancery; in fact, every thing that is to be done in such actions after verdict, may be done as well by the one Court as the other, and therefore it would be a useless form to send the records in such actions back into Chancery. And in all those actions when the records are taken into the Queen's Bench for a trial, the original record either actually or in contemplation of law is transferred to that Court.

Where Queen's Bench has jurisdiction the record is retained.

(g) See *R. v. Arkwright*, Dav. P. C. 141; *R. v. Wheeler*, 2 B. & Ald. 345; *R. v. Bynner*, not yet reported.

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

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

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

(l) 94, b.

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

Thus, in a case stated in the Year Book, 24 Ed. III. (n), Robert Bishop of Chester and another brought a *scire facias* against G. de M. upon a recognizance; after issue joined, the record, and also the record of the recognizance, was sent into the Queen's Bench. The Bishop being nonsuited at the trial, afterwards brought a new *scire facias* in the Queen's Bench upon the recognizance (o), and it was held, that he might do so, for the whole record including the recognizance itself had been removed out of Chancery into the Queen's Bench.

In *scire facias* to cancel a patent a transcript only of the record is sent into Queen's Bench.

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

Upon verdict for the Crown, something to be done which cannot be done in Queen's Bench.

It is evident from what has been stated, that there is something to be done by the judgment in the action which cannot be done in the Queen's Bench, and can only properly be done in Chancery; and it is, therefore, to be inferred from the nature of the case, and independent of all other authority, that after the issues have been properly tried, and a verdict found for the Crown, the record of the verdict ought to be remanded into Chancery for the judgment to be given there. Whether it would be necessary to send the record of the verdict into Chancery if the verdict be for the defendant, it is unnecessary

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

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

issued upon the record of the nonsuit.

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

for the present purpose to enquire, and a case (if there be any such) in which judgment has been given for the defendant in the Queen's Bench after verdict will be no authority against sending the record into Chancery after a verdict for the Crown, for if the defendant is entitled to judgment the judgment renders all further proceedings unnecessary, but if the Crown is entitled to judgment, then there is something further to be done, and respecting which the Queen's Bench has no jurisdiction. It is believed, however, that there is no case in which a judgment has been given by the Queen's Bench for the defendant in a *scire facias* to cancel a patent, and upon principle it seems that even when the defendant obtains a verdict upon all the issues in the action, the record of it ought to be sent into Chancery; for in the first place the Queen's Bench has not the record itself but only a transcript, and in the second place, the Crown might possibly be entitled to judgment *non obstante veredicto*, which can only be given in Chancery.

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

Ample authority that verdict must be sent into Chancery for judgment.

Sir *Edward Coke* in the Fourth Institute (q) says, that after the trial has been had in the Queen's Bench, the record is to be remanded into Chancery and judgment given there. If this was intended to apply to all actions in which the records are sent out of Chancery for trial, it is clear that it is a mistake; but it seems also to be clear that there are cases to which this passage in the Fourth Institute is substantially applicable. Thus, if a traverse is taken in Chancery upon an inquisition under a writ *de lunatico enquirendo*, the issue must be sent to the Queen's Bench to be tried, but after trial that Court has no further jurisdiction, and all the ulterior proceedings must be taken in Chancery, into which Court the record must be remanded. And the passage in the Fourth Institute just cited, is also applicable to the remand of the record of a verdict in *scire facias* into Chancery, after a trial in the Queen's Bench.

4 Inst. c. 8.

In the *Sackvill College* case (r), in Chancery, Chief Baron

Sackvill College case.

(q) P. 80.

(r) T. Raym. 178.

Hale said, that upon an issue tried in a *scire facias*, judgment is not given in the Queen's Bench, but the record is to be returned into Chancery.

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

H. 46 Ed. III. The case cited occurred in the forty-sixth of Edward the Third, and as it is most important with reference to this part of our subject, it is deemed advisable to insert here a literal translation of it, which is as follows:—

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

Fitzherbert's Abridgment is a book of the highest authority in our law, and the case which has been cited from it seems to be conclusive to show that a record may be remanded into Chancery after a verdict in the Court of Queen's Bench. And when it is considered that upon a verdict for the Crown, there are several things to be done, which the Lord Chancellor only can do, and respecting which the Queen's Bench

(s) Title “Petition,” pl. 19.

(t) There could be no *nisi prius* in such a case, without the King's

writ or Attorney-general's warrant, vide *ante*, p. 407.

has no jurisdiction whatsoever; namely, to cancel the patent by taking the Great Seal off it,—to cancel the enrolment in the manner described by *Coke (u)*,—and enter a *vacatur* on the roll; it seems to be difficult to come to any other conclusion except this, that the record of the verdict must be sent into Chancery for judgment to be given there (*x*). And, indeed, as the Queen's Bench never has before it anything more than a transcript of the Chancery record, and that merely for the purpose of trying the issues, it seems to be impossible to come to the conclusion that any judgment can be given in the Court of Queen's Bench.

And a case is stated in Rolle's Abridgment (*y*), which is 38 Ed. III. not only an authority for sending the record of the verdict into Chancery for judgment, but also furnishes us with the form in which the record is to be sent into that Court. The following is the statement of the case, *viz.*—"That a manor was held of a barony of a common person, and the manor being forfeited to the King, he granted it to another to hold of himself, instead of the capital lord of the fee. That there was a petition that the charter be amended, upon which there was a plea in Chancery, and found by the escheator and by a jury in the King's Bench to be true;"—and an entry appears to have been made to the effect that,—"*because the giving of judgment upon the verdict, and execution of the judgment, belonged to the office of Chancellor, the verdict was sent into Chancery and a day given to the parties there.*"

In accordance with the authorities here stated, the record of the verdict upon a *scire facias* was sent out of the Queen's Bench into Chancery, in the case of *The Queen v. Nickels (z)*, and judgment given there for the Crown to revoke and cancel the patent, and to cancel the enrolment (*a*). A writ of error was brought upon that judgment returnable in the House of Lords, but no objection was taken in Chancery,

(*u*) 4 Inst. 88.

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

(*y*) 1 Ro. Abr. 534, (G.) Courts

Bank le Roy.

(*z*) MS.

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

to the regularity of the proceedings, nor was the want of authority in the Court of Chancery to give the judgment assigned for cause of error in the House of Lords.

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

Digges' case.

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

Mark Steward's case.

In *Mark Steward's* case (f), it appears that by letters patent the office of Serjeant-at-Arms had been granted to Mark Steward, who was to be attending upon the Lord Chancellor for the time being. An inquisition was afterwards taken for seizing the office into the hands of the Queen, under which it was found that Mark Steward did serve the office according to the patent, but absented himself during the time specified in the inquisition. Mark Steward traversed this inquisition, and pleaded the Queen's leave of absence during the time mentioned in the inquisition, upon which issue was joined and the record was sent into the Queen's Bench for the issue to be tried. A special verdict was given, and upon argument in the Court of Queen's Bench, judgment was given by that Court for Mark Steward, that he be restored to his office, &c. It will be observed that in this case there was nothing to be done which could not be as well done by the Queen's Bench as the Chancery, no question respecting the cancelling of the patent could have been raised, and therefore the case furnished no authority in favour of the assertion that the Queen's Bench can give judgment to *cancel* a patent, and the enrolment of it.

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

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

(d) *Ibid.* 160, b.

(e) *Ibid.* 172, b.

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

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

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

It is to be observed, that the judgment in *Sarnefield's* case having been obtained by default, the case cannot be considered as one of great authority. And if the form of judgment given by the King's Bench in that case be compared with the form of a judgment in *scire facias*, in Chancery, as stated by Coke (h), the great difference between the two cases will be seen at once. In *Sarnefield's* case, the judgment was merely to revoke and annul the patent, nothing being said about cancelling the patent or the enrolment ; but the form of a Chancery judgment is not only to revoke the patent, but to cancel it, and also to cancel and quash the enrolment. The difference

(g) Part 8, p. 23, a.

(h) 4 Inst. 88.

between the two jurisdictions is indeed apparent from the different way in which *Coke* speaks of the two Courts. He says (i), that a *scire facias* to repeal a patent may be brought in the King's Bench (k); but speaking of the Court of Chancery, he says, that the highest point of the Lord Chancellor's jurisdiction is "to cancel the King's letters patent under the Great Seal, and damning the enrolment thereof by drawing strikes through it like a lettice."

Judgment must be given in Chancery.

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

How to send the record of verdict into Chancery.

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

Nisi prius record when obtained.

The *nisi prius* record cannot be obtained until after the fourth day of term, and if a rule *nisi* for a new trial should be obtained, that record cannot be obtained until after the rule has been disposed of. The appearance of the parties on the

(i) 4 Inst. 72.

(k) See on this subject, *ante*, p. 381.

(l) See the Form in the Appendix,

Chap. II. s. 7.

first day of the term next after the trial is always recorded in the Queen's Bench, and the proper day to give them to appear in the Court of Chancery, is the day after the motions for new trials have been disposed of, namely, the fifth day of the term; any other day in term may, however, be given. If a rule for a new trial has been obtained and discharged, proper continuances must (if necessary) be entered on the Queen's Bench record, prior to the entry of the sending of the record into Chancery.

Day to be given in Chancery.

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

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

No writ necessary for taking the record into Chancery.

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

Judgment how signed.

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

Judgment for the Crown.

But if the defendant has obtained a verdict upon *every* issue

Judgment for defendant.

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

(*n*) 4 Inst. 88.

he will be entitled to judgment, the form of which will be, "It is considered and adjudged by the same Court here, that he the said A. B., do depart hence without day in this behalf."

Motion in arrest of judgment, or for judgment *non obstante*.

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

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

Effect of judgment for the Crown.

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

How the judgment is to be executed.

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

Patent ordered to be restored into Chancery.

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

Defendant being in Court no writ necessary.

The defendant being in Court when he is commanded by the judgment to restore the patent into Chancery, no process is necessary (p), unless he refuses to bring in the patent. In

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

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

order to procure the patent and enrolment to be cancelled, the prosecutor must, after the entry of the judgment, make an entry upon the Chancery record, of a day given to the defendant to bring in the patent (q), and the day ought to be a real day in term, when the Lord Chancellor hears motions. Care must be taken to fix the day given so that a sufficient notice of it may be given to the defendant (r). The prosecutor ought to instruct counsel to appear for the Crown on the day appointed, when, if the defendant appears, and produces the patent, the prosecutor's counsel will move to have it and the enrolment cancelled in pursuance of the judgment, and a *vocat* or *vacatur* entered on the roll:—if the defendant appears, but does *not* produce the patent, the motion will be that the defendant stand committed for his contempt in not restoring the patent into Chancery in pursuance of the judgment (s). The defendant may, however, show cause why the judgment should not be carried into execution, as that a writ of error has been sued out, or is intended to be sued out; or he may ask for further time to answer the application, or to bring in the patent, and any reasonable length of time will be given if the Court thinks it necessary.

Day to bring in the patent.

Motion to cancel patent, or commit defendant for contempt.

Defendant may show cause.

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

Excuse for not bringing in patent.

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

Motion for attachment.

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

When the patent is brought in by the defendant, it must be cancelled by the Lord Chancellor, or one of his officers in his presence, for the Master of the Rolls has no jurisdiction

Patent to be cancelled by the Lord Chancellor.

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

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

(s) See *R. v. Cary*, 1 Vern. 131; 1

Eq. Cas. Ab. 129, S. C.; *Clarke's* case, 2 Q. B. Rep. 619.

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

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

over the patent, and it cannot be properly cancelled by any less authority than that of the Judge by whom it was made (*u*). The cancellation is effected by cutting or tearing the Great Seal from the instrument.

Enrolment to be cancelled.

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

Enrolment how cancelled.

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

Vacatur.

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

Patent ought to be cancelled before the enrolment.

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

Defendant will be excused if he is unable to restore the patent.

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

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

(*x*) 4 Inst. 88.

(*y*) Semble, “lattice.”

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

be excused, until he shall (if over) be enabled to restore the patent as commanded by the judgment.

Thus, in the recent case of *The Queen v. Newton* (a), it appeared upon a motion that the defendant stand committed for not bringing in the patent, that it was in the custody of the defendant's *cestui que trust*, who resided abroad, and that the defendant had in vain endeavoured to procure the restoration of it, and was therefore unable to obey the command given to him by the judgment of the Court. The Lord Chancellor held, that under these circumstances, if the defendant would undertake that he would not assign the patent, bring any writ of error, or do any act to defeat the judgment, he ought to be excused, and having given the required undertaking, he was accordingly excused from *then* restoring the patent into Court. R. v. Newton.

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

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

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

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

For errors in process, or errors of fact, in this action after judgment in Chancery, the party may have a writ of error, *coram nobis in Cancellaria*, in the same way as a party can Writs of error. Error in fact.

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

have a writ of error, *coram nobis*, upon a judgment in the Queen's Bench (*a*). But in cases where process issues out of Chancery, *returnable in the Queen's Bench*, as an execution upon a statute merchant (*b*), such a writ of error must be made returnable in the Queen's Bench.

Errors in law.

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

4 Inst. c. 8.

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

R. v. Cary.

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

3 Bl. Com.
c. 4, p. 49.

Speaking of this case *Blackstone* says in a note (*i*), the opinion of Lord Keeper *North*, that no such writ of error lay seems not to have been well considered. But the authorities which have been cited, show that Lord Keeper *North* was quite correct in what he stated; and, indeed the form of the writ of error given in the register shows conclusively that the

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

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

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

(d) See the case of *The King v. Butler*, 2 Vent. 344, and 3 Lev. 220, in which the writ was made returnable

in Parliament, and all the Judges appear to have attended the argument.

(e) 4 Inst. 80.

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

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

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

(i) 3 Com. p. 49.

writ must be returnable in Parliament, and the forms in the register can only be altered by Act of Parliament (*k*).

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

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

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

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

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

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

There is no instance however of the bond having been enforced, and it seems that the defendant would not be entitled as of right to the benefit of it, for the law, as we have seen, does not entitle him to costs in the action. If, therefore, a defendant obtains a verdict upon every issue, and consequently judgment in the action, it seems (the bond being taken in pursuance of the Attorney-general's fiat,) that the How defendant is to obtain his costs by suit on the bond.

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

(*n*) *Ante*, p. 386.

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

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

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

defendant ought to have the Attorney-general's fiat for the payment and taxation of his costs in the action, and for putting the bond in suit, in case they are not paid. And if it should be necessary to sue on the bond, application ought to be made to the Lord Chancellor or Master of the Rolls for leave to sue in the name of the senior clerk (who is one of the officers of the Court,) for the recovery of the costs, which would only be granted upon condition that the defendant indemnifies the senior clerk against all costs and expenses of the intended proceedings on the bond.

Taxation of costs.

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

Costs upon interlocutory proceedings.

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

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

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

Enforcement of orders for payment of costs under stat. 1 & 2 Vict. c. 110, s. 18.

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

(a) Not reported.

(b) 1 P. Wms. 224.

(when necessary) a rule of Court, and by entering the rule of record in the Court.

SECTION VII.

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

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

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

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

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

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

The revocation may be either by the Queen herself, or by Revocation how made.

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

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

(*o*) *Vide ante*, p. 389.

(*p*) *Ante*, p. 61.

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

No instance of a revocation in modern times.

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

CHAPTER XI.

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

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

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

SECTION I.

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

1st. *Of the Burthen of Proof.*

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

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

1st. *Of the Burthen of Proof.*

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

Burthen of proof generally upon the plaintiff.

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

What plaintiff was compelled to prove under not guilty before the new pleading rules.

(a) R. G. H. T. 3 W. IV. 1834. *Winter*, 1 T. R. 602; *Manton v. Manton*, Dav. P. C. 348; *Minter v. Wells*,

(b) See the cases of *Turner v.* 1 Webs. R. 129, 130.

Not guilty now denies the infringement only.

Evidence of objections must now be given under special pleas.

New pleading rules not intended to shift the burthen of proof.

If *non concessit* is pleaded the plaintiff must give the patent in evidence.

If plaintiff's title is denied in any other way, he must prove a *primâ facie* case.

Notice of objections does not alter the burthen of proof.

3. By the new pleading rules just mentioned, the effect of the plea of not guilty has been narrowed so as to amount only to a denial of the alleged infringement, and consequently the evidence in support of any objection which the defendant intends to take to the patent, must be given under the plea of *non concessit* or some special plea stating the particular cause for invalidating the patent upon which the defendant intends to rely. It was not intended by the new pleading rules, however, to make any alteration respecting the burthen of proof upon any matter in contest between the parties, but merely to confine the evidence at the trial to the particular matters which the defendant shall put in issue by special pleas.

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

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

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

support of each issue (if any) to which the defendant's objections are applicable (c).

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

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

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

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

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

(c) See further as to the Notice of Objections, *ante*, Chap. X. s. 2, p. 284.

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

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

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

matter for the jury to take into consideration as tending to affect his credit.

Competency of licensee.

Derosne v. Fairlie.

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

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

The interest of a licensee to support or defeat a patent.

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

Licensee's interest in the event only affects his credit.

5. These observations are only of importance for the purpose of directing attention to the *extent* of the interest which a licensee may have in the event of an action for an infringement so as to affect his credit as a witness, for it is clear that the statute 6 & 7 Vict. c. 85 (*i*), renders a licensee a competent witness in such an action, unless indeed the action be brought or defended for his immediate benefit. Thus, if a person had an exclusive licence for some particular district, and an action was brought by the patentee for his benefit, against a party infringing the patent within the district comprised in the licence; the licensee could not be a competent witness, for he would come within the meaning of the exception contained in the first section of the statute as being the person "in whose immediate and individual behalf" the action was brought (*i*).

But if the action is brought for a licensee's immediate benefit he is incompetent.

(*h*) 1 Mo. & Rob. 457.

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

(b) Of the Examination of Witnesses (k).

1. Upon the examination of a witness to prove that an invention was not new, the witness proved that he had long before the date of the patent constructed a machine for the same purposes as the patent machine. A drawing, said to be a drawing of the witness's machine was produced, but the drawing had not been made by the witness, and it was objected for the patentee that the witness ought not to look at the drawing, but should describe the machine he had constructed. Mr. Justice *Bayley*, however, held that the witness might look at the drawing, and might be asked whether he had such a recollection of the machine he had made as to be able to say that the drawing was a correct representation of it (*l*).

A drawing not made by the witness, may be put into his hand, and he may be asked if it correctly represents a machine which he has made.

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

Bloxam v. Elsee.

Witness cannot give evidence of what a person (under whom plaintiff claims) said respecting the contents of a deed.

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

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

Defendant must give a notice of all objections of which he intends to offer evidence.

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

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

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

& P. 563.

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

as part of the pleadings, that it ought to be stated or read at the same time that the pleadings are opened (o).

Some objections of which no notice need be given.

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

Under an Issue upon a Plea of Non Concessit.

Plaintiff must give his patent or an exemplification in evidence.

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

Non concessit by the said letters patent, admits that there is a patent, but denies the effect as stated.

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

3. The plea is sometimes, however, more extensive, and denies generally that the Queen has made such grant of privilege as the plaintiff has stated in the declaration, and the existence of *any* patent seems then to be put in issue (r).

Whether defendant can be allowed by plea to deny that there is a patent.

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

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

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

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

case.

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

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

(t) *Ante*, p. 264.

defendant ought not to be allowed to plead a plea which is so manifestly untrue (u).

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

Effect of *non concessit* substantially the same in every form.

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

Patent is admissible in evidence without further proof.

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

Crown grants not available at Common Law unless proved by the patent.

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

Statute 3 & 4 Edw. VI. c. 4, amended by 13 Eliz. c. 6.

Section 2 of the latter Act in substance provides, that patentees and all persons claiming under them are enabled to make such title to lands, "or other things whatsoever," specified in their letters patent, or any part thereof, by showing forth an exemplification or *constat* under the Great Seal of

13 Eliz. c. 6, s. 2. A patentee enabled to make such title to things specified in his patent by an exemplification.

(u) *Eden's case*, 6 Co. R. 15, b; Rol. Abr. 182. Plowd. 232.

(y) See the Statute in the Appendix,

(x) *Lane's case*, 2 Co. R. 16, b; 2 Chap. I. s. 1.

tion of the enrolment as if the patent itself shown.

The statute applies to patents for inventions.

The patent only proves the purport of the grant it contains.

If patent void *non concessit* may be pleaded.

Non concessit puts the plaintiff to the proof of every thing necessary to support his title.

the enrolment of the letters patent (*z*), or so much thereof as shall be necessary, as if the letters patent were themselves pleaded and shown forth.

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

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

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

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

And as the plea of *non concessit* puts in issue not only the fact of a grant having in form been made by the Crown, but also all the facts which go to establish the validity of the grant, it is apprehended that (if the notice of objections be sufficient) a plaintiff will be compelled by the plea to give *prima facie* evidence in support of his title, in the same

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

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

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

(*c*) See Hardr. 119.

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

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

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

manner as he would by pleas alleging, that he or the patentee was not the true and first inventor or importer of the invention, that the invention was not such an art as might be made the subject of a patent privilege, and that it did not possess the requisite qualities of novelty and utility (*g*).

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

Non concessit also enables the defendant to prove that the patent is void.

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

Objections are only available under *non concessit* if patent void *ab initio*.

14. For the purpose of merely proving the purport of the patent grant as alleged in the declaration, it will be sufficient to give the patent itself in evidence. But if any question should arise under this issue, which renders it necessary to show what the invention is, the plaintiff must give his specification in evidence. Thus, if it be objected by the defendant that the patentee was not the true or first inventor, or that the invention was not new, the plaintiff must give his speci-

Patent sufficient to prove the purport of the grant.

Upon any question respecting the invention the specification must be given in evidence.

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

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

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

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

(*l*) 1 Co. R. 43, a; Com. Dig. Grant, (G. 8), (G. 9).

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

cation in evidence, to prove what the invention is to which the patent applies, and to enable his witnesses to give testimony respecting its novelty at the date of the patent.

Specification to be deemed part of the patent.

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

Hornblower v. Boulton.

Thus, in the case of *Hornblower v. Boulton* (n), Mr. Justice Grose said, "I consider the patent and specification so connected together as to make a part of each other, and that to learn what the patent is, I may read the specification and consider it as incorporated with the patent."

Crossley v. Beverley.

So in the case of *Crossley v. Beverley* (o), which was an action for the infringement of a patent, Mr. Justice Bayley, said, "I think the specification and the patent are to be taken as one muniment in enforcing this claim on the part of the patentee, and they only."

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

Plaintiff must prove that he was the true and also the first inventor.

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

Direct evidence of an actual inventing, can only be given by the inventor, who is not a competent witness except in an action by an assignee.

2. Invention is an act of the mind which is incapable of direct proof except by the evidence of the inventor himself, and his evidence is generally inadmissible in an action upon the patent. But when a patentee has assigned over all his interest in the patent privilege, there seems to be no reason why he should not be a good witness to prove that he did actually make the

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

(o) 9 B. & C. 62.

(p) As to who may, as an actual

inventor, be the grantee of a sole right to use an invention, vide *ante*, Chap. III. s. 2, p. 22.

invention as alleged in the petition recited in the patent. And as it is a rule that a party must produce the best evidence, the nature of the case admits of, it may even be questionable whether an assignee plaintiff is not bound in such a case to prove the affirmative of this issue by the evidence of the patentee himself, if his evidence can be procured.

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

Inventing indirectly proved by patentee being the first to communicate the invention.

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

Minter v. Wells.

And accordingly it is the invariable practice at *nisi prius*, to prove the affirmative of this issue, (the patent being admitted,) first by giving the specification in evidence, and then showing that the invention was new, and unknown to the public at the date of the patent; and this is sufficient *prima facie* evidence to establish the affirmative of the two propositions which the plaintiff is bound to prove, *viz.*, that the patentee was not only the true or actual inventor, but also the first to give the invention to the public.

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

An importer may prove a *prima facie* case in the same way under this issue.

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

Defendant may show that patentee was not the true, or not the first inventor.

6. In order to show that the patentee was not the true or

Proof that pa-

(q) 1 Webs. R. 129.

patentee not the true inventor.

actual inventor, the defendant must prove that the patentee acquired a knowledge of the invention from a British subject, or some person residing in this country, or from some other source than his own actual invention or discovery.

Cornish v. Keene.

If patentee borrowed from another or from a book he was not the true inventor.

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

Tennant's case.

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

If any essential part of an invention communicated to patentee he was not the true inventor.

Lewis v. Marling.

If patentee saw a model from which he borrowed the invention, he was not the inventor.

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

(r) 1 Webs. R. 507.

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

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

(u) 10 B. & C. 22.

shown that the plaintiff had seen the model, and had borrowed from it, he would not have been the true inventor.

In the case of *Gibson v. Brand* (x), Lord Chief Justice Tindal held, that proof that the patentee was the first to publish an invention to the world, was not *conclusive* evidence of his being the actual inventor, and that he would not be the inventor if it were shown that he had borrowed it from another person; for the law never intended that a person who has taken all his knowledge from the labours and assiduity, or ingenuity of another, should be the man who was to receive the benefit of another's skill

Gibson v. Brand.

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

Barker v. Shaw.

If a servant make an invention the master cannot support a patent for it.

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

Patentee may avail himself of assistance.

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

Bloxam v. Elsee.

In the case of *Minter v. Wells* (b), Mr. Baron Alderson

(x) 1 Webs. R. 628.

(a) 1 C. & P. 567.

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

(b) 1 Webs. R. 132.

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

Minter v. Wells.

The person who conceives or suggests the invention is the inventor, and his assistant is only his tool.

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

If patentee an importer, his patent may be defeated in the same way.

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

Communication from a Scotchman.

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

Brown v. Annandale.

A communication from any other part of the United Kingdom will not support a patent.

But the case of *Brown v. Annandale* (d) (decided in the House of Lords) shows that the words "in this realm" in the Statute of Monopolies (e), must now be understood to mean the whole of the United Kingdom; and as the patentee must be the true inventor within the United Kingdom, a communication of the invention made to him by any person residing within any part of it, would not enable him to support a patent.

Evidence that patentee not the first inventor.

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

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

(d) 1 Webs. R. 433.

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

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

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

Forsyth v. Riviere.
Who is the first inventor.
Cornish v. Keene.
The inventor who first obtains a patent is the first inventor.

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

It is sufficient if defendant shows that the prior patent comprises something included in the second.

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

11. Proof that the alleged invention, comprised in a patent, or any part of it, was not new to the public at the date of the patent, will also be sufficient to show that the patentee was not the first inventor. And, therefore, a plea that the patentee was not the true and first inventor, puts in issue the novelty

If the invention was not new, the patentee was not the first inventor

(g) Chit. Prerog. Cr. 182.

(h) 1 Webs. R. 308.

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

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

of the invention at the date of the patent (*l*) in the same way as a plea alleging that the invention was not new as to the public knowledge and use of it (*m*).

Stead v. Williams.

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

Prior discovery not published will not defeat patentee's title. *Dollond's case.*

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

Lewis v. Marling.

Jones v. Pearce.

Prior unsuccessful experiment will not defeat a patentee's title. *Lewis v. Marling.*

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

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

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

(*n*) 8 Jur. 930.

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

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

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

(*r*) 1 Webs. R. 122.

(*s*) 4 C. & P. 52.

and Mr. Thompson afterwards purchased the plaintiff's machine. Lord Tenterden, C. J., held, that as it was not shown that the plaintiff had seen the model, the evidence was not sufficient to defeat the plaintiff's title as inventor.

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

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

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

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

If defendant deny the communication of an imported invention, plaintiff must prove it.

2. The plaintiff is consequently compelled to prove under this issue that a communication was made to him on some day before the date of his petition for the patent, or at all events before the date of the patent, for a communication after the date of the patent would be inconsistent with the representa-

What the plaintiff must prove under this issue.

(t) 9 M. & W. 300.

(u) 1 Webs. 508.

(x) 1 Webs. 525.

(y) 1 Webs. 628.

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

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

(b) See the form of plea in the Ap-

pendix, Chap. II. s. 4.

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

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

tion which the patent shows that the patentee has made to the Crown. So also it must be shown that the communication was made by a foreigner, for if the communication were made by a British subject the patent could not be supported.

Tennant's case.

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

Patentee must prove the truth of his representation to the Crown.

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

Whether a communication from a foreigner residing in this country sufficient.

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

Communication from a denizen.

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

Communication from a naturalized foreigner.

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

Evidence for the defendant.

7. Under this issue the defendant may show that the patentee acquired a knowledge of the invention in a manner

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

(g) Vide ante, Chap. III. s. 3, p. 29.

(f) See the form in the Appendix,

different from that which he alleged to the Crown in his petition for the patent.

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

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

2. An issue of this kind is most frequently raised upon the correctness of a representation respecting the nature of the invention intended to be comprised in the title which the patentee has chosen to give it; as, for instance, a representation that the invention was an improvement or improvements in some particular manufacture, or was applicable in the particular manner mentioned by the patentee in the title which he has given to his invention.

Invention not an improvement.

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

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

Plaintiff must prove that the title is substantially correct.

5. An issue respecting the invention being an improvement must not be confounded with an issue raised upon a plea alleging that the invention is useless to the public; the two issues are perfectly separate and distinct (*l*). In the one case

An issue respecting an invention being an improvement, not the same as an issue respecting the utility.

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

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

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

(*l*) *Morgan v. Seaward*, 2 M. & W.

544, and *Beddells v. Massey*, 2 Dowl.

& Law, 322.

the plaintiff must give evidence respecting the utility of his invention in comparison with something previously known; but in the other case it is sufficient for him to prove that the invention is itself of some use to the public (*m*).

Evidence of invention being an improvement.

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

Each distinct part must be an improvement.

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

Cornish v. Keene.

If the title alleges the invention to be an improvement generally, it will not be sufficient to prove that it was so for some particular purpose only.

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

If invention an improvement upon another in a former patent, the specification of the former patent must be given in evidence.

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

Issue upon the invention being applicable in the manner alleged.

8. Under an issue respecting the applicability of the invention in the manner alleged in the title, the plaintiff must show that the allegation is substantially true. Thus, if the title allege the invention to be an improvement in lace machines, and also applicable to stocking looms, the plaintiff must show that the invention is applicable not only to lace machines, but also to

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

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

(*o*) *Morgan v. Seaward*, 2 M. & W. 544.

(*p*) 1 Webs. R. 501, 506.

(*q*) *Lewis v. Davis*, 3 C. & P. 488.

stocking looms. And if he fails in proving the applicability of the invention in either respect, he will fail altogether.

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

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

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

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

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

Thus, in the case of *Felton v. Greaves* (y), the patent had

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

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

(t) 2 M. & W. 544.

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

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

(y) 3 C. & P. 611.

Hill v. Thompson

son.

Issue respecting the nature of the invention.

Evidence for the defendant.

Defendant may prove that invention not an improvement.

Morgan v. Seaward.

Defendant may show that invention is not applicable in the manner represented.

Felton v. Greaves.

been obtained for an invention which the patentee intituled "a machine for sharpening knives, scissors, and razors;" and as it appeared that the machine described in the specification was inapplicable for the purpose of sharpening scissors, the patent was held to be void.

Defendant may show that invention is not of the nature alleged.

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

R. v. Metcalf.

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

R. v. Wheeler.

And in the case of *The King v. Wheeler* (a), the patentee had represented his invention to be "a new or improved method of drying and preparing malt." It appeared, however, that the invention was not applicable in the manufacture of the article previously known by the name of malt, but was a method of converting malt into a colouring matter, to be used in colouring beer. And it was held that the patent was void on the ground of the misrepresentation contained in the title.

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

This issue for the Judge.

Specification must be given in evidence.

And terms of art explained to

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

2. If there are any terms of art contained in the title or

(x) 2 Stark. R. 249.

(a) 2 B. & Ald. 249.

specification, the plaintiff ought to give evidence of the signifi- enable Judge
cation of those terms, and the jury must determine what the to determine
signification is, so as to enable the Judge to arrive at a right the question.
construction of the patent and specification, which, for this
purpose, must be taken as one instrument.

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

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

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

1. This issue compels the plaintiff to prove that the inven- Plaintiff must
tion was new as to the public knowledge and use of it, at the prove the
time of the making of the patent (e). The first thing to be novelty of his
attended to, therefore, is the *date* of the patent, for the patent invention.
must be presumed to have been made on the day it bears
date (f). And the patentee must be able to show *prima facie*,

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

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

(d) See Chap. V. s. 2, p. 102, re-
specting the degree of novelty which
is requisite in order to make an inven-
tion the legal subject of a patent pri-

vilige.

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

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

that the invention which (g) he gave or contracted to give to the public had not before *that day* become public property.

Whether a
manufacture
not in issue.

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

What witnesses
plaintiff must
call.

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

Indirect evi-
dence only can
be given.

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

Value of
evidence
depends upon
witness's means
of knowledge.

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

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

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

(h) *Walton v. Potter*, 1 Webs. R. 601.

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

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

3. If the invention consists of several distinct parts, the plaintiff must prove that each part of the invention was new at the date of the patent (m). And, so, if several inventions have been comprised in the same patent, each invention must be shown to be new, or the whole patent will be void (n).

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

5. If it can be shown that an invention was described in a book published before the date of the patent, or in any public

(i) 1 Webs. R. 509.

(k) Dav. P. C. 350, 353.

(l) 1 Webs. 2. 526.

(m) *Manton v. Manton*, Dav. P. C. 340, 341; *Gibson v. Brand*, 4 M. & G.

179; *Gillet v. Wilby*, 9 C. & P. 334; and *Losh v. Hague*, 1 Webs. R. 208.

(n) *Brunton v. Hawks*, 4 B. & Ald. 541.

Cornish v. Keene.

Each part of invention must be proved to be new.

Evidence for the defendant.

Prior publication in a book, &c.

document, such as a specification enrolled in Chancery, that will be sufficient evidence to prove that the invention was not new within the meaning of the law. For the public had already a knowledge of the invention, or what is the same thing, possessed the means of knowledge available to every one of her Majesty's subjects.

R. v. Arkwright, prior publication in a book.

Hill v. Thompson.

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

Morgan v. Seaward.

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

Cornish v. Keene.

Publication in a specification prior to the date of the patent.

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

Part of invention published before the patent.

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

Huddart v. Grimshaw.

Thus, in the case of *Huddart v. Grimshaw* (s), Lord Ellenborough, C. J., said, in his charge to the jury, that if prior to the time of the plaintiff obtaining his patent any part of that which was of the substance of the invention had been communicated to the public in the shape of a specification of

(o) Dav. P. C. 129.
(p) 8 Taunt. 382; 1 Webs. R. 247,
248.

(q) 2 M. & W. 553.
(r) 1 Webs. R. 516, 511.
(s) Dav. P. C. 279.

any other patent, the plaintiff could not claim the benefit of a patent.

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

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

8. The Statute of Monopolies (x), which, we have seen, was in affirmance of the Common Law in this respect, requires that the art which is made the subject of a patent grant shall be the sole working or making of some manner of *new* manufacture, which others, at the time of the making of the patent, do not use; and the patent itself contains a condition that the invention comprised in it shall be *new as to the public use and exercise of it* (y). And, therefore, if it can be shown that the art or invention comprised in the patent was *used* by others in public before the making of the patent, the defendant will be entitled to a verdict upon this issue. Public use of invention prior to the patent.

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

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

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

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

(x) *Ibid.* p. 106.

(u) Vide *ante*, Chap. V. s. 2, p. 108.

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

is sufficient to prove that there had been a *public use* of the invention.

Lewis v. Marling, supposed to decide that a *general use* was necessary.

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

Observations upon the report of Lewis v. Marling.

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

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

Sufficient to prove a public use.

Cornish v. Keene.

If invention was before publicly known or practised.

In the case of *Cornish v. Keene* (e), it was laid down by the Lord Chief Justice *Tindal*, that if the invention was, at the time the letters patent were granted, in any degree of

(z) 4 C. & P. 52.

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

(b) 10 B. & C. 22.

(c) 9 M. & W. 300.

(d) 1 Webs. R. 122.

(e) 1 Webs. R. 508.

general use, if it was known at all to the world publicly, or practised openly, so that any other person might have the means of acquiring it as well as the person who obtained a patent, that would be sufficient to show that the patent was void.

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

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

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

11. The meaning of the term public use was much discussed in the recent case of *Carpenter v. Smith* (*l*). It was held by Lord Abinger, C. B., at *nisi prius* (*m*), in that case, that Meaning of "public use." *Carpenter v. Smith.*

(*f*) 1 Webs. R. 628.

(*g*) *Ibid.* 122.

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

(*i*) 1 Webs. R. 542.

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

(*l*) 9 M. & W. 300.

(*m*) 1 Webs. R. 530.

Public use means a use in public.

“*public use*,” means a use in public, or in a public manner, and not a use by the public. And upon a motion for a new trial, on the ground of a misdirection (m), the Court of Exchequer held that the Lord Chief Baron’s ruling was right; and a rule nisi for a new trial was refused. In giving judgment in that case, Mr. Baron Alderson said—“Public use means a use in public, so as to come to the knowledge of others than the inventor, as contradistinguished from the use of it by himself in his chamber.”

Public use by one person sufficient to avoid a subsequent patent.

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

Manton v. Manton.

Thus, in the case of *Manton v. Manton* (n), Lord Chief Justice Gibbs held, that proof of the invention having been used or practised (in public) by any one person before the date of the patent, would be sufficient to show that the invention was not new, and avoid the patent. So, in the case of *Carpenter v. Smith* (o), Lord Abinger, C. B., held, that if it were shown that the invention had been once in public use (that is, used in a public manner, not used by the public), or had been used by half-a-dozen individuals, or one, in a public manner, that would be sufficient to defeat the patent. In that case a witness proved (p) that he had made a lock five years before the date of the patent, upon the same principle as the plaintiff’s, which had been put upon a gate belonging to Mr. Davies, where the witness saw it every day; that he afterwards repaired the lock; and that it continued in use until the time it was taken off to be produced at the trial. Lord Abinger held this to be sufficient evidence of a public use of the invention, and told the jury that it was sufficient to justify a verdict for the defendant upon this issue. And upon a motion for a rule for a new trial in that case (q), on the ground of a misdirection, the Court of Exchequer held that the ruling of Lord Abinger, at nisi prius, was correct, and refused a rule.

Carpenter v. Smith.

Losh v. Hague.

So, also, in the case of *Losh v. Hague* (r), Lord Abinger,

(m) 9 M. & W. 300.

(n) Dav. P. C. 333.

(o) 1 Webs. R. 535.

(p) *Ibid.* 539.

(q) 9 M. & W. 300.

(r) 1 Webs. R. 205.

O. B., laid down the same law, that a single instance of public use is sufficient evidence for the defendant, upon this issue.

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

If it be shown that invention was used before for any purpose, not the same as plaintiff applies it to, defendant is entitled to a verdict.

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

Kay v. Marshall.

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

Losh v. Hague.

14. The want of novelty in an invention may also be shown by

Want of novelty may be

(s) Vide *ante*, Chap. V. s. 1, p. 94, and s. 2, p. 113.

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

(u) 1 Webs. R. 202.

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

shown by a
prior sale.

evidence that articles produced by the exercise of the art or invention were sold before the date of the patent. The reason of this is, that a sale of such articles is evidence that a prior inventor has published the invention to the world, and given the benefit of it to the public. And accordingly it is the constant practice to give evidence to prove that articles the same as the patent articles were sold before the date of the patent.

Wood v. Zimmer.

Public sale by the inventor himself will avoid a subsequent patent.

In the case of *Wood v. Zimmer* (y), it appeared that the patentees had, four months previous to the patent, sold an article composed in precisely the same manner as that for which the patent was obtained, although under a name different from that contained in the title in the patent. Lord Chief Justice *Gibbs* held, that inasmuch as the patentees sold the article previously, they gave it to the world without a patent, and could not afterwards obtain a (valid) patent for it. And his Lordship said—"some things are obvious as soon as they are made public. Of others the scientific world may possess itself by analysis, some inventions almost baffle discovery. But to entitle a man to a patent, the invention must be new to the world. The public sale of that, which is afterwards made the subject of a patent, though sold by the inventor only, makes the patent void."

Morgan v. Seaward.

Public sale by inventor before the patent will show that invention was not new.

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

Single instance of sale sufficient.

(y) Holt, N. P. C. 58.
(z) 2 M. & W. 544.

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

deemed the commencement of such a practice and the public use of the invention, so as to defeat a patent."

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

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

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

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

And in the case of *Cornish v. Keene* (h), the Lord Chief Justice Tindal told the jury, that if the defendants had shown that they had practised the invention, and produced the same

(b) 6 A. & E. 735.

142.

(c) 1 Webs. R. 206.

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

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

462.

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

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

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

result in their factory before the time the patent was obtained, they could not be prevented by the subsequent patent from going on with that which they had done.

Sale of articles
for exportation.

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

Carpenter v.
Smith.

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

If any part of
invention not
new, defendant
entitled to a
verdict.

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

Brunton v.
Hawkes.

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

If the specifica-
tion includes
any thing
known before
the date of the
patent the in-
vention is not
new.

18. If the defendant can show that the description contained in the specification by reason of its generality or otherwise, has the effect of including in the patent any thing that was publicly known, or used before the date of it (m), so that a

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

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

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

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

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

subsequent use of a thing so included in the patent would be an infringement of it; the defendant will be entitled to a verdict on this issue.

This was in effect laid down by Lord *Eldon* in the case of *Hill v. Thompson* (n), in which his Lordship said, that "if a patentee seeks by his specification any more than he is strictly entitled to, his patent is thereby rendered ineffectual, even to the extent to which he would be otherwise fairly entitled."

And in the case of *Losh v. Hague* (o), Lord *Abinger*, C. B., said to the jury, "a man can always take out a patent for a new improvement; but when he makes his specification, he must take care that he does not put among his improvements that which another man had before made, or got a patent for."

19. It is therefore important, with reference to the evidence to be given under this issue, to consider what would, or would not be, an infringement of the patent; and then to ascertain whether every thing to which the patent would thus apply, was new at the date of the patent. And if the defendant can prove that there is any art or invention which was public property at the date of the patent, and which would, if used afterwards, render a person liable for an infringement of the patent, if it were valid, the plaintiff cannot have a verdict upon this issue, for he cannot show that every part of the invention was new at the date of the patent (p).

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

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

(n) 3 Mer. 626.
 (o) 1 Webs. R. 206.
 (p) Vide ante, p. 119.

(q) 6 A. & E. 735.
 (r) 1 Webs. R. 538, 539.

include something which was before known, the patent was bad for want of novelty in the invention.

Williams v. Brodie.

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

R. v. Else.

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

Bovill v. Moore.

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

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

Defendant may prove a prior knowledge or use, in any part of the United Kingdom.

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

Brown v. Annandale.
Act of Union with Scotland extended the Statute of Monopolies to Scotland.

This was in effect decided by the case of *Brown v. Annandale (b)*, in the House of Lords. That case it is true was an appeal from a decision of the Court of Session in Scotland; but it is quite clear that the decision of the House is quite as applicable to an English as to a Scotch patent. The effect of that decision is in fact this, that by the Act of the Union between England and Scotland, the Statute of Monopolies (c) was as to patents extended to Scotland, and that from that

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

(t) Dav. P. C. 144.

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

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

(x) Dav. P. C. 203.

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

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

(a) 1 Stark. 354.

(b) 1 Webs. R. 433.

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

into the words, "this realm," in the statute meant, not merely England, Wales, Berwick-upon-Tweed and the colonies, but Scotland also; and that if an invention is shown not to be new in any other portion of the realm than that to which the grant extends, the patent is void.

The words "this realm," in the statute, includes Scotland.

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

Stat. of Union with Ireland.

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

What evidence will not show a want of novelty.

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

Prior invention for effecting the same object by different means.

Thus, in the case of *Hullett v. Hague* (*f*), it appeared that the patentee had, by his specification, described his invention (intituled "improvements in evaporating sugar") as follows—
"I do further declare that my said invention and improvement consists in forcing, by means of bellows, or any other blowing apparatus, atmospheric, or any other air, either in a hot or cold state, through the liquid or solution subjected to evaporation; and this I do by means of pipes, whose extremities reach nearly (or within such distance as may be found suitable under

Hullett v. Hague.

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

which would be insufficient to show that a patentee was not the first inventor.

(*e*) See further the observations and cases, *ante*, p. 448, as to evidence

(*f*) 2 B. & Ad. 370.

peculiar circumstances) to the upper or interior area of the bottom of the pan or boiler containing such liquid or solution, the other extremities of such pipes being connected with larger pipes, which communicate with the bellows or other blowing apparatus which forces the air into them." The defendant gave in evidence a prior patent and specification, comprising an invention for the same object. But it appeared that the prior patentee used pipes perforated with holes, and coiled at the bottom of the vessel, or a shallow metallic vessel of the nature of a cullender; and the Court of Queen's Bench held that as the subsequent patentee effected his object by different means, the inventions were perfectly distinct, and that the prior patent and specification were no proof of a want of novelty in his invention, although the object of the two inventions was precisely the same (g).

If the means used are different, the similarity of the object is not material.

Walton v. Potter.

New mode of producing the same object.

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

Secret use will not prove a want of novelty.

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

Bentley v. Fleming.

In the case of *Bentley v. Fleming* (i), it appeared that the patent had been obtained for a card machine; and there was evidence that about five or six weeks before the patent was obtained, the inventor had lent his patent machine to one N., in order that he might try whether it would set the teeth of the cards, and in order to discover whether it was worth while to take out a patent for it or not. There was also evi-

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

317-365.

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

(i) 1 C. & K. 587.

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

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

In the case of *Morgan v. Seaward* (*m*), an action was brought by the assignee of a patent for an invention, one part of which was an improved paddle-wheel. It was proved in evidence, that before the date of the patent (which was the 22nd July, 1829), Curtis, an engineer, made for Morgan (one of the plaintiffs) two pair of wheels upon the principle men-

Morgan v. Seaward.

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

(*l*) 1 Car. & Kirw. 587.

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

tioned in the patent at his own factory. Galloway, the patentee, gave the instructions to Curtis under an injunction of secrecy, because he was about to take out a patent. The wheels were completed and put together at Curtis's factory, but not shown or exposed to the view of those who might happen to come there. After remaining a short time, the wheels were taken to pieces, packed up in cases, and shipped in the month of April on board a vessel in the Thames, and sent for the use of the Venice and Trieste Company, of which Morgan (one of the plaintiffs) was managing director, and which carried on its transactions abroad, but had shareholders in England. Curtis deposed that "they were sold to the Company," without saying by whom, which might mean that they were sold by Curtis to Morgan for the Company; and Morgan paid Curtis for them. Morgan and Galloway employed an attorney, who entered a *caveat* against any patent on the 2nd of March, and afterwards solicited the patent in question, which was granted to Galloway and assigned to Morgan. Upon these facts, a verdict was entered for the defendant at *nisi prius*, upon a plea alleging that the invention was not new, but leave was reserved for the plaintiff to move the Court of Exchequer to have the verdict entered for him on that issue. The Court afterwards made a rule absolute for entering a verdict for the plaintiff on the ground that the disclosure was private and confidential, and that the sale of wheels was not a public sale, nor a transaction from which the inventor derived any profit (n).

Unsuccessful experiments will not defeat a subsequent patent.

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

Jones v. Pearce.

Thus, in the case of *Jones v. Pearce* (o), for an infringement of a patent for improvements on wheels for carriages, it

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

(o) 1 Webs. R. 122.

appeared that wheels similar to the plaintiff's had been made and used by Mr. Strutt before the date of the patent, but that the wheels being afterwards broken they were laid aside. Mr. Justice Patteson told the jury, that if they were of opinion that Mr. Strutt's wheel was an experiment, and that he found it did not answer, and ceased to use it altogether, and abandoned it as useless, and no body else followed it up, there was no reason for saying that the plaintiff's patent was not good.

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

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

(p) 1 Webs. R. 508.

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

(r) See also the charge of Mr. Justice

Cresswell, in *Walton v. Bateman*, 1 Webs. R. 619.

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